

**#HAVEWEREALLYTHOUGHTTHISTHROUGH?:
WHY GRANTING TRADEMARK PROTECTION
TO HASHTAGS IS UNNECESSARY, DUPLICATIVE,
AND DOWNRIGHT DANGEROUS**

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I. INTRODUCTION

It started innocently enough. On January 18, 2012, McDonald's issued two tweets from its official Twitter handle, "@McDonalds."¹

The first read:

'When u make something w/pride, people can taste it,' - McD potato supplier #McDStories <http://t.co/HaPM5G9F>²

The second, sent three and a half hours later, read:

Meet some of the hard-working people dedicated to providing McDs with quality food every day #McDStories <http://t.co/BoNIwRJS>³

What happened next was a case study of the age-old lesson, "be careful what you wish for."⁴ Sure, Twitter users followed with their own "McDStories."⁵ But no one can say they were the types of Happy-Meal-Go-Lucky tales McDonald's was presumably hoping for.⁶ A small sampling of what *was* tweeted:

- One time I walked into McDonalds and I could smell Type 2 diabetes floating in the air and I threw up. #McDStories⁷

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1. See #McDStories, *McDonald's Twitter Hashtag Promotion, Goes Horribly Wrong*, HUFFINGTON POST (Jan. 23, 2012, 10:58 AM), http://www.huffingtonpost.com/2012/01/23/mcdstories-twitter-hashtag_n_1223678.html [https://perma.cc/WDD8-KYHD].

2. Hannah Roberts, #McFail! McDonalds' Twitter Promotion Backfires as Users Hijack #McDStories Hashtag To Share Fast Food Horror Stories, DAILY MAIL (Jan. 24, 2012, 5:09 AM), <http://www.dailymail.co.uk/news/article-2090862/McDStories-McDonalds-Twitter-promotion-backfires-users-share-fast-food-horror-stories.html>.

3. McDonald's (@McDonalds), TWITTER (Jan. 18, 2012, 12:30 PM), <https://twitter.com/McDonalds/status/159734463469850624> [https://perma.cc/2KMK-PYGJ].

4. See Kashmir Hill, #McDStories: When a Hashtag Becomes a Bashtag, FORBES (Jan. 24, 2012, 2:07 PM), <http://www.forbes.com/sites/kashmirhill/2012/01/24/mcdstories-when-a-hashtag-becomes-a-bashtag/> [https://perma.cc/LS8R-XSV5].

5. See Thomas Mucha, #McFail: McDonald's Hashtag Promotion Is a Marketing Disaster, GLOBALPOST (Jan. 23, 2012, 5:04 PM), <http://www.globalpost.com/dispatches/globalpost-blogs/macro/mcfail-mcdonalds-hashtag-promotion-marketing-disaster> [https://perma.cc/KT9G-X5DE].

6. See Hollis Thomases, *McDonald's Twitter Mess: What Went Wrong*, INC. (Jan. 25, 2012), <http://www.inc.com/hollis-thomases/mcdonalds-mcdstories-twitter-mess.html>.

7. Hill, *supra* note 4.

- Ate a McFish and vomited 1 hour later . . . The last time I got McDonalds was seriously 18 years ago in college. . . . #McDStories⁸
- Fingernail in my BigMac Once #McDStories⁹
- Hospitalized for food poisoning after eating McDonalds in 1989. Never ate there again and became a Vegetarian. Should have sued. #McDStories¹⁰
- #McDStories Learn all about McDonalds using pigs from gestation crates. #McCruelty chn.ge/r5Q4fA¹¹

In all, more than 1500 people posted tweets to the “McDStories” hashtag before McDonald’s pulled down the post two hours later, admitting “#mcdstories did not go as planned.”¹² And McDonald’s is not alone; “Twitter hashtag disasters” happen with regularity.¹³ It is hardly surprising; the explosion of social media over the past decade has brought with it a predictable trend (no pun intended¹⁴): businesses’ desire to harness the phenomenon’s popularity and use it to sell more products and services.¹⁵

This Article focuses on one particular aspect of social media that is becoming more important by the day: the hashtag.¹⁶ Generally speaking, a hashtag is a tool that users of social media and microblog-

8. *Id.*

9. Gus Lubin, *McDonald’s Twitter Campaign Goes Horribly Wrong #McDStories*, BUS. INSIDER (Jan. 24, 2012, 6:12 AM), <http://www.businessinsider.com/mcdonalds-twitter-campaign-goes-horribly-wrong-mcdstories-2012-1> [<https://perma.cc/2TQH-CP5G>].

10. *Id.*

11. *Id.*

12. *Id.*

13. See, e.g., Hannah Waldram, *#Susanalbumparty: Top Five Twitter Hashtag PR Disasters*, GUARDIAN (Nov. 22, 2012, 7:06 AM), <http://www.theguardian.com/technology/shortcuts/2012/nov/22/twitter-susan-boyle-susanalbumparty> [<https://perma.cc/L337-N9YP>] (discussing the McDonald’s and other “so-called PR ‘hashtag fails’”). The #susanalbumparty story has to be at the top of anyone’s list of “hashtag fails”; as put by Hannah Waldram of The Guardian, “Susan Boyle’s PR people are probably wishing they had re-read their promotional hashtag after missing its alternative message to Twitter users.” *Id.* Fortunately, the tweet was later edited to read “#SusanBoylesAlbumParty.” *Id.*

14. Well, maybe a slight pun intended. The terms “trend” and “trending” are used by the microblogging site Twitter to identify popular topics being discussed by its users. See *FAQs About Trends on Twitter*, TWITTER, <https://support.twitter.com/articles/101125> [<https://perma.cc/T4MB-8JP2>]. Many “trending” topics are denoted by the # symbol — also known as a “hashtag” — which is the subject of this article. See *id.*

15. See Uri Bar-Joseph, *5 Brilliant Ways To Use #Hashtags in Social Media Marketing*, SEARCH ENGINE WATCH (Feb. 10, 2014), <http://searchenginewatch.com/sew/how-to/2327748/5-brilliant-ways-to-use-hashtags-in-social-media-marketing> [<https://perma.cc/EVT5-QS5B>].

16. See *Using Hashtags on Twitter*, TWITTER, <https://support.twitter.com/articles/49309> [<https://perma.cc/U8LE-7HWU>].

ging¹⁷ sites can employ to make it easier for other users to find and read posts about a specific topic or theme.¹⁸ By placing the “#” character — also known as a “hash” symbol — before a word or unspaced phrase, the author of a posting can make it easy to locate by anyone who searches for that same word or phrase.¹⁹ For example, if a user of the popular microblogging site Twitter wants to know what others are saying about Hillary Clinton or Donald Trump, she can type “#hillaryclinton” or “#thedonald” into Twitter’s search bar, and up will pop all posts that any Twitter user has tagged with the exact same string of letters.²⁰

Although hashtags are not new, advertisers are quickly developing novel and creative ways to use them for (eventual) monetary gain.²¹ Consequently, as the importance and value of hashtags continue to rise, the intellectual property implications that accompany that rise come into ever-increasing focus.²²

In October 2013, the United States Patent and Trademark Office (“USPTO”) clarified its position on hashtags,²³ releasing guidelines to govern their trademarkability.²⁴ While the guidelines make clear that

17. Microblogging is the practice of publishing short updates, as opposed to the longer types of posts one would normally see on a traditional Internet blog. *See Microblog*, WEBOPEDIA, <http://www.webopedia.com/TERM/M/microblog.html> [https://perma.cc/2V8J-ACK6]; cf. Vangie Beal, *The History of Blogging*, WEBOPEDIA (July 13, 2007), http://www.webopedia.com/quick_ref/history_of_blogging.asp [https://perma.cc/AFT9-8FJS]; *Blog*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Blog> [https://perma.cc/NMB2-7C9G].

18. *See Hashtag*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Hashtag> [https://perma.cc/PAK7-DH98].

19. *See id.*

20. *See id.*

21. *See* Denise Lee Yohn, *Use Hashtags to Generate Greater Brand Engagement*, FORBES (Feb. 18, 2015, 5:10 AM), <http://www.forbes.com/sites/deniselyohn/2015/02/18/use-hashtags-to-generate-greater-brand-engagement> [https://perma.cc/XHG2-DEMJ].

22. *See* Dina Roumiantseva & Aaron Rubin, *#Trademarks?: Hashtags as Trademarks*, SOCIALLY AWARE (May 13, 2015), <http://www.sociallyawareblog.com/2015/05/13/trademarks-hashtags-as-trademarks> [https://perma.cc/QLN4-MW2C]; *see also* Linda Goldstein, *Outside Voices: Top 3 Legal Issues Facing Marketers in 2015*, WALL ST. J. (Dec. 31, 2014, 10:06 AM), <http://blogs.wsj.com/cmo/2014/12/31/outside-voices-top-3-legal-issues-facing-marketers-in-2015/> [https://perma.cc/6568-LLEU].

23. *See* USPTO, TMEP § 1202.18 (Oct. 2013), <http://tmepl.uspto.gov/RDMS/detail/manual/TMEP/Oct2013/d1e2.xml> (last visited May 4, 2016).

24. “Trademarkability” is my term, not the USPTO’s. And to be sure, the USPTO’s guidelines go only to the issue of registration, and not trademark validity in general. As the Supreme Court has observed, “federal law does not create trademarks,” *B&B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 1299 (2015), and even trademarks that are unregistered are nevertheless trademarks and protectable. *Johnny Blastoff, Inc. v. L. A. Rams Football Co.*, 188 F.3d 427, 433, 435 (7th Cir. 1999). But to be sure, the benefits of federal registration are “significant.” *B&B Hardware*, 135 S. Ct. at 1300. They include constructive notice of the registrant’s claim of ownership; prima facie evidence of the mark’s validity, the owner’s ownership of the mark, and of the owner’s exclusive right to use the mark; and incontestability after five years of registration. *See id.*

USPTO believes hashtags are indeed registrable as trademarks, they ignore the fact that offering protection to words and phrases prefaced with a “#” serves no purpose that is not already protected or protectable for trademark-able words and phrases without the symbol.²⁵ Instead, by issuing trademark registrations to hashtags, the USPTO is potentially enabling large corporations — such as McDonalds — to use trademark infringement lawsuits (or just *the threat* of a lawsuit) to bully social media users into silence and insulate those corporations from criticism.²⁶

This Article argues that such hashtags should not be protected by trademark law, primarily because of their very nature as a grouping tool that *encourages use* by others cuts against the notion of *protecting* their status as intellectual property. Part II of the Article explores the history of the hashtag in social media. Part III discusses how hashtags fit in to the general framework of trademark law. In Part IV, I argue why awarding trademark protection to hashtags is both unnecessary and unwise.

II. THE HASHTAG AS WE KNOW IT

A. Social Media: A Primer

“Social media” is an extraordinarily broad term, generally referring to computer-platform tools that enable people and businesses to create, share, and exchange information, ideas, and media content throughout virtual communities and networks.²⁷ Users of social media do this through any number of highly interactive Internet-based programs, applications, and web sites.²⁸ Social media operates in a dialogic transmission system (many sources to many receivers), as opposed to traditional or industrial media, which has typically operated under a monologic transmission model (one source to many receivers).²⁹

25. See *infra* Part IV.A.

26. See *infra* Part IV.B.3.

27. See Jan H. Kietzmann & Kristopher Hermkens, *Social Media? Get Serious! Understanding the Functional Building Blocks of Social Media*, 54 BUS. HORIZONS 241, 241 (2011).

28. See *id.* at 241–42.

29. JOHN V. PAVLIK & SHAWN MCINTOSH, *CONVERGING MEDIA* 189 (4th ed. 2015). This distinction is particularly relevant to my argument that trademark law should protect traditional advertising slogans and tag lines (which typically originate from one source) but not hashtags (which, by their nature, encourage origination from as many sources as possible). See *infra* Part IV.

Social media sites have come to dominate Internet usage.³⁰ According to The Nielsen Company, Internet users spend more time with social media than any other type of Internet site.³¹ But to say that social media means one thing to everybody would be a gross mischaracterization.³² The term can embody many different media, including social networks,³³ blogs³⁴ and microblogs,³⁵ business networks,³⁶ enterprise social networks,³⁷ forums and message boards,³⁸ photo sharing,³⁹ products/services reviews,⁴⁰ social bookmarking,⁴¹ social gaming,⁴² video sharing,⁴³ and virtual worlds.⁴⁴ And many social media sites transcend a single medium. For instance, Facebook and Twitter — undoubtedly the most popular social networks⁴⁵ — are also among the most popular microblogging sites.⁴⁶

30. See *The Paid Social Media Advertising Report 2013*, NIELSEN (Jan. 25, 2013), <http://www.nielsen.com/us/en/insights/reports/2013/the-paid-social-media-advertising-report-2013.html> [<https://perma.cc/YG6U-JMML>].

31. NIELSEN CO., *STATE OF THE MEDIA: THE SOCIAL MEDIA REPORT 2012*, at 4 (2012), <http://www.nielsen.com/us/en/insights/reports/2012/state-of-the-media-the-social-media-report-2012.html> (download the full report from this landing page).

32. See generally Thomas Aichner & Frank Jacob, *Measuring the Degree of Corporate Social Media Use*, 57 INT'L J. OF MKT. RES. 257 (2015) (listing different types of social media and their uses).

33. For example, Facebook (<https://www.facebook.com>) [<https://perma.cc/ZL2U-29TC>] and Google Plus+ (<https://plus.google.com/>) [<https://perma.cc/Q2DA-SL2Z>].

