

Using social media to defend against the trademark bully

These tactics can backfire and create new problems for the beleaguered junior user.

BY [PAIGE MILLS](#) JULY 19, 2016

I wrote an earlier article in this series titled [“How to Enforce Your IP Rights Without Waking the Internet.”](#) The gist of this piece was that if brand owners are too heavy-handed in their enforcement efforts, they increase the risk of their opponent taking the battle to social media. When faced with a claim of intellectual property infringement, rather than litigate in court, which is expensive and slow, the alleged infringer or junior user tries to sway public opinion by using social media to paint the brand owner as a trademark bully. The junior user mobilizes its social media friends, fans and followers to force the brand owner to consider a quick and more favorable settlement than would otherwise have been likely.

While this approach can be effective, these tactics can backfire and create new problems for the beleaguered junior user.

Several junior users have had success using these tactics. Brand owners like [ChikFilA](#) Properties Inc. (for trying to stop the use of “Eat More Kale” for T-shirts by an artist in Vermont), the [U.S. Olympic Committee](#) (for trying to stop an online knitting community from holding the “Ravelympics”), and [Procter & Gamble](#) Co. (for trying to stop the use of “Willa” for preteen skin care products made by an entrepreneurial mom), have all been painted as bullies by media savvy enforcement targets.

When Chick-fil-A sued over his “Eat More Kale” T-shirts (asserting that this infringed its “Eat Mor Chikin” trademarks), the artist got the press interested in the story, got thousands of signatures on supportive petitions and even obtained the help of Vermont’s governor. Similarly, when the U.S. Olympic Committee tried to stop an on-line knitting community from holding a knitting contest called the “Ravelympics,” thousands of furious knitters inundated the committee with angry posts, emails and blog articles.

In both instances, the rights owners found themselves in a public relations quagmire that went from bad to worse and, presumably, gave the junior user leverage to shape a cheaper and more favorable resolution.

Tempting but dangerous

While this approach may be tempting, it can also be dangerous. First, the junior user has no control over the story once it is released into the internet. There is always the chance that consumers largely agree with the brand owner, and that the press the junior user receives actually supports and emboldens the brand owner.

Second, the junior user might create harmful evidence that would not have otherwise existed. For example, while some fans will discuss the “bully’s” claims as ridiculous and overreaching, others will chime in that they also found the use of the competing mark confusing.

Furthermore, it is not unusual for fans of the junior user to declare that he or she will never buy from the brand owner again, or proudly announce that he or she insisted their local store not carry the brand owner’s products. These sorts of statements have created proof of likelihood of confusion and damages that the brand owner would not have otherwise faced.

In addition, it is not usual for angry fans to post expletive-laden, factually incorrect statements that most business would not want on their social media pages.

“No problem,” thinks the junior user. “I’ll just delete that stuff. After all, it is my Facebook/Instagram page.”

However, the brand owner likely will view the deletion of unfavorable comments as evidence spoliation that can subject the junior user to discovery sanctions and the wrath of the judge. Furthermore, there is no doubt that the brand owner’s lawyer is constantly monitoring the pages and taking frequent screen shots so as not to miss any of this favorable evidence.

The brand owner’s public relations response will likely point out to consumers that the junior user is cherry-picking the comments, which can strike consumers as unfair and deceptive and turn public sentiment towards the brand owner.

It is possible that the junior user’s conduct is creating new claims for the brand owner, thereby making its situation worse rather than better. For example, suppose the junior user starts posting about the situation on its Facebook page: “Brand X is trying to steal from the little guy” or “Brand X won’t return our calls.” The junior user fails to mention, however, that the reason Brand X won’t return its calls is because the parties mutually agreed that the situation would be handled between the lawyers.

Because the Facebook, Instagram or Twitter page is an advertisement, any false or even misleading statements posted there can potentially constitute a false advertisement, libel or defamation, deceptive trade practices, or actionable product disparagement.

Rather than drive the matter to a quick settlement, the junior user created several new claims for the very angry brand owner to pursue.

Fair use?

“But wait,” says the junior user. “What about the First Amendment? What about Fair Use?”

Courts have long regulated commercial speech like advertisements, so the junior user has far less freedom to say what he or she wants in a commercial setting like a business' Facebook page. Even though the junior user may be entitled to give its opinion of the situation, and there may be leeway for puffery, the brand owner will take the position that the speech is an unprotected false advertisement or actionable product disparagement.

Neither side will know which has the better of that argument until many months and tens (or hundreds) of thousands of dollars have been spent. Meanwhile, the junior user has given the brand owner new weapons to use in the battle between the two.

In short, trying to litigate in social media can be dangerous business for the junior user. He or she should certainly exhaust all diplomatic efforts before resorting to such tactics. Consult with competent intellectual property counsel on how best to respond to any cease-and-desist letter. The first line of defense should always be to respond in a professional manner with valid legal arguments and suggestions about how the matter might be resolved to address both parties' rights and concerns.

If that tack is not successful, do not take the case to social media without the help and advice of competent legal counsel and experienced public relations professionals. Otherwise, things may get a whole lot worse before they get better.

About the Author

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