

Nutter's IP Bulletin How-To Series on Branding: What to Do Once Your Trademark Registers—The Brand & New Media

IP Law Bulletin

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Nutter's series on building a brand began with the selection of a mark and the process of formally protecting it via trademark registration. At this point in the series, the mark is registered and ready for use and investment to elevate it into a brand. Moving from a mere "mark" to a lauded "brand" takes us into the realm of marketing, as most of what makes a mark into a brand is the result of marketing investment around the mark. However, there are still many legal considerations to keep in mind as you begin using your mark and building it into your brand.

First, and most closely connected to the trademark process we've been describing, is use of the mark. We raised this topic in our previous article and noted that you must be diligent to avoid using a mark in a manner that will diminish (or destroy) its value as a source identifier. This means abstaining from using a mark as a noun or verb, and instead using it only as an adjective to modify a generic term for your product or service. For example, don't GOOGLE something, but run a GOOGLE Web search for it. The goal being to keep marketing from doing too good a job of building the mark into a term recognized everywhere and used generically to refer to the class of product or service with which it is associated.

There is another aspect of "use" that we did not discuss: use of the mark in "new media," such as the Web and social media services. Use and enforcement of your rights in these contexts can be peculiar and difficult given the dynamic and rapidly changing environment. We will begin with the Web, as it is now the 25-or-so year old elder statesman in the technology world. As one might expect, this relatively long life has allowed the law to catch up in many respects, providing a reasonable structure for users to protect their marks/brands. Social media, as explained in more detail below, has not quite had the time to mature in the same way.

Use of one's mark on the Web (and in new media generally) is not all that different from the trademark registration process. Owners begin by securing "registration" for their mark, which in the context of the Web means purchasing a domain name associated with the mark. Domain names are often relatively inexpensive and, as a result, it may be wise to consider purchasing several domain names that are related to the mark. Common misspellings ("MRAK.com") and alternative generic top level domains ("MARK.net") are examples of additional domains that might be worth purchasing. Also worthy of consideration is the purchase of disparaging domains ("MARKSTINKS.com") to prevent others from using such domains against you.

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When considering which domain names to purchase, bear in mind that the Internet Corporation for Assigned Names and Numbers (ICANN), which manages the domain name system, is in the process of expanding the number of available generic top level domains (gTLDs). The expansion is dramatic, from the few common gTLDs currently available (such as “.com,” “.net,” “.org,” etc.) to more than 1,000 wide ranging terms (such as “.app,” “.bargains,” “.car,” etc.). Consideration should be given to purchasing domain names with relevant new gTLDs (“MARK.business,” “MARK.sale,” etc.) in addition to the existing domains. In line with the comment above on disparaging domain names, be aware that there are some new gTLDs that seem ripe for disparaging use (“.sucks,” etc.) and may be worth securing in order to prevent others from doing so. To this end, ICANN has provided mechanisms to aid trademark owners in registering domains, including a “sunrise” period for each new gTLD during which trademark owners can purchase matching domain names before the general public.

If bad actors “cybersquat,” or register a confusingly-similar domain name, despite any of the above efforts at prevention, there are mechanisms in place to challenge their registration and possibly transfer ownership of the domain name. For example, ICANN administers the Uniform Domain-Name Dispute-Resolution Policy (UDRP) that allows for many trademark-based domain name disputes to be resolved via arbitration. In addition, the United States has enacted the Anticybersquatting Consumer Protection Act (ACPA) that creates liability for parties that register domain names confusingly similar to, or dilutive of, a trademark. Pursuing relief under the ACPA can be more expensive because it involves a lawsuit rather than an administrative proceeding, but it also provides for the possible award of actual or statutory damages in addition to the cancellation or transfer of a domain name registration.

The above-described mechanisms for protecting use of a mark in the domain name space are, unfortunately, largely unavailable for use in connection with social media. For example, the UDRP program covers only second level domain names (that is, the name before the gTLD) that are not provided with social media accounts. Similarly, the ACPA is directed to domain names registered with a domain name registrar, a process that is also not associated with social media accounts. There has been at least one attempt to apply the ACPA to the type of addresses commonly utilized with social media accounts (“social-media-service.com/username”), but the issue has yet to be squarely decided.

To address this deficiency, most social media services have developed internal policies and procedures regarding trademark infringement and cybersquatting. Working through a particular social media service does not guarantee a satisfactory process or outcome, but at least provides a tool for mark owners to leverage if necessary. If working through the social media service does not provide relief, there is always the “traditional” option of filing a lawsuit for trademark infringement. However, it is not clear whether use in social media qualifies as the “use in commerce” required by trademark law. The best course of action in the social media context is one of prevention, meaning proactive registration of a mark (and possibly variations on the mark) as a username for each social

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media service to prevent others from doing so.

After staking your territory in new media with domains and usernames, you should remain vigilant and continually monitor use of your mark/brand going forward. Such monitoring should include both your own use (on your website, from your social media accounts, as a hashtag (#MARK) etc.) and the use of others. With respect to your own use, think carefully about who has access and authority to post content to your website or use your social media accounts. Also be mindful of who actually owns the account. For example, was the company's social media page or account created in a manner that makes a particular employee's personal account the only administrator? Login credentials and other important information regarding all social media accounts should be centrally stored such that no employee can separate from the company and take control of the company's accounts.

When monitoring and (especially) policing others' use of your mark/brand on social media, you should remain cognizant of the potential for community backlash. A honey over vinegar approach can often be helpful, as overly aggressive tactics can result in a negative campaign against your company that might go viral and spin out of control. On the other hand, ignoring or too passively approaching inappropriate use of your mark could lead to equitable defenses if a lawsuit is required later. As with so many things, a balanced and carefully escalated approach is key.

In our next article, we'll wrap things up by discussing some further considerations regarding building and sustaining a brand, including building out a portfolio with additional related marks.

This update was prepared by Nutter's Intellectual Property Department. For more information, please contact your Nutter attorney at 617.439.2000.

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