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# HOW MANY LIKES DID IT GET? USING SOCIAL MEDIA METRICS TO ESTABLISH TRADEMARK RIGHTS

Caroline Mrohs\*

## I. INTRODUCTION

On September 14, 2015, PolypLab Inc., a company that develops and sells coral food and supplements for freshwater aquariums, filed an application for the trademark POLYP LAB.<sup>1</sup> The mark was applied for in relation to alkalinity buffer supplements for live coral for use in aquariums, calcium-based nutrient supplements for live coral for use in aquariums, vitamin supplements for coral, and amino acids supplements for coral.<sup>2</sup> Initially, the mark was rejected because it was merely descriptive, meaning the trademark attorney concluded from the evidence presented that POLYP LAB did nothing more than describe the goods or services it was used to sell.<sup>3</sup>

After filing a response to the trademark attorney's rejection, POLYP LAB was allowed for publication in the Trademark Official Gazette on June 7, 2016, and subsequently registered on the Principal Register on August 23, 2016.<sup>4</sup> The response focused on highlighting the vast social media presence that PolypLab maintains as a brand, from Instagram to Facebook.<sup>5</sup> Evidence gathered from social media is readily documentable and serves as a real-time record of the quantity and quality of interactions between a trademarkable brand and its consumers. Evidence presented in the response included comments sections

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<sup>1</sup> U.S. Trademark Application Serial No. 86/755,711 (filed Sept. 14, 2015).

<sup>2</sup> POLYP LAB, Registration No. 86/755,711.

<sup>3</sup> USPTO, SERIAL NO. 86/755,711, OFF. ACTION COMM., at 1-2 (Dec. 30, 2015).

<sup>4</sup> USPTO, SERIAL NO. 86/755,711, OFF. ACTION COMM., at 1 (June 7, 2015).

<sup>5</sup> USPTO, SERIAL NO. 86/755,711, OFF. ACTION COMM., at 3-4 (Apr. 4, 2016).

from Instagram posts,<sup>6</sup> Polyp Lab's Facebook page which features a "Shop" section in which users can make purchases directly from the page,<sup>7</sup> and photographs of Polyp Lab booths at various trade shows.<sup>8</sup>

Previously employed multi-factor tests used to determine secondary meaning did not consider social media as a contributor to establishing secondary meaning for merely descriptive trademarks.<sup>9</sup> Such tests, which are outdated and need to be reconsidered, favor larger entities with sufficient financial capital to invest in advertising and publicity – factors that have traditionally been used to measure how well consumers can connect a brand with a particular source. Not only does this system put smaller businesses at a disadvantage, but it also fails to reflect the shift that social media has caused in terms of how brands market their goods and services to consumers.

Trademarks are words, phrases, symbols, or designs that identify the source of goods.<sup>10</sup> Well-known examples include MCDONALDS, APPLE, and DISNEY.<sup>11</sup> Along with words and phrases, individuals or companies that use certain colors or sounds in commerce may be able to protect them through trademark law, including the catchy NBC three-chime jingle and Christian Louboutin's famous red shoe soles.<sup>12</sup> But not all marks are entitled to legal protection. Instead, marks are classified as fanciful, arbitrary, suggestive, descriptive, or generic, and only marks within certain classifications are protectable.<sup>13</sup>

Fanciful marks are marks that have no meaning outside of their use as a source-identifying device.<sup>14</sup> Such marks include EXON, KODAK, and XEROX.<sup>15</sup> A well-known arbitrary mark is APPLE for computers and phones.<sup>16</sup> Suggestive marks are those that require some "imagination, thought, and perception to reach a conclusion as to the nature of goods."<sup>17</sup> SPEEDI-BAKE is a

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<sup>6</sup> USPTO, SERIAL NO. 86/755,711, OFF. ACTION COMM., at 3-4 (Apr. 4, 2016).

<sup>7</sup> *Id.* at Ex. 10.

<sup>8</sup> *Id.* at 6.

<sup>9</sup> Quoc Viet Foods, Inc., v. VV Foods, LLC, No. SACV 12-02165-CJC, 2016 WL 3536708, at \*4 (C.D. Cal. Jun. 14, 2016).

<sup>10</sup> *Trademark, Patent or Copyright?*, USPTO (June 9, 2016, 1:41 PM), <https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademark-patent-or-copyright>.

<sup>11</sup> MCDONALDS, Registration No. 1,352,168; APPLE, Registration No. 4,206,562; DISNEY, Registration No. 4,067,997.

<sup>12</sup> The mark consists of a catchy three-chime jingle. Registration No. 0,916,522. The mark consists of famous red shoe soles. Registration No. 3,361,597.

<sup>13</sup> Daniel A. Tysver, *Strength of Trademarks*, BITLAW, [www.bitlaw.com/trademark/degrees.html#arbitrary](http://www.bitlaw.com/trademark/degrees.html#arbitrary) (last visited Nov. 2, 2016).

<sup>14</sup> *Id.*

<sup>15</sup> *Id.*

<sup>16</sup> *Id.*

<sup>17</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 11 (2d Cir. 1976) (quoting *Stix Prods., Inc. v. United Merch. & Mfrs. Inc.*, 295 F.Supp. 479, 488 (S.D.N.Y.

suggestive mark for frozen bread dough, because it takes a step of imagination to understand what the mark intends to convey about the product.<sup>18</sup> Fanciful, arbitrary, and suggestive marks are afforded trademark protection based upon their classifications because they are sufficiently distinctive enough to be recognized without further proof of distinction in the minds of consumers.

On the opposite end of the distinctiveness spectrum are generic marks. Generic marks may never receive trademark protection regardless of how consumers perceive the mark in connection with the producer, because a device that is deemed generic has been found too important in commerce to limit its use exclusively to one manufacturer or service provider.<sup>19</sup> For example, ESCALATOR was once a trademarked term, but has since become generic because it gained such wide popularity in commerce that it was too great a burden on free speech to limit its use to a single party.<sup>20</sup>

Finally, merely descriptive marks fall in the middle of the generic-fanciful distinctiveness continuum. Without more, merely descriptive marks do not receive trademark protection because they lack inherent distinctiveness, like generic marks, and would create too great a burden on the freedom of speech to curtail use of such marks to a single source.<sup>21</sup> Examples of merely descriptive marks include COLD AND CREAMY for ice cream.<sup>22</sup>

Although federal registration of trademarks is not necessary for enforcement, registration with the United States Patent and Trademark Office (USPTO) confers certain benefits on trademarks owners.<sup>23</sup> These advantages include a legal, rebuttable presumption that the registrant is the owner of the mark, constructive notice of the claim of ownership of the mark, the ability to stop the importation of infringing or counterfeit goods through recordation of the mark with U.S. Customs and Border Protection, and the right to bring an action in federal court for infringement.<sup>24</sup> Once a USPTO examining attorney determines that the mark is neither generic nor merely descriptive, and falls

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1968)).

<sup>18</sup> *What is a Trademark?* NAT'L PARALEGAL, [http://nationalparalegal.edu/public\\_documents/courseware\\_asp\\_files/patents/Trademarks1/What.asp](http://nationalparalegal.edu/public_documents/courseware_asp_files/patents/Trademarks1/What.asp) (last visited Nov. 2, 2016).

<sup>19</sup> Tysver, *supra* note 14.

<sup>20</sup> *Haughton Elevator v. Seeberger*, 85 U.S.P.Q. 80, 80 (1950).

<sup>21</sup> Tysver, *supra* note 14.

<sup>22</sup> *Fact Sheet: Introduction to Trademarks*, INT'L TRADEMARK ASS'N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/TrademarkStrengthFactSheet.aspx> (last updated Aug. 2014).

<sup>23</sup> *U.S. Trademark Registrations: Principal Register v. Supplemental Register*, INT'L TRADEMARK ASS'N, <http://www.inta.org/TrademarkBasics/FactSheets/Pages/PrincipalvsSupplementalRegister.aspx> [hereinafter *Registrations*] (last updated Apr. 2015).

<sup>24</sup> *Id.*

into the categories of fanciful, arbitrary, or suggestive, then the mark is published for opposition.<sup>25</sup> At this point, qualified third parties may attempt to prevent issuance of a mark registration.<sup>26</sup> The proceeding takes place before the Trademark Trial and Appeal Board (TTAB), which functions as an administrative tribunal.<sup>27</sup> If there are no issues arising from the opposition period, then the trademark will issue on the Principal Register. After five years on the Principal Register the mark may become incontestable, offering further strength in protection of the mark to the registrant.<sup>28</sup>

When the USPTO determines a source's trademark is merely descriptive, it prohibits the source from having the trademark listed on the Federal Register.<sup>29</sup> A trademark is merely descriptive when it consists of a word or phrase that "conveys an immediate idea of the qualities, characteristics, effect, purpose, or ingredient of a product or service."<sup>30</sup> The main purposes of denying registration of merely descriptive marks on the Principal Register are to prevent a trademark owner from unnecessarily or unfairly restricting competition by limiting the speech of competing brands, and to protect the freedom of speech guaranteed to the public through the First Amendment.<sup>31</sup>

A merely descriptive trademark may still be listed on the Supplemental Register, however.<sup>32</sup> Registration on the Supplemental Register affords the trademark registrant some protections, including the use of the ® symbol in commerce and the ability to sue on grounds of unfair competition.<sup>33</sup> Additionally, a trademark registered on the Supplemental Register may be cited by a USPTO examining attorney against a later-filed application to register a confusingly

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<sup>25</sup> *Trademarks - What Happens Next?*, USPTO, <https://www.uspto.gov/trademarks-getting-started/trademark-basics/trademarks-what-happens-next> [hereinafter *Trademarks*] (last visited Oct. 27, 2016).

