

2020

The Power of Social Media as an Evolving Force and its Impact on Intellectual Property

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Recommended Citation

Alston, Whitney N. (2020) "The Power of Social Media as an Evolving Force and its Impact on Intellectual Property," *Cybaris®*: Vol. 11 : Iss. 2 , Article 3.

Available at: <https://open.mitchellhamline.edu/cybaris/vol11/iss2/3>

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THE POWER OF SOCIAL MEDIA AS AN EVOLVING FORCE AND ITS IMPACT ON INTELLECTUAL PROPERTY

BY WHITNEY N. ALSTON¹

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I. INTRODUCTION

Social media is the newest craze composed of various websites and applications which allow users to create and share content as well as participate in social networking by sharing or viewing “information, ideas, personal messages, and other content.”² The more commonly known websites and applications of social media include: “Facebook, Twitter, Google+, Instagram, YouTube, Tumblr, Vimeo, Wikipedia, Pandora, LinkedIn, Kickstarter, Reddit, [and] Pinterest.”³

Despite the above list of social media platforms, the first social media platform, Six Degrees, was created in 1997⁴ and unlikely known to social media users today. Six Degrees was quickly overshadowed in 2003 with the emergence of what many consider the first social media platform, Myspace. Myspace gained extreme popularity in the early 2000s with “about 250 million users in the United States.”⁵ Myspace allowed users to express themselves through coding a variety of page designs, “photographs, videos, and other information”⁶ that the user chose to share with others on Myspace.

Today, social media has evolved from simply communicating with friends to a network for staying in touch, communicating, marketing, branding, and business expansion. The addition of marketing, branding, and business expansion to the social media model requires additional rules and regulations. Due to the expanded use of social media, intellectual property is now also an important component.

² Sublet v. State, 113 A.3d 695 (Md. 2015).

³ 2B Nichols Encyclopedia of Legal Forms Annotated *Social Media Services Consulting Contract—Description of Duties of Provider* §43:99.50 (2019).

⁴ Force v. Facebook, Inc., 934 F.3d 53 (2d Cir. 2019).

⁵ Niraj Chokshi, *Myspace, Once the King of Social Networks, Lost Years of Data from Its Heyday*, N.Y. TIMES, (Mar. 19, 2019).

⁶ Doe v. Myspace, Inc., 528 F.3d 413 (5th Cir. 2008).

II. THE FUNCTION AND EVOLUTION OF SOCIAL MEDIA

A. BIRTH OF SOCIAL MEDIA

Serial entrepreneur, Andrew Weinreich, founded the first official social media networking website 1997, Six Degrees.⁷ Users of the groundbreaking site were able to upload pictures and connect with other users, but that was about all they were able to do. The functionality of the website was very limited and did not offer users much else to do. During the lifetime of Six Degrees, the internet was still very new and not many people were connected, which coupled with the lack of functionality and growth, led to its demise in 2001⁸.

Myspace learned from the mistakes of the social media pioneer Six Degrees. Myspace was founded in 2003 and gained much traction in the social media market becoming “the most-visited website in the United States.”⁹ Access to additional features set Myspace apart from Six Degrees which contributed to their rise but also their fall. Though the additional features attracted more users, Myspace was a bit overzealous in their offerings and could not keep up with the rapidly developing technology. Despite this cripple in technological expertise, they insisted on developing their features in-house rather than utilizing a third-party developer, which created faulty products.¹⁰

⁷ Kent Anderson, *Six Degrees of Facebook*, MEDIUM, (Jan. 26, 2018), https://medium.com/@kentanderson_17716/six-degrees-of-facebook-285adb9cfd2.

⁸ *Then and Now: A History of Social Networking Sites*, CBS NEWS, <https://www.cbsnews.com/pictures/then-and-now-a-history-of-social-networking-sites/2/>.

⁹ Niraj Chokshi, *Myspace, Once the King of Social Networks, Lost Years of Data from Its Heyday*, N.Y. TIMES, (Mar. 19, 2019), <https://www.nytimes.com/2019/03/19/business/myspace-user-data.html>.

¹⁰ Amy Lee, *Myspace Collapse: How the Social Network Fell Apart*, HUFFPOST, (June 30, 2011), https://www.huffpost.com/entry/how-myspace-fell-apart_n_887853.

When they finally decided the company needed a bailout, they looked to capitalize on the \$900 million deal offered by Google in exchange for advertising on the site.¹¹ The advertising on Myspace doubled, due to this deal, and congested user pages which was an “eyesore.”¹² The reputation and image of Myspace quickly began to tarnish and many users quickly flocked to Facebook which seemed more like a social media haven than the “digital ghetto” Myspace had become.¹³ Though the website still exists, it can be said the ultimate demise of Myspace came in 2011 when it was sold.¹⁴

Facebook was founded in 2004, a year after Myspace.¹⁵ Facebook, initially started as “thefacebook,” was unique due to its exclusivity.¹⁶ Initially only offered to students at Harvard University, it became available to “nearly all universities in the [United States] and Canada” by the end of the year.¹⁷ By September 2005, Facebook expanded its services to select high schools, employees of Microsoft and Apple and college students with college email address.¹⁸ Facebook featured the same social communication and entertainment held by its predecessors but in 2007 also incorporated “Marketplace” and “Pages for Businesses.”¹⁹ Marketplace and Pages for Business allowed Facebook users to sell products and services while advertising and marketing on business like pages instead of a personal page.²⁰ Facebook brought about the evolution of social media networking with the incorporation of services to assist businesses.

¹¹ LiveUniverse, Inc. v. MySpace, Inc., No. CV 06-6994 AHM(RZx), 2007 U.S. Dist. LEXIS 43739 (C.D. Cal. June 4, 2007).

¹² Lee, *supra* note 9.

¹³ *Id.*

¹⁴ Chokshi, *supra* note 8.

¹⁵ *In re Facebook, Inc. Sec. 220 Litig.*, Consolidated C.A. No. 2018-0661-JRS, 2019 Del. Ch. LEXIS 197, at *13 (Del. Ch. May 31, 2019).

¹⁶ Joshua Boyd, *The History of Facebook: From BASIC to Global Giant*, BRAND WATCH, (JAN. 25, 2019), <https://www.brandwatch.com/blog/history-of-facebook/>.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.*

²⁰ *Id.*

B. THE BARRIERS FOR EARLY SOCIAL MEDIA PLATFORMS

As described above, the advancement of social media has been significant. Though the initial social media websites did not last long, they set the stage and provided precedent for what social media has grown into currently in 2020.

The failure of the early social media websites was not necessarily due to the error of the company but many indirect influences. Six Degrees was founded when the internet was still a new concept thus there was not widespread availability like today. Internet was introduced to the public around 1992 and in 1997 when Six Degrees originated, only about “10% the country was online.”²¹

Dial up internet, the first type of internet connection,²² was the only option available during the lifetime of Six Degrees and when Myspace started. This archaic type of internet connection has slow connection speeds and “required a phone-line to operate, so phone calls couldn’t be made using a landline while the internet was in use.”²³ Most households only had one phone line so the internet user was required to take a cord out of the telephone and connect it to the computer. In order to receive a phone call or use the phone, the user would need to remove the cord from the computer, causing a loss of internet connection, and inserted back into the phone. Eventually, as the internet became more popular, households would get a second phone line dedicated solely to the internet. However, you can see how this complicated the popularity and constant traffic of early social media platforms.

