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**#CANHASHTAGSBETRADEMARKED: TRADEMARK LAW AND THE
DEVELOPMENT OF HASHTAGS**

*Elizabeth A. Falconer**

Within the past several years, hashtags have become one of the most popular means of organizing content on social media. The experimental categorical tool is rampant in our society because it allows consumers to connect with and engage other social media users based on a common interest, theme, or topic. Brands started using trademarks in hashtags and even trademarking hashtags themselves to encourage users to talk about their products. Incidentally, these hashtags were used by competitors, which has lead to hashtag trademark infringement claims. The United States Patent and Trademark Office recognizes a hashtag can serve as, and be registered as, a trademark. However, a federal district court in Eksouzian v. Albanese determined a hashtag is not a trademark. This Recent Development argues that because of the inherent nature of social media and the way consumers understand how it operates, hashtags should not be afforded legal trademark protection.

I. INTRODUCTION—THE EVOLUTION OF THE HASHTAG

As of September 2015, the hashtag has infiltrated most technological avenues of communication. First appearing on Twitter¹

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¹ Twitter is an online social networking website that enables users to send and read short 140-character messages called “tweets.” See generally Paul Gil, *What Exactly Is ‘Twitter’? What Is ‘Tweeting’?*, ABOUT TECH, July 2012, <http://netforbeginners.about.com/od/internet101/f/What-Exactly-Is-Twitter.htm> (last visited Oct. 23, 2015).

17 N.C. J.L. & TECH. ON. 1, 2
#CanHashtagsBeTrademarked

in 2007,² hashtags are now prominently displayed nearly everywhere. They have moved from their birthplace—Twitter (#barcamp³)—to Instagram (#OOTD⁴), Facebook (#blacklivesmatter⁵) and virtually all social media platforms and networks. Their versatility does not stop with the Internet. Hashtags are also in commercials (#SoLongVampires⁶), on TV shows (#SCANDAL⁷), and on the news (#CNN⁸). They are painted on football fields (#GOBLUE⁹); on fundraising banners (#stjudewalkrun¹⁰); even on ice cream cartons (#CAPTUREEUPHORIA¹¹). Corporations, celebrities, universities,

² David Arnoux, *Hashtag: Where Did This #phenomenon Begin and Why Do We #love it (but only on Twitter)?*, LIFEHACK, <http://www.lifehack.org/articles/communication/hashtag-where-did-this-phenomenon-begin-and-why-love-but-only-twitter.html> (last visited Sept. 21, 2015).

³ #Barcamp was the first hashtag used in a Tweet on Twitter. *See infra* note 18.

⁴ OOTD is an acronym for “outfit of the day.” The hashtag is currently cataloging over seventy-three million photographs. Instagram, <https://instagram.com/explore/tags/ootd/> (last visited Oct. 30, 2015).

⁵ #BlackLivesMatter is a social media activist hashtag that began in light of the 2013 acquittal of George Zimmerman in the shooting death of an African-American teen. BlackLivesMatter, <http://blacklivesmatter.com/> (last visited Sept. 21, 2015).

⁶ This hashtag was displayed on television at the end of the 2012 Audi Super Bowl advertisement. Audi, *Audi “Vampire Party” Super Bowl Commercial 2012* YOUTUBE (Feb. 5, 2012), https://www.youtube.com/watch?v=iDV2yp_AjBM.

⁷ This hashtag was displayed on ABC television network to promote a popular ABC drama by the same name, *Scandal*. ABC (ABC television broadcast).

⁸ CNN displays #CNN during broadcasting. CNN (CNN television broadcast).

⁹ #GOBLUE, the Michigan slogan, is painted on the fifty-yard line. An image of the field can be found on the Michigan Athletic Association website, and coincidentally the Page is entitled #SpringGame. #SpringGame, MICHIGAN ATHLETIC ASSOCIATION, (Apr. 14, 2012), <http://mvictors.com/tag/2012-michigan-spring-game/>.

¹⁰ During St. Jude walk/run in Raleigh. *See* #stjudewalkrun, Instagram, <https://instagram.com/explore/tags/stjudewalkrun/> (last visited Nov. 3, 2015).

¹¹ #CAPTUREEUPHORIA was a Ben & Jerry’s ad campaign encouraging consumers to tag photos on social media depicting joy. Julie Blakley, *6 Cross-Platform Hashtag Marketing Campaigns*, POSTANO (Apr. 16, 2013), <http://www.postano.com/blog/6-cross-platform-hashtag-marketing-campaigns>.

athletes, and politicians all make use of this recent pop culture phenomenon.

Various entities are using trademarks in hashtags on social media,¹² and even trademarking hashtags themselves.¹³ This Recent Development argues that a hashtag does not operate as a trademark, and therefore is not entitled to trademark protection. Part I will explore the history and background of the hashtag. Part II will observe current trademark law governing trademark rights, how to acquire trademark rights, and how to enforce those trademark rights. Part III will analyze hashtag related trademark claims. Part IV will illustrate why hashtags should not be afforded legal protection by arguing that a hashtag is incapable of identifying a source, does not cause consumer confusion, and will encourage genericide. Finally, Part V will discuss why public policy adds additional support to the argument that hashtags should not be entitled to legal trademark protection.

In 2014, Merriam-Webster Dictionary defined a “hashtag” as “a word or phrase preceded by the symbol ‘#’ that classifies or categorizes the accompanying text.”¹⁴ The hashtag has not only been added to the dictionary, but has become ingrained in every day conversation. However, a hashtag is more than the mere addition of a symbol to common discourse, a hashtag is a type of metadata.¹⁵ Metadata is a common tech term meaning data that describes other data.¹⁶ In other words, a hashtag provides

¹² See *infra* Section III.

¹³ See *infra* note 33 and accompanying text.

¹⁴ Jason O. Gilbert, ‘Selfie,’ ‘Tweet,’ and ‘Hashtag’ Added to Merriam-Webster Dictionary, YAHOO TECH (May 19, 2014), <https://www.yahoo.com/tech/selfie-tweep-and-hashtag-added-to-86215489849.html>; see also Madeline Stone, ‘Selfie’ And ‘Hashtag’ Are Being Added To The Merriam-Webster Dictionary, BUSINESS INSIDER, (May 19, 2014), <http://www.businessinsider.com/selfie-and-hashtag-added-to-the-dictionary-2014-5>.

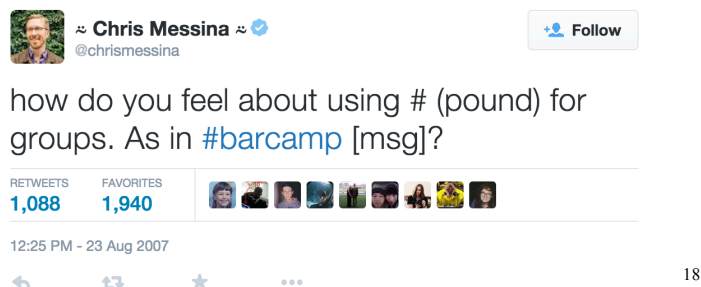
¹⁵ Eksouzian v. Albanese, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *8 (C.D. Cal. Aug. 7, 2015) (holding “a hashtag, as a form of metadata”).

¹⁶ *Metadata* MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/metadata> (last visited Sept. 21, 2015) [hereinafter *Metadata*] (defining metadata as “data that provides information about other

17 N.C. J.L. & TECH. ON. 1, 4
#CanHashtagsBeTrademarked

information about some other data. In 2007, Chris Messina, dubbed the inventor of the hashtag, suggested that Twitter users utilize a hashtag to create “groups.”¹⁷ Figure 1 shows the first use of a hashtag:

Figure 1:



A hashtag functions similarly to a hyperlink;¹⁹ one can simply click on a hashtag with a computer mouse and be taken to another

data”). When used to describe information technology, the prefix “meta” means “an underlying definition or description.” *Metadata*, WHATIS.COM – TECHTARGET, <http://whatis.techtarget.com/definition/metadata> (last visited Oct. 23, 2015). Information technology or “IT” can be understood generally as any technology through which we get information. For example, we get information from Twitter, so Twitter is information technology. The dictionary defines information technology as “technology involving the development, maintenance, and use of computer systems, software, and networks for the processing and distribution of data.” *Information Technology* MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/information%20technology> (last visited Oct. 21, 2015).

¹⁷ Jim Edwards, *The Inventor Of The Twitter Hashtag Explains Why He Didn't Patent It*, BUSINESS INSIDER (Nov. 21, 2013, 10:21 AM), [hereinafter *The Inventor*], <http://www.businessinsider.com/chris-messina-talks-about-inventing-the-hashtag-on-twitter-2013-11>.

¹⁸ Chris Messina @chrismessina, TWITTER (Aug. 23, 2007), [hereinafter *The First Hashtag Tweet*], https://twitter.com/chrismessina/status/223115412?ref_src=twsrc%5Etfw (last visited Oct. 30 2015).

¹⁹ A hyperlink is “a highlighted word or picture in a document or Web page that you can click with a computer mouse to go to another place in the same or a different document of Web page.” *Hyperlink*, MERRIAM-WEBSTER DICTIONARY, <http://www.merriam-webster.com/dictionary/metadata> (last visited Sept. 21, 2015).

place on the Internet.²⁰ To illustrate this concept, when hashtags first appeared on Twitter they operated as a means to direct users to various topics of interest, operating as a grouping mechanism because users could click on a hashtag with a computer mouse and subsequently be taken to other tweets, a group, bearing the same hashtag that the user clicked.²¹ For example, Twitter users can click on Messina's #barcamp, shown in Figure 1, and be taken to other tweets containing #barcamp. What started as a fad on Twitter quickly made its way into mainstream American culture.²²

The appeal of grouping a seemingly infinite number of sources together with the use of a single hashtag, and the hashtag's overall capacity to easily direct consumers to other data, prompted other platforms to follow Twitter's lead.²³ For example, during the 2013 Super Bowl XLVII, hashtags "were in exactly half of the national ads,"²⁴ from #doritos to #calvinklein,²⁵ demonstrating the

²⁰ Like a hyperlink, a hashtag is an HTML-activated device that can be clicked with a computer mouse. *See id.*; *see generally The Inventor*, *supra* note 17.

²¹ Initially, hashtags directed Twitter users, commonly referred to as members of the Twittersphere, to different tweets by providing a clickable HTML-activated device, the hashtag. *See supra* notes 18 and 19; *see also* Julia Turner, #InPraiseofTheHashtag, NEW YORK TIMES MAGAZINE (Nov. 2, 2012), <http://www.nytimes.com/2012/11/04/magazine/in-praise-of-the-hashtag.html> ("[H]ashtags were primarily functional—a way of categorizing tweets by topic so that members of the Twittersphere could follow conversations of interest to them.").

²² Comically, according to Messina: "[Twitter] told me flat out, 'These things are for nerds. They're never going to catch on.'" *See The Inventor*, *supra* note 17.

²³ *See supra* notes 2–10.

²⁴ Russell Brandom, *Who Owns The Hashtag? (It Isn't Twitter)*, THE VERGE (Feb. 7, 2013), <http://www.theverge.com/2013/2/7/3960580/hashtags-are-bigger-than-twitter-vine-tumblr-instagram>. Hashtags were in 26 of 52 advertisements. *See also* Matt McGee, *The #Hashtag Bowl, Game Over: Twitter Mentioned In 50% Of Super Bowl Commercials, Facebook Only 8%, Google+ Shut Out*, MARKETING LAND (Feb. 3, 2013, 11:36 pm), <http://marketingland.com/game-over-twitter-mentioned-in-50-of-super-bowl-commercials-facebook-only-8-google-shut-out-32420>.