<sup>26</sup> Tysver, *supra* note 13.

<sup>27</sup> *Trademarks*, *supra* note 25.

<sup>28</sup> *Registrations*, *supra* note 23.

<sup>29</sup> The Lanham Act § 2, 15 U.S.C. § 1052(e) (2012).

<sup>30</sup> *Zatarains, Inc. v. Oak Grove Smokehouse, Inc.*, 698 F.2d 786, 792 (5th Cir. 1983), *abrogated on other grounds by* *KB Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004); *see also In re SPX Corp.*, 63 U.S.P.Q.2d 1592 (T.T.A.B. 2002) (explaining that examples of merely descriptive trademarks include E-AUTODIAGNOSTICS as merely descriptive for an electronic engine analysis system comprised of a hand-held computer and related computer software); *In re Entenmann's, Inc.*, 15 U.S.P.Q.2d 1750, 1751 (T.T.A.B. 1990) (explaining that OATNUT as merely descriptive of bread containing oats and hazelnuts); *In re Andes Candies Inc.*, 178 U.S.P.Q. 156 (C.C.P.A. 1973) (explaining that CRÈME DE MENTHE as merely descriptive of a chocolate-covered mint).

<sup>31</sup> *In re Abcor Dev. Corp.*, 588 F.2d 811, 813 (C.C.P.A. 1978).

<sup>32</sup> Merely descriptive marks may be registrable on the Supplemental Register in applications under §1 and § 44 of the Trademark Act. *See* TMEP 1209.01 Distinctiveness/Descriptiveness Continuum.

<sup>33</sup> *Registrations*, *supra* note 23.

similar mark for related goods or services.<sup>34</sup>

In order for a descriptive mark to be listed on the Principal Register, the trademark applicant must demonstrate that the trademark has gained secondary meaning or acquired distinctiveness, conveying to a consumer that the trademark is indicative of a specific source.<sup>35,36</sup> According to the Trademark Manual for Examining Procedures (TMEP), three types of evidence may be used to establish acquired distinctiveness under §2(f).<sup>37</sup> This Comment will focus on the importance of further defining the establishment of acquired distinctiveness through use of actual evidence. The forthcoming argument will articulate how courts should proceed to construe such evidence in the determination of a finding of secondary meaning for trademarks previously found to be merely descriptive.

The USPTO refuses registration of marks that are not distinctive and marks that are not capable of distinguishing the goods and services of the owner from those of others.<sup>38</sup> This is because trademarks are arguably the most effective commercial tool to capture the consumer's attention, make the products stand out, and provide brands with a competitive advantage.<sup>39</sup> The USPTO registers trademarks based on the Commerce Clause of the Constitution and therefore its interest in denying trademarks to applicants who do not show that the marks evince a connection between the source and its consumers lies in preventing unfair competition, as well as ensuring that the trademark registration system promotes a flourishing American industry of interstate commerce.<sup>40</sup> Congress enacted the Lanham Act in 1946 to provide national protection for trademarks used in interstate and foreign commerce.<sup>41</sup> The burden is on the applicant of a trademark deemed merely descriptive or not distinctive by a USPTO examining attorney to prove that the mark is in fact distinctive.<sup>42</sup>

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<sup>34</sup> *Id.*

<sup>35</sup> 15 U.S.C. § 1052(f).

<sup>36</sup> For the purposes of this Comment, "secondary meaning" and "acquired distinctiveness" will be used interchangeably to mean the transformation which a merely descriptive trademark or service mark undergoes "through usage by one producer with reference to his product" to acquire "a special significance so that to the consuming public the word has come to mean that the product is produced by that particular manufacturer." 1 HARRY D. NIMS, *THE LAW OF UNFAIR COMPETITION AND TRADEMARKS* § 37 at 66 (2d ed. 1917).

<sup>37</sup> The Trademark Manual of Examining Procedure is a manual published by the USPTO for use by trademark attorneys and trademark examiners [hereinafter TMEP].

<sup>38</sup> *Registrations*, *supra* note 23.

<sup>39</sup> INT'L TRADEMARK ASS'N, *TOP TEN REASONS WHY YOU SHOULD CARE ABOUT TRADEMARKS* 6, 16.

<sup>40</sup> *About Us*, UPTO, <http://www.uspto.gov/about-us> (last updated Aug. 12, 2016).

<sup>41</sup> *Park 'n Fly v. Dollar Park & Fly*, 469 U.S. 189, 193 (1985).

<sup>42</sup> On the question of acquired distinctiveness under Section 2(f), the applicant has the burden of proving that its mark has acquired distinctiveness. *In re Hollywood Brands, Inc.*,

Based on the above summary of rights afforded to registrants with marks on the Principal Register and Supplemental Register, it is obvious why applicants would want their marks to be registered on the Principal Register rather than the Supplemental Register.

The USPTO will not allow registration of merely descriptive marks on the Principal Register, but will allow registration on the Supplemental Register. Once the registrant has demonstrated that the mark has secondary meaning or acquired distinctiveness, then the registrant can then file again to have the mark registered on the Principal Register.<sup>43</sup> When a merely descriptive mark acquires secondary meaning or acquires distinctiveness, it “has come through use to be uniquely associated with a specific source.”<sup>44</sup> The USPTO states in its Trademark Manual of Examining Procedures (TMEP) that if a trademark or service mark is not inherently distinctive, it may be registered on the Principal Register only upon proof that it has become distinctive as applied to the applicant’s goods or services in commerce.<sup>45</sup> It is the point at which the public views the primary significance of a trademark, previously found to be merely distinctive, as identifying the source of the product rather than the product itself.<sup>46</sup> However, once secondary meaning is established as to a particular mark, meaning that the consuming public identifies the mark with a specific source, the previously merely descriptive mark is afforded protection “under the same principles applicable to inherently distinctive marks.”<sup>47</sup>

According to the TMEP, three types of evidence may be used to establish acquired distinctiveness under §2(f).<sup>48</sup> This Comment will focus on the importance of further defining the establishment of acquired distinctiveness by actual evidence, and how courts should proceed to construe such evidence in the determination of a finding of secondary meaning for trademarks previously found to be merely distinctive.

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214 F.2d 139, 140 (C.C.P.A. 1954) (“There is no doubt that Congress intended that the burden of proof [under Section 2(f)] should rest upon the applicant”).

<sup>43</sup> *Registrations*, *supra* note 23.

<sup>44</sup> *Two Pesos, Inc. v Taco Cabana, Inc.*, 505 U.S. 763, 766 n.4 (1992) (citing Rest. 3d of Unfair Competition § 13 Comment e (Tent. Draft No. 2, Mar. 23, 1990)).

<sup>45</sup> The Lanham Act, 15 § U.S.C. 1052(f) (2012); TMEP § 1212.

<sup>46</sup> *Wal-Mart Stores v. Samara Bros.*, 529 U.S. 205, 211 (2000) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 851, n.11 (1982)).

<sup>47</sup> *PaperCutter, Inc. v. Fay’s Drug Co.*, 900 F.2d 558 (2d. Cir. 1990) (citing Rest. 3<sup>rd</sup>, Unfair Competition § 13 cmt. E (Tent. Draft No. 2 (1990))).

<sup>48</sup> The three types of evidence include prior registrations claiming ownership of a mark on the Federal Register that is sufficiently similar to that or those identified in the pending application (37 C.F.R. § 2.41(a)(1)(2015), TMEP §§ 1212.04-1212.04(e)), a statement certifying the applicant’s substantially exclusive and continuous use in commerce for five years before the date on which the claim of distinctiveness is made (37 C.F.R. § 2.41(a)(2)(2015), TMEP §§ 1212.05-1212.05(d)), and other appropriate evidence (37 C.F.R. § 2.41(a)(3)(2015), TMEP §§ 1212.06-1212.06(e)(iv)).