²¹ Samantha Cossick, *Throwback Thursday: Dial-Up and Our Fondness for the First Internet Connection*, ALLCONNECT, (June 20, 2019), <https://www.allconnect.com/blog/enduring-interest-dial-up-internet>.

²² *Id.*

²³ PLUSNET, *What is the Internet and Who Invented It?*, <https://www.plus.net/home-broadband/content/history-of-the-internet/>.

As technology continued to rapidly change, dial up become nearly obsolete and was replaced by Digital Subscriber Line (DSL), Cable, and Wireless internet which provided must faster connection speeds and are still widely used.²⁴ Likewise, cellular phones advanced in 2000 with the additional of text messaging, internet browsing, data plans, and in 2008 and 2012, respectively, Apple and Google announced their application stores to the world which housed third party applications available to download to the phone.²⁵

The transformation of technology has played a major part in the success of social media. The speed and multitude of options available to access social media allows for convenience amongst all age groups to participate in all the features offered.

C. SOCIAL MEDIA'S INTEGRATION WITH INTELLECTUAL PROPERTY

Social media's expanded use including pictures, photographs, and videos as a matter of socializing and networking permits it to become subject to other business and legal implications. Celebrities and businesses have increasingly become users of social media, but not just in a personal capacity. The content they post on social media may require protection under some intellectual property rights.

Some examples include celebrities sharing photographs taken by paparazzi, businesses marketing their products, and individuals posting videos with licensed music in the background.

²⁴ *Id.*

²⁵ Nidhi Shah, *The Evolution of Mobile Apps – 1994 through 2016*, ARKENE, <https://arkenea.com/blog/evolution-of-mobile-apps/>.

III. THE LAW AND POLICY ISSUES BEHIND INTELLECTUAL PROPERTY

A. FEDERAL REGULATIONS

The nature of the content being displayed on social media platforms may summons the protections of certain federal regulations. These regulations are created by Congress to address social or economic needs or problems.²⁶ In particular, social media contains a lot of substance which may trigger the need to protection an individual's rights in their original works, specifically their intellectual property. Though Congress enacted these types of laws far before the birth of social media, the relevance of these type of regulations are still prevalent. However, there is one caveat, given that these laws were made so long ago, they may not fully capture all aspects of the needed protections because this type of social media influx was likely not foreseeable when these regulations were enacted.

Intellectual property is a

set of intangible rights that authors, inventors, and other creators have in the items they write, invent, or create. To have intellectual property in a thing is to have an effective monopoly on its use, such that the property rights holder may enjoin or recover from others who infringe on the rights through unfair duplication or wrongful use.²⁷

Intellectual property is an overall category for more commonly known terms incorporating trademarks, copyrights, patents, and trade secrets.²⁸ Copyrights and trademarks are the most common types of intellectual property found on social media platforms.

²⁶ Robert Longley, *Logistics Behind US Federal Regulations*, THOUGHTCO., (July 26, 2019), <https://www.thoughtco.com/federal-regulations-3322287>.

²⁷ *Intellectual Property*, WOLTERS KLUWER BOUVIER LAW DICTIONARY (Desk Ed. 2012).

²⁸ *Adams Outdoor Advert., Ltd. v. City of Madison*, 717 N.W.2d 803 (Wis. 2006).

i. COPYRIGHT

A copyright is an exclusive legal right to print, publish, sell, or make copies of an author's original work of literary, musical, dramatic, and choreographic works or motion pictures, pictorial, graphic, or sculptural works while preventing others from doing the same^{29,30}. Copyright must be presented in some form of tangible medium and cannot be "facts, ideas, systems, or methods of operation."³¹ A copyright does not require registration with the U.S. Copyright Office, although it is encouraged if there is a possibility to seek a claim for copyright infringement because this would establish prima facie evidence that one is the owner of the exclusive right of use.³² The reason behind voluntary registration is that a copyright exists in the item once it is created.³³

When an author's original work has been reproduced without the permission of the original author, that is considered copyright infringement. The court in *Stockart.com, LLC v. Caraustar Custom Packaging Grp., Inc.*, defines copyright infringement as the "unauthorized distribution of a copyrighted work" even when the distributing party is not aware that he is infringing on a copyright owner's copyright.³⁴ When a copyright has been infringed upon, they may bring a cause of action within the courts. There are several federal regulations that allow a copyright holder to have a cause of action.

a. COPYRIGHT ACT OF 1976

The right of a copyright owner to have a cause of action against an infringer who "displays, distributes, or publishes his copyrighted materials without permission" is a federal statutory right

²⁹ Copyright Act of 1976, Pub. L. No. 94-553, 90 Stat. 2541 (codified as amended at 17 U.S.C. §102 (2018)).

³⁰ See *Gay Toys, Inc. v. Buddy L Corp.*, 522 F. Supp. 622 (E.D. Mich. 1981).

³¹ U.S. COPYRIGHT OFFICE, COPYRIGHT BASICS, (Circular 1 2019) <https://www.copyright.gov/circs/circ01.pdf>

³² *Ontel Prods. Corp. v. Zuru, Ltd.*, No. 17-cv-03658 (PGS)(LHG), 2018 U.S. Dist. LEXIS 147061 (D.N.J. Aug. 28, 2018).

³³ *Sohm v. Scholastic Inc.*, No. 16-CV-7098 (JPO), 2018 U.S. Dist. LEXIS 53490 (S.D.N.Y. Mar. 28, 2018).

³⁴ *Stockart.com, LLC v. Caraustar Custom Packaging Grp., Inc.*, 240 F.R.D. 195 (D. Md. 2006).

given by the Copyright Act of 1976.³⁵ However, the Copyright Act excludes nonexclusive copyright holders from this right to a cause of action for infringement.³⁶ A nonexclusive copyright is one which gives a license to a third-party to use the copyrighted materials on a shared basis with the original owner and possibly other third-party users.³⁷ The holder of a nonexclusive copyright or licensee does not acquire a property right in the copyright and has no standing to sue for infringement.³⁸

The Copyright Act allows the copyright owner exclusive rights to use his work in six ways: 1) right to reproduce the work, 2) right to prepare derivative works based upon the work, 3) right to distribute copies to the public, 4) right to perform the work publicly, 5) right to display the work publicly, and 6) right to perform by digital audio transmission.³⁹

Based on these exclusive rights, the Copyright Act provides the copyright owner a litany of remedies against the copyright infringer to include, “an injunction to restrain the infringer from violating his rights, the impoundment and destruction of all reproductions of his work made in violation of his rights, a recovery of his actual damages and any additional profits realized by the infringer or a recovery of statutory damages, and attorney’s fees.”⁴⁰

b. DIGITAL MILLENNIUM COPYRIGHT ACT (DMCA)

There was an immense concern amongst copyright owners due to the instantaneous ability to distribute and copy digital works globally.⁴¹ As a response to this concern and the increased modernization of technology, Congress passed the Digital Millennium

³⁵ Copyright Act, codified as amended at 17 U.S.C. § 501.

³⁶ *Id.* at § 201(d)(2).

³⁷ *Kid Stuff Marketing Inc. v. Creative Consumer Concepts, Inc.*, 223 F. Supp. 3d 1168 (D. Kan. 2016).

³⁸ David Nimmer & Melville B. Nimmer, *Nimmer on Copyright* §§10.02[A], [B][4] (1963).

³⁹ Copyright Act, codified as amended at 17 U.S.C. § 106.

⁴⁰ *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417, 434 (1984).

