



#IP #TRADEMARKS: New Media, Hashtags, Trademarks & Brand Protection

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BRAND

What is a BRAND

- Brand is the **positioning of a product or service** in relation to other products and services in the market.
- **Consistency and connection of identity and values across platforms** in targeted and non-targeted interfaces.
- **Identification associated with** the relationship with the **consuming/customer world**
 - From the supermarket, to your house, to the latest social media platform—**the identity of the entity**
 - In the form of the product itself
 - Embodiment of the goodwill
 - The message and identity

What Digital Means for Brands & Vice Versa

- **Brands provide differentiation**
 - Easy to copy a product, but not a brand. As a consumer it lowers risk.
- **Brands help distill information**
 - In a world of innumerable news sources, brand can simplify your understanding
- **Brands shape perception**
 - Not about who/what is the best, but about which people think is the best

Millions of options all at once—the brand is crucial for navigating the online world

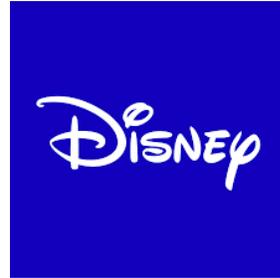
-Kellogg on Branding: The Marketing Faculty of The Kellogg School of Management 1st Edition, Kindle Edition

Brand Factors

- Key components include a brand's
 - **Identity:** Distinctive individual components, such as a name, a design, a set of images, a slogan, a vision, writing style, a particular font or a symbol etc. which sets the brand aside from others.
 - **Personality:** the set of human personality traits that are both applicable to and relevant for brands. e.g., cool, intellectual, tough, classy,
 - **Brand communication,** how a brand transmits a clear consistent message to its stakeholders
 - **Brand awareness,** customers' ability to recall and/or recognize brands, logos, and branded advertising.
 - **Brand loyalty,** the positive feelings towards a brand and dedication to purchase the same product or service repeatedly, regardless of a competitor's actions or changes in the environment.

RELATIONSHIP

Brands



Brands

@CocaCola
#CocaCola

@Disney
#Disney

@ChickfilA
#ChickfilA

@patagonia
#patagonia

@foxnewstalk
#foxnewstalk

@GoldmanSachs
#GoldmanSachs

@Google
#Google

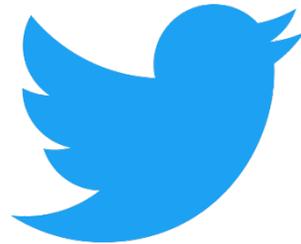
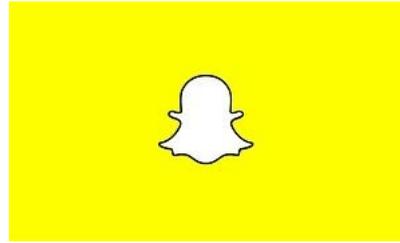
@I_LOVE_NY
#I_LOVE_NY

@Nike
#Nike

Social Media



Instagram



Influencers

- A social media influencer is a user with credibility in a specific industry, has compiled a large social media audience and can persuade others to act based on their recommendations.
- Are they on brand?
- What are their other endorsements?

Brand Protections

Brand Protection

Legal protections can help protect against the hijacking of your creativity, marks, and secrets that comprise/represent your Brand

- **Trademark:** Source identifiers
- **Copyright:** protects creative works of expression
- **Design Patent:** ornamental design of a functional item.
- **Trade Secret:** formulas, practices, processes, designs, instruments, patterns, or compilations of information that have inherent economic value because they are not generally known or readily ascertainable by others, and which the owner takes reasonable measures to keep secret
 - In some jurisdictions, such secrets are referred to as confidential information.