This Comment will analyze how federal courts and the TTAB have interpreted trademark applicants' social media presence to establish secondary meaning of a mark that has been determined to be merely descriptive by an examining trademark attorney. **Part II** will discuss how courts have historically responded to applicants' showings of evidence to establish secondary meaning, noting which types of actual evidence courts found most persuasive, and whether these types of evidence are still pertinent to courts' determinations today. It will also discuss current business trends and the shift towards use of social media to advertise and promote the source of a product or service in commerce. **Part III** will discuss court and TTAB decisions regarding the value of social media as a factor in determining acquired distinctiveness of a merely descriptive mark. This section will highlight cases in which social media has enhanced an applicant's claim for establishment of secondary meaning as well as cases in which courts have been un-persuaded by the use of social media to establish secondary meaning. **Part IV** will summarize the current state of the law with regards to use of social media as a factor to establish secondary meaning. **Part V** argues that social media, specifically customer reviews, is a relevant factor for a showing of secondary meaning. **Part VI** will explain that the 2009 Federal Trade Commission regulations for social media create an increased similarity between social media advertising and endorsements and traditional media, and that courts and the TTAB should view social media as analogous to traditional media with regard to evidence of acquired distinctiveness. **Part VII** will argue that courts should be receptive to considering social media metrics, including customer reviews, website traffic, and Instagram and Facebook use, as evidence of secondary meaning.

## II. EVIDENCE SHOWING SECONDARY MEANING

The Lanham Act, referred to commonly as the Trademark Act, is the primary federal trademark statute in the United States.<sup>49</sup> The Act codifies requirements that must be met by trademark applicants before they are awarded federal trademark registration.<sup>50</sup> Such requirements include that the mark is used or will be used in commerce; that the trademark applicant has no reason to believe that the mark belongs to someone else, or that the mark will cause confusion with another existing trademark; and additionally provide a drawing of the mark and state what products or services it is used or will be used in connection with.<sup>51</sup> Section 2(f) of the Trademark Act allows an exception to the re-

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<sup>49</sup> 15 U.S.C. § 1051.

<sup>50</sup> § 1051(a)(4).

<sup>51</sup> § 1051(a)(3)(D).

fusal of registration on the Principal Register for merely descriptive marks if the applicant establishes, to the satisfaction of the examining attorney, that the matter in question has acquired distinctiveness as a mark in relation to the named goods or services in commerce.<sup>52</sup>

An applicant wants to prove secondary meaning for his or her merely descriptive trademark so they can invoke trademark rights granted through registration on the Principal Register when protecting their mark against trademark infringement. Trademark infringement is proved through a “likelihood of confusion” analysis.<sup>53</sup> Under the Trademark Act, the owner of a registered trademark may file an infringement claim against anyone who, without permission of the owner, uses or imitates the mark in commerce, in connection with the sale, offering for sale, distribution, or advertising of goods or services, where such use is likely to cause confusion, mistake, or deceive.<sup>54</sup> Filing an infringement suit is one of the benefits that owners of federally registered trademarks can enjoy, so the applicant has a huge interest in gaining federal registration through proving acquired distinctiveness.

A trademark applicant who has received a final rejection from an examining attorney to obtain trademark protection through the Principal Register based on a finding of no secondary meaning may appeal to the Trademark Trial and Appeal Board. An applicant who is dissatisfied with the outcome of an appeal to the Trademark Trial and Appeal Board may then appeal to the Federal Circuit.<sup>55</sup> An alternative route also available is filing a civil action in any appropriate district court.<sup>56</sup> Various separate procedural routes, as well as discrepancies among circuits regarding the value afforded to different examples of evidence proving secondary meaning, have led to the appellate process being an unpredictable and expensive ordeal.

An applicant carries the burden of proof when asserting that her merely descriptive mark has acquired secondary meaning.<sup>57</sup> The determination of acquired distinctiveness is a question of fact, evidence of which must be contained in the record.<sup>58</sup>

Because the level of descriptiveness of a trademark is a continuum rather

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<sup>52</sup> § 1052(f). Section 2(f), unlike the other five provision of §1052, is not a provision under which registration on the Principal Register should be refused; rather it is a provision under which applicant has a chance to prove that he is entitled to a federal trademark registration which would otherwise be refused. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1580 n.10 (Fed. Cir. 1988) (quoting *In re Capital Formation Counselors, Inc.*, 219 U.S.P.Q. (BNA) 916, 917 n.2 (T.T.A.B. 1983)).

<sup>53</sup> 15 U.S.C. § 1114(1)(a)-(b).

<sup>54</sup> *Id.*

<sup>55</sup> TMEP §1705.09.

<sup>56</sup> *Id.*

<sup>57</sup> *Yamaha*, 840 F.2d at 1578-79.

<sup>58</sup> *In re Loew’s Theatres, Inc.*, 769 F.2d 764, 769 (Fed. Cir. 1985).

than a discrete category, the level of descriptiveness in relation to the mark for which the applicant seeks to establish secondary meaning affects the amount and type of evidence required to establish secondary meaning.<sup>59</sup> For example, where an applicant's mark contains words or phrases commonly used by third parties in her field or closely related fields, the mark is highly descriptive and would thus require a greater showing of evidence to establish secondary meaning.<sup>60</sup> A prominent example of a highly descriptive mark was found in the Court of Appeals for the Federal Circuit ruling that THE BEST BEER IN AMERICA, while still descriptive and not generic, was incapable of acquiring sufficient evidence of secondary meaning to restrict the use of the laudatory phrase to one source.<sup>61</sup>

The Fifth Circuit, for example, weighs the following factors to determine whether secondary meaning has been acquired depending heavily on the case at hand, and the determination is "primarily an empirical inquiry."<sup>62</sup> The factors set forth in *Pebble Beach* include

- (1) length and manner of use of the mark or trade dress, (2) volume of sales, (3) amount and manner of advertising, (4) nature of use of the mark or trade dress in newspapers and magazines, (5) consumer-survey evidence, (6) direct consumer testimony, and (7) defendant's intent in copying the trade dress or mark.<sup>63</sup>

The *Pebble Beach* factors have been relied on multiple times.<sup>64</sup> Among them, evidence demonstrating an establishment of secondary meaning in the form of consumer surveys has been found most persuasive.<sup>65</sup> According to the International Trademark Association, 40 participants is the size of the typical "pilot" survey used to assess secondary meaning or likelihood of confusion in trademark oppositions and litigation.<sup>66</sup>

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<sup>59</sup> TMEP § 1209.01; *see also* Remington Products, Inc. v. N. Am. Philips Corp., 892 F.2d 1576, 1580 (Fed. Cir. 1990)(explaining that the mark must be viewed in the context of its use).

<sup>60</sup> *See, e.g., In re Packaging Specialists, Inc.*, 221 U.S.P.Q. (BNA) 917, 918 (T.T.A.B. 1984).

<sup>61</sup> Anderson Duff, *Boston has the best beer, but does it have the best trademarks?*, BOSTON.COM (Nov. 27, 2012, 11:00 AM), [http://archive.boston.com/business/blogs/global-business-hub/2012/11/boston\\_has\\_the.html](http://archive.boston.com/business/blogs/global-business-hub/2012/11/boston_has_the.html).

<sup>62</sup> *Pebble Beach Co. v. Tour 18 I Ltd.*, 155 F.3d 526, 541 (5th Cir. 1998).

<sup>63</sup> *Id.*

<sup>64</sup> The *Pebble Beach* factors have been cited by the AIPLA Federal Circuit Legal Standards as the factors required by the 5th Circuit to establish secondary meaning. LEGAL STANDARDS OF THE FEDERAL CIRCUIT COURTS – 2011 UPDATE 5th Cir. (AIPLA TRADEMARK LITIG. COMMITTEE 2011).

<sup>65</sup> *Amazing Spaces Inc. v. Metro Mini Storage*, 608 F.3d 225, 248 (5th Cir. 2010); *Zatarains*, 698 F.2d at 795 ("The authorities are in agreement that survey evidence is the most direct and persuasive way of establishing secondary meaning."); *see also Aloe Crème Labs., Inc. v. Milsan, Inc.*, 423 F.2d 845, 849 (5th Cir. 1970).

<sup>66</sup> Paul F. Kilmer, *The Value Equation of Trademark Oppositions: A Multinational*

“Under Trademark Rule 2.41(a)(3), 37 C.F.R. 2.41(a)(3), an applicant may submit affidavits, declarations under 37 C.F.R. 2.20, depositions, or other appropriate evidence showing the duration, extent, and nature of the applicant’s use of a mark in commerce that may lawfully be regulated by the U.S. Congress, advertising expenditures in connection with such use, letters, or statements from the trade and/or public, or other appropriate evidence tending to show that the mark distinguishes the goods or services.”<sup>67</sup>

As the Internet revolution began to take hold of the way businesses developed and widened the pool of potential start-up business owners, so too did it change the way these new business developers interacted with their existing and potential clients. Through social media, businesses are able to carve out their own space in online commerce with minimal up-front investment.<sup>68</sup>

From the entrepreneur’s viewpoint in promoting its brand, product, or service on social media, many factors contribute to the growing popularity of this channel of communication with the relevant consumers. First, the costs associated with social media marketing and maintaining a social media campaign are highly discretionary in terms of the amount of resources the business is able or willing to dedicate to its maintenance.<sup>69</sup> As opposed to traditional avenues of marketing such as television, radio, and print, social media is relatively inexpensive and can be implemented or terminated at the user’s will, often without start-up fees or fear of breach of contract issues.<sup>70</sup>

Additionally, costs associated with television, radio, and print advertising vary greatly based on many factors, including the time slot and duration that the advertisement will run, the channels it will reach, and its distribution.<sup>71</sup> The resources that a trademark applicant has to expend in advertisements are considered a determining factor in establishing secondary meaning.<sup>72</sup> However, when there is such a great fluctuation among costs associated with different types of traditional advertising that courts accept as proof of secondary meaning, it may be worthwhile to question how accurate it is to look at the amount

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*Comparison of Costs and Perceived Benefits*, INTABULLETIN (Mar. 1, 2013), <http://www.inta.org/INTABulletin/Pages/TheValueEquationofTrademarkOppositionsAMultinationalComparisonofCostsandPerceivedBenefits.aspx>.