⁴¹ S. REP. NO. 105-190 at 1-2 (1998).

Copyright Act (DMCA) as an effort to update the missing digital and technological information from the Copyright Act of 1976, which became effective in October 2000.⁴² This legislative update was not only to meet demands of the new modern era and digital age, but to also keep federal laws concurrent with the World Intellectual Property Organization (WIPO).⁴³ It is also to note that the DMCA does not apply to trademarks but only to copyrights.⁴⁴

Congress felt the passage of this legislation would address the social and economic problem caused by potential social media copyright infringement because copyright owners were becoming hesitant to make their “works readily available on the Internet without reasonable assurance that they will be protected against massive piracy.”⁴⁵ Conversely, companies with a strong market on the internet feared “unavoidable copyright infringement liability if their customers used internet facilities to infringe.”⁴⁶⁴⁷ Therefore, the DMCA’s goal is to limit liability for the actions of their users while also protecting the copyrighted material of copyright owners.⁴⁸ Though the DMCA limits liability on a service provider, the copyright owner is still permitted to serve a subpoena to the service provider to gain the identity of a person who is claimed to be infringing the owner's copyright or to request the copyrighted work be taken down.⁴⁹

According to DMCA, a service provider is one who offers “the transmission, routing, or providing of connections for digital online communications, between or among points specified by a user, of material of the user’s choosing, without modification to the content of the material

⁴² Digital Millennium Copyright Act of 1998, Pub. L. No. 105-304, § 103, (codified as amended at 17 U.S.C. §1201 (2018)).

⁴³ Chamberlain Group, Inc. v. Skylink Techs., Inc., 292 F. Supp. 2d 1040 (N.D. Ill. 2003).

⁴⁴ Digital Millennium Copyright Act, codified as amended at 17 U.S.C § 1201.

⁴⁵ S. REP. NO. 105-190, at 2 (1998).

⁴⁶ H.R. REP. NO. 105-551(I), at 11 (1998).

⁴⁷ See *In re Aimster Copyright Litig.*, 334 F.3d 643, 655 (7th Cir. 2003).

⁴⁸ Digital Millennium Copyright Act, codified as amended at § 17 U.S.C. § 1201.

⁴⁹ 17 U.S.C § 512(h).

as sent or received.”⁵⁰ The term “service provider” includes social media platforms as their functioning purpose aligns with the definition of the term.

The DMCA has established a “notice and takedown” provision for allegations of copyright infringement on social media.⁵¹ Under this provision, upon the copyright owner’s discovery that the allegedly protect work is posted on social media, the copyright owner must provide a written DMCA takedown notice to the service provide detailing the alleged infringed material.⁵² Upon receipt of the written notice, the service provider “must expeditiously remove or disable access to the alleged infringing material and promptly notify the affected subscriber.”⁵³ The affected subscriber may then file a counter notification asserting the material taken down was by mistake or misidentification or that they are protected by fair use or that the material being their original work.⁵⁴ If a counter notification is received by the service provider, they must replace the material or restore access to the material allegedly infringed and notify the copyright owner within 10-14 business days.⁵⁵ This restoration of the allegedly infringed material can be stopped if the copyright holder has filed “has filed an action seeking a court order to restrain the subscriber from engaging in infringing activity related to the material on the service provider's system or network”⁵⁶ before either the 10-14 day period is up or notification is received from the subscriber, whichever occurs first.⁵⁷

A service provider or social media platform, can avoid liability for involvement in a copyright infringement lawsuit if they “respond[] expeditiously to remove, or disable

⁵⁰ *Id.* at § 512(k)(1)(A)

⁵¹ *Id.* at § 512(c)(3)

⁵² *Id.*

⁵³ *Stardock Sys. v. Reiche*, No. C 17-07025 SBA, 2018 U.S. Dist. LEXIS 222971 (N.D. Cal. Dec. 27, 2018).

⁵⁴ *Id.*

⁵⁵ 17 U.S.C. § 512(g)(2)(B), (C).

⁵⁶ *Id.*

⁵⁷ *Stardock*, 2018 U.S. Dist. LEXIS 222971.

access to, the material that is claimed to be infringing or to be the subject of infringing activity”⁵⁸ when the service provider has: “1) has actual knowledge, 2) is aware of facts or circumstances from which infringing activity is apparent, or 3) has received notification of claimed infringement meeting the requirements of § 512(c)(3).”⁵⁹

Congress has made a determination concerning a service provider’s responsibility to protect the copyright owner.⁶⁰ Congress has placed the “burden of policing copyright infringement solely on the owners of the copyright” which include identifying alleged infringing material and adequately documenting the alleged infringement.⁶¹ The DMCA also relieves service providers from the burden of policing “its users for evidence of repeat infringement”⁶² which make it incumbent on the copyright owner to report the alleged infringement.⁶³ The DMCA also requires the service provide have knowledge of specific instances of infringement through a notice and takedown filing.⁶⁴ The DMCA clarifies that a service provider’s general knowledge that copyright infringement may be occurring “does not impose a duty on the service provider to monitor or search its service for infringements.”⁶⁵

ii. TRADEMARK

A trademark is “a distinctive mark of authenticity, through which the products of particular manufacturers or authors may be distinguished from those of others.”⁶⁶ Trademarks typically protect marks like brand names, logos, words, symbols, or phrases used on goods and

⁵⁸ 17 U.S.C. § 512(c).

⁵⁹ *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1111 (9th Cir. 2007).

⁶⁰ *Recording Indus. Ass’n of America v. Univ. of N.C. at Chapel Hill*, 367 F. Supp. 2d 945 (M.D.N.C. 2005).

⁶¹ *UMG Recordings, Inc. v. Shelter Capital Partners LLC*, 718 F.3d 1006, 1022 (9th Cir. 2013).

⁶² *Io Grp., Inc. v. Veoh Networks, Inc.*, 586 F. Supp. 2d 1132 (N.D. Cal. 2008).

⁶³ *See Perfect 10*, 488 F.3d at 1111.

⁶⁴ 17 U.S.C. § 512(c).

⁶⁵ *Viacom Int’l, Inc. v. YouTube, Inc.*, 718 F. Supp. 2d 514 (S.D.N.Y. 2010).

⁶⁶ *Sports Design & Dev. v. Schoneboom*, 871 F. Supp. 1158 (N.D. Iowa 1995).

services”⁶⁷⁶⁸ in commercial use and can coexist with copyrights.⁶⁹ The purpose of trademarks is not only to give a right to the creator but mainly to “distinguish that which was created from that which someone else created.”⁷⁰

Rights in a trademark are acquired through actual use in commerce,⁷¹ unlike a copyright that establishes a right once it is created. There is an actual overt act required to receive trademark protection, actual use.⁷² To gain the legal right in a trademark, one of two things must happen first: 1) actual use in commerce before any other, or 2) registration with the United States Patent and Trademark Office (USPTO).⁷³ If a trademark is not registered with the USPTO, they may have a common law right in the trademark based on its use in commerce, regardless of registration.⁷⁴ Notice, with a trademark, its use, not its creation, is the most important and usually stronger than the registration itself.⁷⁵

A party can be the first to file, but not the first to use the mark in commerce, which though they filed for registration first, would not entitle them to the legal right of the trademark unless an “intent to use” application had been filed with the USPTO prior to the first use of another.⁷⁶ Congress has established the Lanham Act as a means to govern and define trademark protection and registration rules.⁷⁷

⁶⁷ Hershey Foods Corp. v. Mars, Inc., 998 F. Supp. 500 (M.D. Pa. 1998).