²⁵ *Id.* The following hashtags appeared in commercials during Super Bowl XLVII: (1) M&Ms – #betterwithmms; (2) Audi – #braverywins; (3) Hyundai –

popularity and versatility of the hashtag. More importantly, those ads were not specific to Twitter, meaning the commercials did not ask viewers to search these tags on Twitter; they asked viewers to use the hashtag everywhere.²⁶ The commercial possibilities of hashtags seem endless. To use one popular Instagram hashtag as an example, fashion aficionados and clothing companies all over the world tag images of “outfits of the day” with the hashtag #OOTD, making daily fashion trends instantly accessible.²⁷ In a society where clothing trends are constantly evolving, this hashtag provides immense marketing advantages. Marketing and advertising industries “can use hashtags to monitor conversations about their brands and products, promote products, build brand awareness, and conduct marketing campaigns.”²⁸ When asked why he never sought ownership of the hashtag idea,²⁹ Messina first explained that owning the hashtag device would have likely constrained its use to Twitter, emphasizing that he wanted “broad based adoption and support [of the hashtag]—across networks and

#pickyourteam; (4) GoDaddy – #thekiss; (5) Doritos – #doritos; (6) Best Buy – #infiniteanswers; (7) Disney Oz – #disneyoz; (8) Fast & Furious movie – #fastandfurious; (9) Toyota – #wishgranted; (10) Doritos – #doritos; (11) Calvin Klein – #calvinklein; (12) Cars.com – #nodrama; (13) Bud Light – #herewego; (14) Hyundai Sonata – #epicplaydate; (15) Volkswagen – #gethappy; (16) Subway – #15yrwinningstreak; (17) Subway – #FebruANY; (18) Bud Light – #herewego; (19) Subway – #FebruANY; (20) Bud Light – #herewego; (21) MiO Fit – #changestuff; (22) Pistachios – #crackinstyle; (23) Speed Stick – #handleit; (24) Budweiser Clydesdales – #clydesdales; (25) Tide – #miraclestain; (26) Samsung – #thenextbigthing. Hashtags that are repeated appeared in multiple commercials. McGee, *supra* note 24.

²⁶ See *Brandom*, *supra* note 24. (“Only two of the ads called out Twitter specifically. The rest just called out a hashtag. They weren’t saying ‘check us out on Twitter;’ they were just saying, ‘talk about us.’”); see also *id.*; *infra* note 197.

²⁷ See *supra* note 4.

²⁸ Paul Chaney, *Using Hashtags For Ecommerce*, PRACTICAL ECOMMERCE (Oct. 8, 2013), <http://www.practicalecommerce.com/articles/59511-Using-Hashtags-for-Ecommerce>; see also Hill *infra* note 204.

²⁹ Messina could have applied for a patent on the hashtag, giving him a licensable product that, in theory, could have led to him making a large sum of money off the idea. See generally *The Inventor*, *supra* note 17.

mediums.”³⁰ Next, Messina explained: “I had no interest in making money (directly) off hashtags. They are born of the Internet, and should be owned by no one.”³¹

According to the inventor himself, the point of the hashtag was always for it to be used across platforms.³² This is precisely the appeal of the hashtag: it is freely usable.³³ However, Messina’s characterization of the hashtag as freely usable is not entirely true. In 2015, dozens of hashtags were granted federal protection³⁴ as the United States Patent and Trademark Office (“USPTO”) approved trademark applications for 70 hashtags, effectively assigning exclusive rights to the trademark owners of those hashtags.³⁵ Trademark law protects trademark ownership rights by governing trademark use.

II. TRADEMARK LAW

The purpose of a trademark is to identify the source of a good.³⁶ The law defines a trademark as, “a word, phrase, slogan, symbol, or design, or combination thereof, that identifies the source of the goods and services of one owner,”³⁷ and

³⁰ *Id.* (quoting Christ Messina’s belief that owning hashtags, “would have likely inhibited their adoption.”).

³¹ *Id.*

³² *The Inventor*, *supra* note 17.

³³ Brandom, *supra* note 24 (“[W]hile you may not be able to drop that Instagram into your Twitter feed (or drop that Vine into your Facebook), the hashtag can go wherever it wants. Nobody owns it. It’s free.”).

³⁴ Alexandra Roberts, *Hashtags Are Not Trademarks*—Eksouzian v. Albanese, TECHNOLOGY & MARKETING LAW BLOG (Aug. 26, 2015), <http://blog.ericgoldman.org/archives/2015/08/hashtags-are-not-trademarks-eksouzian-v-albanese-guest-blog-post-2.htm> (listing hashtags that were federally registered including KFC’s #HowDoYouKFC; Vanity Fair’s #VFSocialClub; Mucinex’s #BlameMucus; Glade’s #BestFeelings; and Volvo’s #SwedeSpeak).

³⁵ *See infra* Part II.

³⁶ *Basic Facts: Trademarks, Patents, and Copyrights*, UNITED STATES PATENT AND TRADEMARK OFFICE [hereinafter *Basic Trademark Facts*], <http://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos> (last visited Sept. 21, 2015).

³⁷ Lanham Act § 43, 15 U.S.C. § 1127 (2015); *see also Basic Trademark Facts*, *supra* note 35. An example of a trademarked word is “Kindle” to

“distinguishes them from the goods and services of another owner.”³⁸ In other words, a trademark is a brand that is sufficiently specific enough to signify to the consumer the source of a particular good, and the ability to differentiate amongst multiple sources allows consumers to pick and choose one product over another.³⁹ Simply put, trademarks serve to help consumers organize information.⁴⁰ As a result, trademarks make purchasing decisions easier.⁴¹ Instead of having to read fine printed labels or having to ask a cashier who made a certain product, consumers can quickly turn to a trademark for quality assurance.⁴² For example, if a consumer tries a can of Pepsi and is dissatisfied with the product, the consumer can easily avoid Pepsi in the future by avoiding soda products encompassing the easily recognizable and distinct Pepsi trademark. Additionally, consumer recognition gives “manufacturers an incentive to invest in the quality of their goods.”⁴³ Manufacturers will want to invest in the quality of their goods in order to establish goodwill and a positive business

Amazon. KINDLE, Registration No. 85,799,118. An example of a trademark slogan is “just do it,” federally registered to Nike in 1995. JUST DO IT, Registration No. 79,829,171. An example of a trademark symbol is the Nike “swoosh”, federally registered to Nike in 1998. The mark consists of a stylized swoosh, Registration No. 75,977,266.

³⁸ See *Basic Trademark Facts*, *supra* note 35.

³⁹ Lanham Act, § 43; see generally *Basic Trademark Facts*, *supra* note 35.

⁴⁰ Mark P. McKenna, *The Normative Foundations of Trademark Law*, 82 NOTRE DAME L. REV. 1839, 1844 (2007) (“By preserving the integrity of these symbols, trademark law benefits consumers in both a narrow sense (by protecting them from being deceived into buying products they do not want) and a broad sense (by allowing consumers to rely on source indicators generally and thereby reducing the costs of searching for products in the market).”).

⁴¹ *Overview of Trademark Law*, HARVARD LAW, <https://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> (last visited Oct. 30, 2015).

⁴² *Id.*

⁴³ *Id.*

reputation that will foster sales.⁴⁴ In order to facilitate these objectives,⁴⁵ trademark law regulates the use of trademarks.⁴⁶

Improper use of a trademark constitutes infringement⁴⁷ and is governed by both state and federal law.⁴⁸ A mark must satisfy various prerequisites in order to serve as a trademark.⁴⁹ Trademark law sets forth the various requirements. In order to be afforded any protection—the ability to enforce rights in the mark—the mark must be distinctive.⁵⁰ To determine whether a mark is distinctive, courts group marks into four categories, and the degree of legal protection afforded to a particular trademark will depend upon which one of these four categories it falls within.⁵¹ Trademark rights can be acquired in two ways: “(1) by being the first to use the mark in commerce; or (2) by being the first to register the mark with the U.S. Patent and Trademark Office[.]”⁵² the federal agency for registering trademarks.⁵³

If a party has acquired rights to a particular mark, whether that is through federal registration or commercial use, the trademark owner can sue others for trademark infringement in order to protect

⁴⁴ Effectively, trademarks benefit both consumers and businesses because the law serves to “improve the quality of information in the marketplace and thereby reduce consumer search costs.” McKenna, *supra* note 42, at 1844.

⁴⁵ A trademark not only protects the goodwill represented by particular marks, but also helps consumers easily recognize products and their source, thereby preventing consumer confusion between products and between sources of products. *See* Lanham Act 15 U.S.C. § 1127 (2015); *see also* George & Co. LLC v. Imagination Entm’t Ltd., 575 F.3d 383 (4th Cir. 2009).

⁴⁶ *Overview of Trademark Law, supra* note 43.

⁴⁷ *See id.* (“If a party owns the rights to a particular trademark, the party can sue [third] parties for trademark infringement”). *See also* 15 U.S.C. § 1125 (2012).

⁴⁸ *Overview of Trademark Law, supra* note 43.

⁴⁹ *Id.*

⁵⁰ *Id.*

⁵¹ *Id.* *See infra* Part II.C.

⁵² *Id.*

⁵³ The commerce clause allows for the USPTO to register trademarks. *About Us*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/about-us> (last visited Oct. 30, 2015) (“The USPTO registers trademarks based on the commerce clause of the Constitution (Article I, Section 8, Clause 3).”).

its brand.⁵⁴ However, just as trademark rights can be acquired, they can be lost.⁵⁵ This section will explore in more detail: (A) laws establishing and governing trademark rights; (B) acquiring those trademark rights; (C) the categorical approach used by the courts to determine the degree of protection that should be afforded to a trademark; and (D) the enforcement of those acquired trademark rights.

A. *Laws Governing Trademark Rights*

Federal statutes and state common law govern trademark rights. Initially, state common law provided the main source of trademark protection.⁵⁶ Currently, federal law, specifically the Lanham Act,⁵⁷ provides the main source of trademark protection.⁵⁸ The Lanham Act establishes a national system of trademark registration, the principal register,⁵⁹ and charges the USPTO with the authority to oversee applications for trademark registration.

⁵⁴ 15 U.S.C. § 1114, 1125 (2012).

⁵⁵ *Overview of Trademark Law*, *supra* note 43. (“The rights to a trademark can be lost through abandonment, improper licensing or assignment, or genericity.”).

⁵⁶ *Id.*

⁵⁷ Lanham Act 15 U.S.C. §§ 1051 et seq. (2015).

⁵⁸ *Id.*; *see Coca-Cola Co. v. Purdy*, 382 F.3d 774, 777–78 (8th Cir. 2004) (“Congress enacted the Lanham Act over fifty years ago to protect the value of trademarks by encouraging their registration, *see* 3 McCarthy § 19:2, and to provide a federal cause of action to prevent their misappropriation, *see* 15 U.S.C. § 1125. One legislative purpose of that act was to ensure that ‘where the owner of a trade-mark has spent energy, time, and money in presenting to the public the product, he is protected in his investment from its misappropriation by pirates and cheats.’ S.Rep. No. 1333, at *3 (1946).”) Additionally, Justice Stevens articulated that the congressional purpose of the Lanham Act was to bring aid in the uniformity of common-law trademark decisions. *Two Pesos v. Taco Cabana*, 505 U.S. 763, 781–82 (1992) (Stevens, J., concurring in result) (citing H. R. Rep. No. 944, 76th Cong., 1st Sess., 4 (1939) (“Congressman Lanham, the bill’s sponsor, stated: ‘The purpose of [the Act] is to protect legitimate business and the consumers of the country.’ 92 Cong.Rec. 7524 (1946). One way of accomplishing these dual goals was by creating uniform legal rights and remedies that were appropriate for a national economy.”)).

⁵⁹ *See* 15 U.S.C. § 1052 (2012); *see also Lanham Act*, CORNELL UNIVERSITY LAW SCHOOL, https://www.law.cornell.edu/wex/lanham_act (last visited Sept. 21, 2015).

The Act states: “The owner of a trademark used in commerce may request registration of its trademark on the principal register hereby established by paying the prescribed fee and filing in the Patent and Trademark Office an application and a verified statement.”⁶⁰ If approved by the USPTO, the trademark is registered on the Principal Register. The Act protects the owner of a federally registered mark⁶¹ by providing a statutory cause of action for trademark infringement.⁶² In order to succeed on a trademark infringement claim under the Lanham Act, a party must prove that “1) he had a valid trademark and 2) that the defendant had adopted an identical or similar mark such that consumers were likely to confuse the two.”

