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## Facebook, Twitter, and the Wild West of IP Enforcement on Social Media: Weighing the Merits of a Uniform Dispute Resolution Policy

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# FACEBOOK, TWITTER, AND THE WILD WEST OF IP ENFORCEMENT ON SOCIAL MEDIA: WEIGHING THE MERITS OF A UNIFORM DISPUTE RESOLUTION POLICY

DANIEL DOFT\*

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## I. INTRODUCTION

You are the owner of a publicly traded fortune 500 company who spent a great deal of time, money, and effort building your brand into a well-respected business. When you sign up to register a Twitter account under your company's name, you are informed that another user has already registered that name.<sup>1</sup> It turns out

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1. Social media websites are distinguishable from traditional websites in that they allow users to create and contribute, at least in part, to the website's content. See PAUL D. MCGRADY, JR., MCGRADY ON SOCIAL MEDIA § 1.01 (Matthew Bender & Co.). These web-based platforms can be accessed on any device that has access to the Internet, be it computer, phone, or tablet. *Id.* Examples of social media websites include Facebook, Twitter, LinkedIn, and YouTube. See Randy Milanovic, *The World's 21 Most Important Social Media Sites and Apps in 2015*, SOCIAL MEDIA TODAY (Apr. 13, 2015), [www.socialmediatoday.com/social-networks/2015-04-13/worlds-21-most-](http://www.socialmediatoday.com/social-networks/2015-04-13/worlds-21-most-)

that this other user has been posting statuses and interacting with customers as if he were representing your company. This hypothetical situation was not so postulatory for Oneok, Inc.<sup>2</sup> In 2009, Oneok found out that an anonymous user was posting from an account with its trademarked name and logo on Twitter.<sup>3</sup> This act, commonly known as “username squatting,” is one of many intellectual property issues that can arise on social media websites, as are traditional trademark infringement and copyright infringement.<sup>4</sup>

A trademark or copyright owner currently has three potential courses of action against an alleged infringer on social media: (1) report the infringement directly to the social media website, (2) send a cease-and-desist letter to the infringing party, or (3) commence a lawsuit.<sup>5</sup> However, none of these options is ideal.<sup>6</sup> Though reporting the infringement directly to the social media site is quick and inexpensive, the system as a whole lacks transparency; it is unclear how long it will take for the website to take action and remove infringing material, and it is often difficult for either party to know what constitutes a violation due to the vague and inconsistent language used by various social media platforms in their terms of usage and services agreements.<sup>7</sup> The cease and desist option is often very effective and easy for intellectual property owners who would gladly sacrifice transparency for the speedy removal of the infringing material.<sup>8</sup> However, sending a cease-and-

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important-social-media-sites-and-apps-2015. I will discuss each of these websites in detail later in this paper. *See infra* Part III.

2. *See* Compl. for Trademark Infringement, Oneok, Inc. v. Twitter, Inc., No. 4:09-cv-00597-TCK-TLW (N.D. Okla. Sept. 15, 2009).

3. *See id.* at 3.

4. *See, e.g., Username Squatting Policy*, Twitter, <https://support.twitter.com/articles/18370> (last visited Sept. 15, 2016). *See also* Darin Klemchuk, *Counteracting Copyright and Trademark Infringement Online*, ENTREPRENEUR (Mar. 24, 2014), [www.entrepreneur.com/article/232405](http://www.entrepreneur.com/article/232405).

5. *See* Liisa M. Thomas & Robert H. Newman, *Five Steps to Protect Your Trademarks in the Web 2.0 World*, WIPO MAGAZINE (Sep. 2010), [www.wipo.int/wipo\\_magazine/en/2010/05/article\\_0006.html](http://www.wipo.int/wipo_magazine/en/2010/05/article_0006.html).

6. For a discussion on these three courses of action and why none of them is ideal, *see infra* Part II.

7. *See* MCGRADY, *supra* note 1, at § 12.01 (noting that “social media user name disputes can cause great consternation and even monetary harm to the abused party and, due to the wide variety of approaches taken by the various social media providers, can have wildly disparate outcomes and resolution periods”); *see also* Lil Miss Hot Mess, *Shame on Facebook: How Zuckerberg’s Confusing “Real Names” Policy Hurts More Than It Helps*, HUFFINGTON POST (July 15, 2015), [www.huffingtonpost.com/lil-miss-hot-mess/shame-on-facebook-how-zuc\\_b\\_7789438.html?utm\\_hp\\_ref=gay-voices](http://www.huffingtonpost.com/lil-miss-hot-mess/shame-on-facebook-how-zuc_b_7789438.html?utm_hp_ref=gay-voices) (stating that Facebook CEO Mark Zuckerberg admitted confusion in Facebook’s policies by acknowledging that there was “some confusion about what our policy actually is”).

8. *See* Marketa Trimble, *Setting Foot on Enemy Ground: Cease-and-Desist Letters, DMCA Notifications and Personal Jurisdiction in Declaratory Judgment Actions*, 50 IDEA 777, 784 (2010) (stating that cease-and-desist letters “may have a number of effects: they may be instrumental in commencing

desist letter, though often a precursor to settlements that stop the use of intellectual property, and an important step that may help a plaintiff argue a willful infringement claim in court, has little judicial backing and may be ignored by an infringer who does not believe that he is in the wrong.<sup>9</sup> The third option, commencing a lawsuit, is expensive, time consuming, and unpredictable, as the case law is still undeveloped and inconsistent due to the fact that most disputes are resolved using the two alternative courses of action.<sup>10</sup> Initiating a lawsuit can also bring the issue to the public's attention, and generate negative press and a public backlash.<sup>11</sup> These courses of action are typically not mutually exclusive; an infringed party might report the infringement to the website while simultaneously sending a cease-and-desist letter to the infringing party, and subsequently filing a lawsuit.<sup>12</sup>

None of these three options provide a complete solution to the problem—the problem being a lack of a clear and transparent solution for solving intellectual property disputes on social media websites.<sup>13</sup> So even though a social media site taking down the infringing material or a court awarding damages and/or an injunction “solves the problem” on a fundamental level—as the copyright/trademark holder is granted relief—this fails to solve the problem that this paper seeks to address. A complete solution to the problem would grant proper relief while also being cost effective, timely, and completely transparent throughout the whole process of granting relief.

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settlement negotiations or serve as an impetus for licensing discussions; in patent cases they may trigger the filing of reexamination requests or declaratory judgment actions and assist in eliminating ‘bad’ patents from some of the overpatented fields of technology. Letters may also mobilize their addressees to take steps in preparation for a potential lawsuit and initiate development of alternative brands, products, and design-around technologies.”).

9. *I Received a Letter/Email* . . . USPTO (Sept. 26, 2014), [www.uspto.gov/trademark/i-received-letter](http://www.uspto.gov/trademark/i-received-letter) (stating that someone who receives a cease-and-desist letter “may elect not to respond to the letter/email or any follow-up letters/emails”).

10. See Darin M. Klemchuk & Roxana Sullivan, *Brand Enforcement on Social Networking Sites*, A.B.A., <http://apps.americanbar.org/litigation/committees/commercial/articles/092410-klemchuk-sullivan-social-networking-brand-enforcement.html> (mentioning that “[c]ase law pertaining to trademark infringement on social networking sites is sparse. Most cases settle early or are resolved through dispute resolution mechanisms within the social networking website.”).

11. See Thomas & Newman, *supra* note 5. For example, Barbara Streisand sued a website after finding out that it had posted pictures of her house as part of an environmental survey. See *id.* The website had only a few views prior to Stresand commencing the lawsuit against the website; however, the view count surpassed one million as news of the lawsuit increased its publicity. See *id.*

12. See *id.* (describing how an IP owner can report the infringement directly to the social media website, and can also take more aggressive steps such as “sending a cease and desist letter to the account holder, or even filing suit”).

13. For a more in depth analysis of this problem, see *infra* Part II.

In response to this problem, the notion of creating a fourth solution has emerged.<sup>14</sup> This possible fourth solution is to develop a Uniform Social Media Intellectual Property Dispute Resolution Policy (USRP) and to create the system to administer this mechanism.<sup>15</sup> Similar to the Uniform Domain Name Dispute Resolution Policy that has been effective in providing a timely and inexpensive solution to domain name squatters, the USRP would provide a private third-party mechanism for the resolution of intellectual property disputes stemming from the use of social media websites.<sup>16</sup> Users would be contractually obligated to submit to this system when they agree to the terms and conditions of the social media sites.<sup>17</sup> This comment will discuss the viability of such an option, and whether the creation of a USRP is desirable or even attainable.

In Part I, this comment will discuss the different types of intellectual property issues that can arise on social media websites. Part II will then discuss the three actions currently available to an infringed owner attempting to protect its intellectual property rights. Part III will discuss the Uniform Domain Name Dispute Resolution Policy (UDRP), a successful mechanism for resolving domain name disputes online. Finally, Part IV will discuss the possible creation of a USRP, which will be modeled after the UDRP, in which a private third-party arbitrator would resolve intellectual property disputes in the social media arena. This section will debate the viability and desirability of such an option, keeping in mind the need to balance fairness, accuracy in decisions, consistency, cost, and time. This comment will conclude that a USRP, while attainable, is not desirable. Instead, as Part V will discuss, social media websites should play the primary role in regulating social media intellectual property disputes. This comment argues that the best solution to this problem is for social media websites to change their regulations by making their policies more cohesive and coherent, and their takedown requests and decisions more transparent.

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14. McGrady proposed a Social Media Username Dispute Resolution Policy that was limited to username squatting disputes; however, there has never been a proposed uniform mechanism that would address all intellectual property disputes that arise on social media websites. *See* MCGRADY, *supra* note 1, at § 12.07.

15. For an in depth discussion on this possible fourth solution and the positives and negatives of such a solution, *see infra* Part IV.

16. *See Domain Name Dispute Resolution Policy*, ICANN (Jan. 16, 2016), [www.icann.org/resources/pages/dndr-2012-02-25-en#udrp](http://www.icann.org/resources/pages/dndr-2012-02-25-en#udrp) (describing the Uniform Domain Name Dispute Resolution Policy); Jacqueline D. Lipton, *Celebrity in Cyberspace: A Personality Rights Paradigm for Personal Domain Name Disputes*, 65 WASH. & LEE L. REV. 1445, 1456 (2008) (stating that the “UDRP is the simplest and most cost-effective procedural avenue for” celebrities who have been cyber squatted).

17. For a discussion on how users would be contractually obligated to submit to the USRP, *see infra* note 298, and accompanying text.

## II. INTELLECTUAL PROPERTY DISPUTES IN SOCIAL MEDIA

This part discusses the different types of intellectual property issues that can arise on social media websites. First, it will examine trademark law, and a unique subset of trademark law—username squatting—that frequently appears on social media websites. It will then address the topic of copyright law, giving a brief background on the law and discussing various ways that copyright infringement arises on social media websites.

### A. Trademarks

Trademark infringement is a major issue on social media websites.<sup>18</sup> A trademark is a “word, name, symbol, or device” that identifies a particular source of goods or services and distinguishes them from other goods and services.<sup>19</sup> Trademark law can also extend to product features such as colors, sounds, and even the layout of a retail store.<sup>20</sup> Whereas copyright law encourages creative efforts, trademark law was created to protect consumers from source confusion and to incentivize businesses to create quality products by ensuring that their mark’s goodwill is protected.<sup>21</sup>

Trademarks are governed by both state law and by federal law under the Lanham Act.<sup>22</sup> Three elements are required for a valid

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18. See Dan Malachowski, “Username Jacking” In *Social Media: Should Celebrities And Brand Owners Recover From Social Networking Sites When Their Social Media Usernames Are Stolen?*, 60 DEPAUL L. REV. 223, 227–28 (2010) (providing an expansive list of people whose names have been username squatted on social media).

19. See 15 U.S.C. § 1127 (2016) (“The term ‘trademark’ includes any word, name, symbol, or device, or any combination thereof . . .”); ANNE GILSON LALONDE & JEROME GILSON, 1 GILSON ON TRADEMARKS § 1.03 (Matthew Bender & Co. 2015).

20. See *id.* at § 1.02(1)(a) (“Trademarks can consist of almost any conceivable subject matter, from a word, symbol, picture, design, numeral, escutcheon, monogram, abbreviation, acronym, slogan, personal name, phrase, newspaper or magazine column title, title of a book series, fragrance, color, sound, texture, container, packaging, product shape, building shape, sales technique, telephone number, geographical name, grade designation, celebrity persona or any combination of these.”).

21. *Id.* at § 1.03. For example, Rolex has been granted a trademark for its name not because allowing competitors to use the mark would be unfair to Rolex, but rather, because allowing a competitor’s watch to bear the insignia would confuse consumers about which company created the watch. See *id.*

22. *Id.* at § 1.04. However, while federal registration provides certain benefits, such registration is not required to have a legally recognized trademark. *Id.*

trademark: (1) first use in commerce,<sup>23</sup> (2) distinctiveness,<sup>24</sup> and (3) non-functionality.<sup>25</sup> To prove trademark infringement, the plaintiff must show that it has a valid trademark, and that the defendant, without consent, used the mark in commerce “in connection with [the] goods or services” in a manner “likely to cause confusion . . . or to deceive [consumers].”<sup>26</sup>

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23. A mark must be the first of its kind used in commerce. *Id.* The Supreme Court has stated that “the right to a particular mark grows out of its use, not its mere adoption.” *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918). Therefore, a mark first used in a particular geographic region obtains the right to be used and protected in that region. *Id.*

24. To satisfy the distinctiveness requirement, a mark must distinguish goods offered by one company from goods offered by another company within the same sector. *See* GILSON ET AL., *supra* note 19, at § 2.01. Distinctiveness is typically looked at as a spectrum with multiple levels of distinctiveness. *Id.* A fanciful mark is the strongest type of mark, and is typically a made up word. Daniel A. Tysver, *Strength of Trademarks*, BITLAW, [www.bitlaw.com/trademark/degrees.html](http://www.bitlaw.com/trademark/degrees.html) (last visited Jan. 7, 2016). For example, “Kodak” and “Exxon” had never been found in a dictionary before their inception as trademarks. *Id.* Next, an arbitrary mark is typically a word that has meaning elsewhere, but not in relation to the goods or services being used. *Id.* For example, “apple” has long been used to describe a fruit and “camel” has long been used to describe an animal, but these words have become arbitrary marks in the computer and tobacco industry. *Id.* Following that, a suggestive mark indicates to a consumer the nature of a good through a sudden leap in thought. *Id.* For example, the name “airbus” suggests to consumers that the company behind the mark might be an airplane company, but the consumer must make an inferential leap to come to that conclusion. *Id.* Finally, a descriptive mark is the weakest kind of mark, and merely describes the good or service. *Id.* An example of this would be “outback steakhouse.” *Id.* A descriptive mark has no trademark protection unless it has acquired secondary meaning in the market, which means that consumers associate the mark with the specific goods or services. *Id.* Further, a word or phrase that was once distinctive can lose its trademark status if it loses its secondary meaning and becomes generic. *Id.* So while “aspirin” and “thermos” were once protected by trademark, their meaning has become generic over the years and they have lost their trademark status. *Id.*; *see also* *Bayer Co. v. United Drug Co.*, 272 F. 505 (S.D.N.Y. 1921) (holding that “aspirin” has become generic); *King-Seeley Thermos Co. v. Aladdin Indus.*, 321 F.2d 577 (2d Cir. 1963) (holding that “thermos” has become generic). Marks can also be born generic. *See* GILSON ET AL., *supra* note 19, at § 2.02(5).

25. The mark must be non-functional. *See* *TraFFix Devices v. Mktg. Displays*, 532 U.S. 23, 29 (2001). Patent law governs functional product features. *Id.* The Ninth Circuit has employed a four-factor test to determine whether a certain trade dress is functional: “(1) whether the design yields a utilitarian advantage, (2) whether alternative designs are available, (3) whether advertising touts the utilitarian advantages of the design, and (4) whether the particular design results from a comparatively simple or inexpensive method of manufacture.” *See* *Disc Golf Ass'n v. Champion Discs*, 158 F.3d 1002, 1006 (9th Cir. 1998). For example, a pharmaceutical pill capsule’s blue-red color could be found functional (and the capsule would therefore not be trademarkable) due to the fact that it reduces the patient’s anxiety and confusion, and can help the physicians determine which drug was taken in the case of an overdose. *See* *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 862–63 (1982).

26. *See* 15 U.S.C. § 1125(a)(1) (2016) (“Any person who, on or in connection

In addition to suing for trademark infringement, a plaintiff can sue an infringer for trademark dilution.<sup>27</sup> Under federal dilution law, famous trademarks are protected “from unauthorized uses that are likely to impair their distinctiveness or harm their reputation” by blurring or tarnishing the marks, even without any likelihood of confusion.<sup>28</sup> For example, even though “The Polo Club” adult entertainment store might not confuse the average consumer and cause him or her to wonder about whether it is associated with the design company “Polo Ralph Lauren,” it might tarnish the Polo

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with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which— (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.”); 15 U.S.C. § 1114(1) (2016) (“Any person who shall, without the consent of the registrant—(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided.”). Likelihood of confusion is different than actual confusion, and courts typically use a factors test to determine whether there is a likelihood of confusion. *See* *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979) (holding that “[i]n determining whether confusion between related goods is likely, the following factors are relevant: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant’s intent in selecting the mark; and (8) likelihood of expansion of the product lines”).

27. *See* 15 U.S.C. § 1125(c)(1) (2016) (stating that “the owner of a famous mark that is distinctive, inherently or through acquired distinctiveness,” can be granted an injunction “against another person who, at any time after the owner’s mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury”); *see also* *GILSON ET AL.*, *supra* note 19, at § 5A.01.

28. *See* *GILSON ET AL.*, *supra* note 19, at § 5A.01. The Statute itself defines “Dilution by blurring” as the “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark,” and “dilution by tarnishment” as the “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.” 15 U.S.C. § 1125(c)(2)(B), (C) (2016).



Ralph Lauren brand.<sup>29</sup> Trademark dilution protects owners from others seeking to reap free benefit from the owner's good will and investment in that mark.<sup>30</sup> There are, however, statutory exemptions to trademark dilution.<sup>31</sup> Comparative advertising, news reporting and commentary, criticizing and parodying, and noncommercial use are all affirmative defenses to a claim of trademark dilution.<sup>32</sup>

Additionally, a party can be liable for contributory infringement if it induces or knowingly facilitates another party's infringement.<sup>33</sup> Courts have held that Internet service providers can be liable for contributory infringement when they host a website on which a third-party publishes infringing material.<sup>34</sup> However, courts have limited the potential liability to instances in which an Internet service provider has "[d]irect control and monitoring of the

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29. See *Polo Ralph Lauren L.P. v. Schuman*, No. H-97-18551998, U.S. Dist. LEXIS 5890, at \*16 (S.D. Tex. Feb. 12, 1998) (holding that defendants' use of "The Polo Club" and use of the Polo player symbol trademark in his adult entertainment club tarnished the Polo Ralph Lauren trademark). Polo Ralph Lauren is a brand owned by Ralph Lauren Corporation, a global leader in design and marketing. *Company Profile*, RALPH LAUREN, <http://investor.ralphlauren.com/phoenix.zhtml?c=65933&p=irol-irhome> (last visited Jan. 7, 2016). Ralph Lauren Corporation sells high quality apparel and accessory products. See *id.*

30. See 15 U.S.C. § 1125(c) (2016); GILSON ET AL., *supra* note 19, at § 5A.01 (stating that "[d]ilution law . . . protects only a private interest, and a narrow one at that: the distinctiveness and reputation of famous trademarks. At least in cases where there is no simultaneous likelihood of confusion, there is no identifiable benefit to the public").

31. See 15 U.S.C. § 1125(c)(3) (2016).

32. See 15 U.S.C. § 1125(c)(3) (2016) ("The following shall not be actionable as dilution by blurring or dilution by tarnishment under this subsection: (A) Any fair use, including a nominative or descriptive fair use, or facilitation of such fair use, of a famous mark by another person other than as a designation of source for the person's own goods or services, including use in connection with— (i) advertising or promotion that permits consumers to compare goods or services; or (ii) identifying and parodying, criticizing, or commenting upon the famous mark owner or the goods or services of the famous mark owner. (B) All forms of news reporting and news commentary. (C) Any noncommercial use of a mark.").

33. See GILSON ET AL., *supra* note 19, at § 11.02; see also *Inwood Labs. v. Ives Labs.*, 456 U.S. 844, 853–54 (1982) (noting "liability for trademark infringement can extend beyond those who actually mislabel goods with the mark of another. Even if a manufacturer does not directly control others in the chain of distribution, it can be held responsible for their infringing activities under certain circumstances. Thus, if a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorily responsible for any harm done as a result of the deceit.").

34. See *Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 984–85 (9th Cir. 1999) (stating that an internet service provider could fall under the *Inwood* test for contributory infringement liability, but holding that the Defendant Network Solutions was not liable for contributory infringement in the instant case because the service did not entail "the kind of direct control and monitoring required" for such liability).

instrumentality used by a third party to infringe the plaintiff's mark," yet still fails to do anything about the infringing material.<sup>35</sup> In *Tiffany (NJ) Inc. v. eBay, Inc.*, for example, Tiffany, the jewelry retailer, claimed that eBay was liable under a theory of contributory trademark infringement because eBay "fail[ed] to take adequate steps" to stop the infringement and "allowed repeat offenders to sell counterfeit goods" even after Tiffany filed a notice of infringement through the website.<sup>36</sup> However, eBay claimed that it immediately removed the offered listings upon receipt of the infringement claim.<sup>37</sup> The court refused to hold eBay liable for contributory infringement, stating that "eBay cannot be held liable for trademark infringement based solely on [its] generalized knowledge that trademark infringement might be occurring on [its] websites."<sup>38</sup> Here, eBay took appropriate steps and pulled listings after it became aware of the infringement.<sup>39</sup> However, had eBay not taken the appropriate steps, it might have been liable for contributory infringement.<sup>40</sup>

In addition to traditional trademark infringement and contributory infringement, username squatting is a type of trademark infringement that commonly occurs on social media websites.<sup>41</sup> Username squatting in the social media arena, also

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35. *Id.* at 984.

36. *See Tiffany (NJ) Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 516 (S.D.N.Y. 2008). Tiffany & Co. is a jewelry empire that was started in 1837 in New York. *See About Tiffany & Co.*, TIFFANY&CO., <http://press.tiffany.com/ViewBackgrounder.aspx?backgrounderId=33> (last visited Jan. 7, 2016). Tiffany & Co. is known for its exquisite design, diamonds, and gems. *See id.* Tiffany & Co. has even been commissioned by the National Football League to create the Vince Lombardi Trophy for the Super Bowl Championship. *See id.*

37. *See Tiffany (NJ) Inc.*, 576 F. Supp. 2d at 469. eBay did not flat out contend that it removed the content, but rather stated that it is eBay's practice to remove infringing content. *Id.* ("eBay claims that in practice, when potentially infringing listings were reported to eBay, eBay immediately removed the offending listings."). eBay is an online third-party auction retailer that sells anything from baseballs to luxury cars. *Who We Are*, EBAY, [www.ebayinc.com/our-company/who-we-are/](http://www.ebayinc.com/our-company/who-we-are/) (last visited Jan. 7, 2016). eBay has 159 million active buyers and 800 million live listings. *Id.* eBay is a top 10 global retail brand with buyers in 190 countries. *Id.*

38. *See Tiffany (NJ) Inc.*, 576 F. Supp. 2d at 527. With over 800 million live listings, it is no wonder the court determined that eBay had only a generalized knowledge of infringement on its website. *See EBAY*, *supra* note 37.

