

## Protection of Copyrights and Trademarks in the Online World

In today's increasingly connected world, more and more individuals are turning to online directories as replacements for more traditional products like the telephone book. Web sites like CitySearch have replaced the Yellow Pages and Web sites like MySpace™ and Facebook™ have become virtual gathering places. This increased use of Internet-based resources has placed an increased burden on companies' efforts to protect their intellectual property. In many instances, a traditional cease-and-desist letter may simply provide a first step in a long process toward removal of an infringing item on a user's profile or a listing in an online directory.



Federal copyright law has taken steps to deal with online infringement directly and provides copyright holders with tools to combat online infringement of their rights. With the passage of the Digital Millennium Copyright Act (DMCA) of 1998, Congress created a safe harbor provision in the copyright law that helps shield online service providers<sup>1</sup> from liability so long as they “act expeditiously to remove, or disable access to” infringing material following notification.<sup>2</sup> In fact, many Web sites, such as Google's Blogger™ service and Fox's MySpace, include specific provisions in their terms of service that establish procedures for reporting alleged infringements.<sup>3</sup>

A request to remove a copyrighted work from an online Web site under the safe harbor provisions of the DMCA is usually referred to as a “take-down notice.” Even though these notices may seem very similar to traditional cease-and-desist letters, in order to be effective the notices must include specific information as prescribed by statute. All notices must include the following:

- a physical or electronic signature of a person authorized to act,
- identification of the copyrighted work infringed,
- identification of the infringing material,
- contact information for the individual making the request,
- a statement that the request is made in good faith, and
- verification that the information is accurate and that

the person making the request is authorized to act on behalf of the copyright holder.<sup>4</sup>

Once a notice is drafted, it must be sent to the designated agent of the service provider. The address of the individual—or more commonly the e-mail address—is usually identified in the terms and conditions of the Web site. Be aware, however, that in the spirit of free exchange of information on the Internet, some Web sites will also state in their terms and conditions that any notification received may be forwarded for publication on the Chilling Effects Clearinghouse Web site.<sup>5</sup> A quick search allows anyone to see redacted take-down notices that have been served on a variety of Web sites.

Even though the safe harbor provisions of the DMCA have proven quite effective at policing copyrighted works on the Internet, protection of trademark rights is much more problematic. Trademark rights help the general public identify the source of goods or services and require that trademark owners police the use of their marks in order to avoid abandonment. Traditional practice in this area has involved serving a party using the mark in an unauthorized manner or in a manner that creates a “likelihood of confusion” with a cease-and-desist letter. In the Internet world, however, the process is not as easy. Courts have not agreed about whether or not service providers are even liable for a user's infringement of a trademark.

Most jurisprudence in the area of online trademark protection has focused on online auction Web sites. Some such sites—eBay™, for example<sup>6</sup>—have established procedures for trademark owners to use when reporting infringing material, but most other online auction sites have failed to follow suit. Instead, courts have attempted to reconcile brick-and-mortar “flea market” cases with the Internet world under a theory of contributory infringement.<sup>7</sup> Setting aside any further discussion of online auction Web sites and the unclear nature of current case law in the field, another common scenario arises in the context of online directories such as CitySearch™. For example, if a trademark owner discovers that an individual has listed a company name that makes use of a mark in an unauthorized fashion in a local Yellow Pages directory, traditional practice would involve sending a cease-and-desist letter to the individual. Although this method may prove effective in preventing the individual's continued use of the mark, it is likely that the Yellow Pages listing has taken on a life of its own—one that is outside the



control of the individual.

Removal of online listings that make use of an infringing mark may prove to be particularly problematic. Current trademark law does not have any provisions that are similar to the DMCA's safe harbor rules for copyright infringement. Most times, a trademark owner's only recourse is to send an e-mail to the Web site's customer service address and hope for the service provider's cooperation in removing the listing. In practice, however, this procedure usually proves to be a frustrating exercise. Another option may involve filing an action against the service provider for contributory trademark infringement, but without taking steps to "intentionally induce[s] another to infringe a trademark," the burden is usually too difficult to overcome.<sup>8</sup>

Copyright and trademark holders should, therefore, adhere to a systematic method of identifying online material that potentially infringes on their rights as soon as possible. Copyrights enjoy the protection of DMCA's safe harbor provisions to enable the removal of potentially infringing material after it appears on the Internet; trademark holders must rely on early discovery and removal of material, if the trademark infringement is found on Web sites like eBay, which have a clear policy for preventing such unauthorized use, the procedures outlined in the policy should be followed and the infringement reported as soon as possible. **TFL**

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#### Endnotes

<sup>1</sup>See 17 U.S.C. § 512(k)(1)(A–B) (defining service provider as "an entity offering the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user's choosing, without modification to the content of the material as sent or received" or "a provider of online services or network access, or the operator of facilities therefor.")

<sup>2</sup>17 U.S.C. § 512.

<sup>3</sup>Blogger: Terms of Service, [www.blogger.com/terms.g](http://www.blogger.com/terms.g); Terms & Conditions – myspace.com, [www.myspace.com/Modules/Common/Pages/TermsConditions.aspx](http://www.myspace.com/Modules/Common/Pages/TermsConditions.aspx).

<sup>4</sup>17 U.S.C. § 512(c)(3).

<sup>5</sup>Chilling Effects Clearinghouse, [www.chillingeffects.org](http://www.chillingeffects.org).

<sup>6</sup>How eBay Protects Intellectual Property (VeRO), [pages.ebay.com/help/tp/programs-vero-ov.html](http://pages.ebay.com/help/tp/programs-vero-ov.html).

<sup>7</sup>For a discussion of an Internet service provider's contributory infringement liability, see *Gucci America Inc. v. Mindspring Entrs. Inc. et al.*, 135 F. Supp. 2d 409 (S.D.N.Y. 2001).

<sup>8</sup>See *Inwood Labs Inc. v. Ives Labs. Inc.*, 456 U.S. 844, 855 (1982).

## The Foundation of the Federal Bar Association Names Recipient for 2008 Public Service Scholarship

The Foundation of the Federal Bar Association is pleased to announce that Helen Marie Berg of Detroit, Michigan, is this year's recipient of the Foundation's Public Service Scholarship. The Foundation received 32 applications for this year's scholarship.

Each year, one graduating high school senior planning to attend a four-year college or university wins the scholarship. At least one of the parents (or guardians) of the student must be a current federal government attorney or federal judge and a member of the Federal Bar Association. Applicants are evaluated on academic record, leadership recognition, school and community activities and service, and their compelling essay response.

The \$5,000 scholarship is funded by the Earl W. Kintner Memorial Fund. Earl W. Kintner was a distinguished member of the Federal Bar Association and two-time national president. His professional and civic leadership and dedication serve as a model to any aspiring academic.