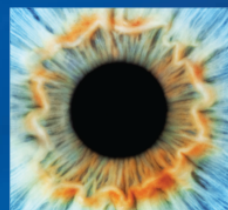
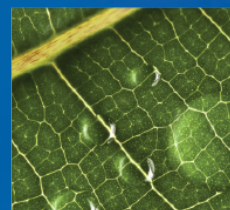
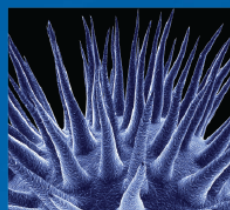
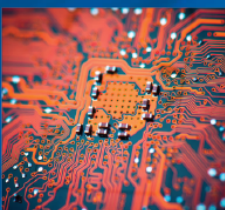


# Ethical Brand Protection in the Age of Social Media: Fair Ball or Foul?

September 11, 2018

ACC-SoCal Doubleheader

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## Presentation Goals

- WHAT - Build and maintain strong **brand equity** through proper trademark policing
- HOW - Protect the brand via a **custom enforcement strategy**
- CONSIDERATIONS - Promote **ethical investigations** in connection with brand usage and enforcement
- INVESTIGATORS – Preserving ethics obligations with **investigators**
- COMMUNICATIONS - Understand the **limits** of attorney-client privilege regarding **in-house** counsel
- PRACTICAL TIPS - Tips for working **with platforms** and their takedown procedures

## Protecting Brand Equity

### ***Build your Brand Equity!***

- Ensure consistent usage and obtain protection
- Use marks as a brand

### ***Police OTHERS using your marks!***

- Monitor your mark
- Keep a log of usage incidents
- Obligation of the trademark owner

## Trademark Policing Overview

- **Consistent Enforcement** to avoid encroachment and abandonment of rights
  - **Worldwide Watching** services
  - **Cease and Desist** letters
  - **Notices and Takedowns** for online infringement
  - **Litigation** when necessary
  - Record key registered marks with **Customs**
- **Considerations** for your enforcement strategy
  - Potential **PR** issues
    - Cease and Desist letters get leaked/posted online
  - Make sure the strategy is in line with your **overall brand**

## Scenario

- Los Angeles Angels' business team has identified an online infringer selling Angels merchandise. The infringer Angel Mania is an unauthorized seller of Angels products.
- In addition to website, Angel Mania has corresponding Twitter, Facebook, and Amazon accounts.
- The Twitter page looks almost identical to the Angels authorized Twitter page. The Twitter page is trying to attract followers to its account.
- The Facebook page is promoting these infringing products, and Angel Mania is selling products on Amazon.
- Depending on team workflow, you may handle in-house or refer to outside counsel or use an investigator.



## The Ethics & Types of Trademark Investigations



- Trademark-in-use Investigations
- Trademark Infringement Investigations
- Counterfeit Investigations

## Pretext Investigations

**WHAT?** undercover investigation involving use of pretense, subterfuge or pretext

**HOW?** pose as consumers, purchasers or counterfeiters

**WHEN?** any time including before or after litigation has started

**WHY?** to gather evidence not otherwise discoverable, because the alleged infringer would not cooperate, and to ascertain (1) how the alleged infringer or counterfeiter presents himself to the consuming public or (2) the source of infringing or counterfeiting goods

**WHO?** attorneys, investigators or parties may explicitly or implicitly misrepresent who they are; may misstate the purpose of their visit, questions or interviews; and may secretly tape record, photograph or videotape others during the visits (to the extent permitted by law)

## Examples of Things Investigators Do

Visit stores, speak to salespeople, determine who the owner of the store is and ascertain the scope of the infringing activity

Take pictures of store windows displaying infringing goods, buy infringing goods and speak with sales reps to assess how they present the products to consumers





## Examples of Things Investigators Do



**Contact online sellers, exchange communications with sellers and purchase infringing goods to ultimately identify sellers and ascertain domiciles**

**Visit defendant's stores, speak to defendant's salespeople and record conversations with defendant's low-level employees to gather evidence for a lawsuit as to defendant's representations to consumers regarding the infringing or counterfeit goods**

