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**In the Beginning was Twitter: the Expansion of Hashtags and the New Challenges for
Trademark Law**

SUMMARY: 1. Introduction. – 2. Protectability problems. – 3. Case law. – 4. Conclusions.

«A brand is no longer what we tell the consumer it is
– it is what consumers tell each other it is».

– Scott Cook

1. *Introduction*

Nowadays hashtags² are almost everywhere: not only they have moved from Twitter to a plethora of social media platforms, but they flooded our everyday life, from commercials, to

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² A hashtag is «a word or phrase preceded by the symbol '#' that classifies or categorizes the accompanying text». See Merriam-Webster Dictionary <https://www.merriam-webster.com/dictionary/hashtag>. Their ever-increasing importance is highlighted by the fact that, in 2013, the United States Patent and Trademark Office (from now on USPTO) amended its guide for examiners (the so-called TMEP) by adding a section explicitly dedicated to hashtag trademarks, in order

TV shows and news. Due to the explosion of social media, they also broadened their first aim; in fact, while they were born to group various topics of interest and facilitate searches on the platform, pretty soon companies realized that hashtags could have been used as marketing tools to promote their business and to sell more products and services. As a consequence, marketing and advertising industries are now using hashtags to launch their campaigns, to generate discussions concerning their brands and products, to engage customers and to increase loyalty,³ in such a way that the interaction between companies and consumers has been irreversibly transformed.

Therefore, it should not surprise that even more companies are seeking trademark protection for their hashtags, given that the main problem with this kind of tools is that virtually any social media user is able to create a hashtag by simply adding the hashtag symbol before any group of words.⁴

Although the spread of social media platforms is a fully-fledged worldwide phenomenon, the US is – needless to say – the Country where hashtags are most popular, and, as such, is the global leader in terms of hashtag trademark applications.⁵ Despite this, there still is no convergence between the USPTO, the courts and commentators about whether a hashtag requires protection by trademark law or not.

to deal with the issue and provide with specific guidelines. As defined by the USPTO a hashtag is more than a mere addition of a symbol to a string of characters; it also is «a form of metadata [...]». See ¶ 102.18. Therefore, it provides information about some other data.

³ ROBERTS A.J., *Tagmarks*, 105 *California Law Review*, 599-666, (2017), 606.

⁴ YOUSEFI D., *#Protected: Hashtags, Trademarks, and the First Amendment*, 33 *Touro L. Rev.* 1343-1347, (2017), 1344.

⁵ «#Hashtag Trademark Applications Rise 64% in Just One Year», <http://www.compumark.com/insights/hashtag-trademark-applications-rise-64-just-one-year/>.

2. *Protectability problems*

First of all, it is of capital importance to understand whether a hashtag meets the protectability requirements laid down in the Lanham Act⁶ or not. Generally speaking, the purpose of a trademark is to identify the source of a good, or simply the idea that goods bearing the mark share a common source; thus, it protects consumers from deception and confusion and gives them the possibility to make purchasing decisions easier, by picking and choosing one product over another.⁷ Moreover, in making a mark easier to identify, it gives its owner an incentive to improve the quality of its good or service.⁸

Consequently, in its Trademark Manual of Examining Procedure the USPTO states that, in order to get protection, the hashtag has to serve as a source-identifier; in addition, it specifies that the inclusion of a hash symbol at the front of merely descriptive or generic wording for goods or services does not suffice to qualify it as a source-identifier, since the main function of hashtags is «merely to facilitate categorization and searching within online social media».⁹ Nevertheless, the TMEP does not consider that not only the addition of a hash symbol fails to render an otherwise unregistrable mark distinctive – and thus registrable – but it could also lead to the opposite effect, namely the conversion of a valid trademark into a mere hashtag.¹⁰

Furthermore, another specific factor which the USPTO considers in order to decide whether to register a hashtag is the entirety of the context; meaning that, every time the USPTO accepted the hashtag for registration, it checked that there was evidence of displaying the hashtag mark also in a non-internet context (for instance, on a billboard) in connection with the product being offered. As a consequence, a considerable number of applica-

⁶ The Lanham (Trademark) Act is the primary federal trademark statute law in the US and currently provides the main source of trademark protection. It charges the USPTO with the authority to oversee applications for trademark registration.

⁷ «Overview of Trademark Law», HARVARD LAW, <http://cyber.harvard.edu/metaschool/fisher/domain/tm.htm>.