<sup>67</sup> TMEP § 1212.06.

<sup>68</sup> *Pure Imagination, Inc. v. Pure Imagination Studios, Inc.*, No. 03-C-6070, 2004 U.S. Dist. WL 2967446, at \*2 (N.D. Ill. Nov. 15, 2004).

<sup>69</sup> Gabriel Reynaga, *Traditional vs. Digital Advertising*, GABRIEL REYNAGA (July 27, 2015), <http://www.gabrielreynaga.com/traditional-vs-digital-advertising/>.

<sup>70</sup> *Id.*

<sup>71</sup> *Id.*

<sup>72</sup> “*Look for Advertising*” A Key to Establishing Distinctiveness For Registration Purposes, FITZPATRICK CELLA, [http://www.fitzpatrickcella.com/DB6EDC/assets/files/documents/Fitz\\_eNewsv2\\_2.4\\_TM.pdf](http://www.fitzpatrickcella.com/DB6EDC/assets/files/documents/Fitz_eNewsv2_2.4_TM.pdf) (last visited Oct. 27, 2016).

spent on advertising, and examine instead how the advertising works to reach consumers.<sup>73</sup>

Secondly, unlike television, print, and radio advertisement, social media campaigns enable businesses to evaluate how well their campaign is working and to what degree viewers or participants are engaged in the content that a company is producing through its social media channels.<sup>74</sup> Social media platforms such as Twitter, Facebook, and Instagram allow account owners to see how much interaction has occurred between the public and the uploaded content.<sup>75</sup> When account owners can use metrics to track how the public and their relevant consumer base receive their social media, there is more assurance that their followers are making a connection between the content produced by the accounts (including trademarks) and who the account owners are (the source).

Popular metrics that account owners can use to track their social media content include tracking trademark or brand mentions, the frequency at which a company's content is shared by the public or the company's account followers, traffic referred from third-party websites or other Internet sources to a company's website or social media page, and the number of engaged community members as measured by comments, direct messages, and other measurable actions.<sup>76</sup> These metrics provide an idea of whether a company is effectively reaching its existing and potential clients through social media. They also provide more feedback than the traditional avenues of advertisement in which a brand or company will expend resources on advertising and send it out into the ether without a direct and concrete way to determine how it is received or how the relevant consuming public relates to it.<sup>77</sup>

From the consumer side, potential customers use social media to connect

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<sup>73</sup> For example, advertisements in Super Bowl 50 broadcast cost \$5 million for a 30-second spot. While 114.4 million people tuned into the Super Bowl in 2015, it would require an inference or assumption that those viewers would be considered relevant consumers with regard to any or all of the advertisements aired during the Super Bowl. Claire Groden, *This is how much a 2016 Super Bowl ad costs*, FORTUNE (Aug. 6, 2015, 1:08 PM), <http://fortune.com/2015/08/06/super-bowl-ad-cost/>.

<sup>74</sup> Brad Shorr, *10 Dumb Social Media Mistakes That Small Business Owners Make*, FORBES (Jan. 21, 2016, 10:46 AM), <http://www.forbes.com/sites/allbusiness/2016/01/21/10-dumb-social-media-mistakes-that-small-business-owners-make/#65659fea42b1>.

<sup>75</sup> *Facebook*, FACEBOOK, facebook.com (last visited Aug. 16, 2016) (social networking site which allows users to connect with others by sharing content such as photos, text posts, videos, and news headlines); *Twitter*, TWITTER, twitter.com (last visited Aug. 16, 2016) (social networking site which limits users' posts and interactions to 140 characters); *Instagram*, INSTAGRAM, Instagram.com (last visited Aug. 16, 2016) (social networking site which allows users to upload photos and videos to their own accounts, while users can interact with other users by "liking" and commenting on post by others).

<sup>76</sup> Shorr, *supra* note 74.

<sup>77</sup> *Id.*

with brands and companies, ask questions, leave product or service reviews, and learn about products and services.<sup>78</sup> A study performed by the digital marketing firm G/O Digital found that before visiting a small business, 30% of the people polled check that business's Facebook page "several times a day."<sup>79</sup> This is no surprise due to the accessibility that users have to social media and the increased use of social media channels through mobile devices.<sup>80</sup> The accessibility that consumers have to businesses when they have an interest in a product or service they provide allows consumers to make a mental connection between the source (represented by the business's Facebook page, for example) and the product or service they are seeking out.

A significant percentage of former traditional media consumers have stopped reading, watching, or listening to news sources because they no longer fulfill the reasons for which they seek out and access the media.<sup>81</sup> In early 2013, for example, about one-third of former readers had deserted a particular news outlet.<sup>82</sup> To stay connected and have access to the same content, they turn to social media.

Based on the above, unsurprisingly, there has been a tangible commercial shift in the business world with respect to traditional advertising channels and digital advertising. Every type of traditional advertising is declining while digital advertising is steadily increasing.<sup>83</sup> Though courts are reluctant to apply long-established standards for secondary meaning to the use of social media and digital advertising, the shift in how businesses interact with consumers to build a link between their trademark and their business as a source must be recognized as a factor alongside expenditures in advertising and market surveys.

Since businesses started to depend on websites to establish secondary meaning of merely descriptive trademarks, courts have determined which types of evidence from a business's online presence are suitable to prove acquired distinctiveness. *In re Sones* is a Federal Circuit case which lays out the elements necessary for specimen acquired from a website to be probative evidence in a showing of trademark use.<sup>84</sup> The test requires that the specimen "must in some

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<sup>78</sup> Justin Lafferty, *Study: Before people shop at a small business, they check Facebook*, ADWEEK (Aug. 12, 2015, 6:00 AM), <http://adweek.com/socialtimes/study-before-people-shop-at-a-small-business-they-check-facebook/300>.

<sup>79</sup> *Id.*

<sup>80</sup> Greg Sterling, *State of the News Media: Everything in Decline But Digital*, MARKETING LAND (Mar. 18, 2013, 1:43 PM), [www.marketingland.com/library/channel/social-media-marketing](http://www.marketingland.com/library/channel/social-media-marketing).

<sup>81</sup> *Id.*

<sup>82</sup> *Id.*

<sup>83</sup> Kristine Lu & Jesse Holcomb, *Digital News Revenue: Fact Sheet*, PEW RES. CTR. (June 15, 2016), <http://www.journalism.org/2016/06/15/digital-news-revenue-fact-sheet>.

<sup>84</sup> *In re Sones*, 590 F.3d 1282, 1287-88 (Fed. Cir. 2009).

way evince that the mark is ‘associated’ with the goods and serves as an indicator of source.”<sup>85</sup> Just as courts were hesitant to begin a shift towards accepting screenshots from websites and webpages as evidence to show trademark use, there is resistance to the acceptance of social media use in establishing secondary meaning.<sup>86</sup> However, as the trend moves more towards businesses depending on social media to make their products known to their consumer base, courts need to establish a test for applicants to rely on in order to make the appeal process more predictable.

### III. RECENT CASES REGARDING SOCIAL MEDIA AS A FACTOR ESTABLISHING ACQUIRED DISTINCTIVENESS

#### Cases in Which Courts Have Found Acquired Distinctiveness Based on Social Media

Several recent cases have required courts to make a determination regarding which elements are necessary for evidence of consumers’ use of social media to be probative of secondary meaning for a trademark.

In *Blumenthal Distributing v. Executive Chair, Inc.*, Blumenthal Distributing, a chair distribution company, sought a finding of secondary meaning for chairs that it marketed for sale on its own website as well as on websites of third-party retail customers.<sup>87</sup> Blumenthal did not submit evidence of advertising expenditures, which is a traditionally accepted type of evidence for establishing secondary meaning.<sup>88</sup> Instead, Blumenthal submitted evidence of the chair being displayed on its website as well as its retailers’ websites.<sup>89</sup> The court held that this “undoubtedly contributed to the public’s association of those chairs with a single source.”<sup>90</sup>

In addition, Blumenthal submitted evidence in the form of unsolicited positive product reviews from customers.<sup>91</sup> The court held that these positive re-

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<sup>85</sup> *Id.* at 1288.

<sup>86</sup> *Lyons v. Am. Coll. of Veterinary Sports Med. & Rehab., Inc.*, 997 F. Supp. 2d 92, 105 (D. Mass. 2014) (holding the plaintiff veterinarian failed to establish trademark infringement since the plaintiff’s mark failed to establish distinctiveness from secondary meaning based on factors including advertising through social media).

