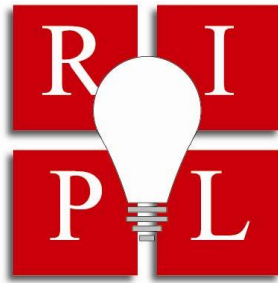


THE JOHN MARSHALL REVIEW OF INTELLECTUAL PROPERTY LAW



#BEWAREOFOVERSHARE: SOCIAL MEDIA DISCOVERY AND IMPORTANCE IN INTELLECTUAL PROPERTY LITIGATION

JENNIFER K. GREGORY

ABSTRACT

As the use of social media continues to expand, lawyers will increasingly rely on evidence gleaned from social media sources. This is already true in several areas of litigation, including various types of intellectual property litigation. Thus far, the rules of civil procedure, evidence, and professional conduct have addressed many of the issues that arise regarding the acquisition and use of social media evidence. Lawyers should at least investigate social media usage by key parties in each particular case in order to be aware of what social media evidence could be available. Lawyers are also responsible for having a basic understanding of how to obtain and effectively use social media evidence to advocate on behalf of the client. Several recent cases and bar association opinions shed light on the utility and traps of obtaining and using social media evidence.

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#BEWAREOFOVERSHARE: SOCIAL MEDIA DISCOVERY AND IMPORTANCE IN INTELLECTUAL PROPERTY LITIGATION

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INTRODUCTION

An overwhelming majority of adults online, almost seven out of ten, use social networking sites.¹ Social media is now commonplace in one form or another, and parties will continue to discover new uses for the vast quantities of casually shared information. Social media evidence has begun to filter slowly into many different types of litigation, most commonly criminal cases, but in some civil contexts as well. In the area of intellectual property litigation, trademark infringement cases have involved the most social media evidence to date, with copyright and patent litigation lagging far behind.² Thus far, the rules for discovery of electronic information, in general, have effectively addressed the discovery and admission of social media evidence.³ As the case law in this area evolves, however, it is yet to be seen whether social media evidence can continue to be so tidily corralled.

This article outlines some of the additional evidence that parties to intellectual property litigation may be able to access through newfound social media channels. Part I lays out the general contours of discovering information from social media sources. Part II then applies these rules to social media evidence that has or could arise in trademark, copyright, and patent litigation.

I. DISCOVERY FROM SOCIAL MEDIA SOURCES

A number of specific issues regarding discovery from social media have arisen. To clarify what is included in this discussion, the term “social media” includes interaction among people in virtual communities and networks.⁴ Some common social media sites are LinkedIn, Facebook, YouTube, Twitter, Pinterest, Google+, and MySpace.⁵ People are keeping increasingly more information about their lives—

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¹ MAEVE DUGGAN & JOANNA BRENNER, PEW RESEARCH CTR., THE DEMOGRAPHICS OF SOCIAL MEDIA USERS—2012, at 2 (2013), available at http://pewinternet.org/~media/Files/Reports/2013/PIP_SocialMediaUsers.pdf.

² See, e.g., *Published Cases Involving Social Media Evidence (First Half 2012)*, X1 DISCOVERY, http://www.x1discovery.com/social_media_cases.html (last visited Apr. 21, 2013) (collecting and summarizing cases involving social media by case type).

³ See Steven S. Gensler, *Special Rules for Social Media Discovery?*, 65 ARK. L. REV. 7, 9 (2012) (concluding that the current electronic discovery rules are sufficient to address social media discovery issues and that judges are already effectively using them to do so); *State v. Eleck*, 23 A.3d 818, 823 (Conn. App. Ct. 2011) (concluding that current rules for admissibility of electronic communications were sufficient to analyze social media evidence such as Facebook posts).

⁴ Linda D. Schwartz, *Social Media—Friend or Foe?*, MD. B.J., Mar.–Apr. 2011, at 12, 13.

⁵ DUGGAN & BRENNER, *supra* note 1, at 11–12.

relevant and discoverable information—in cyberspace. Some information may be publicly available, such as the public profile from a user’s LinkedIn account or some of the public pictures in a user’s Facebook account. If not much discoverable information is publicly available, a few well-crafted discovery requests may turn up other important evidence that could be available from social media sources. The main issues with discovering social media information are: (1) avoiding contact through social media, (2) relevance, (3) privacy objections, and (4) authentication. These issues, as well as the obligation to retain social media evidence, will be discussed below.

A. Avoid Direct Contact Through Social Media

Public portions of social media sites are fair game for anyone, but a lawyer may only “friend” an unrepresented party if the lawyer’s real name and purpose are revealed. A New York state ethics opinion concludes that a lawyer can directly view the public portions of another party’s social networking site to gather information in a pending litigation.⁶ However, there are two major issues with an attorney directly attempting to contact someone and accessing private portions of their social networking sites: the anti-contact rule and the rule that lawyers cannot make misrepresentations.

