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#PROTECTED: HASHTAGS, TRADEMARKS, AND THE FIRST AMENDMENT

*Delaram Yousefi**

When it comes to hashtags, both the justice and trademark systems have failed to keep up with technology. More and more people are using hashtags on social media because they can receive immediate gratification when they are connected with a desired product or service by using and following hashtags. Yet a commercial business has little or no control over the use, and sometimes abuse, of its brand. This paper aims to create an innovative solution for an imperfect system. It addresses various ways hashtags can be examined and evaluated by the courts and the USPTO to better determine whether a trademark should be issued or if there is trademark infringement. Additionally, this note provides guidance to those who wish to create hashtags that will survive scrutiny, in the most beneficial, resourceful, and simple way.

I. INTRODUCTION

Companies have always strived to protect their symbols, designs, appearances, and slogans through trademark protection.¹

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¹ J. Thomas McCarthy, 1 McCarthy on Trademark and Unfair Competition § 3:1 (4th ed. 2007).

Currently, social media advertisements using hashtags have proliferated.² This is because hashtag use further promotes the company's business by encouraging interactive use of the hashtag and creating an advanced exposure of the brand and products to consumers.³ The problem with this practice, however, is that *any* social media user can create a hashtag by using the hashtag symbol before *any* groups of words.⁴ Thus, while a company's main target is to create a hashtag that would identify and distinguish its company's brand, product, or service,⁵ when other users use the same hashtag containing the same words but reference other unrelated subjects, the hashtag can negatively impact the company because it no longer relates positively to that company's brand.⁶ For instance, if Banana Republic, the American clothing and accessories retailer, started using the hashtag #LookProfessionalInEveryStepYouTake to promote its merchandise and, subsequently, other social media users started using that exact hashtag to refer to anything other than Banana Republic's brand or product,⁷ then the hashtag would likely be ineffective for Banana Republic because it would no longer establish a connection with the Banana Republic brand in the consumer's mind.

For these reasons, companies want to trademark hashtags to protect their brand names. Fortunately, in late 2012, the United States Patent and Trademark Office (the "USPTO") established that hashtags may be trademark protected.⁸ However, there has been some hesitation among state and federal courts as to whether hashtags are source identifiers or if they are "merely descriptive devices."⁹ Also, the USPTO has had difficulty determining which hashtags to register.¹⁰ For instance, the USPTO may be reluctant to register a hashtag with only initials, such as #BR for the clothing company "Banana

² Tom Durby, *Why Companies Should Adopt Hashtag Marketing*, HASHTAGS.ORG (Feb. 27, 2014), <https://www.hashtags.org/how-to/marketing-how-to/why-companies-should-adopt-hashtag-marketing/>.

³ Durby, *supra* note 2.

⁴ Durby, *supra* note 2.

⁵ Durby, *supra* note 2.

⁶ Durby, *supra* note 2.

⁷ Social media users might use the Hashtag #LookProfessionalInEveryStepYouTake as caption to a personal picture (first day at work) or a picture promoting their own business.

⁸ David Kohane, *#UNDECIDED Trademark Protection for Hashtags*, IPWATCHDOG.ORG (June 24, 2016), <http://www.ipwatchdog.com/2016/06/24/undecided-trademark-protection-hashtags/id=70111/>.

⁹ Kohane, *supra* note 8.

¹⁰ Kohane, *supra* note 8.

Republic.” This is because, at first glance, one may not be able to associate “#BR” with the brand. However, by showing the hashtag with the entire Banana Republic post, the viewer will most likely be able to identify it as a connection to the company.

While there is hesitation and uncertainty in trademarking hashtags, the law and practice relating to trademarking slogans are more concrete. Thus, it is helpful to compare trademarks for hashtags to trademarks of slogans or other marks that use a descriptive word because of their similarity in function.¹¹

The purpose of this article is to establish hashtag’s similarities to and differences with slogans and to analyze the standards that a court should consider when addressing trademark issues for hashtags. The following five considerations are gleaned from cases addressing trademark protection for slogans: (1) whether the hashtag identifies and distinguishes the source of goods or service;¹² (2) the length of the hashtag and number of words used;¹³ (3) whether the words used are commonly used phrases;¹⁴ (4) whether a descriptive phrase has gained secondary meaning in reference to the goods or service;¹⁵ and (5) whether a phrase in a hashtag is incorporated with a previously existing trademark.¹⁶ These five standards as applied to hashtags will serve to strengthen the mark and simultaneously limit the applicants from overstepping their boundaries. Although they are extracted from decisions concerning slogans, they are narrowly tailored to hashtags. Each standard on its own adds value to the overall decision.

¹¹ Robert T. Sherwin, *#havewereallythoughtthisthrough?: Why Granting Trademark Protection to Hashtags Is Unnecessary, Duplicative, and Downright Dangerous*, 29 HARV. J.L. & TECH. 455, 470 (2016). Sherwin argues that hashtags should not receive trademark protection because they are used as a “grouping tool that encourages use by others [which] cuts against the notion of protecting their status as intellectual property.” Sherwin, *supra*, at 459. He recognizes that the PTO states that hashtags should receive protection when they are used as identifiers of the original source of goods or service similar to slogans. Sherwin, *supra* note 11, at 474. Thus, the author stands firmly on the ground that the protection given by the PTO further clarifies that hashtags are used to facilitate search on a topic. Sherwin, *supra*, at 474. Therefore, his main point is that a “hashtag does not change the nature of the slogan that follows; with or without the hashtag, the slogan has to serve as a distinctive brand identifier to obtain trademark protection.” Sherwin, *supra*, at 477. This note argues that hashtags are not only comparable to slogans but are a modern form of slogans which should be eligible for trademark protection.

¹² *Anheuser-Busch, Inc. v. Customer Co., Inc.*, 947 F. Supp. 422, 424 (N.D. Cal. 1996).

¹³ *In re Superba Cravats, Inc.*, 149 U.S.P.Q. (B.N.A) ¶ 852 (T.T.A.B. Apr. 11, 1966).

¹⁴ *Roux Laboratories, Inc. v. Clairol, Inc.*, 427 C.C.P.A. 1173, 1178 (1970).

¹⁵ *Norm Thompson Outfitters, Inc. v. Gen. Motors Corp.*, 448 F.2d 1293, 1298 (9th Cir. 1971).

¹⁶ *Allstate Ins. Co. v. Allstate Inc.*, 307 F. Supp. 1161, 1165 (N.D. Tex. 1969).

Additionally, when they are aggregated with the hashtag symbol then a descriptive mark is created which may become more distinctive.

Part II of this note will analyze the technical use of hashtag, its history, and how it impacts advertisement. Subsequently, Part III will broadly examine trademark and how it narrowly applies to hashtags. Part IV will compare slogans to hashtags and analyze how the five standards should apply to hashtags. Finally, Part V will focus on the First Amendment implications of trademarking hashtags.

II. HASHTAG

Hashtag's main purpose has been to facilitate searches and categorize posts on social media websites. It is now a trending technique used by countless social media users. Twitter was the first site to introduce it, and now hashtag has shaped the notion of interactive marketing. Users can get involved in the advertisement by using a hashtag and participating in challenges by posting about their experiences with the company.¹⁷ However, even though the company seeks to receive positive feedback from the general public, there are times when such consumer postings will negatively impact their brand. In such instances, the company will be left with little to no recourse to retract the posting.

A. Usage and History

The concept and use of a hashtag were established to bring together all posts regarding a certain topic into one webpage on a certain social media¹⁸ page. For instance, on Facebook an active user can post statuses, pictures, and videos with a description. If the user wishes for others to view the post, the user will create a "hashtag." In the status or description of the post, the user will first type the symbol hashtag ("#") in front of letters, commonly a word or group of words, without the usage of symbols, "spaces" or "periods," such as

¹⁷ Kashmir Hill, *FORBES*, #McDStories: When A Hashtag Becomes A Bashtag, (Jan. 24, 2012), <http://www.forbes.com/sites/kashmirhill/2012/01/24/mcdstories-when-a-hashtag-becomes-a-bashtag/#15f157c1193f>.

¹⁸ "Social media" is a term used to describe websites where users can create profile accounts and are able to share ideas, materials, or videos with others through what is called "social networking." MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/social%20media> (Jan. 17, 2017).

#BlackandWhiteOreos.¹⁹ After the description or status has been posted, depending on whether the user's post is public or private,²⁰ a "hyperlink" will be created, where other members of that specific social media account will be able to click on the hashtag hyperlink and explore other posts regarding a similar topic. As such, it will transport the user to a new page where other members have created a hashtag with the same letters, words, or numbers.