⁶⁸ See *Pebble Beach Co. v. Laub American Corp.*, No. C-84-20125 RPA SJ, 1985 U.S. Dist. LEXIS 23876 (N.D. Cal. Dec. 27, 1985).

⁶⁹ U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/>.

⁷⁰ William E. O’Brien, *Obtaining, Using and Protecting Trademarks* § 1.4 (2020).

⁷¹ *Vision Ctr. Northwest, Inc. v. Vision Value, LLC*, 673 F. Supp. 2d 679 (N.D. Ind. 2009).

⁷² U.S. PATENT AND TRADEMARK OFFICE, PROTECTING YOUR TRADEMARK: ENHANCING YOUR RIGHTS THROUGH FEDERAL REGISTRATION 11 (2020).

⁷³ *Id.*

⁷⁴ *Id.* at 9

⁷⁵ *Id.*

⁷⁶ *Id.* at 21

⁷⁷ See 15 U.S.C. § 1051 (2020).

a. LANHAM ACT

The Lanham Act, enacted in 1946, was established as a public interest⁷⁸ to protect trademark owners “against the use of similar marks if such use is likely to result in consumer confusion, or if the dilution of a famous mark is likely to occur.”⁷⁹ The Lanham Act allows the party already using the mark in commerce to register the trademark with the USPTO.⁸⁰ However, if the mark has not yet been used in commerce, the Lanham Act permits a party with a bona fide intention to use the mark to register the mark with the USPTO using an “intent to use” application.⁸¹

The motivation behind registering a mark and being the first to use it in commerce is to control reputation by preventing others from passing off good and services as the goods and services of another⁸² thus confusing consumers.⁸³

The goal of trademark law is not to encourage creativity and invention, but to foster fair competition between businesses in commerce.⁸⁴ This is an attempt to prevent potential trademark infringement and provide remedies against potential infringers trying to pass off inferior products under another’s successful brand.⁸⁵

A party may have committed trademark infringement if, in commerce, a mark was reproduced, copied, or an imitation was made, without the consent of the trademark owner in connection with the sale, advertising, or distribution of goods or services if the use is likely to

⁷⁸ *Miyano Machinery USA, Inc. v. MiyanoHitec Mach., Inc.*, 576 F. Supp. 2d 868 (N.D. Ill. 2008).

⁷⁹ 15 U.S.C. § 1051.

⁸⁰ *Id.* at § 1051(a)(1)

⁸¹ *Oculus, LLC v. Oculus VR, Inc.*, No. SACV 14-0196 DOC(JPRx), 2015 U.S. Dist. LEXIS 74666 at *14 (C.D. Cal. June 8, 2015).

⁸² *Sealy, Inc. v. Serta Associates.*, 134 F. Supp. 621,623 (N.D. Ill. 1955).

⁸³ *G. Heileman Brewing Co. v. Anheuser-Busch, Inc.*, 873 F.2d 985, 977 (7th Cir. 1989).

⁸⁴ *Phoenix Ent. Partners, LLC v. Rumsey*, 829 F.3d 817, 825 (7th Cir. 2016).

⁸⁵ *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002).

cause confusion, mistake, or used in deception.⁸⁶ A trademark owner can prevail on a claim for trademark infringement if proven that the trademark owner: “(1) it holds a valid, protectable trademark, and (2) the defendant's imitating mark is similar enough to cause confusion, or to cause mistake, or to deceive.”⁸⁷ In order to recover from a claim of trademark infringement, the aggrieved party is not required to have an actual injury or damages.⁸⁸

⁸⁶ *Luxottica Grp. S.p.A. v. Zhiqiang Zhao*, No. 16 C 7988, 2017 U.S. Dist. LEXIS 38527 at *14 (N.D. Ill. Mar. 17, 2017) (*citing* 15 U.S.C. § 1114(1)).

⁸⁷ *Oculu*, 2015 U.S. Dist. LEXIS 74666 at *12.

⁸⁸ *Safeway Stores, Inc. v. Rudner*, 246 F.2d 826, 829 (9th Cir. 1957).

V. THE EFFECT ON BUSINESSES/BRANDS

A. SOCIAL MEDIA MARKETING

Social Media is now a major influence in the way businesses conduct and plan marketing strategies because they provide for immediate access and connectivity to their customer base. Social media has provided a great marketing and publicity tool for all types of business ranging from small businesses and startups to well established businesses. Businesses heavily utilize social media as a quick and relatively inexpensive way to grow their business using various tools provided on many social media platforms. The lack of traditional advertising by way of commercials, billboards, and print marketing due to marketing via social media can imaginably lower overhead costs of a business.

Some businesses and original authors of work enjoy the benefit of increased exposure as a result of having their work distributed, shared, and reposted by social media users because increased exposure also means increases sales. Some writers often encourage others to share their work by sharing links to their articles.⁸⁹ Exposure of the information can also get them cited in larger works which again, means larger exposure and potential future business opportunities.⁹⁰

In *Skyros, Inc. v. Mud Pie, LLC*, one dinnerware company used distinctive designs of another dinnerware company on their social media page.⁹¹ Their position was that it was not their intent to advertise the products of the other dinnerware company because they did not pay for the social media accounts the images were advertised on and because there were no links to

⁸⁹ Renee Hykel Cuddy, *Copyright Issues for Social Media*, LEGALZOOM, <https://www.legalzoom.com/articles/copyright-issues-for-social-media> (June, 2013).

⁹⁰ *Id.*

⁹¹ No. 2:16-cv-02255-STA-tmp, 2016 U.S. Dist. LEXIS 72547, at *2-3 (W.D. Tenn. June 3, 2016).

their website to divert social media viewers to purchase the items.⁹² The company stated that because of those reasons, the images were not considered advertisements.⁹³ The court was not persuaded by this argument, clarifying that “[c]ompanies do not gratuitously post images of their products on social media.⁹⁴ Rather, the purpose of these posts is to market the companies’ products.”⁹⁵

B. CELEBRITIES

Celebrities tend to catch the short end of the stick when it comes to posting on social media. They are constantly followed by paparazzi who take photographs of them without their express consent. Whether paparazzi or photographers snap a picture of a celebrity in a compromising position or if they catch a photo of a celebrity casually strolling the streets, those photos equate to a job and profits for the photographer. However, there are times when a celebrity may see a photograph of themselves on the internet and enjoy the picture enough to want to post it to their social media page. This often causes issues which lead to lawsuits, often ending in settlements.⁹⁶ The photographer has lost the value of having an exclusive photograph to sell now that the celebrity has posted it to their millions of followers.⁹⁷ To solve this issue, one celebrity in particular, Kim Kardashian, decided to hire her own photographer to follow her around daily.⁹⁸ This is likely to prevent the possibility of lawsuits as a result of reposting unauthorized photographs.

⁹² *Id.* at *10.

⁹³ *Id.*

⁹⁴ *Id.*

⁹⁵ *Id.* at *11.

⁹⁶ *Cepeda v. Hadid*, 1:17-cv-00989-LMB-MSN (E.D. Va. 2017).

⁹⁷ *See generally* *Mavrix Photo, Inc. v. Brand Techs., Inc.*, 647 F.3d 1218, 1223 (9th Cir. 2011) (losing value of a photograph when it is used in an unintended way).