39. *See Tiffany (NJ) Inc.*, 576 F. Supp. 2d at 517.

40. *See id.* This is because, as stated earlier, courts have limited contributory infringement liability to instances in which an Internet service provider has "[d]irect control and monitoring of the instrumentality used by a third party to infringe the plaintiff's mark," yet still fails to do anything about the infringing material. *See Lockheed Martin Corp.*, 194 F.3d at 984–85; *see also GILSON ET AL.*, *supra* note 19, at § 11.02; *see also Inwood Labs.*, 456 U.S. at 853–54.

41. *See Malachowski*, *supra* note 18, at 227–28 (providing an expansive list of people whose names have been username squatted on social media).

referred to as cybersquatting,<sup>42</sup> social squatting,<sup>43</sup> brandjacking,<sup>44</sup> or twitterjacking,<sup>45</sup> occurs when a person registers a celebrity or company's name with the bad faith intention of benefiting from the goodwill of that established name or trademark.<sup>46</sup> The names of celebrities can be protected by trademark, and social media websites usually ban impersonation in addition to trademark violations.<sup>47</sup> Many celebrities, both reviled and revered, such as Christopher Walken, Condoleezza Rice, Bill Gates, and even Osama bin Laden, have been twitterjacked.<sup>48</sup> At one point, a fake Peyton Manning Twitter account had 10,848 followers, while a fake Eli Manning account had 17,084 followers.<sup>49</sup> Two cases of username

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42. Zorik Pesochinsky, *Almost Famous: Preventing Username-Squatting on Social Networking Websites*, 28 CARDOZO ARTS & ENT. L.J. 223, 224 (2010).

43. 3 JAMES B. ASTRACHAN, DONNA THOMAS, GEORGE ERIC ROSDEN & PETER ERIC ROSDEN, *THE LAW OF ADVERTISING* § 56.05 (Matthew Bender & Co. 2015).

44. See also Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 BUFF. L. REV. 851, 855 (2010).

45. Jillian Bluestone, *La Russa's Loophole: Trademark Infringement Lawsuits And Social Networks*, 17 VILL. SPORTS & ENT. L.J. 573, 573 n.5 (2010).

46. See Pesochinsky, *supra* note 42, at 224 (defining username squatting as "the badfaith registration of a personal name, other than the registrant's, as a username on a social networking website"). Note that my definition includes the additional requirement that the username squatter intend to benefit from the goodwill of the established name or mark.

47. 15 U.S.C. § 1125(d)(1)(A) (2016) (noting that a person can be held liable for registering, trafficking, or using a domain name that is similar to a trademark owned by somebody else). It is important to note that the Anticybersquatting Consumer Protection Act (ACPA) only applies to domain name squatting, and does not apply to username squatting. 15 U.S.C. § 1125(d) (2016). For a discussion on the varying social media policies, including whether Facebook, Twitter, and YouTube ban impersonation in addition to trademark infringement, see *infra* Part III(A).

48. See Joshua Rhett Miller, "Twitterjacking" - Identity Theft in 140 Characters or Less, Fox News (May 1, 2009), [www.foxnews.com/story/0,2933,518480,00.html](http://www.foxnews.com/story/0,2933,518480,00.html).

49. *Tony La Russa Settles Lawsuit Against Twitter Out of Court*, STREET & SMITH'S SPORTS BUS. DAILY (June 8, 2009), [www.sportsbusinessdaily.com/article/130769](http://www.sportsbusinessdaily.com/article/130769). Peyton Manning is a quarterback in the National Football League who has won the league's most valuable player award a record-breaking five times. Chris Wesseling, *Peyton Manning is MVP of NFL for Record Fifth Time*, NFL.COM (Feb. 1, 2014), [www.nfl.com/news/story/0ap2000000321598/article/peyton-manning-is-mvp-of-nfl-for-record-fifth-time](http://www.nfl.com/news/story/0ap2000000321598/article/peyton-manning-is-mvp-of-nfl-for-record-fifth-time). He also holds the NFL record for most passing touchdowns in a career, most passing touchdowns in a season, and most passing yards in a season. James Dator, *Here's a List of Every Major NFL Record Peyton Manning Holds*, SB NATION (Oct. 19, 2014), [www.sbnation.com/nfl/2014/10/19/7010081/peyton-manning-nfl-record-list-most-touchdowns-509](http://www.sbnation.com/nfl/2014/10/19/7010081/peyton-manning-nfl-record-list-most-touchdowns-509). Eli Manning, Peyton's younger brother, is in his eleventh season as the New York Giant's quarterback. Dan Hanzus, *Eli Manning Signs 4-year, \$84M Extension with Giants*, NFL.COM (Sept. 11 2015), [www.nfl.com/news/story/0ap3000000525338/article/eli-manning-giants-agree-on-4year-84m-extension](http://www.nfl.com/news/story/0ap3000000525338/article/eli-manning-giants-agree-on-4year-84m-extension). In response to the fake Twitter account, Eli Manning stated: "I haven't gotten hurt

squatting in particular, however, are of particular note due to the fact that the infringed party initiated a lawsuit against Twitter instead of the username squatter.<sup>50</sup>

In *LaRussa v. Twitter*, Tony La Russa, the then-manager of the St. Louis Cardinals' major league baseball team, sued Twitter for trademark infringement, trademark dilution, and cybersquatting, among other claims.<sup>51</sup> La Russa's complaint arose after an anonymous user created a fake Twitter profile using the "Tony La Russa" Twitter handle and a picture of La Russa with his name next to it.<sup>52</sup> The fake La Russa page contained a statement in large lettering that read, "Tony La Russa is using Twitter," and encouraged users to "Join today to start receiving Tony La Russa's updates."<sup>53</sup> The page also contained a message that read "Bio Parodies are fun for everyone."<sup>54</sup>

La Russa claims he informed Twitter about the impersonating account, and that Twitter ignored his complaints.<sup>55</sup> This set the table for the first ever lawsuit against Twitter.<sup>56</sup> In his complaint,

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by it. But it was important for Peyton and I to get it out there that we're not on Twitter. We won't be using it. So if anybody gets a message saying it's from Eli or Peyton, it's not us." See Sports Media, *supra* note 49.

50. Compl. for Trademark Infringement, False Designation of Origin, Trademark Dilution, Cybersquatting, Misappropriation of Name, and Misappropriation of Likeness, *La Russa v. Twitter, Inc.*, No. 09-488101 (Cal. Super. Ct. filed May 06, 2009); Compl., *Oneok, Inc.*, No. 4:09-cv-00597-TCK-TLW.

51. La Russa also sued Twitter for false designation of origin, misappropriation of name, misappropriation of likeness, invasion of privacy, and intentional misrepresentation. Compl. for Trademark Infringement, False Designation of Origin, Trademark Dilution, Cybersquatting, Misappropriation of Name, and Misappropriation of Likeness, *La Russa v. Twitter, Inc.*, No. 09-488101 (Cal. Super. Ct. May 06, 2009).

52. *Id.* at \*3. La Russa's days as a baseball player were marred with injury, and he retired from the league following the 1977 season with a meager .199 career batting average. *Tony La Russa*, NAT'L BASEBALL HALL OF FAME, <http://baseballhall.org/hof/larussa-tony> (last visited Jan. 7, 2016). La Russa enrolled in law school during the 1973 offseason, and graduated from Florida State University in 1978. *Id.* He passed the Florida state bar the following year. *Id.* However, La Russa forewent a career in law to manage baseball. *Id.* At the age of 35, La Russa became the youngest manager in baseball when he managed the Chicago White Sox. *Id.* In addition to managing the Chicago White Sox, La Russa went on to manage the Oakland Athletics and the St. Louis Cardinals. See *id.* As a manager, La Russa won 2,728 games and three World Series championships. *Id.* He was inducted into the National Baseball Hall of Fame in 2014. *Id.*

53. Compl. for Trademark Infringement, False Designation of Origin, Trademark Dilution, Cybersquatting, Misappropriation of Name, and Misappropriation of Likeness, *La Russa v. Twitter, Inc.*, No. 09-488101, at \*3 (Cal. Sup. Ct. filed May 06, 2009).

54. *Id.* at Ex. A.

55. Zusha Elinson, *Twitter Says It Will Fight La Russa Suit Over Fake Tweets*, THE RECORDER, June 9, 2009, at 1.

56. *Id.*; Bluestone, *supra* note 45, at 593 (stating "[i]n the first ever lawsuit against Twitter, La Russa raised a variety of claims.").

La Russa alleged that the fake La Russa page contained “written entries that are impliedly written by [La Russa] himself when in fact they are not.”<sup>57</sup> The complaint further alleged that allowing another user to use the “Tony La Russa” username was “misleading and likely to confuse users by leading them to believe that [the page] is endorsed and authored by” the real Tony La Russa.<sup>58</sup> Shortly thereafter, La Russa voluntarily dismissed the lawsuit, and Twitter removed the infringing account and its postings.<sup>59</sup>

Fewer than three months after La Russa dismissed his lawsuit, Twitter was faced with a similar suit filed by Oneok, Inc.<sup>60</sup> In *Oneok, Inc. v. Twitter*, Oneok, a publically traded fortune 500 company, sued Twitter for direct and contributory trademark infringement.<sup>61</sup> Oneok’s complaint arose after a third-party registered the “Oneok” Twitter handle and used the account to send Tweets about the company.<sup>62</sup> In its complaint, Oneok alleged that “[t]he Oneok Twitter account holder has on at least two occasions generated Tweets containing information regarding Oneok, Inc.,” that “[t]hese communications contained the Oneok trademark name and Diamond design,” and that “[t]hese Tweets have the appearance of being an official statement issued by Oneok on the Twitter system.”<sup>63</sup> The complaint also alleged that Twitter refused to provide Oneok with the contact information of the infringed account holder, and that Twitter refused to assign the Oneok Twitter account to Oneok, Inc.<sup>64</sup> Within 24 hours after the complaint was submitted, Twitter suspended the impersonating account, and Oneok withdrew the lawsuit.<sup>65</sup>

In the aftermath of these two lawsuits, Twitter started allowing celebrities and businesses to authenticate their account by having Twitter verify the authenticity of the user behind the account and then publishing a blue check mark insignia on the

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57. Complaint., La Russa, No. 09-488101, at \*3.

58. *Id.*

59. Notice of Dismissal, *La Russa v. Twitter, Inc.*, No. 09-2503 (Cal. Sup. Ct. filed June 5 2009); DMLP Staff, *La Russa v. Twitter, Inc.*, DIGITAL MEDIA LAW PROJECT (May. 20, 2009), [www.dmlp.org/threats/la-russa-v-twitter-inc](http://www.dmlp.org/threats/la-russa-v-twitter-inc).

60. Notice of Dismissal, *La Russa*, No. 09-2503; *see* Complaint., *Oneok, Inc.*, No. 4:09-cv-00597-TCK-TLW.

61. Complaint., *Oneok, Inc.*, No. 4:09-cv-00597-TCK-TLW, at \*2,4 Oneok, Inc. is a diversified energy company. *About Us*, ONEOK, [www.oneok.com/en/About](http://www.oneok.com/en/About) (last visited Jan. 7, 2016). It is also the sole general partner of ONEOK Partners, L.P., owning 41.2%. *Id.* Oneok Partners, L.P., is a publicly traded limited partnership that is involved with the gathering and processing of natural gas, in addition to natural gas pipelines. *Id.* Oneok is a fortune 500 company that is listed on Standard & Poor’s 500 Stock Index (the S&P 500). *Id.*

62. Compl., *Oneok, Inc.*, No. 4:09-cv-00597-TCK-TLW, at \*3.

63. *Id.*

64. *Id.*

65. *Id.*; DMLP Staff, *Oneok, Inc. v. Twitter*, DIGITAL MEDIA LAW PROJECT (Aug. 20, 2010), [www.dmlp.org/threats/oneok-inc-v-twitter#description](http://www.dmlp.org/threats/oneok-inc-v-twitter#description).

user's profile.<sup>66</sup> Facebook adopted a similar policy shortly thereafter.<sup>67</sup> While this authentication process was able to curtail some types of username squatting, it has not been a permanent solution to the problem.<sup>68</sup>

An example of a type of username squatting that could not be prevented by verified accounts recently made national headlines.<sup>69</sup> In August 2015, Target announced that it planned to remove gender-based labels from some of its store's departments.<sup>70</sup> Some outraged customers wanted to complain, so they went onto Target's Facebook page to voice their disdain about the newly proposed policy.<sup>71</sup> Mike Malgaard used this opportunity to pose as Target and post responses to people's comments.<sup>72</sup> Malgaard created a fake account named "Ask ForHelp" that used a picture of Target's logo as the account's picture.<sup>73</sup> In one of its responses, Ask ForHelp said

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66. *FAQs About Verified Accounts*, TWITTER, <https://support.twitter.com/groups/31-twitter-basics/topics/111-features/articles/119135-about-verified-accounts> (last visited Jan. 7, 2016); Craig Kannaley, *Why Twitter Verifies Users: The History Behind the Blue Checkmark*, HUFFINGTON POST (Mar. 12, 2013), [www.huffingtonpost.com/craig-kanalley/twitter-verified-accounts\\_b\\_2863282.html](http://www.huffingtonpost.com/craig-kanalley/twitter-verified-accounts_b_2863282.html) (stating that Twitter adopted its verified accounts system after Tony La Russa was impersonated on Twitter).

67. *Verified Page or Profile*, FACEBOOK, [www.facebook.com/help/196050490547892](http://www.facebook.com/help/196050490547892) (last visited Jan. 7, 2016) ("Some Pages and profiles have been verified by Facebook to let people know that they're authentic. If you see a blue badge on a Page or profile, it means that Facebook confirmed that this is the authentic Page or profile for this public figure, media company or brand. If you see a gray badge on a Page, it means that Facebook confirmed that this is an authentic Page for this business or organization."); Chloe Albanesius, *Facebook Rolls Out Verified Pages, Profiles*, PC MAG (May 29, 2013), [www.pcmag.com/article2/0,2817,2419632,00.asp](http://www.pcmag.com/article2/0,2817,2419632,00.asp) (stating that "Facebook . . . took a page from Twitter and rolled out verified pages and profiles").

68. See *infra* notes 69–74, and accompanying text.

69. Lori Grisham, *Fake Target Account Answers Fake Facebook Gripes*, USA TODAY (Aug. 14, 2015), [www.usatoday.com/story/news/nation-now/2015/08/14/fake-target-account-answers-facebook-gripes/31706967/](http://www.usatoday.com/story/news/nation-now/2015/08/14/fake-target-account-answers-facebook-gripes/31706967/).

70. See *id.* For example, Target planned to no longer make a distinction between "toys for boys" and "toys for girls." See *id.* This move towards gender neutrality has been on the rise lately. See Richard Alleyne, *Couple Raise Child as 'Gender Neutral' to Avoid Stereotyping*, THE TELEGRAPH (Jan. 20, 2012), [www.telegraph.co.uk/news/9028479/Couple-raise-child-as-gender-neutral-to-avoid-stereotyping.html](http://www.telegraph.co.uk/news/9028479/Couple-raise-child-as-gender-neutral-to-avoid-stereotyping.html). For example, Beck Laxton and Kieran Cooper did not reveal the sex of their child until the child turned five. *Id.* The couple referred to their child as "The Infant," only allowing the child to play with "gender-neutral toys" and alternating between boys' and girls' clothes. See *id.*

71. Gisham, *supra* note 69.

72. *Id.* Target is a discount retailer that sells food, clothing, games, sports equipment, and many other products. *Corporate Fact Sheet*, TARGET, <https://corporate.target.com/press/corporate> (last visited Jan. 7, 2016). Target has 1,805 stores in the United States, and employs 347,000 people worldwide. See *id.* Target's iconic logo is a red bullseye. See *id.*

73. See Grisham, *supra* note 69.

“[w]e invite you to come separate the toys yourself. We just personally can't keep doing it anymore. It's a lot of work.”<sup>74</sup>

These clear acts of username squatting were quickly frustrated, as the comments were removed from Target's Facebook Page within days.<sup>75</sup> However, the incident showed that username squatting is still prevalent today and emphasized the need for a lasting and effective solution. Though one could argue that the takedown procedure worked here, as Facebook removed Malgaard's fake account within days, it is still important to explore other possible ways to counteract this type of infringement.<sup>76</sup> Despite the fact that the takedown procedure was quick and effective in this circumstance, it is important that we do not sacrifice speediness for fairness in decisions and transparency.

### B. Copyrights

In addition to trademark infringement, copyright infringement is also prevalent on social media websites.<sup>77</sup> A copyright grants the author of an original work the exclusive right to reproduce, distribute, publicly perform or display, and prepare derivative works of the copyrighted material.<sup>78</sup> A “work” is any creative expression that is “fixed in any tangible medium,” which includes pictures, images, or videos.<sup>79</sup> Congress was granted the power to create copyright law in the United States Constitution, and copyrighted works are typically valid until 70 years after the author of the work dies.<sup>80</sup> Similar to trademarks, the law will recognize and

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74. *Id.*

75. It is unclear whether Malgaard removed the Ask ForHelp comments himself, or whether Facebook removed them. *Id.* Additionally, there is speculation that Target liked the username squatting in question, as Target alluded to “trolls” (a name commonly given to mischievous people on the internet) ruling the world and coming back to Target stores. *Id.*

76. *Id.*

77. See Lindy Herman & Sean Lynch, *Copyright Infringement Risks On Social Media*, 57 ORANGE COUNTY LAWYER 34, 34 (2015) (stating that “[e]very day, Pinterest users ‘pin’ third-party images to their ‘boards,’ Instagrammers post or repost others’ images, Redditors recycle content, and bloggers grab third-party content off the Internet to illustrate their dialogue. Though it may seem harmless, many social media users are unaware that these seemingly benign activities may amount to copyright infringement”).

78. 17 U.S.C. § 106(1) – (6) (2016).

79. 17 U.S.C. § 102 (2016).

80. U.S. CONST. art. 1, § 8, cl. 8 (stating Congress shall “promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries”). Typically, any copyright in a work created on or after January 1, 1978 is valid until 70 years after the author's death. 17 U.S.C. § 302 (a) (2016). However, in “the case of an anonymous work, a pseudonymous work, or a work made for hire, the copyright endures for a term of 95 years from the year of its first publication, or a term of 120 years from the year of its creation, whichever expires first.” 17 U.S.C. § 302(c) (2016).

protect unregistered copyrights; however, a domestic author must register its copyright before suing.<sup>81</sup>

To have a valid copyright, three requirements must be met: (1) originality,<sup>82</sup> (2) work of authorship,<sup>83</sup> and (3) fixation.<sup>84</sup> To win a copyright infringement lawsuit, the plaintiff must prove: (1) that it owns a valid copyright, and (2) that the defendant copied “constituent elements of the work that are original.”<sup>85</sup> Because it is difficult to establish copying as a factual matter (there typically is not a witness who can attest to the physical act of copying), copying is often established indirectly through evidence of the plaintiff’s access to the copyrighted work, and through “substantial” similarity of the works in question.<sup>86</sup>

Accusations of copyright infringement are common on social media.<sup>87</sup> For example, earlier this year, Wisconsin-based photographer Jennifer Reilly sued Twitter for failing to remove her copyrighted photographs despite her multiple requests that it do so.<sup>88</sup> In a complaint filed on January 11, 2016, in the United States District Court for the Central District of California, Reilly claimed that her copyrighted photo “Red Lips and Microphone” was modified and posted to Twitter by a University of North Texas student

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81. *About Copyright: Purpose of Copyright*, COPYRIGHT CLEARANCE CTR., [www.copyright.com/learn/about-copyright/](http://www.copyright.com/learn/about-copyright/) (last visited Sept. 16, 2016).

82. The originality requirement is satisfied if the work is creative and is created independent of another source. 17 U.S.C. § 102(a) (2016).

83. Congress has given courts some guidance in determining whether the work of authorship requirement is satisfied. *See* 17 U.S.C. § 102(a)(1)–(8) (2016). This element encompasses “literary works (including computer programs), musical works, dramatic works, pantomimes and choreographic work, pictorial, graphic, and sculptural works, motion pictures and other audiovisual works, sound recordings, and architectural works.” 17 U.S.C. § 102(a)(1)–(8) (2016). These categories are merely illustrative and are not all encompassing. 17 U.S.C. § 102(a)(1)–(8) (2016).

84. The fixation element is satisfied if a work is written, recorded, or otherwise fixed in a tangible medium. *See* 17 U.S.C. § 102 (2016). Thus, a piece of work must be “sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration.” 17 U.S.C. § 101 (2016).

85. *See Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 361 (citing *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 548 (1985)) (holding that the information contained in Rural’s phonebook was not copyrightable because it was merely fact information without a requisite minimum of original creativity).

86. *See* 4 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 13.01 (Matthew Bender, Rev. Ed. 2015).

87. *See* Herman & Lynch, *supra* note 77, at 35–36 (2015) (providing examples in which copyright owners accuse social media users of copyright infringement).

88. Michael Zang, *Photographer Sues Twitter for Not Removing Photos Despite DMCA Requests*, PETAPIXEL (Jan. 16, 2016), <http://petapixel.com/2016/01/16/photographer-sues-twitter-for-not-removing-photos-despite-dmca-requests/>.



group.<sup>89</sup> The image, which Reilly was selling as a fine art print, was retweeted by supporters of the group without her permission.<sup>90</sup> After discovering that her photograph was being posted without her consent, Reilly alleged she sent Twitter 28 takedown requests.<sup>91</sup> Although Twitter removed some of the images, 50 of the 56 infringing posts were not removed.<sup>92</sup> Reilly then sued Twitter for both direct and contributory copyright infringement.<sup>93</sup> Reilly voluntarily dismissed the action the following month.<sup>94</sup>

But was Twitter really in the wrong? Did the posts actually infringe on Reilly's copyrighted work, or were the student group's modifications to the photograph sufficient to qualify for the fair use defense? The fair use doctrine is one defense to copyright infringement that allows for the unauthorized use of a copyrighted work even without the owner's permission.<sup>95</sup> Fair use of a copyrighted work "for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research," is not copyright infringement.<sup>96</sup> When determining whether certain use of a copyrighted work constitutes fair use, courts implement a four-factor test that weighs:

- (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
- (2) the nature of the copyrighted work;
- (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
- (4) the effect of the use upon the potential market for or value of the copyrighted work.<sup>97</sup>

Due to the nature of social media websites as a platform for "commentary," users accused of copyright infringement often argue

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89. Compl. for Copyright Infringement, *Rondinelli Reilly v. Twitter, Inc. et al*, No. 2:16-cv-00200, at \*3, Exhibit B (C.D. Cal. Jan. 11, 2016).