On August 23, 2007, Chris Messina posted the first status on Twitter which initiated the concept of hashtag.²¹ He wrote: "How you feel about using # (pound) for groups. As in #barcamp [msg]?" He was inspired by the similar usage of the symbol used on the Internet Relay Chat²² ("IRC") back in 1988. It was used in the IRC world to communicate and share ideas, pictures, and videos which were later used on the social media platform.²³ Thereafter, the use of hashtag began to increase as users on Twitter tried to bring awareness to events such as the wildfires that occurred in San Diego in October of 2007.²⁴ Even though the founder of Twitter did not believe that hashtag would catch on by users, a blogger by the name of Stowe Boyd posted a blog called "Hashtag = Twitter Groupings" just a few days after Chris Messina posted his status on Twitter.²⁵ He endorsed the concept in his blog by indicating that it was a proficient way to "[s]hare experience of some kind, involving all those using the tag."²⁶

¹⁹ For purposes of this note, a company's name has been used as an example. However, hashtags do not have to be related to company names. Social media users have created hashtags relating to anything including feelings, such as "#happy life."

²⁰ In the event that the member has created a post that is private, then only friends or those who the member has chosen to share with will be able to view the post.

²¹ Vanessa Doctor, *Hashtag History: When and What Started It?*, HASHTAG.ORG (May 30, 2013), www.hashtags.org/featured/hashtag-history-when-and-what-started-it/.

²² Margaret Rouse, *Internet Relay Chat (IRC)*, SEARCHEXCHANGE (Jan. 20, 2017), <http://searchexchange.techtarget.com/definition/Internet-Relay-Chat>. IRC "is a system for chatting that involves a set of rules and conventions and client/server software." Rouse, *supra*.

²³ Doctor, *supra* note 21.

²⁴ Shea Bennett, *The History of Hashtags in Social Media Marketing [INFOGRAPHIC]*, SOCIALTIMES (Sept. 2, 2014), www.adweek.com/socialtimes/history-hashtag-social-marketing/501237. Nate Ridder, who was residing near where the wildfire had occurred, used "#SanDiegoFire" to bring awareness to what was going on in San Diego, causing 300,000 people to evacuate. Bennett, *supra*.

²⁵ Stowe Boyd, *Hash Tags = Twitter Grouping*, (2008), STOWE BOYD AND THE MESSENGERS (Aug. 26, 2007), www.stoweboyd.com/post/39877198249/hash-tags-twitter-grouping.

²⁶ Boyd, *supra* note 25.

Even though it all began on Twitter, hashtag use quickly trickled down to other social media outlets. In 2013 Facebook jumped on the bandwagon and created a URL link for each unique hashtag that would organize all of the posts regarding that specific hashtag phrase.²⁷ By 2015 the use of hashtag had exploded on Instagram,²⁸ Pinterest,²⁹ Flickr, and Google+.³⁰ Through these social media outlets, hashtags are used to express awareness of events, ideas, feelings and, most importantly, they are used by businesses to market their brands.³¹ Businesses use social media to market their brands by allowing the user to engage and interact with the material that has been posted.³²

B. Interactive Social Media Marketing

The main purpose of marketing is to increase brand awareness and to promote a product or service.³³ Businesses want the public to become familiar with their brand.³⁴ This is accomplished by creating a slogan or mascot, or by describing the product or service.³⁵ Such marketing techniques have proven to be successful in the realm of social media.³⁶ In addition, the use of hashtag to market a brand, product, or service has created even more traffic on the internet³⁷ because businesses have been very creative in how they have managed to keep social media users engaged with their posts.³⁸ The business

²⁷ Bennett, *supra* note 24. For instance, a user on Facebook may search through the use of the search engine “#MomLovesDad” or can also use the URL www.facebook.com/hashtag/MomLovesDad. Both paths will bring the user to the same website.

²⁸ FAQ, INSTAGRAM (Jan. 20, 2017), www.instagram.com/about/faq (“Instagram is a fun and quirky way to share your life with friends through a series of pictures.”).

²⁹ Andy Meng, *What is Pinterest, and How Does it Work?*, INFRONTWEBWORKS (Jan. 20, 2014), www.infront.com/blogs/the-infront-blog/2014/1/20/what-is-pinterest-and-how-does-it-work (“Pinterest is a social network that allows users to visually share, and discover, new interests, by posting . . . images or videos to their own or other’s boards . . . and browsing what other users have pinned.”).

³⁰ Bennett, *supra* note 24.

³¹ Bennett, *supra* note 24.

³² Bennett, *supra* note 24.

³³ *Brand Awareness*, INVESTOPEDIA, (Jan. 20, 2017), <http://www.investopedia.com/terms/b/brandawareness.asp>.

³⁴ Brand Awareness, *supra* note 33.

³⁵ Brand Awareness, *supra* note 33.

³⁶ Brand Awareness, *supra* note 33.

³⁷ Brand Awareness, *supra* note 33.

³⁸ Michael Patterson, Tint, 7 Examples of Successful Hashtag Campaigns, (Aug. 10, 2015), <http://www.tintup.com/blog/7-examples-of-successful-hashtag-campaigns/>.

goal in using hashtag is to create one that will be attractive to, and shared by, other social media users.³⁹ If successful, the hashtag will guide users to the business's intended message by clicking on the hyperlink.⁴⁰

The hashtag campaign was launched by companies to catch social media users' attention and to involve them in the company by posting pictures or videos regarding that specific hashtag, thereby benefitting the company immensely.⁴¹ For instance, Coca Cola used the hashtag "#ShareACoke" to promote its brand in one of its marketing campaigns.⁴² On social media, it used the hashtag with a video or picture of a can or bottle of Coca Cola with a person's name on it.⁴³ Coca Cola's goal was accomplished when consumers used the hashtag to post a bottle of coke which displayed their names.⁴⁴ Sometimes, however, a hashtag benefiting a company goes viral and the company did not actively participate in the matter.⁴⁵ The #CheeriosChallenge, for example, was launched by a father who stacked up five Cheerios cereal pieces on his three-week old son's nose who was asleep on his lap.⁴⁶ He posted the picture on social media with that hashtag and within a few days it went viral.⁴⁷

There are also occasions when companies create a hashtag to bring positive awareness to their brand and it backfires by attacking or bashing their company. For example, in 2012, McDonald's launched

³⁹ Patterson, *supra* note 38.

⁴⁰ Patterson, *supra* note 38.

⁴¹ Patterson, *supra* note 38. Normally, when a company advertises using traditional means of promoting its brand, it is a one-way interaction. The consumer views the advertisement and consumes what he or she may want. In interactive advertising, however, there is a long-lasting effect on the consumer and a higher likelihood that the consumer will discuss the brand through modern form of "word-of-mouth," on social media. Therefore, there is strong likelihood of brand recognition and promotion that will essentially benefit the company.

⁴² Patterson, *supra* note 38.

⁴³ Patterson, *supra* note 38.

⁴⁴ Patterson, *supra* note 38.

⁴⁵ Saeed Ahmed, CNN, Dads Compete to stack Cheerios on Babies' Heads Because . . . Dads (June 19, 2016), <http://www.cnn.com/2016/06/18/health/dads-fathers-day-cheerio-challenge-trnd/>.

⁴⁶ Patterson, *supra* note 38.

⁴⁷ Patterson, *supra* note 38. It may be obvious why Cheerios never took any legal action against the social media users who incorporated the Cheerios brand in their hashtags: Cheerios received positive brand recognition without spending a dime. It was basically free advertisement. If Cheerios had, for some foolish reason, sued these social media users, it would not have been successful based on the fact that the hashtags and the posts were identifying the Cheerios brand. Therefore, if this had been considered trademark infringement, it would have violated the First Amendment. See *infra* Part V.

its own campaign by creating the hashtag #McDStories so that Twitter users would be able to tell their positive experiences regarding their Happy Meal.⁴⁸ Unfortunately, it took an unintended, far less desirable turn when Twitter users began posting their horrible experiences at the fast food restaurant.⁴⁹ Although McDonald's took down the campaign which was promoted on Twitter's homepage, users continued to post their bashing statuses and even created their own hashtag called #McDHorrorStories.⁵⁰ As McDonald's learned from this experience, it is virtually impossible to control what users will post in connection to hashtag. Thus, companies tend to contact the user, either through private message or by commenting on the actual post, and apologize for the user's bad experience, offering something in the hope that the user will remove the post.