**RECORDING  
IN PROGRESS**

## Ethical Rules

<b>RULES</b>	<b>SUBJECT</b>
New CA Rule 4.1(a)	Truthfulness in Statements to Others
New CA Rule 4.2	Communication With a Represented Person
New CA Rule 4.3	Communicating with an Unrepresented Person
New CA Rule 8.4(c)	Misconduct
New CA Rule 8.4(a)	Professional misconduct for a lawyer to knowingly assist, solicit or induce another to violate the rules
New CA Rule 5.3(c)	Responsibilities Regarding Nonlawyer Assistants

## Rule 4.1(a)

### Truthfulness in Statements to Others:

In the course of representing a client a lawyer shall not **knowingly**:

- (a) make a **false** statement of **material** fact or law to a third person; or
- (b) fail to **disclose** a material fact to a third person when disclosure is necessary to avoid assisting a **criminal** or **fraudulent** act by a client, unless disclosure is prohibited by B&P Code section 6068(e)(1) or rule 1.6 (confidential information of a client).

## Rule 4.2

### Communication With a Represented Person:

- (a) In representing a client, a lawyer shall not communicate directly or indirectly about the **subject of the representation** with a person the lawyer **knows** to be represented by another lawyer in the matter, **unless** the lawyer has the consent of the other lawyer.  
...
- (c) This rule shall not prohibit ... communications otherwise authorized by law or a court order.

## Rule 4.3

### Communicating with an Unrepresented Person:

- (a) In communicating on behalf of a client with a person who is not represented by counsel, a lawyer shall not **state** or **imply** that the lawyer is **disinterested**. When the lawyer knows or reasonably should know that the unrepresented person **incorrectly believes** the lawyer is disinterested in the matter, the lawyer shall make reasonable efforts to **correct the misunderstanding**. If the lawyer knows or reasonably should know that the interests of the unrepresented person are in conflict with the interests of the client, the lawyer shall not give legal advice to that person, except that the lawyer may, but is not required to, advise the person to secure counsel.

## Rule 8.4(a) & (c)

### Misconduct:

It is professional misconduct for a lawyer to:

(a) violate these rules of the State Bar Act, **knowingly assist**, **solicit**, or **induce** another to do so, or do so through the acts of another . . .

(c) engage in conduct involving **dishonesty**, **fraud**, **deceit** or reckless or intentional **misrepresentation** . . .

## Rule 5.3(c)

### Responsibilities Regarding Nonlawyer Assistants:

With respect to a nonlawyer employed or retained by or associated with a lawyer:

(c) a lawyer shall be **responsible** for conduct of such a person that would be a violation of these rules of the State Bar Act if engaged in by a lawyer if:

(1) the lawyer **orders** or, with the **knowledge** of the relevant facts and of the specific conduct, **ratifies** the conduct involved; or

(2) the lawyer, individually or together with other lawyers, possesses managerial authority in the law firm in which the person is employed, or has direct **supervisory authority** over the person, whether or not an employee of the same law firm, and **knows** of the conduct at a time when its consequences can be avoided or mitigated but fails to take **reasonable remedial action**.

## Practical Tips Based on Opinions & Cases: Attorneys

- Remember to check each state's local ethics rules.
  - Some state regulations restrict more conduct than the Model Rules of Professional Conduct.
- Direct your investigators/support staff to only seek and gather information that is publicly available.
- Use of investigators should be reserved for:
  - Situations where there is no other way to gather the information; and
  - When the matter at issue involves a potential violation of the law, rather than a simple information gathering technique.



## Practical Tips Based on Opinions & Cases: Investigators

- Obtain information from one who deals with the general public, not a member of management or a control group of the company.
- Seek information available to the public, so that investigator does not have to trick anyone into making admissions or violating the attorney-client privilege.
- Investigation is more likely to be upheld if it is directed to potentially criminal behavior or other violations of the law (and attorney has good faith belief that violation is taking place or is imminent), rather than to obtaining information on TM use or to obtain favorable trademark purchase.