Trademarks

Brand Embodiment: Trademark Protection

- Anything that indicates the origin/source of a product or service
- Identify & distinguish goods or services

Trade Dress

Words

ALT LEGAL



Slogans



Sounds



Logos/Designs

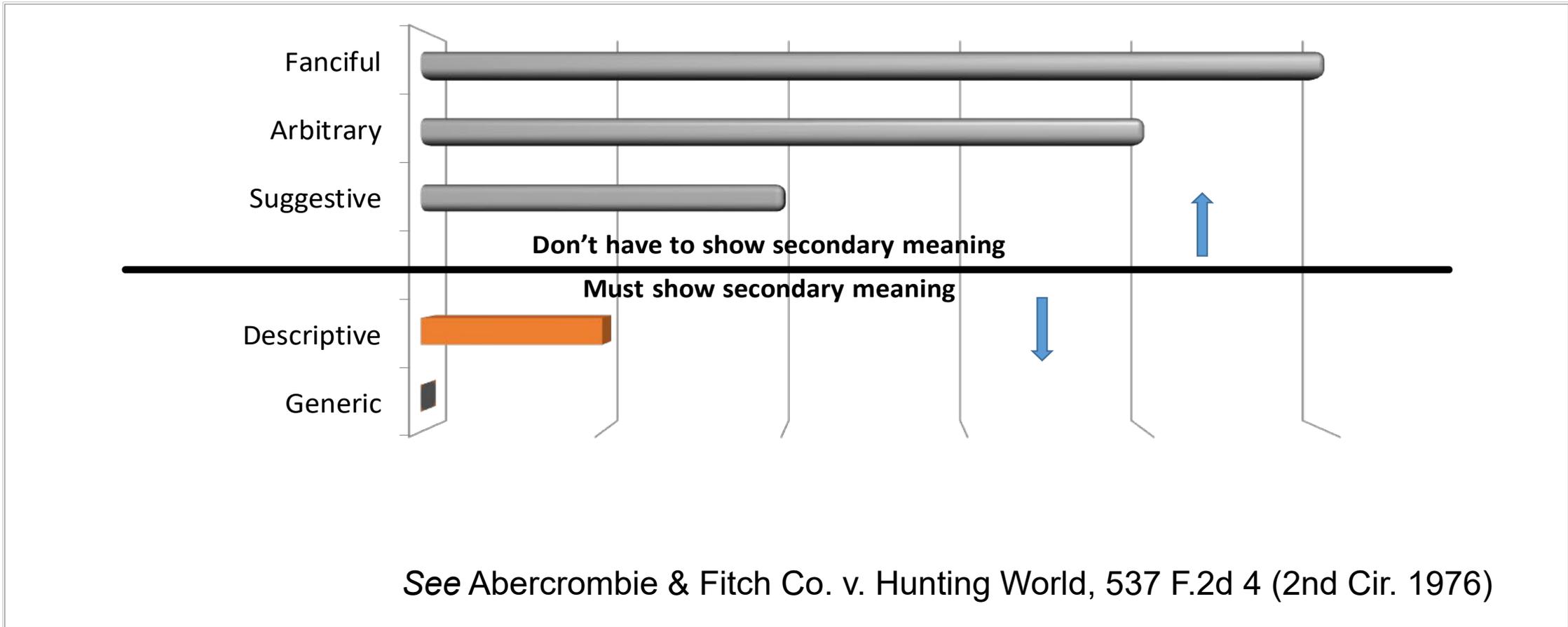


Colors



Knowing What You Have: Measuring Distinctiveness

Scale of Distinctiveness



Trademarks & Goodwill

- **Goodwill is** an intangible asset that represents the extra value ascribed to a company by virtue of **its brand and reputation.**
 - The Economist, p. 70, January 24, 2009,
 - <http://www.economist.com/node/12992559#print>
- A lot of discussion regarding brand:
 - Brands are embodiments of goodwill.
 - **Brand Is All About VALUE**
 - McCarthy §2:15

Trademarks & Goodwill

- Trademarks have *dual* roles:
 - Protect consumers from deception
 - Protect trademark as property
- The law promotes economic efficiency:
 - Encourage production of quality products
 - Reduce purchasing costs
- TM only gives the right to prevent use; to protect good will of “A” to the extent against “B’s” sale of “B’s” products as “A’s”.
 - McCarthy § 2:14