First, an attorney should not directly, or through an assistant, try to “friend” or connect to represented parties through social media to gain access to the private portions of their account.⁷ “Friending” or “Linking” to another party that is represented by an attorney violates ABA Model Rule of Professional Conduct 4.2, the “anti-contact rule,” which bars lawyers from communicating directly with a represented party.⁸

Second, there are even ethical issues with attempting to “friend” an unrepresented non-party witness if there is any deception or omission of material facts involved.⁹ A Philadelphia Bar Association Opinion concludes that “friending” a witness to gain information is deceptive and violates Rule 8.4(c), which prohibits “dishonesty, fraud, deceit or misrepresentation.”¹⁰ Also, failure to disclose that the purpose for “friending” is to gain evidence to possibly impeach the witness is an omission of material fact that violates Rule 4.1(a), which prohibits a lawyer from making a false statement of material fact to a third person.¹¹ However, a more recent New York City Bar opinion concludes that a lawyer may attempt to “friend” an

⁶ N.Y. State Bar Ass’n Comm. on Prof’l Ethics, Formal Op. 843 (2010); *see also* John Eligon, *When Lawyers Can Peek at Facebook*, N.Y. TIMES CITY ROOM (Oct. 1, 2010, 11:38 AM), <http://cityroom.blogs.nytimes.com/2010/10/01/when-lawyers-can-peek-at-facebook/>.

⁷ Ass’n of the Bar of the City of N.Y. Comm. on Prof’l Ethics, Formal Op. 2010-2 (2010) (discussing the procurement of evidence from social networking sites).

⁸ MODEL RULES OF PROF’L CONDUCT R. 4.2 (2011).

⁹ Phila. Bar Ass’n Prof’l Guidance Comm., Informal Op. 2009-02 (2009).

¹⁰ PA. RULES OF PROF’L CONDUCT R. 8.4(c) (2012); *see also* Informal Op. 2009-02.

¹¹ PA. RULES OF PROF’L CONDUCT R. 4.1(a); *see also* Informal Op. 2009-02.

unrepresented party without disclosing the motivation behind the request, as long as the lawyer uses his or her truthful name and profile.¹²

B. Make Specific Requests for Relevant Information from Social Media Sources

Requests for information from social media sources must be limited to specific, relevant information, as required by rule 26(b)(1) of the Federal Rules of Civil Procedure (“FRCP”).¹³ Thus far, courts have generally rejected unqualified requests for usernames and passwords to a person’s social media sites as being too broad.¹⁴ More targeted requests for specific information relevant to claims and defenses from social media sites, however, have been met with more approval.¹⁵

In certain cases where the public portions of parties’ social media sites undermine their claims, a broader examination of the contents of their private social media accounts could be permitted.¹⁶ In general, FRCP 34 addresses the production of electronically stored information and requires “reasonable particularity.”¹⁷ Courts have applied this rule to gauge whether discovery requests from social media accounts are objectionable.¹⁸ A discovery request to garner evidence from social media sources should, therefore, be particularized as much as possible to the claim or defense at issue in order to pass judicial scrutiny.

¹² Ass’n of the Bar of the City of N.Y. Comm. on Prof’l Ethics, Formal Op. 2010-2 (2010).

¹³ FED. R. CIV. P. 26(b)(1) (outlining the general scope of discovery, which includes any nonprivileged matter that is relevant to any party’s claim or defense).

¹⁴ See, e.g., *Howell v. Buckeye Ranch, Inc.*, No. 2:11-cv-1014, 2012 WL 5265170, at *1 (S.D. Ohio Oct. 1, 2012) (finding defendants’ request for plaintiff’s username and password to be overbroad because it would gain them “access to all the information in the private sections of [plaintiff’s] social media accounts—relevant and irrelevant alike”).

¹⁵ See, e.g., *id.* (instructing defendants that they were “free to serve interrogatories and document requests that [sought] information from the [plaintiff’s social media] accounts that [wa]s relevant to the claims and defenses in th[e] lawsuit”).

¹⁶ See *Romano v. Steelcase Inc.*, 907 N.Y.S.2d 650, 654 (Sup. Ct. 2010). In *Romano*, the court held that plaintiff’s “Facebook and MySpace accounts [were] both material and necessary” to defend the personal injury action and could have led to admissible evidence. *Id.* The court reasoned that, because public portions of the accounts showed the plaintiff “smiling happily in a photograph outside the confines of her home despite her claim that she [had] sustained permanent injuries and [was] largely confined to her house and bed,” the private portions may have provided further evidence regarding her enjoyment of life. *Id.* But in *Keller v. National Farmers Union Property & Casualty Co.*, the Defendant did not put forth “any evidence that the content of either of the Plaintiff’s public postings in any way undermine[d] their claims in th[e] case.” *Keller v. Nat’l Farmers Union Prop. & Cas. Co.*, No. CV 12-72, 2013 WL 27731, at *4 (D. Mont. Jan. 2, 2013). As a result, the defendant was not entitled to “delve carte blanche into the nonpublic sections of Plaintiff’s social networking accounts.” *Id.*

¹⁷ FED. R. CIV. P. 34(b)(1)(A).