90. *See Zang, supra* note 88.

91. *Id.*

92. *Id.*

93. Compl. *Reilly*, at \*4.

94. *See* Notice of Voluntary Dismissal, *Rondinelli Reilly v. Twitter, Inc. et al*, No. 2:16-cv-00200 (filed Feb. 23, 2016). The terms of the settlement are unknown. *See id.*

95. *See* 17 U.S.C. § 107 (2016).

96. 17 U.S.C. § 107 (2016) ("[T]he fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.")

97. 17 U.S.C. § 107 (2016).

that they are protected by the fair use doctrine.<sup>98</sup> For example, in 2013, to commemorate the twelfth anniversary of 9/11, Fox News posted on its Facebook account an image of three firefighters hoisting an American flag at the ruins of the World Trade Center site on the day of the attacks.<sup>99</sup> This image was juxtaposed with the iconic World War II photograph of four United States marines hoisting the American flag on Iwo Jima, and was posted to the Facebook page with the hashtag “#neverforget.”<sup>100</sup> North Jersey Media Group, which owns the copyright to the 9/11 picture, sued Fox News and Jean Pirro, one of Fox News’ television personalities, for copyright infringement.<sup>101</sup> In its defense, Fox News contended that its posting of the combined image was protected fair use.<sup>102</sup> Fox News argued, among other things, that its use of the image was commentary because it juxtaposed the image with the Iwo Jima image and also used the hashtag “#neverforget” to signal Fox News’ “participation in an ongoing, global discussion concerning the events of September 11, 2001.”<sup>103</sup> The Court denied Fox news’ motion for summary judgment.<sup>104</sup> The Court held that although

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98. See Herman & Lynch, *supra* note 87, at 36 (discussing the fair use defense on social media).

99. Eriq Gardner, *9/11 Photos Causing Legal Trouble for Fox News, Other Media Outlets*, HOLLYWOOD REPORTER (Feb. 12, 2015), [www.hollywoodreporter.com/thr-esq/9-11-photos-causing-legal-772735](http://www.hollywoodreporter.com/thr-esq/9-11-photos-causing-legal-772735). Fox News is a cable television network involved in news and political commentary. Michael Ray, *Fox News Channel*, ENCYC. BRITANNICA (updated July 22, 2016), [www.britannica.com/topic/Fox-News-Channel](http://www.britannica.com/topic/Fox-News-Channel) (last visited Jan. 7, 2015). The network was launched in 1996 under Fox Entertainment Group. See *id.* Fox News bills itself as a “fair and balanced” alternative to the other liberal networks. *Id.* However, Fox News has heavy conservative leanings, as the network has donated to Republican causes, in addition to forging strong ties with conservative political leaders. *Id.*

100. Gardner, *supra* note 99.

101. *N. Jersey Media Grp., Inc. v. Jeanine Pirro & Fox News Network, LLC*, 74 F. Supp. 3d 605, 609-10 (S.D.N.Y. 2015). North Jersey Media Group is an independent, family-owned news and marketing provider in Northern New Jersey. *About North Jersey Media Group*, NORTH JERSEY, [www.northjersey.com/about-us/north-jersey-media-group-inc-corporate-information-1.177160](http://www.northjersey.com/about-us/north-jersey-media-group-inc-corporate-information-1.177160) (last visited Jan. 7, 2016). The media group has a daily newspaper that reaches almost a half million daily readers, forty-nine community newspapers that circulate to 778,000 households, a website that receives approximately 14 million monthly page views, and a magazine that reaches 50,000 households. See *id.*

102. *N. Jersey Media Grp., Inc.*, 74 F. Supp. 3d, at 609.

103. *Id.*, at 615.

104. See *id.* at 623 (“Weighing the results together, in light of the purposes of copyright, the Court cannot conclude as a matter of law that Defendants’ use of the Work was fair. Material questions of fact exist concerning the purpose of the Combined Image’s use, precluding a determination of the first statutory factor [(the purpose and character of the use)]. The second factor [(the nature of the work)] weighs in favor of fair use, but that factor is only rarely determinative and is not so in this case. This third factor [(the amount and substantiality of the portion used)] is neutral. The fourth and most important factor [(the effect of the use upon the market for or value of the original)] weighs

some of the fair use factors weighed in favor of Fox News, the “fourth and most important factor”—the effect of the use upon the market for or value of the original work—weighed against fair use.<sup>105</sup> Fox News immediately appealed this decision, but later withdrew the appeal after it entered into a settlement agreement with North Jersey Media Group.<sup>106</sup>

When a dispute goes to court and the defense raises the fair use doctrine, one can be sure that the court will adequately address that doctrine.<sup>107</sup> However, it is unclear whether the social media

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against fair use . . . Accordingly, Defendants’ motion for summary judgment must be denied.”).

105. *Id.*

106. Bill Donahue, *Fox News Settles Fair Use Case Over 9/11 Facebook Photo*, LAW360 (Apr. 15, 2015), [www.law360.com/articles/643460/fox-news-settles-fair-use-case-over-9-11-facebook-photo](http://www.law360.com/articles/643460/fox-news-settles-fair-use-case-over-9-11-facebook-photo). Photographs are not the only copyright issues that arise on social media. See Dante D’Orazio, *Twitter is Deleting Stolen Jokes on Copyright Grounds*, VERGE (July 25, 2015, 10:35AM), [www.theverge.com/2015/7/25/9039127/twitter-deletes-stolen-joke-dmca-takedown](http://www.theverge.com/2015/7/25/9039127/twitter-deletes-stolen-joke-dmca-takedown). In particular, Twitter is deleting stolen jokes on copyright grounds. For example, Instagram and Twitter celebrity Josh Ostrovsky, known to his followers as “The Fat Jew” recently found himself at the center of a media frenzy over allegations of copyright infringement. Oliver Herzfeld, *The Fat Jew, Plagiarism and Copyright Law*, FORBES (Aug. 24, 2015), [www.forbes.com/sites/oliverherzfeld/2015/08/24/the-fat-jew-plagiarism-and-copyright-law/](http://www.forbes.com/sites/oliverherzfeld/2015/08/24/the-fat-jew-plagiarism-and-copyright-law/). Ostrovsky, who made TIME’s 2015 list of the thirty most influential people on the Internet, reached fame-level status by posting comedic images and jokes on his Instagram account. Time Staff, *The 30 Most Influential People on the Internet*, TIME (Mar. 5, 2015), <http://time.com/3732203/the-30-most-influential-people-on-the-internet/>. People accused Ostrovsky of deliberately stealing jokes without attributing them to the original creator. See Herzfeld, *supra* note 106. Facebook user Maura Quint stated that “The Fat Jew is someone whose entire career is simply stealing jokes from [T]umblr, [T]witter, etc. He is making a living off of the hard work of other people . . . .” Nolan Feeney, *The Fat Jew’ Is Being Called Out for Plagiarism After Talent Deal*, TIME (Aug. 17, 2015), <http://time.com/4000711/fat-jew-backlash/>. On one occasion, for example, Ostrovsky Tweeted, verbatim and without attribution, a joke that Matt Besser, the Upright Citizens Brigade Improvisation Theatre’s co-founder, had Tweeted years earlier. Jesse David Fox, *A Conversation with The Fat Jew: “That’s Not Who I Am or What I’m About,”* VULTURE (Aug. 21, 2015), [www.vulture.com/2015/08/exclusive-interview-the-fat-jew.html](http://www.vulture.com/2015/08/exclusive-interview-the-fat-jew.html). On another occasion, Ostrovsky posted an exact copy of an image with caption to Instagram that comedian Ben Rosen had posted to Twitter, the only change was that Ostrovsky cropped out Rosen’s name, face, and Twitter handle. Jason Newman, *The Fat Jew’ Joke Victims Speak Out*, ROLLING STONE (Aug. 20, 2015), [www.rollingstone.com/culture/news/the-fat-jew-joke-theft-victims-speak-out-20150820](http://www.rollingstone.com/culture/news/the-fat-jew-joke-theft-victims-speak-out-20150820). While none of the original content creators took any formal legal action, public outcry was overwhelming and television network Comedy Central scrapped a deal it had in the works with Ostrovsky. See Herzfeld, *supra* note 106. In response, Ostrovsky has pledged to “never again post something that doesn’t have attribution,” stating that he “now realize[s] that if [he] couldn’t find a source for something, [he] probably shouldn’t have posted it in the first place.” Fox, *supra* note 106.

107. See NIMMER, *supra* note 86, at § 12B.01 (discussing numerous contributory infringement cases in which courts analyzed the fair use doctrine).

websites balance these factors upon receipt of a takedown request and before deciding whether to remove content.<sup>108</sup> Social media websites offer a speedy resolution, but it is important that they not sacrifice fairness and accuracy in decisions as a result.<sup>109</sup>

The discussion thus far has, for the most part, addressed copyright liability for a party that posts infringing material. But what about the social media website that unknowingly hosts that infringing material? In addition to suing the infringing party, the holder of a valid copyright can sue a third party that materially contributes to the infringement under the law of contributory infringement.<sup>110</sup> In *Metro-Goldwyn-Meyer Studios, Inc. v. Grokster, Ltd.*, the Supreme Court held that “one who distributes a device with the objective of promoting its use to infringe [a] copyright . . . is liable for the resulting acts of infringement by third parties.”<sup>111</sup> This case, adapted to the social media arena, stands for the proposition that a social media website can be held liable for inducing infringement by its users.<sup>112</sup> That is, unless it implements a system that satisfies Congress’ safe harbor provision.<sup>113</sup>

In 1998, Congress created a safe harbor for Internet service providers that take certain precautions against copyright infringement by their users.<sup>114</sup> The Digital Millennium Copyright Act (DMCA) shields a website from copyright liability, but only if it takes certain steps to block or remove the allegedly infringing material after being notified of such infringement by the copyright holder.<sup>115</sup> A website can escape liability for any infringing material posted to its website by a third-party if it is unaware of such infringing material or if, “upon notification of [the] claimed infringement,” the website “responds expeditiously to remove, or

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108. For a discussion on the various social media policies, see *infra* Part II(A).

109. For a discussion on the various social media policies, see *infra* Part II(A).

110. See generally *MGM Studios Inc. v. Grokster, Ltd.*, 545 U.S. 913 (2005). In that case, the Court unanimously held that Grokster and Streamcast, two peer-to-peer file sharing companies that distributed file sharing software that encouraged users to download and upload copyrighted works, could be sued for inducing copyright infringement. See *id.* at 919–24, 941.

111. *Id.* at 919.

112. Jacqueline C. Charlesworth, *The Moral of the Story: What Grokster Has to Teach About the DMCA*, 2011 STAN. TECH. L. REV. 6 (2011).

113. 17 U.S.C. § 512(c) (2016). See also Charlesworth, *supra* note 112, at ¶1.

114. 17 U.S.C. § 512(c) (2016).

115. See 17 U.S.C. § 512 (2016). The DMCA fills certain holes left by the 1995 Communications Decency Act (CDA). 47 U.S.C. § 230 (2016). The CDA protects online service providers from tort liability for content posted by third party users. 47 U.S.C. § 230 (2016). The CDA stipulates that “[n]o provider or user of an interactive computer service shall be treated as the publisher or speaker of any information provided by another information content provider.” 47 U.S.C. § 230(c)(1) (2016). The CDA, however, failed to provide Internet service providers with immunity from copyright or trademark infringement. See *id.*

disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”<sup>116</sup> Additionally, a service provider must “[adopt] and reasonably implement[] . . . a policy that provides for the termination in appropriate circumstances of subscribers and account holders of the service provider's system or network who are repeat infringers.”<sup>117</sup> In short, a website will be protected from liability if it implements a policy against copyright infringement, advertises that policy to its users, and makes reasonable efforts to remove the infringing material after being made aware of it.<sup>118</sup>

*Viacom Inc. v. YouTube, Google Inc.*, provides an example of a website that successfully used the DMCA's safe harbor provision to shield itself from liability.<sup>119</sup> In this 2012 case, Viacom sued YouTube for copyright infringement, alleging that YouTube intentionally made 79,000 unauthorized Viacom clips available to the public between 2005 and 2008.<sup>120</sup> In its defense, YouTube relied on the DMCA's safe harbor provision.<sup>121</sup> The District Court agreed, granting summary judgment for YouTube and rejecting the notion

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116. See 17 U.S.C. § 512(c) (2016) (“A service provider shall not be liable for monetary relief, or, except as provided [in a different subsection], for injunctive or other equitable relief, for infringement of copyright by reason of the storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider, if the service provider— (A)(i) does not have actual knowledge that the material or an activity using the material on the system or network is infringing; (ii) in the absence of such actual knowledge, is not aware of facts or circumstances from which infringing activity is apparent; or (iii) upon obtaining such knowledge or awareness, acts expeditiously to remove, or disable access to, the material; (B) does not receive a financial benefit directly attributable to the infringing activity, in a case in which the service provider has the right and ability to control such activity; and (C) upon notification of claimed infringement as described in paragraph (3), responds expeditiously to remove, or disable access to, the material that is claimed to be infringing or to be the subject of infringing activity.”).

117. 17 U.S.C. § 512(i)(1)(A) (2016).

118. 17 U.S.C. § 512 (2016). This is likely why websites have certain internal procedures and takedown policies. However, there is no evidence that this one factor is the sole reason for self-regulation. It is likely that there are multiple factors that can be attributed to why websites regulate. For example, websites may also ban infringement because they want to protect their users from confusing uses of trademarks and/or because they believe in the protection of copyrights to encourage the creation of creative works.

119. See generally *Viacom Int'l, Inc. v. YouTube, Inc.*, 676 F.3d 19 (2d Cir. 2012).

120. See *id.* at 25–26. Viacom is a New York company that owns Paramount movie studio as well as cable networks such as Comedy Central, MTV, and Nickelodeon. See Jonathan Stemple, *Google, Viacom Settle Landmark YouTube Lawsuit*, REUTERS (Mar. 18, 2014), [www.reuters.com/article/us-google-viacom-lawsuit-idUSBREA2H11220140318](http://www.reuters.com/article/us-google-viacom-lawsuit-idUSBREA2H11220140318). In this billion dollar lawsuit against YouTube, Viacom alleged that YouTube committed copyright infringement by allowing third-party users to post clips from “The Daily Show with Jon Stewart,” “South Park,” “SpongeBob SquarePants,” and other programs. *Id.*

121. *Viacom*, 676 F.3d, at 25.

that YouTube engaged in copyright infringement.<sup>122</sup> On appeal, the Second Circuit Court of Appeals held that though YouTube could not be held liable based merely on its “generalized awareness of infringement,” Viacom had provided enough evidence to warrant a trial.<sup>123</sup> On remand, the District Court affirmed its original judgment by granting summary judgment for YouTube.<sup>124</sup> The court opined that YouTube was not “willfully blind,” nor was there any “evidence that YouTube induced its users to submit infringing videos, provided users with detailed instructions about what content to upload or edited their content, prescreened submissions for quality, steered users to infringing videos, or otherwise interacted with infringing users to a point where it might be said to have participated in their infringing activity.”<sup>125</sup>

The DMCA safe harbor provision is a driving force behind the internal policies created by the various social media websites. As will be discussed below, Facebook, Twitter, and YouTube have all

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122. *Viacom Int'l, Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514, 529 (S.D.N.Y. 2010).

123. *See Viacom Int'l, Inc.*, 676 F.3d at 25–26.

124. *See Viacom Int'l, Inc. v. Youtube, Inc.*, 940 F. Supp. 2d 110, 121–23. The case was settled before further appeal commenced. *See Stemple, supra* note 120.

125. *Id.* at 123. Whereas the court was quick to reject a contributory infringement claim against YouTube because YouTube had no “knowledge or awareness” of the infringing activity, the court was not so sympathetic in *A&M Records v. Napster Inc.* *See* *A&M Records v. Napster, Inc.*, 239 F.3d 1004, 1010–11 (9th Cir. 2001). In *Napster*, A&M Records sued Napster with a theory of contributory copyright infringement, alleging that Napster facilitated copyright infringement by knowingly allowing users to share copyrighted music and audio recordings. *Id.* at 1010–11, 1020. Napster argued that it should be protected from liability through the DMCA’s safe harbor provision. *Id.* at 1025. The court disagreed, holding that there was sufficient evidence to conclude that Napster was liable for contributory infringement. *See id.* The court opined that “Napster materially contribute[d] to the infringing activity” because it had “knowledge, both actual and constructive, of direct infringement,” and failed to remove the infringing material. *Id.* at 1022. Taken together, these two cases stand for the proposition that an Internet service provider will not face liability if it takes certain steps to remove infringing content once brought to light, but that the Internet service provider could face liability if it induces or allows such infringement to occur without any takedown procedures in place. Daniel S. Schecter & Colin B. Vandell, *Safe Harbor Protection for Online Service Providers*, LAW360 (Aug. 12, 2010), [www.law360.com/articles/183778/safe-harbor-protection-for-online-service-providers](http://www.law360.com/articles/183778/safe-harbor-protection-for-online-service-providers) (“Judge Stanton [in *Viacom v. YouTube*] rejected Viacom’s arguments. After assessing the legislative history and cases decided under the DMCA, the court concluded that generalized knowledge was not enough to deprive a service provider of the safe harbor. Instead, Judge Stanton concluded that the Section 512(c) safe harbor for a service provider was available, unless the service provider had actual knowledge of specific and identifiable infringement, and did not then expeditiously act to remove or disable access to the infringing content. Such knowledge would arise from a ‘red flag,’ which most commonly takes the form of an explicit take-down notice sent by a copyright owner. If a service provider was aware of specific, ‘obviously’ infringing content that also would signal actual knowledge and create the take-down obligation under Section 512(c).”).

developed internal reporting systems designed to combat copyright and trademark infringement.<sup>126</sup> This, in theory, shields them from contributory infringement liability.<sup>127</sup> According to Twitter's Transparency Reports, it received over 53,000 DMCA copyright notices in 2015 alone, including both takedown requests and counter notices received.<sup>128</sup> This figure grew 89% from the previous year.<sup>129</sup> In the latter half of 2015, Twitter removed 71% of the allegedly infringing material.<sup>130</sup> Though it is clear that social media websites have incentive to remove material after it receives a takedown request, it is important that these websites not do so at the expense of fairness to the alleged infringer. Moreover, as will be seen later in this comment, sending a takedown request to the social media site is just one of many possible options available for use against an alleged infringer.<sup>131</sup>

### III. CURRENT OPTIONS AVAILABLE FOR USE AGAINST AN ALLEGED INFRINGER ON SOCIAL MEDIA

This section will discuss the three courses of action available to an owner whose intellectual property rights have been infringed on a social media website. First it will explore a first option: reporting the infringement directly to the social media website. Next, it will examine a second option: sending a cease-and-desist letter to the infringing party. Finally, it will assess a third option: commencing a lawsuit. Each subpart will delve into these alternate courses of action, discussing the advantages and disadvantages of each.

#### A. Reporting the Infringement Directly to the Social Media Website

Three of the leading social media websites—Facebook, Twitter, and YouTube—have implemented policies for the reporting and takedown of intellectual property infringement.<sup>132</sup> Reporting infringement directly to the social media website is inexpensive, easy, and quick—all good things for the intellectual property

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126. For a discussion on the various social media policies, see *infra* Part II(A).

127. For a discussion on contributory infringement liability, see *supra* notes 110–125, and accompanying text.

128. *Copyright Notices*, TRANSPARENCY REPORT, <https://transparency.twitter.com/copyright-notices/2015/jul-dec> (last visited Mar. 20, 2016).

129. *Id.*

130. *Id.*

131. For a discussion on the various courses of action available for use against an alleged infringer on social media, see *infra* Part II(A)–(C).

132. For a discussion on the various social media policies, see *infra* Part II(A)(1)–(3).

owner.<sup>133</sup> However, this option lacks transparency, which makes it unclear whether this option promotes fairness, accuracy in decisions, and consistency—all bad things for users and the general public.<sup>134</sup> The various policies differ on substantive issues; something might be considered a violation on Facebook, while being considered licit on Twitter.<sup>135</sup> As one scholar noted:

[T]he largest social media sites have vastly different approaches to username squatting and users' rights. The differing approaches to username disputes must logically lead to inconsistency of outcomes, although there is little data on the subject. At the very least, the inconsistency in approach to the subject renders planning and prediction nearly impossible for users desiring to protect their names or brands.<sup>136</sup>

Further, the policies are often vague and difficult to understand.<sup>137</sup> For example, Facebook states that submitting an infringement claim “*may* result in [the removal of] the reported content from Facebook,” but does not delve into what their seemingly voluntary decision making process entails.<sup>138</sup> Some have described the decision making process as a black box, as “only a few providers systematically release notices and none explicitly describe their procedures.”<sup>139</sup>

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133. Thomas J. Curtin, *The Name Game: Cybersquatting And Trademark Infringement On Social Media Websites*, 19 J.L. & POL'Y 353, 393 (2010) (stating that the process of reporting a username squatter directly to the website is “relatively inexpensive in comparison to litigating against the mark owner”).

134. This is because the law is undeveloped, and social media policies are confusing and contradictory. See Steve Levy, *Socially Unacceptable?*, FAIRWINDS PARTNERS BLOG (Sept. 29, 2014), <http://blog.fairwindspartners.com/brand-protection-social-media/socially-unacceptable-2> (mentioning that “[t]he patchwork of policies that arises from each site establishing its own procedures can be frustrating to trademark owners tasked with enforcing their marks”).

135. MCGRADY, *supra* note 1, § 12.03.

136. *Id.*

137. *Reporting Trademark Infringements*, FACEBOOK, [www.facebook.com/help/440684869305015/](http://www.facebook.com/help/440684869305015/) (last visited Jan. 7, 2016).

138. *Id.* This policy is ambiguous and vague. It is unclear whether or not Facebook will remove the infringing content upon a determination of a valid complaint, or whether such removal is purely optional.