⁹⁸ Katherine Dearing, Meaghan Kent & Danae Tinelli, *Keeping Up with Copyright Infringement: Copyright, Celebrities, Paparazzi, and Social Media*, IP WATCHDOG, <https://www.ipwatchdog.com/2019/10/30/keeping-copyright-infringement-copyright-celebrities-paparazzi-social-media/id=115456/> (October 30, 2019).

a. CELEBRITY CASES

Victoria Beckham

Ramales v. Victoria Beckham Inc., et al., 1:19-cv-08650 (S.D.N.Y. 2019)

On September 9, 2019, Felipe Ramales, a New York based professional photographer, filed a complaint in the United States District Court Southern District of New York against VB Beauty Limited Liability Corporation, Victoria Beckham, Incorporated, and Victoria Beckham, a singer and fashion designer.⁹⁹ The nature of the complaint was a cause of action under Section 501 of the Copyright Act for copyright infringement.¹⁰⁰

Ramales alleges that Beckham reproduced and publicly displayed a copyrighted photograph of Beckham that was owned and registered by Ramales.¹⁰¹ Ramales has produced a registration number of VA 2-162-149, given to him by the Copyright Office for the photograph in question.¹⁰²

Beckham posted the photograph on her Instagram story which Ramales did not give her permission, did not assign a license, nor did he consent to the photograph being published on her Instagram story.¹⁰³

Gigi Hadid

Cepeda v. Hadid, 1:17-cv-00989-LMB-MSN (E.D. Va. 2017)

On September 5, 2017, Peter Cepeda, a freelance photographer, filed a complaint in the United States District Court for the Eastern District of Virginia against IMG Worldwide, Inc, and

⁹⁹ *Ramales v. Victoria Beckham Inc.*, 1:19-cv-08650 (S.D.N.Y. 2019).

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.*

¹⁰³ *Id.*

Jelena Noura “Gigi” Hadid, an American fashion model.¹⁰⁴ The nature of the complaint was a cause of action for copyright infringement.¹⁰⁵

Cepeda alleges he is the sole copyright holder of a photograph he captured of Hadid in New York.¹⁰⁶ In July 2016, Cepeda licensed the copyright photograph to Instar Images for use on *The Daily Mail* who in turn posted the photograph on the internet giving credit to Peter Cepeda as the copyright owner.¹⁰⁷ The same day, Instar Images licensed the copyrighted photograph to TMZ.¹⁰⁸ TMZ credits Instar Images as the copyright owner.¹⁰⁹ Subsequently, Hadid posted this photograph to her Instagram page.¹¹⁰ She also posted a link of that photograph from her Instagram page and posted it to her Twitter page.¹¹¹ Several other media sources copied the photograph from Hadid’s post and credit either her or Instagram for the photograph.¹¹²

The complaint further alleges that Cepeda has asked Hadid numerous times to remove the photographs, yet she refused.¹¹³ He also mentions that he submitted the photograph to the Copyright Office, without a date as to when.¹¹⁴ Cepeda alleges he did not give permission or consent to Hadid to copy or use the photograph.¹¹⁵

This case was dismissed.¹¹⁶

¹⁰⁴ *Cepeda*, 1:17-cv-00989-LMB-MSN.

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.*

¹⁰⁸ *Id.*

¹⁰⁹ *Id.*

¹¹⁰ *Id.*

¹¹¹ *Id.*

¹¹² *Id.*

¹¹³ *Id.*

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

Xclusive-Lee, Inc. v. Hadid, No. 19-CV-520 (PKC) (CLP), 2019 U.S. Dist. LEXIS 119868 (E.D.N.Y. July 18, 2019)

On January 28, 2019, Xclusive-Lee, Inc., a photographer, filed a complaint in the United States District Court for the Eastern District of New York against Jelena Noura “Gigi” Hadid, an American fashion model.¹¹⁷ The nature of the complaint was a cause of action under the Copyright Act for copyright infringement and contributory infringement.¹¹⁸

Xclusive-Lee, Inc. alleges that they were the copyright holder of a photograph he took of Hadid.¹¹⁹ He alleges that Hadid did not have a license or permission to post a cropped version of Xclusive-Lee, Inc.’s photograph to her Instagram account.¹²⁰

The court dismissed Xclusive-Lee, Inc.’s complaint for failure to meet the registration requirements established by the Supreme Court, that copyright registration must be obtained in the work prior to filing a lawsuit.¹²¹ Here, Xclusive-Lee, Inc. concedes that an application for copyright was submitted but had not yet been approved.¹²²

This case was dismissed with prejudice.¹²³

O’Neil v. Hadid, 1:19-cv-8522 (S.D.N.Y. 2019)

On September 2019, Robert O’Neil, a photographer, filed a complaint in the United States District Court for the Southern District of New York against Jelena Noura “Gigi” Hadid,

¹¹⁷ *Xclusive-Lee, Inc. v. Hadid*, No. 19-CV-520 (PKC) (CLP), 2019 U.S. Dist. LEXIS 119868 (E.D.N.Y. July 18, 2019).

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.*

¹²³ *Id.*

an American fashion model.¹²⁴ The nature of the complaint was a cause of action under the Copyright Act for copyright infringement.¹²⁵

O’Neil alleges he is the copyright holder of a photograph taken of English singer and songwriter, Zayn Malik.¹²⁶ Hadid posted this photograph, of her then boyfriend, on her Instagram page.¹²⁷ O’Neil asserts he did not give Hadid permission to use the

This case was dismissed due to the parties reaching a settlement agreement.¹²⁹

Khloe Kardashian

Xposure Photos UK Ltd. v. Khloe Kardashian et al, 2:17-cv-03088-DSF-MRW (C.D. Ca. 2017)

On April 25, 2017, Xposure Photos Ltd., an English photo agency, filed a complaint in the United States District Court for the Central District of California against Khloe Kardashian, a reality television personality.¹³⁰ The nature of the complaint was a cause of action for copyright infringement.¹³¹

Xposure Photos Ltd. alleges that they are the copyright holder that they are the copyright owner of a photograph taken of Khloe and her sister at a Miami restaurant.¹³² Xposure Photos Ltd asserts that they never licensed the photograph to Khloe yet she has used and continued to use the photograph on her Instagram without the permission of Xposure Photos Ltd.¹³³ It is claimed that Khloe removed the copyright management information from the photograph.¹³⁴

¹²⁴ O’Neil v. Hadid, 1:19-cv-8522 (S.D.N.Y. 2019).

¹²⁵ *Id.*

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Xposure Photos UK Ltd. v. Khloe Kardashian et al*, 2:17-cv-03088-DSF-MRW (C.D. Ca. 2017).

¹³¹ *Id.*

¹³² *Id.*

¹³³ *Id.*

¹³⁴ *Id.*

The photograph was posted to Khloe’s Instagram before Xposure Photos Ltd. was able to license the photograph to any other media to make a profit.¹³⁵

This case was dismissed due to the parties reaching a settlement agreement.¹³⁶

Jennifer Lopez

Stewart v. Lopez, 1:18-cv-12019-KPF (S.D.N.Y. 2018)

On December 19, 2018, Michael Stewart, a professional photographer, filed a complaint in the United States District Court for the Southern District of New York against Nuyorican Productions, Inc. and Jennifer Lopez, a singer.¹³⁷ The nature of the complaint was a cause of action under the Section 501 of the Copyright Act for copyright infringement.¹³⁸

Stewart alleges he is the sole author and owns all rights, titles, and interest in the photograph of Lopez walking the streets of New York.¹³⁹ Stewart produced a registration number of VA 2-110-507, given to him by the Copyright Office for the photograph in question.¹⁴⁰ Stewart licensed the photograph to *The Daily Mail*.¹⁴¹ Stewart is contending that Lopez reproduced and publicly displayed the photograph to her Instagram page.¹⁴²

Lopez asserted a fair use defense; however, the case was dismissed due to the parties reaching a settlement agreement.¹⁴³

Versace USA, Incorporated

Barbera v. Versace USA, Inc., 1:19-cv-03563 (S.D.N.Y. 2019)

¹³⁵ *Id.*

¹³⁶ *Id.*

¹³⁷ *Stewart v. Lopez*, 1:18-cv-12019-KPF.