¹⁸ See, e.g., *In re White Tail Oilfield Servs., LLC*, No. 11-0009-C4, 2012 WL 4857777, at *1–2 (E.D. La. Oct. 11, 2012) (citing FRCP 34 while analyzing the acceptable breadth of a discovery request for Facebook account information).

C. Privacy Objections Will Not Shield Relevant Social Media Information

Many parties have unsuccessfully argued that the private portions of their social media accounts should be protected by a common law right of privacy and should not be subject to discovery.¹⁹ In one case, the court pointed out that privacy concerns about a social media account are “more ‘germane to the question of whether requested discovery is burdensome or oppressive and whether it has been sought for a proper purpose’ rather than to affording a ‘basis for shielding those communications from discovery.’”²⁰ Therefore, as the party receiving a discovery request for social media evidence, an unsupported privacy objection will not likely succeed. An objection based on undue burden or improper purpose may meet with more success.

The privacy issue has been embattled further by the idea that there is a lower legitimate expectation of privacy in internet transmissions overall.²¹ It is reasoned that this is so because of the difficulty in foreseeing and controlling the further dissemination of information shared in that manner.²² This result is not unexpected, especially considering that even private diaries, which have much more limited distribution than internet postings, are also discoverable “if they contain relevant information regarding contemporaneous mental states and impressions of parties.”²³

D. Be Prepared for Authentication Through Witness Testimony

Social media sources of information are afflicted with authentication issues, just like paper documents. Rule 901(b)(1) of the Federal Rules of Evidence (“FRE”) may require the testimony of a witness with knowledge for authentication,²⁴ and has been used to analyze the admission of social media evidence.²⁵ In one case, a party argued that a LinkedIn profile should be admitted under FRE 201, allowing the court “to

¹⁹ See *Howell*, 2012 WL 5265170, at *1 (holding that the private section of a social media account “is not privileged nor protected from production by a common law right of privacy”); *Tompkins v. Detroit Metro. Airport*, 278 F.R.D. 387, 388 (E.D. Mich. 2012) (stating that “material posted on a ‘private’ Facebook . . . is generally not privileged, nor is it protected by common law or civil law notions of privacy”); *Largent v. Reed*, No. 2009-1823, 2011 WL 5632688 (Pa. Ct. C.P. Franklin Cnty. Nov. 8, 2011) (identifying that no court has recognized a general privacy privilege for Facebook material); *McMillen v. Hummingbird Speedway, Inc.*, No. 113-2010, 2010 WL 4403285 (Pa. Ct. C.P. Jefferson Cnty. Sept. 9, 2010) (“[I]t would be unrealistic to expect [one’s social network] disclosures [to] be considered confidential.”).

²⁰ *Reid v. Ingerman Smith LLP*, No. CV 2012-0307 (ILG), 2012 WL 6720752, at *2 (E.D.N.Y. Dec. 27, 2012) (quoting *EEOC v. Simply Storage Mgmt.*, 270 F.R.D. 430, 434 (S.D. Ind. 2010)).

²¹ See *id.* (citing *United States v. Lifshitz*, 369 F.3d 173, 190 (2d Cir. 2004)).

²² *United States v. Lifshitz*, 369 F.3d 173, 190 (2d Cir. 2004).

²³ *Reid*, 2012 WL 6720752, at *2.

²⁴ FED. R. EVID. 901(b)(1).

²⁵ See *Burchette v. Abercrombie & Fitch Stores, Inc.*, No. 08 Civ. 8786, 2010 WL 1948322, at *9 n.6 (S.D.N.Y. May 10, 2010) (rejecting submitted photographs from Facebook because they were not properly authenticated pursuant to FRE 901, but stating that photos could be authenticated by the testimony of a witness); *State v. Eleck*, 23 A.3d 818, 822 (Conn. App. Ct. 2011) (referencing FRE 901 in concluding that Facebook posts require authentication under the analogous Connecticut Code of Evidence).

take judicial notice of an adjudicative fact not subject to ‘reasonable dispute.’”²⁶ The court refused, however, because it held that the contents of the profile were “not capable of ready and accurate determination by resort to sources whose accuracy cannot reasonably be questioned.”²⁷ Social media evidence will most likely require authentication through the testimony of a witness with knowledge in order to be admissible in any action.