It is clear from the wording of the Act,⁶³ that federal registration is not required in order to bring a claim under the Act.⁶⁴ The USPTO may reject registration on any number of grounds;⁶⁵ however, rejection does not necessarily mean that the mark is not entitled to trademark protection.⁶⁶ A mark owner does not have to register its mark to prove that it has trademark rights; “rather, [a] plaintiff need only show that its mark is capable of distinguishing [the] owner’s goods from those of others, i.e., that it is sufficiently distinctive.”⁶⁷ Because both state and federal law govern trademarks,⁶⁸ both common law rights and registration rights can be enforceable once acquired.

⁶⁰ 15 U.S.C. § 1051 (2012).

⁶¹ 15 U.S.C.A. § 1052 (2012); *see also Lanham Act*, CORNELL UNIVERSITY LAW SCHOOL, https://www.law.cornell.edu/wex/lanham_act (last visited Sept. 21, 2015).

⁶² *Overview of Trademark Law*, *supra* note 43.

⁶³ 15 U.S.C. § 1051 (“the owner of a trademark used in commerce *may* request registration”) (emphasis added).

⁶⁴ *Id.*; *see also Basic Trademark Facts*, *infra* note 71.

⁶⁵ 15 U.S.C. § 1052 (2015).

⁶⁶ *See infra* Section II.B.

⁶⁷ *Florida Van Rentals, Inc. v. Auto Mobility Sales, Inc.*, 85 F. Supp. 3d 1300 (M.D. Fla. 2015).

⁶⁸ *Lanham Act*, CORNELL UNIVERSITY LAW SCHOOL, https://www.law.cornell.edu/wex/lanham_act (last visited Sept. 21, 2015) (“The

B. *Acquiring Trademark Rights*

1. *Common Law Rights*

While federal law provides the most comprehensive source of trademark protection, common law actions still exist. Furthermore, common law rights can be superior to other rights.⁶⁹ Common law rights are acquired from actual use⁷⁰ of a trademark in commerce.⁷¹ The first approach to acquiring trademark rights is by being the first to sell the product containing the mark to the public.⁷² In other words, using the mark in commerce first provides the user with some enforcement rights. For example, if an individual is the first to sell “Coca-Cola” brand soda to the public, that individual has acquired limited trademark rights⁷³ to use that mark in connection with the sale of soda.

2. *Federal Registration Rights*

The second way to acquire rights is to register the mark with the USPTO, as provided for in the Lanham Act. A mark owner has

scope of the Lanham Act is independent of and concurrent with state common law.”).

⁶⁹ *Basic Facts: Trademarks, Patents, and Copyrights*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos> (last visited Sept. 21, 2015) (“These rights, known as “common law” rights, are based solely on use of the mark in commerce within a particular geographic area. Common law rights may be stronger than those based on a registration, if the common law use is earlier than the use that supports the registration. Therefore, it is critical to learn whether superior common law rights exist, by searching the Internet for websites and articles that reference similar marks that are related to your goods and services.”). To bring a claim under the Lanham Act, federal registration is not required, “but the scope of any common law rights vindicated would be limited to areas where the mark is in use.” *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 336 n.7 (1st Cir. 2004) (citing *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97–98 (1918)) (clarifying that trademark rights are generally confined to geographical territories of use).

⁷⁰ *Overview of Trademark Law*, *supra* note 43 (“The use of a mark generally means the actual sale of a product to the public with the mark attached.”).

⁷¹ *Id.*

⁷² *Id.*

⁷³ *Basic Trademark Facts*, *supra* note 35.

the option to fill out a trademark application that is subject to approval by the USPTO.⁷⁴ Unlike common law trademark rights, federal registration “gives a party the right to use the mark nationwide,”⁷⁵ even if the actual sales occur in a limited geographic area.⁷⁶ While protection is not restricted solely to owners of federally registered marks,⁷⁷ the registration provides several benefits⁷⁸ to the registering party.⁷⁹ These benefits include the right to use the mark nationwide,⁸⁰ the right to bring a suit in federal

⁷⁴ See *Overview of Trademark Law*, *supra* note 43.

⁷⁵ *Overview of Trademark Law*, *supra* note 43. See also 15 U.S.C. § 1072 (2012).

⁷⁶ *Overview of Trademark Law*, *supra* note 43. (“The use of a mark generally means the actual sale of a product to the public with the mark attached.”).

⁷⁷ *On Your Mark: Common Myths About Trademarks and Business Names*, LANE POWELL SPEARS LUBERSKY LLP, [hereinafter *Common Myths About Trademarks*], http://www.lanepowell.com/wp-content/uploads/2009/04/glazera_007.pdf (last visited Sept. 21, 2015).

⁷⁸ *Fact Sheets Selecting and Registering a Trademark*, INTERNATIONAL TRADEMARK ASSOCIATION, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/PrincipalvsSupplementalRegister.aspx> (last visited Oct. 30, 2015) (Federal registration on the Principal Register offers a number of advantages for the trademark owner. These advantages include: “prima facie evidence of the registrant’s exclusive right to use the mark nationwide on or in connection with the goods and/or services designated in the registration; a legal, rebuttable presumption that the registrant is the owner of the mark; constructive notice of the claim of ownership of the mark; Listing of the mark in the USPTO’s online database; the ability to record the mark with U.S. Customs and Border Protection to stop the importation into the United States of infringing or counterfeit goods; the right to bring an action in federal court for infringement of the mark; the ability to use the registration as the basis for a trademark application in many other countries/jurisdictions; the right to use the “registered” (®) symbol with its mark when the mark is used on or in connection with the covered goods and/or services; the possibility that the mark may become incontestable after five years of registration; [and] provisions for treble damages, attorney’s fees, and various other remedies.”).

⁷⁹ Federal registration enables a party to bring an infringement suit in federal court. 15 U.S.C. § 1121 (2012). The Lanham Act “allows a party to potentially recover treble damages, attorneys fees,” and “registered trademarks can, after five years, be ‘incontestable,’ at which point the exclusive rights to use the mark is conclusively established.” See *Overview of Trademark Law*, *supra* note 43.

⁸⁰ 15 U.S.C. § 1072 (2012).

court,⁸¹ the right to potentially recover damages and other remedies provided for in the Lanham Act,⁸² and the possibility, after five years, for a registered mark to become “incontestable.”⁸³ Additionally, registration reduces the likelihood of costly litigation by establishing constructive notice⁸⁴ to others that a party owns a trademark.⁸⁵ The principal register, maintained by the USPTO, publicizes trademark ownership,⁸⁶ putting the public on notice. As a result, a registered mark creates “a legal presumption of the validity and ownership of the mark” on top of the exclusive right to use that mark.⁸⁷ Additionally, if a selected mark is one that would likely cause confusion when used in connection with the particular good, it should be rejected by the USPTO.⁸⁸ Although federal registration can be an outcome determinative factor in the event litigation arises, it is not always dispositive, as “[t]hese presumptions may be rebutted in the court proceedings.”⁸⁹ When a party brings an infringement lawsuit, courts consider several

⁸¹ 15 U.S.C. § 1121 (2012).

⁸² 15 U.S.C. § 1114 (2012).

⁸³ “Incontestable mark” is a term of art in trademark law meaning the exclusive right to use the mark has been conclusively established. Lanham Act § 33, 15 U.S.C. § 1115 (stating: “To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce.”).

⁸⁴ A trademark puts the purchasing public on notice that all goods bearing the trademark: (1) originated from the same source, and (2) are of equal quality. *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383 (4th Cir. 2009).

⁸⁵ Federal registration can effectively reduce the likelihood of conflict and reduce costs and uncertainties in the event of conflict. *Common Myths About Trademarks*, *supra* note 79.

⁸⁶ 15 U.S.C. § 1072 (2012).

⁸⁷ *How do I know Whether I'm Infringing*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/page/about-trademark-infringement> (last visited Sept. 21, 2015).

⁸⁸ *Basic Facts: Selecting A Mark*, UNITED STATES PATENT AND TRADEMARK OFFICE [hereinafter *Selecting a Mark*], <http://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos> (last visited Sept. 21, 2015).

⁸⁹ *How do I know Whether I'm Infringing*, *supra* note 89.

factors to determine whether there is a likelihood of confusion,⁹⁰ and the overall degree of legal protection afforded to a mark depends upon the distinctiveness of the mark.⁹¹

C. *Categorizing Marks*

In order to receive trademark law protection, a mark must be distinctive.⁹² Distinctiveness is often described in terms of strength, which “measures [a mark’s] capacity to indicate the source of the goods or service with which it is used.”⁹³ Every mark “fall[s] somewhere along the ‘spectrum of distinctiveness,’”⁹⁴ with the strongest marks being the most distinctive. This spectrum affects the level of protection a trademark receives. Conflicting uses of a strong mark is more likely to cause consumer confusion, and because of this likelihood of confusion, the mark should be entitled to protection.⁹⁵ On the other hand, conflicting uses of a weaker mark are not likely to cause consumer confusion. For example, “Apple” is a strong mark for a computer; it is distinct and not associated with computers.⁹⁶ If another computer manufacturer starting producing “apple”⁹⁷ computers, hoodwinked consumers would be unable to distinguish “Apple” computers from the new imitation “apple” computers.⁹⁸ In turn, if the imitation “apple” computer was of lesser quality, this infringement could damage “Apple’s” reputation. Non-licensed use of the mark undermines the entire trademark system, leaving the consumer vulnerable to

⁹⁰ *Id.*

⁹¹ See *Overview of Trademark Law*, *supra* note 43.

⁹² *Common Myths About Trademarks*, *supra* note 79.

⁹³ Restatement (Third) Unfair Competition Section 21, cmt i, (1995).

⁹⁴ *Common Myths About Trademarks*, *supra* note 79.

⁹⁵ *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383 (4th Cir. 2009) (Generally, the stronger the mark, the greater the likelihood that consumers will be confused by competing uses of the mark); see also Lanham Act § 45, 15 U.S.C. § 1127 (2012).

⁹⁶ Use federal registration # as evidence here

⁹⁷ *The Five Categories of Trademarks: Legal and Marketing Considerations*, VERI TRADEMARK, <http://www.veritrademark.com/articles/five-categories-trademarks> (last visited Oct. 30, 2015).

⁹⁸ *Overview of Trademark Law*, *supra* note 43.

deception and the manufacturer vulnerable to defamation. Therefore, strong marks are afforded greater and broader protection. To determine the degree of protection, marks submitted to the USPTO are grouped in four categories: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.⁹⁹

1. *Generic Marks*

A generic mark,¹⁰⁰ which cannot ever be a protected trademark, is a word or phrase that is unable to identify the source of a good or service¹⁰¹ because it instead identifies the goods or services themselves. A mark that is incapable of identifying a source is a weak mark that does not warrant protection because there is nothing to protect—there is no associated source. A generic mark denotes a type of good by its already recognized expression. For example, if a party owned the trademark rights to “paper towels” in association with the sale of disposable paper cloths, then other competing paper towel manufacturers would be unable to label their products as precisely what they are—paper towels. To use the “apple” example again, the common understanding is that an apple is a fruit. It would be virtually impossible to designate the fruit by any other name; therefore, apple is a generic mark for fruit. The Third Circuit clearly articulated this phenomenon:

[g]eneric terms, by definition incapable of indicating source, are the antithesis of trademarks, and can never attain trademark status; to allow trademark protection for generic terms, that is, names which describe the genus of goods being sold, even when these have become identified

⁹⁹ See *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976) (holding that “‘Safari’ has become a generic term and ‘Minisafari’ may be used for a smaller brim hat; that ‘Safari’ has not become a generic term for boots, or shoes it is either ‘suggestive’ or ‘merely descriptive’”); see also *Overview of Trademark Law*, *supra* note 43.

