

Protecting your brand in the social media environment

Global trademark practitioners offer practical guidance on the creation and execution of a resilient social media strategy

As social media and networking tools become both more sophisticated and more prevalent, the trademark, legal and brand reputation challenges that they present are likewise increasing. In many respects, trademark law is still playing catch-up in terms of the protection afforded to marks. As such, the need for clear strategic advice on this complex issue has never been greater. WTR sat down with a number of different specialists to discuss practical strategies for social media engagement, protection and enforcement.

To start, what are the fundamental elements to include in an internal social media policy?

Lisa Greenwald-Swire: A company's social media persona communicates a great deal to its consumers and acts as another 'face' of the company. Therefore, it is important to safeguard the company's reputation by crafting a clear internal written policy that applies to each person in the company, from top to bottom, and that extends to each employee's personal use of social media, even when off duty. At its most basic, a good social media policy should advise employees to use good judgement, be respectful and be transparent. Employees should be open about their position in the company when posting about the company, and also make clear that the views expressed are their own and not those of the company. A reasonable reference point to remember is that most postings online are there forever and cannot easily be removed.

A number of questions should be asked with respect to the company's social media accounts. Who is authorised to create and maintain social media accounts on behalf of the company? In what way will social media

accounts be used by the company? What guidelines should those using the company's social media accounts follow to ensure that the company's brand is being protected, from both a trademark and a public relations perspective? Similarly, there are questions to ask with respect to company employees and their personal social media accounts. What are employees not allowed to post about the company? Are employees prohibited from speaking on behalf of the company in their personal social media accounts? What are the consequences for an employee's failure to adhere to the social media policy?

Rosie Burbidge: Social media – including personal websites, blogs, comments (on shopping sites such as Amazon or Q&A sites such as Quora or eHow) and wikis, as well as the more obvious examples such as Facebook, LinkedIn and Twitter – opens up incredible opportunities. But because participants are engaging in a conversation with the world, it also carries with it considerable risks – in particular, the risks of litigation and, perhaps more importantly for businesses, of damage to reputation.

Social media policies should not discourage staff from sharing their views and ideas. However, their use should be responsible and not reflect badly on the business. This will be second nature to most people, but for the few who are less aware of the impact of social media, a clear policy is invaluable. The business's trademark value, its reputation and confidentiality (of both the business and its clients) need to be maintained, and all 'employees should be aware that so-called online anonymity' is misleading. Most companies reserve the right to track all activity carried out on a work device. Even an anonymous private remark made from a personal device can be tracked

– for example, an internet service provider address can be used fairly easily to identify the makers of offensive or abusive remarks.

Malia Horine: It is crucial to develop company principles for personal online behaviour in line with business guidelines when employees are engaging in conversations about the company. Staff should exercise caution in mixing the personal with business, and be aware of their responsibility for their actions. A formal policy should therefore include guidelines on username registration, on writing social media content on behalf of the company and on the authorship of content unrelated to the company, but clearly showing employee affiliation.

How should this be communicated to staff and subsequently policed?

MH: A social media policy should be put in writing and included as part of every organisation's employee handbook. Guidelines can also be presented to the relevant groups or distributed in hard copy during team meetings, or offered as a short class through the company's online training programme.

LGS: I agree – an internal social media policy can best be communicated via a written code of conduct that is part of the employee handbook distributed within the company to every employee. This provides a clear protocol for anyone within the company who either interacts with the company's social media accounts and/or uses personal social media accounts outside the company. Presumably, the company will monitor its own social media accounts to ensure that content adheres to the internal policy. However, I do think that policing employees' use of their personal social media accounts can be much more difficult. A company need not, and perhaps should not, go so far as to police each individual employee's social media accounts for violations of internal policy. However, the company should respond to any violations that come to its attention, particularly if

they harm the company's reputation, divulge confidential company information or otherwise violate the social media policy.

RB: Staff certainly need to be made fully aware of the detail of the policy – for example, through publication on the company's intranet and training sessions. To ensure compliance, businesses should consider expressly including it as part of the employment contract.

Ideally, social media guidelines should help employees to participate safely in social media, with minimum risk, either personally or to the business. This can be achieved through a clear social media policy which clearly delineates between the three sorts of social media interaction: the clearly private (eg, Facebook), the unquestionably professional (eg, LinkedIn) and the blurry line (eg, blogs). But ultimately, the policy and its enforcement should be proportionate and balance the concerns of the company with the freedom of the employee. Telling people what to do in their spare time is really quite restrictive. Clearly, however, where someone is representing the company on social media, the level of monitoring should be much higher and pre-clearance of some or all posts may be appropriate.