E. Social Media Information Obligations, Retention, and Spoliation

When preparing for intellectual property litigation, the attorney should investigate what social media the key parties use, and what might be relevant to the claims and defenses that can be found there. If the lawyer is not competent to investigate social media, the lawyer should utilize an expert to ensure that the investigation is performed competently. The ABA Model Rules of Professional Conduct comment 8 to Rule 1.1, regarding competence, was recently amended to require lawyers to “keep abreast of changes in the law and its practice, *including the benefits and risks associated with relevant technology*.”²⁸ Considering that the rules regarding discovery and admissibility of e-discovery have thus far been stretched to cover social media information, there is no reason to believe that the rules of professional conduct will not be similarly applied.

Once litigation has commenced, or is reasonably anticipated as soon as a party is on notice that social media may contain information relevant to the claims or defenses in a lawsuit, there is an obligation to preserve that information.²⁹ Tampering with social media accounts to avoid producing evidence can subject both the client and the attorney to serious spoliation consequences.³⁰

²⁶ *Shkolnikov v. JPMorgan Chase Bank*, No. 12-03996, 2012 WL 6553988, at *1 (N.D. Cal. Dec. 14, 2012); FED. R. EVID. 201(b).

²⁷ *Shkolnikov*, 2012 WL 6553988, at *2.

²⁸ MODEL RULES OF PROF'L CONDUCT R. 1.1 cmt. 8 (2012) (emphasis added); Bob Ambrogi, *New ABA Ethics Rule Underscores What EDD Lawyers Should Already Know: There's No Hiding from Technology*, CATALYST (Aug. 16, 2012), <http://www.catalystsecure.com/blog/2012/08/new-aba-ethics-rule-underscores-what-edd-lawyers-should-already-know-theres-no-hiding-from-technology/>.

²⁹ *Howell v. Buckeye Ranch, Inc.*, No. 2:11-cv-1014, 2012 WL 5265170, at *2 (S.D. Ohio Oct. 1, 2012) (stating that the plaintiff had an obligation to preserve all the private information in her social media accounts since being served with the defendants' second set of interrogatories, which requested the plaintiff's Facebook username and password).

³⁰ *Lester v. Allied Concrete Co.*, 83 Va. Cir. 308, 310, 321–23 (2011) (holding lawyer and client accountable for spoliation where lawyer directed client to deactivate Facebook page so he could respond to interrogatory that there was no Facebook page). The court went on to discuss the issue in terms of the Virginia Rules of Professional Conduct:

Rule 3.4(a) of the Virginia Rules of Professional Conduct mandates that a lawyer shall not counsel or assist his client to alter, destroy, or conceal a document or other material having potential evidentiary value for the purpose of obstructing a party's access to evidence. The apparent violation of this Rule will be referred to the Virginia State Bar for any action it deems appropriate.

Id. at 322 (italics in original).

All of these strictures concerning discovery from social media are important when considering which sources to explore for relevant evidence in litigation. There are more specific considerations, discussed below, in determining which social media information sources may be useful in intellectual property litigation.

II. DISCOVERY FROM SOCIAL MEDIA IN INTELLECTUAL PROPERTY LITIGATION

Discovery from social media has come up most often in criminal cases, but the civil litigation contexts in which it most commonly arises are employment law, insurance and personal injury law, family law, and general business litigation, including trademark infringement.³¹ As the use of social media continues to increase, many more types of claims and defenses will be affected by evidence gleaned from social media sources. This paper touches on the effect of discovery from social media on three major areas of intellectual property litigation, namely trademark, copyright, and patent infringement. As discussed below, trademark litigation has experienced the greatest impact from the advent of social media channels. However, the potential impact on copyright and patent litigation is also foreseeable.

A. Trademark Litigation and Social Media

The ease of copying, distributing, and using someone else's trademark in social media has created a plethora of issues for trademark owners attempting to police their marks.³² For instance, a celebrity's name could be used as the name of a social media account by someone not affiliated with nor approved to speak on behalf of the celebrity.³³ In one case, Tony La Russa, a "well-known manager for Major League Baseball," sued Twitter when an unauthorized account, which was created using his name, contained derogatory and demeaning tweets.³⁴ The case settled shortly after filing the suit and the domain name for the Twitter account was transferred to La Russa.³⁵ Some social media sites have procedures to remedy obvious trademark

³¹ John Patzakis, 689 *Published Cases Involving Social Media Evidence (With Full Case Listing)*, NEXT GENERATION EDISCOVERY L. & TECH BLOG (Mar. 14, 2012, 1:39 PM), <http://blog.x1discovery.com/2012/03/14/689-published-cases-involving-social-media-evidence-with-full-case-listing/>.