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Goodwill & Value

- “Going concern” value:
 - “...includes the liquidation value of a company's tangible assets as well as the present value of its intangible assets (such as goodwill)...and is the main reason why the purchase price of a company tends to be higher than the current value of the assets of the company.”
 - Going-Concern Value, https://www.investopedia.com/terms/g/going_concern_value.asp#ixzz53GifXZM6;
See also, Valuing a Business: The Analysis and Appraisal of Closely Held Companies, 5th Edition

Fair Use

- **Statutory Fair Use**

- 15 U.S. Code § 1115(b)(4)—“Uses Otherwise Than as A Mark”

- **Nominative Fair Use:**

- “use of another's trademark to identify, not the defendant's goods or services, but the plaintiff's goods or services.” McCarthy § 23:11.
- It is called "nominative" use "because it 'names' the real owner of the mark.
- “The doctrine of nominative fair use allows a defendant to use a plaintiff's trademark to identify the plaintiff's goods so long as there is no likelihood of confusion about the source of the defendant's product or the mark-holder's sponsorship or affiliation.” *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 102 (2d Cir. 2010) (alterations and internal quotation marks omitted).
 - *Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC*, 823 F.3d 153, 165, 2016 U.S. App. LEXIS 9045, *30-31, 120 U.S.P.Q.2D (BNA) 1388, 1397

Nominative Fair Use

When considering a likelihood of confusion in nominative fair use cases, *in addition to* discussing each of the *Polaroid* factors, courts are to consider:

- (1) whether the use of the plaintiff's mark is necessary to describe both the plaintiff's product or service and the defendant's product or service, that is, whether the product or service is not readily identifiable without use of the mark;
- (2) whether the defendant uses only so much of the plaintiff's mark as is necessary to identify the product or service; and
- (3) whether the defendant did anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the plaintiff holder, that is, whether the defendant's conduct or language reflects the true or accurate relationship between plaintiff's and defendant's products or services.

Int'l Info. Sys. Sec. Certification Consortium v. Sec. Univ., LLC, 823 F.3d 153, 168, 2016 U.S. App. LEXIS 9045, *37-38, 120 U.S.P.Q.2D (BNA) 1388, 1399

#WhatIsAHashtag

- **A hashtag**—introduced by the octothorpe symbol (#)—**is a type of metadata tag used on social networks** such as Twitter and other microblogging services. It lets users apply dynamic, user-generated tagging **that helps other users easily find messages with a specific theme or content.**

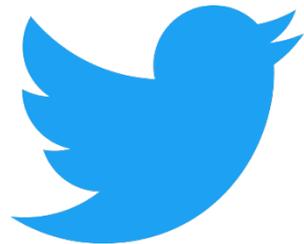
<https://en.wikipedia.org/wiki/Hashtag> (10/1/20, 9:15 pm)

#HashtagsTrend

- Hashtags are mostly used in unmoderated, ad hoc discussion forums;
- any hashtag, if promoted by enough individuals, can "trend" and attract more individual users to discussion.



Instagram



<https://en.wikipedia.org/wiki/Hashtag>
(10/4/20)

#HashtagsFunction

- Use of the hashtag...is merely a functional tool to direct the location of Plaintiffs' promotion so that it is viewed by a group of consumers, not an actual trademark.
 - Eksouzian v. Albanese, No. CV 13-00728-PSG-MAN, 2015 U.S. Dist. LEXIS 104793, at *23 (C.D. Cal. Aug. 7, 2015)

#HashtagsAffiliate

- Trademark use, within the context of a hashtag, indicates an association or affiliation—and crosses the line of nominative fair use or hashtag use.
- Metatags function behind the scenes to direct an internet searcher to a webpage, but **hashtags are visible to consumers in advertising.**
 - Align Tech., Inc. v. Strauss Diamond Instruments, Inc., No. 18-cv-06663-TSH, 2019 U.S. Dist. LEXIS 63616, at *19 (N.D. Cal. Apr. 12, 2019)