MH: Social media policing can be a function of the marketing team leadership, the IT group or human resources staff – or if your company has one, the social media group. The social media monitoring tools available now make it much easier to review content and ensure that it meets company guidelines and is posted with prior approval. Other tools permit IT staff to review the websites that their employees visit during work hours. These are useful if, for example, the company doesn't allow its staff to look at Facebook during the business day.

When considering the company's social media presence, at what point in the process should marketing people consult with trademark experts? What role can trademark counsel usefully play?

RB: This completely depends on how the company is planning to use social media. Is it about connecting with customers or is it about raising profile? Are you educating or advertising, or both? The guiding principle, however, should be that early consultation may well prevent expensive litigation. And remember that social media is online and hence global – so brand guidelines may require updating in light of the global reach of the Internet.

Marketeers will also need to think about



Lisa Greenwald-Swire
Principal, Fish & Richardson PC
Greenwald-Swire@fr.com

Lisa Greenwald-Swire is a principal in Fish & Richardson's Silicon Valley office. Her practice emphasises US and international trademark counselling and prosecution, including issues related to branding strategy, domain name disputes and licensing. Ms Greenwald-Swire also assists clients with trademark and copyright infringement issues in federal court. She is frequently asked to speak on issues related to trademarks and the Internet, and was most recently named one of California's Top IP Lawyers by the *Daily Journal*. She has also been listed in the *WTR 1000* by *World Trademark Review* two years in a row (2011-2012).

the get-up and branding of the social media site – particularly in a world where colour marks are valid in some jurisdictions. As with any new advertising campaign, it is always advisable to get professional advice first, and trademark counsel have a useful role to play in the development and implementation of an online strategy that deals with issues of both protection and enforcement.

In relation to protection, counsel will be able to advise on matters such as the desirability of registering the company's brands (and key brand variations) as usernames on social media sites; the insertion into legal agreements of clauses dealing with online use; and the development of monitoring programmes in relation to third-party use of the company's brands. In relation to enforcement, counsel can provide particularly valuable assistance in the development of an appropriate strategy. Enforcement in the context of social media has its particularities: how you have dealt with a particular 'infringer' can spread like wildfire and negative publicity can outweigh any

advantages that might be gained. An enforcement strategy that encourages a certain lightness of touch, use of the social media sites' complaints procedures and litigation as a last resort is likely to be worth its weight in gold.

LGS: As a general rule, it is never too early for marketing departments to consult with trademark counsel with respect to their company's social media presence. Because social media is a pivotal marketing tool in today's increasingly online society, a company should determine whether a brand is available or can be acquired as a username on key social media websites, even before selecting the brand itself. It can be dangerous for a company to invest considerable goodwill and money in a brand that it only later discovers is no longer available on Facebook or Twitter, for example, or – even worse – is already owned and used by a direct competitor. Trademark counsel can provide early guidance as to which trademarks are relatively clear for a company's use and registration, and which are likely to be problematic because of a potential likelihood of confusion with existing trademarks.

MH: Prior to posting any content, marketing should consult with trademark experts and ensure that the necessary social media usernames have been captured. Legal should also be consulted at this point, so they can highlight any potential negative branding ramifications within the company's social media plan. If the company is subject to governmental regulation, it is important for counsel to make sure an agreement is in place on whether pages will be open or closed and whether their content will be monitored.

Turning to external issues, how should companies then approach the monitoring of social media sites for trademark infringement/brand misuse – and how big a problem is it?

MH: An effective social media monitoring programme tracks two things: third-party infringement of usernames and trademark or content misuse within actual social media posts, including infringement, unauthorised sales, offensive or disparaging mentions and so on. Whether or not you have a social media marketing plan in place, the chances are good that people are already talking about and interacting with your brand online. It is very important that you monitor and be aware of what is being posted, just as you would other online content. Your reputation is at stake!

RB: And there is a potentially unlimited amount of trademark misuse and infringement on social media sites to contend with, ranging from fake brand sub-sites to 'sucks' pages and blogs. The extent of the problem varies with the type of brand (eg, fashion and technology brands tend to have more difficulties than life sciences brands), but no brand is immune. It is therefore useful to have a policy which outlines the approach to be taken to each type of infringement. This should take into account the cost and potential public backlash. Serious online infringement and counterfeiting should be actively monitored – a number of online services offer this service. For smaller businesses, a basic search carried out on a regular basis may be sufficient. Having a reporting facility on your official website is very useful in terms of getting leads on fake sites or pages. At the other end of the scale, misuse (but not abuse) of trademarks may warrant a friendly email, use of the social media website's reporting tool or, if on a large scale (or if the friendly approach does not work), a cease and desist letter. All of these letters should be tailored to the infringer.