³² See Doug Sherwin, *Companies Now Watch Social Networks for Trademark Infringement*, THE DAILY TRANSCRIPT (May 6, 2011), <http://www.sddt.com/reports/article.cfm?RID=836&SourceCode=20110506cra>; Darren B. Cohen et al., *Social Media in Action in Trademarks*, LEGAL BYTES (Mar. 8, 2010, 8:51 AM), <http://www.legalbytes.com/2010/03/articles/social-and-digital-media-law/social-media-in-action-in-trademarks/>.

³³ Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders*, 58 BUFF. L. REV. 851, 863–64 (2010).

³⁴ Complaint for Trade Mark Infringement, False Designation of Origin, Trademark Dilution, Cybersquatting, Misappropriation of Name, and Misappropriation of Likeness at 2–3, *La Russa v. Twitter, Inc.*, No. CGC-09-488101 (Cal. Super. Ct. May 6, 2009), 2009 WL 1569936.

³⁵ Notice of Dismissal of Complaint with Prejudice, *La Russa v. Twitter, Inc.*, No. CV-09-2503-EMC (N.D. Cal. June 26, 2009); Darin M. Klemchuk & Roxana Sullivan, *Brand Enforcement on*

infringement before litigation is needed, so this avenue should be investigated for possible relief if a potential infringer is discovered.³⁶

Social media has served as evidence in trademark infringement suits as well. In *Wm. Wrigley Jr. Co. v. Swerve IP, LLC*, the court considered, in its likelihood of confusion analysis,³⁷ that both Wrigley 5 gum and Swerve artificial sweetener were marketed through the same social media channels: Facebook and Twitter.³⁸ Regarding the “area and manner of concurrent use” factor, the court pointed out that online shopping is often accomplished through keyword searches, which present similar products alongside one another to the consumer.³⁹ The court concluded that methods of selling products through sites like Amazon.com or marketing products through social media are “hardly unique” and that this factor was “too close to weigh heavily in favor of either party, but slightly favor[ed] Swerve IP.”⁴⁰

In *Swatch, S.A. v. Beehive Wholesale, LLC*, the court considered social media advertising under the “similarity of advertising” factor in its likelihood of confusion analysis.⁴¹ Swatch maintained Facebook and Twitter accounts, and although both parties maintained online stores, neither party purchased advertising on other websites nor used its own “online store as a ‘substantial’ marketing or advertising channel.”⁴² The court concluded that because the parties’ online stores were not considered a form of advertising, and the only common ground between the parties was that they each maintained their respective online stores, the advertising of the parties was not similar.⁴³

Social media evidence has also come up in determining individual liability for trademark infringement and dilution.⁴⁴ In *Lorillard Tobacco Co. v. California Imports, LLC*, the defendant’s use of the mark NEWPROT for his smoking product allegedly diluted the trademark NEWPORT, a well-known brand of cigarettes manufactured by the company Lorillard.⁴⁵ The entity that sold NEWPROT was fictitious, and consequently, it was unable to shield the individuals behind it from liability.⁴⁶ In determining that one defendant was individually liable for the infringement and dilution of Lorillard’s trademarks, the court pointed to his operation of a website and Facebook page that carried the NEWPROT products.⁴⁷

Social Networking Sites, A.B.A., <http://apps.americanbar.org/litigation/committees/commercial/articles/092410-klemchuk-sullivan-social-networking-brand-enforcement.html> (last visited Apr. 21, 2013).

³⁶ See Klemchuk & Sullivan, *supra* note 35 (alluding to “dispute resolution mechanisms” within social networking websites, like Twitter).

³⁷ *Wm. Wrigley Jr. Co. v. Swerve IP, LLC*, No. 11-C-9274, 2012 WL 4499063, at *4 (N.D. Ill. Sept. 28, 2012).

³⁸ *Id.* at *6–7.

³⁹ *Id.* at *7.

⁴⁰ *Id.*

⁴¹ *Swatch, S.A. v. Beehive Wholesale, LLC*, 888 F. Supp. 2d 738, 753 (E.D. Va. 2012).

⁴² *Id.* at 753–54.

⁴³ *Id.* at 754.

⁴⁴ *Lorillard Tobacco Co. v. Cal. Imports, LLC*, 866 F. Supp. 2d 529, 538 (E.D. Va. 2012).

⁴⁵ *Id.* at 536.

⁴⁶ *Id.* at 537.

⁴⁷ *Id.* at 538.

