



Strategies for Protecting Copyrights and Trademarks Online

October 24, 2012

SPEAKERS

Edward J. Davis

Partner

Davis Wright Tremaine LLP

Marci Sweren

Editor, PLC IP & Technology

Practical Law Company

G. Roxanne Elings

Partner

Davis Wright Tremaine LLP

Roy Kaufman

Managing Director of New
Ventures

Copyright Clearance Center



TRADEMARK



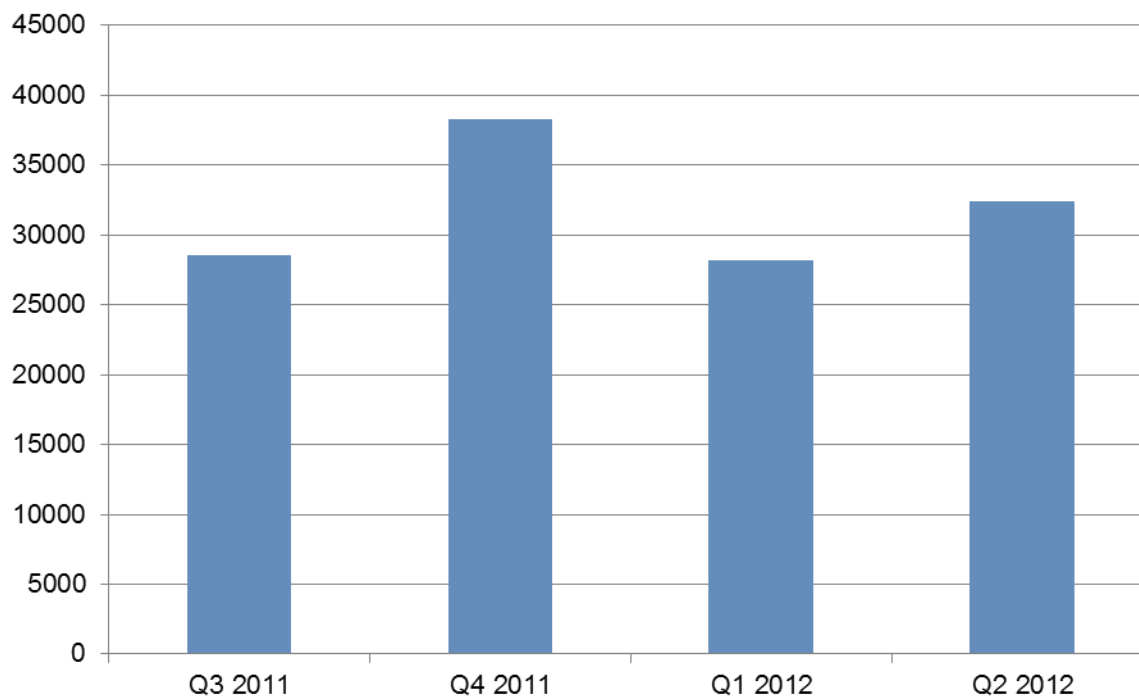
Importance of Online Presence and Branding to Companies

- Online branding has become a Company's most public persona
- Counterfeiters have learned to exploit this online persona
 - The most recent USTR 301 Notorious Markets Report noted the continued growth of online sales of counterfeit and pirated goods will soon surpass the volume sold by street vendors and in other physical markets
- Counterfeiters are competing in the same channels as the brand owner and using the best legal and illegal techniques to drive traffic to their websites, including those around social media



