

Brand protection in the age of social media

Sara Suleiman, IP Attorney at Dinsmore & Shohl LLP, provides five crucial actions required to overcome the new challenges born of this era for protecting against counterfeits on platforms such as Instagram, Facebook and Pinterest.

The advent of social media has permanently transformed the way products and services are marketed and sold. Between Facebook Marketplace, Instagram Shopping, and Pinterest, there seems to be little reason to shop directly on a retailer's website, let alone physically visit a brick-and-mortar store. Social commerce has become especially relevant during the pandemic, due to its integrated and contact-free shopping experience, particularly among Gen Z and millennial consumers. However, these new opportunities and benefits come with inevitable legal and practical challenges, including protecting brand owners' greatest assets amid a virtual minefield of infringing bad actors.

Online marketplaces provide counterfeiters with a certain degree of anonymity and sweeping access to consumers, particularly less sophisticated consumers who are not as familiar with recognizing knockoffs. They also provide access to consumers who are actively looking for luxury knock-offs. Ultimately, this results in loss of industry revenue, reputational harm to brands, and product safety and quality concerns. In order to curtail these effects, experts recommend a combination of the following approaches:



Sara Suleiman

Résumé

Sara Suleiman, IP Attorney

Sara is an intellectual property attorney focused on trademark, copyright, and advertising matters. She also advises clients on the best practices of social media law, including updating social media policies, reviewing terms of conditions and use, and ensuring proper consent when posting photos. She has specialized knowledge to assist clients who frequently run marketing and promotional campaigns, including key word advertising, sweepstakes and contest promotions.

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1. Develop a strong IP portfolio

Before going out to the battlefield, soldiers have to first make sure they have the proper weapons and tools to fight. Similarly, the first step companies should take to protect their IP on social media is to develop and maintain a strong IP portfolio. Without adequate trademark registrations, enforcement becomes increasingly difficult, as many social media platforms require a registration in order to effectuate a takedown.

When assessing current prospective IP portfolios, companies should look strategically at their operating countries as well as future countries of interest in determining in which jurisdictions to file trademark applications, making sure to take advantage of any Paris Convention priority benefits where possible. That said, to help address the counterfeiting problem specifically, companies should seriously consider pursuing intellectual property protection in China, where over 70% of the world's counterfeit goods are sourced from, according to the Global Intellectual Property Center. This is true even for companies with no business operations or sales in China, as China is a first-to-file jurisdiction with relatively inexpensive filing fees. Obtaining trademark protection in China can be a key weapon in a company's IP arsenal.

2. Maintain pages on select social media platforms

Companies should also preemptively assess which social media platforms are most important to them and make sure they have claimed those pages as their own. The particular platform will depend on each company's marketing strategy, audience, and industry, but a few of the most popular include Instagram, Facebook, Twitter, and YouTube. Companies should not only claim those accounts with their business names, but they should also have a real presence on each platform, so that users can clearly compare their pages with impersonators.

One way to distinguish an authentic account from an impersonating account is to obtain a "verified" badge, which is oftentimes recognized as the blue check mark next to the account name. For example, on Facebook, Instagram, and Twitter, the blue check mark means that the platform has confirmed that the account is the authentic presence of the public figure, celebrity, or brand it represents. This will help ensure that when users search for the account, the verified account rises to the top of any searches.

3. Utilize on-platform takedown tools

All major social media platforms have reporting tools that can assist with taking down infringing

accounts and content. Although these are not an end-all-be-all, they are a relatively effective method of removing third-party content that violates IP owners' rights.

Most of these tools are similar in that IP owners will need to submit the following information:

- The name and contact information of the owner of the IP;
- Any relevant trademark registrations, including the class and jurisdiction;
- Links to the infringing pages and/or accounts;
- A brief description of why the pages and/or accounts infringe on the owner's IP.

Traditionally, these tools may have been used to remove third parties who are merely displaying a logo without permission, or if a third-party account uses the IP owner's trademark within its account name. However, recently, the development of social media marketplaces have made it easy for bad actors to go a step further and actually sell their infringing products on these same platforms.

For example, Instagram Shopping allows sellers to set up a customizable storefront where users can shop directly on business profiles. Users can browse products, explore collections, and even purchase products, all without ever leaving the Instagram app. On one hand, this can be helpful and convenient for users who are looking for a quick and easy way to buy that new Ralph Lauren fragrance that Gigi Hadid endorsed. On the other hand, it has proved to be a counterfeit disaster for the fashion industry.

The long and short of it is that IP infringers manipulate Instagram to advertise their fake products. Links for advertisements lead consumers off site, where counterfeits can be sold. Even on the Instagram platform itself, infringers have leveraged Instagram stories to market their counterfeit products without leaving a long-term footprint. The data analytics firm Ghost Data conducted a study in 2019, which revealed that the number of counterfeit accounts active on Instagram has grown by 171% since 2016. In this study, China came out as the top country of origin for Instagram counterfeiters, followed by Russia, Indonesia, Ukraine, Turkey and Malaysia. Louis Vuitton, Chanel, Gucci, and Nike were the most counterfeited fashion brands.