⁸ *Id.*

⁹ TMEP ¶ 102.18.

¹⁰ ROBERTS A.J., *supra* note 3, 602,603.

tions have been rejected on the ground that the hashtag was only conceived for online social media.¹¹

Beyond these – and few more¹² clarifications, the USPTO essentially examines applications for hashtag marks in the same way of traditional marks.

First of all, trademark protection is granted when a mark is distinctive. An identifying mark is distinctive if it either is inherently distinctive or has obtained distinctiveness by secondary meaning;¹³ in order to determine their degree of distinctiveness, marks are grouped into four categories: generic, descriptive, suggestive and arbitrary or fanciful. While there is no protection for generic marks,¹⁴ suggestive, arbitrary and fanciful ones are considered as being inherently distinctive, as soon as a producer begins using them in commerce; instead, descriptive marks require secondary meaning if they want to acquire distinctiveness.¹⁵

Nevertheless, when it comes to apply this scheme to hashtags, many problems arise. Indeed, looking to hashtag marks closely, it is quite evident that most of them are suggestive

¹¹ For instance, on this ground #TAKETHERIDE for beer was rejected by the USPTO examining attorneys. KOHANE D., *#UNDECIDED: Trademark Protection for Hashtags*, (2016), <http://www.ipwatchdog.com/2016/06/24/undecided-trademark-protection-hashtags/id=70111/>.

¹² In the TMEP it is specified that consideration should be given also to «the placement of the hash symbol in the mark, the identified goods and services, and the specimens of use, if available». TMEP ¶ 102.18. Consequently, one party cannot prevent someone else using a similar hashtag in connection with unrelated goods or services, and the application must include examples of the hashtag featured on packaging, labels, or in online or printing advertising

¹³ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). The difference between these two categories is that, while in the first case it is assumed that consumers will automatically perceive those types of marks as source indicators from its earliest use, in the second case they are capable of becoming distinctive to consumers over time

¹⁴ The lack of protection lies in the fact that, as the name suggests, they are common names which refers «to the genus of which the particular product is a species». *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2nd Cir. 1976).

¹⁵ If this is true as a general rule, it is also true that, it has not been strictly applied for hashtag registration requests, since there have been plenty of examples of merely descriptive hashtags which have been registered without a showing of secondary meaning (for instance, #Smart for clothing and #LetsBowl for bowling balls). This highlights a difference in treatment between descriptive hashtag marks and traditional descriptive word marks. ROBERTS A.J., *supra* note 4, 629,630.

without being inherently distinctive. In other words, even when they can technically be categorized as inherently distinctive, still they are highly likely to lack in distinguishing the hashtag owner's products from the products of their competitor,¹⁶ in that they perceive a hashtag primarily as a tool for search on social media. Therefore, it should at least be pointed out that a hashtag can never be seen as inherently distinctive; on the opposite, any trademark meaning of a hashtag must necessarily be considered as secondary meaning.

In addition to their distinctiveness problems, another sensitive issue with regard to hashtags relates to the manner in which they are used. Notably, in order to get a protection, a term or phrase must be used in commerce as a mark in connection with a specific good or service. As a result, the main problem concerning hashtags is to understand whether their use unequivocally make consumers perceive them as source-indicators or, on the contrary, as mere hashtags.

While with "offline" trademarks the examining attorney's duty is to merely consider whether a word mark is affixed to goods sold, or properly used in connection with the specific service provided, things get more problematic with hashtags, as not only do they act as search facilitators, but they also serve communicative functions (for instance, they can be used to comment a popular TV show,¹⁷ or express affiliation).¹⁸

¹⁶ ROBERTS A.J., *supra* note 3, 628.

¹⁷ It is the case of the hashtag #GOT, acronym of the world-famous Game of Thrones.

¹⁸ Such as the hashtag #PrayForParis, which has spread like wildfire after the infamous terrorist attack of November 13th, 2015.

3. Case law

While there is still uncertainty and difference in thought among USPTO examiners about hashtag marks protectability, the situation is not different from a judicial point of view, considering that courts are just beginning to provide some guidance.