## Preserving Ethics Obligations with Investigators

- Check the ethical rules (and legal decisions) of attorney's jurisdiction, jurisdiction(s) where investigation takes place and jurisdiction of any proceeding that may use the information obtained.
- Provide your investigator with written instructions as to the goal/objectives of the investigation and include any restrictions that are applicable to the investigation.
- Documenting transactions in the ordinary course of business is generally permitted, but using audio or video recordings will depend on applicable laws.
- Be aware of the differences between pre-litigation investigations and pending litigation investigations.

## Communications – Protecting the Attorney/Client Privilege

- ***Michael Cohen criminal investigation***
  - Judge ruled over 600 documents of 1,262 were not privileged
- ***Consequences of Breaking or Overuse of Privilege***
  - Loss of attorney-client privilege!
- ***Breach is often unintentional***
  - Casual forwarding, adding cc's, email chain turns into other discussions
  - Nonlawyers may not understand consequences (educate)

## What Is Covered By Attorney-Client Privilege?

- Attorney-client privilege protects the following from compelled disclosure:
  - **Communication**(s);
  - Made in **confidence**;
  - Between an **attorney** (or their agent);
  - And a **client**;
  - For the **primary purpose** of seeking legal advice or assistance.

*See United States v. United Shoe Mach. Corp.*, 89 F. Supp. 357, 358 (D. Mass. 1950).

## Protecting Attorney/Client Privilege with Outside Counsel

- Not all communications protected
- Use, but don't overuse "Attorney/Client Privilege" designation
- If concerned, pick up the phone

## Protecting Attorney-Client Privilege – Inhouse Counsel

- The nature of an in-house attorney's job makes attorney-client privilege more complicated.
  - Mixed **legal** and **business** roles lead courts to be hesitant to give in-house counsel broad privilege protection.
  - Identifying whether the client is the corporate **entity** or the individual **employee** is sometimes difficult.
  - Involving in-house counsel does **not** automatically extend attorney-client privilege to all corporate communications.
    - See *Diversified Industries Inc. v. Meredith*, 572 F.2d 596, 602 (8th Cir. 1977).

## Who Is Covered by Attorney-Client Privilege?

<b>Job Title</b>	<b>What Capacity Was The Action Taken Under?</b>	<b>Is It Privileged?</b>
In-house Counsel	Legal Capacity	Likely
In-house Counsel	Business Capacity	Not Likely
Legal Support Staff	Legal Capacity	Likely
Legal Support Staff	Business Capacity	Not Likely
Non-legal Employees	Working with Legal	It Depends
Non-legal Employees	Working Independently	No

## In-House Counsel

- Privilege protection depends on whether the communication was primarily **legal** or **business** related.
- Important to specify **who** the client is during corporate interactions.
  - i.e., either the business entity or the individual employee
- Courts use **two tests** to see whether in-house communications should be privileged.



## In-House Counsel: Two Tests

- The “But For” Test
  - Communications should only be privileged if the communications would **not** have occurred **but for** the client’s need for legal advice or services.
    - See *First Chicago Int’l v. United Exch. Co.*, 125 F.D.R. 55, 57 (S.D.N.Y. 1989).
  
- “Primary Purpose” Test
  - For privilege to apply, the asserting party must establish that the **primary purpose** of the communications was providing legal services.
    - See *United States v. Cohn*, 303 F. Supp. 2d 672, 683 (D. Md. 2003).

## Legal Support Staff

- When acting as an agent for the in-house counsel, support staff's knowledge and involvement in the communication **does not** violate privilege's requisite confidentiality.
- Support staff need to maintain the same distinctions between **legal** and **business** communications that attorneys do.
- Use of legal support staff does not weaken attorney-client privilege, as long as other precautions are taken.
  - E.g., information not widely disseminated to non-essential staff, do not mix legal and business topics, etc.

## Non-Legal Employees

- Non-legal employee communications **do not** have any presumption of privilege just because they are communicating with the legal department.
  - Communications must meet the **four requirements** of privilege to qualify:
    - (1) Communication; (2) between attorney & client; (3) in confidence; (4) primarily seeking legal advice.

### Reminders For Employees:

- Having a lawyer in the room, or CC'ed on an email chain, **is not** sufficient to protect all communications.
- Attorney-client privilege is not the same thing as confidentiality.

