

PROTECTING YOUR REPUTATION ON SOCIAL MEDIA AND THE INTERNET

Presented by:



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Rich Peirce focuses his practice on trademark, copyright, Internet, and e-commerce issues. These include issues related to Internet brand protection strategies, online brand disputes, content moderation and user generated content, online defamation and product disparagement disputes, search engine advertising, website linking, CAN-SPAM, copyright disputes and fair use, social media, false advertising, website policies and privacy, licensing, domain name disputes, and the FTC guidelines on the use of endorsements and testimonials in advertising.

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Introduction

- Social media and the Internet provide unlimited space for attacks on reputations.
- It can be overwhelming at times. Whether those attacks are directed at brands, companies, or executives, the potential for reputational damage is very real.
- Intellectual property, platform mechanisms, and other tools can be used to address and respond to problematic content.
- Preventive steps can assist with responsive actions.

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Prevention – Protect Your Marks

- Trademarks (goods) and service marks (services) are traditionally words, logos, symbols, taglines, and combinations of these, that identify the source of the goods and services.
- Strong trademark protection can be valuable for takedown requests on platforms.
- If the attacks target trade names or brands, proof of protection can be key.
- Clearance searches can help spot issues before they become more serious.
- The availability of the relevant .com, other relevant domain names, and social media usernames, must be considered.

Prevention – Protect Your Marks

- If feasible, pursue federal registration. The primary benefits include the potential for nationwide rights, and the ability to put third parties on notice.
- Police the Internet, social media, and newly registered domain names.
- You do not have to pursue every problematic use at the same time, but you do have to take steps to protect and enforce your brands.
- If you license your marks for others to use, you must make sure there are quality control mechanisms in place.

Prevention – Protect Your Marks

- Every use of your mark is not always a legal issue.
- Is the issue a potential infringement (a protectable mark, priority of use over the alleged infringer, and a likelihood of consumer confusion)?
- Instances of Internet confusion are not always actionable.
- It may be ok for third parties to show up on Google searches for your name/brand.

Prevention – Protect Your Marks

- Can you go after third party sites that seem to help or contribute to an issue?
- One type of secondary liability is contributory infringement. Is the third party intentionally inducing infringement? Is the third party continuing to supply something to a direct infringer whom the third party knows or has reason to know is engaging in infringing behavior?
- Tiffany/eBay case = No direct or indirect infringement. General knowledge of counterfeiting is not enough. The notice and take down procedure was good, yet you cannot be willfully blind.

Prevention – Protect Your Marks

- Is a fair use of the mark being made? Is it nominative (e.g., comparative advertising) or descriptive (Apple for apples)?
- Nominative Fair Use: (1) the product or service in question must be one not readily identifiable without use of the mark; (2) only so much of the mark may be used as is reasonably necessary to identify the product or service; and (3) the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the mark holder.

Prevention - Control of Your Content

- Social media platforms usually have rules in place relating to who owns what once it is posted.
- Even if ownership is not transferred, the rules may provide for the grant of a very broad license.
- Posting copyrighted content may decrease its value.
- If you plan to post something on social media or to someone else's blog, you need to understand how such content can be used by the platform.

Use of Domain Names and Cybersquatting

- Was your mark used in a domain name? What about a social media usernames or hashtags?
- What is cybersquatting? Has someone else registered and used a domain name that is similar to your mark?
- 15 U.S.C. § 1125(d) is the main cybersquatting portion of the trademark statute. Is suing always best? Can you buy it?
- The Uniform Domain Name Dispute Resolution Policy (“UDRP”) provides a good alternate to litigation in some situations.

Responding To Problematic Content

- Even deleted posts can be captured, circulated, and commented on resulting in brand damage and embarrassment. What is your “public relations” plan if something inappropriate gets posted?
- Do you have a policy in place for employees and social media use?

Responding To Problematic Content

- Overreaction and other questionable IP and brand enforcement tactics can get you into trouble on social media.
- IP “bullies” can get exposed.
- All unauthorized uses of your content or brands are not always infringing or problematic uses, so be mindful of form enforcement.

Platform Rules

- Many platforms have rules and list prohibited conduct.
- Investigate internal complaint procedures.
- Use the rules as the basis for a removal request.
- Be mindful of what you allege.

Copyright

- What can be protected by copyright? *Original works of authorship that are fixed in a set/tangible medium/format.*
- This may include literary works, photos, graphics, and videos, to name a few.

Copyright

- Initial ownership vests in the author/creator.
- What are “Works Made for Hire?” The employer is considered the author in most circumstances if the work was created by an employee as part of his/her work duties.
- What about independent contractors? Assignments are critical if you want to own the copyright rights.

Copyright

- Infringement - Anyone who violates any of the exclusive rights of the copyright owner is an infringer. This can involve making unauthorized use and/or copies on the Internet.
- “Substantial similarity” and access is the test for infringement.

Copyright

- Does the content at issue use copyrighted content?
- Removal of infringing material on social media can be done through the Digital Millennium Copyright Act.
- Most social media sites have a DMCA take down procedure in place under 17 U.S.C. § 512 of the Copyright Act.

Copyright

- Have you considered whether the use is fair?
 - (1) The purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes (raw commercial use vs. something else);
 - (2) The nature of the copyrighted work (creative vs. nonfiction work);
 - (3) The amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
 - (4) The effect of the use upon the potential market for or value of the copyrighted work.

False Advertising

- Federal law provides a cause of action for false advertising.
- The Lanham Act (15 U.S.C. § 1125):
 - *“Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any ... false or misleading description of fact, or false or misleading representation of fact, which ... (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable ...”*

False Advertising

- False or misleading statement of fact (*e.g.*, “*There are no sellers that provide more rebates than Company*”).
- Statement made in interstate commerce in connection with commercial advertising or other promotional activity.
- Statement is a material statement that deceives or can deceive a substantial number of relevant consumers.
- Statement causes injury or is likely to cause injury.

User Generated Content and Defamation

- Defamation is a state law issue, so the legal definition will vary from state to state.
- In general, defamation claims can involve analysis of:
 - A false or defamatory communication made by the Defendant that applies to the Plaintiff.
 - An understanding of its false nature by those who hear/see it.
 - An understanding that the false statement applies to Plaintiff.
 - Some level of harm or damages.
 - No applicable defenses.

User Generated Content and Defamation

- Social media and other platforms or sites that allow user generated content will generally enjoy a broad immunity against liability for any user generated content that is defamatory (*Section 230 of Communications Decency Act, 47 U.S.C. § 230*).
- *§ 230(c)(1) (Treatment of publisher or speaker) - No provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.*
- You can ask, but the immunity is broad and tough to circumvent.

Right of Publicity

- Has someone's name or likeness been used for commercial or advertising purposes? Without authorization?
- Does the name or likeness have commercial value?
- This can be tricky if the intent of the behavior is to harm a person's reputation.

Thank you & Questions

Key Takeaways

- Make sure relevant marks are properly protected
- Every negative comment does not raise a legal issue
- Consider what tools (e.g., IP, platform complaint mechanisms) are available to use
- Try not to make things worse from a public relations perspective

Let's stay connected

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