139. Joséphine De Ruyck, *Global Project Looks At Takedown Notices Across The Internet*, INTELL. PROP. WATCH (July 23, 2014), [www.ip-watch.org/2014/07/23/global-project-looks-at-takedown-notices-across-the-internet/](http://www.ip-watch.org/2014/07/23/global-project-looks-at-takedown-notices-across-the-internet/). Multiple websites have made efforts to make this information more transparent. For example, Chilling Effects has created a database that collects and analyzes legal complaints and takedown requests in the online arena. CHILLING EFFECTS, [www.chillingeffects.org/](http://www.chillingeffects.org/) (last visited Jan. 7, 2016). The Takedown Project is a global collaborative initiative that studies how Internet websites handle notice-and-takedown procedures in instances of alleged online copyright infringement. THE TAKEDOWN PROJECT, <http://takedownproject.org/> (last visited Jan. 7, 2016). Legal Threats Database provides a database for “lawsuits, cease [and] desist letters, subpoenas, and other legal threats directed at those who engage in online speech.” *Legal*



### 1. Facebook

Facebook is the world's largest social media website, with over 1.5 billion monthly active users.<sup>140</sup> Facebook allows users—both people and entities—to create a profile, add other users as friends, post status updates, share videos and photos, send and receive private messages, join groups, and “like” pages.<sup>141</sup> Facebook has implemented certain policies to try to combat trademark and copyright infringement.<sup>142</sup>

Facebook does not allow users to “post content or take any action on Facebook that infringes or violates someone else’s rights or otherwise violates the law.”<sup>143</sup> Facebook reserves the right to remove any content posted on Facebook if it appears to violate any of Facebook’s policies.<sup>144</sup> Although users are encouraged to resolve any issues directly with those involved in the dispute, Facebook allows users to report trademark and copyright infringement to Facebook itself by submitting an infringement claim.<sup>145</sup> Facebook reserves the right to remove any reported content from its website, but will restore such content if the alleged infringing user contacts Facebook (by filling out an online form) and Facebook determines that the content should not have been removed.<sup>146</sup> Further,

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*Threats Database*, DIGITAL MEDIA LAW PROJECT, [www.dmlp.org/database](http://www.dmlp.org/database) (last visited Jan. 7, 2016).

140. *Social Media Comparison Infographic*, LEVERAGE (Sept. 1, 2015), <https://leveragenewagemedia.com/blog/social-media-infographic/>.

141. See generally FACEBOOK, [www.facebook.com/](http://www.facebook.com/) (last visited Jan. 7, 2016).

142. As previously discussed, intellectual property infringement is abundant on Facebook. See *supra* Part I. For example, one article states that “[c]opyright infringement on Facebook is quite simply ‘out of control,’” and details what it describes as a “copyright infringement epidemic.” Rob Price, *Facebook’s Copyright Infringement Epidemic*, THE DAILY DOT (Oct. 29, 2014), [www.dailydot.com/entertainment/facebook-video-content-id-copyright-infringement/](http://www.dailydot.com/entertainment/facebook-video-content-id-copyright-infringement/).

143. See *Statement of Rights and Responsibilities*, FACEBOOK, [www.facebook.com/legal/terms](http://www.facebook.com/legal/terms) (last visited Jan. 7, 2016).

144. See *id.* (stating “[w]e can remove any content or information you post on Facebook if we believe that it violates this Statement or our policies.”).

145. See *About Copyright*, Facebook, [www.facebook.com/help/249141925204375?helpref=page\\_content](http://www.facebook.com/help/249141925204375?helpref=page_content) (last visited Sept. 4, 2016) (“If you believe someone is using your copyrighted work without your permission, you may wish to fill out this [infringement] form. You can also contact our designated agent. In that case, please be sure to include a complete copyright claim in your report. Keep in mind that you don’t need a Facebook account to submit a report. Before you report a claim of copyright infringement, you may want to send a message to the person who posted the content. You may be able to resolve the issue without contacting Facebook.”). See also *About Trademark*, Facebook, [www.facebook.com/help/249141925204375?helpref=page\\_content](http://www.facebook.com/help/249141925204375?helpref=page_content) (last visited Sept. 4, 2016).

146. See *Reporting Trademark Infringements*, FACEBOOK, [www.facebook.com/help/440684869305015/](http://www.facebook.com/help/440684869305015/) (last visited Jan. 7, 2016) (“If the content is removed based on United States trademark rights, they will also be able to contact Facebook directly if they believe the content should not have

Facebook has discretion to disable the accounts of recidivist infringers on its website.<sup>147</sup>

With regard to username squatters and impersonation accounts, Facebook has a zero tolerance policy.<sup>148</sup> In its *Statement of Rights and Responsibilities*, Facebook explains that its users cannot falsify any personal information on their Facebook account or create an account for anyone other than themselves without permission.<sup>149</sup> Further, Facebook reserves the right to remove a username that violates a trademark right and does not closely relate to the user's actual name.<sup>150</sup> A squatter can be reported by either going to the imposter's profile and clicking "report," or by filling out a complaint form on Facebook's Help Center.<sup>151</sup>

One example in particular gives a brief glimpse into Facebook's removal system. In September of 2012, Facebook permanently deleted "The Cool Hunters" Facebook page for copyright infringement.<sup>152</sup> The Page's 788,000 fans and 1,500–2,500 daily

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been removed. Our team will review their submission, and if we determine that the content should not have been removed, we will restore it and notify you that we have restored that content."). See also *About Copyright*, FACEBOOK, *supra* note 145 ("If we remove your content because of a copyright claim, you'll receive a warning from Facebook that includes the contact information of the person or company who made the report and/or the contents of the report. If you believe the content should not have been removed, you can follow up with them directly to try to resolve the issue. If the content was removed under the notice and counter-notice procedures of the United States Digital Millennium Copyright Act (DMCA), then you will be able to file a DMCA counter-notification. If that is the case, you will also receive further instructions about this process in the warning you receive from Facebook.").

147. See FACEBOOK (Statement of Rights and Responsibilities), *supra* note 143 (stating that "[i]f you repeatedly infringe other people's intellectual property rights, [Facebook] will disable your account when appropriate.").

148. See FACEBOOK (Statement of Rights and Responsibilities), *supra* note 143 (mentioning that Facebook "reserve[s] the right to remove or reclaim" any account if it deems appropriate).

149. *Id.* (stating "[y]ou will not provide any false personal information on Facebook, or create an account for anyone other than yourself without permission").

150. See *id.* (mentioning that "[i]f you select a username or similar identifier for your account or Page, we reserve the right to remove or reclaim it if we believe it is appropriate (such as when a trademark owner complains about a username that does not closely relate to a user's actual name)").

151. *How Do I Report A Fake Account That's Pretending to be me?*, FACEBOOK, [www.facebook.com/help/174210519303259](http://www.facebook.com/help/174210519303259) (last visited Jan. 7, 2016) (describing the different options a person can take to report a username squatter).

152. Emil Protalinski, *Facebook confirms it shut down The Cool Hunter's Facebook Page over copyright infringement*, TNW NEWS (Oct. 5, 2012, 12:09 AM), <http://thenextweb.com/facebook/2012/10/05/facebook-confirms-it-shut-down-the-cool-hunters-facebook-page-over-copyright-infringement/>.

likes were lost in an instant.<sup>153</sup> The Page's founder, Bill Tikos, took to the Internet in frustration to explain what had happened:

No explanation, flimsy warnings, no instructions on what to do next. None of our numerous attempts to rectify the situation and resurrect the page have worked. And because we suspect there are other businesses in the same bind, we are writing this to seek help and encourage open conversation. This is not a minor problem. This is a huge issue and potentially fatal to businesses. We feel that FB must change its one-sided, secret policies and deal with us, and others like us, openly and fairly.<sup>154</sup>

Although Tikos got his account restored briefly, it was quickly terminated again—this time permanently.<sup>155</sup> Facebook stated that “[t]his account has been disabled due to repeat copyright infringement under our terms and the account has been removed from the site accordingly. Additionally, we have thoroughly reviewed all related reports and have determined that we took the correct action in this case.”<sup>156</sup> Tikos claims that he has no idea why his page was deleted, although he thinks it might have to do with the fact that his page “sometimes use[d] images even when [it did] not know who ha[d] taken the picture.”<sup>157</sup> Even if that was a valid reason for Facebook's removal of his page, it is troubling that Facebook never once told Tikos why his Page was being removed and never once gave him the opportunity to respond to any accusations of infringement. This lack of transparency is unacceptable. Though it might be more cost-effective, quick, and easy for the social media site, it does so at the expense of transparency and fairness to the alleged infringer and the public at large.

## 2. Twitter

Twitter is a social media website that allows users to publicly blog by “Tweeting” pictures and messages in fewer than 140 characters.<sup>158</sup> To send a Tweet, a user must create a Twitter account by selecting a unique Twitter handle.<sup>159</sup> Users can customize their homepages by posting a profile picture and writing a blurb about themselves.<sup>160</sup> Twitter has over 289 million active users, and 9,100

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153. Michael Zhang, *Facebook Shuttering Massive Pages for Violating Photo Copyrights*, PETAPIXEL (Oct. 8, 2012), <http://petapixel.com/2012/10/08/facebook-shuttering-massive-pages-for-violating-photo-copyrights/>; Protalinski, *supra* note 152.

154. Protalinski, *supra* note 152.

155. *Id.*

156. *Id.*

157. *Id.*

158. *See generally* TWITTER, <https://twitter.com/> (last visited Jan. 7, 2016).

159. *Id.*

160. *Id.* Many celebrities use Twitter. *See Twitter Top 100 Most Followers*, TWITTER COUNTER, [http://twittercounter.com/pages/100?utm\\_exp](http://twittercounter.com/pages/100?utm_exp)

Tweets a second.<sup>161</sup> Twitter has adopted a number of policies that try to combat trademark and copyright infringement on its website.<sup>162</sup>

Under its *Trademark Policy*, Twitter states that “[u]sing a company or business name, logo, or other trademark-protected materials in a manner that may mislead or confuse others with regard to its brand or business affiliation may be considered a trademark policy violation.”<sup>163</sup> Twitter reserves the right to reclaim or suspend any account that uses the trademarked name or logo of a business or individual in a manner that misleads others.<sup>164</sup> However, Twitter “may” give the account holder an opportunity to clear up any confusion before doing so.<sup>165</sup> Interestingly, while Facebook does not require a trademark to be registered to take action against an infringer, such registration is a necessity on Twitter.<sup>166</sup>

Twitter reserves the right to remove any content that violates a copyright “without prior notice, at [its] sole discretion, and without liability.”<sup>167</sup> Such copyright infringement can take the form

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=102679131-65.MDYnsQdXQwO2AlKoJXVpSQ.0&utm\_referrer=https%3A%2F%2Fwww.google.com%2F (last visited Jan. 7, 2016). Katy Perry (@katyperry) is the most followed Twitter user, with over 81 million followers. *Id.* Justin Bieber (@justinbieber) is second with north of 73.5 million followers. *Id.* Rounding out the top 10 is Taylor Swift (@taylorswift13), Barrack Obama (@BarrackObama), YouTube (@YouTube), Rihanna (@rihanna), The Countess (@ladygaga), Ellen DeGeneres (@TheEllenShow), Justin Timberlake (@jtimberlake), and Twitter (@twitter). *Id.*

161. See Leverage (Infographic), *supra* note 140.

162. For a further discussion of this issue, see *infra* notes 163–93, and accompanying text.

163. *Trademark Policy*, TWITTER (updated June 30, 2016), <https://support.twitter.com/articles/18367> (last visited Jan. 7, 2016).

164. *The Twitter Rules*, TWITTER, <https://support.twitter.com/articles/18311> (last visited Jan. 7, 2016) (stating “[w]e reserve the right to reclaim usernames on behalf of businesses or individuals that hold legal claim or trademark on those usernames. Accounts using business names and/or logos to mislead others may be permanently suspended”).

165. See *id.* (mentioning “[w]hen we determine that an account appears to be confusing users, but is not purposefully passing itself off as the trademarked good or service, we give the account holder an opportunity to clear up any potential confusion”).

166. *Id.* Twitter states that it will review an account when it receives a trademark violation report from a “trademark holder.” *Id.* When filling out a Trademark Report Form on Facebook, the form allows you to continue even if you do not have a registered trademark but instead have some “other basis for trademark rights.” *Trademark Report Form*, FACEBOOK, [www.facebook.com/help/contact/284186058405647](http://www.facebook.com/help/contact/284186058405647) (last visited Jan. 7, 2016).

167. *Twitter Terms of Service*, TWITTER, <https://twitter.com/tos> (last visited Jan. 7, 2016). To report a copyright violation, the claimant must provide Twitter with the following information: “(i) a physical or electronic signature of the copyright owner or a person authorized to act on their behalf; (ii) identification of the copyrighted work claimed to have been infringed; (iii) identification of the material that is claimed to be infringing or to be the subject of infringing activity and that is to be removed or access to which is to be disabled, and information

of “the unauthorized use of a copyrighted image as a profile photo, header photo, or background . . . the unauthorized use of a copyrighted video or image uploaded through [the] media hosting services, or Tweets containing links to allegedly infringing materials.”<sup>168</sup>

If Twitter decides to remove or restrict user content in response to an infringement allegation, Twitter will “make a good faith effort” to notify the account holder and provide him or her with a copy of the takedown notice and information regarding how to file a counter-notification.<sup>169</sup> Twitter will send a copy of any counter-notification to the intellectual property owner who complained about the infringement.<sup>170</sup> Afterward, unless Twitter receives notice that the infringed owner is seeking a court order to prevent any further infringement within 10 days, Twitter may restore the blocked or restricted content.<sup>171</sup>

Twitter does not allow users to engage in username squatting.<sup>172</sup> However, “[u]sers are allowed to create parody, newsfeed, commentary, and fan accounts on Twitter.”<sup>173</sup> Twitter will investigate any account that is reported to be an impersonation

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reasonably sufficient to permit [Twitter] to locate the material; (iv) [the claimant’s] contact information, including [his] address, telephone number, and an email address; (v) a statement by [the claimant] that [he] ha[s] a good faith belief that use of the material in the manner complained of is not authorized by the copyright owner, its agent, or the law; and (vi) a statement that the information in the notification is accurate, and, under penalty of perjury, that [the claimant is] authorized to act on behalf of the copyright owner.” *Id.*

168. *Copyright and DMCA Policy*, TWITTER, <https://support.twitter.com/articles/15795> (last visited Jan. 7, 2016).

169. *See id.* (stating “Twitter’s response to notices of alleged copyright infringement may include the removal or restriction of access to allegedly infringing material. If we remove or restrict access to user content in response to a notice of alleged infringement, Twitter will make a good faith effort to contact the affected account holder with information concerning the removal or restriction of access, including a copy of the takedown notice, along with instructions for filing a counter-notification”).

170. *Id.*

171. *Id.* (noting “[u]pon receipt of a valid counter-notice, we will promptly forward a copy to the person who filed the original notice. If we do not receive notice within 10 business days that the original reporter is seeking a court order to prevent further infringement of the material at issue, we may replace or cease disabling access to the material that was removed”).

172. *See* TWITTER (The Twitter Rules), *supra* note 164. When determining whether certain conduct constitutes username squatting, Twitter will take into account factors such as: “the number of accounts created... creating accounts for the purpose of preventing others from using those account names... creating accounts for the purpose of selling those accounts . . . [and] using feeds of third-party content to update and maintain accounts under the names of those third parties.” *Id.* Additionally, “[a]ccounts that are inactive for more than six months may also be removed without further notice.” *Id.*

173. *Parody, Comedy, and Fan Account Policy*, TWITTER, <https://support.twitter.com/articles/106373%20> (last visited Jan. 7, 2016).

account to determine whether it violates Twitter's rules.<sup>174</sup> To comply with Twitter's parody policy, "[t]he avatar should not be the exact trademark or logo of the account subject . . . [and] the name should not be the exact name of the account subject without some other distinguishing word, such as 'not,' 'fake,' or 'fan.'"<sup>175</sup> It should be clear from the account's profile information that the account is not actually the company or business that the account is commenting on or parodying.<sup>176</sup>

If an account is determined to be in violation of Twitter's impersonation policy, Twitter will either suspend the account or ask the account holder to update the account so that it complies with Twitter's policies.<sup>177</sup> Twitter reserves the right to permanently suspend the accounts of any recidivist infringers.<sup>178</sup> Selling usernames is strictly prohibited.<sup>179</sup>

Twitter's policies can be extremely effective in resolving trademark and copyright disputes. For example, StartupNation, an online website that assists users in starting a business, wrote an article in 2009 detailing Twitter's response to a username squatter.<sup>180</sup> The article discussed how someone created a Twitter

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174. See *Reporting Impersonation Accounts*, TWITTER, <https://support.twitter.com/groups/56-policies-violations/topics/238-report-a-violation/articles/20170142-reporting-impersonation-accounts> (last visited Jan. 7, 2016) (stating "[u]pon receipt of an impersonation report, we will investigate the reported accounts to determine if the accounts are in violation of the Twitter Rules. Accounts determined to be in violation of our impersonation policy, or those not in compliance with our parody, commentary, and fan account policy, will either be suspended or asked to update the account(s) so they no longer violate our policies").

175. TWITTER, *supra* note 173. For example, the Twitter account "Not Mark Zuckerberg" (@notzuckerberg) is not in violation of Twitter policies even though it is accompanied by a picture of Mark Zuckerberg, Facebook's founder. See Not Mark Zuckerberg (@notzuckerberg), TWITTER, <https://twitter.com/notzuckerberg>.

176. TWITTER, *supra* note 163. For example, the fact that the Twitter account for "Bored Elon Musk" (@BoredElonMusk) states that "[t]his is a futuristic hyper-parody account" in its account profile information probably satisfies this requirement. See Bored Elon Musk (@BoredElonMusk), TWITTER, <https://twitter.com/BoredElonMusk>.

177. See TWITTER (Reporting Impersonation Accounts), *supra* note 174 (stating "[a]ccounts determined to be in violation of our impersonation policy, or those not in compliance with our parody, commentary, and fan account policy, will either be suspended or asked to update the account(s) so they no longer violate our policies").

178. See TWITTER, *supra* note 175 ("When we receive a valid impersonation or trademark report about an account that violates our parody policy, we temporarily suspend the account and may give the user the opportunity to come into compliance. Accounts with a history of repeated violations may be permanently suspended.").

179. See TWITTER *supra* note 164 (mandating that "[y]ou may not buy or sell Twitter usernames").

180. Rich Sloan, *How Someone Ripped off Our Twitter Name and We Fought Back*, STARTUP NATION (Aug. 2, 2009), [www.startupnation.com/start-your-business/launch-your-invention/how-someone-ripped-off-our-twitter-name-](http://www.startupnation.com/start-your-business/launch-your-invention/how-someone-ripped-off-our-twitter-name-)

account with the name “StartupNation” and was pretending to be the actual StartupNation.<sup>181</sup> This imposter “built followers who thought they were getting Tweets from StartupNation when it was really a poser who had his own agenda to develop his own following using [StartupNation’s] name, content, branding in the market, etc.”<sup>182</sup> StartupNation sent the imposter a direct message, to which he responded that he would transfer the account for \$15,000.<sup>183</sup> StartupNation then reported the imposter to Twitter.<sup>184</sup> Twitter responded within 48 hours, asking for confirmation that StartupNation owned the trademark for use of its name.<sup>185</sup> After providing Twitter with proof, Twitter, within days, transferred the account to StartupNation.<sup>186</sup>

Twitter’s policies, when used correctly, can be very effective; however, Twitter’s response to takedown requests has been sporadic. In an example discussed earlier, we saw a photographer sue Twitter after it failed to take action in response to her sending Twitter 28 DMCA takedown requests.<sup>187</sup> In a similar lawsuit, artist Christopher Boffoli sued Twitter for copyright infringement after it failed to act on a DMCA takedown request he sent the site.<sup>188</sup> Yet once the lawsuit was filed, Twitter removed the infringing material.<sup>189</sup> Compare this to the instance in which Olga Lexell, a freelance writer, filed a DMCA takedown request with Twitter, reporting that multiple users had copied and reposted a joke that she had originally tweeted in July of 2015.<sup>190</sup> Twitter promptly

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and-we-fought-back/.

181. *See id.* (mentioning “not only was someone squatting on our name on Twitter, but that person was periodically linking to content at our site and acting as if he was us”).

182. *Id.*

183. *Id.* The imposter wrote: “I am asking for \$15,000 to be transferred into my PayPal account (r[xxxxxxx]@gmail.com) at which point I will assign ‘startupnation’ twitter user name to an email account of your choice.” *Id.*

184. *Id.*

185. *See id.* (stating “Twitter responded within 48 hours asking for confirmation that StartupNation owned the trademark for use of our name, which I produced for them by visiting [www.uspto.gov](http://www.uspto.gov), searching for our Trademark, and sending them the direct link confirming assignment to us”).

186. *See id.* (mentioning that “[w]ithin days, Twitter took action. They booted the poser and returned the rights to use ‘StartupNation’ on Twitter to us”).

187. *See supra* notes 85–92, and accompanying text.

188. John Brodtkin, *Artist who sued Twitter over copyright declares victory—via settlement*, ARS TECHNICA (Nov. 2, 2012, 3:15 PM), <http://arstechnica.com/tech-policy/2012/11/artist-who-sued-twitter-over-copyright-declares-victory-via-settlement/>.

189. *See id.* (explaining that “suddenly, the pictures have been removed, with messages stating ‘This image has been removed in response to a report from the copyright holder.’ And Boffoli has withdrawn his lawsuit, saying the case has been resolved to his satisfaction”).

190. Lorenzo Ligato, *You Can’t Steal Jokes On Twitter Anymore*, HUFFINGTON POST (July 27, 2015, 05:15PM), [www.huffingtonpost.com/entry/dont-steal-jokes-on-twiter\\_us\\_55b67147e4b0224d88331c6d/](http://www.huffingtonpost.com/entry/dont-steal-jokes-on-twiter_us_55b67147e4b0224d88331c6d/).

responded to Lexell's takedown request by deleting the allegedly infringing posts.<sup>191</sup> This non-uniform application of Twitter's policies is concerning. To be a viable dispute resolution mechanism, Twitter must strive to be more uniform and transparent in its decision making process.

### 3. YouTube

YouTube is the world's most popular online video platform, hosting both user-generated and professional content.<sup>192</sup> Videos on the website cover a wide range of topics, such as music videos, television clips, video blogs, and educational videos.<sup>193</sup> YouTube has more than one billion users uploading over 400 hours of videos every minute.<sup>194</sup> YouTube has implemented an array of policies that aim to curtail trademark and copyright infringement.<sup>195</sup>

YouTube reserves the right to remove content that violates a trademark right.<sup>196</sup> Although using someone else's trademark in a username, tag, or title does not constitute infringement per se, content that confuses viewers into "believing that the trademark owner created or sponsors" the content may constitute trademark infringement.<sup>197</sup> A trademark owner who believes that its trademark is being infringed is "strongly encouraged" to resolve the dispute directly with the user who posted the allegedly infringing content.<sup>198</sup> YouTube states that it is "not in a position to mediate

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191. *Id.* (explained in the video clip).

192. *Statistics and Facts About YouTube*, STATISTA (Jan. 2015), [www.statista.com/topics/2019/youtube/](http://www.statista.com/topics/2019/youtube/).