¹⁰⁰ Courts have defined generic as “the genus of which the particular product or service is a species.” *Surgicenters of America, Inc. v. Medical Dental Surgeries, Co.*, 601 F.2d 1011, 1014 (9th Cir. 1979).

¹⁰¹ See *Basic Trademark Facts*, *supra* note 35.

17 N.C. J.L. & TECH. ON. 1, 17
#CanHashtagsBeTrademarked

with a first user, would grant the owner of the mark a monopoly, since a competitor could not describe his goods as what they are.¹⁰²

Thus, a manufacturer selling “paper towel” brand paper towels or “apple” brand apples would not be afforded exclusive rights to use that term with respect to that product.¹⁰³ As a result, generic marks will not be afforded trademark protection.

2. *Descriptive Marks*

Next, a descriptive mark, as the name implies, merely describes the good, not by its generic name, but by “immediately convey[ing] knowledge of a quality, feature, function, or characteristic of the goods or services with which it is used.”¹⁰⁴ While a descriptive mark, unlike a generic mark, is not necessary when describing a product, it is still suitable for labeling a product. For example, “Holiday Inn”¹⁰⁵ describes an aspect of the underlying product—a hotel (inn) for vacation (on holiday). A descriptive mark, in general, will be rejected by the USPTO unless the party can show the mark has acquired a “secondary meaning.”¹⁰⁶

In order to establish that a mark has acquired “secondary meaning,”¹⁰⁷ a party must show “that the mark has, through long use, become a source identifier.”¹⁰⁸ Therefore, a merely descriptive

¹⁰² In re Pennington Seed, Inc., C.A.Fed.2006, 466 F.3d 1053, 80 U.S.P.Q.2d 1758.

¹⁰³ *Overview of Trademark Law*, *supra* note 43 (“[G]iving a particular manufacturer the exclusive right to use the [mark] could confer an unfair advantage.”).

¹⁰⁴ In re Chamber of Commerce of the U.S., 675 F.3d 1297 (Fed. Cir. 2012).

¹⁰⁵ *Overview of Trademark Law*, *supra* note 43.

¹⁰⁶ *See generally* George & Co. LLC v. Imagination Entm’t Ltd., 575 F.3d 383 (4th Cir. 2009) (explaining that a trademark has acquired “secondary meaning” when a descriptive mark has become distinct enough that a buyer associates the mark to a single source); In re Chamber of Commerce of the U.S., 675 F.3d 1297 (Fed. Cir. 2012).

¹⁰⁷ A descriptive mark can be registered if it has obtained “secondary meaning” or has “acquired distinctiveness,” whereby the mark has come to serve a trademark function of identifying a particular source of goods or services. Lanham Act, 15 U.S.C. § 1052(f).

¹⁰⁸ *Basic Facts: Selecting A Mark*, *supra* note 90.

mark can, through extensive use, become associated with a particular manufacturer rather than the underlying product.¹⁰⁹ To illustrate, “Holiday Inn” has obtained secondary meaning, and thus is entitled to some protection because the general public associates the term not with hotels commonly, but with a single hotel provider.¹¹⁰ Additionally, to acquire a secondary meaning “the public need not be able to identify the specific producer; only that the product or service comes from a single producer.”¹¹¹ In assessing whether or not a descriptive mark has obtained a secondary meaning, the courts look at the following factors: (1) the amount and manner of advertising; (2) the volume of sales; (3) the length and manner of the mark’s use; and (4) results of consumer surveys.¹¹²

3. *Suggestive Marks*

A stronger mark, and one that is registrable¹¹³ with the USPTO, is a suggestive mark.¹¹⁴ A suggestive mark implies a characteristic of the underlying product,¹¹⁵ instead of simply describing the underlying product.¹¹⁶ Courts have clarified the distinction between descriptive marks and suggestive marks as follows: a suggestive mark requires some additional thought to connect it with the goods.¹¹⁷ For example, “Coppertone” is a suggestive mark because

¹⁰⁹ *Overview of Trademark Law*, *supra* note 43.

¹¹⁰ *Overview of Trademark Law*, *supra* note 43 (“‘Holiday Inn’ has acquired secondary meaning because the consuming public associates that term with a particular provider of hotel services.”).

¹¹¹ *Overview of Trademark Law*, *supra* note 43.

¹¹² *Overview of Trademark Law*, *supra* note 43. (citing *Zatarian’s Inc. v. Oak Grove Smokehouse, Inc.* 698 F.2d 786 (5th Cir. 1983)).

¹¹³ “Registrable” is a term of art in trademark law. Trademarks registrable on principal register, 15 U.S.C § 1052 (2012).

¹¹⁴ *Basic Facts: Selecting a Mark*, *supra* note 90.

¹¹⁵ *Overview of Trademark Law*, *supra* note 43.

¹¹⁶ *Selecting a Mark*, *supra* note 90.

¹¹⁷ Determination of the USPTO is *prima facie* evidence of whether the mark is descriptive or suggestive. *Synergistic Int’l, LLC v. Korman*, 470 F.3d 162 (4th Cir. 2006). Courts will defer to the USPTO determinations, which establishes *prima facie* evidence of whether a mark is descriptive or suggestive. *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383 (4th Cir. 2009).

it does not specifically describe sunscreen, but with the use of some additional thought and imagination, it alludes to sunscreen.¹¹⁸ Similarly, “Q-TIP” is a suggestive trademark for cotton swabs and “Greyhound” is a suggestive trademark for a transportation service.¹¹⁹ As demonstrated, while a suggestive mark is not entirely unrelated to the underlying product, it is still fundamentally distinctive and therefore given a high degree of protection.¹²⁰

4. *Arbitrary or Fanciful Marks*

The strongest marks are fanciful and arbitrary marks.¹²¹ These marks are afforded a high degree of protection because they are not logically related to the underlying product.¹²² To return to the “Apple” computer example,¹²³ “Apple” is an arbitrary mark for a computer because an apple bears no logical relationship to a computer. Computers neither contain apples nor do apples play any role in their production. Similarly, “Comet” is an arbitrary mark for kitchen cleaner.¹²⁴ In other words, an arbitrary mark usually involves “common words that have no connection with the actual product.”¹²⁵ On the other hand, a fanciful mark is usually comprised of made-up words.¹²⁶ Because arbitrary and fanciful¹²⁷

¹¹⁸ *Overview of Trademark Law*, *supra* note 43 (“For example, the word ‘Coppertone’ is suggestive of sun-tan lotion.”).

¹¹⁹ *Legal Strength of Trademarks*, Pliam Law Group, PA, <http://marklaw.com/trademark-FAQ/strength.htm> (last visited Oct. 30, 2015).

¹²⁰ *Overview of Trademark Law*, *supra* note 43.

¹²¹ *Selecting A Mark*, *supra* note 90.

¹²² *Overview of Trademark Law*, *supra* note 43.

¹²³ *See Overview of Trademark Law*, *supra* note 99 and accompanying text.

¹²⁴ *Legal Strength of Trademarks*, Pliam Law Group, PA, <http://marklaw.com/trademark-FAQ/strength.htm> (last visited Oct. 30, 2015).

¹²⁵ “Arbitrary marks” involve common words that have no connection with the product. They do not suggest or describe “any quality, ingredient, or characteristic, so the mark can be viewed as arbitrarily assigned.” *George & Co. LLC v. Imagination Entm’t Ltd.*, 575 F.3d 383 (4th Cir. 2009)

¹²⁶ “Fanciful marks” involve made-up words created for the sole purpose of serving as a trademark. *Id.* For example, “Kodak” is a fanciful mark for film. *See Overview of Trademark Law*, *supra* note 43.

¹²⁷ An example of a mark that is both arbitrary and fanciful is the trademark “Phish.” PHISH, Registration No. 1,782,981. The word “fish” does not have any

marks are each inherently distinctive, they are given the highest degree of protection.¹²⁸

5. *Genericide*

Genericide occurs when a distinctive mark becomes generic and trademark rights cease.¹²⁹ It is important to note that even a strong mark can become generic.¹³⁰ To give an example, “yo-yo” was once a strong mark, considered arbitrary or fanciful for a children’s toy, but the mark lost its source-indicating power and became the generic name for the toy.¹³¹ The word “yo-yo” became a part of everyday vernacular, and as a result, the public began to associate the word with the type of toy generally, not with a particular manufacturer of the toy. As a result, “yo-yo” is no longer afforded legal protection, even though it was initially federally registered and considered a strong mark.¹³²

inherent connection to music, and the mark “phish” is a made up word, therefore the trademark “phish” is entitled to a high degree of protection.

¹²⁸ *Legal Strength of Trademarks*, Pliam Law Group, PA, <http://marklaw.com/trademark-FAQ/strength.htm> (last visited Oct. 30, 2015).

¹²⁹ *Freecycle Network, Inc. v. Oey*, 505 F.3d 898, 905 (9th Cir. 2007) (“Where majority of relevant public appropriates trademark term as name of product or service, mark is victim of “genericide” and trademark rights generally cease.”).

¹³⁰ *Basic Facts: Selecting A Mark*, *supra* note 90.

¹³¹ *Basic Facts: Selecting A Mark*, *supra* note 90.

¹³² The following marks have all been federally registered, but over time have become subject to genericness. In response to this threat of genericide, mark owners of “Xerox,” “Jeep,” “Band-Aid,” and “Kleenex” ran advertisements urging consumers to view these marks as source identifiers and not common household names for the respective good. For example, Xerox Corporation ran the following ad: “You can’t Xerox a Xerox on a Xerox. But we don’t mind at all if you copy a copy on a Xerox® copier.” Gary H. Fechter, *Practical Tips on Avoiding Genericide*, INTERNATIONAL TRADEMARK ASSOCIATION (Nov. 15, 2011), <http://www.inta.org/INTABulletin/Pages/PracticalTipsonAvoidingGenericide.aspx>. Chrysler LLC ran the following ad: “They invented “SUV” because they can’t call them Jeep®.” *Id.* Johnson & Johnson ran: “I am stuck on Band-Aids brand cause Band-Aid’s stuck on me.” *Id.* Kimberly-Clark ran: “Kleenex’ is a brand name . . . and should always be followed by an ® and the word ‘Tissue.’ [Kleenex® Brand Tissue] Help us keep our identity, ours.” *Id.*

Under trademark law, genericide is a form of abandonment.¹³³ An abandoned mark “falls into the public domain and is free for all to use,”¹³⁴ and thus not entitled to protection. A mark becomes generic when the consuming public associates the term with the underlying product generally and not the source of a product.¹³⁵ In the case finding “Aspirin” to be generic in the United States, Judge Learned Hand set forth the following legal standard:

The single question, as I view it, in all these cases, is merely one of fact: What do the buyers understand by the word for whose use the parties are contending? If they understand by it only the kind of goods sold, them [sic], I take it, it makes no difference whatever what efforts the plaintiff has made to get them to understand more. He has failed, and he cannot say that, when the defendant uses the word, he is taking away customers who wanted to deal with him, however closely disguised he may be allowed to keep his identity.¹³⁶

Today a more specific standard is used for determining whether genericide has occurred: “First, what is the genus of the goods or services at issue? Second, is the term sought to be registered . . . understood by the relevant public primarily to refer to that genus of goods or services?”¹³⁷ The test for genericness under the Lanham Act is the “primary significance of the registered mark to the relevant public rather than purchaser

¹³³ A mark will be deemed to be “abandoned” if: (1) its use has been discontinued for three years with intent not to resume such use; or (2) when the mark becomes the generic name for the goods or services on or in connection with which it is used. In other words, a generic term is “the name of the product or service itself - what [the product] is, and as such . . . the very antithesis of a mark.” 2 J. Thomas McCarthy, *Trademarks and Unfair Competition* § 12:1[1] (4th ed. 1997).

¹³⁴ *Cumulus Media, Inc. v. Clear Channel Commc’ns, Inc.*, 304 F.3d 1167, 1173 (11th Cir. 2002) (quotation marks omitted); *American Ass’n for Justice v. The American Trial Lawyers Ass’n*, 2010 WL 1050321, 6 (D. Minn. 2010).