C. Impact on Advertisement

As the internet has become an integral aspect of everyday life, it is easy to see how it has revolutionized the advertising market.⁵¹ Advertisements are prevalent on websites such as social media outlets.⁵² These social media advertisements are displayed in many different forms. More commonly, a company may advertise its product or service on the sidelines of a website or merge it among the texts of the page.⁵³ Even though these ads may appear to be stale, users have the ability to like, share, and tag others whom they believe will also enjoy the advertisement.⁵⁴ Companies have realized that the best way to promote their brand, product, or service is by having social media users interact with their ads.⁵⁵ When users notices family,

⁴⁸ Hill, *supra* note 17.

⁴⁹ Hill, *supra* note 17. 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."

⁵⁰ Hill, *supra* note 17.

⁵¹ Durby, *supra* note 2.

⁵² Durby, *supra* note 2.

⁵³ Sonny Ganguly, *Why Social Media Advertising Is Set To Explode In The Next 3 Years*, MARKETINGLAND (March 17, 2015), <http://marketingland.com/social-media-advertising-set-explode-next-3-years-121691>. Instagram, an APP used primarily on smartphones, places together photos and videos posted by followers onto the user's home screen. Among these posts, companies are able to advertise by also using a picture or video concerning their product or service. Elise Moreau, *What is Instagram, Anyway?*, LIFEWIRE (Dec. 21, 2016), <https://www.lifewire.com/what-is-instagram-3486316>.

⁵⁴ Ganguly, *supra* note 53.

⁵⁵ Ganguly, *supra* note 53.

friends, or colleagues have somehow reacted to a certain ad, they are more inclined to also engage in it.⁵⁶ Recently, companies have engaged in a new practice where they have ordinary, everyday people video themselves using and assessing the product.⁵⁷ This type of advertisement is more likely to attract customers when the product needs demonstration.

All of these forms of social media advertisements have certainly expanded the audience for advertisements.⁵⁸ However, companies have taken it a step further by using hashtags in the description of their ad.⁵⁹ After a potential customer has viewed or watched the advertisement, the company offers that person the opportunity to discover and investigate more about the post, product, or brand by clicking on the hashtag hyperlink.⁶⁰ This action will further promote the company and the user will become more familiar with it.⁶¹ The company's main goal is to create a hashtag hyperlink solely to gather positive posts regarding its brand.⁶² Thus, companies will spend time, energy, and money creating a unique hashtag that will be easily associated with their brands and not be confused with other companies.⁶³ Therefore, these companies have the right to register their hashtag as a trademark as if it were a slogan associated with the company.⁶⁴

⁵⁶ Ganguly, *supra* note 53. On Facebook, when the advertisement appears on the user's newsfeed, the top section of the advertisement will indicate the names of those friends who have liked the advertisement. There were lawsuits regarding this issue. Jeff Roberts, *Facebook hit with lawsuit over "Like" ads – user says he never "Liked" USA Today*, GIGAOM (Jan 10, 2014), <https://gigaom.com/2014/01/10/facebook-hit-with-lawsuit-over-like-ads-user-says-he-never-liked-usa-today/>.

⁵⁷ Ganguly, *supra* note 53. A company by the name of Elizavecca sells a product called "Milky Piggy Carbonated Bubble Clay Mask." It has created videos, advertised on Facebook, where a young woman applies the product onto her face and after a few minutes the product starts to bubble. Throughout the entire video, the woman narrates the step by step process, how it makes her skin feel and shows the end result. GOOD HEALTH ACADEMY, *Carbonated Bubble Clay Mask – Benefits and Review* (Jan. 20, 2017), <http://www.goodhealthacademy.com/beauty-tips/carbonated-bubble-clay-mask/>.

⁵⁸ Durby, *supra* note 2.

⁵⁹ Durby, *supra* note 2.

⁶⁰ Durby, *supra* note 2.

⁶¹ Durby, *supra* note 2.

⁶² Durby, *supra* note 2.

⁶³ Durby, *supra* note 2.

⁶⁴ Durby, *supra* note 2.

III. TRADEMARK LAW

A. Trademarks, Generally

The Lanham Act⁶⁵ defines trademark as “any word, name, symbol or device, or any combination thereof.”⁶⁶ The purpose of trademark protection is to shield both the consumer and the business owner (trademark holder) from a “vigorously competitive market.”⁶⁷ Consumers are protected from confusing and deceitful source identifications,⁶⁸ while the trademark holder can preserve its own interest in the business created and nurtured under its trademark.⁶⁹ Towards this end, the trademark holder has the right to exclude others from using the trademark without authorization.⁷⁰ Trademark protection is granted for the mark’s distinctiveness which is either inherently obvious or obtained by secondary meaning.⁷¹ Inherently distinctive marks “are irrefutably presumed to have achieved customer recognition as a symbol of origin immediately upon first use as a mark.”⁷² “Distinctiveness” essentially means that the trademark associated with the goods or services is capable of setting itself apart from other goods or services.⁷³

B. Categorization of Marks

There are four categories in which marks are classified to determine the degree of distinctiveness in ascending order of receiving protection: (1) generic; (2) descriptive; (3) suggestive; and (4) arbitrary or fanciful.⁷⁴ In the spectrum of distinctiveness, utmost protection is given to arbitrary or fanciful marks, while there is no protection for

⁶⁵ Lanham Act § 45; 15 U.S.C. § 1127 (2010).

⁶⁶ *Id.*

⁶⁷ *Christian Louboutin S.A. v. Yves Saint Laurent America Holdings, Inc.*, 696 F.3d 206, 216 (2d Cir. 2012).

⁶⁸ *Id.* at 215.

⁶⁹ *Id.*

⁷⁰ *Id.*

⁷¹ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 769 (1992). “The general rule regarding distinctiveness is clear: an identifying mark is distinctive and capable of being protected if it either (1) is inherently distinctive or (2) has acquired distinctiveness through secondary meaning.” *Id.*

⁷² McCarthy, *supra* note 1, at § 11:4.

⁷³ McCarthy, *supra* note 1, at § 11:2.

⁷⁴ McCarthy, *supra* note 1, at § 11:2.

generic marks.⁷⁵ Suggestive, arbitrary and fanciful terms fall into the inherently distinctive category and, as a result, do not require any further proof of distinctiveness.⁷⁶ On the other hand, descriptive marks require secondary meaning and generic terms do not receive trademark protection.⁷⁷ In addition to the mark's distinctiveness, the strength of the mark in the market place is equally important.⁷⁸ This determination "ascertain[s] its degree of recognition in the minds of the relevant customer class."⁷⁹ In other words, a mark that falls within the lowest degree of distinctiveness may not be recognizable or a source identifier in the customer's mind.⁸⁰

1. *Generic*

A generic term is "one that refers, or has come to be understood as referring, to the genus of which the particular product is a species."⁸¹ Generic marks will never obtain trademark protection because they are common names used to identify a particular product or service and these terms are not necessary to be competitive in the market.⁸² For instance, the term "pants" or "shirts" are generic terms because they are the common terms to identify these products. Banana Republic would be unable to receive trademark protection over these words. Thus, unlike descriptive terms, generic marks do not receive trademark protection, even with the proof of secondary meaning.⁸³

2. *Descriptive*

Descriptive marks are marks that are simply descriptive of a product or service.⁸⁴ Descriptive marks are not inherently distinctive and, therefore, require secondary meaning.⁸⁵ These marks are rights given to the public as a whole and all competitive businesses have the

⁷⁵ McCarthy, *supra* note 1, at § 11:2.

⁷⁶ McCarthy, *supra* note 1, at § 11:4.

⁷⁷ McCarthy, *supra* note 1, at § 11:4.

⁷⁸ McCarthy, *supra* note 1, at § 11:2.

⁷⁹ McCarthy, *supra* note 1, at § 11:2.

⁸⁰ McCarthy, *supra* note 1, at § 11:2.

⁸¹ Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 9 (2d Cir. 1976).

⁸² *Id.* at 11.

⁸³ *Id.*

⁸⁴ Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763, 769 (1992).

⁸⁵ *Id.*

right to use these terms as informational descriptions of their goods and services to consumers.⁸⁶ Secondary meaning determination occurs when an ordinary meaning of a word obtains trademark protection through extensive use of the term for a period of time with a specific product or service, thereby causing consumers to associate the term with that particular product or service.⁸⁷ The plaintiff has the burden to establish that, in the mind of the consumer, the term is associated with the source rather than the product directly.⁸⁸ The following eleven factors are considered by the courts in determining whether a mark has secondary meaning:

(1) the extent of sales and advertising leading to buyer association; (2) length of use; (3) exclusivity of use; (4) the fact of copying; (5) customer surveys; (6) customer testimony; (7) the use of the mark in trade journals; (8) the size of the company; (9) the number of sales; (10) the number of customers; and (11) actual confusion.⁸⁹

Thus, courts have struggled with giving descriptive words trademark protection to ensure that the trademark owner does not receive a monopoly over a common descriptive word.⁹⁰

3. *Suggestive*

Unlike descriptive marks, a mark is suggestive when it merely suggests the product or service.⁹¹ Suggestive marks fall between arbitrary and descriptive marks on the spectrum and it has become difficult to draw a distinction between them.⁹² Suggestive marks are classified as inherently distinctive and do not require secondary meaning.⁹³ “A term is suggestive if it requires imagination, thought and perception to reach a conclusion as to the nature of goods.”⁹⁴ The following two examples will further illustrate what constitutes a

⁸⁶ McCarthy, *supra* note 1, at § 11:15.