<sup>87</sup> *Blumenthal Distrib. v. Exec. Chair, Inc.*, No. CV-10-1280 (CBA), 2010 U.S. Dist. LEXIS 142193, at \*6-7, (E.D.N.Y. Nov. 9, 2010).

<sup>88</sup> *Id.* at \*24.

<sup>89</sup> *Id.*

<sup>90</sup> *Id.* (citing *Cartier, Inc., v. Four Star Jewelry Creations, Inc.*, 348 F. Supp. 2d 217, 226, 241 (S.D.N.Y. 2004) (crediting both direct advertising and “co-op” advertising in which costs were shared between Cartier and its dealers)).

<sup>91</sup> *Blumenthal Distrib.*, 2010 U.S. Dist. LEXIS 142193, at \*24-25.

views indicated that Blumenthal's chairs had "developed a presence and favorable reputation on the internet and weigh[ed] in favor of a finding of secondary meaning."<sup>92</sup> While not dispositive in showing acquired distinctiveness, the court in *Blumenthal* readily acknowledged that customer reviews should hold at least some value in helping an applicant prove that consumers of a product associate a specific mark with a specific source.

In *GamerModz v. Golubev*, the plaintiff GamerModz is a Florida-based corporation that owns the service mark GAMERMODZ, and sells modified video game controllers online with the domain name "Gamermodz.com."<sup>93</sup> GamerModz sued Mikahil Golubev for his use of "GamingModz" and "RapidModz" in connection with modified video game controllers after GamerModz began receiving Golubev's products that were being returned by customers of GamingModz and RapidModz.<sup>94</sup> In response, Golubev filed a counterclaim asserting that GAMERMODZ is merely descriptive and lacking secondary meaning, and therefore it is not a protectable mark capable of being infringed.<sup>95</sup> While GamerModz did not include evidence based on market survey or direct consumer testimony, there was a finding of secondary meaning on the basis of advertising expenditures amounting to \$100,000 in Google AdWords search engine optimization, an online advertising service.<sup>96</sup>

Advertising expenditure is historically a factor considered by courts in the acquired distinctiveness analysis.<sup>97</sup> The cost paid for GoogleAds advertising in this case was a factor that was relevant to establishing secondary meaning. GamerModz provided additional evidence that the advertising created through investing in Google AdWords brought over 250,000 consumers to the applicant's website.<sup>98</sup> This direct link between dollars spent and effect on consumer exposure to applicant's mark is likely more persuasive than a dollar amount standing alone, because it demonstrates that the online advertising expenses creates a nexus between the producer and the consumer. However, it can be argued that the evidence is not dispositive of consumer awareness that the mark is representative of the applicant source.<sup>99</sup>

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<sup>92</sup> *Id.* at \*25.

<sup>93</sup> *GamerModz, LLC v. Golubev*, No. 8:10-CV-1466-T-27TGW, 2011 WL 4755026, at \*3 (M.D. Fla. Aug. 3, 2011).

<sup>94</sup> *Id.* at \*1, \*7-8.

<sup>95</sup> *Id.* at \*1-2, \*28-29.

<sup>96</sup> *Id.* at \*34; see also *What is Google AdWords? How the AdWords Auction Works*, WORDSTREAM, <http://www.wordstream.com/articles/what-is-google-adwords> ("Google AdWords is an advertising program. provided by Google that enables businesses to bid on certain keywords in order for their clickable ads to appear in Google's search results.").

<sup>97</sup> *GamerModz*, 2011 WL 4755026, at \*12.

<sup>98</sup> *Id.* at \*13.

<sup>99</sup> See *Int'l Jensen, Inc. v. Metrosound U.S.A., Inc.*, 4 F.3d 819, 824 (9th Cir. 1993) ("While evidence of a manufacturer's sales, advertising and promotional activity may be

## Cases in Which Courts Have Refused to Find Acquired Distinctiveness Based on Social Media

A number of recent cases have held that trademark owners have failed to establish acquired distinctiveness despite a social media presence. In *Nortech Investments Ltd.*, the TTAB refused to recognize the applicant's mark CASINO INFO as having acquired secondary meaning.<sup>100</sup> The plaintiff sought to register CASINO INFO in connection with a website providing information on gaming and entertainment.<sup>101</sup> Nortech Investments stated in its application that its continued use for 13 years of the website "CasinoInfo.com" should serve as evidence that CASINO INFO had acquired distinctiveness.<sup>102</sup>

The TTAB evaluated the applicant's evidence, which included the number of visitors to its website over several months' time.<sup>103</sup> Specifically, the evidence showed that between January and September of 2012, CasinoInfo.com received traffic from 17,615 visitors, and in 2011 received traffic from 28,570 unique visitors.<sup>104</sup> Nevertheless, the TTAB determined that this evidence was insufficient to prove secondary meaning.

The TTAB found the evidence insufficient on the basis that there was "nothing in the record to put [the number of visitors to the website] in context...to indicate applicant's market share or the proportion of relevant consumers exposed to applicant's mark."<sup>105</sup> Additionally, the Board found it insufficient that there was only evidence submitted regarding traffic to the website by visitors for the time period of January 2011 through September 2012.<sup>106</sup> Though the evidence showed that the applicant's site was receiving traffic and consumers were interacting with it on at least a basic level, the TTAB was hesitant to recognize this evidence as probative of a showing of acquired distinctiveness because there was no way to tie in the traffic with how consumers felt about CASINO INFO with respect to the applicant and applicant's website.<sup>107</sup>

Another case in which the link was missing between consumers' awareness of a mark in connection with a source can be found in *Pure Imagination, Inc.*

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relevant in determining secondary meaning, the true test of secondary meaning is the effectiveness of this effort to create it.").

<sup>100</sup> *In re Nortech Inv. Ltd.*, 2013 WL 5407237, at \*3 (T.T.A.B. 2013).

<sup>101</sup> *Id.* at \*8.

<sup>102</sup> *Id.* at \*7.

<sup>103</sup> *Id.* at \*8.

<sup>104</sup> *Id.*

<sup>105</sup> *Id.*

<sup>106</sup> *Id.*

<sup>107</sup> *Id.* (explaining the TTAB could not tell from the record "whether 28,570 hits on its website in a year represents anything more than some passing interest in the content of applicant's website, as opposed to wide recognition of the words CASINO INFO as an indication of source.").

*v. Pure Imagination Studios, Inc.*<sup>108</sup> Pure Imagination was a small advertising and marketing firm incorporated in Illinois.<sup>109</sup> Pure Imagination Studios (“Studios”) provided advertising, graphic design, illustration, and web site services, and was also incorporated in Illinois.<sup>110</sup> The dispute between the parties was over rights to the trademark PURE IMAGINATION.<sup>111</sup> Studios acquired rights to the domain name www.PureImagination.com in May 2001 and argued that acquisition of the domain name served as evidence that Studios was using the mark as a trademark. Without more, however, “mere registration of a domain name does not constitute the use of the domain name as a trademark.”<sup>112</sup>

In *Washington Speakers Bureau, Inc. v. Leading Authorities, Inc.*, an applicant for a mark submitted evidence attempting to demonstrate trademark use through the purchase of a domain name.<sup>113</sup> The Eastern District of Virginia court determined that purchasing a domain name did not show trademark use, because although “[a]nyone may register any unused domain name upon payment of a fee,”<sup>114</sup> but there is missing probative evidence showing that consumers associate the domain name (which happens to be the sought-after trademark) with the source.

A showing of domain name registration as evidence of secondary meaning, without more, is a logical basis upon which to reject a showing of secondary meaning, because domain name registration does not require the registrant to do more than pay a fee.<sup>115</sup> There could easily be no interaction between the website and the public after the time of registration, and such registration cannot count as evidence towards establishing secondary meaning.<sup>116</sup>

In another TTAB decision, *In re King Productions, Inc.*, the Board determined that the applicant had not established secondary meaning after submitting as evidence the sale of 884 copies of the ROCK YOUR BODY DVD for which applicant was seeking trademark protection.<sup>117</sup> An employee of the applicant company testified that all sales were transacted through the applicant’s website, pages of which contained the applied-for mark in connection with the

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<sup>108</sup> *Pure Imagination, Inc. v. Pure Imagination Studios, Inc.*, 72 U.S.P.Q.2d 1432, 1436-37 (N.D. Ill. 2004).

<sup>109</sup> *Id.* at 1433.

<sup>110</sup> *Id.*

<sup>111</sup> *Id.*

<sup>112</sup> *Id.* at 1435 (citing *Juno Online Servs., L.P. v. Juno Lighting, Inc.*, 979 F. Supp. 684, 691 (N.D. Ill. 1997)).

<sup>113</sup> *Wash. Speakers Bureau, Inc. v. Leading Auths., Inc.*, 33 F. Supp. 2d 488, 491 (E.D. Va. 1999).

<sup>114</sup> *Id.* at 491 n.3.

<sup>115</sup> *Burns v. Realnetworks, Inc.*, 359 F. Supp. 2d 1187, 1192 (W.D. Okla. 2004) (“The first party to adopt and use a mark in commerce obtains ownership rights in the mark.”) (citing *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90, 97 (1918)).