## International Attorney-Client Privilege

- Not every country or jurisdiction gives attorney-client privilege the same weight or protection.
  - E.g., China does not recognize attorney-client privilege, while Russia does not extend attorney-client privilege to in-house attorneys.
  - Many European Union (EU) member countries do not recognize attorney-client privilege for in-house counsel.
- Be mindful of the possible differences when dealing with foreign clients or companies and **do not** assume attorney-client privilege applies or provides the same protections.

## Guiding Principles To Maintain Attorney-Client Privilege

- Clarify the representative relationship with the client.
- Be clear that you are primarily communicating **legal advice** to the client.
- Clarify whether the discussion is primarily legal or business.
- Refresh your understanding of the Model Rules of Professional Conduct involving confidentiality.
- In highly sensitive matters where an investigation is being conducted, consider referring the matter to outside counsel to conduct the investigation, as courts are more willing to uphold the privilege when outside counsel has been retained.

## Practical Tips To Best Maintain Attorney-Client Privilege

- Consider using a **distinct email signature** when primarily communicating about legal issues.
- Coach employees to include **signaling phrases** such as “I need your **legal advice**” or “I have a **legal question**” when contacting the legal department.
- Avoid **mixing** business and legal advice in the same email chain.
- Coach employees to not just “**CC**” the legal department on emails containing potential legal concerns.
- Do not use stock “privilege language” on emails that clearly do **not contain privileged** information.
- Do not **forward** any communications labeled attorney-client privilege. Can easily go to non-essential staff (think about who you are sending to) and cc.

## Working With Social Media Platforms

- Unwanted use of your brand will occur, but how do you deal with it?
- Types of Takedown Methods
  - Online takedown request forms with the platform
  - Demand letters
  - Informal communications with the takedown teams
    - If chronic infringement occurs, building relationships with takedown teams can enable you to submit “mass takedown” requests without needing to use the takedown forms.
  - Formal court proceedings

## What Types of Infringement to Go After on Social Media

- What types of activities should you initiate takedown procedures over?
  - Infringement that has direct impact on the company's **revenue**;
  - Actions that inhibit **marketing**;
    - E.g., fake customer support pages, counterfeit stores, etc.
  - Any usage that you think endangers the company's **reputation** or **brand equity**; and
  - Infringement that does, or could, cause actual consumer **confusion**.



## Creating a Takedown Strategy

- Many types of infringement and many types of responses.
- Company's priorities dictate what level of response is the "default response."
  - Do you want to be known as a strong enforcer or a relaxed enforcer?
- Identify the most common types of infringement, and on what platforms, to develop strategy.
  - Does the platform have a robust takedown response team?
- Amount of resources the company wants to spend on enforcement.
  - If infringement is a chronic problem, consider involving outside counsel, but if infringement is often a one-off problem, an in-house response may be suitable and more economical.

## Requirements for Filing Takedown Requests

- The platforms may request many pieces of information, but the following are generally required:
  - User's name, company name, trademark at issue, and contact information;
  - Registration number, registration agency, goods/services; and
    - Registration is sometimes required to file a takedown request:
      - E.g., Twitter requires registration for filing a takedown notice, while Facebook, YouTube, and Amazon strongly encourage registration.
  - Infringing party, description of infringing activity, and information to locate the infringing content.

## Takedown Forms

- Takedown Considerations
  - Timeline
    - While takedown forms are the most convenient method of enforcement, the responses can be **slow**, **inconsistent**, and **automated**.
  - Each platform will have a different “tolerance” of infringement until they act.
  - Try to **align** your interest with the platform for a quicker response.
  - Remember, you are dealing with platform **policy**, not the **law**.

## Takedown Request Forms: Twitter

[Help Center](#) > [Submit A Ticket](#) > [Report A Violation](#)

### Report a trademark issue

How can we help?

- I have a trademark and someone is impersonating my brand.  
Someone is trying to look like or imply affiliation with my organization.
- I have a trademark and someone is infringing my trademark.  
Someone is using my organization's trademark-protected materials.