⁸⁷ Kellogg Co. v. Natl. Biscuit Co., 305 U.S. 111, 120 (1938).

⁸⁸ *Id.*

⁸⁹ Commerce Nat. Ins. Services, Inc. v. Commerce Ins. Agency, Inc., 214 F.3d 432, 438 (3d Cir. 2000).

⁹⁰ Abercrombie & Fitch Co. v. Hunting World, Inc., 537 F.2d 4, 12 (2d Cir. 1976).

⁹¹ McCarthy, *supra* note 1, at § 11:62.

⁹² McCarthy, *supra* note 1, at § 11:62.

⁹³ McCarthy, *supra* note 1, at § 11:62.

⁹⁴ Abercrombie & Fitch Co., 537 F.2d at 9.

suggestive mark: the “Florida Tan” brand refers to suntan lotion products and “POM” is the brand name for the company that produces and sales pomegranate juice.⁹⁵ A consumer will be able to make the “suggestive” connection between the brand name and the product.

4. *Arbitrary or Fanciful*

Arbitrary and fanciful marks, like suggestive marks, are categorized as inherently distinctive marks.⁹⁶ An arbitrary mark fails to describe or suggest the goods or services in any way.⁹⁷ The ordinary meaning attached to these words do not suggest anything relating to the goods or services that accompany the arbitrary mark; rather, they are used in a non-descriptive form.⁹⁸ The most well-known example of an arbitrary mark is the “APPLE” mark for consumer electronics, computer software, and online services.⁹⁹ This technology company used a common word as its brand as it did not describe or suggest anything about its product.¹⁰⁰ Therefore, common words may receive trademark protection when they are used in an arbitrary manner.¹⁰¹

Fanciful marks are those that have been created for the simple purpose of serving as a trademark.¹⁰² Brands that are fanciful marks include: EXXON, KODAK, POLAROID, and CLOROX.¹⁰³ These names have no meaning attached to them; however, companies created them to better distinguish their brand from competing marks.¹⁰⁴ Even though both arbitrary and fanciful marks are placed in the highest section of the distinctiveness spectrum, a court, in an infringement action, also considers the mark’s “strength” through the consumer recognition test in the marketplace.¹⁰⁵ Companies are capable of achieving both distinctiveness and strength of the mark by advertising and promoting the arbitrary or fanciful mark.¹⁰⁶

⁹⁵ McCarthy, *supra* note 1, at § 11:72.

⁹⁶ McCarthy, *supra* note 1, at § 11:4.

⁹⁷ McCarthy, *supra* note 1, at § 11:11.

⁹⁸ McCarthy, *supra* note 1, at § 11:11.

⁹⁹ McCarthy, *supra* note 1, at § 11:11.

¹⁰⁰ McCarthy, *supra* note 1, at § 11:11.

¹⁰¹ McCarthy, *supra* note 1, at § 11:11.

¹⁰² McCarthy, *supra* note 1, at § 11:4. Fanciful terms are also known as “coined terms.”

¹⁰³ McCarthy, *supra* note 1, at § 11:8.

¹⁰⁴ McCarthy, *supra* note 1, at § 11:83.

¹⁰⁵ McCarthy, *supra* note 1, at § 11:6.

¹⁰⁶ McCarthy, *supra* note 1, at § 11:6.

C. Registering Hashtags with the USPTO

There are a few obvious reasons why a business or company would want to register its hashtag, such as establishing solid brand recognition through social media.¹⁰⁷ By registering the hashtag, the owner would have the exclusive right to that specific hashtag for the designated product or service across the country and establish a greater protection in foreign trademark registrations.¹⁰⁸ Additionally, after five years, the owner would be eligible for incontestability status over the hashtag mark, which eliminates most challenges or defenses.¹⁰⁹ However, there are some less desirable aspects of the process, such as the fact that registration may take six to eight months.¹¹⁰ Thus, the applicant would have to limit its registration of hashtag marks to those that have permanent or lasting impact.¹¹¹ Still, companies may choose to use a mark that is not registered to gain secondary meaning.¹¹²

In determining whether the hashtag mark functions as a trademark, consideration must be given to the entirety of the context.¹¹³ In October of 2013, the USPTO altered its Trade Mark of Examining Procedure (the “TMEP”) and added section 1202.18 to clarify when a hashtag is registrable as a trademark or service mark.¹¹⁴ The first consideration is the placement of the hashtag, and whether it is used for the purposes of the pound or number symbol.¹¹⁵ If the hashtag is used for such purposes, it would not be considered registrable because it is not incorporated to “facilitate categorization and searching within online social media.”¹¹⁶ This section also makes clear that a mark that is not registrable on its own will not be rendered registrable by simply adding the hashtag symbol to the word.¹¹⁷ Thus, the addition of a descriptive or generic word would make the entirety of the mark not registrable.¹¹⁸

¹⁰⁷ *Should I register my mark*, USPTO.GOV (March 6, 2017), <https://www.uspto.gov/trademarks/basics/register.jsp>.

¹⁰⁸ *Should I register my mark*, *supra* note 107.

¹⁰⁹ *Should I register my mark*, *supra* note 107.

¹¹⁰ *Should I register my mark*, *supra* note 107.

¹¹¹ *Should I register my mark*, *supra* note 107.

¹¹² McCarthy, *supra* note 1, at § 27:18.

¹¹³ USPTO, TMEP § 1202.18 (Apr. 2016).

¹¹⁴ *Id.*

¹¹⁵ *Id.*

¹¹⁶ *Id.*

¹¹⁷ *Id.*

¹¹⁸ USPTO, TMEP § 1202.18 (Apr. 2016).

Hashtag marks, containing arbitrary or suggestive words, must still be established as a form of source indicator for the goods or services.¹¹⁹

If the specimen shows the hash symbol or the term HASHTAG in a proposed mark as merely a tag used to reference or organize keywords or topics of information to facilitate searching a topic, the relevant public will not view the hash symbol or the term HASHTAG in the mark as identifying the source of the goods or services.¹²⁰

The USPTO aims to validate what has been recognized and established in the trademark world from the start.¹²¹ It distinguishes between a mark that is a source identifier of the goods or services, rather than a mark that facilitates searching a topic.¹²² Furthermore, section 1202.18(a) addresses “Disclaiming the Hashtag or Hash Symbol” when the applicant seeks to register the mark, providing that, when the hashtag is placed together with words that are distinctive, then the hashtag symbol needs to be disclaimed.¹²³ The disclaimer essentially indicates that the applicant is seeking to receive trademark protection over the words attached to the hashtag, but not the hashtag itself.¹²⁴

Examining certain hashtags that the USPTO has both registered, and denied registration to, provides a better understanding as to what might qualify for registration.¹²⁵ For instance, #HowDoYouKFC was registered by the fast food restaurant chain and the phrase was also utilized on billboards, signs, and other similar tangible forms of advertisements as a form of a source identifier.¹²⁶ However, the TMEP states that #Skater in reference to skateboarding equipment would not be registrable because it is a descriptive word for the product.¹²⁷ One might argue that “KFC” is incorporated within the hashtag and is, therefore, distinguishable from the “skater” hashtag because it is a source identifier but, this is not always the case. For

¹¹⁹ *Id.*

¹²⁰ *Id.*

¹²¹ *Id.*

¹²² *Id.*

¹²³ USPTO, TMEP § 1202.18 (Apr. 2016).

¹²⁴ *Id.*

¹²⁵ Kohane, *supra* note 8.

¹²⁶ Kohane, *supra* note 8.

¹²⁷ USPTO, TMEP § 1202.18 (Apr. 2016).

example, the USPTO has approved registration for hashtags such as #KickHunger or #LikeAGirl with a “real-life sample,” or “specimen,” by providing the screenshot of the social media page.¹²⁸ Hence, the USPTO issues specimen refusal when the applicant has failed to show the way the mark will be used in the marketplace.¹²⁹

Unfortunately, the USPTO has failed to take a stand on the extent to which hashtag marks should be trademark protected,¹³⁰ and has not given clear guidance as to what is considered an “acceptable specimen.”¹³¹ Consequently, the USPTO has subjected the courts to a floodgate of legal issues regarding hashtags and their trademark status. Thus, the USPTO should tackle this matter to guide courts into making consistent decisions. In order to create that path, this note compares the unresolved hashtag issue to the more established law and procedures for slogans.