193. *See generally* YouTube, [www.youtube.com/](http://www.youtube.com/) (last visited Jan. 7, 2016). Google purchased YouTube for \$1.65 billion in 2006. *See* Associated Press, *Google Buys YouTube for \$1.65 Billion*, NBC NEWS (Oct. 10, 2006), [www.nbcnews.com/id/15196982/ns/business-us\\_business/t/google-buys-youtub-e-billion/#.VpxLiJMrKCQ](http://www.nbcnews.com/id/15196982/ns/business-us_business/t/google-buys-youtub-e-billion/#.VpxLiJMrKCQ). At the time of the sale, it was "by far the most expensive purchase made by Google during its eight-year history." *See id.* Google has since had larger acquisitions, such as its purchase of Motorola in 2011 for \$12.5 billion. *See* Zach Epstein, *Google Bought Motorola for \$12.5B, Sold it for \$2.9B, and Called the Deal 'A Success'*, BGR (Feb. 14, 2014), <http://bgr.com/2014/02/13/google-motorola-sale-interview-lenovo/>.

194. *Statistics*, YOUTUBE, [www.youtube.com/yt/press/statistics.html](http://www.youtube.com/yt/press/statistics.html) (last visited Jan. 7, 2016).

195. For a more detailed examination of YouTube's various policies, see *infra* notes 196–217, and accompanying text.

196. *Legal Policies*, YOUTUBE, <https://support.google.com/youtube/answer/2801979> (last visited Jan. 7, 2016).

197. *See id.* ("Using someone else's trademark in a username, tags, or the title of your video does not necessarily constitute infringement. However, if there is content on your profile or video that would confuse viewers into believing that the trademark owner created or sponsors your page or content, then the trademark owner's rights may be infringed. In these cases, we may remove the content in question, so it's important to be sensitive to other people's trademark rights when choosing a username or adding metadata to your videos.")

198. *Id.* ("If you are a trademark owner and you believe your trademark is



trademark disputes between users and trademark owners.”<sup>199</sup> If users are not able to resolve their dispute privately, a trademark holder can fill out YouTube’s trademark claim form.<sup>200</sup> If the complaint is reasonable, YouTube will conduct a limited investigation and will remove content in cases of obvious infringement.<sup>201</sup> However, YouTube fails to delve into what “reasonable,” “limited investigation,” or “obvious infringement” entail.<sup>202</sup>

With regard to copyrights, a “copyright owner or an agent authorized to act on the owner’s behalf” can submit a copyright infringement notification if its copyrighted work is posted on YouTube without its authorization.<sup>203</sup> A user affected by a copyright claim can try to get the owner to retract its infringement claim by messaging that owner directly.<sup>204</sup> However, it is unclear whether YouTube allows users to file a formal counter-notification with the website.<sup>205</sup>

With regard to impersonation, YouTube states that “[a]ctivities such as copying a user’s channel layout, using a similar username, or posing as another person in comments, emails, or videos” may violate YouTube’s policies.<sup>206</sup> An account will be

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being infringed, please note that YouTube is not in a position to mediate trademark disputes between users and trademark owners. As a result, we strongly encourage trademark owners to resolve their disputes directly with the user who posted the content in question. Contacting the uploader may allow for a quicker resolution to your claim in a way that is beneficial to you, the uploader, and the YouTube community. Trademark owners can contact the user through YouTube’s private messaging feature or you can submit a complaint directly to the uploader through our Trademark complaint form.”). *Id.*

199. *Id.*

200. *See id.* (directing users that “[i]f you are unable to reach a resolution with the account holder in question, please submit a trademark claim through our Trademark complaint form”).

201. *See id.* (stating “YouTube is willing to perform a limited investigation of reasonable complaints and will remove content in cases of clear infringement”).

202. *Id.* The terms are never defined on YouTube’s website.

203. *See* Submit a Copyright Takedown Notice, YOUTUBE, <https://support.google.com/youtube/answer/2807622?hl=en> (last visited Jan. 7, 2016) (mentioning “[i]f you believe your copyright-protected work was posted on YouTube without authorization, you may submit a copyright infringement notification. These requests should only be submitted by the copyright owner or an agent authorized to act on the owner’s behalf”).

204. *See* Retract a Claim of Copyright Infringement, YOUTUBE, <https://support.google.com/youtube/answer/2807691?hl=en> (last visited Jan. 7, 2016) (stating “[i]f you’re a user affected by a copyright claim, you may reach out to the copyright owner directly in search of a retraction. If the claimant has a YouTube account, the easiest way to contact them is through YouTube’s private messaging feature”).

205. *Id.*

206. *Impersonation*, YOUTUBE, <https://support.google.com/youtube/answer/2801947> (last visited Jan. 7, 2016).

removed if YouTube determines that it was established to impersonate another channel or individual.<sup>207</sup>

YouTube sets itself apart from the other social media websites by allowing copyright holders to proactively protect their copyrighted work.<sup>208</sup> A copyright holder who meets certain criteria can qualify for a Content ID.<sup>209</sup> Through this Content ID system, “[v]ideos uploaded to YouTube are scanned against a database of files that have been submitted to [YouTube] by content owners.”<sup>210</sup> For example, if Universal Music Group owns the rights to Prince’s song “Let’s go Crazy,” it can register that song so that it is flagged whenever a video is uploaded to YouTube containing a portion of the song. The copyright owner can choose which action to take if its copyrighted audio or video clip is being used in an unauthorized video.<sup>211</sup> Such “action varies from work to work and can include blocking the uploaded video, tracking its use or monetizing the content.”<sup>212</sup>

YouTube’s Content ID system has been controversial. For example, in 2007, Stephanie Lenz uploaded a 29-second video to YouTube of her young son dancing to the Prince song “Let’s go Crazy.”<sup>213</sup> Shortly thereafter, Prince’s YouTube management

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207. *Id.* YouTube considers two types of impersonation. *Id.* First, impersonation of a channel occurs when “[a] user copies a channel’s profile, background, or text, and writes comments to make it look like somebody else’s channel posted the comments. *See id.* Second, impersonation of an individual occurs is “[a] user creates a channel or video using another individual’s real name, image, or other personal information to deceive people into thinking they are someone else on YouTube.” *See id.* Both of these types of impersonation can be reported directly to YouTube. *See id.* Interestingly, YouTube does not allow complaints for “channels or videos pretending to represent a business.” *See id.* If a channel impersonates a business, YouTube states that the infringed “may want to consider submitting a legal complaint via [YouTube’s] legal reporting forms.” *See id.*

208. *How Content ID Works*, YOUTUBE, <https://support.google.com/youtube/answer/2797370?hl=en> (last visited Jan. 7, 2016).

209. *Id.* Though YouTube’s website does not list the criteria, it states that “[c]ontent ID acceptance is based on an evaluation of each applicant’s actual need for the tools,” and that “applicants may be rejected if other tools better suit their needs.” *Qualifying for Content ID*, YOUTUBE, <https://support.google.com/youtube/answer/1311402> (last visited Jan. 7, 2016).

210. YOUTUBE, *supra* note 208.

211. *Id.* YouTube’s Content ID system has many flaws. *See* Jonathan Bailey, *9 Questions and Answers Regarding YouTube and Content ID*, PLAGIARISM TODAY (Dec. 23, 2013), [www.plagiarismtoday.com/2013/12/23/9-questions-answers-regarding-youtube-content-id/](http://www.plagiarismtoday.com/2013/12/23/9-questions-answers-regarding-youtube-content-id/). For example, one article states that “Content ID is an automated process and isn’t able to make determinations of fair use.” *See id.* “Even though many of the uses being trapped by Content ID are almost certainly clear fair uses, Content ID, nor anyone else really [other than a court of law], can make that determination definitively.” *Id.*

212. *Id.*

213. Sam Gutelle, “Dancing Baby” Woman Wins Fair Use Decision Against Universal Music Group, TUBEFILTER (Sept. 14, 2015), [www.tubefilter.com/2015/09/14/stephanie-lenz-lawsuit-universal-music-grou](http://www.tubefilter.com/2015/09/14/stephanie-lenz-lawsuit-universal-music-grou)

company, Universal Music Group, requested through the Content ID system that Lenz remove the video.<sup>214</sup> Lenz responded by initiating lawsuit against Universal, a decision that put in motion seven years of appeals.<sup>215</sup> In affirming the District Court's ruling in favor of Lenz, the Ninth Circuit Court of Appeals stated that "[c]opyright holders cannot shirk their duty to consider—in good faith and prior to sending a takedown notification—whether allegedly infringing material constitutes fair use."<sup>216</sup> Although the immediate impact of this case is still uncertain, it seems to question the legal validity of a Content ID system that allows for the removal of material without a proper fair use analysis.

YouTube's internal policies, like those of Facebook and Twitter, make removing content cheap and inexpensive for trademark and copyright owners.<sup>217</sup> However, this comes at the expense of transparency, uniformity, and fairness in decisions. Though Universal may be in favor of such policies, surely Lenz and her young son would oppose them.

### B. Sending a Cease-and-Desist Letter

In addition to reporting the infringement to the social media website, an intellectual property owner can also send a cease-and-desist letter directly to the infringing party.<sup>218</sup> A cease-and-desist letter, also called a demand letter, informs a recipient of its illegal activity and demands that it stop using the intellectual property.<sup>219</sup> There may also be a demand for money to cover lost profits, unjust enrichment, and/or attorneys' fees.<sup>220</sup> Cease-and-desist letters are frequently used in intellectual property disputes.<sup>221</sup> The letter typically serves as the first form of contact between the parties.<sup>222</sup>

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214. *Id.*

215. *Id.*

216. *Lenz v. Universal Music Corp.*, 801 F.3d 1126, 1138 (9th Cir. 2015).

217. For a discussion on the internal policies of Facebook, Twitter, and Youtube, see *infra* Part II(A)(1)-(3).

218. Marketa Trimble, *Setting Foot on Enemy Ground: Cease-and-Desist Letters*, DMCA NOTIFICATIONS AND PERS. JURISDICTION IN DECLARATORY JUDGMENT ACTIONS, 50 IDEA 777, 784 (2010).

219. *Cease-and-Desist Letter*, BLACK'S LAW DICTIONARY (9th ed. 2009).

220. *Id.*

221. See Trimble, *supra* note 218, at 784 (stating "[a]lthough not exclusive to the area of intellectual property, cease-and-desist letters are frequently utilized in disputes concerning intellectual property and represent an important feature of the intellectual property law landscape").

222. Michael J. McCue, *The Letters of the Law: Sending Cease and Desist Letters*, 10 NEV. LAW. 23 (2002).

A cease-and-desist letter has many beneficial functions.<sup>223</sup> First, it can operate as a coercive mechanism that causes the infringing party to remove the infringing material for fear of litigation.<sup>224</sup> Second, it can set in motion a licensing negotiation or settlement agreement.<sup>225</sup> Finally, it puts the infringer on notice of the allegation and can help a plaintiff prove willful infringement (which can increase damages and attorneys' fees) if the infringing party continues to use the intellectual property.<sup>226</sup> For these reasons, sending a cease-and-desist letter is often very effective and

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223. *See id.* (stating that cease-and-desist letters “may have a number of effects: they may be instrumental in commencing settlement negotiations or serve as an impetus for licensing discussions; in patent cases they may trigger the filing of reexamination requests or declaratory judgment actions and assist in eliminating ‘bad’ patents from some of the overpatented fields of technology. Letters may also mobilize their addressees to take steps in preparation for a potential lawsuit and initiate development of alternative brands, products, and design-around technologies”); *see also* McCue, *supra* note 222 (“[T]here are several benefits to sending a pre-suit cease and desist letter: (1) the letter may result in the recipient’s compliance with the demand or a settlement without incurring the expense or uncertainty of a lawsuit; (2) the letter may result in the recipient’s disclosure of its position and give the sender and its counsel the opportunity to evaluate the merits of its case prior to deciding whether to file suit; and (3) if the recipient does not cease its illegal conduct in response to the letter, the sender may have a better chance of establishing that the recipient’s conduct is willful, which may affect the ability to obtain an award of punitive damages. Moreover, courts have expressed disfavor towards plaintiffs who commence litigation without first sending a cease and desist letter.”).

224. *See* Trimble, *supra* note 218, at 784. While most cease-and-desist letters take a firm stance that can scare the recipient into removing the infringing material, others can take a more lighthearted approach. Debra Weiss, *Jack Daniel’s Cease-and-Desist Letter Goes Viral for Being Exceedingly Polite*, ABA JOURNAL (July 26, 2012), [www.abajournal.com/news/article/jack\\_daniels\\_ceaseanddesist\\_letter\\_goes\\_viral\\_for\\_being\\_exceedingly\\_poli/](http://www.abajournal.com/news/article/jack_daniels_ceaseanddesist_letter_goes_viral_for_being_exceedingly_poli/). For example, in 2012, Jack Daniels got positive publicity after sending a cease-and-desist letter to a satirical author who used an edited picture of the whisky label on her book cover. *See id.* The letter read: “We are certainly flattered by your affection for the brand, but while we can appreciate the pop culture appeal of Jack Daniel’s, we also have to be diligent to ensure that the Jack Daniel’s trademarks are used correctly. Given the brand’s popularity, it will probably come as no surprise that we come across designs like this on a regular basis. What may not be so apparent, however, is that if we allow uses like this one, we run the very real risk that our trademark will be weakened. As a fan of the brand, I’m sure that is not something you intended or would want to see happen. . . . In order to resolve this matter, because you are both a Louisville ‘neighbor’ and a fan of the brand, we simply request that you change the cover design when the book is re-printed. If you would be willing to change the design sooner than that (including on the digital version), we would be willing to contribute a reasonable amount towards the costs of doing so.” *See id.*

225. Trimble, *supra* note 218, at 784.

226. *See* USPTO, *supra* note 9 (stating that if you do not respond to a cease-and-desist letter and “are later found liable for infringement, the court may determine that you acted recklessly and subject you to additional monetary damages”).

easy for intellectual property owners, who may willingly support a system that has some frivolous and abusive claims, if that system results in the speedy and inexpensive removal of the infringing material.<sup>227</sup>

However, sending a cease-and-desist letter is not always effective for an intellectual property owner.<sup>228</sup> A cease-and-desist letter has no judicial backing; it is often the first step an intellectual property owner takes, and merely threatens subsequent legal action if the accused party does not refrain from continuing the allegedly illegal behavior.<sup>229</sup> Though it may help a plaintiff prove willful infringement, there are often no repercussions—other than the threat of further legal action—for a party that refuses to respond or take action after receiving a cease-and-desist letter.<sup>230</sup> Because of this, reporting the infringement directly to the social media website might be more effective than sending a cease-and-desist letter.<sup>231</sup>

Additionally, it may be difficult to determine to whom the cease-and-desist letter should be sent.<sup>232</sup> An infringed party has to try to ascertain the infringer's home or business address and send the cease-and-desist letter there.<sup>233</sup> Although this might not be a problem if the infringing party provides accurate contact

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227. See Trimble, *supra* note 218, at 784.

228. Elizabeth L. Rosenblatt, *Fear And Loathing: Shame, Shaming, And Intellectual Property*, 63 DEPAUL L. REV. 1, 26 (2013) (discussing some of the negative aspects to sending a cease-and-desist letter, such as the negative attention the sending party receives); see also McCue, *supra* note 225 (“Although there are several benefits to sending a cease and desist letter, there are also several risks: (1) the cease and desist letter may trigger a declaratory judgment action in an unfavorable forum; (2) the cease and desist letter may form the basis for liability; or (3) the cease and desist letter may contain inadvertent omissions. This article explores the pitfalls of sending cease and desist letters in the context of intellectual property disputes in federal practice, but the principles are generally applicable to all areas of practice.”).

229. See Trimble, *supra* note 220, at 784.

230. See USPTO, *supra* note 9 (stating that you do not need to respond to a cease-and-desist letter; however, if you do not respond and “are later found liable for infringement, the court may determine that you acted recklessly and subject you to additional monetary damages”). Further, “courts have repeatedly confirmed that a cease-and-desist letter by itself, absent other acts in the forum, will not present a sufficient basis for the exercise of personal jurisdiction over a non-resident rights holder in a declaratory judgment action.” See Trimble, *supra* note 220, at 784.

231. See Whitney C. Gibson & Jordan S. Cohen, *How to Report Trademark, Other IP Infringement on Facebook*, LEXOLOGY (Sept. 3, 2015), [www.lexology.com/library/detail.aspx?g=cabfaac7-e3ff-484d-a785-ab1d5670d468](http://www.lexology.com/library/detail.aspx?g=cabfaac7-e3ff-484d-a785-ab1d5670d468) (mentioning that “[s]ubmitting a report about the alleged infringement to Facebook might be more effective than contacting the alleged infringer [directly]”). However, as noted before, these courses of action are not mutually exclusive; an infringed party might report the infringement to the website while simultaneously sending a cease-and-desist letter to the infringing party and subsequently filing a lawsuit. See Thomas & Newman, *supra* note 5.

232. See Gibson & Cohen, *supra* note 231.

233. *Id.*

information on their social media profile, it can be difficult if there is no contact information listed or if the information provided is false or inaccurate.<sup>234</sup> Social media infringers can hide behind their IP address, making it difficult for an owner to ascertain their private contact information.<sup>235</sup> Alternatively, infringed parties have started sending cease-and-desist letters through a private or public message on the social media website itself.<sup>236</sup> In 2008, for example, Burger King served a cease-and-desist letter through Twitter to the owner of the account “@whoppervirgins.”<sup>237</sup> “Whopper Virgins” was the slogan for Burger King’s multi-million dollar ad campaign that depicted Hmong, Inuit, and Romanian villagers eating the restaurant’s burgers for the first time.<sup>238</sup> On December 17, 2008, Burger King’s official Twitter page “@theBKlounge” sent a public message to “@whoppervirgins” via a Tweet that read in all caps: “CEASE AND DESIST. UNAUTHORIZED USE OF TRADEMARK.”<sup>239</sup> Although the result of the publicly sent cease-and-desist letter is unknown, this serves as a good example of how companies are more amenable to sending cease-and-desist letters over social media websites.<sup>240</sup>

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234. See *id.* (stating that reporting infringement directly to the social media website directly might be more effective than sending a cease-and-desist letter).

235. Many users use proxy networks and virtual private networks (VPN) that mask their IP address and assigns them a new one so it appears as if they are accessing the social media website from a different location. See Natasha Stokes, *How to Browse the Web Anonymously*, TECHLICIOUS (Dec. 8, 2015), [www.techlicious.com/tip/how-to-browse-the-web-anonymously/](http://www.techlicious.com/tip/how-to-browse-the-web-anonymously/). One study showed that as many as 410 million people worldwide use technologies such as private browsers, VPNs, and proxy servers to mask their true location. See Chris Smith, *Seriously Dark Traffic: 500 Mil. People Globally Hide Their IP Addresses*, DIGIDAY (Nov. 18 2014), <http://digiday.com/publishers/vpn-hide-ip-address-distort-analytics/>. This allows users to appear as if they are surfing the Internet from an entirely different country. See *id.* This would make it nearly impossible for a trademark or copyright owner to ascertain an infringing user’s location in order to send him or her a cease-and-desist letter.

236. Gibson & Cohen, *supra* note 231.

237. Dennis Yang, *Did Burger King Really Just Issue A C&D Through Twitter?*, TECHDIRT (Dec. 18, 2008), [www.techdirt.com/articles/20081218/1926583171.shtml](http://www.techdirt.com/articles/20081218/1926583171.shtml). The “@whoppervirgin” bio was left blank. Whoppervirgins (@whoppervirgins), TWITTER, <http://twitter.com/whoppervirgins> (last visited Jan. 7, 2015)).

238. Yang, *supra* note 237.

239. Burger King (@theBKlounge), TWITTER (Dec. 17, 2008, 2:09 PM), <https://twitter.com/theBKlounge/status/1063696337>. However, “@theBK lounge” “may not really be Burger King.” Yang, *supra* note 237.

240. Some people believe that “@whoppervirgins” was set up by Burger King and that the publicly sent cease-and-desist letter was a publicity stunt. Sachin Balagopalan, *@whoppervirgins - Cease and Desist*, REPUBLIC OF INTERNETS (Dec. 19, 2008), [www.republicofinternets.com/?p=1321](http://www.republicofinternets.com/?p=1321). The “@whoppervirgins” Twitter handle is still active, with 64 Tweets and 351 followers. Whoppervirgins (@whoppervirgins), TWITTER, <https://twitter.com/whoppervirgins> (last visited Jan. 7, 2015). However, the last post was on January 30th, 2009, and read: “Whopper Virgin, died Tuesday choking on a whopper at age unknown, leaving behind an expansive collection whopper wrappers and excrement.”

Sending a cease-and-desist letter can also open a person or entity up to a flood of negative publicity.<sup>241</sup> Taco John's, a Wyoming-based Mexican restaurant chain, learned this the hard way when it asserted its trademark rights to the phrase "Taco Tuesday."<sup>242</sup> Since 1989, Taco John's has owned U.S. Trademark Registration No. 1,572,589 for the use of "Taco Tuesday" in the restaurant services industry.<sup>243</sup> In 2010, Taco John's sent a cease-and-desist letter to Iguana Grill, an Oklahoma based Mexican restaurant that was using the phrase "Taco Tuesday" along with the hashtag "#tacotuesday" on Twitter to promote its specials.<sup>244</sup> Taco John's, using its twitter handle "@TacoJohn's" even Tweeted: "Taco John's holds the copyright [sic] to Taco Tuesday giving us the exclusive right to use and protect it."<sup>245</sup> This turned into a public relations disaster for Taco John's, as the online community rallied around Iguana Grill.<sup>246</sup> Iguana Grill sold a record number of tacos the following Tuesday.<sup>247</sup> However, one could argue that the public Tweet ultimately worked for Taco John's. Iguana Grill eventually agreed to stop using "Taco Tuesday" in its advertising efforts,

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Whoppervirgins (@whoppervirgins), TWITTER (Jan. 30, 2009, 7:26 AM), <https://twitter.com/whoppervirgins/status/1161879250>. It is unknown whether the account is currently run by its original owner, whether it is now run by Burger King, or whether it has since been abandoned.

241. This is because the law is undeveloped, and social media policies are confusing and contradictory. Levy, *supra* note 134 (stating "[t]he patchwork of policies that arises from each site establishing its own procedures can be frustrating to trademark owners tasked with enforcing their marks"); Gregory S. Bernabeo, *Defending Your Trademarks in the Social Media World*, BLOOMBERG LAW REPORTS, [www.saul.com/sites/default/files/1047\\_PDF\\_2734.pdf](http://www.saul.com/sites/default/files/1047_PDF_2734.pdf) (noting that "unlike domain name cybersquatting and trademark abuses for which specific legal remedies are well-established, law and procedures for resolving social media trademark issues are in their infancy").

242. See Dina Roumiantseva & Aaron Rubin, *#Trademarks?: Hashtags as Trademarks*, SOCIALLY AWARE (May 13, 2015), [www.sociallyawareblog.com/2015/05/13/trademarks-hashtags-as-trademarks/](http://www.sociallyawareblog.com/2015/05/13/trademarks-hashtags-as-trademarks/).