34. For example, WordPress (<https://wordpress.com>) [<https://perma.cc/L4L5-TGT3>] and Blogger (<https://www.blogger.com>) [<https://perma.cc/J2VE-TLSL>].

35. For example, Twitter (<https://twitter.com>) [<https://perma.cc/RR97-ULGF>] and the “status update” function of Facebook (<https://www.facebook.com>) [<https://perma.cc/XT3R-A9RN>].

36. For example, LinkedIn (<https://www.linkedin.com>) [<https://perma.cc/5WBX-R7A2>] and Viadeo (<http://us.viadeo.com/en>) [<https://perma.cc/7235-UUZR>].

37. For example, Yammer (<https://www.yammer.com>) [<https://perma.cc/AL85-5DGG>] and eXo Platform (<http://www.exoplatform.com>) [<https://perma.cc/H35C-EN8Q>].

38. For example, Gaia Online (<http://www.gaiaonline.com>) [<https://perma.cc/ZAF7-T5UR>] and 4chan (<https://www.4chan.org>) [<https://perma.cc/RP6V-DKEJ>].

39. For example, Instagram (<https://instagram.com>) [<https://perma.cc/6EA7-DYCJ>] and Flickr (<https://www.flickr.com>) [<https://perma.cc/594W-FB2A>].

40. For example, Yelp (<http://www.yelp.com>) [<https://perma.cc/DH4W-HK8F>] and Angie’s List (<http://www.angieslist.com>) [<https://perma.cc/6U4V-PQ2Y>].

41. For example, Pinterest (<https://www.pinterest.com>) [<https://perma.cc/5KE3-VZLT>] and Reddit (<https://www.reddit.com>) [<https://perma.cc/4UQL-MLTS>].

42. For example, Microsoft’s Xbox Live (<http://www.xbox.com/en-US/live>) [<https://perma.cc/6YJ5-L5ZV>] and Sony’s Playstation Network (<https://www.playstation.com/en-us/my/account/>) [<https://perma.cc/45B7-MHZZ>].

43. For example, YouTube (<https://www.youtube.com>) [<https://perma.cc/T2D7-ND4U>] and Vine (<https://vine.co>) [<https://perma.cc/M9BV-96YD>].

44. For example, Minecraft (<https://minecraft.net>) [<https://perma.cc/9MVR-KEWT>] and Second Life (<http://secondlife.com>) [<https://perma.cc/H7VE-FJJE>].

45. *Top 15 Most Popular Social Networking Sites, August 2015*, EBIZMBA, <https://web.archive.org/web/20150808072453/http://www.ebizmba.com/articles/social-networking-websites> [<https://perma.cc/8DH7-XRJS>].

46. Thomas Timely, *Top 10 Microblogging Sites*, GURUGROUNDS (Mar. 18, 2015), <https://web.archive.org/web/20150320024059/http://www.gurugrounds.com/uncategorized/>

The microblogging sites — or at least those sites with microblogging functions, such as Facebook — are the primary backdrop for this article. Twitter, which limits users' posts to 140 characters, is by far the king of microblogging sites.⁴⁷ So it is hardly a surprise that the hashtag — at least in its current iteration — is generally agreed to have been born (or perhaps reborn) on Twitter.⁴⁸

B. The Ancestry of Hashtags

Even before Twitter — and indeed, before the Web as we know it — there was Internet Relay Chat (“IRC”).⁴⁹ IRC was invented in 1988 to facilitate Internet discussion in the form of text.⁵⁰ At some point in the late 1980s, IRC users began using the “#” symbol, known in most parts of the world as the “hash” sign but referred to by Americans primarily as the “number” or “pound” sign, to categorize content into groups.⁵¹ This categorization made it possible to easily search for content later on.⁵² Of course, IRC — while still in operation today — never had the kind of mass traffic that today's social media sites enjoy.⁵³

Fast forward another decade: In 2006, Twitter was born as a result of its three founders looking for a way to send and share text mes-

top-10-microblogging-sites/ [https://perma.cc/K3JK-FY9H]; *Microblogging*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Microblogging> [https://perma.cc/5VHL-N6KF].

47. See Timely, *supra* note 46. But see Steven Hodson, *Twitter is Not a Micro-Blogging Tool*, MASHABLE (Jul. 19, 2008), <http://mashable.com/2008/07/18/twitter-not-a-microblogging-tool> [https://perma.cc/HNA6-RHKN] (arguing that “the inane twaddle” regularly seen on Twitter is “stupid and devalues the hard work that most bloggers do everyday.”).

48. See *infra* Part II.B.

49. See *Internet Relay Chat*, WIKIPEDIA, https://en.wikipedia.org/wiki/Internet_Relay_Chat [https://perma.cc/6WDL-Q9FQ].

50. See *id.*

51. See Shea Bennett, *The History of Hashtags in Social Media Marketing* [INFOGRAPHIC], SOCIAL TIMES (Sep. 2, 2014), <http://www.adweek.com/socialtimes/history-hashtag-social-marketing/501237> [https://perma.cc/G3FW-8BM4]; see also *#Octorpe - A Symbolistic Journey*, YOUTUBE (Oct. 24, 2014), <https://www.youtube.com/watch?v=HEVOM0VycMI> [https://perma.cc/E48M-W7DB] (discussing the global and U.S. history of the “#” sign).

52. See Bennett, *supra* note 51.

53. See *IRC Is Dead, Long Live IRC*, PINGDOM (Apr. 24, 2012), <http://royal.pingdom.com/2012/04/24/irc-is-dead-long-live-irc> [https://perma.cc/XPT9-A3GQ]; see also Alex Williams, *IRC Has Lost 60% of Its Users Since 2003, But Life as a Robot Is Just Beginning*, TECHCRUNCH (Jan. 6, 2013), <http://techcrunch.com/2013/01/06/irc-has-lost-60-of-its-users-since-2003-but-life-as-a-robot-is-just-beginning/> [https://perma.cc/AN5C-6TJF]. IRC reached its height at one million users in 2003. *Id.* By comparison, Twitter alone had 302 million monthly active users in the first quarter of 2015. *Number of Monthly Active Twitter Users Worldwide from 1st Quarter 2010 to 1st Quarter 2015 (in Millions)*, STATISTA, <http://www.statista.com/statistics/282087/number-of-monthly-active-twitter-users> [https://perma.cc/PGC4-5P3Y].

sages on their cellular phones⁵⁴ (the iPhone did not debut until mid-2007).⁵⁵ They restricted the messages to 140 characters because cellular carriers limited SMS (Short Message Service) messages to 160 characters, and the new service needed to leave room for usernames.⁵⁶ They named their new service “Twitter” after coming across the word’s definition: “a short burst of inconsequential information.”⁵⁷

At that point, with the site still in its infancy, there was no need for any type of classification or organization instrument.⁵⁸ But as the platform and user base grew, in 2007, designer Chris Messina pitched the idea of using the old IRC grouping tool to organize messages.⁵⁹ He wrote:

how do you feel about using # (pound) for groups.
As in #barcamp [msg]?

Three days after Messina’s tweet and corresponding personal blog posts, fellow blogger Stowe Boyd endorsed the proposal, and in doing so, became the first to coin the term “hash tag.”⁶⁰ Two months later, while tweeting about the devastating wildfires in San Diego,⁶¹ resident Nate Ridder began prefacing all his posts with the label #sandiegofire, thereby allowing people around the world to search for that specific term and quickly find posts by Ridder and other users on that precise topic.⁶²

The Messina-Boyd-Ridder confluence in late 2007 is generally agreed to be the genesis of what we now know to be an extraordinary tool, even if it took Twitter another two years before it formally adopted the hashtag by hyperlinking any post with a # symbol before

54. Mark Johnson, *The History of Twitter*, SOCIALNOMICS (Jan. 23, 2013), <http://www.socialnomics.net/2013/01/23/the-history-of-twitter> [https://perma.cc/RJ8QDAW6].

55. Rene Ritchie, *History of iPhone: Apple Reinvents the Phone*, IMORE (Aug. 22, 2014), <http://www.imore.com/history-iphone-2g> [https://perma.cc/CF8S-62DN].

56. Johnson, *supra* note 54.

57. *The History of Hashtags*, HASHTAGS.ORG (June 26, 2012), <https://www.hashtags.org/platforms/twitter/history-of-hashtags>.

58. *Id.*

59. *Id.*; Bennett, *supra* note 51.

60. “Chris Messina has outlined (in a fairly voluminous way) a proposal for the use of hash tags (strings like ‘#tag’) as a way to help make sense of the noise within Twitter.” Stowe Boyd, *Hash Tags=Twitter Groupings*, STOWE BOYD (Aug. 26, 2007), <http://stoweboyd.com/post/39877198249/hash-tags-twitter-groupings> [https://perma.cc/5TKY-EU78]; Amanda MacArthur, *The History of Hashtags: Shedding Some Light on the History of Hashtags and How We’ve Come To Use Them*, ABOUT TECH, <http://twitter.about.com/od/Twitter-Hashtags/a/The-History-Of-Hashtags.htm> [https://perma.cc/HBE5-LQR7].

61. See *We Can’t Stop It*, NBC NEWS, http://www.nbcnews.com/id/21431682/ns/us_news-2007_california_wildfires/t/we-cant-stop-it/#.Vw_6aRMrJE4 [https://perma.cc/6KTH-H3FS].

62. See MacArthur, *supra* note 60.

it.⁶³ From there, its use began to grow, and in 2011, it exploded.⁶⁴ In January of that year, mobile photo sharing site Instagram began linking to hashtags, while Audi aired the first Super Bowl commercial to include reference to a hashtag.⁶⁵ A few months later, Twitter found itself at the center of the Arab Spring⁶⁶ protests, with the “#Bahrain” tag becoming one of the most-used of all time.⁶⁷ By 2013, half of all Super Bowl commercials included a hashtag, and Facebook added support for its use.⁶⁸ As 2015 came to a close, the use of hashtags in television commercials generally had grown from less than one percent in May of 2012 to thirteen percent — equal to the percentage of commercials that list telephone numbers.⁶⁹ And because hashtags are “cross-platform,” as Facebook, Instagram, Google+, and Flickr also all provide support for their use, they have quickly become one of the most effective ways for businesses to track how their brand or product is being discussed and considered by the public.⁷⁰

C. C’mon, Everyone Is Doing It!

If there was any doubt about just how societally endemic hashtagging has become, there is even such a thing as “verbal hashtagging” — the practice of saying the word “hashtag” before whatever one had planned on saying, in an effort to convey meaning beyond the words themselves.⁷¹ Of course, doing so serves no real purpose, but it goes to show just how pervasive the symbol’s presence is in our daily lives and culture.⁷² Like it or not, hashtagging has “be-

63. See *id.*; Bennett, *supra* note 51; Lindsay Kolowich, *The History of Hashtags [Infographic]*, HUBSPOT BLOGS (Dec. 5, 2014, 2:00 PM), <https://blog.hubspot.com/marketing/history-of-hashtags> [<https://perma.cc/L5RG-4PZF>].

64. See Kolowich, *supra* note 63.

65. *Id.*

66. See *The Arab Spring: A Year of Revolution*, NPR, <http://www.npr.org/2011/12/17/143897126/the-arab-spring-a-year-of-revolution> [<https://perma.cc/A2P4-XHSD>].

67. Kolowich, *supra* note 63.

68. *Id.*

69. Sean Muller, *Hashtags Have Outgrown Twitter in TV Advertising*, DAILY DOT MEDIA (Mar. 11, 2015, 6:28 PM), <http://media.dailydot.com/blog/hashtags-have-outgrown-twitter-in-tv-advertising/> [<https://perma.cc/RGX6-7STC>].

70. See *id.*

71. See Eric Mack, *The Spoken Hashtag Must Die — Here’s How*, CNET (Aug. 1, 2012, 4:46 PM), <http://www.cnet.com/news/the-spoken-hashtag-must-die-heres-how/> [<https://perma.cc/8Q6S-SSR5>]; see also “#Hashtag” with Jimmy Fallon & Justin Timberlake (*Late Night with Jimmy Fallon*), YOUTUBE (Sep. 24, 2013), <https://www.youtube.com/watch?v=57dzaMaouXA> [<https://perma.cc/E7LH-5KB5>] (lampooning the practice of hashtagging and “verbal” hashtagging through a skit featuring Jimmy Fallon, Justin Timberlake, and Ahmir Khalib Thompson, aka “QuestLove”).