<sup>116</sup> *Burns*, 359 F. Supp. 2d at 1193.

<sup>117</sup> *In re King Prods., Inc.*, 2014 WL 7172033, at \*10-11 (T.T.A.B. 2014).

sold DVD, as well as a book, apparel, choreography and dance workshops and special event production services.<sup>118</sup>

Because the applicant in this case was proving secondary meaning to show that the mark was representative of a source, rather than a single work, the applicant had a higher burden of proof.<sup>119</sup> The TTAB found the evidence of sales originating from and transacted through rockyourbody.com to be insufficient for a showing of secondary meaning on the basis that there was not “significant exposure” of the ROCK YOUR BODY mark displayed such that a significant portion of the consuming public would be aware of it.<sup>120</sup>

Without more, such as evidence showing that the consumers knew that ROCK YOUR BODY was representative of the applicant source, rather than only being the name of the DVD, the TTAB refused to allow registration of the mark.<sup>121</sup> Had the applicant submitted evidence of consumers demonstrating an understanding of the link between the mark and the source, perhaps through reviews of the applicant’s products, there may have been a greater chance of the TTAB finding that the applicant had established secondary meaning.

An example of a TTAB appeal in which the applicant presented direct testimony but still did not reach the level of evidence necessary to establish acquired distinctiveness is demonstrated in *In re FreeHailEstimate.com*.<sup>122</sup> In this case, Freehailestimate.com applied for a stylized mark featuring FREE-HAILESTIMATE.COM.<sup>123</sup> After final rejection and appeal to the TTAB, the applicant submitted evidence from its social media pages including Facebook.<sup>124</sup> In addition to evidence from social media, the applicant submitted “21 form declarations from possible customers and business professionals in the paintless dent repair industry” affirming that they knew of Freehailestimate.com through its unique advertising and business model.<sup>125</sup>

The TTAB decided that evidence in the form of 21 form declarations provided by applicant was insufficient to prove secondary meaning.<sup>126</sup> The majority of the declarations were from technicians or independent contractors with whom the applicant may have worked.<sup>127</sup> The Board found that of the submitted declarations, only three were from end users who could potentially associ-

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<sup>118</sup> *Id.* at \*9-10.

<sup>119</sup> *Id.* at \*8 (quoting *In re Steelbuilding.com*, 415 F. 3d 1293, 1300 (Fed. Cir. 2005)).

<sup>120</sup> King Prods., 2014 WL 7172033 at \*10.

<sup>121</sup> 4 CALLMANN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES § 18.73 (4th ed. & Supp. 2015).

<sup>122</sup> *In re FreeHailEstimate.com*, 2012 WL 6654117, at \*16 (T.T.A.B. 2012).

<sup>123</sup> *Id.* at \*1 n. 1.

<sup>124</sup> *Id.* at \*17.

<sup>125</sup> *Id.* at \*14.

<sup>126</sup> *Id.* at \*19.

<sup>127</sup> *Id.* at \*16.

ate FREEHAILESTIMATE.COM with the applicant.<sup>128</sup> This evidence, according to the Board, “does not demonstrate that the relevant purchasers in general recognize FREEHAILESTIMATE.COM as a mark” and is therefore not sufficient to prove secondary meaning.<sup>129</sup>

Additionally, the applicant presented evidence that its website and Facebook page had established a “substantial and continuous presence in electronic media”<sup>130</sup> in the form of 159 Facebook “likes.” The Board found persuasive the examining attorney’s observations that there was no way to know how many of those “likes” were provided by people employed by or related to the applicant, rather than members of the relevant consumer public, and above all, the number was not large enough in context to establish secondary meaning.<sup>131</sup>

Some courts have offered commentary as to which evidence applicants should have gathered and submitted in order to increase their likelihood of proving secondary meaning. For example, in *Utah Lighthouse Ministry v. Foundation for Apologetic Information & Research*, the court stated “the number of search engine hits, *standing alone*, is inadequate to demonstrate that consumers associate the mark with a particular product or producer, or perceive UTAH LIGHTHOUSE as a distinctive mark.”<sup>132</sup>

The court then cited to a similar unsuccessful example in which Vail Ski Resort relied on as evidence for secondary meaning the fact that “Ski Magazine had repeatedly ranked the Vail Ski Resort as a preeminent ski resort over the last twenty years.”<sup>133</sup> The *Utah* Court explained the evidence of “Vail” in a ski resort ranking publication “would have been more probative of consumer perceptions” if there was, in addition, evidence of the percentage of consumers who read the magazine or evidence as to the circulation of the magazine.<sup>134</sup> With regard to search engine hits, the Court stated that evidence accompanying the number of hits, such as proof that the “relevant market of consumers” had visited the websites containing these hits, would have been more useful to establishing secondary meaning for the applicant.<sup>135</sup>

Similarly to *Utah Lighthouse*, the Trademark Trial and Appeal Board in *Nortech* did not find metrics of website traffic sufficient to prove secondary

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<sup>128</sup> *Id.*

<sup>129</sup> *Id.*

<sup>130</sup> *Id.* at \*16-17.

<sup>131</sup> *Id.* at \*17 (citing *In re Country Music Ass’n*, 100 U.S.P.Q.2d 1824, 1834 (T.T.A.B. 2011)).

<sup>132</sup> *Utah Lighthouse Ministry v. Found. For Apologetic Info. & Res.*, 527 F.3d 1045, 1051 (10th Cir. 2008).

<sup>133</sup> *In re FreeHailEstimate.com*, 2012 WL 6654117, at \*17 (citing *Vail Assocs. v. Vend-Tel-Co., Ltd.*, 516 F.3d 853, 867 n.12 (10th Cir. 2008)).

<sup>134</sup> *Utah Lighthouse*, 527 F.3d at 1051 (citing *Vail Assocs.*, 516 F.3d at 867 n.12).

<sup>135</sup> *Id.*

meaning.<sup>136</sup> There is a missing factor in establishing proof of secondary meaning by relying on raw metrics alone, which is the connection that consumers create between the content on a website and the source of the website; this link is not something that can be proved by website traffic and raw metrics alone.

#### IV. CURRENT OUTLOOK

Currently, the TTAB prefers not to delineate a bright-line rule with regards to the evidence necessary to establish secondary meaning, and instead cites to a standard emphasizing the success that an applicant has in educating the public to associate the proposed mark with a single source.<sup>137</sup> Though not necessary, the Board considers survey evidence to be a valuable method of showing secondary meaning.<sup>138</sup> When relying on survey evidence, the TMEP emphasizes the fact that the evidence should demonstrate that the “consuming public views the proposed mark as an indication of the source of the product or service,” and moreover that the consumer associates the mark with one single source, not one of many sources.<sup>139</sup>

Many circuit courts have attempted to simplify the required showing of evidence to establish secondary meaning by providing applicants with a list of types of evidence that can be probative in establishing acquired distinctiveness.<sup>140</sup> In determining secondary meaning, courts often consider factors including plaintiff’s advertising expenditures, consumer surveys, sales success, unsolicited media coverage, attempts to plagiarize the trademark, and length of exclusivity of use of plaintiff’s trademark.<sup>141</sup>

While a bright-line test should simplify the appeal procedurally, it has instead created divisiveness between circuits as some courts weigh certain factors more heavily than others.<sup>142</sup> For example, the 7<sup>th</sup> Circuit weighs product success heavily in establishing secondary meaning.<sup>143</sup> The neighboring 8<sup>th</sup> Cir-

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<sup>136</sup> Nortech, 2013 WL 5407237, at \* 8.

<sup>137</sup> TMEP § 1212.06.

<sup>138</sup> *Yankee Candle Co. v. Bridgewater Candle Co.*, 259 F.3d 25, 43 (1st Cir. 2001) (citing *I.P. Lund Trading ApS v. Kohler Co.*, 163 F.3d 27, 42 (1st Cir. 1998)); *Perini Corp. v. Perini Const., Inc.*, 915 F.2d 121, 125 (4th Cir. 1990) (citing *Thompson Medical Co. v. Pfizer Inc.*, 753 F.2d 208, 217 (2nd Cir. 1985)).

<sup>139</sup> TMEP § 1212.06(d) (2016).

<sup>140</sup> *L & J.G Stickley, Inc. v. Canal Dover Furniture*, 79 F.3d 258, 263 (2d Cir. 1996).

<sup>141</sup> *Id.* at 259.

<sup>142</sup> Kenneth L. Port, Note, *Eighth Circuit Trademark Opinions*, 36 WILLIAM MITCHELL L. REV. 1657, 1659-60 (2010).

<sup>143</sup> *See, e.g., Int’l Kennel Club of Chicago, Inc. v. Mighty Star, Inc.*, 846 F.2d 1079, 1085 (7th Cir. 1988) (explaining that secondary meaning is established when consumers think of the word as the product itself instead of being merely a descriptive tool).

cuit, however, has stated that evidence of the success of a product cannot provide the basis for an inference of secondary meaning because something other than secondary meaning could be the cause of the success of the product.<sup>144</sup>

This discrepancy, though not relevant in every case, can cause issues for trademark applicants,<sup>145</sup> especially because the Trademark Act is a federal statute. Thus, there should be a greater effort put forth for circuit courts to apply a unified bright-line rule so that divisiveness does not cause unpredictable results between circuits.