243. USPTO, <http://tmsearch.uspto.gov/bin/showfield?f=doc&state=4809:677dx2.3.13> (last visited Jan. 7, 2016).

244. Roumiantseva & Rubin, *supra* note 242.

245. Emily E. Campbell, *Taco John's Claims Rights in Taco Tuesday*, DUNLAP CODDING (Aug. 4, 2010), <http://dunlapcoddington.com/phosita/2010/08/taco-johns-claims-rights-taco-tuesday>.

246. *Id.* Angry Twitter users Tweeted things like: "petition @tacojohns to stop copyright enforcement of #tacotuesday hashtag," "#tacotuesday is used all over CA! But qdoba uses #tacomonday. Who want #tacowednesday...Patent pending," "Potential new @iguanaokc promotion: @TacoJohns Sucks Tuesday #tacotuesday (They don't have a patent on that one.)," "So does anyone know if ThirstyThursday has a copyright? If so, Who will hold a big party to celebrate the end? #tacotuesday," and "Their trademark can't keep the customers from calling it #TacoTuesday." *Id.*

247. *Id.*

instead telling customers to “[k]eep a look out for our taco specials . . . for *Iguana Tuesday!*”<sup>248</sup>

In addition to sometimes being ineffective for intellectual property owners, cease-and-desist letters also have many disadvantages from the perspective of the public in general.<sup>249</sup> Cease-and-desist letters can be frivolous and abusive, and no third party evaluates a claim of infringement.<sup>250</sup> A party could always contact an attorney and file an action for declaratory judgment of noninfringement, but that is expensive.<sup>251</sup> Though intellectual property owners might like the fact that this option gives them a quick and inexpensive solution, the general public should be concerned that this option might lack fairness and accuracy in its results.<sup>252</sup> We do not know the content of these cease-and-desist letters, or even how many letters are sent.<sup>253</sup> Moreover, the public sometimes views sending a cease-and-desist letter as a bullying tactic, in which corporations use the threat of litigation to scare users into removing content that a court of law may or may not find to be infringing.<sup>254</sup>

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248. Roumiantseva & Rubin, *supra* note 242.

249. Dennis Crouch, *Patent Reform 2013: Demand Letter Transparency Act of 2013*, PATENTLYO (Nov. 20, 2013), <http://patentlyo.com/patent/2013/11/patent-reform-2013-demand-letter-transparency-act-of-2013.html> (discussing a proposed Demand Letter Transparency Act that would combat the lack of transparency in patent cease-and-desist letters), *see also* Notes of Advisory Committee, FED. R. CIV. P. 57.

250. *Id.*

251. *Id.*

252. *See* Leah Chan Grinvald, *Shaming Trademark Bullies*, 2011 WIS. L. REV. 625, 648–49 (2011) (“The majority of cease-and-desist letters include a variety of aspects that unfairly take advantage of small businesses’ or individuals’ lack of legal knowledge. The cease-and-desist letter is typically written by a lawyer (either the corporation’s in-house lawyer or an outside law firm) and written in legalese. The letter will sometimes cite to court cases, which may or may not be relevant to the small business or individual (not that the victim would have reason to know that). Not only do these letters take unfair advantage of the recipients’ lack of legal knowledge, there is also an element of emotional coercion. This type of letter from a lawyer, received by a non-lawyer, often brings emotional distress, which many recipients of cease-and-desist letters cite upon receipt. In addition, many large corporations demand an extremely short time-frame for a response by the small business. This takes further advantage of the recipients’ lack of legal knowledge, as the short time frame does not provide enough time for the small business to properly consult an attorney.”).

253. *Id.*

254. For example, Chick Fil-A sent Bo Muller-Moore a cease-and-desist letter in 2011 after he filed a trademark claim for the phrase “Eat More Kale,” a phrase which he would print on t-shirts. Abby Ohlheiser, *‘Eat More Kale’ Guy Wins Trademark Battle With Chick fil-A. Vermont Rejoices, Naturally.*, THE WASH. POST (Dec. 12, 2014), [www.washingtonpost.com/news/post-nation/wp/2014/12/12/eat-more-kale-guy-wins-trademark-battle-with-chick-fil-a-vermont-rejoices-naturally/](http://www.washingtonpost.com/news/post-nation/wp/2014/12/12/eat-more-kale-guy-wins-trademark-battle-with-chick-fil-a-vermont-rejoices-naturally/). Chick Fil-A claimed that the phrase infringed on their “Eat Mor Chickin” slogan. *Id.* Muller-Moore, with the help of pro bono legal aid, ignored the cease-and-desist letter, and proceeded with his trademark claim.



In sum, while sending a cease-and-desist letter has many benefits, it also has many drawbacks. When weighing the merits of a dispute resolution mechanism, it is imperative not to sacrifice fair and accurate results for speed and cost considerations. Some of these drawbacks can be solved with litigation. Litigation not only allows a plaintiff to identify a user by getting a subpoena, but it also strives to reduce frivolous and abusive tactics, and to create a mechanism that allows for fairness and accuracy in results.<sup>255</sup>

### C. Initiating a Lawsuit

As an alternative or additional step to reporting the infringement to the social media website or sending a cease-and-desist letter, an infringed party can initiate a lawsuit against an infringing party.<sup>256</sup> Like the other options, this course of action comes with many advantages and disadvantages.<sup>257</sup> Unlike reporting infringement to the social media website or sending a cease-and-desist letter, a lawsuit allows an intellectual property owner to recover damages in some instances.<sup>258</sup> Additionally, filing a lawsuit and getting a court order may be a necessary step if an intellectual property owner is trying to determine the identity of an infringer.<sup>259</sup> Moreover, courts often publish opinions and abide by precedent.<sup>260</sup> This means that the system as a whole promotes more

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*Id.* He prevailed in that claim. *Id.* Vermont Governor Peter Shumlin (D) called Chick Fil-A a corporate bully, stating that “[t]his isn’t just a win for the little guy who stands up to a corporate bully; it’s a win for our state. In Vermont, we care about what’s in our food, who grows it, and where it comes from.” *Id.* Senator Patrick Leahy (D) also commented on the dispute, stating that “[l]aws that protect the intellectual property rights are crucial to U.S. creativity and our economy. But we’ve also seen in the past how trademark laws can be misused by deep-pocketed corporations to bully small businesses. This is a happy ending to a long struggle for a Vermont entrepreneur.” *Id.*

255. *See supra* Part II(C).

256. Thomas & Newman, *supra* note 5.

257. *See id.* (stating that although traditional enforcement techniques such as initiating a lawsuit can be an effective mechanism for protecting intellectual property rights on social media websites, it can also alienate an IP owner’s customers and create negative publicity).

258. Terrance P. Ross, *Intellectual Property Law: Damages and Remedies*, L. J. PRESS § 1.03 (2015).

259. Marisa A. Trasatti & Anna C. Horevay, *Litigation and Social Media: Using Social Media to Your Advantage at Every Step of the Trial*, 63 FDCC QUARTERLY 4, 265 (2013), [www.semme.com/publications\\_archive/litigation/pdf/litigation-and-social-media.pdf](http://www.semme.com/publications_archive/litigation/pdf/litigation-and-social-media.pdf) (stating that “plaintiffs may file suit and then serve a subpoena upon an Internet service provider to obtain the identity of the person using a particular IP address”).

260. The legal principle of stare decisis ensures that judges respect the precedent set by previous courts. *Stare Decisis*, BLACK’S LAW DICTIONARY (9th ed. 2009).

transparency, consistency, and fairness in decisions—important qualities that are lacking from the other two courses of action.<sup>261</sup>

However, there are some disadvantages to this approach. Initiating a lawsuit is often expensive, time consuming, and the law surrounding trademarks and copyrights on social media may be unclear.<sup>262</sup> First, lawsuits are costly. Aside from large corporations, many people lack the resources to pay for such litigation.<sup>263</sup> According to a 2015 economic report published by the American Intellectual Property Law Association (AIPLA), the median cost of trademark litigation, not including appeal, is between \$325,000 and \$1.6 million depending on the amount in controversy.<sup>264</sup> The median cost of copyright litigation, not including appeal, is between \$250,000 and \$1.2 million depending on the amount in controversy.<sup>265</sup> One famous illustration of litigation costs involved a

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261. For a discussion on the other two courses of action, *see supra* Part II(A)–(B).

262. *See* Klemchuk & Sullivan, *supra* note 10 (stating that “case law pertaining to trademark infringement on social networking sites is sparse. Most cases settle early or are resolved through dispute resolution mechanisms within the social networking website”); *see also* Bernabeo, *supra* note 243 (stating that “unlike domain name cybersquatting and trademark abuses for which specific legal remedies are well-established, law and procedures for resolving social media trademark issues are in their infancy”).

263. *See* Curtin, *supra* note 133, at 387. (stating that “litigation is costly and burdensome for defendants” and that “the high cost of litigation will discourage users from expressing themselves in a social setting”). American adults have a median net worth of only \$44,900. *See* Tami Luhby, *America's Middle Class: Poorer Than You Think*, CNN MONEY (Aug. 5, 2014), <http://money.cnn.com/2014/06/11/news/economy/middle-class-wealth/>. This means that more than half of American adults have less than \$45,000 to their name. *See id.*

264. AM. INTELLECTUAL PROP. LAW ASS'N, REPORT OF THE ECONOMIC SURVEY 2015, at 38–39 (2015) (stating that in 2015 the median cost of a trademark infringement lawsuit was \$325,000 for a dispute with less than \$1 million in controversy, \$500,000 for a dispute with between \$1 million and \$10 million in controversy, \$720,000 for a dispute with between \$10 million and \$25 million in controversy, and \$1.6 million for a dispute with over \$25 million in controversy). Mediating these disputes is much cheaper. *Id.* (stating that in 2015 the median cost of *mediating* a trademark infringement lawsuit was \$50,000 for a dispute with less than \$1 million in controversy, \$75,000 for a dispute with between \$1 million and \$10 million in controversy, \$100,000 for a dispute with between \$10 million and \$25 million in controversy, and \$100,000 for a dispute with over \$25 million in controversy).

265. *Id.* at 39 (stating that in 2015 the median cost of a copyright infringement lawsuit was \$250,000 for a dispute with less than \$1 million in controversy, \$500,000 for a dispute with between \$1 million and \$10 million in controversy, \$750,000 for a dispute with between \$10 million and \$25 million in controversy and \$1.2 million for a dispute with over \$25 million in controversy). Mediating these disputes is much cheaper. *Id.* (stating that in 2015 the median cost of *mediating* a copyright infringement lawsuit was \$40,000 for a dispute with less than \$1 million in controversy, \$63,000 for a dispute with between \$1 million and \$10 million in controversy, \$100,000 for a dispute with between \$10 million and \$25 million in controversy, and \$100,000 for a dispute with over \$25 million in controversy); *See also* Mprose, *UPDATE:*

2007 lawsuit between Luis Vuitton and Haute Diggity Dog, a small company that sold “Chewy Vuitton” dog products.<sup>266</sup> Luis Vuitton sued Haute Diggity Dog for trademark, trade dress, and copyright infringement.<sup>267</sup> Haute Diggity Dog won on appeal after asserting a parody defense.<sup>268</sup> The win, however, did not come cheap.<sup>269</sup> Haute Diggity Dog “incurred approximately \$300,000.00 in legal fees and spent years in court” defending itself against Louis Vuitton.<sup>270</sup> Haute Diggity Dog also “lost distributors and had merchandise sent back as a result of the lawsuit.”<sup>271</sup>

Second, lawsuits are time consuming. The average time for trademark and copyright litigation is three years, not including appeals.<sup>272</sup> As was seen earlier in this paper, Stephanie Lenz was in court for over 7 years in order to defend a YouTube video of her son dancing to Prince’s “Let’s go Crazy” from removal by Universal Music Group.<sup>273</sup> Further, social media is a transitory forum.<sup>274</sup>

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*Explaining the Continuing Surge in the U.S. of Non-English Language Document Review Projects*, POSSE LIST (Apr. 27, 2011), [www.theposselist.com/2011/04/27/the-surge-in-foreign-language-document-review-projects/](http://www.theposselist.com/2011/04/27/the-surge-in-foreign-language-document-review-projects/) (stating that in 2011, The average cost of trademark litigation was \$600,000, while the average cost of copyright litigation was between \$500,000 and \$800,000, barring appeal).

266. See *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 256 (4th Cir. 2007). For another example of the exorbitant costs of trademark litigation, see *E. Iowa Plastics, Inc. v. PI, Inc.*, 2015 U.S. Dist. LEXIS 86889, \*3–5 (N.D. Iowa July 2, 2015). In that 2015 case, plaintiff alleged trademark infringement for defendant’s use of trademarked egg flats. *Id.* The case went to jury. See *id.* The court ultimately ruled “[a]fter a thorough review of the record and the billing data, including hours and rates, under all the circumstances, plaintiff is awarded a reasonable attorneys’ fee of Five Hundred Eight-Five Thousand Dollars (\$585,000.00).” Another example involves a 2001 case in which a jury found defendant wholesaler liable for trade dress infringement, contributory trade dress infringement, and dilution of plaintiff manufacturer’s registered trademarks. See *Coach, Inc. v. We Care Trading Co.*, 2001 U.S. Dist. LEXIS 9879, \*14–16, 48 (S.D.N.Y. July 18, 2001). There, the court noted “Coach seeks an award of \$ 405,578.94 in total fees and costs. We Care does not object to Coach’s request for attorneys’ fees on the more traditional grounds that they are duplicative or unreasonable, except to the extent that it argues fees should be awarded only for those claims on which Coach won at trial.” *Id.* at 48.

267. *Louis Vuitton Malletier S.A.*, 507 F.3d at 256.

268. *Id.* at 254, 257.

269. See Milord A. Keshishian, *Trademark, Trade Dress & Copyright Litigation - Appellate Court Rules Against Louis Vuitton*, L.A. INTELL. PROP. TRADEMARK ATTORNEY BLOG (Jan. 30, 2008), [www.iptrademarkattorney.com/2008/01/appellate\\_court\\_rules\\_against\\_1.html](http://www.iptrademarkattorney.com/2008/01/appellate_court_rules_against_1.html).

270. *Id.*

271. Peter Lattman, “Chewy Vuitton” Beats Louis Vuitton, But Feels a Bite, WALL ST. J. (Nov. 28, 2006), <http://blogs.wsj.com/law/2006/11/28/chewy-vuitton-beats-louis-vuitton-but-feels-a-bite/>.

272. Mprose, *supra* note 265.

273. See *supra* note 215, and accompanying text.

274. See Roberto A. Ferdman, *When to Post Things to Facebook if you Want the Most Likes*, WASH. POST (Jul. 2, 2015), [www.washingtonpost.com](http://www.washingtonpost.com)

Someone's Facebook post will often become irrelevant hours after the initial posting, let alone three years later.<sup>275</sup> Unless the plaintiff is seeking damages, most litigation over social media intellectual property disputes is pointless if it is not against a recidivist infringer or a username squatter.<sup>276</sup> Granting an injunction to remove a three-year old infringing post will only burden the courts, and may not be worth the time and expense to trademark and copyright owners.<sup>277</sup>

Finally, the law surrounding trademark and copyright infringement on social media websites is still undeveloped.<sup>278</sup> It is unknown whether this lack of case law is due to the fact that intellectual property owners prefer resolving their disputes by reporting the infringement directly to the website and/or sending a cease-and-desist letter, or because litigation is so time consuming and expensive.<sup>279</sup> Though courts certainly rely on traditional trademark and copyright precedent, social media disputes are unique, application of established law is difficult, and outcomes are hard to predict.<sup>280</sup> As one legal scholar noted: "cases tend to end up settling out of court once the process has begun due to the unpredictability of their results at trial."<sup>281</sup> For example, in the North Jersey Media Group case, discussed earlier, North Jersey Media Group sued Fox News for copyright infringement after Fox News posted on its Facebook account an image of three firefighters hoisting an American flag at the ruins of the World Trade Center

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/news/wonk/wp/2015/07/02/when-to-post-things-to-facebook-if-you-want-the-most-likes/ (citing research that indicates that most likes, shares, and comments occur "occur within the first 2 hours of posting times," and that that number is even shorter for Twitter).

<sup>275.</sup> *Id.*

<sup>276.</sup> MCGRADY, *supra* note 1, at § 12.03. For example, an order to terminate a parody account will prevent continued and future damage to the plaintiff. Further, an order to delete a recidivist user's account will prevent future damage to the plaintiff. However, an order to delete a one-time user's account or infringing post will likely not prevent any damage. This is because a one-time infringer's post will not damage the plaintiff in the future; all the damage will have already occurred by the time litigation is commenced.

<sup>277.</sup> *See id.* (stating that the burden on the courts in the current system is undeniable).

<sup>278.</sup> *See id.* (stating that "there is little to no legal precedent regarding many of the issues that arise in username disputes").

<sup>279.</sup> *See id.* McGrady states that the lack of case law is due to "the unpredictability of their results at trial." *See id.* (stating that username squatting "cases tend to end up settling out of court once the process has begun due to the unpredictability of their results at trial"). It could be that IP owners are persuaded to forgo litigation due to its high time and costs, but it could also be that IP owner chose not to pursue litigation because the other two courses of action are so effective.

<sup>280.</sup> For a discussion on traditional trademark and copyright infringement on social media websites, *see supra* Part I.

<sup>281.</sup> MCGRADY, *supra* note 1, at § 12.03.

site on the day of the attacks.<sup>282</sup> Fox claimed that its posting of the picture was protected under the fair use doctrine, and the Court used traditional fair use law to deny Fox News' motion for summary judgment.<sup>283</sup> However, on appeal, Fox News argued that the Court erred in not taking into account the "unique, transformative qualities of social media" when weighing fair use.<sup>284</sup> Fox argued that because of the nature of social media, the post was part of a global conversation, and not a promotion.<sup>285</sup> Additionally, Fox argued that allowing the ruling to stand would have "massive implications for the millions of Americans who use social media on a regular basis."<sup>286</sup> Although the appeal was only pending when Fox News reached a settlement agreement with North Jersey Media Group, it raised a question about whether future courts might apply existing law to social media disputes in new and unique ways.<sup>287</sup>

Overall, litigation promotes transparency, consistency, and fairness in decisions.<sup>288</sup> However, it is not a perfect solution. Litigation can often be time consuming, expensive, and unpredictable.<sup>289</sup> None of the current courses of action—reporting the infringement directly to the social media website, sending a cease-and-desist letter, and initiating litigation—provides a complete solution that balances cost, time, transparency, and uniformity.<sup>290</sup> Maybe it is time to look elsewhere for such a solution.

#### IV. HOW THE UDRP TARGETS CYBERSQUATTING

As the preceding section discussed, the three current options to remedy infringement on social media, while at times effective, are not perfect.<sup>291</sup> A possible fourth option is to adopt a mechanism for resolving trademark and copyright disputes on social media similar to the Uniform Domain-Name Dispute Resolution Policy (UDRP). The UDRP is a uniform dispute resolution mechanism that is effective in providing a timely and inexpensive solution to trademark owners who want to stop domain name squatters.<sup>292</sup> The

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282. Gardner, *supra* note 99.

283. N. Jersey Media Grp., Inc. v. Jeanine Pirro & Fox News Network, LLC, 74 F. Supp. 3d 605, 623 (S.D.N.Y. 2015).

284. See Donahue, *supra* note 106. As discussed earlier, fair use of a copyrighted work "for purposes such as criticism, comment, news reporting, teaching . . . , scholarship, or research," is not copyright infringement." 17 U.S.C. § 107. For a discussion on the fair use doctrine, see *supra* notes 95–109, and accompanying text.

285. Donahue, *supra* note 106.

286. *Id.*

287. *Id.*

288. See *supra* notes 257–61, and accompanying text.

289. See *supra* notes 262–87, and accompanying text.

290. See *supra* Part II.

291. See *supra* Part II.

292. ICANN, *supra* note 16; see also Bluestone, *supra* note 45, at 587 (stating that "[t]he Uniform Domain Name Dispute Resolution Policy (UDRP), adopted

UDRP's scope is limited to trademark infringement in domain names themselves; it does not apply to trademarks in the content of a website and does not apply to copyrights.<sup>293</sup> UDRP proceedings are private, and users agree to the arbitration by contract.<sup>294</sup>

The UDRP was established by the Internet Corporation for Assigned Names and Numbers (ICANN), a non-profit corporation formed to manage the Internet domain name system.<sup>295</sup> The UDRP applies to top-level domains (.com, .net, .org, etc.).<sup>296</sup> It does not apply to usernames registered on social media sites, because they are lower level subpages that appear after the top-level domain (for example, twitter.com/oneok would not be covered, while both twitter.com and oneok.com would be covered).<sup>297</sup> All top-level domain name registrars must agree to follow the UDRP, and all domain name registrants and users must submit to the UDRP proceedings if a formal complaint is filed against them.<sup>298</sup>

There are currently five authorized service providers that receive complaints and provide an administrative panel to hear the

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by the Internet Corporation for Assigned Names and Numbers (ICANN), is an instrument that provides remedy to cybersquatting victims. The UDRP is composed of arbitrators who have the power to provide limited relief by either transferring the domain name to the complainant, or cancelling the domain name”).

293. See ICANN, *supra* note 16.

294. See *id.* (mentioning “[t]he UDRP is a policy between a registrar and its customer and is included in registration agreements for all ICANN-accredited registrars”).

295. ICANN, *supra* note 16.

296. See *id.* (stating “[t]he Uniform Domain-Name Dispute Resolution Policy (UDRP) has been adopted by ICANN-accredited registrars in all gTLDs (.aero, .asia, .biz, .cat, .com, .coop, .info, .jobs, .mobi, .museum, .name, .net, .org, .pro, .tel and .travel)”; see also GILSON ET AL., *supra* note 19, at § 7A.02 (“A domain name may be up to sixty-seven characters long, including the characters of the “dot” and the top level domain name (e.g., “com”). A typical domain name consists of letters, numbers and hyphens, though hyphens may not be used at the beginning or the end of a domain name . . . The characters to the left of .com, .org, .net and other gTLDs are called *second-level domain names*. For example, in www.uspto.gov, “uspto” is the second-level domain name. The characters to the right of the period in a domain name are called *top-level domain names*. In www.uspto.gov, “gov” is the top-level domain name.”).

297. *Id.*; GILSON ET AL., *supra* note 19, at § 7A.04.