72. Ashley Parker, *Twitter’s Secret Handshake*, N.Y. TIMES (June 12, 2011), http://www.nytimes.com/2011/06/12/fashion/hashtags-a-new-way-for-tweets-cultural-studies.html?_r=0 [<https://perma.cc/CX23-B3VW>].

come a new cultural shorthand,⁷³ as its use has expanded beyond mere grouping and categorizing into a wink-wink way of adding “humor, context and interior monologues”⁷⁴ to our communication.⁷⁵ As one scholar pointed out, “You’ll see them used as humor, as sort of meta-commentary, where you’ll write a message and maybe you don’t really believe it, and what you really think is in the hashtag.”⁷⁶ For example, “a message that reads ‘3 hour delay on Amtrak #StimulusDollarsAtWork,’ likely implies that the user does not, in fact, think that their stimulus dollars are hard at work.”⁷⁷ This trend has, understandably, drawn the ire of some commentators, who bemoan the hashtag’s “misuse” as annoying, irritating, and even threatening to the English language.⁷⁸

In any event, love them or hate them, marketers can no longer ignore them.⁷⁹ And as they have engrained themselves into the fabric of life, the question of ownership, from an intellectual property perspective, has come front and center.⁸⁰

III. WHEN SOCIAL MEDIA AND INTELLECTUAL PROPERTY COLLIDE: TRADEMARK PROTECTION FOR HASHTAGS

A. Trademarks Generally

A trademark may be any one or more words, devices, or symbols — or some composite of both — that someone uses to distinguish his goods or services from those of others.⁸¹ For example, the trademark “Coca-Cola” distinguishes the brown, carbonated beverage made by the Coca-Cola Company from similar brown, carbonated beverages made by other companies — for instance, PepsiCo, Inc.⁸²

73. *Id.*

74. *Id.*

75. *Id.*

76. *Id.*

77. *Id.*

78. See Sam Biddle, *How the Hashtag Is Ruining the English Language (Updated)*, GIZMODO (Dec. 28, 2011, 2:54 PM), <http://gizmodo.com/5869538/how-the-hashtag-is-ruining-the-english-language> [https://perma.cc/A5Q2-B2ZU].

79. See Daniel Stein, *#Stopthetmadness: Advertisers Are Guilty of Hashtag Abuse*, DIGIDAY (Mar. 3, 2014), <http://digiday.com/brands/stopthetmadness-advertisers-guilty-hashtag-abuse/> [https://perma.cc/L3XT-RCCX].

80. See, e.g., Arina Shulga, *Who Owns #Hashtags?*, BUS. L. POST (May 12, 2013), <http://www.businesslawpost.com/2013/05/who-owns-hashtags.html> [https://perma.cc/9ZBU-CPW9].

81. 15 U.S.C. § 1127 (2012).

82. *Overview of Trademark Law*, BERKMAN CTR. FOR INTERNET & SOC’Y, <https://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> [https://perma.cc/26DX-R4FH].

Most scholars and courts agree that trademarks serve two purposes: to protect consumers from deception and confusion, and to protect the infringed mark as property.⁸³ These dual interests often work symbiotically.⁸⁴ Take, for example, an average consumer looking for her cola drink of choice. If she wants Coca-Cola, she can find it quickly by looking for a red can with white script lettering that reads “Coca-Cola.”⁸⁵ Ensuring that only Coca-Cola can market its drink in that manner protects the consumer from purchasing a competitor’s product — which, in her mind may be substandard, or even dangerous — by mistake.⁸⁶ And in making Coca-Cola easier to identify, trademark law gives the Coca-Cola Company an incentive to invest in the quality of its product.⁸⁷ After all, if our consumer buys a can of Coke and isn’t satisfied, she will most certainly avoid making the same mistake the next time she’s thirsty.⁸⁸ In that way, it is important to protect Coca-Cola’s investment; if other companies could “free-ride” on the good will Coca-Cola has worked hard to build by selling their own product with a deceptively similar mark, the incentive to invest would evaporate.⁸⁹

So, it should go without saying that in order to be protectable as a trademark, the mark must be *capable* of distinguishing one’s goods or services from those of others.⁹⁰ In other words, a protectable trademark must be distinctive.⁹¹

83. J. THOMAS MCCARTHY, 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:2 (4th ed. 2015). McCarthy notes that some have argued that, historically, the avoidance of consumer confusion/deception purposes overshadowed the concept of protecting trademarks as property. *Id.* § 2:1. But in his opinion, “to select as paramount either protection of the trademark property or protection of consumers would be to oversimplify the dual goals of trademark law, both historical and modern.” *Id.* § 2:2. He explains that as trademark and unfair competition law evolved from Eighteenth and Nineteenth Century case law, it must be understood in light of the distinction between equitable Courts of Chancery and Courts of Law. *Id.* § 2:1. “In the Law Courts, the case was seen primarily as concerning a type of fraud and deceit practiced by the defendant on the public, to the injury of the trademark owner. In Chancery, the case was seen... as an injury to the plaintiff’s property right embodied in the trademark.” *Id.*

84. MCCARTHY, *supra* note 83, § 2:2.

85. See Turner Duckworth, *Coca-Cola — “Coca-Cola Classic Can,”* ADFORUM, <http://www.adforum.com/creative-work/ad/player/34447187> [https://perma.cc/32SW-HH4W]. Admittedly, the “red can” and “white script lettering” components of my example constitute trade dress, and not trademark. See MCCARTHY, *supra* note 83, § 8:1. However the analysis is largely the same regardless. *Id.*

86. See *Overview of Trademark Law*, *supra* note 82.

87. *Id.*

88. *Id.*

89. See James T. Caleshu, *Trademarks and the “Free-Ride” Doctrine*, 16 STAN. L. REV. 736, 737 (1963–1964).

90. 15 U.S.C. § 1052 (2006). As will be discussed below, despite spending 850 words on its advice to examiners regarding the registrability of hashtags, the USPTO’s guidance can be boiled down to just one sentence: “A mark comprising or including the hash symbol (#) or the term HASHTAG is registrable as a trademark or service mark only if it functions as

B. The Categorization of Trademarks

In determining whether a mark is distinctive, courts will place it in one of four categories based on the relationship between the mark and its associated product or service: (1) generic, (2) descriptive, (3) suggestive, or (4) arbitrary or fanciful.⁹²

A generic mark is one that merely refers to the “genus” of which the product or service is a species.⁹³ At its most basic level, a generic mark does nothing more than answer the question, “What is it?”⁹⁴ Take the Coca-Cola example above and combine it with a crazy hypothetical: Due to the miracle of modern science, what if we were able to resurrect the frozen corpse of one of our nation’s Founding Fathers who passed away in the early 1800s?⁹⁵ When we hand him a can of Coke, how would we describe it?⁹⁶ Clearly, we cannot just say, “Why, it’s Coca-Cola of course!”; that description would bear no meaning to someone who has never seen, tasted, or heard of Coca-Cola.⁹⁷ Rather, we would probably tell him, “It’s a flavored, carbonated beverage.”⁹⁸

an identifier of the source of the applicant’s goods or services.” USPTO, *supra* note 23, § 1202.18.

91. JEROME GILSON & ANNE GILSON LALONDE, 1–2 GILSON ON TRADEMARKS § 2.01 (2015).

92. *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9–10 (2d Cir. 1976).

93. *Id.*

94. GILSON, *supra* note 91, § 2.02.

95. Ridiculous, I know. *But see Cryonics*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Cryonics> [<https://perma.cc/8J77-TJ9C>] (discussing the idea of cryogenically preserving people or large animals in hopes that advancements in technology will enable us to “reco- ver” them at some time in the future).

96. Because, of course, he will probably be somewhat distrustful of his surroundings and inclined to ask what it is we are telling him to imbibe.

97. According to the Coca-Cola Company, the drink was not invented until 1886, when John S. Pemberton concocted and served it at Jacobs’ Pharmacy in Atlanta. COCA-COLA CO., 125 YEARS OF SHARING HAPPINESS: A SHORT HISTORY OF THE COCA-COLA COMPANY 4, http://assets.coca-colacompany.com/a7/5f/95ccf35a41d8adaf82131f36633c/Coca-Cola_125_years_booklet.pdf [<https://perma.cc/RWF7-T65M>]. Thus, our Founding Father — again, assuming he died in the early 1800s — would not have had the pleasure of enjoying a Coke during his lifetime.

98. Carbonated drinks were invented in 1767 by Englishman Joseph Priestley, who first discovered a method of infusing water with carbon dioxide to make carbonated water. *Soft Drink*, WIKIPEDIA, https://en.wikipedia.org/wiki/Soft_drink [<https://perma.cc/2BU2-R8GX>]. Shortly thereafter, Johann Jacob Schweppe began manufacturing carbonated mineral water. *Id.* “He founded the Schweppes Company in Geneva in 1783 and relocated his business to London in 1792.” *Id.* Thus, it is safe to assume that our hypothetical Founding Father would have been familiar with the notion of a carbonated drink. Furthermore, to the extent one might suggest answering our Founding Father by saying, “It’s a particular brand of cola,” that too would be meaningless. Although Merriam-Webster defines the word “cola” as “a carbonated soft drink colored usually with caramel and flavored usually with extracts from kola nuts,” it identifies the origin of the word as coming from Coca-Cola itself. *Cola*, MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/cola> [<https://perma.cc/5AFV-9ZAX>].

That type of denominative label for a product or service can never serve as an enforceable trademark, because it's a competitive necessity that marketers be able to generally describe what they are selling.⁹⁹ Other examples of generic marks: "piano" is the generic name for one type of keyboard instrument, "cat food" is the generic name for food one buys to feed cats, and "pen" is the generic name for an ink-filled writing instrument.¹⁰⁰

Next on the spectrum of distinctiveness are those marks that are descriptive. Whereas generic marks — such as piano, cat food, and pen — are typically nouns, descriptive marks are usually adjectives or adverbs that describe the product or service: its characteristics, size, weight, dimensions, uses, or components.¹⁰¹ But like generic marks, terms that merely *describe* typically do not perform the essential trademark function of distinguishing the source of products or services.¹⁰² For example, using the word "tasty" to describe a cupcake company does not distinguish, inasmuch as competing bakeries would likely say their confections are tasty too.¹⁰³ Thus, "Tasty Cupcakes" would not qualify for trademark protection.¹⁰⁴ But a descriptive term *can* be protectable if it attains what is known as "secondary meaning," — that is, the public has come to regard it as a particular company's trademark.¹⁰⁵

The idea of secondary meaning accounts for the reality that, sometimes, terms with an ordinary and primary meaning of their own "may by long use with a particular product, come to be known by the public as specifically designating that product."¹⁰⁶ If a trademark plaintiff wants to rely on secondary meaning, it "must show that the primary significance of the term in the minds of the consuming public is not the product but the producer."¹⁰⁷ Examples of descriptive terms that courts have held acquired secondary meaning are "Bug" associated with the Volkswagen Beetle,¹⁰⁸ "Fish-Fri" associated with Zata-

99. GILSON, *supra* note 91, § 2.02.

100. *Id.* Interestingly, there are a number of products that at one time were *not* generic, but would now be considered so: "Yo-yo," "thermos," and "escalator," for example, were all at one time registered trademarks that have become so synonymous with the *type* of product they describe so as to no longer be distinctive. *Id.* For example, what would you call a yo-yo if you could not use that name? According to Gilson, this process of "genericide," is often difficult to prevent. *Id.*

101. *Id.* § 2.03.

102. *Id.*

103. *See id.*

104. *See id.*

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

106. *Volkswagenwerk Aktiengesellschaft v. Rickard*, 492 F.2d 474, 477 (5th Cir. 1974).

107. *Kellogg Co. v. Nat'l Biscuit Co.*, 305 U.S. 111, 118 (1938).

108. *Volkswagenwerk Aktiengesellschaft*, 492 F.2d at 478.

rain's fried fish batter mix,¹⁰⁹ and "Nu-Enamel" associated with a company's paint.¹¹⁰

After descriptive marks, the next category is suggestive.¹¹¹ Suggestive marks, as their name implies, merely suggest — but without explicitly describing — the qualities or functions of a product or service.¹¹² They will typically require a slight exercise of imagination by the consumer to connect the mark and its product, but that gap shouldn't be particularly wide.¹¹³ Take, for example, Coppertone sunscreen.¹¹⁴ If one had never heard of the product and were asked, "guess what 'Coppertone' is?," we could imagine a bevy of wild guesses; nothing about "Coppertone" necessarily implies sunscreen.¹¹⁵ But if that same person were asked, "I have an unnamed sunscreen — do you think 'Coppertone' is a good name?," the response would likely be, "Absolutely!," as the responder pictures himself on the beach with a golden tan.¹¹⁶ Other examples of suggestive marks are "Slickcraft" for recreational boats¹¹⁷ and "Visa" for a credit card.¹¹⁸

Where the descriptive common word leads the buyer by the hand, the rarer suggestive mark ushers through the mind. From the commercial name to the product or its market to its source, the suggestive term transports both through purposefully evocative words laden with intimation and through the contemplated imagery and associations the name conjures. That passage is neither linear nor strait [sic]. It

109. *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 799 (5th Cir. 1983).

110. *Armstrong Paint & Varnish Works v. Nu-Enamel Corp.*, 305 U.S. 315, 336 (1938). In categorizing the mark, the Court noted that the "phonetically spelled or misspelled" word "Nu" in place of "New" did not take it outside the bounds of being descriptive. *Id.* at 328. "Obviously this slight variation from the orthographic normal is not unusual." *Id.*

111. GILSON, *supra* note 91, § 2.04.

112. *Id.*

113. *Platinum Home Mort. Corp. v. Platinum Fin. Grp., Inc.*, 149 F.3d 722, 727 (7th Cir. 1998) (quoting *Sands, Taylor & Wood Co. v. Quaker Oats Co.*, 978 F.2d 947, 952 (7th Cir. 1992)).

114. Michael J. Salvatore, *Trademark Registration Basics: An Overview for General Practitioners*, A.B.A.: TYL, https://www.americanbar.org/publications/tyl/topics/intellectual-property/trademark_registration_basics_overview_general_practitioners.html [<https://perma.cc/29V8-YCE3>].

115. *See id.*

116. *See id.*

117. *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 349 (9th Cir. 1979).