Before sending anything, it is worth considering whether the comment really damages your brand. Very often, use of social media is in a private rather than a commercial capacity; if it doesn't damage the brand and doesn't infringe your rights, do you need to take any action at all? The key, as outlined above, is to have a good clear policy in the first place.

LGS: Either in-house or outside counsel should be monitoring social media sites for trademark infringement by checking whether users are infringing the company's trademarks or misleading consumers into believing that they are somehow affiliated with or authorised by the company when they are not. Monitoring typically involves conducting regular searches on social media websites or via search engines such as Google or Bing for infringement or misuse. It is especially important that companies be vigilant to ensure that third parties are not securing the company's brand as a username (eg, www.facebook.com/yourbrandhere/) and appearing to present themselves as the company or as being associated with the company. Companies should also be aware of infringers that typosquat on social media websites (eg, www.facebook.com/urbrand/ or www.facebook.com/yourbrand1/), as these instances of misuse can be just as confusing to consumers, and the possibilities for typographical errors are nearly endless.



Rosie Burbidge
Associate lawyer, Rouse Legal UK
rburbidge@iprights.com

Rosie Burbidge is an IP lawyer and regular blogger on art law issues for art and artifice. Her particular area of interest is digital photography and its use in social media. She works for a variety of IP-rich companies in the fashion, digital media (including gaming), life sciences and technology industries. She has particular expertise in copyright, trademark and domain name infringement and cross-border patent litigation.

What initial steps should a trademark owner take when it finds cases of infringement?

LGS: First, the owner should capture evidence of the instance of infringement by either saving a screen capture or printing the particular webpage. Next, review the IP policy on the specific social media website and determine whether the owner can issue a takedown notification through either a formal letter or an online form directly on the social media website. A determination of whether the incident constitutes infringement and should be removed involves a number of factors, including the nature of the incident and whether defences to infringement apply, such as nominative fair use. Finally, an owner may want to consider the practical implications of issuing a takedown notice – specifically, whether requesting removal of content may create a public relations fiasco or otherwise do more harm than good.

RB: It's important to be mindful that in a very short space of time, legal letters can be published and dissected, and public campaigns started against your company – even if you are completely justified in asking someone to stop using your mark. Social media involves a conversation and it is open

to companies themselves to engage in that conversation. So appoint an individual to respond to these sorts of issues. A friendly email (or post/comment) saying that your company owns rights in the name and please can they not use it anymore without clearing it first may be a lot more effective, at least in the first instance, than a long legal letter quoting all sorts of legal issues which the user is unlikely to understand or care about (but is likely to scan in and disseminate).

MH: It's worth adding that the first step, and one that you should take well in advance of any infringement actions, is to defensively register the appropriate usernames for your brands so that others don't. This reduces the need for username monitoring and also ensures that your marketing department has the usernames it needs when it comes time to register them on popular and emerging social media sites. At a minimum, companies should identify their main brands and proactively register the corresponding vanity URLs. If you then detect infringement against your brands, your first recourse is the terms of service agreement specific to each social media site. Report your claim of copyright or trademark infringement to the social networking site and have it removed or access to it disabled. Facebook, for instance, has two forms of action available to aggrieved parties: an automated IP infringement form and a Digital Millennium Copyright Act notice of copyright infringement. If necessary, companies can attempt direct communication with the infringer or pursue arbitration or litigation actions.

Staying in this area, do most social media sites tend to have comprehensive trademark and username policies?

MH: As mentioned above, each site has its own terms of service policy, which serves as recourse for handling any instances of trademark misuse. Of course, some policies are much more established and the site owners work well within their policies. Others are not as well defined or are poorly managed. It is important to review and understand the policies of all main social media sites that you intend to participate on, preferably before you establish a presence there.

LGS: While most social media websites have detailed trademark and username policies and purport to respect brand owners' rights, in the end it does indeed come down to how responsive a specific site is when a company

brings allegations of infringement or misuse to the site's attention. While some sites are responsive to communications regarding removal of infringing material, at the other end of the spectrum, some social networking sites may not always respond to takedown requests expeditiously or may make it difficult to find a point of contact to correspond with regarding IP violations.