Online Counterfeiting – Scope

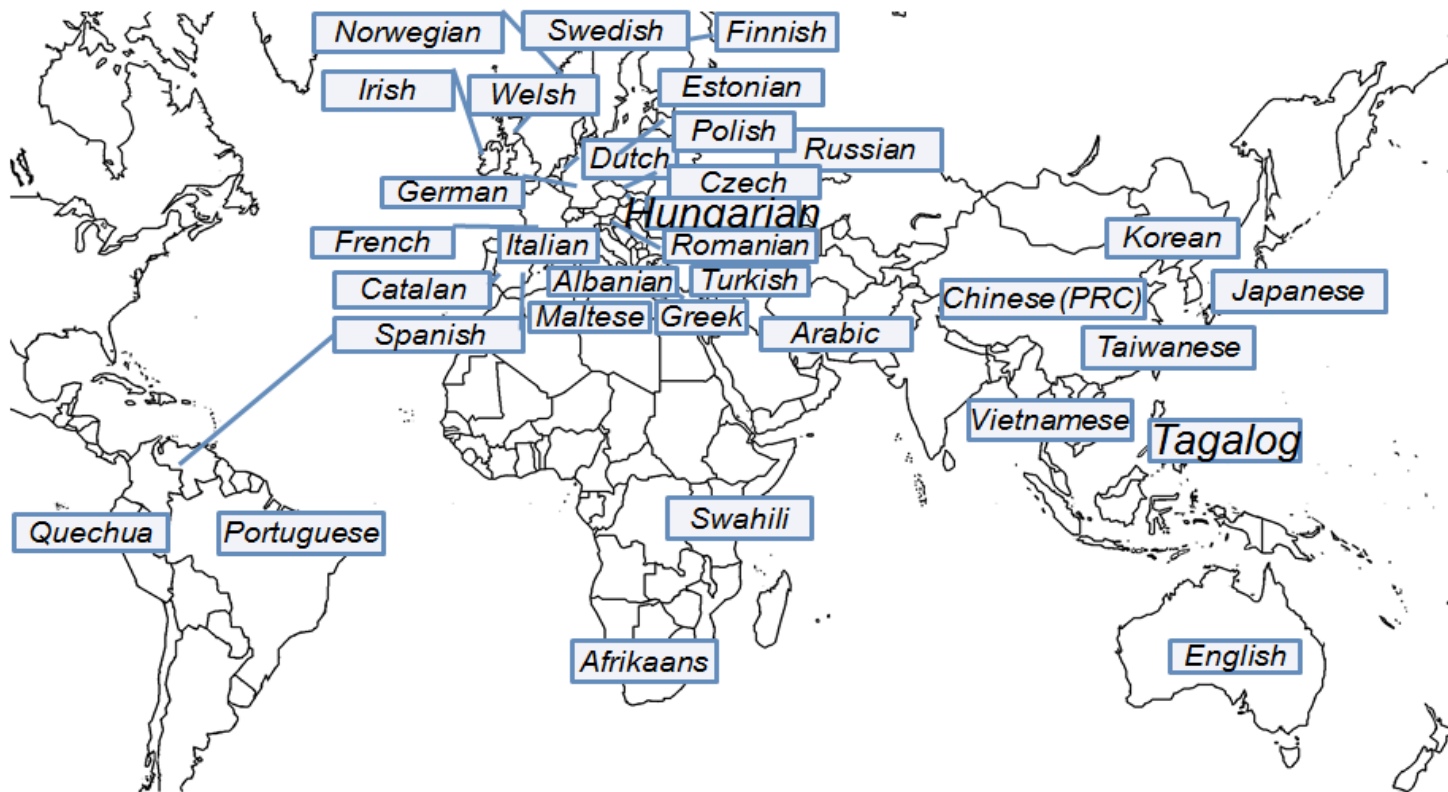
New Rogue Sites Created by Quarter – One Industry



Copyright MarkMonitor



Rogue Site Target Audience by Language



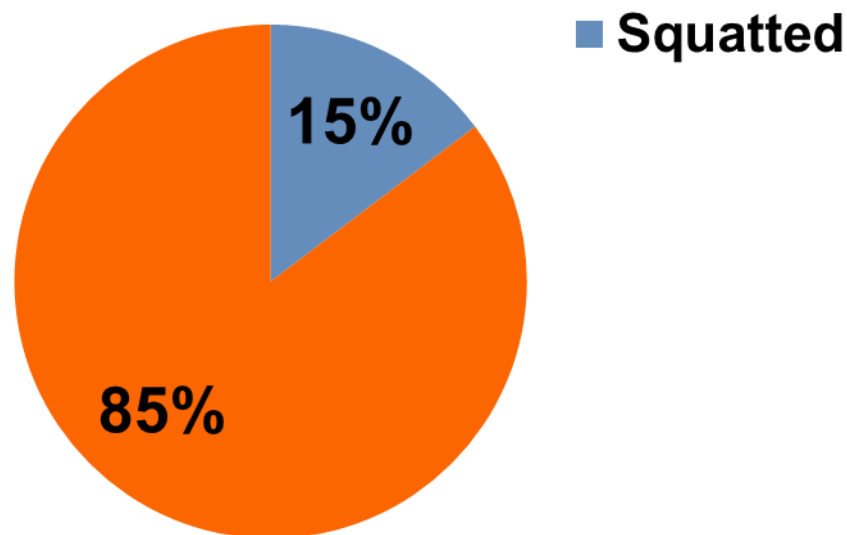
34 languages and dialects – global targeting

Copyright MarkMonitor



Trends in Online Counterfeiting

- Cybersquatted sites are a minority
- ISPs are more often outside the U.S.
- Single counterfeited websites are more often a small part of a larger group of websites



Copyright MarkMonitor



Media Sharing YouTube - Flickr

Chinese website

YouTube
Cheap north face
myxintan + Subscribe 1 video

Uploaded by myxintan on Oct 14, 2010
No description available.

All Comments (0)
Sign in or Sign Up now to post a comment!