298. See GILSON ET AL., *supra* note 19, at § 7A.06. Domain name registrants are bound to the UDRP by the contractual terms of their registration agreements with the registrar. See *Consensus Policies*, ICANN, [www.icann.org/resources/pages/registrars/consensus-policies-en](http://www.icann.org/resources/pages/registrars/consensus-policies-en) (last visited Jan. 7, 2016). The Registrar Accreditation Agreement states that: “[d]uring the Term of this Agreement, Registrar shall have in place a policy and procedures for resolution of disputes concerning Registered Names. Until ICANN adopts an alternative Consensus Policy or other Specification or Policy with respect to the resolution of disputes concerning Registered Names, Registrar shall comply with the Uniform Domain Name Dispute Resolution Policy.” *2013 Registrar Accreditation Agreement*, ICANN, at § 3.8, [www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#raa](http://www.icann.org/resources/pages/approved-with-specs-2013-09-17-en#raa).

expedited dispute.<sup>299</sup> The largest of the service providers, the World Intellectual Property Organization (WIPO), has handled in excess of 31,750 UDRP cases.<sup>300</sup> The UDRP strives for transparency; all decisions are posted to the ICANN website and the service provider's website.<sup>301</sup>

A complainant under the UDRP has the initial burden of proving that: "(i) [the] domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; and (ii) [the respondent has] no rights or legitimate interests in respect of the domain name; and (iii) [the] domain name has been registered and is being used in bad faith."<sup>302</sup> The claimant usually pays all fees; however, fees will be split evenly amongst the parties in cases where the respondent elects to expand the Administrative Panel from one to three panelists.<sup>303</sup>

The UDRP has many advantages.<sup>304</sup> The UDRP provides for expedited proceedings, and costs are typically lower than those in traditional litigation.<sup>305</sup> Further, the UDRP allows for transparency, fairness in decisions, and consistency, as the elements of the prima facie case and burden of proof are uniform across all "jurisdictions," and all decisions are published.<sup>306</sup> Finally,

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299. GILSON ET AL., *supra* note 19, at § 7A.06.

300. As of July 2015. *Id.* Of the 31,750 cases "the complainant prevailed in approximately 85% of the cases, the respondent in 15%." *Id.*

301. *Id.*

302. See *Uniform Domain Name Dispute Resolution Policy*, ICANN, [www.icann.org/resources/pages/policy-2012-02-25-en#4aiii](http://www.icann.org/resources/pages/policy-2012-02-25-en#4aiii) (last visited Jan. 7, 2016).

303. See *id.* (stating "[a]ll fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists . . . in which case all fees will be split evenly by you and the complainant").

304. See *Bluestone*, *supra* note 45 (stating "[t]he UDRP may prove to be a better forum not only because of its efficiency and timeliness, but also because of its 'user-friendly' quality").

305. See *MCGRADY*, *supra* note 1, at § 9.03; see also *MCGRADY*, *supra* note 1, at § 12.04 ("The high experience levels of the arbitrators and the security of using a uniform dispute resolution system make the UDRP route highly efficient for victims of cybersquatting. The proceedings are much faster and significantly lower in cost than court proceedings. Additionally, of great importance in today's Internet-fueled global business environment, UDRP proceedings are multinational. Finally, use of the UDRP removes the burden of determining rights and procedures involving domain disputes from individual registrars and registries."); *Bluestone*, *supra* note 45, at 587 (noting that "[UDRP proceedings] move quite quickly, requiring the adjudicator to come to a decision within three weeks. In cases where the complainant prevails, the remedy will take place 10 days after the decision is issued unless the panel is informed by the defendant that they are initiating court proceedings [via ACPA] on the matter") (internal quotations omitted).

306. See *MCGRADY*, *supra* note 1, at § 9.03; see also *MCGRADY*, *supra* note 1, at § 12.04. The Policy itself states "[a]ll decisions under this Policy will be published in full over the Internet, except when an Administrative Panel

the UDRP provides multinational proceedings and a panel of judges who are experts on the matter at hand.<sup>307</sup>

Conversely, there are also some disadvantages to the UDRP.<sup>308</sup> The UDRP is limited in its ability to grant remedies.<sup>309</sup> A UDRP panelist may only cancel or transfer a disputed domain name; he or she may not award damages or attorney's fees.<sup>310</sup> Moreover, the UDRP does not provide for a discovery mechanism, and only applies to use of marks in the limited scope of top-level domain names.<sup>311</sup> The UDRP does not apply to the use of marks in the domain's content.<sup>312</sup>

Further, the UDRP's lack of fair use consideration is concerning. As one scholar put it: "ICANN 'isn't concerned with US First Amendment rights to free speech.'"<sup>313</sup> This lack of concern has led to an inconsistent application of free speech law.<sup>314</sup> One study showed that U.S. panels, which hear about half of all fair use proceedings, were friendlier to free speech interests than their foreign counterparts.<sup>315</sup> As one author noted:

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determines in an exceptional case to redact portions of its decision." *Domain Name Dispute Resolution Policy*, ICANN (Adopted Aug. 26, 1999), [www.icann.org/resources/pages/policy-2012-02-25-en](http://www.icann.org/resources/pages/policy-2012-02-25-en).

307. See MCGRADY, *supra* note 1, at § 9.03; see also MCGRADY, *supra* note 1, at § 12.04.

308. See MCGRADY, *supra* note 1, at § 9.03 ("The primary advantages of a UDRP proceeding rather than litigation under the ACPA are the short time frame of the proceedings and the relatively low costs. However, a UDRP panelist may award only cancellation or transfer of the disputed domain name(s). There is no discovery mechanism. The ACPA enjoys several advantages over the UDRP complaint mechanism. The primary advantages are the availability of statutory damages, injunctive relief, and perhaps attorneys' fees, as well as access to discovery mechanisms useful to determine the full scale of cybersquatting activities and the extent of defendant's assets").

309. See *id.* (stating that the UDRP cannot grant statutory damages, injunctive relief, or attorneys' fees).

310. See *id.* (stating that the UDRP cannot grant statutory damages, injunctive relief, or attorneys' fees).

311. *Id.* The lack of a discovery mechanism is not necessarily a bad thing. While discovery is important for determining the full extent of the infringement, it is often prohibitively expensive. See Martha Neil, *Litigation Too Costly, E-Discovery a 'Morass,' Trial Lawyers Say*, ABA JOURNAL (Sept. 09, 2008), [www.abajournal.com/news/article/litigation\\_too\\_costly\\_e\\_discovery\\_a\\_morass\\_trial\\_lawyers\\_say](http://www.abajournal.com/news/article/litigation_too_costly_e_discovery_a_morass_trial_lawyers_say) (stating that "judges don't do enough to control excessive discovery (particularly e-discovery, which can be extremely expensive)").

312. ICANN, *supra* note 16.

313. Wayde Brooks, *Current Public Law and Policy Issues in ADR: Wrestling Over the World Wide Web: ICANN's Uniform Dispute Resolution Policy for Domain Name Disputes*, 22 HAMLIN J. PUB. L. & POL'Y 297, 327 (2001).

314. See David A. Simon, *An Empirical Analysis of Fair Use Decisions Under the Uniform Domain-Name Dispute-Resolution Policy*, 53 B.C. L. REV. 65, 67-68 (2016).

315. *Id.* ("In other words, U.S. panels began importing U.S. law—law that is generally (viewed as) more sensitive than the law of other countries to free speech interests—into UDRP disputes with higher frequency than did foreign panels. More than non-U.S. panels, U.S. panels also applied U.S. law in



The stringent trademark requirements imposed on personal name disputes in the context of domain names have led to confused and often contradictory results in panel proceedings. For example, a panel granted Julia Roberts rights to the website juliaroberts.com, while another panel denied Bruce Springsteen rights to the website brucepringsteen.com. Similarly, it was decided that Hillary Clinton has rights to hillaryclinton.com, while Kathleen Kennedy Townsend did not have rights to kathleenkennedytownsend.com.<sup>316</sup>

This lack of consistency and fairness with regard to free speech would have to be remedied in a USRP.

Overall, in its limited capacity the UDRP provides an effective means for trademark owners to protect their trademarks from being used, in bad faith and without authorization, in domain names.<sup>317</sup> For example, in 2000, a three-member WIPO administrative panel decided a dispute between entertainer Madonna and an unnamed respondent who was using the Madonna.com domain name as an adult entertainment website.<sup>318</sup> Entertainer Madonna had two U.S. trademarks for the word “MADONNA.”<sup>319</sup> In a well written decision, the three-member panel discussed each of the three prima facie factors before ruling in favor of Madonna and ordering the domain name be transferred to her.<sup>320</sup> The panel stated that “[t]he disputed domain name is identical or confusingly similar to a trademark in which Complainant has rights; Respondent lacks rights or legitimate interests in the domain name; and the domain name has been registered and used in bad faith.”<sup>321</sup> Such an inexpensive, quick, and transparent mechanism for the resolution of trademark disputes could be a welcome addition to the social media arena.

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cases where the respondent was from the United States. Because U.S. law is (viewed as) more friendly to speech interests than foreign law, the use of U.S. law favored respondents.”).

316. Pesochinsky, *supra* note 42, at 235.

317. See Bluestone, *supra* note 45, at 588–89. (listing the UDRP’s advantages).

318. See *Ciccone v. Parisi*, WIPO Case No. D2000-0847 (Oct. 12, 2000), [www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html](http://www.wipo.int/amc/en/domains/decisions/html/2000/d2000-0847.html).

Madonna is a pop music singer who reached worldwide fame in the 1980s. See *Madonna Biography*, BIO., [www.biography.com/people/madonna-9394994](http://www.biography.com/people/madonna-9394994) (last visited Jan. 7, 2016). By 1991, she had sold over 70 million albums internationally and had 21 songs reach the top 10 on the United States’ music charts. *Id.*

319. See *id.* (noting “[c]omplainant is the well-known entertainer Madonna. She is the owner of U.S. Trademark Registrations for the mark MADONNA for entertainment services and related goods (Reg. No. 1,473,554 and 1,463,601). She has used her name and mark MADONNA professionally for entertainment services since 1979”).

320. *Id.*

321. *Id.*

## V. THE CREATION OF A USRP: A BETTER SOLUTION OR AN UNNECESSARY MECHANISM?

The previous part analyzed the UDRP, a successful mechanism for the resolution of domain name disputes.<sup>322</sup> This part will now use the UDRP as a roadmap for what a possible similar mechanism for the resolution of trademark and copyright disputes in social media would look like. It will then discuss the advantages and disadvantages to such a mechanism, ultimately concluding that adopting a USRP is not warranted.

### A. *The Text of a USRP*

The creation of a Uniform Social Media Intellectual Property Dispute Resolution Policy (USRP) has been raised on a few occasions, but no substantive policy has been set forth that covers both trademark and copyright disputes.<sup>323</sup> Attorney Paul McGrady proposed the creation of a Social Media Username Dispute Resolution Policy limited to username squatting disputes.<sup>324</sup> In his proposal, McGrady advocates for a compulsory one-person administrative panel to adjudicate disputes in the limited scope of username squatting.<sup>325</sup> McGrady sets forth the proposed text of such a policy.<sup>326</sup> McGrady's proposed "Social Media Username Dispute Mechanism" applies where: (1) a disputed username is "identical or confusingly similar to" a claimant's trademark, service mark, or personal name, (2) "the user has no rights or legitimate interests in respect of the [u]sername," and (3) "the [u]sername has been registered in bad faith or is being used in bad faith."<sup>327</sup> The text of McGrady's proposed mechanism then provides a non-inclusive list of evidence of registration and use in bad faith.<sup>328</sup> That evidence includes circumstances indicating that the user: (1) intended to sell the username for valuable consideration, (2) registered the username to prevent the mark holder from doing so itself, (3) registered the username for the primary purpose of disrupting a business or harassing somebody, or (4) intentionally

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322. *See supra* part III.

323. The term "Uniform Social Media Intellectual Property Dispute Resolution Policy (USRP)" has been created for the purposes of this paper.

324. MCGRADY, *supra* note 1, at § 12.07. Paul D. McGrady is a partner at Winston & Strawn LLP, where he practices trademarks, domain names, and brand enforcement. *Paul D. McGrady*, WINSTON & STRAWN LLP, [www.winston.com/en/who-we-are/attorneys/mcgrady-paul-d.html](http://www.winston.com/en/who-we-are/attorneys/mcgrady-paul-d.html) (last visited Jan. 7, 2016). McGrady has also taught advanced trademarks and cyberlaw at DePaul Law School. *See id.* In addition to authoring *McGrady on Social Media*, McGrady has also authored *McGrady on Domain Names. Id.*

325. *Id.*

326. *Id.*

327. MCGRADY, *supra* note 1, at § 12.06.

328. *Id.*

intended to attract, for commercial gain, Internet users to another location “by creating a likelihood of confusion with the complainant’s personal name or mark as to the source, sponsorship, affiliation, or endorsement of the disputed account.”<sup>329</sup> Finally, McGrady’s proposed mechanism concludes by providing a non-inclusive list of ways a user can demonstrate rights to or a legitimate interest in a username.<sup>330</sup> Those rights and interests can be proven with evidence that the user: (1) used the username in connection with a “bona fide, non-infringing, non-harassing” offering of goods and services before any notice of the dispute, (2) is an individual, business, or organization commonly known by the username in question, even if it has no trademark rights associated with that name, or (3) is making a legitimate fair use or noncommercial use of the username “without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark, service mark, or personal name at issue.”<sup>331</sup>

McGrady also sets forth text of a proposed contractual user agreement.<sup>332</sup> Users would be compelled to agree to this contract while registering to use the social media website.<sup>333</sup> However, McGrady does not explain what compels the social media websites

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329. *See id.* (“The following circumstances, in particular but without limitation, if found by the Panel to be present, shall be evidence of the registration and use of a Username in bad faith: [i] circumstances indicating that the user registered or acquired the Username primarily for the purpose of selling, renting, or otherwise transferring the username to the complainant who is the owner of the trademark, service mark, or personal name or to a competitor of that complainant, for valuable consideration in excess of documented out-of-pocket costs directly related to the username; or [ii] the user registered the disputed Username in order to prevent the owner of the trademark, service mark, or personal name from reflecting the mark in a corresponding username; [iii] the user registered the Username primarily for the purpose of disrupting the business of a competitor or harassing an individual whose personal name corresponds to the user name; or [iv] by using the disputed Username, the user intentionally attempted to attract, for commercial gain, Internet users to a social media account or other on-line location, by creating a likelihood of confusion with the complainant’s personal name or mark as to the source, sponsorship, affiliation, or endorsement of the disputed account or of a product or service on a social media account or other on-line location”).

330. *Id.*

331. *Id.* (“Any of the following circumstances, in particular but without limitation, if found by the Panel to be proved based on its evaluation of all evidence presented, shall demonstrate rights or legitimate interests in the Username: [i] before any notice of the dispute, the use of the Username in connection with a bona fide, non-infringing, non-harassing offering of goods or services; or [ii] the user is an individual, business, or other organization, which has been commonly known by the Username, even if the individual, business, or other organization has acquired no trademark or service mark rights; or [iii] the user is making a legitimate noncommercial or fair use of the Username, without intent for commercial gain, to misleadingly divert consumers, or to tarnish the trademark, service mark, or personal name at issue”).

332. *Id.* at § 12.07.

333. *See id.*

to partake in this system.<sup>334</sup> Among the important contractual terms included in the user agreement are: fees, remedies available, and the availability of court proceedings.<sup>335</sup> With regard to fees, the cost associated with this mechanism would be paid in full by the complainant, unless the owner of the username elects to increase the administrative panel from one to three panelists, in which case the costs would be split evenly between the two parties.<sup>336</sup> With regard to the remedies available, the administrative panel can only cancel the username or transfer the username to the complainant.<sup>337</sup> Finally, with regard to the availability of court proceedings, McGrady's proposed dispute mechanism does not prevent either party from "submitting the dispute to a court of competent jurisdiction for independent resolution" at any time during the process.<sup>338</sup>

In addition to McGrady's proposal, there have been three other instances in which attorneys and scholars have called for the creation of a Uniform Username Dispute Resolution mechanism.<sup>339</sup> All three instances have similarly limited the scope of the proposal to that of username squatting.<sup>340</sup> First, in 2009 Attorney Erik Heels posted an article on his blog about how easy it is to username squat

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334. *Id.*

335. *Id.*

336. *See id.* (stating "[a]ll fees charged by a Provider in connection with any dispute before an Administrative Panel pursuant to this Policy shall be paid by the complainant, except in cases where you elect to expand the Administrative Panel from one to three panelists, in which case all fees will be split evenly by you and the complainant").

337. *See id.* (mentioning "[t]he remedies available to a complainant pursuant to any proceeding before an Administrative Panel shall be limited to requiring the cancellation of your Username or the transfer of your Username registration to the complainant").

338. *See id.* ("The mandatory administrative proceeding requirements set forth above shall not prevent either you or the complainant from submitting the dispute to a court of competent jurisdiction for independent resolution before such mandatory administrative proceeding is commenced or after such proceeding is concluded. If an Administrative Panel decides that your Username registration should be canceled or transferred, we will wait five (5) business days (as observed in the location of our principal office) after we are informed by the applicable Provider of the Administrative Panel's decision before implementing that decision. We will then implement the decision unless we have received from you during that five (5) business day period official documentation (such as a copy of a complaint, file-stamped by the clerk of the court) that you have commenced a lawsuit against the complainant in a jurisdiction to which the complainant has submitted. If we receive such documentation within the five (5) business day period, we will not implement the Administrative Panel's decision, and we will take no further action, until we receive (i) evidence satisfactory to us of a resolution between the parties; (ii) evidence satisfactory to us that your lawsuit has been dismissed or withdrawn; or (iii) a copy of an order from such court dismissing your lawsuit or ordering that you do not have the right to continue to use your Username").

339. *See* notes 341–45, and accompanying text.

340. *See* notes 341–45, and accompanying text.

some of the largest companies on social media.<sup>341</sup> He concluded his article by advocating for a third-party arbitration system, which he called the Uniform Username Dispute Resolution Policy (UUDRP), but never described what such a solution would look like.<sup>342</sup> Second, in a 2010 student-written note, Zorik Pesochinsky discussed the need for a username squatting dispute resolution mechanism, but the policy was only briefly discussed.<sup>343</sup> Finally, attorneys Steve Levy and Kristine Dorrain proposed a similarly limited mechanism in 2011, but their proposal merely raised the idea without describing what such a mechanism would entail.<sup>344</sup> They called their mechanism the Social Media Uniform Dispute Resolution Policy (SUDRP).<sup>345</sup>

An ideal third-party dispute resolution mechanism would be more expansive than just username squatting. Though a limited mechanism would be beneficial in resolving username squatting disputes, the breadth of intellectual property disputes on social media is much larger.<sup>346</sup> An ideal mechanism would aim to resolve trademark and copyright disputes as well. It would be illogical to create a mechanism that aims to resolve a small subset of disputes

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341. See Erik J. Heels, *How To Twittersquat The Top 100 Brands: A Call for the Creation of the Uniform Username Dispute Resolution Policy*, ERIKJHEELS.COM (Jan. 8, 2009), [www.erikjheels.com/1298.html/comment-page-15#comments](http://www.erikjheels.com/1298.html/comment-page-15#comments). Heels founded Clocktower Law LLC, a patent and trademark firm geared towards startups. *About Erik*, ERIKJHEELS.COM, [www.erikjheels.com/about-erik](http://www.erikjheels.com/about-erik) (last visited Jan. 7, 2016). Heels practices in both patent and trademark law. See *id.*

342. *Id.*

343. Pesochinsky, *supra* note 46, at 247–52.

344. See Levy, *supra* note 134 (stating “. . . Kristine Dorrain of the National Arbitration Forum and I presented a proposal for a more streamlined dispute resolution mechanism at the 2011 intellectual property forum hosted by the Pennsylvania Bar Institute in Philadelphia. We argued that it is time for an SUDRP or ‘Social Uniform Dispute Resolution Policy’ that would bring consistency and accountability to the social media brand enforcement process and relieve social media sites of the potential liability they currently face when handling these disputes on their own. Much like the UDRP, an SUDRP could include objective standards for confusion, legitimate interest, and bad faith and would also assure timely and reliable implementation of decisions”). Levy is an attorney with 27 years of experience who founded the Accent Law Group and who also manages FairWind Partners’ Domain Name Reclaim Services. *Steve Levy*, FAIRWINDS PARTNERS BLOG, <http://blog.fairwindspartners.com/authors/steve-levy> (last visited Jan. 7, 2016). Prior to joining FairWinds, Levy was a Senior Director at The Home Depot’s legal department where he managed their intellectual property. *Id.* Kristine Dorrain is the National Arbitration Forum’s Director of Internet and IP Service. *Kristine Dorrain*, ICANN WIKI, [http://icannwiki.com/Kristine\\_Dorrain](http://icannwiki.com/Kristine_Dorrain) (last visited Jan. 7, 2016). Mr. Levy, through email and in preparation for this comment, graciously provided me with a copy of the slideshow Ms. Dorain and he used at the 2011 Intellectual Property Forum.

345. Steve Levy, through email correspondence, was kind enough to provide me with a slideshow he presented about the SUDRP.

346. For a discussion on the varying types of trademark and copyright issues on social media, see Part I.

while leaving out other important intellectual property disputes that arise. This would not solve many of the issues described earlier—transparency, fairness, and uniformity.<sup>347</sup> Creating uniformity in one subset of intellectual property issues while ignoring it in the larger category would likely lead to more inconsistency and confusion.

An ideal mechanism for the resolution of disputes on social media would cover both trademark and copyright disputes. This would, in theory, solve many of the issues that arise in the previously discussed courses of action.<sup>348</sup> Unlike the internal policies the social media websites have created to deal with takedown requests, the USRP would create a more uniform policy.<sup>349</sup> Eliminating a system with differing policies in favor of one solitary mechanism would reduce confusion.<sup>350</sup> Unlike cease-and-desist letters, the USRP would have legal clout and would be binding on both parties.<sup>351</sup> Finally, unlike litigation, the USRP could reduce cost and offer speedy resolutions.<sup>352</sup> Further, the USRP would create transparency by publishing decisions.<sup>353</sup>

The USRP would be modeled after the UDRP and the aforementioned proposed username squatting dispute resolution mechanisms.<sup>354</sup> Just as domain registrants are contractually obligated to submit to the UDRP, social media websites can update their terms of services to contractually obligate all users to submit

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347. For a discussion of these issues, *see* notes 133–39, and accompanying text.

348. As discussed earlier, reporting infringement directly to the social media website lacks transparency, and the various policies differ on substantive issues. *See supra* notes 133–39, and accompanying text. Sending a cease-and-desist letter has no judicial backing, can open the sender up to a flood of negative publicity, and can be used as a bullying tactic. *See supra* Part II(B). Further, initiating a lawsuit is often expensive, time consuming, and the law surrounding the matter can be unclear. *See supra* Part II(C).

349. For a discussion on the social media internal reporting systems currently in place, *see supra* Part II(A).

350. *See Levy, supra* note 134 (stating “[t]he patchwork of policies that arises from each site establishing its own procedures can be frustrating to trademark owners tasked with enforcing their marks”); MCGRADY, *supra* note 1, at § 12.03 (mentioning “[e]ven three of the largest social media sites have vastly different approaches to username squatting and users’ rights. The differing approaches to username disputes must logically lead to inconsistency of outcomes, although there is little data on the subject. At the very least, the inconsistency in approach to the subject renders planning and prediction nearly impossible for users desiring to protect their names or brands”).