Hashtag as a Trademark



#Cases

Cases have permitted infringement claims based on uses of protected marks in hashtags:

- Chanel, Inc. v. WGACA, LLC, 2018 U.S. Dist. LEXIS 158077 (S.D.N.Y. Sep. 14, 2018) (Chanel plausibly alleged use of #WGACACHANEL was TM infringement);
- Pub. Impact, LLC v. Bos. Consulting Grp., Inc., 169 F. Supp. 3d 278 (D. Mass. 2016) (use #publicimpact likely infringed on PUBLIC IMPACT trademark);
- Fraternity Collection, LLC v. Fagnoli, No. 3:13-CV-664-CWR-FKB, 2015 U.S. Dist. LEXIS 42120 (S.D. Miss. Mar. 31, 2015) (use of #fratcollection and #fraternitycollection could plausibly infringe on FRATERNITY COLLECTION mark);
- Align Tech., Inc. v. Strauss Diamond Instruments, Inc., No. 18-cv-06663-TSH, 2019 U.S. Dist. LEXIS 63616 (N.D. Cal. Apr. 12, 2019) (use of marks in hashtags and use of mark in an image copied from website imply association.)
- Khaled v. Bordenave, 2019 U.S. Dist. LEXIS 71892 (S.D.N.Y. Apr. 29, 2019) (plaintiffs' allegations—old and new—as to defendants' use of hashtags clearly state a claim of trademark infringement.)

Hashtag Considerations

#UsingYourMarkAsAHashtag

What should owners consider regarding whether to use a trademark as a hashtag?

- Getting your brand exposure through trending
- Social Media Blowback
- Third party misuse
- Control of your mark
- Ability to trend your own brand



#SHAREACOKE

- Home
 - Explore
 - Notifications (18)
 - Messages
 - Bookmarks
 - Lists
 - Profile
 - More
- Tweet

Luis Cartagena, CPA @loucartagena · Sep 10, 2017
After 12 years of **marriage**, sometimes it's as simple as a Coke & A Smile!
Happy Anniversary @JessCartagena #ShareaCoke

2 replies, 0 retweets, 0 likes

Turkish
90.5K Tweets

World news
Syria: At least 29 Turkish soldiers killed by airstrike in ...

#Mulan
In theaters March 27, get tickets now!
Promoted by Mulan

Trending in New York
NJ Transit

Politics · Trending
Mnuchin
8,427 Tweets

Politics · Trending
#TrumpVirus
86.4K Tweets

Show more



#BuildBrandAwareness

- #ShareACoke
 - Idea behind the hashtag—cokes with names and titles on them:
 - drove massive numbers of sales, and
 - generated a ton of user-generated content
- #NationalFriedChickenDay
 - started trending on Twitter
 - KFC hashtag-brand relation, and ran a promotional campaign around it.

#Marketing

- Create brand awareness
- Increase the visibility of your content
- Makes easier to track & quantify your content
- Boost your followers and retweets
- Get your audience involved
- Promote events effectively
- Help running contest or launching a product