¹³⁵ *Horizon Mills Corp. v. QVC, Inc.*, 161 F.Supp.2d 208, 213 (S.D.N.Y. 2001) (citing, *inter alia*, *King-Seeley Thermos Co. v. Aladdin Indus., Inc.*, 321 F.2d 577, 579–81 (2d Cir.1963)).

¹³⁶ *Bayer Co. v. United Drug Co.*, 272 F. 505, 509 (S.D.N.Y. 1921).

¹³⁷ *E.g.*, *In re Dial-A-Mattress Operating Corp.*, 240 F.3d 1341, 1344 (Fed. Cir. 2001) (quoting *H. Marvin Ginn Corp. v. International Ass’n of Fire Chiefs, Inc.*, 782 F.2d 987, 990 (Fed. Cir. 1986)); *In re American Academy of Facial Plastic and Reconstructive Surgery*, 2002 T.T.A.B. LEXIS 312 (T.T.A.B. 2002).

motivation.”¹³⁸ To summarize, a mark’s strength can be threatened by genericide.

D. *Enforcing Trademark Rights*

The USPTO does not enforce a party’s rights in a mark, bring action against alleged infringers, or assist owners in policing marks against infringement.¹³⁹ This fact is important because without proper policing, a strong mark can become weak or even generic.¹⁴⁰ Once rights are acquired, trademark law serves to protect the owner’s right to use the trademark by providing remedies¹⁴¹ for infringement under the Lanham Act.¹⁴² In order to establish a trademark infringement under the Act for either registered marks¹⁴³ or unregistered marks,¹⁴⁴ the plaintiff must prove (1) the mark is valid and protectable; (2) the plaintiff owns the mark; and (3) the defendant’s use of the mark is likely to cause consumer confusion.¹⁴⁵ A likelihood of confusion exists¹⁴⁶ when the marks of

¹³⁸ 15 U.S.C. § 1064(3) (2012).

¹³⁹ *Basic Trademark Facts*, *supra* note 35 (“[e]nforce your rights in the mark or bring legal action against a potential infringer” or “[a]ssist you with policing your mark against infringers.”).

¹⁴⁰ *Basic Trademark Facts*, *supra* note 35

¹⁴¹ *Trademark Infringement*, CORNELL UNIVERSITY LAW SCHOOL, https://www.law.cornell.edu/wex/trademark_infringement (Oct. 30, 2015) (“The remedies for infringement under the Lanham Act are statutory and consist of: injunctive relief; an accounting for profits; damages, including the possibility of treble damages when appropriate; attorneys fees in “exceptional cases;” and costs. *See* 15 U.S.C. § 1117. These remedies are cumulative, meaning that a successful plaintiff may recover the defendant’s profits in addition to any damages, or other remedies awarded.”).

¹⁴² *Id.*

¹⁴³ 15 U.S.C. § 1114 (2012).

¹⁴⁴ Accordingly, to bring a claim under the Lanham Act, federal registration is not required, “but the scope of any common law rights vindicated would be limited to areas where the mark is in use.” *Gen. Healthcare Ltd. v. Qashat*, 364 F.3d 332, 336 n.7 (1st Cir. 2004) (internal citation omitted).

¹⁴⁵ *E.g.*, *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400 (2d Cir. 2005); *A&H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198 (3rd Cir. 2000) (recapitulating the distinct elements necessary to establish a trademark infringement claim).

parties are similar and the goods and services of the parties are “related in such a way that the consumer is likely to believe they came from the same source.”¹⁴⁷ A trademark owner who believes a competitor is using its mark or a similar mark in a way that is causing consumer confusion has a statutory right to bring an infringement suit in federal court.¹⁴⁸ When determining likelihood of confusion, courts use several factors, often referred to as the “Polaroid factors,”¹⁴⁹ that are applied in slight variation among federal courts.¹⁵⁰ These factors include:

- (1) the strength¹⁵¹ or distinctiveness of the plaintiff’s mark as actually used in the marketplace, (2) the similarity of the two marks to consumers, (3) the similarity of the goods or services that the marks identify, (4) the similarity of the facilities used by the markholders, (5) the similarity of advertising used by the markholders, (6) the defendant’s intent, (7) actual confusion, (8) the quality of the

¹⁴⁶ A defendant who creates likelihood of confusion by using another’s mark has infringed the mark. For example, Playboy Enterprises, Inc. (“PEI”) claimed that “[b]ecause banner advertisements appear immediately after users type in PEI’s marks” that users were “likely to be confused regarding the sponsorship of un-labeled banner advertisements.” *Playboy Enterprises, Inc. v. Netscape Commo’ns Corp.*, 354 F.3d 1020, 1025 (9th Cir. 2004). PEI introduced an expert study conducted by a Dr. Ford that demonstrated a “significant number of Internet users searching for the terms “playboy” and “playmate” would think that PEI, or an affiliate, sponsored banner ads containing adult content that appear on the search results page. When study participants were shown search results for the term “playboy,” 51% believed that PEI sponsored or was otherwise associated with the adult-content banner ad displayed.” *Id.* at 1026-27 (holding that “[b]ecause actual confusion is at the heart of the likelihood of confusion analysis, Dr. Ford’s report alone probably precludes summary judgment.”).

¹⁴⁷ *Basic Trademark Facts*, *supra* note 35.

¹⁴⁸ *Overview of Trademark Law*, *supra* note 43; *see also supra* note 147.

¹⁴⁹ The factors are called “Polaroid Factors” because they originate from the 1961 case *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961).

¹⁵⁰ While *Polaroid* is not binding on other circuits, the other Circuit Courts use similar factors. *E.g.*, “Roto-Rooter” factors in the Fifth Circuit, *see Roto-Rooter Corp. v. O’Neal*, 513 F.2d 44, 46 (5th Cir. 1975); “Beer Nuts” factors in the Tenth, *see Beer Nuts, Inc. v. Clover Club Foods Co.*, 805 F.2d 920, 928 (10th Cir. 1986)). Generally, the first three factors are considered to be the most important.

¹⁵¹ *See supra* note 97.

defendant's product, and (9) the sophistication of the consuming public.¹⁵²

However, this list is not comprehensive and the factors serve “to assist the courts in predicting the subjective state of mind of the average relevant consumer.”¹⁵³ The categorical approach used by the USPTO and the factors considered by the courts do not provide “clear lines between inherently distinctive marks and inherently nondistinctive marks.”¹⁵⁴ To illustrate this possibility, the Court of Customs and Patent Appeals held “CHICKEN OF THE SEA to be non-descriptive for tuna fish, but other federal courts held it to be descriptive.”¹⁵⁵

III. HASHTAG RELATED TRADEMARK CLAIMS

As discussed, the USPTO does not monitor or police trademarks,¹⁵⁶ and unchallenged third party uses of a trademark can weaken the strength of a mark,¹⁵⁷ which in turn weakens the trademark owner's ability to enforce the trademark rights. Even

¹⁵² *George & Co. LLC v. Imagination Entm't Ltd.*, 575 F.3d 383 (4th Cir. 2009); *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

¹⁵³ *Common Myths About Trademarks*, *supra* note 79.

¹⁵⁴ *Common Myths About Trademarks*, *supra* note 79.

¹⁵⁵ *Van Camp Sea Food Co. v. Cohn-Hopkins*, 56 F.2d 797, 797 (9th Cir. 1932) (“This trade-mark was before this court in *Van Camp Sea Food Co. v. Westgate Sea Products Co.*, 28 F.(2d) 957. We there held that ‘Breast-O’-Chicken’ did not infringe the trade-mark ‘Chicken of the Sea’ for the reason that the word ‘chicken,’ the only word common to both, was descriptive and not the subject of appropriation by way of trade-mark. We expressly declined to pass upon the validity of the trade-mark ‘Chicken of the Sea’ taken in its entirety.”); *see also Common Myths About Trademarks*, *supra* note 79.

¹⁵⁶ This duty applies to owners of unregistered trademarks as much as federal registered marks, since registration is not necessary to claim many trademark rights. *Selecting a Mark*, *supra* note 90 (The USPTO does not “[e]nforce your trademark rights or bring legal action against an infringer” and “[i]t is your legal responsibility to police your trademark and to protect it from infringement.”).

¹⁵⁷ *Basic Facts: What Every Small Business Should Know Now, Not Later*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademarks-getting-started/trademark-basics/basic-facts-about-trademarks-videos> (last visited Sept. 21, 2015).

though this presupposed duty¹⁵⁸ to monitor and police a trademark is not a statutory requirement under the Lanham Act,¹⁵⁹ the consequences of not monitoring a trademark can result in the forfeiture of certain, if not all, acquired rights.¹⁶⁰ In order to protect its brand, trademark owners often send cease and desist letters¹⁶¹ to third parties threatening legal action¹⁶² if the unauthorized use of the trademark does not stop. Additionally, when a letter does not

¹⁵⁸ Trademark owners have a “duty to police [their] rights against infringers.” J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 31:38 (4th ed. 2007).

¹⁵⁹ Although not required by statute, the courts often look at evidence of trademark policing when assessing whether third party use of a trademark constitutes an infringement. In other words, evidence of a trademark owner’s failure to perform this duty can lead to a rejection of an infringement claim. *See* Hard Rock Café Int’l (USA) v. Morton, 1999 U.S. Dist. Lexis 13760, No. 97 Civ. 9483, 1999 WL 717995 (S.D.N.Y. Sept. 9, 1999). Conversely, a trademark owner’s due diligence in performing this duty can preserve the enforceability of a mark. For example, in July 2002, defendant Purdy began registering Internet domain names “incorporated distinctive, famous, and protected marks owned by the plaintiffs.” *Coca-Cola Co. v. Purdy*, 382 F.3d 774, 779 (8th Cir. 2004). That same month, the Washington Post sent Purdy a cease and desist letter and McDonald’s and Pepsi both contacted Purdy with similar requests. *Id.* When Purdy did not stop using plaintiff’s marks, they filed action seeking an emergency temporary restraining order and preliminary injunction, and the district court issued both on July 23, 2002. *Id.* at 780. Despite the district court order, Purdy’s activity continued, and the Washington Post sent another cease and desist letter on October 1, 2002. *Id.* They filed another motion for a second emergency temporary restraining order and preliminary injunction. *Id.* On appeal, the court concluded, “that plaintiffs would be irreparably harmed in the absence of a preliminary injunction, that this harm outweighs any potential harm to Purdy, and that the public interest supports an injunction.” *Id.* at 790. *See also* *Fechter*, *supra* note 133.

¹⁶⁰ *See* *Fechter*, *supra* note 133.

¹⁶¹ “A cease and desist (or demand) letter is correspondence that states or suggests that you are potentially infringing the trademark of another and demands that you stop using, or consider stopping use of, the accused mark. You should treat any such letter seriously. Before deciding how to proceed, consider your options as described below.” *I Received a Letter*, UNITED STATES PATENT AND TRADEMARK OFFICE, <http://www.uspto.gov/trademark/i-received-letter> (last visited Oct. 30, 2015).

¹⁶² If a party owns the rights to a particular trademark, that party can sue subsequent parties for trademark infringement. 15 U.S.C. § 1072 (2012).

resolve the dispute, a trademark owner can file a complaint with a court alleging trademark infringement and seeking remedies that routinely include an injunction against further infringement and monetary relief.¹⁶³ This section will explore four separate attempts made by trademark owners to police and enforce their rights in a trademark used in a hashtag. The section will conclude by examining the first court case to adjudicate whether a hashtag can be a trademark.

A. *Policing a Trademark Used in a Hashtag by a Competitor*

In August 2010, Mexican restaurant Taco John's sent a cease and desist letter to Iguana Grill, another Mexican restaurant, asking Iguana Grill to stop using their registered mark, "Taco Tuesday,"¹⁶⁴ in the hashtag "#tacotuesday."¹⁶⁵ The letter maintained that Taco John's had trademark rights in the "Taco Tuesday" mark, and therefore Iguana Grill's hashtag containing the trademark infringed on those rights.¹⁶⁶ Unfortunately for Taco John's, the story received extensive media attention resulting in many individuals using the hashtag in their tweets.¹⁶⁷ Iguana Grill voluntarily stopped using

¹⁶³ See *Trademark Infringement*, *supra* note 142.