480

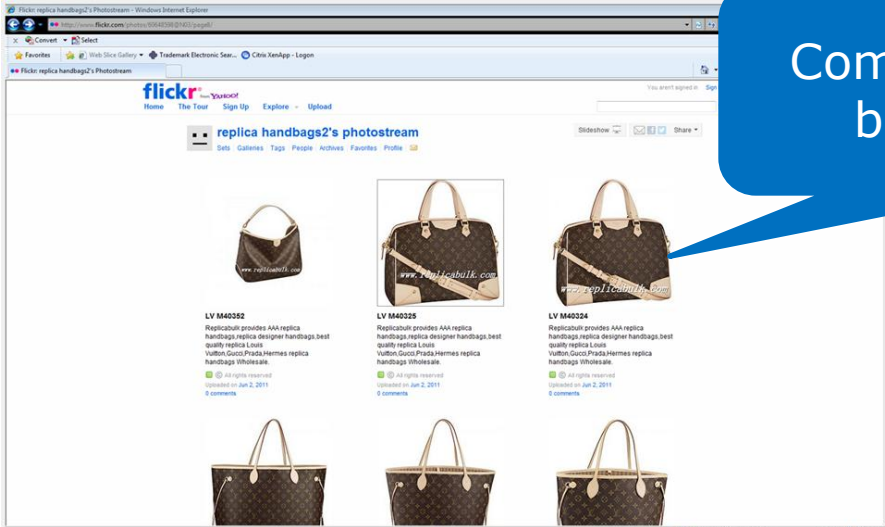
1:49

Like Share

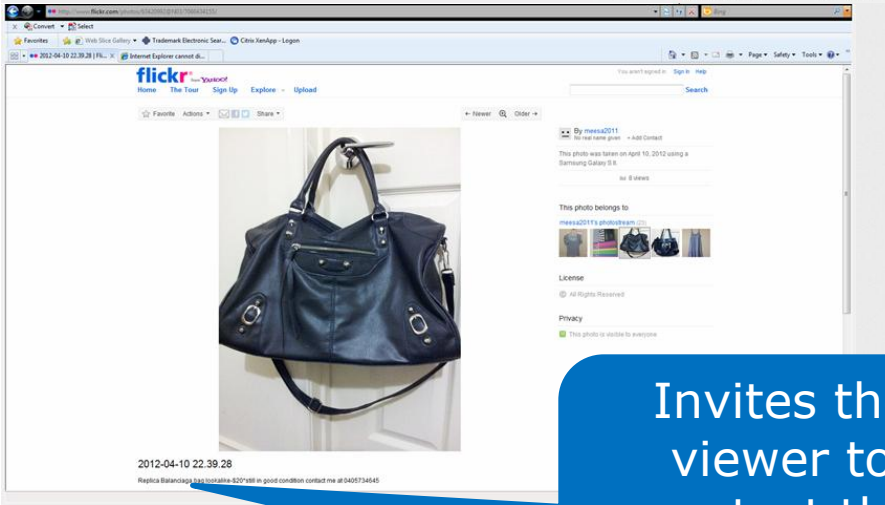
Search more

Right sidebar video list:
northface apogee jacket review by REALKalkikyle 2,053 views
North Face Transformer Jacket by cootech123456 1,414 views
Of Man and Beast = The Free Solo by MrClimbingrock 1,357,592 views
The North Face Promotion Codes and by CheapSallyCoupons 364 views
Helicopter Coverage of The North Face® Ultra- by TheNorthFace 149,254 views

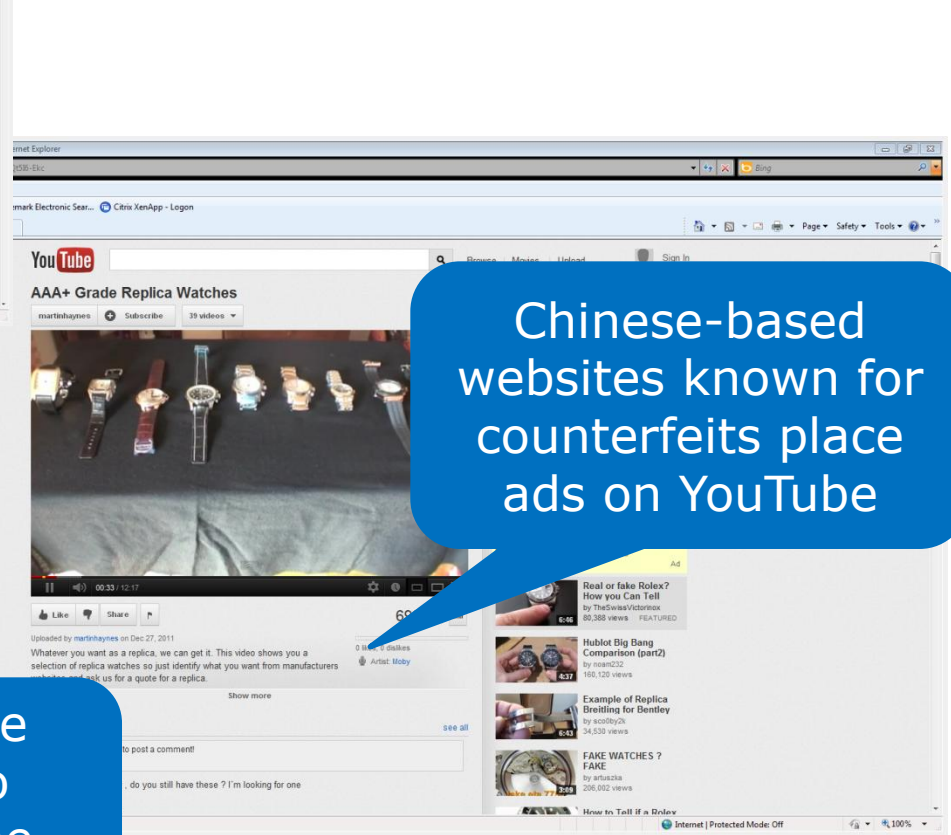
Create a message, mail merge username, create multiple versions of the message with different content and the same call to action. Schedule the sending of messages to YouTube users that have been harvested at the rate of about 20 messages per hour. Something like: Hey "username" I saw that you commented on a video about XYZ and wanted to let you know about another similar video and would love your opinion.