#Bashtags

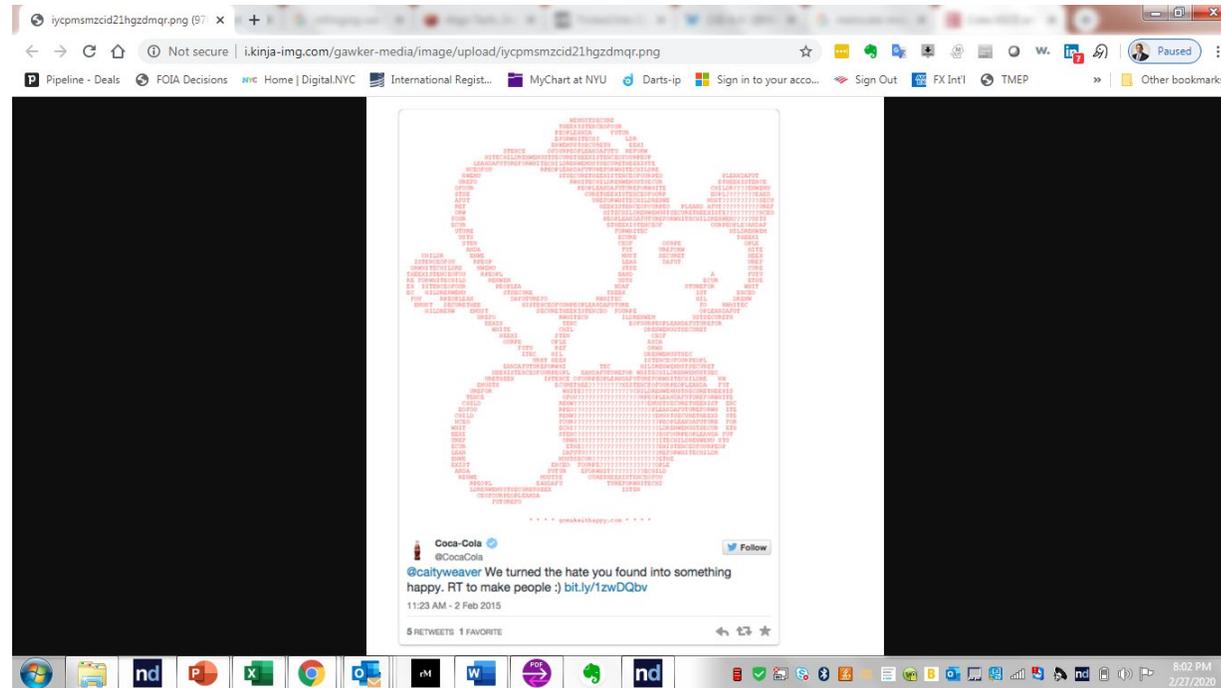
- "Twitter hashtag disasters" happen with regularity.
- #McDStories
 - Intended to draw out positive stories about McDonald's and experiences
 - Became PR nightmare with a lot of bad publicity
 - People's stories were perhaps honest, certainly negative