351. For a discussion on cease-and-desist letters, *see supra* Part II(B).

352. For a discussion on litigating intellectual property disputes that arise on social media, *see supra* Part II(C).

353. USRP decisions would be published similar to how UDRP decisions are published. For a discussion on how UDRP decisions are published, *see supra* note 306, and accompanying text.

354. *See supra* Part III for a discussion on the UDRP. McGrady similarly based his proposed Social Media Username Dispute Resolution Policy on the UDRP. *See* MCGRADY, *supra* note 1, at § 12.07 n. 56.

to the USRP.<sup>355</sup> The social media websites would be encouraged to partake in such a system because it would decrease their costs and liability.<sup>356</sup> Under the current system, social media websites have to hire employees to assess and adjudicate takedown requests; their costs are all internalized.<sup>357</sup> Further, these social media websites still face litigation over the mishandling of takedown requests.<sup>358</sup> However, subscribing to the USRP would allow the websites to shift their cost to the disputing parties and eliminate their liability due to the fact that they are outsourcing the organization that reviews takedown requests.

The USRP would serve as a mechanism to protect trademark and copyright owners from: (1) username squatting, (2) trademark infringement, and (3) copyright infringement. An administrative panel consisting of one judge would adjudicate the proceedings. However, this panel could be expanded to three judges upon request.

The username squatting provisions would be nearly identical to those set forth by McGrady.<sup>359</sup> As to trademark and copyright disputes, the USRP would track current U.S. laws pertaining to those issues. In order to prevail on a claim of trademark infringement, a claimant must prove that: (1) he or she owns a valid, protectable trademark (registration is not required), (2) the alleged infringer used the trademark without the claimant's consent, and (3) the trademark is used in a manner likely to cause confusion among ordinary consumers as to the true mark's source, owner, or affiliation.

In order to prevail on a claim of copyright infringement, a claimant must prove that: (1) he or she owns a valid, protectable copyright (registration is not required), (2) the alleged infringer used the copyrighted work without the claimant's consent, and (3) the alleged infringer did not use the copyrighted work for purposes

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355. See *supra* note 296, and accompanying text.

356. An argument could be made that forcing users to submit to the USRP would possibly deter people from signing up for these social media websites. However, this argument is purely speculative. Most users do not read the terms and conditions, and it is unlikely that the addition of a submission clause would deter people from signing up. See Amanda Scherker, *Didn't Read Facebook's Fine Print? Here's Exactly What It Says*, THE HUFFINGTON POST (July 21, 2014), [www.huffingtonpost.com/2014/07/21/facebook-terms-condition\\_n\\_5551965.html](http://www.huffingtonpost.com/2014/07/21/facebook-terms-condition_n_5551965.html)

(stating that most people "blindly agreed to Facebook's Terms and Conditions without reading the fine print," and citing a Carnegie Mellon study that "determined that it would take the average American 76 work days to read all the privacy policies they agreed to each year"). Liability for the social media websites would be decreased if Congress passed a law which would provide a safe harbor for websites that agree to the USRP.

357. For a discussion of these internal policies, see Part II(A).

358. For an example, see notes 51–59 (*LaRussa v. Twitter*); 60–65 (*Oneok, Inc. v. Twitter*); 51–59 (*Reilly v. Twitter*), and accompanying text.

359. For a discussion on the username squatting policy set forth by McGrady, see notes 328–31, and accompanying text.

such as criticism, commentary, news reporting, teaching, scholarship, research, or resale.

The USRP would handle fees differently than the way proposed by McGrady. McGrady wants all fees to be paid by the claimant.<sup>360</sup> This policy seems unfair when a user is clearly infringing on a claimant's intellectual property rights. A more fair system would allow for fee shifting if the plaintiff prevails.

Remedies would also be more expansive than those set forth by McGrady.<sup>361</sup> This is due to the fact that cancellation and transfer of the account are not sufficient in a system that covers more than just username squatting. The remedies available to a complainant would be: (1) in the case of username squatting, the termination of the username or the transfer of the username to the complainant, and (2) in the case of trademark infringement or copyright infringement (i) the removal of the infringing post; and (ii) possible suspension or termination of the host account. An account would be suspended or terminated only in the case of a recidivist infringer (the user has committed trademark or copyright infringement on more than one occasion) or when actual malice is found (the user knowingly infringed with the intent to cause harm).

The USRP would ideally condense the time period compared to that of litigation. Upon receipt of a complaint, the alleged infringer would be given 10 business days to submit a response. The panel would reach a verdict within 10 business days from receiving the response. Additionally, similar to McGrady's proposal, parties may submit their dispute to a court of competent jurisdiction at any time.<sup>362</sup>

Now that the framework for the USRP has been set forth, it is vital to assess whether adopting such a mechanism would be beneficial to the current courses of action.

### *B. Advantages and Disadvantages to the USRP*

There are both advantages and disadvantages to the adoption of a USRP. First, the USRP allows for a quicker resolution of disputes than does litigation. Given the instantaneous nature of the Internet and the fact that an infringing post can have irreversible and lasting effects on a person or company within minutes of its publication, such a speedy resolution is necessary.<sup>363</sup> However, the USRP would still take up to 20 business days to render a decision.<sup>364</sup>

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360. For a discussion on the fee terms set forth by McGrady, *see* note 336, and accompanying text.

361. For a discussion on the remedies terms set forth by McGrady, *see* note 337, and accompanying text.

362. For a discussion on the availability of court proceedings terms set forth by McGrady, *see* note 338, and accompanying text.

363. *See supra* notes 274–77, and accompanying text.

364. Under the UDRP, most disputes are resolved within 60 days. *The*



Although this is certainly faster than initiating a lawsuit, it might not be fast enough to prevent or halt the damage that an infringing post exacts on a person or company.<sup>365</sup> A 20-day turnaround would likely mitigate damage caused by username squatters or recidivist infringers.<sup>366</sup> However, it would be unlikely to mitigate damage done by a single post that infringes on a trademark or copyright.<sup>367</sup> Moreover, this 20-day turnaround is slower than action by a social media website itself, and would also be slower than an infringing user's immediate compliance to a cease-and-desist letter.<sup>368</sup>

Second, the USRP allows for a more uniform application of the laws compared to takedown requests and cease-and-desist letters. Similar to litigation, the USRP would strive to maintain an administrative panel that would uniformly apply the law.<sup>369</sup> However, though the law may be uniform, it is not realistic to assume that the application of those laws by various panels will be uniform, especially if the panels are composed of people from different countries with different legal systems.<sup>370</sup> Nonetheless, the USRP would do its best to foster a system that is consistent in applying the law.

Though uniform application of the law is typically favored, it is unclear whether it is ideal in the current situation because user expectations vary amongst the various social media websites. For example, Facebook and Twitter have differing policies regarding parody accounts.<sup>371</sup> Facebook has a per se ban on all fake accounts, while Twitter allows parody accounts in certain circumstances.<sup>372</sup>

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*UDRP Process*, BERKMAN CTR. FOR INTERNET & SOC'Y, <http://cyber.law.harvard.edu/udrp/process.html#timeline> (last visited Jan. 7, 2016); *see also* Bluestone, *supra* note 45, at 588 (mentioning "[UDRP proceedings] move quite quickly, requiring the adjudicator to come to a decision within three weeks. In cases where the complainant prevails, the remedy will 'take place 10 days after the decision is issued unless the panel is informed by the defendant that they are initiating court proceedings [via ACPA] on the matter") (internal quotations omitted). The USRP would further streamline this process in order to resolve disputes in 10 to 20 days.

365. *See supra* notes 272–73, and accompanying text. As stated earlier, the average time for intellectual property litigation is three years, but has been seen to last more than seven years. *See supra* notes 272–73, and accompanying text.

366. For a discussion on why such a turnaround would mitigate damage caused by username squatters and recidivist infringers, but not damage caused by a single infringing post, *see supra* note 271–75, and accompanying text.

367. *See supra* note 274–77, and accompanying text.

368. As stated previously, social media websites are vague and ambiguous when discussing how long it takes them to address a complaint, but most complaints are resolved within a few days. *See supra* Part II(A).

369. For a discussion of how litigation ensures that the judiciary uniformly applies the law, *see supra* notes 260–61, and accompanying text.

370. For a discussion on the inconsistency of UDRP decisions, *see supra* notes 313–17, and accompanying text.

371. For a comparison of Facebook's and Twitter's parody account policies, *see supra* Part II(A).

372. *See supra* Part II(A). Facebook had such a strict "real name" policy that

The USRP would eliminate this discrepancy, but does one really want a blanket policy that either bans fake accounts per se or allows parody accounts? Facebook users sign up and use the website knowing that the users behind an account are usually who they say they are.<sup>373</sup> Twitter users, on the other hand, are more accustomed to fake or parody accounts; some users even consider the inclusion of parody accounts to be an added feature.<sup>374</sup> People like to clump these varying social media websites into one “social media” conglomerate.<sup>375</sup> However, each website is distinct and different, so a uniform solution might not be desirable.<sup>376</sup>

Third, the USRP provides users with a more cost effective dispute resolution mechanism compared to litigation. As discussed earlier in the comment, litigation costs regarding trademark and copyright infringement are prohibitive.<sup>377</sup> However, reporting the infringement directly to the social media website is typically free.<sup>378</sup> The USRP would offer users a more traditional forum, similar to a court, while keeping costs down.

Fourth, the USRP offers a more global solution than does filing a lawsuit in a national court. A number of jurisdictional issues regarding the Internet have arisen in recent years.<sup>379</sup> People from

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it received negative backlash after banning some transgender users who had used their chosen name instead of their legal name. See Joseph Patrick McCormick, *Facebook to do Away With ‘Real Name’ Policy*, PINK NEWS (Oct. 31, 2015), [www.pinknews.co.uk/2015/10/31/facebook-to-do-away-with-real-name-policy/](http://www.pinknews.co.uk/2015/10/31/facebook-to-do-away-with-real-name-policy/). In response to this, Facebook made some minor changes to their policy, and now allows users to use “authentic names.” See *id.* Using an “authentic name” allows users to create an account that does not use their legal name, so long as they are using a name that they are known by to family and friends. See *id.*

373. For a discussion of Facebook’s “real person” policies, see *supra* Parts II(A)(1).

374. See Katie Burke, *The 10 Best Parody Twitter Accounts to Follow*, HUBSPOT BLOGS (Feb. 10, 2014), <http://blog.hubspot.com/marketing/twitter-parody-accounts-list> (listing the “top 10 parody Twitter accounts [the author] think[s] you should start following today, along with some shining examples of their tongue-in-cheek Twitter brilliance”).

375. Over half of all Americans use two or more social media websites. *More People Use Multiple Social Media Websites*, PEW RES. CTR. (Jan. 8, 2015), [www.pewinternet.org/2015/01/09/social-media-update-2014/pi\\_2015-01-09\\_social-media\\_09/](http://www.pewinternet.org/2015/01/09/social-media-update-2014/pi_2015-01-09_social-media_09/).

376. For a discussion on how each social media website is distinct and different, see *supra* Part II(A).

377. For a discussion of the high cost of litigation involving intellectual property disputes, see *supra* notes 263–71, and accompanying text.

378. No social media website ever mentions a cost or fee to report infringement. See FACEBOOK, *supra* note 137; see also TWITTER, *supra* note 163.

379. See TTT Nguyen, *A Survey of Personal Jurisdiction based on Internet Activity: A Return to Tradition*, 19 BERKELEY TECH. L.J. 519 (2004) (“By its very nature, the Internet is without boundaries. Any person connected to the Internet can access it and is limited in her activity only by the current state of technology. Additionally, the Internet rapidly changes to adapt to new technological innovations. In contrast, personal jurisdiction doctrine prevents

all parts of the world use social media websites, meaning that initiating litigation and sending a cease-and-desist letter is often futile. Litigation is jurisdictionally bound.<sup>380</sup> An intellectual property owner can sue an infringing user in another country, but this might influence the cost and the predictability of the outcome.<sup>381</sup> Additionally, an intellectual property owner could send a cease-and-desist letter to an infringing user in another country and threaten suit, but the threat might not be as convincing.<sup>382</sup> However, reporting infringement directly to the social media website itself is also multinational.<sup>383</sup> It is clear that a multinational solution is necessary when creating the ideal mechanism for solving trademark and copyright disputes in the social media arena; however, it is unclear whether the USRP would offer a better multinational solution than the current system of direct-reporting.

Finally, the USRP provides for more transparency and predictability in both the application and results of the proceedings compared to takedown requests and cease-and-desist letters. This is vital to the success of any dispute resolution mechanism, and is one of the main benefits of this system over the current system of reporting the infringement directly to the social media website from the user's and general public's point of view.<sup>384</sup> Sending a cease-and-desist letter and filing an infringement report with the social media website lacks transparency in result.<sup>385</sup> Though settling a dispute in court would allow for adequate transparency and predictability, litigation is often not feasible due to the high cost and time required.<sup>386</sup> This factor weighs in favor of adopting a uniform dispute resolution mechanism.

However, when looking at these factors in the aggregate, it seems clear that a USRP is undesirable. The USRP would be slower

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courts from exercising their power beyond the geographical boundaries of their authority. This limitation derives from the interests in protecting defendants against undue litigation burdens and in preventing state courts from infringing upon the sovereignty of other states. The rise of litigation relating to Internet activity raises concerns about applying personal jurisdiction rules developed in geographical space to a means of exchanging information that has no boundaries.”).

380. *Id.*; see also Joseph W. Goodman, *The Pros and Cons of Online Dispute Resolution: An Assessment of Cyber-Mediation Websites*, 2003 DUKE L. & TECH. REV. 4 (2003) (noting “[t]raditional mechanisms [for resolving Internet disputes], such as litigation, can be time-consuming, expensive and raise jurisdictional problems”).

381. See Admin, *Can I Sue Someone in a Foreign Country?*, RYAN ALEXANDER (Aug. 19, 2008), [www.ryanalexander.us/2008/08/can-i-sue-someone-in-a-foreign-country/](http://www.ryanalexander.us/2008/08/can-i-sue-someone-in-a-foreign-country/) (stating that, although sometimes possible, “it is difficult and expensive to sue people in foreign countries”).

382. See *supra* Part II(C).

383. A person from any country can file an infringement report to any of the three social media websites discussed earlier. See *supra* Part II(A).

384. See *supra* note 134–39, and accompanying text.

385. See *supra* Part II(A)–(B).

386. See *supra* Part II(C).

and more costly than the current system of reporting infringement directly to the social media websites.<sup>387</sup> Moreover, a uniform solution would strip social media websites of their ability to build and foster a unique platform and would be no more multinational than the current direct-reporting system.<sup>388</sup> The sole advantage that the USRP would have over users reporting directly to social media websites is its ability to provide users with transparency and predictability. But this begs the question: why not just require more transparency from social media sites?

## VI. THE BEST SOLUTION: MAKING CHANGES TO THE CURRENT DIRECT-REPORTING SYSTEM

There is a definite need for transparency and predictability in the administration and creation of intellectual property policies on social media websites; however, this problem could be solved without the creation of a USRP. When discussing what an ideal resolution would look like, it is important to analyze the various parties involved and how their goals differ. An ideal solution would balance protecting the rights of intellectual property owners with protecting the rights of the public and those accused of infringement. A trademark or copyright owner usually just wants the infringing material removed.<sup>389</sup> This group would be happy with a system that quickly and inexpensively removes infringing material, even if such a system lacks transparency and fairness in decisions.<sup>390</sup> Social media users, on the other hand, would prefer a

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387. For a discussion of the cost and time involved with reporting infringement directly to social media websites, see *supra* notes 185–87, and accompanying text (providing an example of how Twitter only took 48 hours to respond to a takedown request).

388. See *supra* notes 371–83, and accompanying text. As stated earlier, users have different expectations of the different social media websites. See *id.* Users on Facebook expect all accounts to be real, while users on Twitter and YouTube understand and enjoy the fact that some accounts will be fake or parody accounts. See *supra* Parts II(A)(1)–(3).

389. See MELVIN JOSEPH DEGEETER, TECHNOLOGY COMMERCIALIZATION MANUAL: STRATEGY, TACTICS AND ECONOMICS FOR BUSINESS SUCCESS 107 (2004) (discussing the primary considerations of an intellectual property owner). Though, a trademark and copyright owner might also want to determine the identity of the poster and avoid bad publicity. See *id.*

390. *Id.* Of course, IP owners may want transparency if the site refuses to remove the infringing material (they want to know why) and want a system that is “fair” to them. *Id.*; see also MCGRADY, *supra* note 1, at § 12.03 (“The difficulty and high costs of protecting numerous brands and monitoring an ever-expanding number of social media sites is unaffordable for many small or mid-sized companies who look to the Internet as a low-cost way of publicizing and running their businesses. As such, those companies face a much higher possibility of suffering from consumer confusion and brand dilution online, which could go on undiscovered for great lengths of time. The resulting uncertainty trickles down to consumers who cannot trust the authenticity of brands with which they might otherwise confidently conduct business online[.]”)

transparent and consistent system.<sup>391</sup> Without transparency and consistency, it would be difficult for users to determine whether their posts infringe on another's rights. Such confusion could ultimately lead to fewer (or different) posts, which would constrain the goals of users and social media sites. This could ultimately hurt a third group, the general public, by stifling free speech and discussion. The general public wants a system that balances all of the goals: fairness, accuracy in decisions, consistency, cost, time, and transparency.

An ideal solution would provide the copyright and trademark owners with a quick and inexpensive resolution of disputes. The ideal solution's decisions would be accurate and consistent, and the administration of its policies would be transparent from the initial submission of the dispute to the final decision. Though creating the USRP as a fourth solution might make achieving these goals attainable, its creation is plainly unnecessary. Each of these goals can be satisfied through the existing framework of reporting the infringement to the social media site, so long as fundamental changes are made.<sup>392</sup>

Reporting infringement directly to the social media website is inexpensive, easy, and quick—all positives for intellectual property owners.<sup>393</sup> However, it lacks transparency, which makes it unclear whether this option optimizes fairness, accuracy in decisions, and consistency—all negatives for users and the general public.<sup>394</sup> Ensuring that social media websites are more transparent would make that option more ideal for all parties involved.

In order to determine how to make the social media websites more transparent, it is important to remember why the websites

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.] While the high costs of protecting brands may be difficult for many smaller companies, those costs are prohibitive for individuals who likely do not have the manpower to monitor every possible site requiring a username. The result is that individuals seeking to provide products or services via their social media presence or individuals who are the targets of bullies may suffer at the hands of a competitor or inadvertent infringer without their knowledge for a protracted period of time. Those same individuals, upon discovering that their usernames have been abused, will then face uncertainty as to how to proceed, depending on the platform at issue and the exact manner of the abuse. A uniform rule and procedure regarding username disputes will give everyone—both victims and transgressors—more security regarding the consequences of their actions.”)

391. See DEGEETER, *supra* note 391, at 107–08 (discussing the primary considerations for those concerned with being accused of infringement); see also MCGRADY, *supra* note 1, at § 12.03 (stating that “[a] uniform rule and procedure regarding username disputes will give everyone—both victims and transgressors—more security regarding the consequences of their actions”).

392. For a discussion of the existing framework, see *supra* Part II(A). That section provides an in depth discussion of the various internal policies of social media websites—Facebook, Twitter, and YouTube—and how they compare with one another. See *supra* Part II(A).

393. See *supra* note 133, and accompanying text.

394. See *supra* note 134, and accompanying text.

currently lack transparency. As discussed previously in this paper, Facebook, Twitter, and YouTube are unclear in their internal decision making process.<sup>395</sup> The various policies differ on substantive issues, and the policies are often vague and difficult to understand.<sup>396</sup> Additionally, the websites do not publish decisions and take down requests, and do not mandate a time frame for the process.<sup>397</sup> This has lead some people to describe the decision making process as a black box, as “only a few providers systematically release notices and none explicitly describe their procedures.”<sup>398</sup>

For the current system to maximize the goals set forth above, social media websites must be clearer about their policies. They must inform users of how long it will take to address infringement issues, when they can expect a decision to be issued, and the standards used to warrant a take down. The social media websites must work with one another to create coherent policies.

Further, social media websites must be more transparent about their actions and the decision making process. They should publish every takedown request received, or be required to submit such takedown requests to third-party websites that collect data on the matter.<sup>399</sup> Moreover, social media websites must release information on the result of the takedown requests. Such a database that details which alleged infringements are in violation of the policies and which alleged infringements are not in violation of the policies, would give users a level of predictability that is lacking from the current system.<sup>400</sup> It is true that this system would likely increase costs for social media websites; they would need to spend more time creating a written “opinion” that sets forth the reason for

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395. See *supra* notes 135–39, and accompanying text. McGrady states that “even three of the largest social media sites [Twitter, Facebook, and LinkedIn] have vastly different approaches to username squatting and users’ rights.” See MCGRADY, *supra* note 1, at § 12.03. He goes on to state that these “differing approaches to username disputes must logically lead to inconsistency of outcomes.” See *id.* And even if the outcomes are similar, this inconsistency in approach, at the least, “renders planning and prediction nearly impossible for users desiring to protect their names or brands.” See *id.*

396. See *supra* notes 134–36, and accompanying text.

397. See *supra* Part II(A). Although some takedown requests are sent to third-party websites, the results of those requests are never released. See *supra* note 139, and accompanying text (describing how websites like *Chilling Effects* and *The Takedown Project* publish some social media takedown requests). Not all social media websites provide takedown requests to these third-party websites, however, and those that do often redact so much information that the takedown request is rendered moot as a predictive tool. See De Ruyck, *supra* note 139; CHILLING EFFECTS, *supra* note 128; TAKEDOWN PROJECT, *supra* note 139.

398. See De Ruyck, *supra* note 139.

399. For a discussion on websites that collect data on takedown requests, see *supra* note 139.

400. For a discussion on the lack of predictability in the current self-reporting system, see *supra* notes 135–39, and accompanying text.

their decision. However, Congress could incentivize such action by requiring publication of this information in return for a safe harbor defense. Ultimately, implementing these policies would solve the inadequacies of the current self-regulatory mechanism without the need to create a new mechanism.

## VII. CONCLUSION

For the aforementioned reasons, a USRP, while possibly attainable, is not desirable. Regulation by social media websites, if modified as suggested, is the best option for both the infringer and the infringed. It is easy to clump social media websites together and talk about them as one entity; however, they are distinct entities with distinct goals and users.<sup>401</sup> While users on Facebook expect accounts to be an accurate portrayal of the user behind it, users on Twitter and YouTube are aware that many accounts are parodies.<sup>402</sup> It would be undesirable to create one policy to satisfy both groups.

Reporting infringement directly to the social media website is far from perfect. Its biggest issue is lack of transparency. Social media sites must work with one another to create coherent and cohesive policies. The policies should clearly state how long it will take for a decision to be issued. Further, in order to foster transparency, websites should publish every takedown request they receive and the result of the request.

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401. *See supra* notes 371–76, and accompanying text.

402. *See supra* notes 373–74, and accompanying text.