In one unfortunate trademark infringement case, the plaintiff found that his scant advertising via social media channels was insufficient to show commercial use of his registered trademarks.⁴⁸ The plaintiff had obtained New York state trademark registrations for his “Lower East Side” and “LES NYC” marks used on apparel, but his federal trademark registration for “LES NYC” was rejected as geographically descriptive.⁴⁹ He sued Old Navy when it began selling shirts with “Lower East Side NYC” logos on them.⁵⁰ Old Navy argued that the plaintiff had not shown sufficient use in commerce of his trademarks, and therefore, Old Navy was entitled to summary judgment of non-infringement.⁵¹ The court agreed that the plaintiff’s photograph of him wearing an LES hat, one flyer, and a screenshot of his Facebook page with the LES Mark displayed on it did “not come close to supporting a finding of ‘use in commerce’ as that term has been interpreted and applied.”⁵²

Social media evidence has been useful in trademark litigation for likelihood of confusion analyses, individual liability, and evidence of use in commerce. Exploring possible social media information sources has been beneficial thus far to some trademark infringement litigants. As social media use increases by the day, it will certainly continue to provide important evidence in trademark infringement cases.

B. Copyright Litigation and Social Media

Similar to trademark litigation, the ease of copying others’ creative content in social media has provided many new instances of copyright infringement concerns.⁵³ This area is evolving rapidly, and a recent case seems to indicate to social media website operators that courts will not hold them liable for induced infringement unless they specifically encourage their users to infringe.⁵⁴

In *Ark Promotions, Inc. v. Justin.tv, Inc.*, the owner of the live broadcast of the January 22, 2011 Evander Holyfield and Sherman Williams boxing match sued Justin.tv for unauthorized real time streaming of the broadcast and sued YouTube for hosting a copy of the unauthorized broadcast.⁵⁵ Defendants filed a motion to dismiss the inducement claims because the complaint did not allege “any ‘affirmative steps’ intended to encourage copyright infringement by their users.”⁵⁶ The magistrate judge agreed, finding that plaintiff’s submitted evidence of defendants’ instructions to stream content and upload videos in general did not support a “facially plausible claim” of induced copyright infringement under *Grokster*.⁵⁷

⁴⁸ Lopez v. Gap, Inc., 883 F. Supp. 2d 400, 417 (S.D.N.Y. 2012).

⁴⁹ *Id.*

⁵⁰ *Id.* at 411.

⁵¹ *Id.* at 413.

⁵² *Id.* at 417.

⁵³ See G. Ross Allen & Francine D. Ward, *Things Aren’t Always as They Appear: Who Really Owns Your User-Generated Content?*, LANDSLIDE, Nov.–Dec. 2010, at 49, 49–50.

⁵⁴ *Ark Promotions, Inc. v. Justin.tv, Inc.*, No. 3:12-cv-131-RJC-DCK, 2012 WL 4978079, at *12 (W.D.N.C. Oct. 17, 2012).

⁵⁵ *Id.* at *2.

⁵⁶ *Id.* at *4.

⁵⁷ *Id.* at *11–12 (citing *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 545 U.S. 913, 936–37 (2005), to explain inducement of infringement).

District Court Judge Robert J. Conrad, Jr. adopted the magistrate's recommendation and granted defendants' partial motion to dismiss on October 17, 2012.⁵⁸

One area where social media evidence could be very useful in copyright infringement litigation is in proving access to the original work.⁵⁹ In a copyright infringement case, evidence of access to the original work is required because independent creation is a defense to copyright infringement.⁶⁰ In *Watt v. Butler*, for example, there was not enough evidence to show that the accused copyright infringer had access to the original work.⁶¹ Therefore, the plaintiff had to make up for the lack of evidence by showing significantly more substantial similarity between the original and allegedly infringing work.⁶² During discovery in copyright infringement cases, then, the alleged infringer's social media sites and online accounts, such as iTunes, Spotify, Pandora, and Amazon, should be investigated for any evidence that could show access to the original work.

C. Patent Litigation and Social Media

Discovery from social media in patent litigation has not come up much in published case law, aside from cases in which a social media site is a party to the patent infringement litigation. In one interesting case, though, multiple companies were accused of patent infringement based solely on their use of social media sites that allegedly incorporated patented features.⁶³ A motion by one defendant to implead the implicated social media sites—Google+, Facebook, and Twitter—was recently denied because the motion was untimely and impleading was likely to cause undue delay.⁶⁴ Staying ahead of the curve requires a prospective analysis of elements of patent infringement claims or defenses that could be bolstered by probing social media sources in discovery.

1. Social Media Evidence the Patentee Should Seek

The first opportunity to gather information from social media sites for a patent infringement lawsuit is during the pre-filing investigation. Many companies have their own social media sites that supply information about products and sales that a

⁵⁸ *Id.* at *1.

⁵⁹ *See, e.g.*, *City of Carlsbad v. Shah*, 850 F. Supp. 2d 1087, 1100 (S.D. Cal. 2012) (stating that copyright infringement claims require proof that there is ownership of a valid copyright and copying of the original elements of the work, which can, in turn, be shown if: "(a) the defendant had access to the allegedly infringed work; and (b) the two works (i.e., the original and the alleged copy) are substantially similar").