¹⁶⁴ Emily E. Campbell, *Taco John's Claims Rights in Taco Tuesday*, PHOSITA: AN INTELLECTUAL PROPERTY BLOG (Aug. 4, 2010), <http://dunlapcoddling.com/phosita/2010/08/taco-johns-claims-rights-in-taco-tuesday.html> ("Taco John's owns U.S. Trademark Registration No. 1,572,589 for the mark Taco Tuesday."); see also Steve Lackmeyer, "Taco Tuesday" Out at Downtown Restaurant Due to Challenge by Taco John's chain, But Promotion Lives On, NEWSOK (Aug. 3, 2010), <http://newsok.com/article/3481863>. However, under current trademark law, Taco Tuesday would likely be considered a weak mark, arguably one not even capable of federal registration today. The phrase has made its way into everyday custom and usage, and is prominently displayed on most Mexican restaurant menus, becoming a fairly common and descriptive term for Mexican restaurant deals on Tuesdays. See *supra* Section II.C.

¹⁶⁵ Campbell, *supra* note 165.

¹⁶⁶ *Id.*

¹⁶⁷ Lackmeyer, *supra* note 165; Thomas J. Curtin, *The Name Game: Cybersquatting and Trademark Infringement on Social Media Websites*, 19 J.L. & POL'Y 353, 371 (2010); see Campbell, *supra* note 165.

the mark.¹⁶⁸ Paradoxically, the ensuing media frenzy resulted in a day of record sales for Iguana Grill.¹⁶⁹

B. *Pleading Trademark Infringement when a Competitor Uses a Trademark in a Hashtag.*

On June 11, 2014, Starbuzz Tobacco, Inc. (“Starbuzz”) filed a complaint with the court alleging that defendant Souzie Yousif’s use of their trademark in a hashtag constituted an infringement.¹⁷⁰ In 2013, Starbuzz entered into a manufacturing agreement with PhD Marketing and E-Hose Technologies, LLC (“E-Hose”), providing E-Hose with exclusive manufacturing rights of electronic hookahs.¹⁷¹ Shortly thereafter, Starbuzz alleged that E-Hose started making miniature versions of electronic hookahs (“Mini E-Hose”).¹⁷² While Starbuzz markets the E-Hose, it “does not endorse, support, associate with, receive compensation for, or have anything to do with the manufacture, distribution or sale of the Mini E-Hose.”¹⁷³ As a result, Starbuzz filed this complaint alleging specifically that defendant’s February 5, 2014, Facebook post marketing the Mini E-Hose with the description “Ehose Mini from the makers of #starbuzz #ehose” improperly associates Starbuzz with the Mini E-Hose, which is likely to cause consumer confusion.¹⁷⁴ On October 6, 2014, Starbuzz dismissed the suit.¹⁷⁵

¹⁶⁸ Lackmeyer, *supra* note 165.

¹⁶⁹ Curtin, *supra* note 168. *See* Campbell, *supra* note 165 (“Iguana [Grill] sold a record number of tacos [in one day].”).

¹⁷⁰ Complaint & Demand for Jury Trial at 6, Starrbuzz Tobacco, Inc. v. Yousif, 2014 WL 4653042 (C.D. Cal.) (No. 8:14-CV-00487) (“This action concerns Defendant’s infringement of Starbuzz’s trademarks. Defendant has flagrantly disregarded Starbuzz’s trademarks and used Starbuzz’s name, without authorization, to promote electronic hookah products. Defendant has done so with the intent to steal the goodwill in Starbuzz’s name and injure Starbuzz’s reputation.”).

¹⁷¹ Complaint & Demand for Jury Trial at 10. Starrbuzz Tobacco, Inc. v. Yousif, 2014 WL 4653042 (C.D. Cal.) (No. 8:14-CV-00487).

¹⁷² *Id.* at 11.

¹⁷³ *Id.* at 12.

¹⁷⁴ *Id.* at 20, 33.

In another infringement action, Fraternity Collection, LLC filed a complaint against former employee and designer Elise Fagnoli for her use of “the terms ‘#fratcollection’ and ‘#fraternitycollection’ in her social media accounts to promote her designs for [a] competitor,”¹⁷⁶ seeking declaratory and injunctive relief from Fagnoli’s improper use of their trademark.¹⁷⁷ Fagnoli maintained Fraternity Collection failed to state a claim for trademark infringement.¹⁷⁸ In response, both parties filed

¹⁷⁵ Notice of Voluntary Dismissal, *Starrbuzz Tobacco, Inc. v. Yousif*, 2014 WL 4653042 (C.D.Cal.), (No. 8:14-CV-00901) (“Dismissal is Without Prejudice.”).

¹⁷⁶ *Fraternity Collection, LLC v. Fagnoli*, No. 3:13-CV-664-CWR-FKB, 2015 WL 1486375, at *1–2 (S.D. Miss. Mar. 31, 2015). (“Fraternity Collection learned that Fagnoli was hashtagging ‘fratcollection’ and ‘fraternitycollection’ in connection with her separate Francesca Joy merchandise. For example, one post on Fagnoli’s Instagram account read: ‘My #francescajoy #frocket collection is now available at @fashiongreek dot com for \$24.’ This text was followed by, *inter alia*, ‘#tshirts #pockets #fratcollection #fraternitycollection.’ (emphasis added). True and correct copies of screenshots demonstrating Fagnoli’s hashtagging are attached hereto as Exhibit ‘E.’”). Verified Complaint for Declaratory and Injunctive Relief at 37, *Fraternity Collection LLC v. Fagnoli*, 2013 WL 6180126 (S.D. Miss.) (3:13cv00664).

¹⁷⁷ Verified Complaint for Declaratory and Injunctive Relief at 37, *Fraternity Collection LLC v. Fagnoli*, 2013 WL 6180126 (S.D. Miss.) (3:13cv00664) (“Fraternity Collection is the owner of valid and enforceable trademark rights in the mark FRATERNITY COLLECTION for use in connection with clothing. Fraternity Collection has used the FRATERNITY COLLECTION mark in commerce continuously since at least 2011 and consumers have come to associate the FRATERNITY COLLECTION mark with goods and services provided by Fraternity Collection. As a result of this association, Fraternity Collection has engendered significant goodwill. Fagnoli has used marks in commerce that are confusingly similar or identical to the FRATERNITY COLLECTION trademark, including but not limited to ‘fratcollection’ and ‘fraternitycollection,’ to identify and describe her own goods and services that are similar or identical to Fraternity Collection’s goods and services. Fagnoli’s use of these confusingly similar trademarks causes consumer confusion as to the source of the goods and services being provided by her and/or Fashion Greek and, therefore, constitutes trademark infringement.”).

¹⁷⁸ Fagnoli argues that Fraternity Collection has failed to state a claim for common law trademark infringement under either federal or Mississippi law. *Fraternity Collection, LLC v. Fagnoli*, No. 3:13-CV-664-CWR-FKB, 2015 WL

competing motions to dismiss.¹⁷⁹ In March 2015, the United States District Court for the Southern District of Mississippi declined to dismiss the infringement claims.¹⁸⁰ Instead, the district court entered an Order stating: “hashtagging a competitor’s name or product in social media posts could, in certain circumstances, deceive consumers.”¹⁸¹ However, on June 17, 2015, the parties agreed to a settlement and the district court entered an Order dismissing the suit.¹⁸²

C. *Adjudicating Whether Hashtags Can Be Trademarks*

In March 2015, the United States District Court for the Central District of California was the first court to adjudicate whether hashtags can be trademarks in *Elksouzian v. Albanese*.¹⁸³ In 2013, plaintiffs filed an amended complaint against their former business partners¹⁸⁴ alleging trademark infringement¹⁸⁵ and a violation of the

1486375, at *4 (S.D. Miss. Mar. 31, 2015) (“The Court agrees that Fraternity Collection may attempt to prove trademark infringement under Mississippi common law and, for the reasons already stated regarding the Lanham Act, finds that Fraternity Collection’s complaint sufficiently states such a claim.”).

¹⁷⁹ *Id.* at *2 (“The competing motions to dismiss followed shortly thereafter.”).

¹⁸⁰ See Roberts, *supra* note 34.

¹⁸¹ Fraternity Collection, LLC v. Fagnoli, No. 3:13-CV-664-CWR-FKB, 2015 WL 1486375, at *4 (S.D. Miss. Mar. 31, 2015) (internal quotation marks omitted) (internal citation omitted).

¹⁸² Order of Dismissal at 1, Fraternity Collection, LLC v. Fagnoli, No. 3:13--CV-664-CWR-FKB, 2015 WL 1486375 at *1 (“Order dismissing case with prejudice as to all parties”).

¹⁸³ Eksouzian v. Albanese, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *1 (C.D. Cal. Aug. 7, 2015).

¹⁸⁴ Plaintiff and Defendant both manufactured compact vaporizers. A compact vaporizer is “a device used to vaporize the oils of commonly smoked substances, such as tobacco, to a user.” First Amended Complaint at 1, Eksouzian v. Albanese, No. 2:13-CV-00728-PSG, 2013 WL 6417464 at *1 (C.D. Cal.).

¹⁸⁵ *Id.* at *10 (Plaintiffs claim defendant’s use of their mark “is likely to cause confusion among consumers as to the source, affiliation, connection, association, origin, sponsorship, and approval of the goods and services offered by Defendants, and Plaintiffs are informed and believe, and based thereon allege, that Defendants’ use of the Trademarks has caused such confusion.”).

Lanham Act.¹⁸⁶ Defendants (“Cloud Vapez”) filed a Motion to Dismiss, arguing the Plaintiffs (“CloudV” and “Vape A Cloud”) cannot bring a claim for trademark infringement because the mark used was jointly owned by a partnership between the Plaintiffs and Defendants.¹⁸⁷ In Plaintiffs’ Opposition to the Motion to Dismiss, Plaintiffs claimed CloudV and Vape A Cloud are the owners of certain trademarks and that Defendants have infringed on those marks: “[a]s corporations with distinct identities from the partnership, CloudV and Vape A Cloud are entitled to maintain claims for infringements of their marks.”¹⁸⁸ In response, Plaintiffs and Defendants entered into a settlement agreement (“SA”) that restricted both parties trademark use of ‘cloud’ in connection with ‘pen’ or ‘penz.’¹⁸⁹

However, on September 11, 2014, plaintiffs filed a Motion to Enforce Settlement Agreement¹⁹⁰ claiming the Defendants violated

¹⁸⁶ *Id.* at *12 (Plaintiffs assert that Defendants actions constitute a violation of 15 U.S.C. § 1125(a) and “has caused and continues to cause substantial effect on interstate commerce in that a likelihood of confusion, mistake, and deception exists as to the source, sponsorship, affiliation, and connection of Defendants’ goods in the minds of the consuming public.”).

¹⁸⁷ Defendant’s Notice of Motion and Motion to Dismiss Plaintiffs’ Third, Fourth, Fifth, Sixth, and Seventh Claims for Relief Pursuant to Federal Rules of Civil Procedure Rule 12(b)6 at 2, *Eksouzian v. Albanese*, No. 2:13-CV-00728-PSG, 2013 WL 6418509 at *2 (C.D. Cal) (The partnership between Plaintiff and Defendant adopted the name “Cloud” and therefore Defendant’s argue “neither Eksouzian nor any of the other corporate Plaintiffs may bring a claim for infringement of a trademark owned by the Joint Venture because partnership assets are owned by the partnership not by any individual partner.”).

¹⁸⁸ Plaintiffs’ Opposition to Motion to Dismiss at 2, *Eksouzian v. Albanese*, No. 2:13-CV-00728-PSG, 2013 WL 6418509 at *2 (C.D. Cal.).

