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**Protecting Trademarks and Copyrights Online:
Perspectives and Strategies from In-house and
Outside Counsel**

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Protecting Trademarks and Copyrights Online: Perspectives and Strategies from In-house and Outside Counsel

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For many companies and other IP owners, trademark and copyright issues involving domain names, websites, online marketplaces, and social media platforms continue to account for a significant amount of legal spend and effort, especially as infringements may occur across the globe and IP owners receive backlash in the media and on social networks. Trademark and copyright owners need to develop strategies to determine how and when to protect their IP.

Developing a strong brand protection strategy ideally should involve a combination of (1) taking proactive, preventative measures to secure the intellectual property, (2) evaluating defensive positions and vulnerabilities, and (3) enforcing IP rights against unauthorized uses and other infringements. Enforcing IP rights online can quickly—and understandably—become the focus of the brand strategy, but taking the time to implement offensive tactics and develop defensive arguments early on can help reduce the frequency, duration, and intensity of online IP disputes.

This paper covers recent legal developments in the area of online trademark and copyright issues and also provides a practical discussion and tips on developing a brand protection strategy from an in-house and outside counsel perspective.

I. AN INTRODUCTION TO INTELLECTUAL PROPERTY

Intellectual property consists of three main categories: trademarks, copyrights, and patents. Most organizations and businesses will create intellectual property in at least the first two categories and thus acquire intellectual property rights, whether they intend to or not. Patents, which are outside the scope of this paper, provide legal protection for inventions and useful processes. Although the focus of this paper is on trademarks and copyright, state privacy laws and right of publicity issues are also important areas of the law that often intersect with trademark and copyright issues when creating and posting online content.

Below is a brief overview of trademark and copyright law, but for newcomers to the field, the U.S. Patent and Trademark Office has helpful information on its website

(<http://www.uspto.gov/trademark>), and the U.S. Copyright Office's Circulars and Copyright Compendium are useful resources (available at www.copyright.gov).

A. Trademark Law

A trademark is a word, design, shape, slogan, sound, or other indicator that identifies and distinguishes one company's products or services from another. Brand names are trademarks, but not all trademarks are brand names. Sometimes, you may see a reference to a "service mark" – this term merely refers to a source identifier for services as opposed to goods. But often, the word "trademark" will be used in connection with both goods and services. A "Circle R" or registration symbol ® can be used with registered trademarks, whereas a "TM" can be used with any trademark that is in use, whether registered or not.

A defendant is liable for trademark infringement if, without the consent of the trademark owner, the defendant uses "in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark" which "is likely to cause confusion, or to cause mistake, or to deceive."¹ Trademark rights extend not only to registered trademarks, but also unregistered, or "common law" trademarks. A trademark owner obtains common law trademark rights from the moment that he or she begins selling a product or providing a service under a trademark.

B. Copyright Law

Copyright law protects original works of authorship (musical, literary, artistic, and dramatic works) by granting exclusive rights to use and distribute the works. Generally, a copyright owner (usually the author of the work or the publisher of the work) is the only person who has the rights to copy a work, distribute it to the public, perform or display it in public, or create another work based on the original, unless those rights have been licensed or assigned. Copyright protection begins once the original work has been reduced to tangible form, such as a website, a video or image file, photograph, a drawing, or sheet music. Thus, the very nature of the internet is that it is filled with copyrightable content. A copyright owner can use the symbol © whether or not the work is registered with the U.S. Copyright Office.

C. Right of Publicity

The right of publicity protects an individual's right to control the commercial use or exploitation of their image, likeness, or identity. There is no federal right of publicity, and state statutes and common law rights vary across the country. The right of publicity is constrained by the First Amendment and a defense of "newsworthiness." Nevertheless, "commercial use" is often interpreted to mean *any* benefit, and the jurisdictional uncertainty that comes with online activity heightens the need to obtain consent before posting an individual's image online.

¹ 15 U.S.C. § 1114(1).

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