A common factor in many circuits whose test for secondary meaning outlines a list of probative evidence is the high value placed on consumer studies reflecting how the consumer views the trademark in relation to the source of the good it identifies.<sup>146</sup> The American Intellectual Property Law Association Trademark Litigation Committee released standards of the federal circuit courts in 2011, among which most of the courts identified consumer surveys as a probative type of evidence used to establish secondary meaning.<sup>147</sup>

Courts have been hesitant to consider an applicant's website traffic metrics as evidence of secondary meaning.<sup>148</sup> It is clear that, although metrics that record website traffic provide concrete information to applicants and domain name managers, the hard numbers are missing the link between consumers and the source that allows for a showing of secondary evidence – that is, the link that connects the product and its source in the minds of consumers.<sup>149</sup> When courts consider a website to be “a potential promotional tool,” as it was considered to be in *Lyons*, if there is no evidence showing that consumers become aware of the source's mark through that site, then “the mere existence of a website is not highly probative of either an effective advertising technique or... the public's association” of the mark with the source.<sup>150</sup>

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<sup>144</sup> See, e.g., *Foamation, Inc. v. Wedeward Enter., Inc.*, 970 F. Supp. 676, 689 (E.D. Wis. 1997).

<sup>145</sup> See generally Jerome Gilson & Anne Gilson LaLonde, *The Lanham Act: Time for a Face Lift?*, 92 TRADEMARK REP. 1013, 1013 (2002).

<sup>146</sup> See, e.g., *Rosetta Stone Ltd. v. Google, Inc.*, 676 F.3d 144, 160 (4th Cir. 2012); *Fortune Dynamic, Inc. v. Victoria's Secret Stores Brand, Inc.*, 618 F.3d 1025, 1036 (9th Cir. 2010); *Zatarains*, 986 F.2d at 795; see also *Foamation*, 970 F. Supp. at 687 (emphasizing that secondary meaning stems from consumers' ability to identify the source of the product rather than the product itself).

<sup>147</sup> LEGAL STANDARDS OF THE FEDERAL CIRCUIT COURTS – 2011 UPDATE 5th Cir. (AIPLA TRADEMARK LITIG. COMMITTEE 2011).

<sup>148</sup> *Utah Lighthouse*, 527 F.3d at 1051 (holding that Utah Lighthouse failed to establish a secondary meaning); *Blinded Veterans Ass'n v. Blinded Am. Veterans Found.*, 872 F.2d 1035, 1036, 1038-39 (D.C. Cir. 1989) (holding that “Blinded Veterans Association” is generic and thus unprotectable).

<sup>149</sup> *Jenzabar, Inc. v. Long Bow Group, Inc.*, 82 Mass. App. Ct., 648, 665-66 (Mass. App. Ct. 2012); *Chatam Int'l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 556-57 (E.D. Pa. 2001); *Zatarains*, 698 F.2d at 793-94.

<sup>150</sup> *Lyons*, 997 F. Supp. 2d at 105.

V. PARTIES CAN USE SOCIAL MEDIA TO ESTABLISH THEIR MARKS,  
BUT MUST BE AWARE OF THE NEXUS REQUIREMENT

Based on the existing case law and TTAB decisions, courts and the TTAB appear to be hesitant to allow trademark protection when there is evidence of social media presence, but only weak evidence that the consumers of the trademark applicant's products or services associate the mark with the goods or services.

Though social media is an increasingly popular method by which brand owners foster relationships and communicate with their customers, this trend has not yet been reflected through adoption of social media metrics as a form of evidence establishing acquired distinctiveness. In the cases that have been discussed in this Comment, trademark applicants who had success with using social media to prove a showing of secondary meaning among consumers accomplished such a task through evidence of a high enough quantum of consumer interaction with the applicant's interactive platforms.<sup>151</sup> This is helpful for larger companies who already have a sizeable market share, or brands that have large market audiences for their area of commerce.

Courts already use a two-part threshold determination before reaching the factors that are probative of secondary meaning. First, they define the goods and services that the mark identifies, and then they specify the relevant consuming public.<sup>152</sup> If courts extrapolated this threshold determination to apply to cases involving evidence of social media, then the size of the company would not prevent the source from submitting evidence of social media interactions simply because they appear to be objectively lower. Because a mark achieves secondary meaning only when a "significant quantity of the *consuming public* understand the name as referring exclusively to the appropriate party," it is an essential task to determine what the size of the consuming public is.<sup>153</sup> If courts took into account the size of the market in which the applicant is competing, then applicants could be more confident in relying on evidence of website visits or other quantifiable online communication without being concerned about having to measure up to the social media presence of larger businesses.

However, it does not help those smaller businesses that are relying on social media to connect to users and make a first impression for their business, a practice utilized by many small companies. Given that over 80% of small

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<sup>151</sup> See, e.g., *GamerModz*, 2011 WL 4755026, at \*12-15 (in which 250,000 website hits established acquired distinctiveness in trademark).

<sup>152</sup> *Lyons*, 997 F. Supp. 2d at 103-04 (citing *Boston Beer Co., Ltd. v. Slesar Bros. Brewing Co., Inc.*, 9 F.3d 175, 182 (1st Cir. 1993)).

<sup>153</sup> *Boston Beer*, 9 F.3d at 181 (emphasis added).

businesses rely on social media to promote their brand,<sup>154</sup> and that these small businesses are less likely to shell out large amounts of money on advertising campaigns, the use of social media in establishing acquired distinctiveness for trademarks would benefit those who rely on it most heavily if the quantum of interactions were considered in light of the business's target audience.<sup>155</sup>

Precedent has shown, however, that trademark applicants do not need a staggeringly high level of platform traffic in order to gain trademark protection or defend their registered trademark. Customer reviews have been given evidentiary significance in proving acquired distinctiveness, comparable to consumer surveys that have historically been considered as evidence supporting secondary meaning.<sup>156</sup> This appears to be the most effective way to use social media to prove secondary meaning, as it shows the nexus that must exist between the source and the consumer.

An issue that could arise when relying on customer reviews would be courts and the TTAB taking into consideration the identity of the affiant or declarant when making a determination about the value of the affidavits or declarations as evidence of acquired distinctiveness.<sup>157</sup> The veil of anonymity afforded to social media users could work to the detriment of trademark applicants who want to rely on customer reviews, which may function as quasi-affidavits or declarations, as these statements as evidence could be weakened by an inability to state the identity of the affiant or declarant.

Along with the risk of insufficient credibility given to a customer review, customer reviews from individuals, typically who have a personal interest in the success of the trademark or brand, will be discredited by both the courts and the TTAB.<sup>158</sup> For those managing social media accounts for brand development purposes, a major key to ensuring that the content of the accounts will be helpful in demonstrating secondary meaning among customers is by curating the account, assuring that the information provided by brand owner and the customers communicating with it is both authentic and unbiased.<sup>159</sup> The Word

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<sup>154</sup> Geoff Weiss, *This is How Small Businesses Are Using Social Media*, ENTREPRENEUR (Feb. 13, 2014), <http://www.entrepreneur.com/article/231515>.

<sup>155</sup> *Id.*

<sup>156</sup> *Box Acquisitions, LLC v. Box Packaging Products, LLC*, 32 F. Supp. 3d 927, 936 (2014).

<sup>157</sup> *In re Doctors on Liens, Inc.*, 2015 WL 7273015, at \*7 (T.T.A.B. 2015).

<sup>158</sup> *See, e.g., id.* (declarations from company's principal and executive director of an associated professional group); *see also In re Steelbuilding.com*, 415 F.3d at 1300 (online poll results not considered in determination of acquired distinctiveness because the poll "lacked sufficient signs of reliability" failing to include the number of participants, the number of participates prevented visitors from voting more than once, the number of interested parties such as friends, associates, or employees of the applicant that participated and whose vote could skew results).

