

# An internal and external approach

## An effective policy for social media and internet trademark use starts from within

Companies are discovering that their trademarks are being used in ways that could not have been imagined a few years ago. For example, companies can purchase and use a competitor's trademark as a 'keyword', and then use these keywords to trigger internet advertising for their own products and services. Brand owners are also discovering that their marks are being used without authorisation on social media sites. This article explores these phenomena and makes suggestions for trademark owners with regard to the protection of their brands from a US perspective.

### Use of trademarks in social media

The remarkable growth of social media has been well documented. With it has come an increase in the use of brands and trademarks in social media. Sometimes this use is authorised; often it is not. Broadly speaking, two main sources of problems have emerged with regard to the use of social media by companies. Some problems are caused by the activities of people inside the company – that is, marketing staff, support staff, executives and others who provide or support content for social media platforms. The other source of problems is people from outside the company. How should a company manage its brand, and preserve its quality and the goodwill associated therewith, when faced with this overwhelming number of unauthorised users?

### Managing from the inside

One of the more important things that a company can do is to register its trademarks with the US Patent and Trademark Office. There is a cost-benefit analysis involved in this process, and at some point the benefit may be too low to justify the cost. Confronting abusive registrants and policing unauthorised users of marks on

YouTube channels and in similar contexts is much easier once a company has obtained federal trademark registration, however.

Most companies implement policies regarding the use of their email systems and computers. These need to be examined, extended or updated in order to cover the use of a company's brands and trademarks. The use of such brands and trademarks should be carefully controlled, just as third-party use is often controlled through the use of trademark use guidelines. At the very least, such policies can help to prevent employees from using the company's name or trademarks as part of their screen names and on their personal pages.

Other sources of concern are the company's marketing and investor relations departments. These departments must be monitored, as they are often on the front line of a company's social media activities. They have been known to create a company Facebook community page, YouTube channel or Twitter account without contacting the legal department or seeking external counsel. Properly informed marketing and public relations colleagues can serve as valuable assets in promoting branding consistency and in policing potentially harmful third-party uses of an organisation's trademarks on the Internet.

### Managing on the outside

It is also important for companies to police harmful third-party uses of their trademarks, especially in social media settings. This is done by monitoring social media websites and using search engines to conduct searches for third-party use. In addition to basic search engines, certain specialised services and online tools are available – some free, some fee based. These tools differ, so companies should ascertain which service or tool best corresponds to

their needs. Many companies use third-party vendors, in particular, to screen out false positives in the search results (eg, trademark use which is merely referential). Facebook community pages, Twitter accounts and comments on discussion boards should also be checked as far as possible.

Companies should assemble a 'toolkit' for dealing with unauthorised use. In many cases, the use may be in the content of the page, rather than the domain name, meaning that the Uniform Domain Name Dispute Resolution Policy does not apply. Companies also should familiarise themselves with the specific policies of Facebook, Twitter, YouTube and the other major social media websites. For example, Twitter's current terms of service allow it to terminate a user account at any time, whereas YouTube's general policy is not to become involved in trademark disputes (although it may close or transfer inactive accounts in response to a complaint).

Companies should respond to threats appropriately. Not all unauthorised trademark use is worth pursuing, whereas some abuses are especially egregious and require a strong demand letter or law suit. Other instances may be fair trademark uses that do not require action, or may constitute *de minimis* infringements that merit monitoring.

### Use of trademarks in internet advertising

When competitors reserve a company's trademark (or that of a client) as a Google AdWords keyword in order to attract attention to competing products and services, the prospect of bringing legal action is daunting. As Google plays an active role in the reservation of trademarks as keywords through its AdWords programme, brand owners have brought a number of

suits against Google in an attempt to tackle the practice at its source. The claims in these suits have alleged both direct and secondary trademark infringement.

### Google's AdWords programme

Google's AdWords programme allows users to reserve a term or 'keyword' that, when entered into Google's search engine, triggers advertisements that appear either as sponsored links at the top of the search results (ie, set apart from the ordinary search results by colour shading) or in a separate column to the right. Users can reserve a keyword that comprises another party's trademark, and users can also refer to the same third-party trademark within the advertising text.

The landscape of legal decisions in the United States concerning Google's potential liability for its role in offering trademarks as keywords has shifted recently in favour of Google. One court has ruled that Google's sale of keywords composed of trademarks to parties other than the trademark owners qualifies as trademark 'use' under the Lanham Act, and allowed claims against Google to proceed (*Rescuecom Corp v Google Inc*, 562 F3d 123 (2d Cir 2009)). This decision provided hope to those who sought a legal challenge against the auctioning of trademarks as keywords by Google and other search engine providers.

A more recent decision by the District Court for the Eastern District of Virginia assumed that Google's practices constituted trademark use and engaged in a more detailed analysis of the AdWords practice. The court's findings were bad news for aggrieved trademark owners. The court found that where a competitor's trademarks are used as keywords in generating paid-placement search results, Google's 'use' of the marks is merely for practical indexing purposes and does not constitute use in a source-identifying manner. The court also analysed Google's practice of auctioning keywords comprised of trademarks and concluded that consumer confusion is unlikely to arise from the practice (*Rosetta Stone Ltd v Google Inc* (Case 1:09cv736, ED Va, 8/3/10)).

### Google policies

Google has differing policies and procedures that apply where a trademark owner complains about another party's registration of its trademark as a keyword (as opposed to another party's display of its trademark within keyword advertising text).

Google's responses to complaints that trademarks have been used as keywords have varied by jurisdiction. Based upon the



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legal developments that have favoured it, Google will not consider disabling keywords that include trademarked terms where the search results are transmitted to the United States. In fact, Google will respond to trademark owner complaints to disable keywords that include trademarked terms to the extent that the search results and advertisements triggered by those keywords are served to an increasingly limited number of jurisdictions (ie, Australia, Brazil, China, Hong Kong, Macau, New Zealand, North Korea, South Korea and Taiwan). Where advertisements triggered by keywords that are third-party trademarks are served to the European Union or European Free Trade Area, Google will conduct investigations in response to trademark owners' complaints and disable keywords only where the context of the use, as viewed in combination with the advertising copy and nature of the so-called 'landing page', causes confusion "as to the origin of the advertised goods and services".

Google has also implemented a multi-jurisdictional approach to complaints involving the depiction of third-party trademarks within AdWords advertising text. Google will require the removal of third-party trademarks from AdWords advertisements in the vast majority of jurisdictions without a contextual analysis of whether the complained-of use is fair. However, in the United States (as in Canada, the United Kingdom and Ireland), Google observes a policy whereby it will not force the removal of third-party trademarks from AdWords advertisement text where the use is descriptive or generic, or where the use is by a reseller, component seller or information provider (according to Google's determination of whether the landing page for the AdWords advertisements in question indicates that the sites are "primarily dedicated" to such activities).

Brand owners would be well advised to take maximum advantage of Google's policies. Although the number of countries to which Google will block keyword-triggered paid placements is limited, they include important, populous markets, such as China, Brazil and South Korea. Companies should have their clients' and their own organisation's marks included on Google's list as far as possible.

Furthermore, brand owners should regularly conduct searches on Google and other search engines, using their trademarks as search terms, in order to review the text of paid-for-placement advertisements for misleading use of their trademarks. [WTR](#)