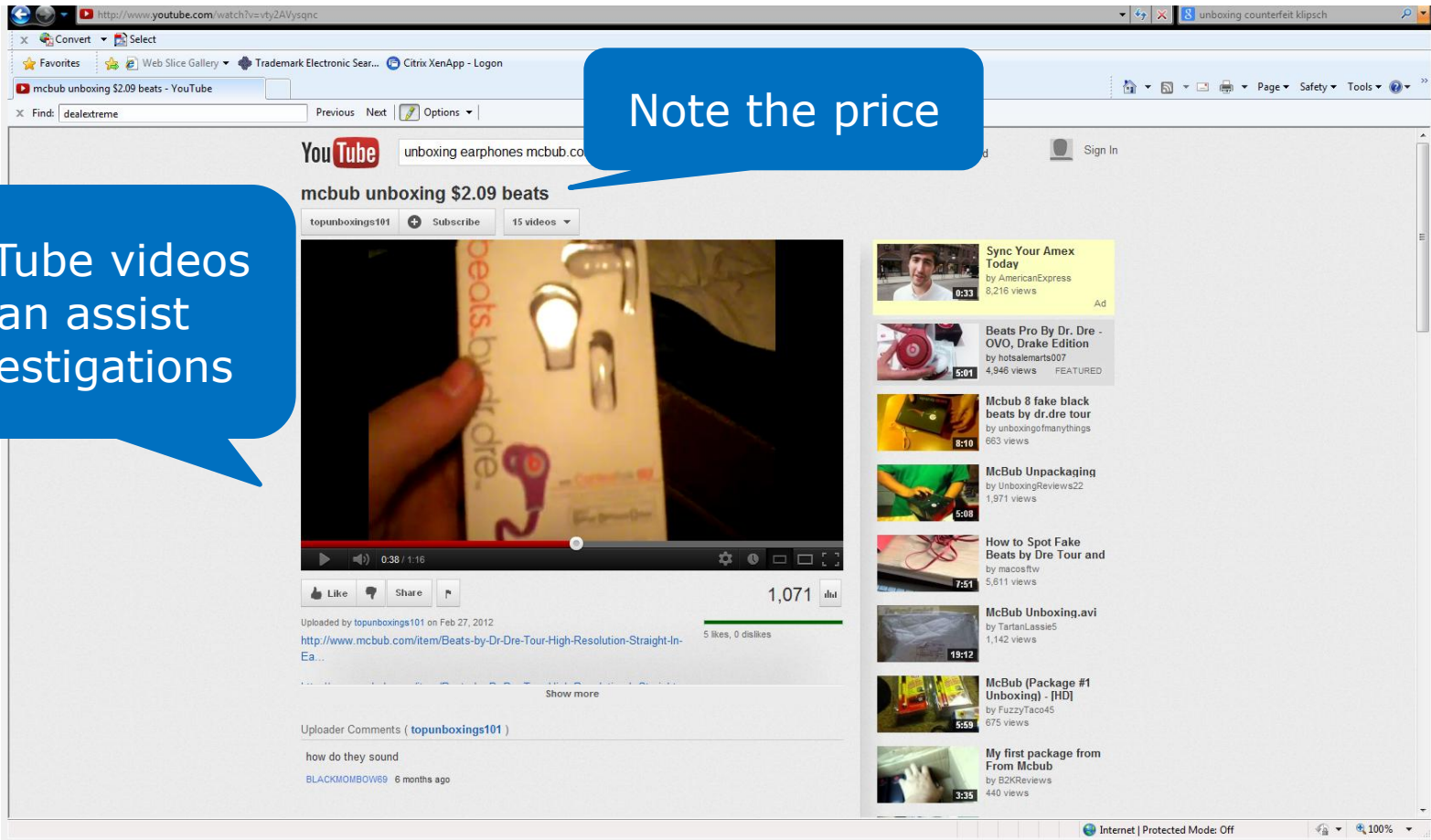
Comments with links back to website



Invites the viewer to contact the seller directly



Chinese-based websites known for counterfeits place ads on YouTube