¹³⁸ *Id.*

¹³⁹ *Id.*

¹⁴⁰ *Id.*

¹⁴¹ *Id.*

¹⁴² *Id.*

¹⁴³ *Id.*

On April 22, 2019, Robert Barbera, a New York based professional photographer, filed a complaint in the United States District Court for the Southern District of New York against Versace USA, Inc, a business corporation.¹⁴⁴ The nature of the complaint was a cause of action under the Section 501 of the Copyright Act for copyright infringement and removal/alteration of copyright management information under the Digital Millennium Copyright Act.¹⁴⁵

Barbera alleges he is the sole author and owns all rights, titles, and interest in the two photographs of singer and actress, Jennifer Lopez.¹⁴⁶ Barbera produced two registration numbers of the photographs VA 2-142-952 and VA 2-146-389.¹⁴⁷ Versace posted the photograph taken by Barbera to Versace’s Instagram page and removed the copyright management information.¹⁴⁸

This case was dismissed.¹⁴⁹

VI. PROTECTING AGAINST SOCIAL MEDIA INTELLECTUAL PROPERTY ABUSE

A. HOW TO PROTECT

An owner of a copyright can protect their original work by registering the original work with the United States Copyright Office.¹⁵⁰ Though a copyright automatically exists once it is fixed in a tangible medium by the original owner, it reduces the likelihood of ownership debate if it is registered with the U.S. Copyright Office. Also, in order to have a right to sue based on a claim of infringement upon intellectual property or

¹⁴⁴ Barbera v. Versace USA, Inc., 1:19-cv-03563 (S.D.N.Y. 2019).

¹⁴⁵ *Id.*

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ Fourth Estate Pub. Ben. Corp. v. Wall-Street.com, LLC, 139 S. Ct. 881 (2019).

any other intellectual property litigation, registration is required to enforce the exclusive rights.¹⁵¹

It is also important that the original work be fixed in a tangible medium.¹⁵² It was explained by the court in *Erickson v. Trinity Theatre, Inc.*, that an author is the one “who translates an idea into a fixed, tangible expression.”¹⁵³ The thought, design, and layout of a future copyright is not copyrightable, only the outcome, whatever is produced on a fixed medium.¹⁵⁴ An example provided by *Natkin v. Winfrey*, was when Oprah Winfrey felt she was a co-author of photographs because she contributed “her facial expressions, her attire, the ‘look’ and ‘mood’ of the show, the choice of guests, the staging of the show.”¹⁵⁵ Ms. Winfrey has only provided the design concepts and ideas of how the photos would be produced but the actual production of the photos was the copyright of the photographer.¹⁵⁶

In order to register a copyright with the U.S. Copyright Office, there is a required application, fee, and submission of the item requesting copyright protection.¹⁵⁷ Once the application is submitted, a Copyright Office Examiner will review the application and either request corrections, clarification, or additional information or submit the mark for approval.¹⁵⁸ During this review process, the Copyright Office Examiner does not search other copyrights to determine if the new copyright infringes on another’s copyright.¹⁵⁹ Instead, the Copyright Office

¹⁵¹ *Id.*

¹⁵² *In re Avalon Software*, 209 B.R. 517 (Bankr. D. Ariz. 1997).

¹⁵³ *Erickson v. Trinity Theatre, Inc.*, 13 F.3d 1061, 1071 (7th Cir. 1994).

¹⁵⁴ *Natkin v. Winfrey*, 111 F. Supp. 2d 1003 (N.D. Ill. 2000).

¹⁵⁵ *Id.*

¹⁵⁶ *Id.*

¹⁵⁷ Joel R. Leeman & Lisa M. Tittlemore, *Protecting and Enforcing Copyright* § 3.1 (2020).

¹⁵⁸ *Id.*

¹⁵⁹ *Id.*

Examiner determine if the application is merely copyrightable. Once approved, a copyright registration certificate is issued.¹⁶⁰

Protecting a trademark is a bit different than that of the process of protecting a copyright. Both require an application and a fee, however once the application meets the minimum requirements it is sent to an examining attorney for review.¹⁶¹ Unlike the Copyright Office Examiner, the examining attorney will ensure the application complies with all the rules and statutes but also searches other trademarks that this application may conflict with.¹⁶² The examining attorney will determine whether the trademark should or should not be registered.¹⁶³ If the decision is not to register the trademark, a letter will be mailed to the applicant explaining the reasons for refusing to approve the trademark and the applicant must respond within six months.¹⁶⁴ Once the examining attorney has no objections to the registration, the trademark will be approved for publication in the “Official Gazette.”¹⁶⁵ The Official Gazette is a weekly publication produced by the United States Patent and Trademark Office which gives notice to the masses of an approved trademark.¹⁶⁶ If “any party who believes it may be damaged by registration of the mark has 30 days from the publication date to file either an opposition to registration or a request to extend the time to oppose.”¹⁶⁷ If no opposition is received, the United States Patent and Trademark Office will finish the process by registering the trademark and issuing the applicant and trademark owner a certificate of registration.¹⁶⁸

¹⁶⁰ *Id.*

¹⁶¹ U.S. PATENT AND TRADEMARK OFFICE, <https://www.uspto.gov/>.

¹⁶² *Id.*

¹⁶³ *Id.*

¹⁶⁴ *Id.*

¹⁶⁵ *Id.*

¹⁶⁶ *Id.*

¹⁶⁷ U.S. PATENT AND TRADEMARK OFFICE, TRADEMARK PROCESS, <https://www.uspto.gov/>.

¹⁶⁸ *Id.*

Along with these methods of protecting intellectual property via registration, an original owner should also be specific by giving exceptions and/or conditions of use at the release of the intellectual property to another. It is important to be thorough and intentional with the parameters of the use of the intellectual property. Though this may not be able to prevent the need to file a cause of action, it will help the litigation process if the intended purpose of the intellectual property is made clear by the original owner to show the alleged infringer violated that purpose.

Another avenue of protection comes by way of copyright management information. This includes, for example, when a copyright owner places a name or other identifying mark of the author of the work.¹⁶⁹

B. REPORTING INFRINGEMENT

Along with the avenues afforded to copyright owners in the form of a takedown notice courtesy of the DMCA, social media platforms have also provided means for reporting copyright infringement.

Facebook and Instagram's Help Centers provide an online form as a means to report intellectual property infringement.¹⁷⁰ They also provide contact information for their designated DMCA agents as another means to report infringement.¹⁷¹ The Help Centers advise that only the copyright owner or authorized representative may file a report for copyright infringement with them.¹⁷² YouTube provides a "copyright and rights management" page on their Help Center, which provides a great amount of educational information on intellectual property.¹⁷³ They also

¹⁶⁹ See, e.g., *IQ Group. v. Wiesner Publ'g, LLC*, 409 F. Supp. 2d 587, 591 (D.N.J. 2006).

