

## Trademark Protection in the Digital Age

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### Overview

Trademark protection in the Digital Age has become increasingly difficult during the past couple of years because of rapidly evolving technology that makes protecting a company's marks more challenging, and due to the broadening use of the Internet and social media platforms. Protecting a company's marks has become more important due to the ease in which infringement may occur. This QuickCounsel summarizes some of the laws and regulations that in-house counsel should be aware of in order to protect their companies' marks in the Digital Age.

### Trademarks and Services Marks

According to [15 U.S.C. §1127](#), 'the term "trademark" includes any word, name, symbol, or device, or any combination thereof— (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.' The term "service mark" has almost the exact same definition as "trademark," except a "service mark" applies to services and not goods.

### U.S. Trademark Law

In the U.S., [trademark law](#) is governed by statute and common law. Both state and federal laws may protect a company's intellectual property. The Trademark Act of 1946, [15 U.S.C. §§1051 et seq.](#) (also known as the Lanham Act), and [37 C.F.R. Parts 2, 3, 6, 7, 10, and 11](#) governs trademarks.

The [Anti-Cybersquatting Consumer Protection Act \(ACPA\)](#) enables a trademark owner to file suit against a cybersquatter who has registered a domain name that is identical to, or confusingly similar to, or dilutive of a famous mark. For a cybersquatter to be held liable in a civil action for trademark infringement there also needs to be a bad faith intent to profit from a mark. A trademark owner may base a claim on [a likelihood of confusion or trademark dilution](#). ACPA does not protect marks that exist only under [non-U.S. law](#).

The [Trademark Dilution Revision Act of 2006 \(TDRA\)](#) amended the Lanham Act, [15 U.S.C. § 1125\(c\)](#) and overturned prior case law that required a showing of actual dilution by owners of a famous trademark. Under the TDRA, the lower threshold of likelihood of dilution and not actual dilution, is required. The TDRA may become more important in the future because the opportunity for trademark infringement will drastically increase as more commerce moves onto the Internet and more people utilize social media.

The [remedies](#) available to U.S. trademark holders include: injunctive relief, monetary damages, and in some instances attorney's fees. To obtain a preliminary injunction to stop an infringer, a four-part test is applied: 1) Is there substantial likelihood of success on the merits?; 2) Is there immediate and irreparable injury absent relief?; 3) Does the threatened harm to plaintiff substantially outweigh any harm an injunction might pose to defendant and third parties?; and 4) Will the injunction serve the public interest? Trademark owners may also obtain a defendant's profits, along with any damages and costs sustained. If the defendant utilizes a counterfeit mark, treble damages along with statutory damages may also be obtained.

## Canadian Trademark Law

According to the [Canadian Intellectual Property Office](#), “A trade-mark is a word (or words), a design, or a combination of these, used to identify the goods or services of one person or organization.” Most countries have their own top-level domain names and most of these nations have their own rules that govern their use. In Canada, the [Canadian Internet Registration Authority](#) (CIRA) manages the .CA country code top-level domain name. The CIRA has a [domain name dispute resolution policy](#) that governs the dispute resolution policy for CA top-level domain names. Section 1.4 of the CIRA policy states that the complainant must satisfy the Canadian Presence Requirements for Registrants in “respect of the domain name that is the subject of the Proceeding unless the Complaint relates to a trade-mark registered in the Canadian Intellectual Property Office (“CIPO”) and the Complainant is the owner of the trade-mark.”

## European Union Trademark Law

Trademark law in Europe is governed individually by each country that is part of the European Union. However, the European Union has passed directives that require member states to achieve certain intellectual property protection results. For example, [Directive 2008/95/EC](#), of 22 October 2008, provides European member states guidance on how to regulate trademark issues.

## World Intellectual Property Organization

The [World Intellectual Property Organization](#) (WIPO) is an agency of the United Nations that promotes intellectual property protection throughout the world. WIPO administers [The Madrid System for the International Registration of Marks](#). The Madrid System enables a trademark holder to protect his marks in multiple countries by filing only one trademark application. Intellectual property protection is afforded to trademark holders in the countries that are part of the Madrid System. As of 2010, [85 states/intergovernmental organizations](#), including the United States and the European Union were part of the Madrid System.

## Anti-Counterfeiting Trade Agreement (ACTA)

The [Anti-Counterfeiting Trade Agreement](#) is a proposed trade agreement being negotiated by a group of countries to increase intellectual property protection. The United States, Canada, and the European Union are part of the group of countries that are in the process of negotiating ACTA. According to the [U.S. Trade Representative’s Office](#), the proposed treaty [aims to establish international standards](#) for enforcing intellectual property rights in order to fight more efficiently the [growing problem of counterfeiting and piracy](#). Since ACTA is still being negotiated, it is too early to determine how it may affect trademark owners. If ACTA becomes a reality, it may create a governing body outside of the World Trade Organization (WTO) and WIPO with the authority to create and implement intellectual property law that may trump current court precedents and be binding on those countries that ratify ACTA.

## Internet Corporation for Assigned Names and Numbers (ICANN)

The [Internet Corporation for Assigned Names and Numbers’ \(ICANN\) Uniform Domain-Name Dispute-Resolution Policy](#) (UDRP) enables trademark owners to obtain through arbitration domain names that third parties are utilizing that infringe upon their marks. UDRP governs all generic top-level domains ([gTLDs](#)), which include .aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel, and .travel domain names. ICANN’s UDRP is a powerful tool that intellectual property rights holders may utilize to acquire infringing domain names.

## User Name Cybersquatting

Consistent branding is extremely important in ensuring that your product or service’s message is uniform. As previously mentioned, two powerful tools that trademark owners have in their fight against cybersquatters are UDRP and ACPA. While UDRP has been adopted by officially recognized ICANN registrars of gTLDs, every website has its own terms of service that govern user names. In addition, on page 10 of [Senate Report 106-140 \(1999\)](#) it states that ACPA excludes

screen names. Therefore, there does not appear to be a legal framework available for trademark owners for [user name cybersquatting](#).

Trademark holders are at the mercy of the policies of each individual website when claiming a user name infringes upon its trademarks. Some social media websites, such as [Facebook](#), have specific user name policies in place when a trademark holder claims that a user name infringes on its intellectual property rights. Since every website has its own rules and procedures, trademark owners must be proactive in obtaining user names for Internet and Social Media platforms.

### Conclusion

Trademark protection in the Digital Age has become a 24/7, 365-day a year fight for intellectual property rights holders. Due to new electronic platforms and increased usage of the Internet, it is becoming more difficult to protect a company's brand. In the U.S., registering your trademarks is not mandatory due to the availability of common law protection. However, in the Digital Age, registering your trademarks with the [United States Patent Trademark Office \(USPTO\)](#) is highly recommended because registration enables a mark owner to take full advantage of the protections that U.S. law may provide.

### Additional Resources

- [U.S. Patent Trademark Office](#)
- [Report to Congress: The Anti-Cybersquatting Consumer Protection Act of 1999, Section 3006](#)
- [The World Intellectual Property Organization's Gold Global Collections Searchable IP Reference Resources](#)
- [The World Intellectual Property Organization Trademark Gateway](#)
- [UK Intellectual Property Trademark Infringement Information](#)

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