YouTube videos can assist investigations

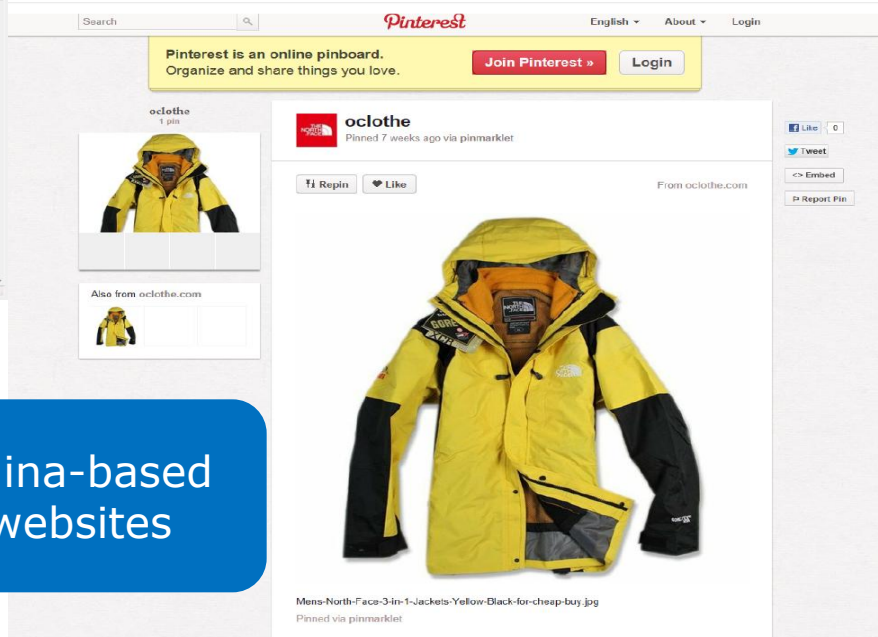
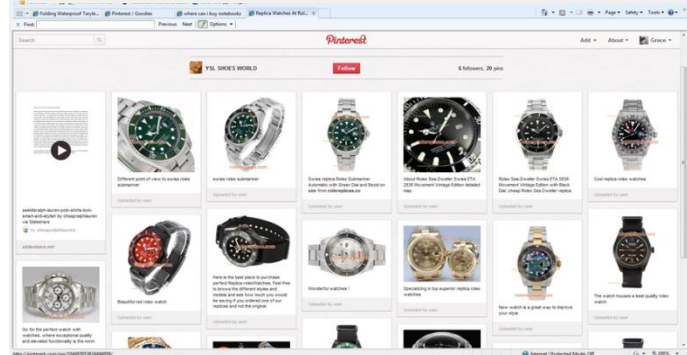
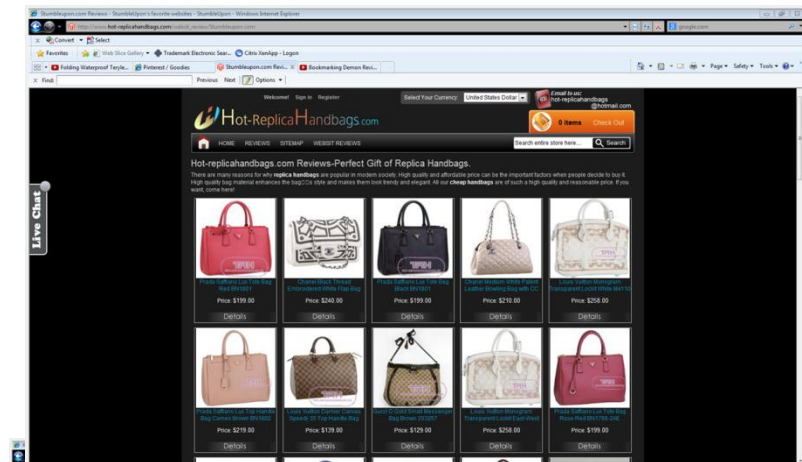
Note the price