¹⁷⁰ See *Help Center*, INSTAGRAM, <https://help.instagram.com/intellectualproperty>.

¹⁷¹ See *Help Center*, FACEBOOK, HELP CENTER, <https://www.facebook.com/help/contact/634636770043106>.

¹⁷² *Id.*

¹⁷³ *Help Center*, YOUTUBE, https://support.google.com/youtube/topic/2676339?hl=en&ref_topic=6151248.

provide links with information on material to submit a takedown notice, how to dispute claims, and what to do if a video was removed because someone claimed music or content within your video.¹⁷⁴

It is great that social media has taken responsibility in aiding in protecting intellectual property however, copyright owners still have the liberty to contact the alleged infringer on their own to attempt to get the copyrighted material removed.

C. DEFENSES

When the original author of a copyright sees their copyright being infringed upon in a manner they did not authorize, they may commence a lawsuit for copyright infringement. Bringing a suit for another using the author's work is not a guaranteed win. There may be several defenses that an alleged infringer may be able to use. The court in *Stross v. Redfin Corp.*, calls these defenses "shields" to a claim of misuse of copyrighted material.¹⁷⁵

a. FAIR USE

The Fair Use Doctrine is an affirmative defense provided for in the Copyright Act for the intended purpose of promoting the advancement of science and the arts.¹⁷⁶ The party asserting the defense, usually the defendant, has the burden of proving the copyright was not infringed upon but used in fair use.¹⁷⁷

The Copyright Act affirms that an infringement on a copyright has not occurred when the fair use of a copyrighted work is used for "criticism, comment, news reporting, teaching, scholarship, or research"¹⁷⁸.¹⁷⁹ Though there are no definite elements which

¹⁷⁴ *Id.*

¹⁷⁵ See *Stross v. Redfin Corp.*, 730 F. App'x 198 (5th Cir. 2018).

¹⁷⁶ *Warren Publ'g. Co. v. Spurlock*, 645 F. Supp. 2d 402, 414-15 (E.D. Pa. 2009).

¹⁷⁷ *Oyewole v. Ora*, 291 F. Supp. 3d 422, 433 (S.D.N.Y. 2018).

¹⁷⁸ 17 U.S.C. § 107 (2012).

¹⁷⁹ *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 434 (1984)

must be met to determine fair use, Section 107 of Title 17 of the United States Code provides four factors to consider when assessing fair use.¹⁸⁰ It is important to remember that factors are not elements. Elements are items required to be met to determine the applicability whereas, factors are items to consider and weigh when determining the applicability in relation to the copyright.^{181, 182} The four factors used to determine whether fair use applies involves, 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.”¹⁸³

The first factor seeks to determine the purpose of the use of the copyright, whether used for commercial purposes or to benefit the public through nonprofit use.¹⁸⁴ In this section, the person using the copyright will be referred to as the secondary user. The court will lean in favor of the copyright owner and less in the favor of fair use, if the facts appear to show the commerciality of the use was greater than its benefit to the public.¹⁸⁵ In *Am. Geophysical Union v. Texaco Inc.*, the court provides an example of when commercial use can be for exploitation and not fairly categorized as fair use.¹⁸⁶ For example, when a “copier directly and exclusively acquires conspicuous financial rewards from its use of the copyrighted material.”¹⁸⁷ If a secondary user reproduces the copyrighted work and sells it for private gain that is not protected by the Copyright Act, it is likely the court will not find fair use.¹⁸⁸ However, be cautious that not all

¹⁸⁰ 17 U.S.C. § 107.

¹⁸¹ See *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913 (2d Cir. 1995) (analyzing factors).

¹⁸² See *Malibu Media, LLC v. Doe*, No. 12-2078, 2013 U.S. Dist. LEXIS 55985 * 11 (E.D. Pa. Mar. 6, 2013).

¹⁸³ *Triangle Publ'ns Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1174-75 (5th Cir. 1980).

¹⁸⁴ *Am. Geophysical Union v. Texaco, Inc.*, 60 F.3d 913, 918 (2d Cir. 1995) (citing 17 U.S.C. § 107(1) (2012)).

¹⁸⁵ See *id.* at 922.

¹⁸⁶ *Id.*

¹⁸⁷ *Id.*

¹⁸⁸ *Id.*

commercial use negates the fair use defense. Even if there is a finding of a commercial nature of the use, the court will use this determination and weigh it against the other factors to conclude fair use.¹⁸⁹ It is important to realize that profiting from the commercial use of an original copyright and not receiving profits when used for noncommercial use can be, at times, weigh equally because there are more factors to consider.¹⁹⁰

The second factor is straight forward and can be viewed in light of the definition given in 17 U.S. Code § 107.

The third factor considers the amount and substantiality of the secondary use in its totality.¹⁹¹ The court clarified that is not necessarily the total amount that is being considered but the totality of the circumstances.¹⁹² To consider a secondary user's reproduction of a copyright to be outside of fair use because an entire copyrighted work was copied, is a generalization and overly broad.¹⁹³ Like *Texaco* who photocopied an extensive amount of the publisher's materials, for a personal library to avoid payment, the court still determine this was fair use.¹⁹⁴

The fourth factor considers how the alleged fair use impacts the value and potential sales of the copyrighted work.¹⁹⁵ The publishers in *Am. Geophysical Union v. Texaco Inc.*, argued that the reproduction of their materials caused "substantial harm to the value of their copyright" because *Texaco* did not pay them for reproducing the documents and using them for a personal library for an employee.¹⁹⁶ However, the Court of Appeals held that

¹⁸⁹ *Id.* at 921

¹⁹⁰ *See* *Malibu Media, LLC v. Doe*, No. 12-2078, 2013 U.S. Dist. LEXIS 55985, at *32 (E.D. Pa. Mar. 6, 2013).

¹⁹¹ *Id.* *11.

¹⁹² *Id.*

¹⁹³ *Triangle Publ'ns, Inc. v. Knight-Ridder Newspapers, Inc.*, 626 F.2d 1171, 1155 n.15 (5th Cir. 1980).

¹⁹⁴ *Am. Geophysical Union v. Texaco Inc.*, 60 F.3d 913 (2d Cir. 1995).

¹⁹⁵ *Id.* at 926 (citing 17 U.S.C. § 107(4) (2012)).

¹⁹⁶ *Id.*

there was a fair use in the reproduction for research inquiries.¹⁹⁷ If the secondary user modifies the copyright and subsequently adds value or the new value exceeds that of the original copyright, this transformative action will weigh heavily in the favor of fair use through the promotion of science and the arts.¹⁹⁸

This affirmative defense allows a social media user to borrow copyrighted material without fear of copyright infringement as long as they can provide it was used for one of the allowable reasons under the Copyright Act. This gives wide latitude to a secondary user as long as they can potentially tie their use of the copyrighted material to a form of “criticism, comment, news reporting, teaching, scholarship, or research.”¹⁹⁹ This could have a negative effect on the original author because third-parties could easily identify the secondary user’s work as the original author’s work. This could be harmful and tarnish the brand of the original author depending on how the secondary user intends to use the copyrighted material.