In particular, in one case the district court stated that hashtag may never be protectable as trademarks,¹⁹ while another court opined that using a hashtag could deceive consumers in violation of the Lanham Act.²⁰

Eksouzian v. Albanese was the first case where a District Court²¹ adjudicated whether a hashtag could be a trademark. As a matter of background, the parties – competitors dealing with manufacturing and selling compact vaporizer pens (also known as e-cigarettes) – had a settlement agreement to resolve a trademark dispute in a previous case. Specifically, the agreement explicitly prohibited both parties from using the words “cloud”, “cloud v” and “cloud vapes” in close association with the words “pen” and “penz”, in connection with their products as a unitary trademark.²² However, when the Plaintiffs sued to enforce the agreement – claiming the Defendants violated it by using the “cloudpen” mark – the Defendants counterclaimed and accused the Plaintiffs of materially breaching the agreement by their use of the hashtags #cloudpen and #cloudpenz on Instagram and in promotional contests.

In its findings, the court explained that the Plaintiffs’ use of the hashtag under scrutiny 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».²³ This means that, although it is true that the settlement agreement restricted both party’s use of the trademark, it is equally

¹⁹ *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN, 2015 WL 4720478, (C.D. Cal. Aug. 7, 2015).

²⁰ *Fraternity Collection, LLC v. Fargnoli*, No. 3:13-CV-664-CWR-FKB, 2015 WL 1486375, (S.D. Miss. Mar. 31, 2015).

²¹ Namely, the US District Court for the Central District of California.

²² CHU D., #CautionBusiness: Using Competitors’ Hashtags Could Possibly Lead to Trademark Infringement, 25 Cath U.J.L. & Tech, (2017), 406. Available at <http://scholarship.law.edu/jlt/vol25/iss2/8>.

²³ *Eksouzian v. Albanese*, at *8.

true that, since the hashtag did not function as a trademark, that agreement did not imply a restriction of Plaintiffs' use of the trademark in a hashtag on social media.²⁴

Besides, the court grasped the opportunity to make a broader statement about hashtag in general. In fact, it affirmed that the Plaintiffs did not breach the settlement agreement through their use of #cloudpen because «hashtags are merely descriptive devices, not trademarks, unitary or otherwise, in and of themselves».

This ruling has cast a shadow on the issue, on the ground that – as several commentators pointed out – it failed to consider whether the given hashtag could also function as a source-identifier (and not only as a form of metadata) under the standards set forth by the USPTO.²⁵

Moreover, the court omitted analysis on whether the Plaintiffs' use of #cloudpenz was also descriptive, especially taking account of the Defendants' federal registrations for the mark CLOUD PENZ for e-cigarettes and vaporizers.²⁶

Despite the clear commitment of the court, the same week the case was decided, seven new hashtags were granted federal registration by the USPTO,²⁷ thus highlighting – once again – the difference of view between court decisions and the practice.

Although for the time being *Eksouzian v. Albanese* remains the only court decision regarding whether hashtags can be protected as trademarks, another recent opinion states that a hashtag could contribute to consumer confusion, and, as such, the use of a competitor's name as a hashtag could form the basis of trademark infringement or false advertising claims.²⁸

²⁴ FALCONER E. A., *#CanHashtagsBeTrademarked: Trademark Law and the Development of Hashtags*, North Carolina Journal of Law & Technology, 17 N.C. J. L. & Tech. On. 1, (2016), 31.

²⁵ ROBERTS A., *Hashtags Are Not Trademarks – Eksouzian v. Albanese (Guest Blog Post)*, Tech. & Marketing L. Blog (Aug. 26, 2015), <http://blog.ericgoldman.org/archives/2015/08/hashtags-are-not-trademarks-eksouzian-v-albanese-guest-blog-post-2.htm>.

²⁶ KIEDROVSKI C. L., and MURPHY C. K., «Are Hashtag Capable of Trademark Protection under US Law?», INTABulletin, (2016), <https://www.inta.org/INTABulletin/Pages/AreHashtagsCapableofTMProtectionunderUSLaw-.aspx>.

²⁷ ROBERTS A., *supra* note 25.

²⁸ SAPER D., «Are Hashtags Intellectual Property?» (2017), <https://www.business.com/articles/are-hashtags-intellectual-property/>; KIEDROVSKI C. L., and MURPHY C. K., *supra* note 26.