118. *Visa Int'l Serv. Ass'n v. Visa Hotel Grp., Inc.*, 561 F. Supp. 984, 991 (D. Nev. 1983).

demands a mental exercise, multiple bounds in a dual act of perception and imagination.¹¹⁹

Because suggestive marks are inherently distinctive, they do not require secondary meaning to gain protection.¹²⁰

The final category — which could very easily be two categories unto themselves — is the arbitrary or fanciful trademark.¹²¹ Arbitrary marks are those that have an ordinary meaning, but that meaning has no relation to the product or service to which it is tied.¹²² For example, the “Apple” in Apple Computer is a real thing (a fruit); in fact, its logo is an apple with a bite taken out of it.¹²³ But why name the company that? Because company co-founder Steve Jobs, who had visited an apple farm before coming up with the name, thought it sounded “fun, spirited and not intimidating.”¹²⁴ According to Steve Wozniak, the company’s other co-founder, “We both tried to come up with technical-sounding names that were better, but we couldn’t think of any good ones. Apple was so much better, better than any other name we could think of.”¹²⁵ Other examples of arbitrary marks are Domino’s Pizza and Amazon.com.¹²⁶

119. *BigStar Entm’t Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 196 (S.D.N.Y. 2000).

120. *Sun Banks of Fla., Inc. v. Sun Fed. S&L Ass’n*, 651 F.2d 311, 315 (5th Cir. 1981).

121. GILSON, *supra* note 91, § 2.04.

122. *King of the Mountain Sports, Inc. v. Chrysler Corp.*, 185 F.3d 1084, 1093 (10th Cir. 1999).

123. Holden Frith, *Unraveling the Tale Behind the Apple Logo*, CNN (Oct. 7, 2011), <http://www.cnn.com/2011/10/06/opinion/apple-logo/> [https://perma.cc/CJK5-JULC].

124. Steve Rivkin, *How Did Apple Computer Get Its Brand Name?*, BRANDING STRATEGY INSIDER (Nov. 17, 2011), <http://www.brandingstrategyinsider.com/2011/11/how-did-apple-computer-get-its-brand-name.html> [https://perma.cc/DZ4L-UPWM].

125. *Id.* According to Wozniak, the first thing he said to Jobs upon hearing the idea to name the company “Apple Computer” was, “[w]hat about Apple Records?” — referring to the Beatles’ record label. *Id.* As it happened, Apple Records — well, actually, Apple Records’ parent company, Apple Corps — sued Apple Computer in 1978 for trademark infringement. Alex Salkever, *John, Paul, George, Ringo...and Steve?*, BUSINESS WEEK ONLINE (Sep. 30, 2004), https://web.archive.org/web/20070310204214/http://www.businessweek.com/technology/content/sep2004/tc20040930_9317_tc056.htm [https://perma.cc/J3B7-NH6D]. The case settled several years later with Apple Computer paying Apple Corps \$80,000 and promising to stay out of the music business. See Tom Hombry, *What’s In a Name? Apple Corp vs. Apple Computer*, LOW END MAC (Apr. 27, 2014), <http://lowendmac.com/2014/whats-in-a-name-apple-corp-vs-apple-computer/> [https://perma.cc/5757-EPK5]. But peace did not get its chance, as the record company sued the computer company again in 1991, claiming that it violated the previous agreement by equipping its computers with software — the Musical Digital Interface (Midi) — that allowed users to create, record, and edit music. *Id.* That case settled too, only to beget more litigation in 2003 when the computer company launched its iTunes music service. *Id.* A British judge ruled three years later that iTunes’s use of the name “Apple” was in connection with its store, and not music, and thus did not violate the parties’ earlier settlement agreement. *Apple Computer Triumphs in Beatles Case*, BILLBOARD (May 8, 2006), <http://www.billboard.com/articles/news/58508/apple-computer-triumphs-in-beatles->

Fanciful marks, unlike arbitrary ones, will not be found in the dictionary,¹²⁷ at least not until they become famous. Words such as “Exxon” and “Kodak” — seemingly invented out of thin air¹²⁸ — make up this category. Fanciful marks are words invented or selected for the sole purpose of functioning as a trademark.¹²⁹ For that reason, they are awarded the highest degree of protection of any trademark.¹³⁰ One should think of the categories as a sort of spectrum; at one end, generic marks receive no protection, but as we move along toward descriptive, and then suggestive, and then arbitrary and fanciful, the protection afforded increases accordingly.¹³¹

C. Slogans as Trademarks

The discussion up to this point has mostly focused on brand names. Indeed, all the examples I’ve used — for example, Coca-Cola, Coppertone, Visa, Domino’s, Apple Computer — are names that describe either a company or specific product. But what about a slogan, phrase, or tag line?¹³² Are these “trademarkable”? And if so, how should they be categorized?¹³³ The answers to both questions are important, because many advertisers’ social media campaigns (including hashtag campaigns) will center on creative slogans or phrases, as opposed to the company or product name itself.¹³⁴

As McCarthy notes, “Neither in the common law nor in the Lanham Act is there any reason why a plurality of words cannot function as a mark to identify and distinguish goods and services.”¹³⁵ In fact, slogans or other combinations of words have long been protected so long as they’re used to identify and distinguish a seller’s goods and

case [<https://perma.cc/ZJC8-TPTQ>]. The record company appealed, but in 2007 the parties finally settled the dispute. See Jonny Evans, *EMI, Apple Corps Deal Good News for iTunes?*, MACWORLD (Apr. 12, 2007), <http://www.macworld.co.uk/news/apple/emi-apple-corps-deal-good-news-itunes-17737/> [<https://perma.cc/M9DN-Z3DX>].

126. GILSON, *supra* note 91, § 2.04.

127. *Id.*

128. *George Eastman*, KODAK, http://www.kodak.com/ek/US/en/George_Eastman.htm [<https://perma.cc/V869-85Z8>].

129. *Sally Beauty Co. v. Beautyco, Inc.*, 304 F.3d 964, 976 (10th Cir. 2002).

130. *Eli Lilly & Co. v. Nat. Answers, Inc.*, 233 F.3d 456, 462 (7th Cir. 2000). “The strongest protection is reserved for fanciful marks that are purely the product of imagination and have no logical association with the product.” *Id.* at 466.

131. *Daddy’s Junky Music Stores, Inc. v. Big Daddy’s Family Music Ctr.*, 109 F.3d 275, 280 (6th Cir. 1997).

132. See MCCARTHY, *supra* note 83, § 7:19.

133. See *supra* Part III.B.

134. See, e.g., Jillian Zacchia, *Hashtag Marketing: How Brands Are Using Hashtags to Engage Across Platforms*, SPARKSHEET (June 7, 2013), <http://sparksheet.com/hashtag-marketing-how-brands-are-using-hashtags-to-engage-across-platforms/> [<https://perma.cc/CL5T-RQCV>].

135. MCCARTHY, *supra* note 83, § 7:19.

services from those of others.¹³⁶ Slogans can even incorporate other marks. For example, Coca-Cola's 1980s slogan "Coke is it!" was trademarked as a slogan, even though the three-word tagline already included a trademarked word — Coke.¹³⁷

In terms of how a slogan will be categorized and the strength it will be afforded, the usual generic-to-arbitrary/fanciful spectrum still applies.¹³⁸ It is hard to imagine an advertising slogan that would qualify as generic (advertisers typically pride themselves on their creativity), although perhaps something like "Custom-Blended" (as a slogan for gasoline) would count.¹³⁹

Rather, it is far more likely that slogans will be descriptive.¹⁴⁰ But as with brand names, a slogan that merely describes a good or service will only be protected if it acquires secondary meaning — it needs to achieve such a special significance that the word has come to mean that the product or service is tied to its source.¹⁴¹ So, slogans such as "The Champagne of Bottled Beer" for Miller beer and "Extra Strength Pain Reliever" for Excedrin pain reliever, despite being merely descriptive, would be protectable under the secondary-meaning doctrine.¹⁴²

It is possible to construct a suggestive (which would not require secondary meaning) slogan.¹⁴³ They will typically be clever plays on

136. *See id.* McCarthy notes, however, that "the longer the slogan, the less the probability that it functions as a trademark, and the greater the probability that the slogan is merely advertising copy — protectable, if at all, by copyright law." *Id.* This is because copyright law does not protect short, functional phrases, while trademark law only prevents the use of one's mark in such a way as to cause confusion. *Id.* §§ 6:14, 6:19. But there are some situations where copyright law and trademark law *may* overlap — for instance, when a copyrightable picture is also used as a mark to identify the source of goods or services — to grant protection to a single item. *Id.* § 6:14.

137. COKE IS IT!, Registration No. 1,258,784. Surprisingly, Coca-Cola did not apply for trademark protection for the word "Coke" until 1945, and even then, the company sought registration only to avoid losing the term to genericity as a result of people referring to "any fizzy drink" or any cola as "Coke." Shireen Smith, *How Safe Is Coca Cola's Trade Mark COKE?*, AZRIGHTS (June 28, 2010), <http://azrights.com/media/news-and-media/blog/intellectual-property/2010/06/how-safe-is-coca-colas-trade-mark-coke/> [perma.cc/EJS4-76WS]. This fight had been going on for decades; in 1913 the company's campaign slogan was, "Ask for it by its full name — then you will get the genuine." *Id.*

138. MCCARTHY, *supra* note 83, § 7:22.

139. *See In re Sun Oil Co.*, 426 F.2d 401, 403 (C.C.P.A. 1970) (Rich, J., concurring); *see also id.* ("While I see no objection to pointing out to appellant that its evidence has not established 'secondary meaning,' I am unwilling to lead appellant... to think that the fault was in the quantity or quality of... evidence rather than in the descriptiveness of the words sought to be registered.")

140. This includes "self-laudatory" slogans, such as "America's Best Popcorn" or "America's Freshest Ice Cream," which include such ordinary and common phrases that consumers could not identify them with a single source. MCCARTHY, *supra* note 83, § 7:22.

141. *See id.*

142. *Bristol-Myers Co. v. Approved Pharm. Corp.*, 149 U.S.P.Q. (BNA) 896, 1966 WL 7631, at *1, 5 (N.Y. Sup. Ct., June 7, 1966).

143. MCCARTHY, *supra* note 83, § 7:22.

words or other types of catchy and artistic phrasing that go beyond the merely descriptive.¹⁴⁴ For example, “Sportswear for Everywear” for clothing and “From Maine’s Cool Breeze to the Florida Keys” for a moving company have been determined to be suggestive.¹⁴⁵

As with the generic category, it is hard to imagine advertisers pushing a truly arbitrary or fanciful slogan on consumers.¹⁴⁶ A fanciful phrase (something made up, like “Our product will scumcorkdor-framel to bouncerblue”), by its very nature, will not make any sense as a slogan, and even arbitrary phrases (those that consist of real words used outside of their normal meaning) will likely leave people scratching their heads (e.g., “Tylenol: Celery sticks for your trees!”).¹⁴⁷

D. Where Do Hashtags Fit In?

So that brings us to hashtags. Do they fit within the traditional trademark legal framework? As I’ve discussed above, hashtags have become a commonplace component of advertising.¹⁴⁸ But marketers are growing more savvy, and it’s not uncommon to see specific advertising campaigns that center on the hashtag itself — not just as pointer to the company’s Facebook or Twitter page, but as a carefully designed promotion that implores potential customers to actually *use* the hashtag in the way it was intended.¹⁴⁹

For example, in 2013, Charmin toilet paper launched the “tweet-fromtheseat” campaign “to take advantage of the staggering number of people who use social media in the bathroom.”¹⁵⁰ In 2012, Dr. Pepper aired a commercial with people wearing red shirts that explained their personalities (“I’m a Dreamer,” “I’m a Cougar,” “I’m a Control Freak,” etc.).¹⁵¹ The ad, which was part of the soft drink’s “Always

144. *Id.*

145. *In re David Crystal, Inc.*, 145 U.S.P.Q. (BNA) 95, 1965 WL 7370, at *1 (T.T.A.B. Mar. 30, 1965); *In re Lincoln Park Van Lines*, 149 U.S.P.Q. (BNA) 313, 1966 WL 7196, at *1 (T.T.A.B. Mar. 31, 1966).

146. *See In re Sottile*, 156 U.S.P.Q. (BNA) 655, 1968 WL 8080, at *3 (T.T.A.B. Jan. 24, 1968) (“[S]logans are usually composed of dictionary words.”).

147. This is not to suggest that advertisers do not create new words and phrases. Stuart Elliott, *Turketarian’ or ‘Meatatarian’? It’s All in the ‘Framily’*, N.Y. TIMES (Apr. 15, 2014), http://www.nytimes.com/2014/04/16/business/media/turketarian-or-meatatarian-its-all-in-the-framily.html?_r=0 [<https://perma.cc/5SR7-F95L>]. But when they do, those new words or phrases are typically variations or combinations of existing words, or at least sufficiently connected that consumers can quickly understand the campaign. *See id.*

148. *See Zacchia*, *supra* note 134.

149. *Id.*

150. *Id.*

151. Anna Washenko, *3 Excellent Uses of Twitter and Hashtags in TV Commercials*, SPROUTSOCIAL (Mar. 20, 2013), <http://sproutsocial.com/insights/twitter-hashtags-tv-examples/> [<https://perma.cc/Y9MS-MP94>].