Can provide detailed views of the product, packaging, date posted



Social Bookmarking StumbleUpon, Pinterest

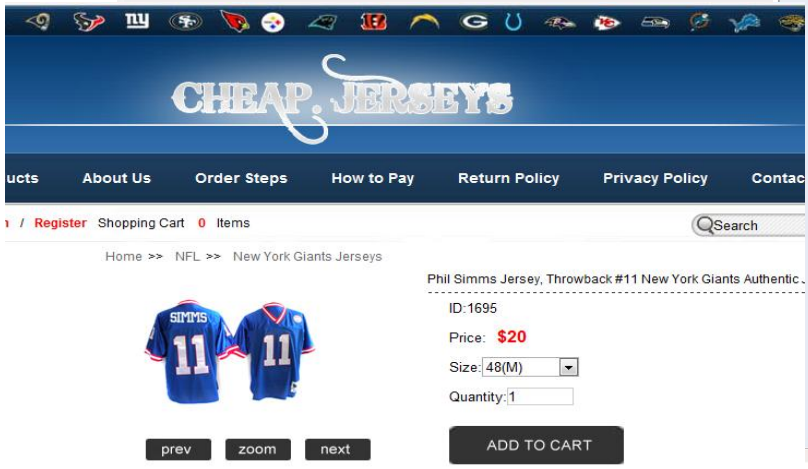
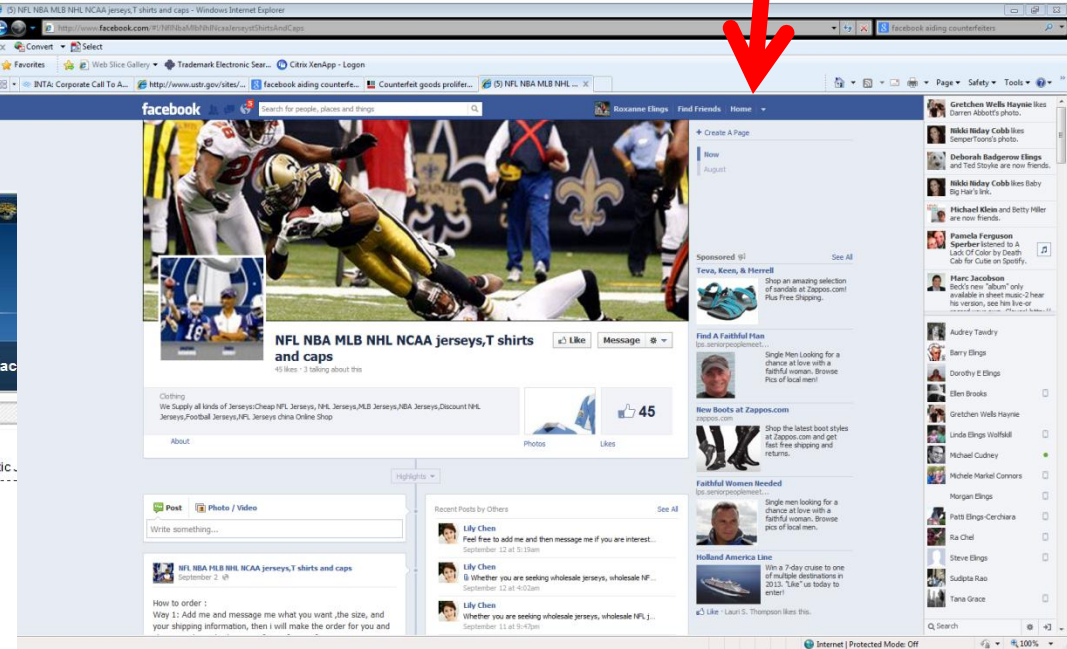
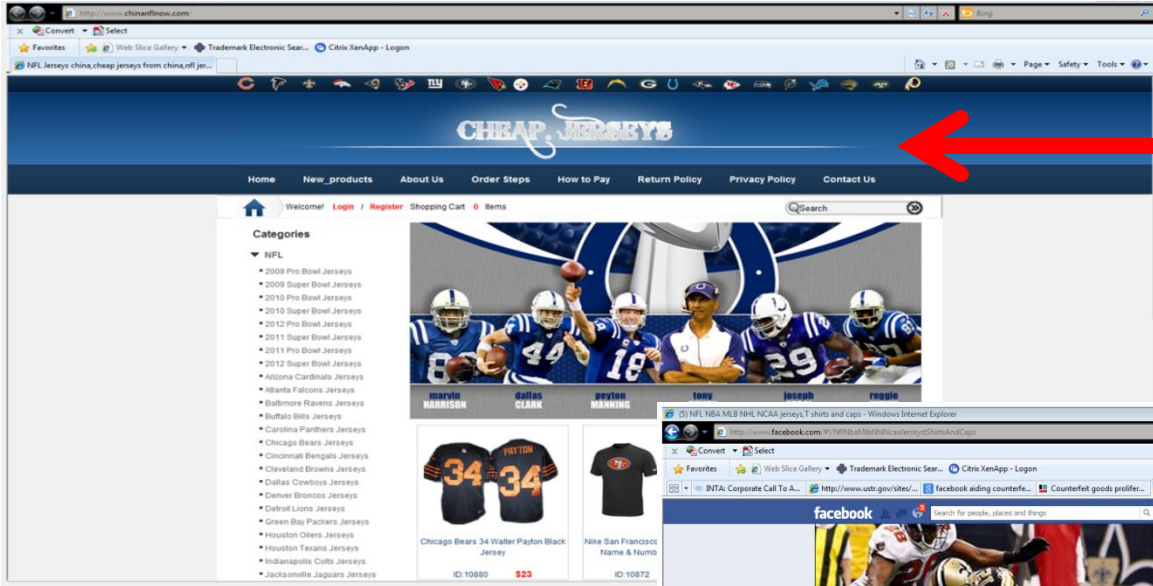
Software sets up multiple social bookmarking accounts and then randomly picks content to promote.