In *Fraternity Collection LLC v. Fagnoli*, the Plaintiff filed a complaint against former employee Elise Fagnoli on the assumption that she used the hashtags “#fratcollection” and “#fraternitycollection” to promote her designs on her social media account for a competitor. Accordingly, the Plaintiff sought declaratory and injunctive relief from Fagnoli’s improper use of their trademark. The designer moved to dismiss the Plaintiff’s Lanham and trademark infringement claims; nevertheless, the court denied Fagnoli’s motion and ruled that the use of the abovementioned hashtags proved false advertising and trademark infringement claims. Moreover, the court stated that «hashtagging a competitor’s name or product on social media post, could, in certain circumstances, deceive consumers».²⁹

4. Conclusions

It is almost clear to everyone that both the trademark system and the justice have failed to keep up with the spread of hashtags and their possible commercial implications. However, there are arguments which could suggest that a trademark protection is unnecessary and – to some extent – duplicative.

First of all, a possible reason against the trademark protection lies in their very nature: hashtags were born to be used across platforms from an indefinite number of people. Consequently, a hashtag is incapable of identifying a single source in the mind of the consumers, given that they are often well-known phrases – either because they were widely used before their “conversion” into hashtags, or because they acquired relevance once being used as a hashtag.³⁰ In other words, social media users perceive that everyone can freely use a hashtag in every platform which supports it; therefore, they are highly unlikely to assume that a

²⁹ *Fraternity Collection, LLC v. Fagnoli*, at *4.

³⁰ ROBERTS A. J., *supra* note 3, 647.

hashtag containing a trademark originates from its owner,³¹ since «a hashtag denotes the topic, but not the originator [...]».³²

Secondly, it can be argued that providing a hashtag with a legal protection does not bring any additional advantage to a marketer that he could already obtain through a «traditional» registration. Specifically, companies can rely on the framework laid down for slogans,³³ since both hashtags and slogans aim to serve as a link to the particular good or service. Somehow, we could argue that hashtags are the online equivalent of what slogans are for the offline world.

Therefore, as well as an already-trademarked slogan does not need to get a new protection when the owner adds a hash symbol before it,³⁴ similarly, a non-trademarked slogan that does not yet exist could be undoubtedly registered without a hashtag.

If trademarking a hashtag is hence unnecessary, the underlying reason why marketers and advertisers seek trademark protection is to be empowered to control the discussion about their goods and services in the unfortunate event that such discussion goes in an undesired direction.

On social media platforms, hashtag advertising campaigns often prove to be a double-edged sword, with marketing disasters which are just around the corner.³⁵ Thus, giving

³¹ Evidence of this can be found in a 2015 survey conducted by Associate Professor at the University of New Hampshire School of Law Alexandra J. Roberts, whose aim was to check consumer perception of hashtags. The results underlined that, in many cases, consumers perceive even those who have been registered as mere hashtags which simply enabled them to group posts on given pic or invite them to join a conversation on social media. ROBERTS A., *supra* note 25.

³² JUNG A. M., *Twittering Away the Right of Publicity: Personality Rights and Celebrity Impersonation on Social Networking Websites*, 86 Chi.-Kent. L. Rev. 381 (2011), p. 402.

³³ The Trademark Trial and Appeal Board stated that «slogans may be ingenious, clever, catchy, trite, dull, nonsensical and the like, but to be registrable a slogan need to be a work of art». YOUSEFI D., *supra* note 4, 1358.

³⁴ For example, taking Nike's famous catchphrase "Just Do It" and creating #justdoit does not give rise to a new mark which requires protection. SHERWIN R.T., *#HaveWeReallyThoughtThisThrough?: Why Granting Trademark Protection to Hashtags is Unnecessary, Duplicative, and Downright Dangerous*, Harvard Journal of Law & Technology, Vol. 29 (2016), 456-493, 476.

³⁵ As happened, for instance, with Coca-Cola's #MakeItHappy. During the 2015 Super-Bowl, Coca-Cola asked Twitter users to reply any negative tweet they saw with the aforementioned hashtag. Their

businesses legal protection through registered trademark translates into providing them with a tool that might be used to suppress critical discussion about their products.³⁶

idea was to deal with the negativity polluting social media, by using an automatic algorithm which would have converted the letters in the tweet into a visual image made up of letters, numbers and symbol (the so-called ASCII). Despite Coca-Cola's aim, the director of the media company Gawker's editorial labs decided to repeatedly tweet lines from Adolf Hitler's autobiography (*Mein Kampf*) followed by "#MakeItHappy". As a result, images of cute animals were attached with phrases like "we must secure the existence of our people and a future for White Children". It goes without saying that Coca-Cola was forced to remove the campaign few hours later. SHERWIN R.T., *supra* note 34, 481.

³⁶ SHERWIN R.T., *supra* note 34, 493.