IV. SLOGANS V. HASHTAGS

A. Slogans Generally

The *McCarthy* treatise defines a slogan as a group of words or catch phrases used to distinguish the seller’s goods or services from other competitive companies.¹³² It is “an advertising which accompanies other marks such as house marks and product line marks.”¹³³ The Trademark Trial and Appeal Board has stated that “[s]logans may be ingenious, clever, catchy, trite, dull, nonsensical and the like, but to be registrable a slogan need not be a work of art.”¹³⁴ Furthermore, when a slogan has been used and circulated in the general public for a long period of time, it is extremely unlikely that it will later receive trademark protection for another good or service.¹³⁵

¹²⁸ Aaron Ruben, *#Trademarks?: Hashtags as Trademarks Revisited*, SOCIALLYAWARE, (July 18, 2016), <http://www.sociallyawareblog.com/2016/07/18/trademarks-hashtags-as-trademarks-revisited/>. #KickHunger was established to fight against and promote awareness for those struggling with hunger. Ruben, *supra*. #LikeAGirl provides information to encourage women and fight against anti-gender discriminations. Ruben, *supra*.

¹²⁹ Ruben, *supra* note 128.

¹³⁰ Kohane, *supra* note 8.

¹³¹ Ruben, *supra* note 128.

¹³² McCarthy, *supra* note 1, at § 7:20.

¹³³ McCarthy, *supra* note 1, at § 7:19.

¹³⁴ In re National Training Center of Lie Detection, Inc., 226 U.S.P.Q. (BNA) 798, 800 (Trademark Trial & App. Bd. 1985).

¹³⁵ 1 Pat. L. Fundamentals § 5:43 (2d ed. 2017).

Slogans are not created with the initial intention of becoming trademark protected.¹³⁶ Thus, companies and advertising agencies are faced with the struggle of obtaining trademark protection for them.¹³⁷ The Lanham Act effectively gives slogans the same protection as brand names or other marks, and it only considers a slogan in its entirety.¹³⁸ Therefore, courts need to consider whether a registered mark that is part of the slogan will affect the registration process.¹³⁹ The underlying consideration is the customer's tendency to recognize the slogan in regard to the brand mark.¹⁴⁰ The court's main objective is to establish whether the slogan is generic, descriptive, fanciful or arbitrary.¹⁴¹ Generic slogans are uncommon because companies want to create an original and catchy slogan.¹⁴² Likewise, since slogans are created so that consumers would be better able to identify the particular goods or service, the use of fanciful or arbitrary words would not further that purpose.¹⁴³ To be precise, it is believed that a slogan with arbitrary or fanciful terms would be more confusing and not relate to the brand in the customer's mind.¹⁴⁴ Thus, trademarked slogans are more likely to be descriptive.¹⁴⁵ Next, courts determine whether the slogan has acquired secondary meaning.¹⁴⁶

B. Slogans and Hashtags

Hashtags and slogans ultimately have the same purpose because both are meant to serve as a link to the particular goods or services. One can even say that hashtags are the contemporary form of slogans in the digital world. Thus, as the digital world has evolved, the corresponding law should develop with it. Hashtags have not yet established a strong legal root and courts have not yet clearly identified how hashtags should be analyzed. Therefore, this note proposes the

¹³⁶ Evynne Grover, *The Trademark Protection of Advertising Slogans: A Modern Perspective*, 1 FORDHAM ENT. MEDIA & INTELL. PROP. L.F. 213, 214 (1991).

¹³⁷ PATENT LAW FUNDAMENTALS, *supra* note 135.

¹³⁸ PATENT LAW FUNDAMENTALS, *supra* note 135.

¹³⁹ Grover, *supra* note 136, at 217.

¹⁴⁰ Grover, *supra* note 136, at 217.

¹⁴¹ Grover, *supra* note 136, at 217.

¹⁴² Grover, *supra* note 136, at 228.

¹⁴³ Grover, *supra* note 136, at 216.

¹⁴⁴ Grover, *supra* note 136, at 217.

¹⁴⁵ See *supra* Part III.B.2.

¹⁴⁶ Grover, *supra* note 136, at 216.

following five standards to guide the courts in determining whether a particular hashtag should receive trademark protection. First, and prior to discussing the five standards, there are two significant distinctions that need to be made between slogans and hashtags.

1. Distinctions

a. Mark in Isolation

Courts have held that even if a brand name by itself contains a secondary meaning, it does not constitute a trademark slogan.¹⁴⁷ However, this view does not hold true for hashtags because hashtags containing only the brand name may receive trademark protection, even though they do not satisfy this slogan requirement.¹⁴⁸ In *Hugo Boss Fashions, Inc. v. Fed. Ins. Co.*,¹⁴⁹ Hugo Boss Germany and USA (“HB”) and Boss Manufacturing Company (“BMC”)¹⁵⁰ signed a Concurrent Use Agreement¹⁵¹ to prevent the parties from infringing the other’s trademarks.¹⁵² Seven years later, HB started selling gloves and boots displaying the term “BOSS.”¹⁵³ BMC sued HB, and HB informed its insurance company, the defendant, to defend the suit and make any indemnity payments.¹⁵⁴ Defendant refused to do so based on several assertions, one of which was that the word “BOSS” did not constitute a “slogan” within the meaning of the policy¹⁵⁵ and did not fall within the intellectual property exclusion in the policy.¹⁵⁶ The

¹⁴⁷ *Hugo Boss Fashion, Inc. v. Fed. Ins. Co.*, 252 F.3d 608, 625 (2d Cir. 2001).

¹⁴⁸ *See infra* Part III.C.

¹⁴⁹ *Hugo Boss Fashion, Inc.*, 252 F.3d at 608.

¹⁵⁰ The plaintiff’s company in the United States, “Hugo Boss USA,” is a subsidiary of a company established in Germany (Hugo Boss Germany). *Id.* at 611. It manufactures and sells expensive men clothing merchandise. *Id.*

¹⁵¹ When plaintiff began its marketing campaign in the U.S., another company by the name of “Boss Manufacturing Company” believed that Hugo Boss USA would start infringing on its trademarks. *Id.* Both companies entered into a Concurrent Use Agreement which stated that “HB Germany agreed not to sell or license others to sell gloves, mittens or boots with a mark that incorporated the word BOSS.” *Id.*

¹⁵² *Id.*

¹⁵³ *Id.*

¹⁵⁴ *Id.* at 612.

¹⁵⁵ Defendant stated that a slogan is “a phrase with a secondary or a distinctive meaning, and BOSS did not constitute a phrase.” *Id.* at 613.

¹⁵⁶ *Hugo Boss Fashion, Inc.*, 252 F.3d at 613. The intellectual property exclusion for injury in the policy stated that injury “arising solely out of . . . infringement of . . . trademarked or service marked titles or slogans.” *Id.* at 616. The plaintiff claimed that a trademarked slogan

Second Circuit court held that “BOSS” is not considered a trademark slogan because it is not a word or phrase “used to promote particular products or product lines.”¹⁵⁷

The court cited to a Fourth Circuit case which stated that trademark slogans are reminders to the consumer of the brand.¹⁵⁸ However, the court added that it must be “something other than the house mark or product mark itself that provides such a reminder.”¹⁵⁹ Unlike slogans that could stand alone, hashtags are accompanied by either a status, picture or video.¹⁶⁰ Even if the hashtag contains only the brand name, it refers to the attached content.¹⁶¹ Additionally, when consumers utilize the hyperlink, the new webpage reminds consumers of other products or services that are associated with the brand.¹⁶² Thus, hashtags may only incorporate the brand and it may be registrable under the USPTO. Additionally, it also reminds the consumer of the brand as related to its product or service.

b. Disclaimers and Unitary Marks

This section discusses portions of the mark that are not registrable: disclaimers and unitary marks.¹⁶³ A disclaimer is a declaration made by the applicant specifically indicating no claim of exclusive rights to the words or symbols.¹⁶⁴ Portions of a mark that include the following words or designs require a disclaimer: merely descriptive; laudatory words; generic; geographic; business type designations; informational; well-known symbols; or descriptive or non-descriptive.¹⁶⁵ Such words or designs need to be disclaimed because they describe the good or service or its origin, create a claim of “superior quality,” or include symbols used in social, political or

is a trademark that “conveys messages regarding characteristics of [a] product to the consumer.” *Id.*

¹⁵⁷ *Id.* at 620.