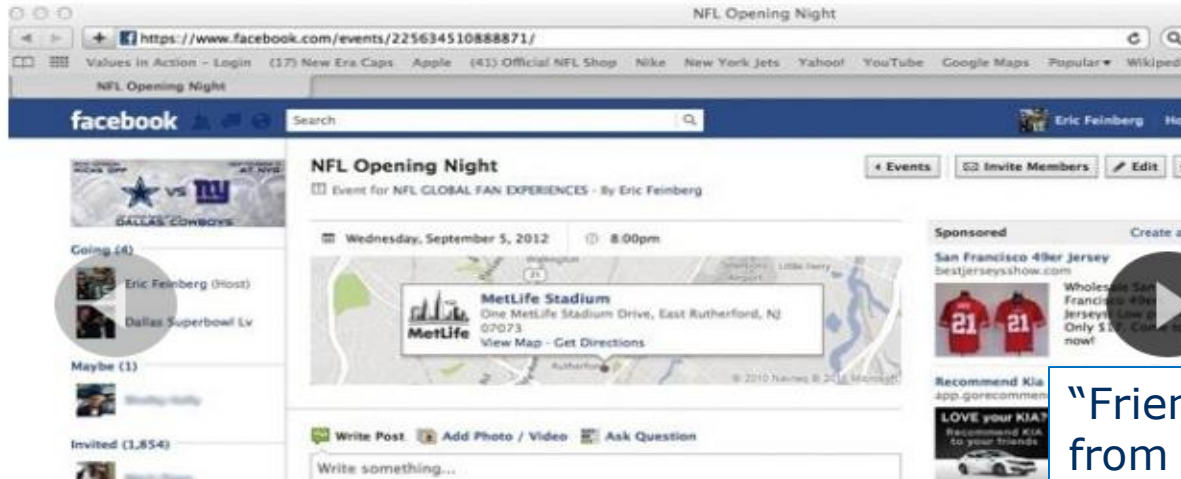


China-based
websites



China-based counterfeit website maintains a Facebook page





An NFL-related event page draws an ad for a fake team jersey



"Friend requests" also appeared from a member named "Nflcn JerseysShop," which then posted links on wall to a China-based website offering a variety of sports apparel.

Ad for knockoff LVMH handbags appear on profile page one day after posting a cover photo related to designer brand



Online Counterfeiting

- Effective strategies for policing trademarks on the Internet/identifying counterfeiters
 - Create a program for monitoring the Internet
 - View abuses in larger framework of goals/problems
 - Use available tools to combat counterfeit sales online (*e.g.*, on eBay, Alibaba, rogue websites)



Online Counterfeiting (cont'd)

- Steps businesses can take to pursue legal action against online counterfeiters
 - Evaluate harm being caused and prioritize enforcement targets
 - Investigate (methods, sources of information)
 - Send cease and desist letters/use complaint processes of online retailers, social media sites
 - File civil lawsuits
 - Cooperate with government in criminal enforcement actions



Online Counterfeiting (cont'd)

- *The North Face Apparel Corp. v. Fujian et al.*

“My injunction, once served on Public Interest Registry, should have alerted it to no longer play its role in allowing customers to connect to defendant counterfeiters’ websites, for Public Interest registry would, by continuing to do so, commit an unlawful act, by aiding and abetting in defendants’ unlawful counterfeiting activities in violation of United States law. Furthermore, Public Interest Registry should no longer have accepted transmissions of registration information from registrars who had received defendants’ orders for domain name registrations and registration renewals because my injunction advised that defendants’ domain names had been used to advertise and sell counterfeits of plaintiffs’ goods.”

~ Judge Hellerstein (June 13, 2011)



Polo And North Face Prevail In Web Counterfeiting Case.

WWD | September 16, 2010 | Steigrad, Alexandra | Copyright

Byline: Alexandra Steigrad



Polo and North Face Prevail In Web Counterfeiting Case

Polo Ralph lauren Corp. and VF corp.'s the north Face unit scored a major victory against Chinese cybersquatters, but collecting the damages may be another matter entirely.

A court in the Southern District of New York awarded the brands \$78 million, which is believed to be the highest sum of damages ever awarded in an Internet counterfeiting case.

Initially filed in March, the lawsuit pitted the apparel brands against a network of more than 130 Chinese Web sites selling counterfeit goods to U.S. customers through up to 6,500 domain names such as laurenpolo.com and officialnorthface.com. ...

December 2010

“the concern I have is that the defendants are going to be quicker than the plaintiffs. The defendants have the ability, limited only by imagination... to create [new domains], to evade any process of this Court.”

~ Judge Hellerstein



COPYRIGHT



Protecting Copyright Online

- Registering online works



Copyright

Copyright Registration for Online Works

General Information

This circular gives information about copyright registration of online works made available over a communications network such as the Internet. This information applies also to works accessed via network (websites, homepages, and FTP sites) and files and documents transmitted and/or downloaded via network.

Copyright protects original authorship fixed in tangible form (17 USC sec. 102(a)). For works transmitted online, the copyrightable authorship may consist of text, artwork, music, audiovisual material (including any sounds), sound recordings, etc. Copyright does not protect ideas, procedures, systems, or methods of operation (17 USC sec. 102(b)).

Under U.S. law, copyright protection subsists from the time the work is fixed in any tangible medium of expression from which it can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Copyright registration is not mandatory, but it has important benefits. For general information about copyright, see Circular 1, *Copyright Basics*. See "For Further Information" on page 4 on how to obtain circulars and other information.

What the Registration of an Online Work Covers

For all online works other than computer programs and databases, the registration will extend only to the copyrightable content of the work as received in the Copyright Office and identified as the subject of the claim. The application for registration should exclude any material that has been previously registered or published or that is in the public domain. For published works, the registration should be limited to the content of the work asserted to be published on the date given on the application.