This is much like the company in *Queen Virgin Remy LTD. Co. v. Thomason, No.*, who felt that the hairstylist’s alleged fair use of their trademark on her social media pages would misrepresent their brand as well as confuse and mislead the public.²⁰⁰ The hairstylist allegedly claimed some ownership in the Queen Virgin Remy products.²⁰¹ However, the court felt that, as part of her occupation of styling hair, her assumption of fair use was not outside the realm of possibility.²⁰²

b. FIRST SALE DOCTRINE

¹⁹⁷ 17 U.S.C. § 107.

¹⁹⁸ *Am. Geophysical Union*, 60 F.3d 913 at 923.

¹⁹⁹ *Id.* at 933.

²⁰⁰ *Queen Virgin Remy Ltd. v. Thomason, No. 1:15-cv-1638-SCJ*, 2015 U.S. Dist. LEXIS 186411 at *2 (N.D. Ga. June 10, 2015).

²⁰¹ *Id.* at *8.

²⁰² *Id.* at *12.

Codified under Section 109 of Title 17 of the United States Code, the First Sale Doctrine “provides that an individual who knowingly purchases a copy of a copyrighted work from the copyright holder receives the right to sell, display or otherwise dispose of that particular copy.”²⁰³ The Supreme Court explains that “once the copyright owner places a copyrighted item in the stream of commerce by selling it, he has exhausted his exclusive statutory right to control its distribution.”²⁰⁴ The sale of the copyrighted work removes the original author’s ability to control the work unless there are express conditions and limitations attached at the sale.²⁰⁵ The First Sale Doctrine is one that is difficult for prosecutors to disprove due to inability to gain adequate proof to sustain a conviction.²⁰⁶ People tend to escape liability under this doctrine by “claiming that they believed that the works they were selling had been the subject of a legitimate first sale.”²⁰⁷

Like in *Luxottica Grp. S.p.A. v. Zhiqiang Zhao*, the internet store was selling and displaying Oakley brand glasses on their Facebook and Pinterest pages.²⁰⁸ The luxury eyewear company’s issue was that these items were counterfeit and displayed features that Oakley products do not have.²⁰⁹ The other issue was that by displaying these items on their social media pages, they provided the false appearance to outsiders that they were affiliated or associated with the Oakley company.²¹⁰ The court found in favor of the luxury eyewear company because the internet store had not purchased a copyrighted

²⁰³ 17 U.S.C. § 109.

²⁰⁴ *Quality King Distribs. v. L’Anza Research Int’l*, 523 U.S. 135, 152 (1998).

²⁰⁵ *Id.* at 144.

²⁰⁶ U.S. DEP’T OF JUSTICE, CRIMINAL RESOURCE MANUAL 1801-1899 §1854 (2020).

²⁰⁷ *Id.*

²⁰⁸ *Luxottica Grp. S.p.A. v. Zhiqiang Zhao*, No. 16 C 7988, 2017 U.S. Dist. LEXIS 38527 at *7 (N.D. Ill. Mar. 17, 2017).

²⁰⁹ *Id.* at *2.

²¹⁰ *Id.* at *14.

work because they were creating counterfeit products.²¹¹ Had they purchased authentic products and resold them via their social media pages, they would like have been afforded the protection of the first sale doctrine like the purveyor in *Chanel, Inc v. WGACA, LLC*. The case of *Chanel, Inc v. WGACA, LLC*, involves a luxury designer (Chanel) and a purveyor (What Goes Around Comes Around -WGACA) the reselling goods.²¹² This case is distinguished from *Luxottica Grp. S.p.A. v. Zhiqiang Zhao*, because though they are both cases involving trademark violations, WGACA actually resold authentic products.

c. IMPLIED LICENSE

An implied license exists when, 1) “a person (the licensee) requests the creation of a work, 2) the creator (the licensor) makes that particular work and delivers it to the licensee who requested it, and 3) the licensor intends that the licensee copy and distribute his work.”²¹³ An important determinant for the court in deciding if an implied license existed is the information that was conveyed when the copyrighted work was delivered; did the original author give any “warning that [the copyrighted material’s] further use would constitute copyright infringement.”²¹⁴ Even if not express, an implied license may be inferred if the opposing party alleges the original author knew or intended for the opposing party to redistribute the work at the time it was handed over.²¹⁵ An implied license’s use may be limited only if it was specified at the time of delivery.²¹⁶

²¹¹ *Id.*

²¹² *Chanel, Inc. v. WGACA, LLC*, 2018 U.S. Dist. LEXIS 158077 *2 (S.D.N.Y. Sept. 14, 2018).

²¹³ *Davis v. Tampa Bay Arena, Ltd.*, No. 8:12-cv-60-T-30MAP, 2013 U.S. Dist. LEXIS 90602 at *16-17 (M.D. Fla. June 27, 2013)

²¹⁴ *Wilchombe v. TeeVee Toons, Inc.*, 555 F.3d 949, 956 (11th Cir. 2009).

²¹⁵ *MacLean Associates v. Wm. M. Mercer-Meidinger-Hansen, Inc.* 952 F.2d 769, 779 (3d Cir. 1991).

²¹⁶ *Latimer v. Roaring Toyz, Inc.*, 601 F.3d 1224, 1235 (11th Cir. 2010).

In *Davis v. Tampa Bay Arena, Ltd*, the photographer granted the arena “an implied license to post his images to the [arena’s] Facebook page.”²¹⁷ The agreement was for the photographer to take photographs (his original copyrighted work) of events at the arena.²¹⁸ The photographer provided the arena staff access to upload the photos by providing logins and passwords to his server.²¹⁹ The arena staff used the photographs on their Facebook page, where visitors could see the images and make copies of the images posted to Facebook.²²⁰ At the time the photographer gave the implied license to the arena by delivering the photos, he did not attach limitations to the distribution.²²¹

VII. CONCLUSION

As we have seen, the evolution of technology and the internet have birthed the phenomenon of social media. The expansive scope social media recently developed has caused presented issues in the realm of intellectual property that do not seem to have a solution or end in sight. Though there are corrective actions and remedies in place, it is clear that the process of monitoring every user on each social media platform is not heavily monitored and likely a cumbersome process. Take notice that the courts do not require social media platforms to continuously monitor user pages for potential or future infringement, they are only required to act once a potential infringement is brought to their attention. This task may become daunting and unsuccessful in the hands of an unsophisticated owner of intellectual property. Thus, there is a strong possibility that continued infringement of intellectual property will not subside and infringers will slip through the cracks and not be caught

²¹⁷ *Davis*, 2013 U.S. Dist. LEXIS 90602 at *16.

²¹⁸ *Id.*

²¹⁹ *Id.*

²²⁰ *Id.*

²²¹ *Id.*

This note has explained how intellectual property owners are encouraged to use the protections afforded by the Copyright Act, Digital Millennium Copyright Act, and the Lanham Act. Additional measure to help protection intellectual property are the use of 1) the copyright symbol ©, 2) digital watermarks, 3) low resolution images, and 4) links back to your website to direct users to the terms and conditions. Even if an owner of intellectual property goes through any of these steps, this is not a one-time solution; the infringers can be defiant and create another user profile or continue posting the content on their current page. So, the question remains, are the protections granted by various statutes regarding intellectual property really covering actions taken on the novel social media platforms.

The combined use of these protections will not eliminate intellectual property infringement but they will afford intellectual property owners with the greatest tools to fight against infringers. Intellectual property and social media have a very complex correlation to each other. It will be interesting to see how social media platforms continue to handle alleged infringements, if there will be an increase in reported allegations, and if higher courts will receive pressure to force social media platforms to heavily police the content submitted to their sites.

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