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US Perspectives: US Court Adds Confusion To #Trademarks

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Once, hashtags (like #cute_cat) merely identified topics on Twitter, Facebook, and other social media. No longer. A rapidly growing number of companies are using hashtags (like #HowDoYouKFC) as trademarks. There is one problem, however. A court in the US has recently ruled that hashtags can never receive trademark protection.

The 7 August decision in *Eksouzian v. Albanese* found that the hashtag at issue was not a trademark – and indicated that no hashtag could ever be a trademark. According to the federal judge who decided the case, a hashtag “is merely a functional tool” to direct online users to “the location of a promotion so that it is viewed by a group of consumers.” Thus, Magistrate Judge Margaret A. Nagle concluded, “hashtags are merely descriptive devices, not trademarks.”

Many trademark law experts do not agree with this analysis. Nor does the US Patent and Trademark Office. As of 16 September, the USPTO had granted 175 trademark registrations to hashtags, with over a thousand more in the application process.

Registered hashtag marks include Mucinex’s #BlameMucus, Glade’s #BestFeelings, Vanity Fair’s #VFSocialClub, and Volvo’s #SwedeSpeak. Many other major companies – including Coca Cola, Lexis Nexis, Abercrombie & Fitch, PNC bank, and Walmart – have registered and/or are seeking to register hashtag marks.

The USPTO’s stance doesn’t surprise most experts in trademark law. “Can a hashtag be a trademark? Yes, when it satisfies the requirements of a trademark – when it is used in commerce to distinguish the trademark owner’s goods or services from another’s,” said David J. Steele, a partner in the Los Angeles law firm of Tucker Ellis and an adjunct professor of law at Loyola Law School.

“The Supreme Court has ruled that the trademark statute is written very broadly, that even a color can be protected as a trademark,” he added. “Just because someone puts a hashtag in front of a mark, that doesn’t mean it can’t be a trademark.”

Whether or not a hashtag can receive trademark protection depends on how the hashtag is used, explained David M. Kohane, a partner in the New Jersey office of law firm Cole Scholtz. “If a hashtag is being used only as an identifier for a particular online conversation or thread, it would not obtain trademark protection,” he said. But the hashtag could be registered if “it is being used as an identifier for products or services.”

The situation is analogous to domain names, which also serve a functional purpose. Such functional use does not prohibit domain names from ever achieving trademark protection. “Amazon.com is a trademark,” Steele noted. “If a term is being used as a trademark, it is a trademark.”

Hashtag marks are also analogous to phone numbers, which serve a functional purpose. “If a phone number is being used as means of identifying a source of goods or services, it can be registered” Kohane said. He added, “1-800-mattress may be the best known phone number that was registered.”

A Key Issue

For companies seeking to register hashtag marks, a key stumbling block is use in commerce. To be registered in the US, a mark must be used in connection with the sale of specific goods or services. This can be a problem for hashtag marks, because goods and services are not usually sold on social media.

“For the Trademark Office to find that a mark is used in commerce, the Office wants the mark to be used in close proximity to the point of sale. The Office wants to see it used on or in connection with a good or service,” said Steele.

One clear way a company can satisfy this requirement is to use the hashtag mark in the real world. “The slam dunk cases are offline use, such as putting the hashtag on goods in stores,” said Prof. Alexandra Roberts of University of New Hampshire School of Law. One example is #Tanlife brand suntan lotion, whose bottles prominently display the hashtag mark. #Tanlife.

Use in cyberspace can sometimes suffice to prove use in commerce. If the hashtag mark “is used where goods are offered for sale online, such as on the company’s web page, that’s usually enough to show use in commerce,” Roberts said.

If a hashtag mark is used only on social media, proving use in commerce is more problematic, but it is not impossible. If the hashtag is used merely as a slogan or social media push that provides positive PR for a company, that is not enough to satisfy the use in commerce requirement, according to Steele. But if the hashtag is part of a positive PR campaign about a company’s products or services, that can be a use in commerce.

One example is #steakworthy, a registered mark of restaurant Logan’s Roadhouse. As part of its application for registration, Logan’s proved use in commerce by providing a copy of this Facebook post, which used #steakworthy as part of a pitch for the restaurant’s services. Other instances where the USPTO found social media use constituted uses in commerce include #Hollywood Trends (YouTube), #RembrandtCharms (Facebook and Twitter), and #LikeAGirl (Twitter).

Not Worth Registering

Even if a company can register a hashtag mark, it should think carefully before it does so. “If you already have a trademark, it is redundant to register #trademark. That grants no new rights,” said Roberts.

The life of hashtags is often fleeting, as trending topics change rapidly. So a hashtag is worth registering only if a company intends to use that hashtag over the long term. “If you only use it for six months, by the time you get the trademark registration, the PR campaign will be over,” said Roberts.

Registration does not, of course, give a hashtag mark’s owner a complete monopoly on the term. The usual limits of trademark law still apply. Steele notes, for instance, that if a hashtag mark is descriptive (e.g., #crunchy), non-owners of the mark can still use the term to describe their own goods/services (e.g., their goods can be described as #crunchy), even if this creates some likelihood of consumer confusion.

Moreover, non-owners of the hashtag mark can make nominative fair use of the mark. In other words, non-owners can use the mark to discuss whether they like or dislike the goods/services associated with the mark; to say they provide parts, repairs or other services for goods/services associated with the mark; and to compare their own goods/services with the goods/services associated with the mark.

None of this has discouraged companies large and small from seeking trademark protection for hashtags. The *Eksouzian* decision casts doubt on the validity of these registrations, but many legal experts disagree with that ruling, adding that it is just one ruling from one court. Cases involving hashtag marks are just starting to reach the courts. Other judicial decisions will follow.

Eksouzian is only the first US case on hashtag marks. It is unlikely to be the last.

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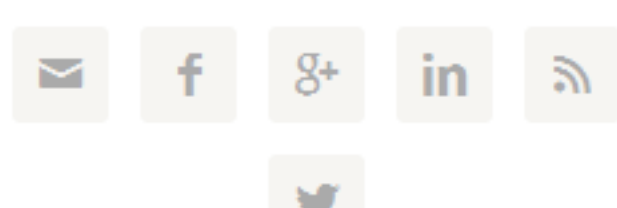
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