NOTE: For a claim in a computer program that establishes the format of text and graphics on the computer screen when a website is viewed (such as a program written in HTML), registration will extend to the entire copyrightable content of the computer program code. It will not, however, extend to any website content generated by the program that is not present in the identifying material received and that is not described on the application. On the other hand, for all other computer programs that are transmitted or accessed online, as well as for online automated databases, the registration extends to the entire copyrightable content of the work owned by the claimant, even though the entire content is not required in the identifying material deposited. For more information about deposit requirements, see page 3.



Protecting Copyright Online (cont'd)

- Watermarking
 - Embedding identifying information
 - Embedding surprises
 - Adding metadata
- Copyright notice: ©
[your name here] 2012





Protecting Copyright Online (cont'd)

- Access Controls and Digital Rights Management
 - Encryption
 - Online authorization
 - Copy controls (preventing or limiting copying)
 - Duration controls
 - Metadata
 - Instructions for licensing
 - Information on purchaser and purchased rights



Policing Online Infringement

- Identifying infringers
 - What if “Whois” is not enough?
 - Forensic investigations
 - Tracking techniques
 - Source code examination
 - Other research
 - Trademark, copyright and corporate registrations
 - DMCA subpoenas
 - Possible limitations



Policing Online Infringement (cont'd)

- DMCA notice and take-down demands
 - Address the agent designated by the website or ISP
 - Identify the infringing material as exactly as possible (links are best)
 - Comply with formal requirements, including statement of good-faith belief
 - May facilitate holding third-party hosts secondarily liable for infringement
- Cease-and-desist letters



Policing Online Infringement (cont'd)

- Litigation – potential claims
 - Copyright infringement
 - Circumvention of technological protection measures
 - Provision of false copyright management information
 - Removal or alteration of copyright management information
 - Trademark infringement



Policing Online Infringement (cont'd)

- Working with ISPs
 - To identify infringers
 - “John Doe” lawsuits
 - ISP resistance
 - To deter and punish infringers
 - “Six strikes” programs
- Working with search engines and major websites
 - Google
 - Facebook
 - YouTube
 - Twitter
 - Amazon



Policing Online Infringement (cont'd)

- DMCA safe harbor: How can a third party avoid secondary liability?
- Navigating the DMCA safe harbor
 - *UMG Recordings, Inc. v. Shelter Capital Partners LLC*, 667 F.3d 1022 (9th Cir. 2011)
 - *Viacom International, Inc. v. YouTube, Inc.*, 676 F.3d 19 (2d Cir. 2012)
 - *Capitol Records, Inc. v. MP3Tunes, LLC*, 821 F. Supp. 2d 627 (S.D.N.Y. 2011)





Policing Online Infringement (cont'd)

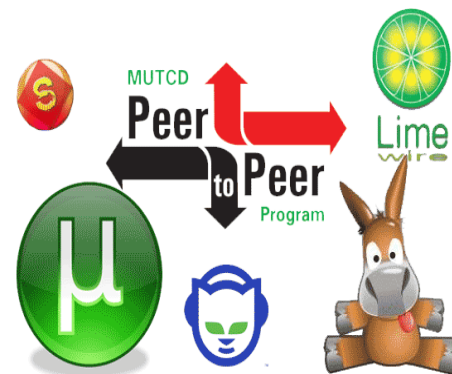
- Recent developments
 - Online infringement of the performance right
 - *Warner Bros. Entm't, Inc. v. WTV Sys., Inc.*, 824 F. Supp. 2d 1003 (C.D. Cal. 2011)
 - *American Broadcasting Companies, Inc. v. Aereo, Inc.*, -- F. Supp. 2d --, 2012 WL 2848158 (S.D.N.Y. July 11, 2012)





Policing Online Infringement (cont'd)

- Recent developments continued
 - Statutory damages for online infringement
 - *Capitol Records, Inc. v. Thomas-Rasset*, -- F.3d --, 2012 WL 3930988, (8th Cir. Sept. 11, 2012)
 - *Sony BMG Music Entmt. v. Tenenbaum*, 660 F.3d 487 (1st Cir. 2011)





Benefitting from Online Dissemination

- Collective licensing
- Web-based instant licensing systems (*e.g.*, RightsLink)
- Other ways of monetizing content as it travels through the Web
 - Contextual advertising
 - Social media



New Technologies – New Solutions

- Responsible people and organizations will act responsibly, *if you make it easy*
 - Photocopier - from transactional to repertory
 - E-mail - letting it happen
 - Web- mobile licensing
 - Social media- rewarding creators
- And when you offer a license, *it makes enforcement easier*



Related Resources

Practical Law's online service has additional resources in which you may be interested. The below can be found on www.practicallaw.com.

- Digital Millennium Copyright Act (DMCA): Safe Harbors for Online Service Providers
Practice Note
- DMCA Complaint (Takedown Notice)
Standard Document
- Copyright Infringement Cease and Desist Letter
Standard Document
- Trademark Infringement Cease and Desist Letter
Standard Document