¹⁸⁹ The SA provides: “Defendants will not use the term CLOUD standing alone in commerce as a mark.” Additionally, the SA provides: “Plaintiffs *may* use the words CLOUD, CLOUD V, and/or CLOUD VAPES standing alone as trademarks” but “*Plaintiff may not do is create a unitary trademark* (as has been defined here) which includes CLOUD in close association with the words “pen”, “pens”, “penz”, “pad”, or “fuel.” *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *1, *7 (C.D. Cal. Aug. 7, 2015).

¹⁹⁰ *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *1 (C.D. Cal. Aug. 7, 2015).

the agreement when it used the “cloudpen” mark.¹⁹¹ In response, Defendant’s asserted that Plaintiff’s violated the SA when it used “#cloudpen” and “#cloudpenz” on social media.¹⁹² The court explained that Plaintiff’s use of “#cloudpen” on social media was “merely a functional tool to direct the location of Plaintiffs’ promotion so that it [was] viewed by a group of consumers, not an actual trademark.”¹⁹³ In other words, the SA restricted the party’s use of trademarks, and because a hashtag does not function as a trademark, the SA did not restrict Plaintiff’s use of the trademark in a hashtag on social media. The court did not stop there; additionally, the court made a much broader statement about hashtags in general: “Defendant’s argument fails because . . . hashtags are merely descriptive device, not trademarks, unitary or otherwise, in and of themselves.”¹⁹⁴ Notwithstanding the SA, the court held that hashtags are not trademarks.

The court correctly interpreted trademark law by reiterating that a hashtag, as a form of metadata, is incapable of being a source indicator. To explain, the public views hashtags as a way to group content.¹⁹⁵ Necessarily, even a highly distinctive trademark used in a hashtag still does not function as a trademark in the eyes of the consumer.¹⁹⁶ Therefore, the court’s declaration that hashtags

¹⁹¹ “Unitary trademark” is defined as a trademark in which “the elements are so closely aligned and situated that the average consumer would view the group of words or symbols as a single trademark.” *Trademark Manual of Examining Procedure*, UNITED STATE PATENT AND TRADEMARK OFFICE (Oct. 2012), <http://tmep.uspto.gov/RDMS/mashup/html/page/manual/TMEP/Oct2012/TMEP-1200d1e11977.xml>.

¹⁹² See Roberts, *supra* note 34.

¹⁹³ Eksouzian v. Albanese, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *8 (C.D. Cal. Aug. 7, 2015).

¹⁹⁴ *Id.*

¹⁹⁵ See *supra* Part I.

¹⁹⁶ See Roberts, *supra* note 34. Despite the inability to identify a source, “[t]he trademark office has accepted screenshots of hashtags on social media as specimens sufficient to establish use in commerce—check out those submitted with the applications to register #LikeAGirl (Twitter); #Steakworthy (Facebook); #Hollywood Trends (YouTube); and #RembrandtCharms (Facebook and Twitter).” Additionally, Alexandra Roberts, J.D., conducted a survey to gauge how consumers understand hashtags, and the

are “merely descriptive devices, not trademarks, unitary or otherwise”¹⁹⁷ is the correct interpretation of trademark law because the inability to function as a source identifier necessarily means the hashtag is not entitled to trademark protection.

IV. HASHTAGS—THE ANTITHESIS OF TRADEMARKS¹⁹⁸

The week *Eksouzian* was decided, seven new hashtags were granted federal registration by the USPTO,¹⁹⁹ making the *Eksouzian* court decision inconsistent with present USPTO practice. However, the opinion in *Eksouzian* does not address or give weight to the fact that Defendants owned the federal registration for “Cloud Penz.”²⁰⁰ Here, Plaintiffs were in fact using Defendant’s registered mark in a hashtag, just as Fagnoli used Fraternity Collection’s mark, Iguana Grill used Taco John’s mark, and Souzie Yousif used Starbuzz’s mark in a hashtag on social media. Given the recent trend by the USPTO, in theory defendants could also register “#cloudpenz”²⁰¹ as a trademark. However,

results suggest that a hashtag does not function as a trademark. *Id.* According to the study, “consumers perceive even registered tagmarks as mere hashtags that invite them to join a conversation on social media or enable them to organize posts on a given topic.” *Id.* For example, “[i]n response to a question modeled after the classic *Teflon* survey for genericide asking whether, based on the image below, #BeUnprecedented was a hashtag or a trademark, only 5% of respondents chose ‘trademark’ or ‘both,’ while 83% classified it as a hashtag and 11% selected ‘neither’ or ‘I don’t know.’” *Id.*

¹⁹⁷ *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *8 (C.D. Cal. Aug. 7, 2015).

¹⁹⁸ See *McCarthy*, *supra* note 134.

¹⁹⁹ See *Roberts*, *supra* note 34.

²⁰⁰ *Id.*

²⁰¹ The Trademark Manual of Examining Procedure “TMEP” is published to provide “a reference work on the practices and procedures relative to prosecution of applications to register marks in the USPTO.” Trademark Manual of Examining Procedure October 2015, United States Patent and Trademark Office, <http://tmep.uspto.gov/RDMS/detail/manual/TMEP/current/d1e2.xml> (last visited Nov. 11, 2015). The TMEP states: “A mark comprising or including the hash symbol (#) or the term HASHTAG is registrable as a trademark or service mark.” TMEP § 1202.18, Hashtag Marks, *available at*

ultimately it does not matter who owns the trademark used in a hashtag or that the hashtag itself was federally registered; hashtags on social media do not function as a trademark and are therefore not entitled to protection. This section will expand on the *Eksouzian* decision and explore in detail how a hashtag (1) is incapable of being a source identifier; (2) does not cause consumer confusion; and (3) will likely dilute a trademark or lead to genericide.

A. *A Hashtag Is Not a Trademark Because It Does Not Function as a Source Identifier.*

A hashtag is incapable of identifying a single, particular source because the very purpose of hashtags is to categorize multiple sources. Not only does a hashtag catalog multiple sources across various media and outlets, it can seldom distinguish one source from another source, an essential trademark element.²⁰² In other words, hashtag users are under the assumption that anyone can freely use a hashtag in a post on the Internet, whether that is on Twitter, Facebook, Instagram, etc., and that the very purpose of the metadata tag is to provide easy access to multiple sources. Because anyone can include any hashtag in any post, consumers understand that a hashtag containing a trademark does not necessarily mean the post came from the owner of said trademark; posts can originate from anyone. For example, an image of a shoe may contain “#tree,” and an image of a tree may contain “#Nike.” Someone who understands hashtags will not identify Nike the shoe company as the source of the tree image. While “#tree” would ideally categorize tree related content, hashtag users understand that there are no “hashtag rules” dictating when and what hashtag can be used in a post; in fact, hashtag users often use illogical and satirical hashtags in their posts.²⁰³ Furthermore, not only can

http://tmep.uspto.gov/RDMS/mashup/html/page/manual/TMEP/Oct2013/ch1200_d1ff5e_1b5ad_3bc.xml (last visited Nov. 11, 2015).

²⁰² See *Basic Trademark Facts*, *supra* note 35.

²⁰³ For example, in 2012, McDonald’s launched an ad campaign encouraging consumers to share stories about their McDonald’s experience using the hashtag “#McDStories.” McDonald’s even paid to have the hashtag advertised on the

anyone use a hashtag in a post, there is no distinction amongst sources on social media platforms: if a post contains a given hashtag, then the post is included in that grouping. To illustrate, if a consumer uses “#Nike” to facilitate a search of Nike shoe related content, there is not a mechanism to distinguish posts relating to Nike shoes from other posts relating to other shoes, or even arbitrary posts such as an image of a tree containing “#Nike.” Therefore, necessarily, a hashtag serves to catalog an idea from many sources—anyone placing hashtags in posts. Because there is no way to distinguish amongst these sources, a hashtag cannot function in a way that denotes a single source to the consumer. In other words, a hashtag denotes a topic, not an original source.²⁰⁴ So when a trademark is used in a hashtag on social media, and the trademark owner attempts to enforce its rights against the infringer, a court will likely view the tag just as the *Eksouzian* court did—as a “merely descriptive device.”²⁰⁵ Courts are likely to take this stance because consumers are going to view the hashtag not as a trademark, but as any other hashtag.

B. A Hashtag Does Not Cause Consumer Confusion.

Even when used by a competitor, hashtags will not cause consumer confusion. As discussed in Part II, the courts takes into

Twitter homepage. Unfortunately for McDonalds, Twitter users did not share “heart-warming stories about Happy Meals,” and instead made a mockery of the tag by using it to bash the brand. For example, one Twitter user tweeted: “One time I walked into McDonalds and I could smell Type 2 diabetes floating in the air and I threw up. #McDStories.” Pertinent to this analysis, McDonald’s pulled the ad “within two hours,” but that did not stop Twitter users from continuing to use the hashtag. As demonstrated, hashtags campaigns are hard to control and virtually impossible to stop. Kashmir Hill, *#McDStories: When A Hashtag Becomes A Bashtag* (Jan. 24, 2012 2:07PM), FORBES <http://www.forbes.com/sites/kashmirhill/2012/01/24/mcdstories-when-a-hashtag-becomes-a-bashtag/> (last visited Nov. 11, 2015).

²⁰⁴ Andrew M. Jung, *Twittering Away the Right of Publicity: Personality Rights and Celebrity Impersonation on Social Networking Websites*, 86 CHI.-KENT L. REV. 381, 401–02 (2011).

²⁰⁵ *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *8 (C.D. Cal. Aug. 7, 2015).

account “evidence of actual confusion,”²⁰⁶ when assessing trademark infringement. In the *Eksouzian* case, Plaintiffs argued that using a hashtag “with a competitor’s product name brings more eyeballs to that post without creating confusion.”²⁰⁷ In support of this claim, Plaintiffs “submit[ed] a report from a social media expert who opines that using a competitor’s product name that way is a common practice, analogous to ‘placing an advertisement on a billboard in view of a competitor’s retail establishment.’”²⁰⁸ A billboard advertisement for Subway that can be seen from a Jimmy John’s is not going to create consumer confusion.²⁰⁹ The purpose of the billboard is not to deceive the consumer; the purpose is to attract the competitor’s customers. While it may not be common for Jimmy John’s to post a picture of a sandwich on social media accompanied with “#subway,” it is unreasonable to think hashtag users will be confused by “#subway,” because the user understands anyone at any given time can use the hashtag, including Jimmy John’s.²¹⁰ Additionally, if anything, consumers are being directed to join in a conversation about a competing brand, which is why the practice seems unlikely. Plaintiff’s argument illustrates that hashtags do not in fact create confusion because they do not operate as a trademark in the eyes of the consumer.²¹¹ Trademark law serves to protect the

²⁰⁶ *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 352 (9th Cir. 1979).

²⁰⁷ *Roberts*, *supra* note 34.

²⁰⁸ *Id.*

²⁰⁹ Subway and Jimmy John’s are competing restaurant franchises that sell submarine sandwiches.

²¹⁰ Similarly, in response to Plaintiff’s argument in *Eksouzian*, one lawyer postulates: “I wouldn’t expect to see Burger King promote their new chicken fries by tagging an image #FieryChickenFries #Spicy #BurgerKing #McDonalds, though I would be less surprised to see it tag a competitor conversationally in a manner resembling traditional nominative fair use (“Our new #FieryChickenFries are not for the faint of heart. If you can’t handle the heat, try #McDonalds.”). *Roberts*, *supra* note 34. It is not only plausible, but highly likely tagging a competitor’s product name will only bring more attention to the post without creating confusion.