#Trolls

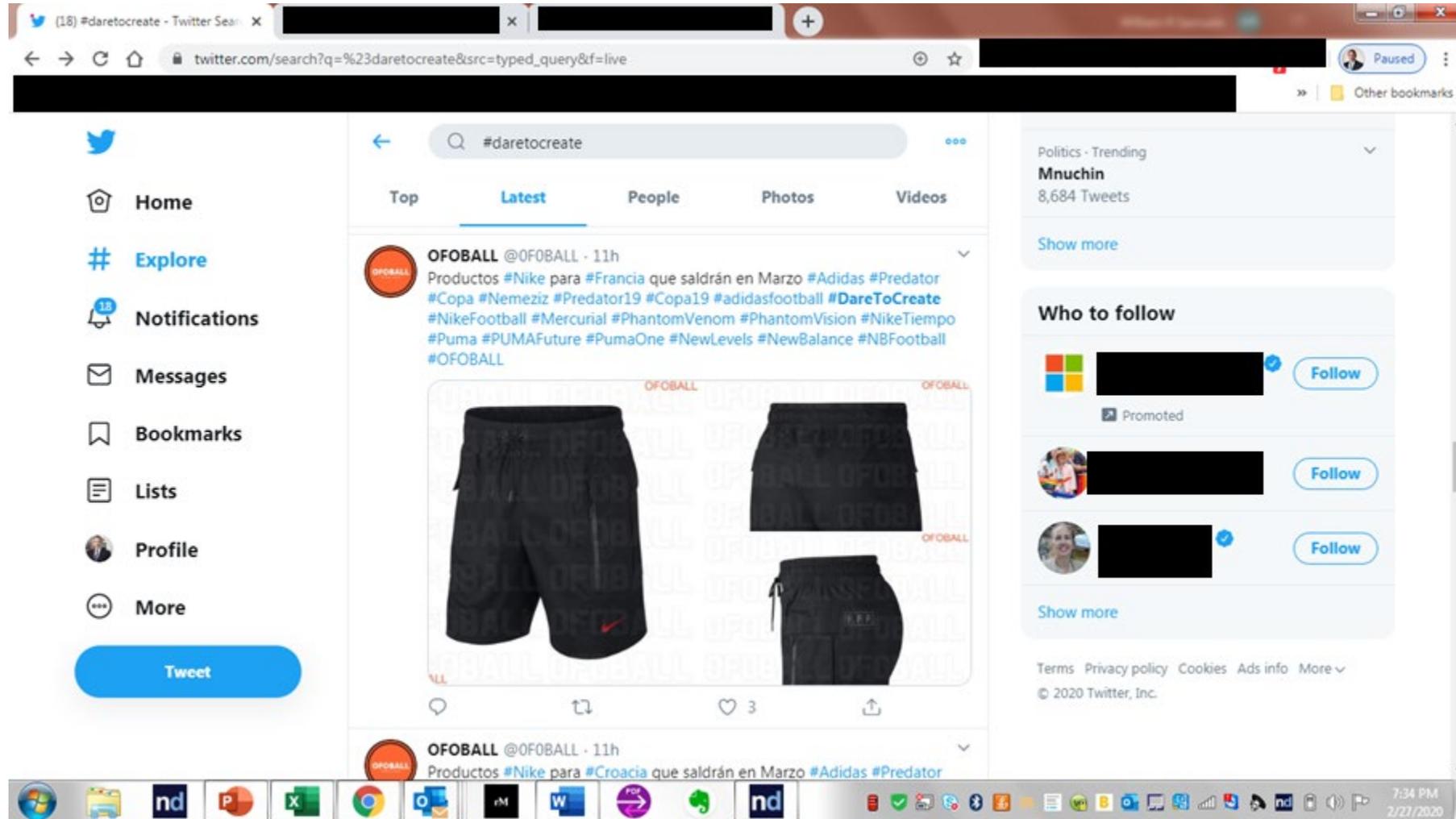
- Adidas #DARETOCREATE Campaign:
 - like and share a tweet advertising the brand
 - Adidas jersey is automatically generated with social media handle on the back, with a message that says: “This is home. Welcome to the squad.”
- Third party use of hashtag spread negative association— from the Adidas account
 - campaign was interrupted when accounts with Twitter handles like “@GasAllJewss,”

#MAKEITHAPPY

- Coca Cola's social media marketers came up with a cute idea:
 - Add #MakeItHappy to a negative tweet and Coca Cola's Twitter bot will pick it up and use the message's characters to create a cute ASCII art image.
- Sounds awesome until your company suddenly is posting ASCII art made from quotes from Adolf Hitler's "Mein Kampf"



#Hashtag Use to Categorize or Affiliate



#Context

- Is it used in an advertisement
- Used to identify own product?
- Used to reference third parties?
- Use of more of the mark than is necessary
 - Is there use of the mark in images?
 - What other comments are there in the tweet?

Internet Domain Names

Domain Names & Booking.com

- For only one entity can occupy a particular Internet domain name at a time, so a “generic.com” term could convey to consumers an association with a particular website.
- More-over, an unyielding legal rule that entirely disregards consumer perception is incompatible with a bedrock principle of the Lanham Act:
 - The generic (or nongeneric) character of a particular term **depends on its meaning to consumers**, i.e., do consumers in fact perceive the term as the name of a class or, instead, as a term capable of distinguishing among members of the class.
- United States PTO v. Booking.com B.V., 140 S. Ct. 2298, 2306, 207 L. Ed. 2d 738, 749, 2020 U.S. LEXIS 3517, *15, 2020 U.S.P.Q.2D (BNA) 10729, 28 Fla. L. Weekly Fed. S 460, 2020 WL 3518365