Brands can start out with combating online piracy by monitoring these social media platforms, identifying counterfeit products on each platform and filing the appropriate takedown requests. That said, once the request

is submitted, that does not necessarily guarantee that the content will be removed. Many of these social media have non-attorneys working as the first line of contact in fielding these requests who may not necessarily undertake an accurate legal review. In other cases, the infringer may take the position that their content is not infringing and refuse to comply. Here, companies should assess the situation with an experienced IP professional in order to potentially conduct an investigation, send a cease-and-desist letter, etc. Another more complicated issue that companies often face in the digital world is that although a social media platform might remove a particular link or page, the infringer may continue to re-post the same or similar content that was already removed. Then, IP owners are forced to send multiple takedown notices without any permanent resolution achieved through the takedown process.

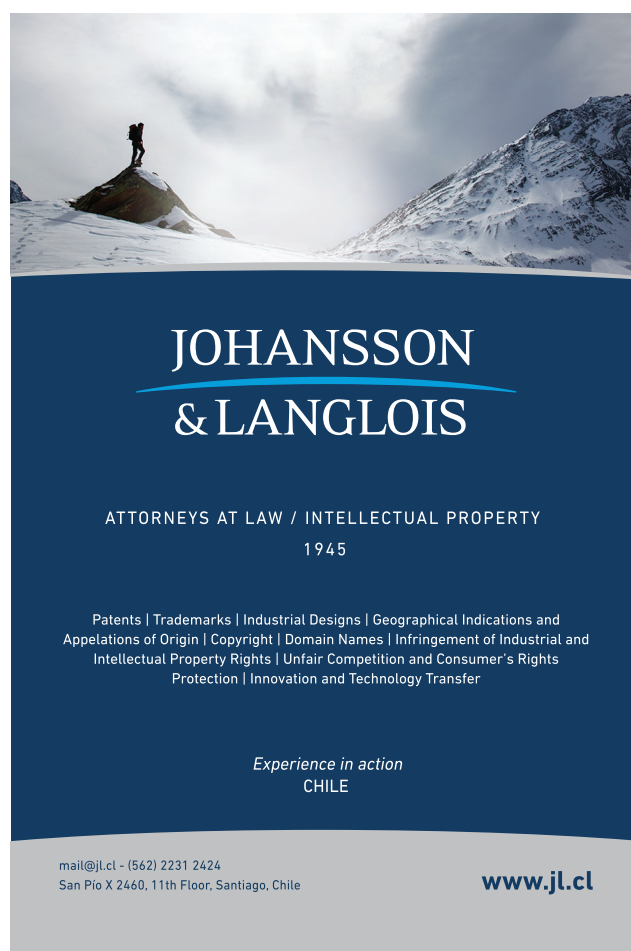
4. Educate Consumers

A brand's consumers are key allies in battling counterfeits. Brands should invest in educating their customers about the dangers of buying from unauthorized sources, as well key identifiers that can help them distinguish between fake and real products.

For example, Chanel has a page on its website exclusively dedicated to fighting counterfeits. Although Chanel does not provide the public with detailed information on how to identify genuine Chanel products, as this would provide too much of a detailed guide for counterfeiters to follow, it does provide some helpful tips. For example, Chanel suggests that consumers look for errors in the details of the products, such as poor stitching, misspellings, or mistakes in the logo. They also encourage consumers to only buy from authorized Chanel vendors and to avoid flea markets, street vendors and unauthorized websites.

From an online perspective, when encountering too-good-to-be-true products on social media, consumers may notice that illicit accounts tend to display amateur-looking photos, spelling mistakes and obscure account names. Further, these bad actors tend to have several similar accounts all trying to sell the same thing. For example, they might have similar account names (e.g. <https://www.instagram.com/kfc312>, <https://www.instagram.com/kfc313>, <https://www.instagram.com/kfc314>, etc.), similar posting behavior and message structure, and similar content. If customers are able to readily recognize these types of bad actors, this

“**A brand's consumers are key allies in battling counterfeits.**”



will assist brand owners in continuing to provide the high-quality, sought-after products that its fans know and love.

5. Use artificial intelligence object recognition to spot counterfeits

Traditional monitoring and enforcement strategies are important, but with the advent of new technology, brand owners should also consider utilizing AI object-recognition software to enhance their enforcement capabilities. Where brand owners might otherwise search via key-word for infringements online, this technology is particularly helpful to find parties who do not necessarily use the exact name of the brand in text form. Specifically, object recognition can be used to identify products within photos or images, which involves identifying shapes, dimensions, logos, and other key elements. Some of the leading companies in this space include LogoGrab, Clarifai, BrandWatch, and GumGum.

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learning technology. That said, these issues can quickly escalate and become quite complicated, so hiring an IP lawyer can be a brand's best move to protect its assets.

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