²¹¹ *Roberts*, *supra* note 34.

consumer, and without a likelihood of consumer confusion, the hashtag serves as “the antithesis of trademarks.”²¹²

C. *Using a Trademark in a Hashtag Encourages Genericide.*²¹³

When a trademark becomes generic, the brand’s value becomes insignificant because anyone, including competitors, can use the mark. This is problematic for trademark owners because a brand is arguably the most valuable corporate asset;²¹⁴ it is what distinguishes one company from the rest.²¹⁵ The effect of genericide is costly as “[n]ot even aggressive marketing and advertising can save a mark found to be generic through extensive use by others.”²¹⁶ In other words, if an owner fails to police their trademark, genericide²¹⁷ can occur from widespread use of the

²¹² See McCarthy *supra* note 134; see also *In re Pennington Seed, Inc.*, 466 F.3d 1053, (Fed. Cir. 2006).

²¹³ Trademark law protects the consumer, and if a consumer believes the trademark is the name of the product itself, and not an identifying source, then that trademark has lost its distinctiveness and become generic. See *supra* note 130.

²¹⁴ “It is estimated that the value of a brand like Apple is close to \$100 billion.” Simon Tulett, *Genericide: Brands Destroyed by Their Own Success*, BBC (May 28, 2014), <http://www.bbc.com/news/business-27026704>.

²¹⁵ “The brand is often the most valuable asset of a company - its exclusivity is what puts it apart. If you get to the stage where you no longer have that, the brand is finished.” *Id.*

²¹⁶ Joan Archer, *Enforcement of Trademark Rights on the Internet: Nuts and Bolts Tools to Help Protect Against Infringement*, AMERICAN BAR ASSOCIATION, http://www.americanbar.org/content/dam/aba/administrative/litigation/materials/2012_hot_topics_in_ip_lit/2012_aba_panel3_Enforcement_of_Trademark_Rights_on_the_Internet.authcheckdam.pdf (last visited Sept. 26, 2015); see, e.g., *America Online, Inc. v. AT&T Corp.*, 342 F.3d 812 (4th Cir. 2001) (“[T]he phrase ‘You’ve Got Mail’ was determined to be generic and, therefore, unenforceable as a trademark.”).

²¹⁷ See *Trademarks vs. Generic Terms*, INTERNATIONAL TRADEMARK ASSOCIATION (June 2015), <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarksvsGenericTermsFactSheet.aspx> (“The term “genericide” is sometimes used to describe the process where the trademark owner actually participates, often unknowingly, in the destruction of the distinctiveness of the trademark.”).

mark.²¹⁸ Extensive use by others is the precise nature of the hashtag. Yet, corporations are not only using their trademarks in hashtags, they are registering hashtags.²¹⁹ Manufacturers may be incentivized to produce quality products in order to facilitate positive social media discussions containing their trademark in a hashtag, but users who join in these conversations about certain brands do so with the knowledge that anyone at any given time, including competitors, can also join in that conversation.²²⁰

Under the Lanham Act, the test for genericide considers the “primary significance of the registered mark to the relevant public.”²²¹ The primary significance to the relevant public of a trademark alone is different than the primary significance of a trademark used as a hashtag because the public views hashtags as freely usable devices, not trademarks. However, corporations should be wary that extensive use of a trademark in a hashtag could lead to genericide of that trademark, effectively destroying a brand.²²² A trademark used in a hashtag can actually change the primary significance of that trademark outside its usage in a hashtag on social media. To give a hypothetical example, if Coca-Cola ran an ad campaign encouraging consumers to join in water bottle conversations for “#Dasani,” and consumers started using “#Dasani” to reference all bottled water generally, the hashtags could change the relevance of the mark to the general public. Images of various water bottles containing “#Dasani,” could be evidence that Coca-Cola’s strong mark has become a generic name for bottled water in the minds of the consumer.²²³ In other words,

²¹⁸ J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 12:1 (4th ed. 2007).

²¹⁹ See *supra* note 197.

²²⁰ See *supra* note 204; see also *supra* note 211.

²²¹ Lanham Act § 14, 15 U.S.C. § 1064(3) (2012) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

²²² See Tulett *supra* note 215; see also Hill, *supra* note 204.

²²³ See Tulett *supra* note 215 (“If consumers understand the trademark to be the name of the product itself, as opposed to identifying its exclusive source,

extremely popular hashtags can change public perception, turning trademarks into household names.²²⁴

V. CONCLUSION

In a society centered on technology, trademarking a hashtag does not benefit the commercial world. A hashtag should not be afforded legal trademark protection because applying trademark law is impractical, does not further trademark objectives, and is not an efficient allocation of resources. Hashtags direct consumers to search a particular topic and encourage consumers to join in topic discussions.²²⁵ It is important to note that this social movement—the ability to categorize, classify, and connect a given topic with the click of two buttons²²⁶—has commercial value because of its public utility. To illustrate this point, Facebook has value because of its billions of users.²²⁷ If a similar site came into existence today, it would have little to no value unless consumers *use* it. Corporations want to facilitate brand discussion by using hashtags, but simultaneously want to restrict who can join in these conversations.²²⁸ This restriction is unreasonable and simply irreconcilable with the function of a hashtag. If one party restricts

that trademark loses its distinctiveness.”); *see also* Lanham Act § 14, 15 U.S.C. § 1064(3) (2012) (“The primary significance of the registered mark to the relevant public rather than purchaser motivation shall be the test for determining whether the registered mark has become the generic name of goods or services on or in connection with which it has been used.”).

²²⁴ *See* Tulett *supra* note 215.

²²⁵ *See* Roberts, *supra* note 34 (“Hashtags began their reign on social media as metatags that facilitate searching and enable users to organize content. If you want to peruse the millions of Instagram images tagged #LoveWins or pull up the latest #deflategate news on Twitter, you can type the hashtag into the site’s search box or click on it in an existing post to display all other content tagged with that phrase.”).

²²⁶ Pressing shift and 3 on a standard QWERTY keyboard will yield a # symbol.

²²⁷ Dave Lee, *Facebook Has a Billion Users in a Single Day, Says Mark Zuckerberg* (Aug. 28, 2015), BBC NEWS, <http://www.bbc.com/news/world-us-canada-34082393>.

²²⁸ *See* Roberts, *supra* note 34.

the use of hashtags by assigning ownership rights through trademarking, hashtags will lose their value because the community will no longer be able to freely share or access these classifiers.²²⁹ In other words, restricting the use of hashtags deters the ordinary user from continuing to experiment with the device, and if no one uses the device, it is useless. In order for the hashtag to retain its social allure, the hashtag should not be entitled to legal trademark protection.

A hashtag does not function as a trademark for a number of reasons, but the USPTO has nonetheless approved hashtag trademark registration. As illustrated, a brand must be protected, and given the widespread use of the hashtag, policing a mark on social media is impractical.²³⁰ As discussed, if an owner fails to police their mark, genericide²³¹ can occur from widespread use of the mark.²³² While a popular hashtag could, in theory, lead to genericide of that trademark, a notable reason to try and police a mark on social media, ultimately policing marks on social media is not feasible. Again, hashtags serve as an open invitation for anyone to join in a given conversation, even competitors, and hashtags do not distinguish amongst all these sources.²³³ It is unrealistic to expect corporations to comb through thousands, if not millions of posts containing the hashtag to ensure no unlawful use by a competitor. Again, assigning ownership rights and threatening users with litigation will only deter hashtag use.

However, hashtags do not function as trademarks because those familiar with a hashtag understand how the hashtag works. In

²²⁹ See Brandom, *supra* note 26.

²³⁰ See *supra* note 204.

²³¹ See *supra* note 116; See *Trademarks vs. Generic Terms*, INTERNATIONAL TRADEMARK ASSOCIATION (June 2015), <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarksvsGenericTermsFactSheet.aspx> (“The term “genericide” is sometimes used to describe the process where the trademark owner actually participates, often unknowingly, in the destruction of the distinctiveness of the trademark.”).

²³² J. THOMAS MCCARTHY, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 12:1 (4th ed. 2007).

²³³ See *generally* Part IV.A.

other words, hashtag users understand that a hashtag does not serve as a trademark on social media, but should courts use trademark law to change the way consumers think? The court in *Fraternity Collection, LLC v. Fagnoli* declined to dismiss the hashtag infringement claims on the grounds that “hashtagging a competitor’s name or product in social media posts could, in certain circumstances, deceive consumers.”²³⁴ To return to that example, Fagnoli, a t-shirt manufacturing competitor, used Fraternity Collection’s registered marks in a hashtag on social media in a post displaying t-shirts that were not in fact manufactured by Fraternity Collection.²³⁵ Even more egregious, the defendants in *Starbuzz* used Starbuzz’s registered mark in a Facebook post marketing a competing product that flat out incorrectly stated: “Ehose Mini from the makers of #starbuzz #ehose.” Trademark law should allow for some degree of confusion that may arise in these circumstances.²³⁶ In cases of new technologies such as social media platforms, trademark law should be normative with respect to consumer habits by reacting to consumer behaviors. This approach is the most logical because it allows for rapid technological development. As technologies change and advance unpredictably, trademark law must be able to react to consumer’s responses to these changes; otherwise the law is wasted protecting unconfused consumers. As consumers adapt to new advances in technology, trademark law is most effective when it reacts to these adaptations and protects consumers from actual brand confusion. In cases of certain new technologies, a law seeking to shape consumer habits discourages technological

²³⁴ *Fraternity Collection, LLC v. Fagnoli*, No. 3:13-CV-664-CWR-FKB, 2015 WL 1486375, at *4 (S.D. Miss. Mar. 31, 2015).

²³⁵ *See id.*

²³⁶ “[S]hould trademark law allow some degree of confusion in the short term so that consumers can learn in the long term not to be confused by [defendant’s] conduct? Should trademark law seek over time to change consumers’ habits in how they might interpret shopping websites or other shopping venues?” BARTON BEEBE, TRADEMARK LAW: AN OPEN-SOURCE CASEBOOK at Part II 94-95, available at <http://tmcasbook.org/wp-content/uploads/2015/07/BeebeTMLaw-2.0-Part-2.pdf>.

advances. The law should not prescribe how consumers *should* behave by seeking to shape consumer habits.²³⁷ While laws that seek to over time change consumers' habits in how they might interpret new technologies could be beneficial in certain instances, trademark law should protect consumers from real confusion, not prescribe what is or is not confusing. If consumers are told how to act, they may not experiment with new forms, such as the hashtag.

Although trademark law serves to reduce consumer confusion, modest confusion actually benefits consumers by teaching them how to distinguish amongst brands more effectively, furthering the goals of trademark law. In the case of hashtags, modest confusion is necessary to provide users with time to learn how the system operates. Allowing trademark law to function in a way that can shape consumer habits benefits the commercial world by allowing for new behaviors to become normative behaviors, such that the minimal confusion that may arise in the minds of new hashtag users today will be entirely eliminated in the future. Allowing some flexibility in terms of modest confusion is more responsive to real world circumstances that are constantly advancing, and this flexibility is more likely to promote fairness to the parties—the corporation and the public learning to use a new system. Ultimately trademark law works most effectively when it responds to societal norms.

Allowing for the continued federal registration of hashtags ultimately does not serve the goals of trademark law. Specifically, registering hashtags does not afford consumer protection because consumers do not view tags as source indicators. Additionally,

²³⁷ *Id.* (“[C]onsider the extent to which trademark law should be not merely reactive to consumer conduct (i.e., merely descriptive of actual consumer conduct), but also normative with respect to consumer conduct (i.e., affirmatively prescriptive of proper consumer conduct). In other words, on the following facts, should trademark law allow some degree of confusion in the short term so that consumers can learn in the long term not to be confused by Amazon.com’s conduct? Should trademark law seek over time to change consumers’ habits in how they might interpret shopping websites or other shopping venues?”).

17 N.C. J.L. & TECH. ON. 1, 42
#CanHashtagsBeTrademarked

assigning ownership rights of hashtags hampers economic efficiency and will only continue to burden the legal system. In summary, the California court correctly concluded, “hashtags are merely descriptive devices, not trademarks, unitary or otherwise, in and of themselves.”²³⁸ When used on social media, hashtags are public domain, and therefore should be owned by no one.

²³⁸ Elksouzian v. Albanese, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, at *8 (C.D. Cal. Aug. 7, 2015).