RB: I would say that these policies and social media sites' responsiveness to complaints have both improved dramatically in the last couple of years. All the main social media sites encourage initial engagement with the individual concerned before using the policy, which may be a cost-effective starting point and can enable a quick resolution. However, where there is illegal activity such as counterfeiting, you may prefer to make a test purchase and save the relevant web pages before taking stronger action.

Facebook has problems with counterfeiting, fake sites and individual pages (particularly of celebrities). Facebook's reporting facility is fairly straightforward and can be completed directly by the brand owner. It covers copyright as well as trademark infringement, which can be useful for logos and unregistered but distinctive brand designs. Twitter is a bit more complicated, because in many ways a Twitter ID is analogous to a domain name. Only one ID per name is available and it is not easily transferable. If someone tweets in his or her own name, which is also the name of celebrity or a brand (a particular issue for the fashion industry), there may be little that the more famous person can do.

He Fang: In China, the Twitter equivalent is Sina Weibo, a popular platform used by more than 22% of the Chinese internet population. Sina Weibo started a requirement for 'true-ID' registration in early 2012, which requires users to provide their name and mobile telephone number, which must then be verified. Those who refuse are barred from posting messages and limited to reading others' entries. This makes the enforcement and protection on Sina Weibo much more straightforward.

In some instances, brand misuse may be accidental or stem from a genuine misunderstanding of trademark law (rather than due to wilful infringement). How should a brand owner make that assessment and tailor its approach appropriately, so that it is not seen as heavy handed?



He Fang
Consultant, Rouse (China)
fhe@iprights.com

He Fang is a consultant to the Dispute Resolution Team in China and works on a wide range of contentious IP issues. His experience includes advice and advocacy for a range of right holders across a range of industries. He has substantial China litigation and enforcement experience and significant advocacy experience in the courts. He has successfully advocated for a number of clients in a series of high-profile and award-winning cases and is widely renowned as an IP litigation expert in China.

LGS: It is a good point to remember that not all misuse or infringement of a brand comes with ill will. In some instances, brand owners should be aware that genuine fans of the company, as opposed to competitors, can just as easily misuse a brand. For example, fan sites or fan-made products to be used in conjunction with an owner's product (eg, a knitted pouch for the 'Your Brand' widget) can be inappropriately labelled so as to result in trademark infringement or misuse. The company should carefully consider such instances of infringement in terms of how it wants to be perceived publicly and/or whether it wants to risk offending a loyal fan with a takedown request. On the other hand, the brand owner has a duty to protect its trademarks, as even the best-intentioned instances of infringement can still mislead consumers into believing that the fan site and fan product originate from, or are endorsed by, licensed by or somehow associated with, the brand owner when they are not.

RB: As noted earlier, a short, polite email or message is always a good starting point.

Unless the infringement is really severe or causing brand damage, you should give the infringer enough time to respond before taking action. You always need to bear in mind that your email, letter or similar could be published online. It is useful to imagine it, and give it the same degree of attention, as a press release. You can have standardised letters/emails, but be careful to tailor them appropriately. Make sure it is not a wholly automated process – nobody likes to be told off by a computer.

MH: Ultimately, the trademark owner should handle this in the same manner as it would other instances of online infringement. In many cases, contacting posters and making them aware of the issue is enough to resolve it. Social media spreads very rapidly, so a heavy-handed approach can have negative impacts on a company's reputation. The company may also choose to ignore certain situations rather than address them because with social media, it can be 'here today, gone tomorrow', and the time and effort required to address a problem will not pay a high return.

Where an action results in a backlash, should the brand owner seek to engage the community proactively and engage in online discussion? If so, how, and who should take on this function?

RB: This can be done either very well or very badly. Social media is about people. If a brand breaks the trust of an online community, the response should not be from the 'brand', but rather from the people representing the brand. Responsibility should be taken immediately and unequivocally, and measures put in place to prevent the problem from happening in the future. One of the most interesting examples of this recently was Vogue Spain's use on its Instagram feed of photos that it claimed as Vogue images, but which were in fact taken from other Instagram users (who were not credited). No cease and desist letters were necessary – the backlash was immediate and Vogue Spain ultimately retrieved the situation through an unequivocal apology to the artists involved (and artists in general).

LGS: It is certainly appropriate for a company to make clear that it has a duty to protect its IP rights, although this should be done in a reasonable and measured manner. This is likely an issue that the public relations and marketing teams should tackle. There are some instances when no

response is the best one, so as not to call further attention to a matter.