<sup>159</sup> Melissa Landau Steinman & Mikhia Hawkins, *When Marketing Through Social Media, Legal Risks Can Go Viral* 2-3, VENABLE (May 2010),

of Mouth Marketing Association, which advises businesses on best practices in digital, social, and mobile marketing, suggests that brand managers make necessary disclosures when third parties endorse their products or services. This is recommended to maintain integrity in the social media campaign and additionally to avoid reliance on customer reviews that courts or the TTAB will use to discount and discredit trademark prosecution or litigation as being too involved in the success of the company to be given the same evidentiary weight as would be given a traditional consumer survey.<sup>160</sup>

#### VI. FTC REGULATION OF SOCIAL MEDIA PROMOTES CONSISTENCY WITH EFFECTS OF TRADITIONAL ADVERTISING

In 2009 the Federal Trade Commission (FTC) introduced revisions to its Testimonial and Endorsement Guides.<sup>161</sup> Under the revised FTC Act, “native advertising,” or advertising that is paid media where the ad experience follows the natural form and function of the user experience in the platform in which it is placed, can amount to a false advertising violation.<sup>162</sup> The first case in which this issue was discussed was when Lord & Taylor paid the online fashion magazine Nylon and 50 Instagram users, each with “a massive number of followers” to write reviews for a specific article of clothing.<sup>163</sup> Lord & Taylor did not require any of the paid advertisers to disclose that they were reviewing the product in exchange for compensation, a fact that the FTC believed was material to consumers’ understanding of the relationship between the company and the endorsers.<sup>164</sup>

The Endorsement Guidelines are available to advertisers to advise them on how to keep their endorsement and testimonial ads in line with the FTC Act.<sup>165</sup> The standards treat advertising and marketing via social media just as

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[https://www.venable.com/files/publication/b4f467b9-0666-4b36-b021-351540962d65/presentation/publicationattachment/019f4e5f-d6f8-4eeb-af43-40a4323b9ff1/social\\_media\\_white\\_paper.pdf](https://www.venable.com/files/publication/b4f467b9-0666-4b36-b021-351540962d65/presentation/publicationattachment/019f4e5f-d6f8-4eeb-af43-40a4323b9ff1/social_media_white_paper.pdf).

<sup>160</sup> *Word of Mouth Marketing Association Guide to Best Practices for Transparency and Disclosure in Digital, Social, & Mobile Marketing*, WOMMA, <http://www.womma.org/wp-content/uploads/2015/08/WOMMA-Social-Media-Disclosure-Guidelines-2013.pdf> (last updated Nov. 18, 2013).

<sup>161</sup> Press Release, FTC, *FTC Publishes Final Guides Governing Endorsements, Testimonials*, (Oct. 5, 2009) (on file with author) [hereinafter *FTC Press Release*].

<sup>162</sup> Lesley Fair, *FTC’s Lord & Taylor Case: In Native Advertising, Clear Disclosure is Always in Style*, FTC (Mar. 15, 2016), <https://www.ftc.gov/news-events/blogs/business-blog/2016/03/ftcs-lord-taylor-case-native-advertising-clear-disclosure>.

<sup>163</sup> *Id.*

<sup>164</sup> *Id.*

<sup>165</sup> FTC Press Release, *supra* note 161.

they do similar practices employed in the context of traditional media.<sup>166,167</sup> The FTC protocol provides recommendations to the people who use social media to write about products and services, whether as a voluntary review or after being compensated by the brand for their endorsement.<sup>168</sup>

The FTC Act does not apply differently to online reviewers than to traditional print publications; and, online reviewers found to be in violation of the FTC Act can be subject to forfeit of profits gained from deceptive advertising.<sup>169</sup> By publishing a comprehensive set of suggestions to online reviewers and social media account managers for products and services, the FTC acknowledged the influence and import that such reviews have on commerce and establishing a certain image with a specific source.<sup>170</sup>

The goal of the FTC Act is to ensure that “the audience understands the reviewer’s relationship to the company whose products are being recommended.”<sup>171</sup> Not only does an undisclosed endorsement put brand owners at risk of violating the FTC Act, but it could also count against them in an attempt to establish acquired distinctiveness of a merely descriptive trademark.<sup>172</sup> For these reasons, social media account managers and product reviewers should understand that borderline-commercial interactions such as product reviews are governed in the same way that traditional commercial activity is governed. As such, courts and the TTAB should view authentic, disclosed endorsements with the same evidentiary value as traditional forms of advertising.

In addition to customer reviews, other commercial activity occurring on social media should be considered under the traditional analysis for acquired distinctiveness for merely descriptive trademarks. For example, Instagram enables certain account owners to include a link button in their posts which upon clicking redirects visitors to the account owner’s website where visitors can purchase goods and services online.<sup>173</sup> Often this link button is labeled “Buy” and serves to “transform viewers into shoppers with a single click.”<sup>174</sup> Banana Republic was the first to employ these new marketing tools on the

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<sup>166</sup> Steinman & Hawkins, *supra* note 159.

<sup>167</sup> Traditional media here includes trade shows, conferences, educational seminars, sponsorships, direct mailings, online and print advertisements, and press releases.

<sup>168</sup> FTC, THE FTC’S ENDORSEMENT GUIDES: WHAT PEOPLE ARE ASKING 3 (May 2015) [hereinafter ENDORSEMENT GUIDES].

<sup>169</sup> *Id.* at 4.

<sup>170</sup> *Id.* at 2.

<sup>171</sup> *Id.* at 3.

<sup>172</sup> However, the FTC Act only applies “if an endorser is acting on behalf of an advertiser” and what the endorser says is commercial speech. *Id.* at 4.

<sup>173</sup> See Garrett Sloane, *Instagram Takes Another Step Towards E-Commerce, Has its eye on click-to-shop ads*, ADWEEK (Apr. 13, 2015, 7:54 PM), <http://www.adweek.com/news/technology/instagram-takes-another-step-toward-e-commerce-164024>.

<sup>174</sup> *Id.*

social media platform in March of 2015 and the developments have increased in popularity since their debut.<sup>175</sup>

Facebook has similarly added a shopping option to its “Pages” feature.<sup>176</sup> A Page on Facebook is owned and managed by a business or organization, and recently Facebook added a Shop application to the Pages options, allowing visitors to a business or organization’s Page to see what products or services are available to purchaser from the business or organization and initiate the commercial transaction.<sup>177</sup> Facebook has also recently developed a Messenger app that allows businesses to communicate with customers about placing orders and answer questions about the business’s products and services.<sup>178</sup>

Facebook and Instagram have motives to provide more commercially interactive platforms for customers and businesses or organizations to communicate – bringing in advertising money. However, by changing the way that businesses choose to advertise and generally communicate with their audiences, these social media giants are causing tension in the way that courts and the TTAB historically analyzes evidence showing acquired distinctiveness. If the trend is going to continue in the direction of social media platforms becoming increasingly capable of hosting complex commercial transactions, then the bodies determining what factors are important in establishing secondary meaning must recognize this trend and the powerful effect it has already started to have on businesses.

## VII. CONCLUSION

According to the International Trademark Association, in a study comparing the average costs for trademark oppositions among countries, the United States averages between \$150,000 and \$500,000, while other countries’ average costs are considerably lower.<sup>179</sup> The survey attributes the cost disparity to the proce-

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<sup>175</sup> *Id.*

<sup>176</sup> Kyli Singh, *What’s Really the Difference Between Facebook Pages, Groups and Profiles?*, MASHABLE (Oct. 19, 2014), <http://mashable.com/2014/10/19/facebook-pages-groups-profiles/#UgMxLOx0ZmqQ>.

<sup>177</sup> Julia Greenberg, *Facebook is Testing a Shopping Section for In-App Retail*, WIRED (Oct. 12, 2015, 5:33 PM), <http://www.wired.com/2015/10/facebook-testing-shopping-section-app/>.

<sup>178</sup> Ryan Mac, *Facebook Goes All In On E-Commerce By Bringing Businesses Onto Messenger*, FORBES (Mar. 25, 2015, 3:18 PM), <http://www.forbes.com/sites/ryanmac/2015/03/25/facebook-goes-all-in-on-e-commerce-by-bringing-businesses-onto-messenger/#7a1843414747>.

<sup>179</sup> For example, average costs in Australia are \$15,000-\$30,000; in Brazil, \$1,500-\$10,000; in Canada \$20,000-\$50,000; in the European Union \$5,000-\$25,000; and in Japan \$5,000-\$500,000. Kilmer, *supra* note 66.

dural requirements of the TTAB, including discovery requests.<sup>180</sup>

To avoid some of the costs of adjudicating a claim for acquired distinctiveness, the USPTO should consider social media use and online presence as actual evidence of acquired distinctiveness. Because examining attorneys do not and should not specify the kind or amount of evidence sufficient to establish that a mark has acquired distinctiveness, applicants would benefit from a more inclusive definition of what the USPTO will consider persuasive evidence in establishing acquired distinctiveness.

Allowing such evidence would help increase efficiency within the system when appeals to the TTAB regarding an examining attorney's refusal to find evidence sufficient for establishing secondary meaning are a common and prohibitively costly occurrence. Especially because social media is based upon metrics and tracking who sees what information, the courts should have less trouble than with surveys or advertising through newspaper and other traditional media outlets in establishing whether social media has effectively led consumers to an understanding that the applicant's mark has come to represent a source rather than a product.

The difficulty in prescribing a method of best use for social media in establishing acquired distinctiveness for merely descriptive marks evolves from the highly fact-dependent assessment of each individual trademark registration, rejection, or contestation. Regardless of the facts of each matter, business owners should feel that it is in their best interest to invest in managing social media platforms for their brands in order to connect with customers.

Businesses should also do so with the assurance that they can rely on the records kept by social media accounts to prove that they are entitled to the brand goodwill that they have put effort into fostering. It is time for the TTAB and courts to acknowledge the shift in how businesses communicate with their audiences and revise a long-standing formulation for determining acquired distinctiveness of merely descriptive trademarks in a way that fits in with the modern business trend promoted by social media.

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<sup>180</sup> *Id.*