⁶⁰ *Peters v. West*, 692 F.3d 629, 633 (7th Cir. 2012).

⁶¹ *Watt v. Butler*, 457 F. App'x 856, 859 (11th Cir. 2012).

⁶² *Id.* at 860–61.

⁶³ *Helferich Patent Licensing, LLC v. Legacy Partners, LLC*, Nos. CV-11-2304-PHX-NVW, CV-11-2476-PHX-NVW, CV-12-0060-PHX-NVW, CV-12-0100-PHX-NVW, 2013 WL 68610, at *1 (D. Ariz. Jan. 7, 2013).

⁶⁴ *Id.* at *2–3.

patentee could use to gather evidence of possible infringement.⁶⁵ An adequate pre-filing investigation requires an analysis of the features covered by the asserted claims,⁶⁶ which, in some cases, could be accomplished by examining digital color photographs.⁶⁷ Gathering any and all photographs, descriptions, and videos of the accused products from social media sites and other sources is a highly recommended part of a pre-filing investigation. Many companies have set up YouTube pages that contain videos and corresponding information about products posted by the corporation itself.⁶⁸ Similarly, companies may have posted product information on Facebook,⁶⁹ LinkedIn,⁷⁰ or Google+.⁷¹ All of these social media sources could provide information important to determining whether a target product contains the suspected patented features.

Next, during litigation, discovery requests should be specifically tailored to the relevant information being sought when targeting social media sources.⁷² The requests should closely track the evidence required for each claim or defense in the case.⁷³ For the patentee, this means that requests from social media will largely focus on the accused products and the accused infringer's knowledge of the patent in suit.⁷⁴

As previously discussed in connection with the pre-filing investigation, information about products accused of patent infringement could be lurking on many social media sites. During formal discovery, however, the additional *non-public*

⁶⁵ See, e.g., *Coca-Cola*, FACEBOOK, <https://www.facebook.com/cocacola> (last visited Apr. 21, 2013); *Disney*, FACEBOOK, <https://www.facebook.com/Disney> (last visited Apr. 21, 2013); *Converse*, FACEBOOK, <https://www.facebook.com/converse> (last visited Apr. 21, 2013).

⁶⁶ *Q-Pharma, Inc. v. Andrew Jergens Co.*, 360 F.3d 1295, 1300–01 (Fed. Cir. 2004) (stating that, in the context of patent infringement, Rule 11 requires “that an attorney interpret the asserted patent claims and compare the accused device with those claims before filing a claim alleging infringement”).

⁶⁷ See *Woods v. DeAngelo Marine Exhaust, Inc.*, 692 F.3d 1272, 1288–89 (Fed. Cir. 2012) (affirming the district court's refusal to impose Rule 11 sanctions where the patentee decided to file the infringement suit based only on photographs he took himself after receiving no response to his written request for information about the products).

⁶⁸ See, e.g., *Toyota USA*, YOUTUBE, <http://www.youtube.com/user/ToyotaUSA?feature=pvchclk> (last visited Apr. 21, 2013) (containing various how-to and demonstration videos for features on certain Toyota vehicles).

⁶⁹ See, e.g., *Toyota USA*, FACEBOOK, <https://www.facebook.com/toyota> (last visited Apr. 21, 2013); *Coca-Cola*, FACEBOOK, <https://www.facebook.com/cocacola> (last visited Apr. 21, 2013).

⁷⁰ See, e.g., *Toyota USA*, LINKEDIN, <http://www.linkedin.com/company/toyota> (last visited Apr. 21, 2013); *The Coca-Cola Company*, LINKEDIN, <http://www.linkedin.com/company/the-coca-cola-company> (last visited Apr. 21, 2013).

⁷¹ See, e.g., *Toyota USA*, GOOGLE+, <https://plus.google.com/+toyotausa/posts> (last visited Apr. 21, 2013); *Coca-Cola*, GOOGLE+, <https://plus.google.com/+Coca-Cola/posts> (last visited Apr. 21, 2013).

⁷² See *Mailhoit v. Home Depot U.S.A., Inc.*, 285 F.R.D. 566, 571–72 (C.D. Cal. 2012).

⁷³ FED. R. CIV. P. 26(b)(1); see also *Mailhoit*, 285 F.R.D. at 571–72 (finding that requests for any social media evidence “that reveal, refer, or relate to any emotion” are too broad to be “reasonably particular” to the case).

