

Intellectual Property & Technology Law Journal

Edited by the Technology and Proprietary Rights Group of Weil, Gotshal & Manges LLP

VOLUME 31 • NUMBER 8 • AUGUST 2019

Can and Should You Register Hashtags as Trademarks?

By Kevin R. Casey

Hashtags are ubiquitous and appear on storefronts, in advertisements and on packaging. In the social media context, a hashtag is a word or phrase preceded by a hash mark (#), used within a message posted on sites such as Twitter and Instagram to identify a keyword or topic of interest and facilitate a search for the message. Hashtags function to identify the subject of a message rather than the source of the message. Trending terms are now routinely followed by applications filed with the U.S. Patent and Trademark Office (PTO) by opportunistic applicants who want to gain exclusive rights to a popular term. The PTO almost always rejects such applications, however, because the designation #Designation fails to function as a mark. Two recent examples illustrate the PTO's analysis.

In re Gillard

In *In re Gillard*,¹ the Trademark Trial and Appeal Board (the Board) refused to register the designation #covfefe for hats, T-shirts, wristbands, hoodies, jackets, jerseys, ties, and tops.

The designation is a hashtag version of the bizarre term used by President Donald Trump in a May 31,

2017, tweet: “Despite the constant negative press covfefe.” The tweet went viral and prompted much discussion. The applicant, John E. Gillard, filed his application to register the designation on the same day as the tweet.



Image 1

The Board's ruling was based on a finding that consumers will associate the designation with Trump and the subsequent “whirlwind” of media publicity rather than a particular source of goods or services. In other words, the designation does not perform the source-identifying function required of a trademark. “The critical inquiry in determining whether a designation functions as a mark is how the designation would be perceived by the relevant public.”

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The Trademark Manual of Examining Procedure (TMPE) Section 1202 lists 15 grounds for refusal under the rubric “failure to function.” In this case, the examining attorney invoked the “informational matter” ground, maintaining that #covfefe is “a social, political, or similarly informational message that is understood and commonly used as a reference to President Trump, typically expressing either support or disapproval of the President.” Moreover, he asserted, consumers are accustomed to seeing the designation (both covfefe and #covfefe) used by many different sources on a variety of goods and services, mostly in an ornamental manner.

The Board deemed the designation to be “in the nature of a verbal Rorschach test, in which users and observers of the word can project onto it any meaning they wish, and, as a result, it has been used ubiquitously” in several non-trademark senses. The Board further explained, “The more commonly a phrase is used, the less likely that the public will use it to identify only one source and the less likely that it will be recognized by purchasers as a trademark.” The use of the hashtag symbol with covfefe is “particularly probative” because hashtags “are commonly employed to facilitate categorization and searching of topics of public discussion.” Based on its analysis, the Board affirmed the refusal under Sections 1, 2, 3, and 45 of the Lanham Act.

In re DePorter

The Board issued a similar ruling in *In re DePorter*.² The Board affirmed a refusal to let a Chicago Cubs fan register the hashtag #MAGICNUMBER108 as a trademark for shirts. See Harry Caray’s image on the applicant’s specimen T-shirt in Image 2.

In a precedential decision under Sections 1, 2, and 45 of the Lanham Act, the Board held that the designation is merely a term widely used on social media linked to the baseball team winning the World Series in 2016 rather than as an identification of source for the goods identified in the application. The Board ruled that even if Grant DePorter, the applicant and perhaps the world’s leading expert in Cubs numerology, was the first to use the hashtag—as he claimed to be—and the term were arbitrary or fanciful in a trademark sense, such facts would not give him exclusive rights to a phrase that was later used by countless others to celebrate the end of a 108-year World Series drought.



Image 2

“Due to the widespread use of #MAGICNUMBER108 to express affiliation for the Chicago Cubs baseball team and their pursuit of a 2016 World Series win 108 years after their last one, applicant’s proposed mark would not be perceived as identifying a particular source of goods,” the Board stated. “That applicant may have been the first to use the phrase and/or hashtag does not change the fact that the evidence shows widespread use . . . to informationally convey reference to the Chicago Cubs’ World Series appearance,” the Board continued. The ruling carefully avoided sweeping statements about the registrability of hashtags, but the Board cautioned that the mere addition of a hash mark to a word is “usually devoid of source-identifying significance.” “We do not hold that hashtags can never be registered as trademarks,” the Board stated. “To be registrable, a hashtag – like any other matter – must function as a trademark.” The Board observed that a hashtag, when used as part of an online social media search term, generally serves no source-identifying function. It “merely facilitate[s] categorization and searching within online social media.”³ “Therefore, the addition of the term HASHTAG or the hash symbol (#) to an otherwise unregistrable term typically will not render the resulting composite term registrable.”

Query whether people beyond the North Side of Chicago know (or care) what the designation

refers to? If the designation is informational to only the small percentage of Americans who are Cub fans, is that enough to invoke the failure-to-function bar? Compare the prior, now discredited, doctrine of niche market fame.

The PTO recognizes that hashtags can serve sometimes to identify the source of goods or services. Consider a product hanhtag with the designation #CalvinKlein; such use would convey to consumers the source of the product. Therefore, the PTO has issued registrations for hashtags such as #EverydayMadewell⁴ and #SayItWithPepsi.⁵

Is it Worthwhile to Register a Hashtag?

Given the difficulty but possibility of registering hashtags as marks, the question is whether an application to register is worthwhile. The answer is, of course, it depends on the nature of the hashtag. If the hashtag is in the form of #RegisteredTrademark (i.e., the hashtag incorporates an existing registered trademark), then there is likely no need to register the hashtag. If a third party were to start using #RegisteredTrademark and the trademark owner only had a registration for their mark (without the hash symbol), it seems likely that the trademark owner could prevail over the user of #RegisteredTrademark. Therefore, registration of the hashtag would not be necessary.

When services are rendered through social media, however, it might be necessary to register a hashtag as a trademark.

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hashtag as a trademark. For example, if an applicant offered customer support by telling users to label their messages with the hashtag #TrademarkService or #TrademarkHelp, and then the applicant's customer support personnel responded to those messages, it might be possible to register the hashtag for use in connection with online customer support. A registration might cover goods or services not covered by other registrations and could aid in enforcement efforts.

A registration for a hashtag might also be necessary if an applicant seeks to enforce its rights online. Many websites have their own trademark enforcement policies, and although they may be willing to take action when a trademark owner has a registration for its mark (without a hash symbol) and a user is using #RegisteredTrademark in an infringing manner, a website might be more inclined to act when the trademark owner has a registration corresponding to the hashtag. This is especially true when addressing websites located outside the United States.

Takeaway

Including the hashtag symbol often hurts rather than helps a designation achieve trademark status. In most situations, there is no need to register hashtags as trademarks anyway, particularly where the hashtag is #RegisteredTrademark and a client has already registered its trademark.

Notes

1. Serial No. 87469115 (TTAB Jan. 11, 2019) (not precedential), <http://ttabvue.uspto.gov/ttabvue/ttabvue-87469115-EXA-15.pdf>.
2. Serial No. 87229711 (TTAB Jan. 29, 2019), <https://thetmca.com/files/2019/02/DePorter.pdf>.
3. TMEP Section 1202.18.
4. U.S. Reg. No. 4,895,377.
5. U.S. Reg. No. 5,037,848.

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Number 8, pages 3–5, with permission from Wolters Kluwer, New York, NY,
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