

Case Study: Web Monitoring

“Many potential infringements on the web fly under the radar. Web Monitoring identifies infringing uses that would otherwise be very difficult to detect.”

— **Richard M. Assmus**

Senior Associate, Intellectual Property
Mayer, Brown, Rowe & Maw LLP

THE LAW FIRM

One of the 10 largest law practices in the world, Mayer, Brown, Rowe & Maw LLP serves clients on both sides of the Atlantic, including 65 of the Fortune 100. Recognized for innovation, the firm spans a wide range of practice areas—from antitrust to product liability to intellectual property.

THE CHALLENGE

According to Richard Assmus, Senior Associate in Mayer, Brown’s Intellectual Property Department, the continued growth of the Internet as a medium of commerce and communication has created new challenges in trademark protection and enforcement.

“In recent years, we’ve run into quite a number of web-based infringements that were not caught by existing tools,” Assmus says. “Watch services monitor federal and state trademark applications, business name filings and new domain name registrations, but they don’t capture situations where someone is using a mark on the web without authorization.”

Initially, Assmus had a staff member perform web searches in-house. He quickly concluded this was not cost-effective or advisable.

“It was very time-consuming. In addition, monitoring should be performed in a uniform way according to documented and accepted standards. Having one of the firm’s paralegals perform ad hoc Internet searches is difficult to document, and we can’t necessarily establish that method as meeting a certain standard of care” he says. “And if an infringement does go to litigation, you may end up having to put one of your own people on the stand to testify about how they performed the monitoring.”

Adding up all these factors, Assmus concluded the best option was to have this task performed by a third party specializing in web monitoring, according to documented and accepted procedures.

THE SOLUTION

A subscriber to Thomson CompuMark watch services for many years, Assmus was intrigued to hear about the company’s Web Monitoring offering. The service provides customized, sophisticated searching of the web to identify a range of threats to a client’s trademark or brand—including unauthorized or fraudulent uses, generic uses, and even appearances of a mark on inappropriate sites. Advanced, proprietary filtering techniques narrow down the identified “hits” to the most relevant results in ranked order. This minimizes the time required to review search results and accelerates one’s ability to respond quickly to potential infringements, reducing risk to a client’s brand and reputation.

Assmus tried Web Monitoring, liked what he saw and offered the service to his clients. The service has since become a valuable tool Assmus uses to help protect his clients' trademarks.

"With Web Monitoring, we now have a systematic, documented and cost-effective way to capture potential infringing uses on the web," he says. "It's an ideal supplement to existing watch services."

Web Monitoring is one of Thomson CompuMark's Web Watching services and is tailored to each firm's needs, allowing users to establish criteria to deliver customized results. For example, users can indicate known authorized uses of a mark, to ensure these are not included in Web Monitoring reports. Reports are delivered via an easy-to-use web-based interface, with links directly to identified sites. E-mail alerts notify users when report updates are available. Searches can be performed and reported as frequently, or infrequently, as a client wishes—monthly, quarterly, or according to any other schedule.

Assmus notes that once a listed site has been reviewed, it will not appear on future Web Monitoring update reports, unless the site changes. "This is a major time-saver," he says, noting that most update reports have 10 or fewer sites listed.

Web Monitoring can also be a money saver. "In the large scheme of things, it's relatively inexpensive, certainly compared to the costs and risks of litigating a long-unnoticed infringement," Assmus says.

RESULTS

Since he began using Web Monitoring for his clients, Assmus says the service has proven its worth.

"With Web Monitoring, we have found several web sites of interest that were otherwise not detected," he says. "We were able to respond quickly to pursue these and get our clients' marks removed."

Assmus pointed to one notable example for a client in the collegiate sports industry. A key challenge for this client is identifying the many "mom and pop" web sites devoted to collegiate sports, including fan sites, that may use a protected mark—often without realizing they are infringing on a legally protected trademark.

"With Web Monitoring, we have been able to identify sites using our client's mark in a way that might lead viewers to believe that our client is sponsoring the site," he says, noting that Web Monitoring is also effective in finding web sites that sell goods or knockoffs with unauthorized uses of the client's trademark.

Assmus says Web Monitoring has become an important complement to other trademark monitoring activities and tools.

"We now recommend Web Monitoring as part of a suite of watch services to any client with a mark that is subject to Internet infringement. It's a very useful tool," Assmus says. "The problem of unauthorized trademark use on the web is not going away. With Web Monitoring, we have a very useful tool to address the problem and protect our clients' valuable brands."

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To learn more about Web Monitoring and Thomson CompuMark's suite of Web Watching Services, call (800) 692-8833 or visit <http://compumark.thomson.com>.

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