One of a Kind” slogan, featured the hashtag “#ImA” at the very end.¹⁵² These kind of advertisements — no different from the ill-fated #McDStories campaign — are specifically calculated to take advantage of social media’s “dialogic” transmission model (many sources to many receivers), as opposed to the “monologic” transmission model (one source to many receivers) of traditional marketing.¹⁵³

Not surprisingly, as the popularity of hashtagging began to grow, many began to question whether this new form of promotion would be entitled to the same form of trademark protection as traditional advertising.¹⁵⁴ In October 2013, the USPTO officially answered when it revised its Trademark Manual of Examining Procedure.¹⁵⁵ One of the additions it made was section 1202.18, which specifically deals with “Hashtag Marks.”¹⁵⁶

In all, the section is quite thorough, and it is clear much thought went into it. And to be sure, it is not entirely off base; one could argue that its overall tone is one of caution and skepticism toward the registration of hashtags. For example, it warns that “[t]he addition of the term HASHTAG or the hash symbol (#) to an otherwise unregistrable mark typically cannot render it registrable.”¹⁵⁷ It goes on to reason:

Generally, the hash symbol and the wording HASHTAG do not provide any source-indicating function because they merely facilitate categorization and searching within online social media (i.e., social-media participants are directed to search a particular subject by typing, e.g., ‘hashtag ABC,’ where ABC is the subject). . . . Thus, if a mark consists of the hash symbol or the term HASHTAG combined with wording that is merely descriptive or generic for the goods or services, the entire mark must be refused as merely descriptive or generic.¹⁵⁸

It provides “#SKATER for skateboarding equipment” as an example of a “merely descriptive” mark that would not qualify for protection.¹⁵⁹

152. *Id.*

153. PAVLIK, *supra* note 29, at 189.

154. *Can I Trademark My Awesome Hashtag?*, DAVIS & UDOKA (Sept. 25, 2015), <http://davisudoka.blogspot.com/2016/01/can-i-trademark-my-awesome-hashtag.html> [<https://perma.cc/G7AD-YZHV>].

155. USPTO, TMEP § 1202.18 (Oct. 2015).

156. *Id.*

157. *Id.*

158. *Id.*

159. *Id.*

In giving examples of marks that would be more than merely descriptive, (“#SLUGGERTIME for clothing, #DADCHAT for counseling services, and HASHTAGWALKING for entertainment services”), it cautions that if the proposed hashtag-appended mark is “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,” and that “[i]n such cases, registration must be refused. . . .”¹⁶⁰

But those warnings should not be confused with an unwillingness to grant trademark status to hashtags generally.¹⁶¹ Indeed, no one would argue that a hash symbol should act as some sort of legal Fairy Godmother, magically transforming an otherwise unregistrable mark into one deserving of protection,¹⁶² so the USPTO saying as much is hardly revolutionary.¹⁶³ Likewise, its cautionary words that its examiners should ensure the mark actually identifies the source of goods or services — as opposed to just facilitating search on a topic — does little more than remind us how the overwhelming majority of social media users employ hashtags.¹⁶⁴ In the end, the reality remains that the USPTO apparently believes that trademark protection *should* extend to hashtagged terms to the same degree other terms or slogans are protected: So long as it functions as an identifier of the source of the applicant’s goods or services, it qualifies (at least according to the USPTO¹⁶⁵).¹⁶⁶

160. *Id.* As an example, the manual provides: “[I]f the proposed mark #SEWFUN for instruction in the field of sewing appears on a specimen comprising a screenshot of a social networking site used merely to organize users’ comments about sewing classes applicant offers, the mark must be refused registration for failure to function as a service mark.” *Id.*

161. See Patrice N. Perkins, *Can I Trademark a Hashtag?*, CREATIVE GENIUS SOCIETY (May 7, 2014), <http://creativegeniussociety.com/can-i-trademark-a-hashtag/> [<https://perma.cc/E7WZ-LRJ4>].

162. See generally CHARLES PERRAULT, CENDRILLON (1697) (introducing the Fairy Godmother to the “Cinderella” story; the Fairy Godmother magically makes a would-be debutante out of Cinderella, a house servant, by turning her rags into a jeweled gown with glass slippers, a pumpkin into a golden carriage, mice into horses, a rat into a coachman, and lizards into footmen).

163. USPTO, *supra* note 155, § 1202.18. The USPTO also points out, rather unnecessarily: “In unique cases, marks that consist solely of variants of the term HASHTAG or the hash symbol may function as a mark and should not be refused as descriptive or generic,” because “[i]n such cases, the symbol and term HASHTAG do not create the commercial impression of being a metadata tag since they do not immediately precede other wording, and may be considered suggestive or arbitrary... (e.g., HASHTAG for use in connection with liquor or THE HASHTAG for providing office facilities).” *Id.* Of course, I agree; that someone might open a bar called “The Hashtag” and seek trademark protection for it has nothing to do with the scope of this article, which focuses solely on the use of the “#” symbol in social media advertising.

164. See *supra* Part II.B.

165. It is important to remember that “[a]lthough a federal registration will give the owner of a mark important legal rights and benefits, the registration does not create the trade-

IV. WHY TRADEMARK PROTECTION SHOULD NOT EXTEND TO HASHTAGS

The general consensus — including that of the USPTO — appears to be that hashtags are deserving of the same legal status as any other word, term, or phrase that serves to distinguish a product or service.¹⁶⁷ But it is as if that conclusion has been reached in a shoulder-shrugging, “why not?” sort of way, with little (if any) discussion devoted to why it might be a bad idea to extend the law that far. It is my position that granting trademark status to hashtags provides no *legitimate* advantage to a marketer that it could not already obtain through traditional (i.e., sans hashtag) registration.¹⁶⁸ What it *does* do is arm companies with a weapon that would make it easier to bully social media networks and users into silence when these “trademarked” hashtags spark viral discussions that go off the tracks.¹⁶⁹ Think about it this way: if the idea of trademark law is to *discourage* use by anyone other than the trademark holder, then what purpose is served by awarding protection to a mark whose entire reason for existence is to *encourage* use by the entire world?¹⁷⁰

A. Isn't the Content of Hashtags Already Protected (or Protectable)?

I spent extensive time discussing the general tenets of trademark law only because it is important to my first (which, I hope, is an undisputed) position: A marketer's hashtagged word, term, or phrase is *absolutely* protectable *without* the appended hashtag.¹⁷¹ In other words, the hashtag does not change the nature of the slogan it precedes, so long as that slogan serves as a distinctive brand identifier.¹⁷²

mark.” MCCARTHY, *supra* note 83, § 19:3. Likewise, “[t]he government, by registering a mark, does not thereby give its approval or imprimatur to the propriety, suitability, or tastefulness of the mark or of the suitability or quality of the goods or services with which it is used.” *Id.* § 19:3.50. “[G]overnment registration of a mark is neither a government endorsement of the quality of the goods to which the mark is applied nor a government pronouncement that the mark is a good or reliable one in any moral or commercial sense.” *Id.*; see also *supra* note 24 and accompanying discussion.

166. Daliah Saper, *Are Hashtags Intellectual Property?*, BUSINESS.COM (June 19, 2015), <http://www.business.com/legal/are-hashtags-intellectual-property/> [https://perma.cc/YNS6-4YSL].

167. See *supra* Part III.D.

168. See *infra* Part IV.A.

169. See *infra* Part IV.B.3.

170. See *infra* Part IV.B.3.

171. See *supra* Part III.

172. See Valentina Torelli, *Trade Marks in Social Networks: The Case of Coke's Hashtag Trade Mark Applications*, IPKAT (Apr. 15, 2015), <http://ipkitten.blogspot.com/2015/04/trade-marks-in-social-networks-case-of.html> [https://perma.cc/4TRU-FZKH].

The reason is because of a doctrine called “tacking,”¹⁷³ which essentially says that close is good enough.¹⁷⁴

The Supreme Court most recently summed up the doctrine as follows:

Recognizing that trademark users ought to be permitted to make certain modifications to their marks over time without losing priority, lower courts have provided that, in limited circumstances, a party may clothe a new mark with the priority position of an older mark. This doctrine is called “tacking,” and lower courts have found tacking to be available when the original and revised marks are “legal equivalents” in that they create the same, continuing commercial impression.¹⁷⁵

Certainly, an already trademarked word or phrase can be tacked onto by the simple addition of a “pound” sign; they would obviously “create the same, continuing commercial impression.”¹⁷⁶ For example, clothing retailer Nike has trademarked the word “Nike.”¹⁷⁷ It does not need to trademark “#Nike,” as it can simply tack on to its existing trademark.¹⁷⁸ In the same way, adding a hashtag to a trademarked slogan — for example, taking Nike’s famous tagline “Just Do It” and creating “#justdoit” — does not give us some new, yet-to-be protected mark.¹⁷⁹ And of course, if we’re talking about a new, non-trademarked slogan that does not yet exist, that could be used or registered in the traditional manner (without a hashtag), then any future use with a hashtag would be protected through tacking.¹⁸⁰

By way of an actual example, in December 2014, Coca-Cola applied for trademark registration of two hashtags: “#cokecanpics” and

173. See *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159–60 (Fed. Cir. 1991), *abrogated by* *Hana Financial, Inc. v. Hana Bank*, 135 S. Ct. 907 (2015).

174. Baseball great Frank Robinson reportedly said, “[c]lose only counts in horseshoes and hand grenades.” Nick Acocella, *More Info on Frank Robinson*, ESPN CLASSIC, <http://espn.go.com/classic/000728frankrobinsonadd.html> [<https://perma.cc/LHS5-8CZJ>]. A trademark scholar, Robinson was not.

175. *Hana Financial*, 135 S. Ct. at 909.

176. *See id.*

177. *Trademark Electronic Search System (TESS)*, USPTO, <http://tess2.uspto.gov/bin/gate.exe?f=tess&state=4803:r9tggg.1.1> [<https://perma.cc/UT3E-DNET>] (search for “Nike” under the basic word mark option).

178. *See, e.g.*, NIKE, Registration No. 3,081,688.

179. *See Hana Financial*, 135 S. Ct. at 909.

180. *See id.*

“#smilewithacoke.”¹⁸¹ Presumably, the company has (or had) in mind a social-media advertising campaign where users would take pictures of themselves holding or drinking a Coca-Cola beverage, and then post those pictures online using one or both of the hashtags.¹⁸² Neither slogan — with or without the hashtags — had been registered before, and neither had ever been used in Coca-Cola’s advertising.¹⁸³ So did Coca-Cola really need to register the two hashtags?

Starting with the obvious: Coca-Cola already has a trademark in the word “Coke,” and thus any competitor who used “#cokecanpics” or “#smilewithacoke” would unquestionably be infringing Coca-Cola’s trademark.¹⁸⁴ Now, what if competitor PepsiCo launched its own campaign, “#pepsicanpics” or “#smilewithapepsi”? Well, if Coca-Cola had been the first to use “#cokecanpics” or “#smilewithacoke,” the court would look at two things: (1) were the Coke slogans suggestive (and therefore inherently distinctive); or (2) were they just descriptive, and if so, did they acquire some sort of secondary meaning?¹⁸⁵ But in either event, the analysis is no different than it would be had the slogans been used in a traditional advertisement (without the hashtag and spaces between the words, for example).¹⁸⁶ My point, rather simply, is that the 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. And so there is no legitimate reason Coca-Cola cannot register (or simply use) “Coke Can Pics” and “Smile With a Coke” — again, without the hash symbol — and still obtain full protection for the hashtagged versions of those same slogans.

B. “Controlling the Discussion”: The Real Reason for Registering Hashtags

So if it is *unnecessary* to trademark hashtagged words, terms, and phrases, does that mean we should not allow it? In other words, “so what?” If a marketer would rather trademark “#cokecanpics” than “Coke Can Pics,” why should we care? And that is certainly a fair

181. David Allison, *Coca-Cola Seeks To Trademark Two Twitter Hashtags*, ATLANTA BUS. CHRON. (Jan. 5, 2015), <http://www.bizjournals.com/atlanta/news/2015/01/05/coca-cola-seeks-to-trademark-two-twitter-hashtags.html> [<https://perma.cc/R9CB-Z9U6>]

182. See Julius Kielaitis, *Coca-Cola Applies To Trademark Hashtag Slogans*, TRADEMARKS & BRANDS ONLINE (June 1, 2015), <http://www.trademarksand-brandsonline.com/news/coca-cola-applies-to-trademark-hashtag-slogans-4231> [<http://perma.cc/75BL-BEJH>].

183. See Torelli, *supra* note 172.

184. See *id.*

185. *Id.*

186. See *id.*

question, particularly if Coca-Cola has no intention of using “Coke Can Pics” outside the hashtag context.¹⁸⁷

My answer — yes, we should absolutely care — isn’t about wanting to see a less-cluttered federal trademark register. Rather, it rests on what I see as a desire by advertisers to have their cake and eat it too.¹⁸⁸ On one hand, they want to harness the awesome power of social media by creatively encouraging discussion about their goods and services.¹⁸⁹ On the other hand, they want the power to rein in that discussion if it goes in an undesired direction.¹⁹⁰

Use of litigation as a tool to silence critics (or just to be a schoolyard bully) is nothing new; it happens frequently in the defamation context, and as I’ve argued in another article, with copyright cases.¹⁹¹ Could trademark infringement cases be the new weapon in a bully’s arsenal? My position is rather simple: The only reason for a company to trademark a word or phrase with an appended hashtag is to increase leverage over social media networks and users when the discussion goes south.¹⁹²

Trademark owners might attempt to do that in a number of creative ways — perhaps by employing trademark dilution or initial-interest confusion theories.¹⁹³ And while those theories may not ultimately be successful, they may nevertheless work by “chilling” speech that is critical of the trademark holder.¹⁹⁴

1. From Hashtag to Bashtag: Social Media Disasters

In her recent article applying memetic theory¹⁹⁵ to trademark law, Professor Shontavia Jackson Johnson points out that America’s “in-

187. *See supra* Part IV.A.