¹⁵⁸ *Id.* at 619, citing to *Advanced Res. Int’l, Inc. v. Tri-Star Petroleum Co.*, 4 F.3d 327, 334 (4th Cir. 1993).

¹⁵⁹ *Id.*

¹⁶⁰ See *infra* Part II.A.

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ *How to Satisfy a Disclaimer Requirement*, USPTO (March 3, 2017), <https://www.uspto.gov/trademark/laws-regulations/how-satisfy-disclaimer-requirement>.

¹⁶⁴ *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

¹⁶⁵ *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

religious matters.¹⁶⁶ As a result, they are not registrable because other people and businesses will need the words or designs to describe and promote their own products and services.¹⁶⁷

The USPTO further expands on this view by identifying other types of words or phrases that cannot be registered and must be disclaimed by the applicant.¹⁶⁸ These include compressed compound wording, foreign words, and unitary marks.¹⁶⁹ Unitary marks are words that are “so merged together that they cannot be regarded as separate elements” and as a result are considered as the same trademark.¹⁷⁰ Such words cannot be disclaimed separately and apart from one another; however, an applicant may instead be required to disclaim the entire unitary phrase.¹⁷¹ For instance, the USPTO explained that, if a “Pete’s Pizza Parlor” mark is used by a restaurant, then “Pizza Parlor” would be considered a unitary phrase and would need to be disclaimed together.¹⁷² The TMEP identified the following factors to consider when determining whether a phrase is a unitary mark: “whether it is physically connected by lines or other design features; the relative location of the respective elements; and the meaning of the terminology as used on or in connection with the goods or services.”¹⁷³

TMEP section 1202.18 states that unlike slogans hashtag marks consisting of distinctive words do not require a disclaimer, as long as they are utilized as source identifiers.

When a mark containing the hash symbol or the term HASHTAG is unitary with other arbitrary or suggestive wording in the mark (e.g., #SLUGGERTIME for clothing, #DADCHAT for counseling services, and HASHTAGWALKING for entertainment services), no descriptive or generic refusal or disclaimer is required. However, such marks must still be evaluated to ensure

¹⁶⁶ *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

¹⁶⁷ *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

¹⁶⁸ *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

¹⁶⁹ *How to Satisfy a Disclaimer Requirement*, *supra* note 163. This note focuses solely on unitary marks.

¹⁷⁰ McCarthy, *supra* note 1, § 19:66.

¹⁷¹ McCarthy, *supra* note 1, § 19:66.

¹⁷² *How to Satisfy a Disclaimer Requirement*, *supra* note 163.

¹⁷³ USPTO, TMEP § 1213.05 (Apr. 2016).

that they function as source indicators for the goods or services.¹⁷⁴

In *Eksouzian v. Albanese*,¹⁷⁵ plaintiff and defendant were business partners who parted ways and, as a result, entered into a settlement agreement.¹⁷⁶ The settlement agreement prohibited the competing parties from using the unitary term “Cloud Pen” and any other type of connections between “Cloud” and “Pen” or “Penz.”¹⁷⁷ The court held that hashtags are “merely descriptive devices, not trademarks, unitary or otherwise” and they are “merely a functional tool.”¹⁷⁸ Therefore, when the plaintiff used #Cloudpen, the court held that there was no material breach of their settlement agreement as there was no infringement.¹⁷⁹ This holding has been largely criticized by commentators because it suggests that hashtags are incapable of serving as source identifiers.¹⁸⁰ The court’s argument fails to recognize the continued trademark registration of certain hashtags by the USPTO.¹⁸¹

2. Suggested Hashtag Standards

The above distinction sets the stage for using the following five standards to determine whether a hashtag should be registered. These five standards are currently used to determine whether slogans can be registered and should be used to determine whether hashtags can be registered: whether it identifies and distinguishes; its length; whether it utilizes commonly-used phrases; whether it is a distinctive phrase that acquired a secondary meaning; and whether it incorporates a previously existing trademark.

¹⁷⁴ USPTO, TMEP § 1202.18(a) (Apr. 2016).

¹⁷⁵ *Eksouzian v. Albanese*, CV 13-00728-PSG-MAN, 2015 W.L. 4720478, at *1 (C.D. Cal. Aug. 7, 2015).

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

¹⁷⁸ *Id.* at *8.

¹⁷⁹ *Id.*

¹⁸⁰ Carrie L. Kiedrowski & Charlotte K. Murphy, Are Hashtags Capable of Trademark Protection U.S. Law?, INTABULLETIN (Feb. 1, 2016), <http://www.inta.org/INTABulletin/Pages/AreHashtagsCapableofTMProtectionunderUSLaw.aspx>.

¹⁸¹ Kiedrowski & Murphy, *supra* note 180.

a. Identify and Distinguish

First, the hashtag must identify and distinguish the source of goods or services on its own.¹⁸² This standard seeks to eliminate consumer confusion. In *Anheuser-Busch, Inc. v. Customer Co.*,¹⁸³ the plaintiff brought a trademark infringement action against the defendant alleging that customers would likely be confused by defendant's beer can colors, as well as the slogan, "Beer of Beers."¹⁸⁴ By examining the eight factors of likelihood of confusion,¹⁸⁵ the court found that the plaintiff successfully demonstrated consumer confusion.¹⁸⁶ To begin, the plaintiff's mark was strong: It had been in the marketplace for over a century and the company had spent a few billions of dollars to promote and advertise the brand.¹⁸⁷ Additionally, the plaintiff's product was identical to the defendant's, because each is a type of beer.¹⁸⁸ Finally, both promoted and advertised the same product in the same competitive market, where customers were most likely to spend less time and money making a brand selection.¹⁸⁹ Given these factors, the court found for the plaintiff, and also provided some guidance.

The hashtag applicant needs to choose words or phrases that tailor the hashtag so that it identifies with as much certainty as possible the applicant's goods or products so that it will not confuse the consumer. If the hashtag contains a long-term slogan of the company, it is more likely that it will be registrable because, in the customer's mind, the slogan is clearly associated with the company. For instance, if Geico Insurance Company applied to have part of its slogan registered as hashtag, #SaveFifteenPercentOnCarInsurance, it would probably be registrable because most customers would instantly

¹⁸² McCarthy, *supra* note 1, at § 7:20.

¹⁸³ *Anheuser-Busch, Inc. v. Customer Co., Inc.*, 947 F. Supp. 422 (N.D. Cal. 1996).

¹⁸⁴ *Id.* at 423.

¹⁸⁵ *Id.* at 424. *citing* E. & J. Gallo Winery v. Gallo Cattle Co., 967 F.2d 1280, 1290 (9th Cir.1992). There are a number of similar variations of these factors in different Circuits. For instance, in the Ninth Circuit, the *Sleekcraft* factors to prove likelihood of confusion are as follows: (i) the strength of the mark; (ii) the similarity of the marks; (iii) the marketing channels used; (iv) the proximity of the goods; (v) defendant's intent in selecting its mark; (vi) evidence of actual confusion; (vii) the likelihood of expansion of the product line; and (viii) the type of goods and the degree of care likely to be exercised by purchaser. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348 (9th Cir. 1979).

¹⁸⁶ *Id.* at 425.

¹⁸⁷ *Id.* at 424.

¹⁸⁸ *Anheuser-Busch, Inc.*, 947 F. Supp. at 425.

¹⁸⁹ *Id.*

identify Geico as the source. On the other hand, if National Benefit Insurance Company wanted to register the hashtag #Benefit, it would probably be unsuccessful because many other businesses and companies, such as Benefit Cosmetics, are associated with that word. Additionally, other social media users are more likely to use the all-too-common hashtag for unrelated posts which would, as a result, negatively impact the insurance company. Hence, businesses and companies need to narrowly tailor their hashtags to only identify with their brand by using the hashtag, for example #NationalBenefitInsuranceCo. When consumers see this hashtag, they will know that it does not relate to another source.

b. Length

A second consideration is the number of words and the length of the hashtag in proportion to its brand.¹⁹⁰ Similar to slogans, the more words used in the hashtag, the less likely it is that it will function as a trademark.¹⁹¹ Hashtags should not have excessive numbers of words, but at the same time they should have enough words to promote, advertise, and encourage the purchase and use of the intended product or service.¹⁹² In *In re Superba Cravats, Inc.*,¹⁹³ the Patent Office Trademark Trial and Appeal Board denied the application for slogan registration for “Soil It-Wash It-Never Needs Pressing” for neckties.¹⁹⁴ The board held that it was not a slogan or coined term because it stated a fact and was neither “catchy” nor had a “ring to it.”¹⁹⁵ The applicant argued that he shortened what a normal person would say in over fifteen words into seven and, therefore, it was inventive.¹⁹⁶ The board rejected this argument, indicating that the phrase could have been said in other short forms and still possess the same informational capabilities.¹⁹⁷

Similarly, the applicant’s hashtag must be lengthy enough to identify the product or service and promote advertisement, but with as few words as possible. Because of the way hashtags are constructed

¹⁹⁰ McCarthy, *supra* note 1, at § 7:20.