⁷⁴ J. Christopher Carraway, *Discovery Issues in Patent Cases*, KLARQUIST SPARKMAN, LLP 1 (July 9, 2010), http://www.klarquist.com/Articles/16_Discovery%20Issues%20in%20Patent%20Cases%202010.pdf.

portions of any social media sites used by the accused infringer will be available for relevant data mining.⁷⁵

The patentee should inquire about the accused infringer's knowledge of the patent in suit to investigate possible copying and to show that the patent was willfully infringed. To show copying of patented features, there should be discovery requests directed to any content on social media sites related to the patent-in-suit or products embodying the patent-in-suit.

2. Social Media Evidence the Accused Infringer Should Seek

The accused infringer will be concerned primarily with gathering information to help invalidate the asserted patent claims. This evidence often centers on the activities of the inventor around the time of the alleged conception and reduction to practice of the invention.⁷⁶ Even though we now have a first-inventor-to-file patent system in the United States, disputes regarding conception will continue for many years on patents having an effective filing date prior to March 16, 2013, when the first-inventor-to-file system took effect under the America Invents Act.⁷⁷

Social media sources could be especially useful when the alleged infringer is investigating the patentee's claims of conception and trying to find relevant prior art. In formulating invalidity arguments, it is useful for the accused infringer to have access to as much prior art as possible in order to prove the invention was not novel or was obvious to those of ordinary skill in the art at the time of invention. In particular, prior art that the inventor or inventors had access to around the time of conception could serve as strong obviousness references. Some examples of relevant social media evidence in this area include content about conferences the inventor attended and the inventor's Amazon Reading List around the time of alleged conception.

Other evidence that is useful for invalidating patents is evidence of public use or sale more than one year prior to the filing date of the patent application.⁷⁸ To obtain

⁷⁵ See *Keller v. Nat'l Farmers Union Prop. & Cas. Co.*, No. CV 12-72-M-DLC-JCL, 2013 WL 27731, at *4 (D. Mont. Jan. 2, 2013) ("The content of social networking sites is not protected from discovery merely because a party deems the content 'private.'").

⁷⁶ See *Preston v. Marathon Oil Co.*, 684 F.3d 1276, 1287 (Fed. Cir. 2012). Conception requires the "formation in the mind of the inventor, of a definite and permanent idea of the complete and operative invention, as it is hereafter to be applied in practice." *Id.* at 1287 n.6 (citing *Burroughs Wellcome Co. v. Barr Labs., Inc.*, 40 F.3d 1223, 1228 (Fed. Cir. 1994)).

⁷⁷ See *Leahy-Smith America Invents Act*, Pub. L. No. 112-29, § 3, 125 Stat. 284, 285–93 (2011) [hereinafter *AIA*].

⁷⁸ The United States had a "first to invent" system before the AIA went into effect, which awarded a patent to the first person or persons to invent something, regardless of whether another party later independently invented the same thing and was the first to file a patent application on the invention. See U.S. PAT. & TRADEMARK OFFICE, U.S. DEP'T OF COMMERCE, *MANUAL OF PATENT EXAMINING PROCEDURE* § 2138.01 (8th ed. Rev. 9, Aug. 2012) (outlining priority challenges in an interference proceeding). Under the first to invent system, if there was a dispute about which party was the first to invent something, evidence such as the date of conception and diligence in developing the invention after conception was vital. *Id.* After the AIA, the United States now has a "first to file" system, as do the majority of other countries in the world, which awards patent rights to the first inventor to file a patent application on that invention. See *supra* note 77 and

useful evidence in this area, discovery from social media accounts such as eBay, Amazon, and Craigslist could be instrumental.

Both parties should be mindful that social media is a way to communicate, so they should both seek discovery of relevant communications between key parties on all social media sites. Expert witnesses in particular should be consistent, and therefore, any and all of their relevant social media content should be reviewed for discrepancies.⁷⁹

CONCLUSION

Social media evidence is already being used in many different types of cases, including trademark infringement litigation. So far, the rules surrounding its discovery and use have been effectively applied, building on the framework in place for general electronic discovery. The use and importance of social media evidence will continue to grow and litigants in intellectual property litigation should aim to be ahead of the curve in understanding the impact of social media evidence on their claims and defenses.

accompanying text. Even under a “first to file” system, evidence of conception is useful in certain circumstances, but not as instrumental as under the previous “first to invent” system. Patrick J. Coyne, *Make a New Plan, Stan! Dealing Effectively with the America Invents Act*, FINNEGAN (Apr. 6, 2012), <http://www.finnegan.com/resources/articles/articlesdetail.aspx?news=50224ef5-6012-40bf-a033-3449efb14550> (explaining that proof of conception may still be useful in a derivation proceeding under the AIA).

⁷⁹ Tracy L. Coenen, *Collision of Expert Witnesses, Social Media*, WIS. L.J. (Apr. 20, 2009, 1:00 AM), <http://wislawjournal.com/2009/04/20/collision-of-expert-witnesses-social-media/>.