188. *See infra* Part IV.B.3.

189. *See supra* Part II.C.

190. *See infra* Part IV.B.1.

191. *See* Robert T. Sherwin, *Clones, Thugs, ‘N (Eventual?) Harmony: Using the Federal Rules of Civil Procedure to Simulate a Statutory Defamation Defense and Make the World Safe from Copyright Bullies*, 64 DEPAUL L. REV. 823, 826–31 (2015).

192. *See infra* Part IV.B.3.

193. *See infra* Part IV.B.2.

194. *See infra* Part IV.B.3.

195. “Memetics” is the study of how memes — informational units that carry ideas and cultural information — evolve and spread. Francis Heylighen & Klaas Chielens, *Evolution of Culture, Memetics*, in *ENCYCLOPEDIA OF COMPLEXITY AND SYSTEM SCIENCE* 3205, 3205 (Robert Meyers ed., 2009). The term “meme” (pronounced “meem”) was coined by Richard Dawkins: “We need a name for the new replicator, a noun that conveys the idea of a unit of cultural transmission, or a unit of imitation. ‘Mimeme’ comes from a suitable Greek root, but I want a monosyllable that sounds a bit like ‘gene,’” he explained, “I hope my classicist friends will forgive me if I abbreviate mimeme to meme. If it is any consolation, it could alternatively be thought of as being related to ‘memory’, or to the French word *même*. It should be pronounced to rhyme with ‘cream’”. RICHARD DAWKINS, *THE SELFISH GENE* 192 (1989). Memes can be any distinct memorable unit, such as a melody, a catch phrase, or the

fatuation” with the immediate and seemingly unending availability of information has resulted in two “phenomena:” (1) immediate and pervasive fame for people involved in events that become the subject of viral news, and (2) the inextricable linking of words and catchphrases that describe those events.¹⁹⁶ The first, predictably, is fleeting,¹⁹⁷ even prior to the onset of the Internet revolution, sudden fame was thought of as a 15-minute proposition.¹⁹⁸ But the second — those words and catchphrases — have frequently resulted in the formation of cultural icons.¹⁹⁹

For example, recall the Boston Marathon terrorist attack in April of 2013.²⁰⁰ For most, the lasting, distinct, memorable “unit” that came from that event wasn’t the names of the bombers (Dzhokhar and Tamerlan Tsarnaev), or the name of any particular victim, or a pressure-cooker bomb.²⁰¹ No, the lasting meme that instantly comes to

design of a building or clothing article. *See Examples of Memes*, MEMETICS, <http://memetics.chielens.net/memetics/examples.html> [<http://perma.cc/N9UU-RZJQ>]. Given the Internet’s ability to quickly proliferate information, memes are particularly prevalent in cyberspace. *See* Paul Gil, *What Is a “Meme”? What Are Examples of Modern Internet Memes?*, ABOUT TECH, <http://netforbeginners.about.com/od/weirdwebculture/f/What-Is-an-Internet-Meme.htm> [<http://perma.cc/LFG4-NMJN>]. Videos and graphic images like the “Rickroll,” *Rickroll*, KNOW YOUR MEME, <http://knowyourmeme.com/memes/rickroll> [<https://perma.cc/WZE7-Q9M3>], the “Numa Numa Guy,” *Numa Numa*, KNOW YOUR MEME, <http://knowyourmeme.com/memes/numa-numa> [<https://perma.cc/Y4MX-RJG4>], and “Someecards,” *Your Ecards/Someecards.com*, KNOW YOUR MEME, <http://knowyourmeme.com/memes/sites/your-ecards-someecardscom> [<https://perma.cc/2DR9-8CGH>], are common examples. *See generally* KNOW YOUR MEME, <http://knowyourmeme.com/> [<https://perma.cc/CA3W-BUUA>] (“a website dedicated to documenting Internet phenomena: viral videos, image macros, catchphrases, web celebs, and more”). One quintessential type of meme features a frequently used, interchangeable picture with white words in the same font: Impact. Phil Edwards, *The Reason Every Meme Uses That One Font*, VOX (July 26, 2015), <http://www.vox.com/2015/7/26/9036993/meme-font-impact> [<https://perma.cc/K2DR-XW3E>].

196. Shontavia Jackson Johnson, *Memetic Theory, Trademarks & the Viral Meme Mark*, 13 J. MARSHALL REV. INTELL. PROP. L. 96, 97–98 (2013).

197. *Id.* at 98.

198. The expression “fifteen minutes of fame” is generally credited to pop artist Andy Warhol, who reportedly said that “[i]n the future, everyone will be world-famous for 15 minutes” at the 1968 exhibition of his work at the Moderna Museet in Stockholm, Sweden. JEFF GUINN & DOUGLASS PERRY, *THE SIXTEENTH MINUTE: LIFE IN THE AFTERMATH OF FAME 4* (2005). But photographer Nat Finkelstein also claims credit for the expression, explaining that when photographing Warhol two years earlier for a proposed book, Warhol uttered that everyone wants to be famous, to which Finkelstein replied, “Yeah, for about fifteen minutes, Andy.” *Id.* at 364–65.

199. Johnson, *supra* note 196, at 98.

200. *Boston Marathon Bombings*, HISTORY.COM, <http://www.history.com/topics/boston-marathon-bombings> [<https://perma.cc/VGD8-WYS6>].

201. *See* Charlotte Wilder, *What Happened to Boston Strong?*, BOSTON.COM (Apr. 16, 2015), <https://www.boston.com/news/opinion/2015/04/16/what-happened-boston-strong/dxRSWidc0fEBzA3ci479aN/story.html>.

mind three years later was a two-word rallying cry issued that very day: “Boston Strong.”²⁰²

Although it may be impossible to say who created the slogan, three things are for sure: (1) the two bombs exploded at approximately 2:50 p.m.;²⁰³ (2) less than two hours later, a 46-year-old Cleveland man posted the following tweet: “Thoughts and prayers to Boston marathon victims. Hoping for the best. #bostonstrong;”²⁰⁴ and (3) that same day (they claim it was around 4 p.m.), two Emerson College students began selling blue T-Shirts with gold lettering that read “Boston Strong.”²⁰⁵

Whether the meme was created by a Cleveland Twitter user, the college students, or both, it spread with remarkable speed.²⁰⁶ As one columnist noted two years after the tragedy:

The ads came first. The best copywriters couldn’t have come up with words capable of greater impact — commercial use became almost inevitable. McDonald’s included a photo of a marquee sign with “Boston Strong” written on it in a montage of photos showing how caring the company was. Chevy took a lot of heat for a [sic] planning — and then canceling — to give “Silverado Strong” signs to fans at one of the 2013 World Series games at Busch stadium. A Chicago apparel company made t-shirts that said Chicago Stronger when the Blackhawks faced the Bruins in the Stanley cup in 2013.²⁰⁷

As proof of the term’s staying power, on the first anniversary of the bombing, the phrase was mentioned more than 285,000 times on Twitter and Facebook — and that was just one day.²⁰⁸

202. *Id.*

203. *Boston Marathon Terror Attack Fast Facts*, CNN, <http://www.cnn.com/2013/06/03/us/boston-marathon-terror-attack-fast-facts/> [https://perma.cc/9LZT-SQHJ] (last updated Dec. 30, 2015).

204. The user was Curtis Clough (@TigerSuper44680). Robert Burgess, *Where Did The Term Boston Strong Come From?*, BOSTON.COM (Apr. 15, 2014), <https://www.boston.com/2014/04/15/bdc-bostonstrongstart/paU4PMYxb4ayBUwcvBKAQK/story.html>.

205. Wilder, *supra* note 201.

206. Ben Zimmer, “*Boston Strong*,” *The Phrase That Rallied a City*, BOS. GLOBE (May 12, 2013), <https://www.bostonglobe.com/ideas/2013/05/11/boston-strong-phrase-that-rallied-city/uNPFaI8Mv4QxsWqjXBOQO/story.html>.

207. Wilder, *supra* note 201.

208. Melanie Eversley, *Ohio Man Was First To Tweet “Boston Strong,”* USA TODAY (Apr. 22, 2014), <http://www.usatoday.com/story/news/nation/2014/04/22/boston-strong-twitter-ohio/7995557/> [https://perma.cc/23L4-SXB4].

But every “#BostonStrong” success story has a bizarro²⁰⁹ counterpart (such as the aforementioned “#McDStories” catastrophe of 2012), a few of which I outline below.

a. Coca-Cola’s #MakeItHappy

During the 2015 Super Bowl, Coca-Cola aired a commercial urging Twitter users to reply to any sad or negative tweets they encountered with the hashtag “#MakeItHappy.”²¹⁰ It employed an automatic algorithm that would convert the actual letters in the tweets into ASCII²¹¹ art.²¹² Coca-Cola would tweet back, “[w]e turned the hate you found into something happy,” accompanied by an image such as a cute mouse, a man sleeping, or a chicken drumstick wearing a cowboy hat.²¹³ The idea, according to the company, was to “tackle the pervasive negativity polluting social media feeds and comment threads across the Internet.”²¹⁴

Adam Pash, who was the director of the media company Gawker’s editorial labs, had an idea of his own: He created a Twitter handle “@MeinCoke,” and programmed it to repeatedly tweet lines from Adolf Hitler’s autobiography, *Mein Kampf*, before appending the #MakeItHappy tag.²¹⁵ As a result, Coca-Cola’s own Twitter handle was sending out cutesy pictures that consisted of text such as “[w]e must secure the existence of our people and a future for White Children.”²¹⁶ Needless to say, Coca-Cola pulled the campaign hours later, lamenting that “[b]uilding a bot that attempts to spread hate through #MakeItHappy is a perfect example of the pervasive online negativity Coca-Cola wanted to address with this campaign.”²¹⁷

209. Bizarro is a fictional supervillain appearing in DC comic books. *Bizarro*, WIKIPEDIA, <https://en.wikipedia.org/wiki/Bizarro> [https://perma.cc/L37S-HV5V]. He is usually portrayed as a “mirror image” of Superman, insofar as a mirrored image is typically reversed. *Id.* So, while he has all the abilities of Superman, in many incarnations those traits are reversed, such as “freeze vision” instead of “heat vision,” and “flame breath” instead of “freeze breath.” *Id.*

210. Max Read, *Make Hitler Happy: The Beginning of Mein Kampf, as Told by Coca-Cola*, GAWKER (Feb. 4, 2015), <http://gawker.com/make-hitler-happy-the-beginning-of-mein-kampf-as-told-1683573587> [https://perma.cc/SZP6-LHGN].

211. ASCII text art is a visual image that is made up of letters, numbers, and symbols strategically placed on a page. See *ASCII Art*, WIKIPEDIA, https://en.wikipedia.org/wiki/ASCII_art [https://perma.cc/86X2-C4YZ].

212. Read, *supra* note 210.

213. *Id.*

214. Nicky Woolf, *Coca-Cola Pulls Twitter Campaign After It Was Tricked into Quoting Mein Kampf*, GUARDIAN (Feb. 5, 2015), <http://www.theguardian.com/business/2015/feb/05/coca-cola-makeithappy-gakwer-mein-coke-hitler> [https://perma.cc/24CH-9WD3].

215. *Id.*

216. Read, *supra* note 210.

217. Woolf, *supra* note 214.

b. NYPD's #myNYPD

In April 2014, the New York Police Department asked members of the public to tweet pictures they had taken with police officers.²¹⁸ But instead of pictures featuring happy citizens smiling with New York's finest, the hashtag was bombarded with tweets and pictures suggesting police brutality and misbehavior.²¹⁹

For example, @OccupyWallStNYC tweeted, "Here the #NYPD engages with its community members, changing hearts and minds one baton at a time. #myNYPD pic.twitter.com/GERbiFFDvY," accompanied by a picture of an officer swinging his baton at a masked citizen.²²⁰ Another tweet read, "Want some help with that tan? #myNYPD can help! pic.twitter.com/n9P2O1OfGF," joined by a picture of a shirtless man being pinned down and handcuffed by two NYPD officers.²²¹ One user posted a picture of an officer sleeping on a subway train, with the text "An officer from Precinct 114 once ticketed me for doing this exact thing on the N train. #myNYPD."²²²

c. The Islamic State's #WeAllGiveBayahToKhalifah

Even terrorist groups are not immune.²²³ In mid-August 2015, online supporters of the terrorist group ISIS launched a Twitter campaign anchored by the hashtag "#WeAllGiveBayahToKhalifah," which means "We all pledge allegiance to the caliphate."²²⁴ Within hours, anti-ISIS activists were using the hashtag to post various satirical messages and memes, including cartoons intimating ISIS supporters prayed in the wrong direction, photoshopped pictures that showed the organization supporting gay rights, and reminders of victims who had been beheaded by ISIS soldiers.²²⁵ By the fourth hour of the hashtag's existence, it was estimated that 30% of the messages using

218. Abby Phillip, *Well, The #MyNYPD Hashtag Sure Backfired Quickly*, WASH. POST (Apr. 22, 2014), <https://www.washingtonpost.com/news/post-nation/wp/2014/04/22/well-the-mynypd-hashtag-sure-backfired-quickly/> [https://perma.cc/G4KE-LKK2].