¹⁹¹ McCarthy, *supra* note 1, at § 7:20.

¹⁹² McCarthy, *supra* note 1, at § 7:20.

¹⁹³ *In re Superba Cravats, Inc.*, 149 U.S.P.Q. (B.N.A) ¶ 852 (T.T.A.B. Apr. 11, 1966).

¹⁹⁴ *Id.*

¹⁹⁵ *Id.*

¹⁹⁶ *Id.*

¹⁹⁷ *Id.*

without spaces and usually all lower case, it is sometimes difficult to make out the words that are intended to be read. Therefore, the more words a hashtag contains the less likely the customer is able to identify the words, and *then* associate those words with the brand. Even with the Geico hashtag example stated earlier, half the slogan is missing. If instead of #SaveFifteenPercentOnCarInsurance, Geico tried to register the full slogan such as #afifteenminutecallcouldsaveyoufifteenpercentormoreoncarinsurance, then it would defeat the purpose of registering hashtags: A consumer would most likely be unable to decipher the words and, as a result, the consumer would have failed to link the brand and the hashtag.

c. Commonly-Used Phrases

Third, if a hashtag uses phrases that are commonly used in a competitive market, it will not receive trademark protection.¹⁹⁸ Professor McCarthy treatise gives a few examples of such commonly used phrases: “Sale Today” or “We Sell at Low Prices” or “Half Off.”¹⁹⁹ This standard may seem to be straightforward, but parties still argue their adversary’s “slogan” should not be protected because it is a commonly-used phrase. For instance, the plaintiff in *Roux Labs Inc. v. Clairol, Inc.*²⁰⁰ argued that the slogan “Hair Color So Natural Only Her Hairdresser Knows For Sure” was a “common, laudatory advertising phrase.”²⁰¹ The plaintiff further stated that the slogan is “merely descriptive of the goods ... [and it] does not, and could not, function as a trademark to distinguish Clairol’s goods and serve as an indication of origin.”²⁰² The United States Court of Customs and Patent Appeals rejected the plaintiff’s argument, stating that, even though it was merely descriptive, it had acquired secondary meaning based on defendant’s extensive advertisement and use of the slogan.²⁰³

In contrast, hashtags such as #EverythingHalfOff or #SaleToday would not be trademark protected. These are commonly-used phrases that are incorporated in everyday business activities in a competitive market. Similarly, a commonly-used phrase incorporated

¹⁹⁸ McCarthy, *supra* note 1, at § 7:22.

¹⁹⁹ McCarthy, *supra* note 1, at § 7:22.

²⁰⁰ Roux Laboratories, Inc. v. Clairol, Inc., 427 C.C.P.A. 1173 (1970).

²⁰¹ *Id.* at 1175.

²⁰² *Id.* The plaintiff further stated that defendant would use this protection to “harass” the use of the slogan, and prohibit others from using the phrase. *Id.*

²⁰³ *Id.* at 1178.

in a hashtag, either preceding or accompanying a trademarked brand may not qualify as registrable. Therefore, according to the TMEP, a hashtag such as #SaleTodayBananaRepublic,²⁰⁴ which uses a commonly-used phrase, would preclude registration of the entire hashtag.²⁰⁵

d. Descriptive Phrases That Acquire Secondary Meaning

Fourth, descriptive phrases in a hashtag need to acquire secondary meaning.²⁰⁶ In *Roux Laboratories, Inc.*, the court first analyzed whether the phrase “Hair Color So Natural Only Her Hairdresser Knows For Sure” was considered descriptive²⁰⁷ and determined that the phrase did indeed describe the type of goods, their function, their characteristics, and their purpose.²⁰⁸ Having found that the phrase was descriptive, the court thought that it clearly was original with respect to defendant’s products.²⁰⁹ Next, the court examined extrinsic evidence to determine whether the slogan had generated a secondary meaning.²¹⁰ The court recognized that the defendant used the slogan commercially for approximately ten years, and had spent over twenty-two million dollars towards advertisements.²¹¹ Therefore, the court held that the slogan was distinctive to defendant’s brand and product, respectively.²¹²

Furthermore, a secondary meaning must unambiguously establish that the slogan triggers brand or product identification in the consumer’s mind. In *Norm Thompson Outfitters, Inc. v. General Motors Corp.*,²¹³ plaintiff was an Oregon based sporting goods corporation that sued the defendant, a Delaware automobile company, for utilizing the slogan “Escape from the Ordinary.”²¹⁴ The Ninth

²⁰⁴ See *supra* Part III.B.

²⁰⁵ USPTO, TMEP § 1202.18 (Apr. 2016).

²⁰⁶ *Roux Laboratories*, 427 C.C.P.A. at 1178.

²⁰⁷ *Id.*

²⁰⁸ *Id.* at 1177. The products are used for hair coloring to make consumers hair look natural.
Id.

²⁰⁹ *Id.*

²¹⁰ *Id.* at 1181.

²¹¹ *Roux Laboratories*, 427 C.C.P.A. at 1181.

²¹² *Id.*

²¹³ *Norm Thompson Outfitters, Inc. v. General Motors Corp.*, 448 F.2d 1293 (9th Cir. 1971).

²¹⁴ *Id.* at 1294.

Circuit held that the slogan was an invalid trademark because it was descriptive.²¹⁵ In addition, plaintiff failed to prove that the slogan acquired a secondary meaning.²¹⁶ More specifically, plaintiff's expert witness at trial stated that plaintiff's advertising technique would not make a consumer outside the state of Oregon associate the slogan with the plaintiff's brand.²¹⁷ Additionally, the court held that the six letters from consumers questioning its association with defendant's company did not have enough weight to establish a secondary meaning for the slogan.²¹⁸

Conversely, this standard applied to the hashtag #LookProfessionalInEveryStepYouTake as associated with Banana Republic supports a finding that the hashtag is descriptive. It illustrates that Banana Republic's clothing makes a consumer appear professional. If Banana Republic uses this hashtag with a majority of its social media posts, continuously for five years, thereby saturating the online advertising market with its brand and this hashtag, then there is a high probability that consumers will associate the hashtag with the brand and the company's product or service. Similarly, Geico's slogan--#SaveFifteenPercentOnCarInsurance--has secondary meaning because it created an automatic association between the slogan and the brand in the minds of consumers.

e. Previously Existing Trademark

Fifth and last, a hashtag that incorporates both a phrase and a previously existing trademark will not receive trademark registration.²¹⁹ In *Allstate Ins. Co. v. Allstate Inc.*,²²⁰ the plaintiff sued the defendant, owner of "Allstate Car Wash," for infringing plaintiff's service marks and sought injunctive relief, directing defendant to change its name so that it would not deceive consumers into

²¹⁵ *Id.* at 1295. The president of plaintiff's company identified himself as the "finder of unique items" and "expert in selling things that people don't need but that they would like to have." *Id.* The company's catalog described each article in a way that it was one of a kind and "unusual." *Id.* Additionally, the catalog had a narrative section describing the company's efforts to find unique items by traveling the world. *Id.*

²¹⁶ *Id.* at 1297.

²¹⁷ *Id.* The expert witness further stated that if one thousand people were randomly selected on the streets of Georgia, a small percentage of them would make the connection between the brand and the slogan. *Id.*

²¹⁸ *Id.* The letters were few in number and did not represent the majority of the consumers.

²¹⁹ McCarthy, *supra* note 1, at § 7:22.

