

IP Practice specializing in trademark and copyright law; IP counseling; domestic and international maintenance and protection of IP portfolios; internet issues; IP audits and strategies relating to IP portfolios; drafting and negotiating IP and IT-related agreements

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Avoid Surprises with Your Trademark: Keeping a Lookout for Online Infringement

While Halloween is just behind us, there may be other ghosts and goblins lurking in dark corners – that is, the dark corners of the Internet, which often houses many instances of trademark infringement.

As many of you already know, trademark infringement occurs when one uses a trademark in a way that is

likely to confuse consumers as to the source or origin of the goods or services being offered under a trademark. This occurs when the mark at issue is considered “confusingly similar” to another mark—in other words, when the two marks are used for

similar or related goods or services and they look and sound the same or create a similar visual or aural impression.

Because trademark owners have a duty to police for infringing uses of their marks, it is important to know where possible infringements might be lurking.

Policing Social Media

Facebook, Twitter and other social

media sites provide a great opportunity for companies and associations to make personal connections with their customers and members, but trademark infringement also can make those connections confusing for consumers. Since Facebook and Twitter do not allow companies to reserve accounts, unauthorized company pages or user

names can quickly pop up and infringe on trademarks legitimately owned by the companies.

However, both Facebook and Twitter allow users to report potential trademark infringements and may suspend accounts that clearly

intend to mislead consumers through an unauthorized use of a trademark.

While a complaint to Facebook or Twitter or a cease-and-desist letter directly to an infringer might sometimes be called for, when it comes to fan pages or other unofficial pages, a friendlier approach may be more productive and help preserve the good reputation of your company or association.

Trademark owners have a duty to police for infringing uses of marks.

Smartphone and Tablet Apps

The rise of apps for smartphones and tablets has created a new environment that trademark owners should review for potential infringements. The digital marketplace mirrors the real world, and similarly, the burden is on the trademark owner to police for any unlicensed use of its trademark. This could occur when the name of an app includes a mark without authorization from the legitimate trademark owner. For example, an app called “Weight Watchers Calorie Counter” that is not authorized or created by Weight Watchers would be considered an infringing use of the Weight Watchers mark.

Apple and Google’s Android Market may terminate accounts of users who infringe another’s trademark. Trademark owners who actively police their trademarks online should review the iTunes AppStore, Android Market and other applicable app stores to be sure that their marks are not being misused there as well.

Keyword Advertising

Search engines, such as Google and Yahoo!, help companies increase their online visibility by selling keyword advertising. Businesses can purchase keywords that, when used as search terms by consumers, will highlight a business’s site at the top of the search page or display

the business as a featured ad.

While generic words are available for everyone’s use, a potential infringement can arise when one business purchases a competitor’s trademark as a keyword so that the purchaser’s ad will appear at the top of the search results. For example, a computer retailer could purchase keywords like “computer” or “pc,” but it could face liability if it used “Apple” or “Dell” as keywords.

It would be wise to develop a monthly policing program for online infringements of your valuable trademarks.

Courts are split on whether the use of keyword advertising, since it is not visible to the public, constitutes “use” in the context of a trademark infringement. Nevertheless, if you believe that another business is purchasing your trademarks as keywords (which would direct traffic to its site), it is important to follow up to ensure that the infringement stops. Google will address complaints that involve the use of trademarks in Google AdWords text advertisements, which are marked as “Sponsored Links” or “Ads by Google.” If infringing uses pop up within the

search results, you will have to contact each site directly.

Source Code and Metadata

What you see is not always what you get online. The metadata that websites rely on to generate traffic hides within a website’s source code. Unfortunately, this metadata also can hide key words that would qualify as trademark infringements – albeit invisible trademark infringements.

Much like keyword advertising, source code that incorporates a competitor’s trademark may infringe on the rights of a trademark owner by directing the trademark owner’s customers to the infringer’s website. For example, if BMW incorporates “Mercedes” in the metadata of its website, it is doing so to lure Mercedes’s customers to the BMW site (which they would end up on if they typed in Mercedes in a search engine). This is often referred to as “invisible trademark infringement,” and it is actionable.

In view of these often overlooked areas of infringement, you would be wise to include them in your monthly policing programs while looking for infringements of your valuable trademarks. If you do not yet have a policing program as part of your company procedures, you should institute one immediately.