219. *Id.*

220. *Id.*

221. *Id.*

222. Inae Oh, *This NYPD Idea Backfired Horribly on Twitter*, HUFFINGTON POST (Apr. 22, 2014), http://www.huffingtonpost.com/2014/04/22/mynypd-nypd-twitter_n_5193523.html [https://perma.cc/S3JA-6K67].

223. See *ISIS Hashtag Campaign Hijacked by Twitter Trolls: A Case Study*, MEMRI (Aug. 26, 2015), <http://www.memrijtm.org/isis-hashtag-campaign-hijacked-by-twitter-trolls-a-case-study.html> [https://perma.cc/WH4R-REP5].

224. *Id.*

225. See *id.*

the hashtag were anti-ISIS; after 24 hours, the percentage of anti-ISIS messages using the hashtag was over 50%.²²⁶

2. Flexing Legal Muscle: Potential Infringement Actions

The examples above are just a sampling of the ways in which social media campaigns can be abused by ordinary Internet users.²²⁷ Obviously, social media presents incredible opportunities to reach consumers in new and revolutionary ways.²²⁸ With so many instances of embarrassment, it is possible some advertisers will stay away from hashtag advertising campaigns, recognizing their nature as a double-edged sword.²²⁹ But others will not; Coca-Cola's registration of "#cokecanpics" and "#smilewithacoke" should be proof enough that many companies will continue to experiment with ways to corral social media's unique powers.²³⁰ Arming themselves with hashtag-specific trademark registrations may be one way to stem the tide of Twitter PR disasters and shift momentum in their war against Internet trolls.²³¹

Once a company obtains trademark registration for a hashtag, there are a few legal theories it might employ against a "hashtag hijacker."²³² Among them are trademark dilution claims and initial-interest confusion claims.

a. Dilution

Aside from the notion of trademark *infringement* — that is, when a consumer is likely to be confused when he sees one seller using a similar or identical trademark to that which belongs to another seller²³³ — is trademark *dilution*.²³⁴ Dilution deals with the possibility that a mark's ability to clearly distinguish only one source can be

226. *Id.*

227. Sara Roncero-Menendez, 8 *Hijacked Hashtags Gone Horribly Wrong (or Right)*, MASHABLE (Oct. 19, 2013), http://mashable.com/2013/10/19/hijacked-hashtags/#_ [https://perma.cc/8933-MJTU].

228. Yohn, *supra* note 21.

229. *See* Roncero-Menendez, *supra* note 227.

230. *See* Allison, *supra* note 181.

231. *See infra* Part IV.B.3.

232. *See ISIS Hashtag Campaign Hijacked by Twitter Trolls: A Case Study*, *supra* note 223.

233. *Groeneveld Transp. Efficiency, Inc. v. Lubecore Int'l, Inc.*, 730 F.3d 494, 504 (6th Cir. 2013).

234. MCCARTHY, *supra* note 83, § 24:67.

weakened or reduced.²³⁵ This can happen in two ways: by blurring or by tarnishment.²³⁶

Dilution by blurring occurs when consumers identify a single mark with two different sources.²³⁷ For example, if an enterprising company were to release a “Chrysler” line of personal computers, few would have any reason to believe that the automaker had all of the sudden jumped into the computer market.²³⁸ But while consumers may not be confused, some would argue that the unique and distinctive connection between the word “Chrysler” and cars is weakened by the noncompeting product’s use.²³⁹ And if the word Chrysler loses its grip on being able to uniquely identify a brand of car, then what’s next?²⁴⁰ Chrysler home appliances? Chrysler tools? Chrysler exercise equipment?²⁴¹ As stated by Professor McCarthy, “Dilution is a name for a kind of erosion of the strength of a mark that could occur in the absence of consumer confusion.”²⁴² Another way to think of it: traditional infringement is when consumers link two similar marks to one source; dilution is when consumers link one mark to two sources.²⁴³

Dilution by tarnishment refers to an entirely different type of conduct, even if the effect — to weaken the mark in the eyes of consumers — is the same.²⁴⁴ “Tarnishment occurs when a famous trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context.”²⁴⁵ The general idea is that it is possible for one to use a mark in such a way as “to undermine or damage the positive associations evoked by the mark.”²⁴⁶

b. Initial-Interest Confusion

Aside from the possibility that dilution theory could apply, there exists another potential pitfall when it comes to hashtags: initial-interest confusion.²⁴⁷ Before we get into the doctrine too deeply, con-

235. *Id.*

236. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 (Am. Law Inst. 1995).

237. See *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 506 (2d Cir. 1996).

238. See MCCARTHY, *supra* note 83, § 24:67.

239. See *id.*

240. See *id.*

241. See *id.*

242. *Id.* § 24:69 (emphasis omitted).

243. *Id.*

244. See *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43 (2d Cir. 1994).

245. GILSON, *supra* note 91, § 5A.01.

246. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25 cmt. g (AM. LAW INST. 1995).

247. See MCCARTHY, *supra* note 83, § 23:6.

sider the following hypothetical posed by Professor Jennifer Rothman:

Suppose you want to compare music downloading software and online music stores that allow you to download music without violating copyright law. You don't know a good search term for such a thing, but you do know the name iTunes and that iTunes is an example of one such service. You don't necessarily want Apple's trademarked product, iTunes — in fact, you've heard that the software has some bugs and takes over your entire music library. But for lack of a better term, you put "itunes" in as your search term on Google, an online search engine, hoping to get some choices. You want to find something *like* iTunes, but *not* iTunes. Under the logic of a number of recent federal appellate court decisions, however, the only result you should see is Apple's iTunes because only Apple is the trademark holder of the term iTunes.²⁴⁸

Could such a result be true? Perhaps. Courts have held that one instance in which infringement can occur is when the use of another's mark causes confusion that creates *initial* customer interest, regardless of whether an actual sale eventually takes place.²⁴⁹

To borrow and modify a hypothetical posed by an early court to take up the issue, imagine if a new, small, family-run, non-chain fast-food restaurant (let's call them McDowell's) put up an interstate highway billboard advertising not itself, but a well-known chain like McDonald's.²⁵⁰ The billboard directed drivers to exit at the next off-ramp and turn right, where they would find all the Big Macs and golden French fries a human being could eat.²⁵¹ Why would McDowell's do that, you ask? Well, remember — McDowell's is new and small, and thus presumably not well-known. Putting up a billboard of its own would be unlikely to attract customers. So it decides to trick potential diners by telling them there's a McDonald's at the next ex-

248. Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105, 107–08 (2005). Rothman based her hypothetical on four cases: *Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004); *Horphag Research, Ltd. v. Pellegrini*, 337 F.3d 1036 (9th Cir. 2003); *Eli Lilly & Co. v. Nat. Answers, Inc.*, 233 F.3d 456 (7th Cir. 2000); and *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999). See Rothman, *supra* at 107 n.1.

249. *Id.* at 106.

250. See *Brookfield*, 174 F.3d at 1064.

251. *Cf. id.*

it.²⁵² Drivers do exit, and when they take the first right, they don't find a McDonald's.²⁵³ Some may get back on the highway and keep driving. But won't some shrug their shoulders and settle for McDowell's as a substitute?²⁵⁴

As the Ninth Circuit pointed out in its hypothetical (which involved video stores, not hamburger restaurants²⁵⁵), "customers are not confused in the narrow sense;" they would be fully aware that they are not eating at McDonalds, nor would they have any reason to believe McDowell's is related to or sponsored by McDonald's.^{256, 257} "Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that [McDowell's] would be misappropriating [McDonald's] acquired goodwill."²⁵⁸

Of course, the subject of this article is Internet social media, and so a hypothetical about physical brick-and-mortar stores may seem inapposite. But it is important to understand the underpinnings of the initial-interest confusion doctrine *precisely because* it has been so

252. *Cf. id.*

253. *Cf. id.*

254. *Cf. id.*

255. Talking about video stores in 1999 was hardly passé. Indeed, 1999 was the year Viacom, Inc. took behemoth rental chain Blockbuster, Inc. public, having paid \$8.4 billion for it just five years earlier. See Matt Phillips & Roberto A. Ferdman, *A Brief, Illustrated History of Blockbuster, Which Is Closing the Last of Its US Stores*, QUARTZ (Nov. 6, 2013), <http://qz.com/144372/a-brief-illustrated-history-of-blockbuster-which-is-closing-the-last-of-its-us-stores/> [<https://perma.cc/WV6J-MBUP>]. The initial public offering raised \$465 million. *Blockbuster's IPO Raises \$465 Million*, L.A. TIMES (Aug. 11, 1999), <http://articles.latimes.com/1999/aug/11/business/fi-64598> [<https://perma.cc/R3EP-37NR>]. Nevertheless, hardly 15 years later, video stores — Blockbuster included — are nearly non-existent, making the Ninth Circuit's hypothetical seem a little behind the times. See Christopher Harress, *The Sad End Of Blockbuster Video: The Onetime \$5 Billion Company Is Being Liquidated as Competition from Online Giants Netflix and Hulu Prove All Too Much for the Iconic Brand*, INT'L BUS. TIMES (Dec. 5, 2013), <http://www.ibtimes.com/sad-end-blockbuster-video-onetime-5-billion-company-being-liquidated-competition-online-giants> [<https://perma.cc/SAJ3-Z3A8>]. But see Dana Levitz, *Meet the Independent Video Stores Making It in the Age of Netflix*, CITYLAB (Nov. 2, 2012), <http://www.citylab.com/design/2012/11/meet-independent-video-stores-making-it-age-netflix/3775/> [<https://perma.cc/3Z3L-SH9P>] (discussing how some video stores have managed to survive by specializing and moving into the events business).

256. *Brookfield*, 174 F.3d at 1064.

257. This assumes, of course, that the McDowell's of my hypothetical bears no resemblance to the identically named restaurant in the 1988 Eddie Murphy film *Coming to America*. COMING TO AMERICA (Eddie Murphy Productions & Paramount Pictures 1988). In that movie, an enterprising man named Cleo McDowell opens up a blatant McDonald's rip-off and attempts to justify it by saying his restaurant has the "Golden Arcs" (instead of the "Golden Arches") and a "Big Mick" (instead of the "Big Mac"; both contain "two all-beef patties, special sauce, lettuce, cheese, pickles and onions", but McDonald's has a sesame-seed bun, whereas McDowell's buns have no seeds). Ben Yakas, *Beloved Coming to America Restaurant McDowell's Will Soon Be Demolished*, GOTHAMIST (June 16, 2003), http://gothamist.com/2013/06/16/beloved_coming_to_america_restauran.php [<https://perma.cc/SM8N-LKLR>].

258. *Brookfield*, 174 F.3d at 1064.

often applied to the Internet.²⁵⁹ Indeed, the *Brookfield* case — despite being the source of the Ninth Circuit’s hypothetical from which I borrowed — was *really* about the Internet. Or, more specifically, website metatags.²⁶⁰

Brookfield Communications (the plaintiff in the case) was a company that offered marketing software and services for the entertainment industry.²⁶¹ The software applications it initially offered featured information such as recent film submissions, industry credits, professional contacts, and future projects²⁶² (picture a time before the World Wide Web and IMDb²⁶³). The programs were targeted at major Hollywood film studios, production companies, actors, agents, producers, and directors.²⁶⁴

Brookfield then decided to expand into the consumer market; it labeled its industry-targeted software “The Studio System” and created a different software program, titled “MovieBuff,” for smaller companies and individual consumers who didn’t want the feature-heavy version aimed at industry insiders.²⁶⁵ Brookfield initially sold the MovieBuff product in retail book and software stores, but in 1996, it decided to launch an Internet presence to sell the software as well as offer an online searchable database.²⁶⁶

Meanwhile, West Coast Entertainment Corporation (the defendant), one of the nation’s largest video rental store chains, registered the Internet domain *moviebuff.com*.²⁶⁷ It claimed to have chosen that domain because the term “Movie Buff” was part of its 1991-registered service mark, “The Movie Buff’s Movie Store.”²⁶⁸ So although Brookfield wasn’t able to obtain the *moviebuff.com* domain name —

259. See Rothman, *supra* note 248, at 109.

260. As concisely described by Rothman: “Programmers use source code to construct webpages. The source code of any webpage includes metatags, which are HTML commands that describe the content of a webpage.” As he explains, “[t]he most common metatags... are used to describe the website and to list keywords that relate to the site in order to assist search engines in locating the website... An average websurfer never sees metatags...” *Id.* at 118 (citations omitted).

261. *Brookfield*, 174 F.3d at 1041.

262. *Id.*

263. “IMDb,” which stands for “Internet Movie Database,” *Internet Movie Database*, WIKIPEDIA, https://en.wikipedia.org/wiki/Internet_Movie_Database [<https://perma.cc/NTK9-FU3L>], is a website that claims to be “the world’s most popular and authoritative source for movie, TV and celebrity content.” *Press Room*, IMDB, http://www.imdb.com/pressroom/?ref=ft_pr [<https://perma.cc/M36U-4SKZ>]. The site goes on to boast that it “offers a searchable database of more than 185 million data items including more than 3 million movies, TV and entertainment programs and more than 6 million cast and crew members.” *Id.*

264. *Brookfield*, 174 F.3d at 1041.

265. *Id.*

266. *Id.* at 1042.