Tell us about yourself

- I am a trademark holder.
  - I work directly for the company that holds this trademark.
  - I am an authorized representative, e.g., law firm, marketing or PR company.
- I would like to report misuse of someone else's trademark.

## Takedown Request Forms: Twitter

### Trademark Information

Trademarked word,  
symbol

Please provide the exact registered mark.

Registration number

Registration number should correspond to an active and officially registered trademark. Pending trademarks are not sufficient. If you don't have a registered trademark, you can file a brand impersonation report [using this form](#).

Trademarked goods  
and services class

Registration office

The agency you registered your trademark with, e.g., USPTO.

Direct link to  
trademark record or  
trademark search  
page (optional)

If you have a direct link to your trademark record, please provide that URL.

## Takedown Request Forms: Twitter

### Reported Account

- Platform
- Twitter
  - Vine
  - Periscope

Reported account

Description

Describe the confusion with your trademark. For more information, please see our [Trademark Policy](#). Please note that you may be liable for any damages, including costs and attorneys' fees, if you knowingly materially misrepresent that reported material or activity is infringing. In the event that Twitter is made party to a suit, Twitter will defend its rights vigorously and seek fees and costs associated with such defense.

### Required statements

- Copy of Report
- I understand that in order to process this notice, Twitter may provide third parties, such as Lumen and the affected user, with a copy of this complaint.

- Authority to Act
- I am authorized to act on behalf of the trademark holder.

## Takedown Request Forms: Facebook

### Reporting a Violation or Infringement of Your Rights

What right is being violated or infringed?

Copyright

Trademark

If you believe content on Facebook violates our [Community Standards](#) (ex: bullying, harassment, or hate speech), please visit our [Help Center](#) to learn about reporting it to us.

Continue with your trademark report

Learn more about trademark

## Takedown Request Forms: Facebook

**Trademark Report Form**

Use this form to report content that you believe infringes your trademark rights

To be sure you're in the right place, what best describes your issue?

- My account has been hacked
- I lost access to a group or Page I used to manage
- I found a fake profile that is pretending to be me
- I am being bullied or harassed
- I found inappropriate or abusive content
- I want to claim a Page for my business
- I found content which I believe infringes my copyright
- I found content which I believe infringes my trademark

**Submit**



## Takedown Request Forms: Facebook

### Contact Information

Provide your contact information

### Trademark Information

Provide your trademark information

### Content You Want to Report

Provide the content you want to report

### Declaration

Confirm declaration statement

Submit

## Takedown Request Forms: Facebook

### Trademark Information

Provide your trademark information

#### What is your trademark?

Please provide information for one trademark at a time. Note, you will have an opportunity to list additional trademarks below.

#### Where is your trademark registered?

#### What is your trademark registration number (if applicable)?

#### Which categories of goods and/or services are covered by your registration?

#### If possible, please provide a link (URL) leading directly to your trademark registration.

A direct link (URL) will help us process your report.

#### Attachment (optional)

If possible, please provide a scanned copy of your trademark registration certificate(s) or screenshot of your registration on the website or database of the applicable national or community intellectual property office(s). Please note that we only support the following file formats: JPG, GIF, PNG, TIFF and PDF.

I have additional trademarks.

## Takedown Request Forms: Amazon

### Report Infringement



If you are a rights owner with a registered trademark, you may be eligible to enroll your brand in the Amazon Brand Registry. Amazon Brand Registry provides access to powerful tools including proprietary text and image search, predictive automation based on your reports of suspected intellectual property rights violations, and increased authority over product listings with your brand name. To learn more and start the enrollment process, [click here](#).

### Sign in Required

Not Rosaleen? [Sign out](#)

### About Amazon's Report Infringement Form

Amazon's Report Infringement form is intended for use by intellectual property rights owners and their agents to notify Amazon of alleged intellectual property infringements such as copyright and trademark concerns. If you are not an intellectual property rights owner or their agent, Amazon will not be able to process complaints submitted through this form. Please report your concerns to Amazon through the appropriate venue:

- Sellers may use this [contact us form](#) to report inappropriate listings, other sellers, policy violations, etc.
- Buyers may use this [contact us form](#) to report problems with orders, seller policy violations, etc.