²²⁰ *Allstate Ins. Co. v. Allstate Inc.*, 307 F. Supp. 1161 (N.D. Tex. 1969).

identifying the plaintiff as the source of defendant's company.²²¹ The court held that the word "Allstate" in defendant's slogan "Place your car in good hands with Allstate Car Wash," established trademark infringement because it imitated plaintiff's service mark.²²² Even though the plaintiff did not do business in the same competitive market, the court found that the defendant's use of the mark would most likely confuse and deceive the consumer into believing that the plaintiff endorsed, and was connected to, defendant's car wash service.²²³ Essentially, if, the defendant were permitted to use the slogan, it would reap benefits from the plaintiff's reputation and investment in its trademark.²²⁴

Similarly, applicants who attempt to register a hashtag that contains their own trademark plus another company's slogan, will not be successful. This problem arises when business owners try to attract customers to their products or services by combining their hashtag with another's. For instance, as a direct explanation, a brand-new car company by the name of "Quora" which is promoting its vehicles on Instagram might include other vehicle related hashtags to attract more customers, such as #Nissan, #BMW, #Volvo, and even #Geico. A consumer who is utilizing the hashtag platform to search for posts relating to a certain brand of car, like Nissan, will also come across Quora's posts by virtue of the hashtags included in the post. Incorporating these registered hashtags will most likely cause trademark infringement for the same reasons as above: Quora would benefit from the other company's reputation and investment. This issue also arises when the defendant, like the defendant in *All State Ins. Co.*, uses another company's trademark as part of its hashtag. For example, if Quora tries to register the hashtag #TheSpiritOfAmericanStyleQuora which incorporates his brand with Buick's slogan, then it will most likely be denied because a portion of the hashtag is already trademarked.

Each of these five standards plays a role in the hashtag's overall strength. They structure and format words to create a nexus in the consumer's mind between the hashtag and the source of the product or service. This nexus makes the hashtag distinctive and, therefore, assists the applicant in obtaining trademark protection over the hashtag.

²²¹ *Id.* at 1163.

²²² *Id.* at 1164.

²²³ *Id.*

²²⁴ *Id.* at 1165.

V. FIRST AMENDMENT IMPLICATIONS

When the First Amendment²²⁵ is applied to trademark law, there is a collision between expression and protection. The former seeks to give individuals the right to freely express themselves, while the latter fiercely attempts to protect marks, slogans, and designs of other owners to prevent likelihood of confusion.²²⁶ Thus, the First Amendment is viewed as an important affirmative defense by commentators.²²⁷ The First Amendment applies to hashtags in the same way that it applies to slogans or marks.²²⁸ If the hashtag is used by the social media user as a noncommercial or nominative form of expression, then it has not infringed on the owner's trademark.²²⁹ The first step, therefore, is to determine whether the expression is "social, artistic, political, [or] commercial."²³⁰

Commercial speech can be protected, but it receives a lesser degree of constitutional protection than non-commercial speech, such as news.²³¹ Commercial speech has been defined as "speech of any form that advertises a product or service for profit or for business purpose."²³² Further, commercial speech is evaluated solely on the basis of "whether it proposes commercial transaction."²³³ In *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*,²³⁴ the plaintiffs brought an action attacking the state code which prohibits the publishing and advertising of prescription drug prices by pharmacists.²³⁵ They claimed that the statute violated the First Amendment because advertisements constituted free speech.²³⁶ The Supreme Court agreed, and held that commercial speech is protected

²²⁵ U.S. CONST. amend. I.

²²⁶ McCarthy, *supra* note 1, at § 31:139.

²²⁷ See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog LLC.*, 507 F.3d 252, 261 (4th Cir. 2007); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 839 (6th Cir. 1983); *Brown v. Electronic Arts, Inc.*, 724 F.3d 1235, 1239 (9th Cir. 2013).

²²⁸ McCarthy *supra* note 1, at § 31:139.

²²⁹ McCarthy *supra* note 1, at § 31:139.

²³⁰ McCarthy *supra* note 1, at § 31:139.

²³¹ McCarthy, *supra* note 1, at § 31:147.

²³² *Id.* at § 31:139.25.

²³³ McCarthy *supra* note 1, at § 31:139.25.

²³⁴ *Virginia State Bd. of Pharmacy v. Virginia Citizens Consumer Council*, 425 U.S. 748 (1976).

²³⁵ *Id.* at 771.

²³⁶ *Id.*

by the First Amendment and, therefore, it fell within the “free speech” clause of the constitution.²³⁷

The First Amendment should have the same impact on trademark protected hashtags as it does on protected slogans, designs and marks. As discussed above, when a protected trademark brand, design, or slogan has been used without authorization by another for a commercial purpose, then there should be no dispute as to trademark infringement because consumers may be confused as to whether the infringer’s product comes from the owner’s source.²³⁸ The same holds true when dealing with hashtags: Social media users are not free to use the same hashtag such as #BananaRepublic to promote *their own* products that are not in any way associated with the original Banana Republic retailer. In other word, the social media users are essentially advertising their own products by using an established company’s name in a hashtag to increase profits, thereby benefiting from the trademark owner’s investment and reputation.

Conversely, when “the unauthorized use of a trademark is for expressive purposes of comedy, parody, allusion, criticism, news reporting, and commentary, the law requires a balancing of the rights of the trademark owner against the interests of free speech.”²³⁹ This is known as the “nominative fair use defense” and provides that when a defendant uses plaintiff’s trademark to describe plaintiff’s product, even if the defendant’s goal is to describe his own product, it is not considered misleading.²⁴⁰ Instead of applying the likelihood of confusion factors, the Ninth Circuit used the following factors:

first, the product or services in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that that would in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.²⁴¹

²³⁷ *Id.*

²³⁸ *See, e.g.,* Yankee Pub. Inc. v. News Am. Pub. Inc., 809 F. Supp. 267, 276 (S.D.N.Y. 1992).

²³⁹ McCarthy, *supra* note 1, at § 31:139.

²⁴⁰ McCarthy, *supra* note 1, at § 11:45.

²⁴¹ *New Kids on the Block v. News America Pub., Inc.*, 971 F.2d 302, 308 (9th Cir. 1992). Other circuit courts use similar type of variations in setting forth the factors required to prove nominative fair use. The Second Circuit two-part analysis focuses on whether the defendant’s

Similarly, the parody defense is a successful First Amendment defense and it, too, may fall under the nominative fair use defense.²⁴² It is used when the defendant has intentionally deceived, imitated or mimicked the plaintiff's goods or services, and the consumer will readily know that plaintiff did not endorse or produce defendant's product.²⁴³ For example, the hashtag #McDStories²⁴⁴ was created by McDonald's but customers hijacked it to write about their bad experiences on Twitter. Here, the use of McDonald's hashtag would be protected under the First Amendment because the users commented on or criticized the product and service. Likewise, if an individual wore a mermaid custom imitating the Starbucks mermaid mark and posted a picture on a social media website with the hashtag #Starbucks, then that social media user would be imitating the Starbucks mark and would be protected by the First Amendment. Therefore, these social media users could successfully use a First Amendment defense against a trademark owner's claim of trademark infringement.

VI. CONCLUSION

The magnitude of hashtag's impact on social media and its users was unpredictable. The concept has been beneficial to all who utilize it; whether it would be through creating a hashtag or using it to navigate through social media. The problem arises when businesses want to advertise on social media platforms and the hashtag they have created is not trademark protected. A social media user clicks on that hashtag and is then transported to a new site where the user can view all the posts containing that exact hashtag. That business wants all of the posts to reflect and identify that specific business. However, if other users' posts incorporate the same hashtag to reference other, very different subject matters, then the hashtag can have an adverse effect on that business's brand. Thus, it is in the best interests of businesses to have their hashtags trademark protected. Many commentators have argued that it is a waste of the judicial system's time, money, and energy to have hashtags trademark protected and they justify their

description of plaintiff's goods or services were genuine and accurate, and that plaintiff did not endorse or affiliate with the defendant's goods or services. *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 113 (2d Cir. 2010).

²⁴² See, e.g., *Louis Vuitton Malletier S.A. v. Haute Diggity Dog, LLC*, 507 F.3d 252, 261 (4th Cir. 2007).

²⁴³ *Id.*

²⁴⁴ See *supra* Part II.B.

point by indicating that the contents of hashtags are already protected through classic trademark applications to brands and slogans.²⁴⁵

However, even though slogans and hashtags are alike, these commentators fail to recognize the subtle yet significant difference between the two. They also fail to recognize the rapid development of technology, and how important it is for the legal system to evolve with that development. Hashtags were created with the main purpose of organizing content on social media sites. However, it should also be recognized that it indirectly functions as a source identifier. Consumers who view a desired post containing a specific hashtag automatically identify the source, or they explore by utilizing the hashtag to find out more about that product or service. This indirect source identification has superior marketing value for the business, more so than, for example, simply catching a glimpse of an advertisement on a billboard. This is because hashtag creates an interactive space for desired consumers to surf throughout the business's social media posts to better familiarize themselves with the product or services. Even though these five standards have been extracted from cases involving slogans, the same principles apply to hashtags. Therefore, the USPTO should continue registering hashtags, and apply these five standards to definitively determine which hashtags should be considered registrable.

²⁴⁵ Sherwin, *supra* note 11, at 470.