267. *Id.*

268. *Id.*

West Coast had beaten them to the punch — it nevertheless did register the trademark “MovieBuff” with the USPTO in 1998.²⁶⁹

The dispute between the two parties came to a predictable head later that year, when Brookfield learned that West Coast planned to launch its moviebuff.com website.²⁷⁰ Although much of the Ninth Circuit’s decision centered on whether West Coast’s website domain name infringed Brookfield’s registered trademark (with the court deciding that question in favor of Brookfield), the most interesting part of the opinion involved initial-interest confusion and West Coast’s use of metatags — the snippets of text buried in a website’s code that describe its content to search engines — to direct Internet queries towards its site.²⁷¹ Already having found that West Coast could not use “moviebuff.com” as its website domain, the secondary question then became whether it could use “MovieBuff” or “moviebuff.com” as metatags of a differently named website, like “west-coastvideo.com.”²⁷²

The court acknowledged the predicament accordingly:

[W]hen the user inputs “MovieBuff” into an Internet search engine, the list produced by the search engine is likely to include both West Coast’s and Brookfield’s web sites. Thus, in scanning such list, the Web user will often be able to find the particular web site he is seeking. Moreover, even if the Web user chooses the web site belonging to West Coast, he will see that the domain name of the web site he selected is “westcoastvideo.com.” Since there is no confusion resulting from the domain address, and since West Coast’s initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast’s web site.²⁷³

But despite admitting that confusion was nonexistent, the court nevertheless found infringement under the initial-interest confusion theory, writing that “by using ‘moviebuff.com’ or ‘MovieBuff’ to divert people looking for ‘MovieBuff’ to its web site, West Coast improperly benefits from the goodwill that Brookfield developed in its

269. *Id.*

270. *Id.*

271. *See id.* at 1061–64.

272. *Id.* at 1062.

273. *Id.*

mark.”²⁷⁴ That’s when the court invoked its brick-and-mortar video store analogy I referenced earlier, opining that “using another’s trademark in one’s metatags is much like posting a sign with another’s trademark in front of one’s store.”²⁷⁵

The Ninth Circuit’s *Brookfield* decision was not the first or last case to apply the initial-interest confusion doctrine to website searches or the Internet more generally.²⁷⁶

3. Tweet Softly and Carry a Big Stick

So could a marketer prevail on a claim that an ordinary social media user tarnished the company’s trademark by using it in a disparaging way?²⁷⁷ For example, what if #cokecanpics sparks a bevy of Instagram photographs with people doing untoward things to or with a Coke can?²⁷⁸ If Coke had registered “#makeithappy” *before* launching that campaign, could it have argued that Gawker tarnished the Coca-Cola mark by tying it to Hitler? Or, could Coca-Cola win on an initial-interest confusion claim against a sports handicapper, whose last name just happens to be Coke, if soft drink enthusiasts unwittingly happen upon his “#cokecanpick” page when looking for a discussion about cola?²⁷⁹

Maybe, maybe not. Admittedly, most social network users are probably safe from liability, because one major hurdle trademark holders will have to overcome is proving that the alleged infringer used the trademark in commerce.²⁸⁰ Ordinary Twitter and Facebook

²⁷⁴ *Id.*

²⁷⁵ *Id.* at 1064.

²⁷⁶ *See* *Horphag Research, Ltd. v. Pellegrini*, 337 F.3d 1036 (9th Cir. 2003). In *Horphag*, the court easily found trademark infringement when the defendant admitted to using the plaintiff’s registered trademark in website metatags. *See id.* at 1041; *see also* *Google Inc. v. Am. Blind & Wallpaper Factory, Inc.*, 74 U.S.P.Q.2d (BNA) 1385, 2005 WL 832398, at *7 (N.D. Cal. Mar. 30, 2005) (refusing to dismiss claims against search engines for selling advertisements keyed to trademarked terms); *Gov’t Emps. Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 705 (E.D. Va. 2004) (same). However, the district court later granted, in part, Google’s motion for judgment as a matter of law during trial because the plaintiff’s survey evidence failed to show a likelihood of confusion with respect to some (but not all) of Google’s search results, No. 1:04cv507, 2005 U.S. Dist. LEXIS 18642, at *25–28 (E.D. Va. Aug. 8, 2005); *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003) (holding software company liable under the initial-interest-confusion doctrine for use of third-party pop-up advertisements that featured plaintiff’s trademark), *rev’d on other grounds*, 414 F.3d 400 (2d Cir. 2005).

²⁷⁷ *See supra* Part IV.B.2.a.

²⁷⁸ *See id.*

²⁷⁹ *See supra* Part IV.B.2.b.

²⁸⁰ 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A) (2006); *see also* *DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 936 (8th Cir. 2003) (discussing the requirement that an infringing use be “in commerce”); Lisa P. Ramsey, *Brandjacking on Social Networks: Trademark In-*

users, or those just trolling a company for kicks, probably don't qualify.²⁸¹ But there are creative arguments around that obstacle, and to date, there simply are not enough test cases to know for sure.²⁸²

In the end, however, it does not really matter whether advertisers win or lose in a particular instance. The problem is that once they are armed with a federally registered trademark, the very threat of litigation may be enough to shut down a hijacked hashtag.²⁸³ Since the late 1980s, commentators have observed — both empirically and anecdotally — that litigation and the threat thereof can be effectively used as tools to silence one's critics.²⁸⁴ Because marketers could just as easily trademark their words, terms, and slogans without a hashtag and extend protection through the doctrine of tacking,²⁸⁵ the registration of hashtagged marks can only serve one purpose: to provide companies with a stronger weapon — real or perceived — to help them prevent social media campaigns from becoming public relations disasters.²⁸⁶

Concededly, companies could threaten litigation with or without a registered hashtag; even if they followed my argument and registered their term or phrase traditionally (sans hashtag), they could always threaten suit (or actually sue). But the fact that their registered mark contains the “#” symbol may give them more leverage than if the mark were registered without the tag,²⁸⁷ because hashtag registration may give an infringement lawsuit a longer lifespan in court. One of the benefits of registration is presumptive validity.²⁸⁸ The presumption attached to the hashtagged mark (as opposed to a registered mark in non-hashtagged form) may be enough to overcome several kinds of motions to dismiss. Two that immediately come to mind are a 12(b)(6)²⁸⁹ “*Twiqbal*” motion in federal court, or an anti-SLAPP motion in state court.

Twiqbal is the colloquial portmanteau²⁹⁰ given to the duo of earth-shaking federal civil procedure cases decided by the Supreme

fringement by Impersonation of Markholders, 58 *BUFF. L. REV.* 851, 854 (2010) (explaining that the level of clarity will depend on the type of infringing use).

281. See Ramsey, *supra* note 280.

282. See *id.* at 873–94.

283. See generally George W. Pring, *SLAPPs: Strategic Lawsuits Against Public Participation*, 7 *PACE ENVTL. L. REV.* 3 (1989); Penelope Canan, *The SLAPP from a Sociological Perspective*, 7 *PACE ENVTL. L. REV.* 23 (1989).

284. See, e.g., Pring, *supra* note 283; Canan, *supra* note 283.

285. See *supra* Part IV.A.

286. See *supra* Part IV.B.1.

287. See Sherwin, *supra* note 191.

288. *About Trademarks*, USPTO, <http://www.uspto.gov/page/about-trademarks> [http://perma.cc/UW8B-PGX9].

289. FED. R. CIV. P. 12(b)(6).

290. A portmanteau is “a word or morpheme whose form and meaning are derived from a blending of two or more distinct forms (as smog from smoke and fog).” *Portmanteau*,

Court in 2007 and 2009.²⁹¹ First in *Bell Atlantic Corp. v. Twombly*,²⁹² and then in *Ashcroft v. Iqbal*,²⁹³ the Court overhauled the standard for pleading civil cases in federal courts, replacing “notice pleading” (as announced in *Conley v. Gibson*²⁹⁴) with a more demanding rule that requires a plaintiff to show not only a legally cognizable claim for relief, but also a factually “plausible” one.²⁹⁵

I have argued before that courts, particularly in light of *Twiqbal*, should more liberally exercise their Rule 12(b)(6) (or 12(c)²⁹⁶) dismissal powers for copyright infringement suits that appear to be nothing more than “shakedown” attempts by copyright-holding bullies.²⁹⁷ I would suggest the same for trademark suits that similarly aim at silencing critics or harmless trolls. The problem with allowing registration of hashtagged terms — separate and apart from their unhashtagged brethren — is that it *might* provide just enough ammunition for an infringement plaintiff to survive a *Twiqbal* motion. By emphasizing the existence of a registration certificate for the hashtagged mark (which, again, carries with it a presumption of validity), the plaintiff might come closer to convincing a judge that defendant’s use was “in commerce” because that use — in hashtag form — more closely mirrors the format of plaintiff’s registration as well as the manner (in social media) of plaintiff’s use.

Anti-SLAPP motions, on the other hand, are statutory procedural mechanisms that exist in twenty-eight states (as well as the District of Columbia and Guam).²⁹⁸ An acronym for the coined term “Strategic Lawsuit Against Public Participation,” a SLAPP is a frivolous lawsuit brought for the sole purpose of silencing one’s critics.²⁹⁹ Anti-SLAPP statutes provide defendants with a tool that gums up a plaintiff’s lawsuit by providing for an expedited hearing on a motion to dismiss and a discovery freeze while requiring him to show the suit has a probability of success.³⁰⁰

MERRIAM-WEBSTER, <http://www.merriam-webster.com/dictionary/portmanteau> [http://perma.cc/57GT-YFKP].

291. See Arthur R. Miller, *From Conley to Twombly to Iqbal: A Double Play on the Federal Rules of Civil Procedure*, 60 DUKE L.J. 1, 15 & n.52, 16 (2010).

292. 550 U.S. 544, 556 (2007).

293. 556 U.S. 662, 687 (2009).

294. 355 U.S. 41, 47 (1957).

295. David Freeman Engstrom, *The Twiqbal Puzzle and Empirical Study of Civil Procedure*, 65 STAN. L. REV. 1203, 1204 & n.3 (2013).

296. FED. R. CIV. P. 12(c).

297. See Sherwin, *supra* note 191, at 861.

298. *State Anti-SLAPP Laws*, PUBLIC PARTICIPATION PROJECT, <http://www.anti-slapp.org/your-states-free-speech-protection> [http://perma.cc/L32T-KGHB].

299. Sherwin, *supra* note 191, at 844–45. Typically, these lawsuits are framed as defamation cases, but they can take on many different forms. *Id.* at 845.

300. Sherwin, *supra* note 191, at 847–50.

Unlike copyright cases (for which there is mandatory federal jurisdiction³⁰¹), trademark cases can be filed in state court. Although that could introduce the possibility of an anti-SLAPP motion to dismiss (at least in states with anti-SLAPP statutes), a plaintiff might rest easier knowing that his registration-granted presumption of validity could be used to argue that the suit has a probability of success.³⁰² If judges were to decide that the presumption — whether as a matter of law or simply factually — gives the suit a degree of viability that other actions (like defamation) don't enjoy, it could effectively destroy the deterrent intent of a state's anti-SLAPP statute and encourage large, corporate plaintiffs to sue in state courts that are traditionally more plaintiff-friendly.³⁰³

Without the aid of a crystal ball, it is impossible to determine at this point: (1) how vociferously the Cokes and McDonalds of the world would argue the presumption; and (2) whether state and federal judges would buy the argument. But simply from a public policy standpoint, marketers should not be able to encourage others' widespread use of a word or slogan, and then turn around and sue when it is used in a negative way. If they want to trademark a slogan and use it to sell a product — even making use of that slogan in hashtagged form — then of course, the law should protect that.³⁰⁴ But their remedies for infringement should be limited along traditional lines. Their registered marks should not become bully sticks to lord over social media critics and trolling ne'er-do-wells; after all, hashtags are simply discussion points companies themselves have established.

V. CONCLUSION

The use of hashtags in social media has become so incredibly common that it is nearly impossible to make one's way through a Twitter, Facebook, or Instagram feed without seeing at least one instance of a strung-together phrase preceded by the # symbol.³⁰⁵ Predictably, advertisers are constantly employing creative uses of hashtags to generate (and monitor) discussion about their goods and

301. 28 U.S.C. § 1338(a) (“The district courts shall have original jurisdiction of any civil action . . . relating to patents, plant variety protection, copyrights and trademarks. No State court shall have jurisdiction over any claim for relief . . . relating to patents, plant variety protection, or copyrights.”).

302. See Sherwin, *supra* note 191, at 861.

303. Gavin Rooney, Joseph Fischetti & Amy Schwind, *State Courts May Become Sole No-Injury Class Action Forum*, LAW 360 (Jan. 8, 2016, 2:41 PM), <http://www.law360.com/articles/743588/state-courts-may-become-sole-no-injury-class-action-forum> [<http://perma.cc/2UZP-B9QT>].

304. See Ramsey, *supra* note 280, at 929.

305. See *supra* Part II.C.

services.³⁰⁶ And as those creative uses have grown, efforts to trademark hashtags have likewise intensified.³⁰⁷ The USPTO has even given its blessing.³⁰⁸

But we should give serious thought as to whether granting protection to a hashtag — whose entire purpose is to incite widespread use — comports with the purpose of trademark law, which in many ways aims to restrict use by others. Because marketers do not need to trademark their hashtagged terms to protect them from commercial use by competitors, we should not hand companies a tool that might very well be used to suppress critical discussion they would rather not see.

306. See Zacchia, *supra* note 134.

307. See Perkins, *supra* note 161.

308. USPTO, *supra* note 155, § 1202.18.