MH: Remember that social media is meant to be a fun and informative way to engage with customers. It requires that the brand owner have a 'thick skin' in certain situations, because it is inviting consumers to interact with it, and they may not always have a positive experience or interact with the brand in ways that the brand owner would like. Social media takes place in real time and changes quickly. It is important to assess the risk of letting a situation go versus addressing it. If you address it, make sure you understand how the content could then be used and what potential backlash it might cause. In the case of usernames, if a third party is using your username and is posting content that is damaging your brand or causing consumer confusion, it definitely needs to be addressed.

What should brand owners be aware of when using the trademarks of social media sites themselves – for instance, on marketing messages?

LGS: Where appropriate, brand owners can certainly make fair use of social media sites' trademarks. For example, in referencing the fact that a company has a Facebook page, it would be incredibly difficult to convey this information without making reference to the word 'Facebook'. However, brand owners should avoid using a social media site's trademarked and/or copyrighted logos or designs without authorisation. When in doubt, brand owners can use the ® or ™ symbols immediately following the social media site's trademark to denote their recognition, as well as to convey to the public that the word or symbol is that site's or company's trademark.

RB: Clearly, the key social media sites all have registered trademarks for both their names and their logos. The Facebook 'like' symbol is both ubiquitous and a trademark. Each social media site has a different policy – most will allow some online usage without pre-clearance, particularly to link to the relevant page (eg, via the Facebook 'like' button), although some have exceptions for pornographic or gambling websites and online advertising. For any other use, particularly broadcast usage, permission should first be sought. The main thing is to check the relevant policy first.

MH: If you point customers to your social media site, make sure that you are monitoring the site for activity and engaging them. It has become common practice for



Malia Horine
Director of business & product
development, Corporation Service
Company
CIPServices@cscinfo.com

Malia Horine has spent the last decade partnering with Global 2000 companies and law firm clients to develop and maintain strong business practices for managing their intellectual property in the online environment. She is also responsible for developing new tools to help clients to promote and protect their brands online as the market changes and the challenge of brand protection grows. Ms Horine has prior experience working in both law firm and corporate environments, with responsibilities primarily focused in brand protection. This experience fuelled her desire to develop and implement strategies to make the growing landscape of protecting brands online manageable and effective.

many consumers to handle their customer service issues through a social media channel rather than call centres, email or even online chat. If you are marketing social media as a way for consumers to interact with you, be sure to have resources in place to support and respond to them.

Are there any other issues you would like to raise?

MH: It is important for every company to determine its social media approach. Do you plan to be proactive or reactive with your marketing efforts? Which sites will you focus on? Do you have a policy for managing usernames and content? Which of your brands or trademarks should be represented on social media sites? What budget and resources do you have for social media, from both a marketing and legal standpoint?

Answering these types of questions is an essential first step when navigating today's social media world. Another point that bears mentioning is that companies should treat usernames as they would a domain portfolio or trademark portfolio. Come up with a central process and repository for maintaining your usernames and passwords, so you don't lose access to valuable intellectual property. Be mindful of new sites emerging in the social media market (Pinterest is a current example), so you don't miss the 'next big thing'. It's equally important to incorporate social media into your monitoring and enforcement practices.

HF: In terms of this 'next big thing', there is no question that the mobile space will be the next battleground in China for social networks and the issues outlined above will apply in the same way. The move to mobile is being led by locations-based services, which use geolocation software to link users to places. More than 69% of the Chinese population access the Internet through mobile devices. The current leading service is Wechat — formerly known as Weixin. This is a mobile voice and text app with social features such as 'friend discovery'. In the future, it is likely to add features such as 'brands close to me' and 'services close to me', which can be easily shared across the network. As a result, negative brand comments, again, will be easy to spread.

LGS: Whatever the source in question, it is always recommended to address any potential infringement issues in a timely fashion. This is critical not only to reduce the likelihood of any consumer confusion, dilution or tarnishment of a famous brand, but also because an entity does not want to be subject to any equitable defences, such as waiver, laches or trademark acquiescence.

RB: Facebook may not have been quite as successful post flotation as everyone expected, but it and other websites like it are here to stay. Ensuring that brands engage without appearing too 'keen', and enforce their rights without being too militant, is a difficult balancing act which needs to be taken seriously and given the appropriate level of responsibility. Simply giving the job of updating Twitter or policing Facebook to an intern is a recipe for disaster. Clear guidance and management support should minimise the potential for an 'omnishambles'. [WTR](#)