Copyright

Copyright

A form of protection provided by the laws of the United States for "**original works of authorship**," including literary, dramatic, musical, architectural, cartographic, choreographic, pantomimic, pictorial, graphic, sculptural, and audiovisual creations. "Copyright" literally means the **right to copy** but has come to mean that body of exclusive rights granted by law to copyright owners for protection of their work. **Copyright protection does not extend to any idea, procedure, process, system, title, principle, or discovery.** Similarly, names, titles, short phrases, slogans, familiar symbols, mere variations of typographic ornamentation, lettering, coloring, and listings of contents or ingredients are not subject to copyright.

<https://www.copyright.gov/help/faq/definitions.html>

U.S. Copyright Registrations

What can be protected by a copyright?

- *Original* works of authorship *fixed* in a tangible medium
- Protects the *expression* of an idea, but not the idea or concept itself
- Copyright generally not available for:
 - a. words
 - b. symbols
 - c. slogans
 - d. *common* designs
- Copyright protection is available for work that contains sufficient originality and expressive elements.

Copyright Grants

Exclusive rights to:

- **Make** the work.
- **Make copies** of the work.
- **Sell and distribute** the work.
- **Make a derivative work.**
 - e.g., movie version of book, or foreign translation
- **Perform the work publicly.**
 - © owners use *licensing* agreements; ASCAP/BMI; performing sheet music
- **Display the work publicly.**
 - least litigated of the 6 rights; usually, π sues for *recall* of the work (e.g., art)

Brand & Copyright Protection

- Pepe originated in a 2005 comic by Matt Furie called *Boy's Club*
- FourChan: anonymous English-language imageboard website
- Character's image was appropriated as a symbol of the alt-right movement, as well as by white supremacists.
- The Anti-Defamation League put Pepe in its hate symbol database in 2016
- Pepe's creator has expressed his dismay at Pepe being used as a hate symbol and has sued organizations for doing so.



• Too little,
too late?

Instagram: Who Owns What?

We do not claim ownership of your content, but **you grant us a license to use it...**[you] grant to us a non-exclusive, **royalty-free, transferable, sub-licensable, worldwide** license to host, use, distribute, modify, run, copy, publicly perform or display, translate, and create derivative works of your content (consistent with your privacy and application settings).

- You can end this license anytime by deleting your content or account.
 - However, content will continue to appear if you shared it with others and they have not deleted it.
 - <https://help.instagram.com/478745558852511>
- It is important that photographers are aware of this because if they sell an image under an exclusive license, posting the image on their Instagram would breach that license.



Instagram

Submittable: Who Owns What?



- **You retain rights to your Content and your Submission.** By submitting any material including Content to any Public area of the Site (including, but not limited to, blog, user commenting, social media),
- **you automatically grant**, or warrant that the owner of such material has expressly granted,
- **us the royalty-free, worldwide, perpetual, irrevocable, non-exclusive right and license to use, reproduce, modify, adapt, publish, display, translate and distribute such content, in whole or in part and/or to incorporate it in other works in any form, media or technology now known or hereafter developed.**

Fair Use

. . . the fair use of a copyrighted work, including such use by reproduction . . . for purposes such as **criticism, comment, news reporting, teaching** (including multiple copies for classroom use), **scholarship, or research**, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include—

- (1) the **purpose and character** of the use, including whether such use is of a **commercial nature** or is for **nonprofit educational purposes**;
- (2) the **nature** of the copyrighted 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.

The fact that a work is unpublished shall not itself bar a finding of fair use if such finding is made upon consideration of all the above factors.

17 U.S. Code § 107

Brand & Copyright Protection

- **Brand communication**



Trade Secrets

What is a Trade Secret?

- Valuable information, not generally known, that the owner has taken reasonable steps to keep secret
- Examples: recipes, marketing strategies, computer algorithms, customer lists, formulas, techniques
- The Trade Secret can be a core part of the brand:

11 Herbs and Spices



Original Formula





Thank You

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