### We Do Not Enforce

**Detail Page Ownership and Image Restrictions:** When a detail page is created, it becomes a permanent catalog page on Amazon.com that will remain even if the creator's inventory sells out. Additionally, when you add your copyrighted image to a detail page, you grant Amazon and its affiliates a non-exclusive, worldwide, royalty-free, perpetual, irrevocable right to exercise all rights of publicity over the material.

Other sellers can list their items for sale against pages that you have created or added your copyrighted images to. However, we do require sellers to list only against detail pages that exactly match their items. If you believe sellers are listing against detail pages that do not exactly match their items, we ask that you report the violation directly by using the [contact us form](#).

If your copyrighted image has been added to our catalog without your consent, please complete the form below.

**Exclusive or Selective Distribution:** Amazon respects a manufacturer's right to enter into exclusive distribution agreements for its products. However, violations of such agreements do not constitute intellectual property rights infringement. As the enforcement of these agreements is a matter between the manufacturer and the retailers, it would not be appropriate for Amazon to assist in enforcement activities.

## Takedown Request Forms: Amazon

**Allegation of Infringement**

Are you the Rights Owner or an Agent?  
 Rights Owner  Agent

The primary complaint pertains to  
copyright concerns - unauthorized use of copyrighted material such as text, photos, ... ▾

The specific concern is  
the physical product or its packaging includes unauthorized copyrighted content or ... ▾

Name of Brand

Please provide one of the following:  
A written description of the copyrighted work

**-OR-**

A link to the copyrighted work

Copyright registration # (optional)

Additional Information

1000

The ASIN (Amazon Standard Identification Number) or the URL of each product you are reporting. You can report up to 50 products for the same specific concern in 1 form. If you have different concerns to report, please submit 1 form for each concern.

ASIN/ISBN-10 -OR- Product URL

## Takedown Request Forms: Amazon

Are you a seller on Amazon?

Yes  No

First Name

Rosaleen

Last Name

Chou

Company(Optional)

Address Line 1

2906 Shoemaker Drive

Address Line 2(Optional)

City

San Mateo

State(Optional)

CA

ZIP Code

94403

Country/Region

United States ▾

Phone Number

(415) 606-8790

E-mail Address

rosaleenchou@gmail.com

### Secondary Contact Details

The contact details which we will provide to **Third Party Sellers** (if relevant) for queries regarding this notification.

Use the contact details provided above

Name

E-mail Address

### Statements

"I have a good faith belief that the content(s) described above violate(s) my rights described above or those held by the rights owner, and that the use of such content(s) is contrary to law."

"I declare, under penalty of perjury, that the information contained in this notification is correct and accurate and that I am the owner or agent of the owner of the rights described above."

I have read and accept the statements above.

## Takedown Remedies

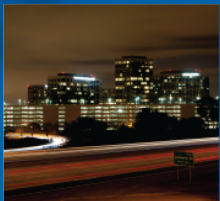
- Remedies vary platform to platform.
- Most platforms will disable the infringing page, but will not transfer the control of the page to the content's rightful owner.
- Available remedies are controlled by the platform's policy, not the available remedies under the law.
- Consult the platform's intellectual property policies for details on available remedies.

## Takedown Effective- Practice Pointers

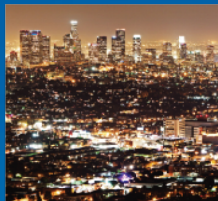
- Copyright infringement tends to work better
- Twitter inactive account policy is effective
- Amazon Brand Registry is a helpful tool
- Develop contacts within platforms
- Follow up is key

Thank You!

Jeff Van Hoosear, Jaime Shean, Rosaleen Chou



Orange County



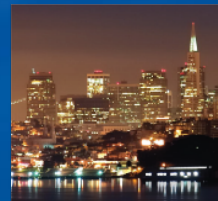
Los Angeles



New York



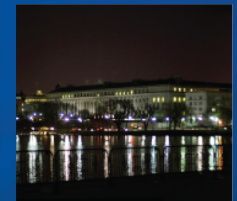
San Diego



San Francisco



Seattle



Washington DC