

Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders

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INTRODUCTION

Many companies and organizations today are using social network sites such as Facebook, Twitter, and MySpace to communicate with the public about their goods, services, and activities.¹ Examples include Southwest Airlines, Comcast, Taco Bell, Billabong, and my own law school.² Trademark holders often set up a social network

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1. See Verne Kopytoff, *Twitter Brainstorming for Plan to Turn Profit*, J. GAZETTE, Feb. 16, 2009, available at <http://www.journalgazette.net/article/20090216/BIZ/302169952/-1/BIZ09>; Julian Lee, *Squatters Creating Twittering Confusion*, AGE, Apr. 30, 2009, at B2, available at 2009 WLNR 8073054; Brian Stelter, *Griping Online? Cable Company Hears You and Talks Right Back*, N.Y. TIMES, July 25, 2008, at A1. For example, “US retail chain Wal-Mart recently tweeted: ‘Walmart.com Spalding NBA 52’ Steel Framed Portable Basketball System \$398.00.” Lee, *supra*.

2. Southwest Airlines on Facebook, <http://www.facebook.com/Southwest> (last visited June 10, 2010); Comcast Cares on Twitter, <http://twitter.com/comcastcares> (last visited June 10, 2010); Taco Bell Truck on Twitter, <http://twitter.com/tacobelltruck> (last visited June 10, 2010); Billabong Girls on MySpace, <http://www.myspace.com/billabonggirls> (last visited June 10,

site account with a publicly-available “page” or “profile” and use their brand name or other trademarked terms in their username to identify themselves on these sites.³

Yet markholders are not the only ones who have registered usernames containing trademarks on social network sites. Some people have engaged in “username squatting” and have registered usernames containing another’s mark with the intent to sell the username to the markholder for a profit. For example, Coca-Cola and Nike were allegedly “victims of squatters of their Twitter identities.”⁴ There were also many reports of “facesquatting” on Facebook once it allowed registration of usernames during the summer of 2009.⁵

Several individuals have also set up unauthorized social network site pages for brands on Facebook, Twitter, MySpace, and other sites.⁶ Some, like the Coca-Cola fan page on Facebook, are allowed to exist and are embraced (or at least tolerated) by markholders who recognize the benefits of this user-generated content.⁷ Other accounts are

2010). My law school’s Facebook page is at University of San Diego School of Law on Facebook, <http://www.facebook.com/usdlaw> (last visited June 10, 2010).

3. For more details about how brands use social network sites, see *infra* Part I.

4. Lee, *supra* note 1, at B2; see also Charlotte McEleny, *Brand Identities at Risk as Fakers Take Their Place on Twitter*, NEW MEDIA AGE, Mar. 12, 2009, at B2, available at 2009 WLNR 8073054.

5. Posting of Lillian Edwards to PanGloss, *Brandjacking and FaceSquatting*, <http://blogsript.blogspot.com/2009/06/brandjacking-and-face-squatting.html> (June 16, 2009, 2:42); Posting of Nick O’Neil to All Facebook, *Facesquatting and the 2009 Facebook Username Landrush Aftermath*, <http://www.allfacebook.com/2009/06/facesquatting-facebook-usernames/#> (June 15, 2009, 12:53); see also Brad Stone, *Keeping a True Identity Becomes a Battle Online*, N.Y. TIMES, June 18, 2009, at B1; Steven Swinford & Chris Gourlay, *Facebookers Snap Up Names*, AUSTL., June 15, 2009, at 10, available at 2009 WLNR 11400217.

6. McEleny, *supra* note 4.

7. As explained in a video posted on Facebook, Dusty Sorg and Michael Jedrzejewski created a Facebook fan page for Coca-Cola without first obtaining authorization from Coca-Cola. Videos Posted by Coca-Cola: We Made a Facebook Page, <http://www.facebook.com/video/video.php?v=57458127013> (last visited June 10, 2010). Today the page is maintained in partnership with The Coca-Cola Company. Coca-Cola on Facebook, <http://www.facebook.com/cocacola> (last visited June 10, 2010).

investigated, and shut down or taken over, once their existence is discovered. For example, “Janet” registered ExxonMobilCorp on Twitter and used the account to answer questions about the direction of the company and where it was spending philanthropy resources.⁸ It is unclear whether this person was an Exxon employee.⁹ Regardless, Exxon’s official spokesperson said Janet’s Twitter posts were unauthorized and contained several errors.¹⁰ Later, the account username was changed to Not_EM C.¹¹

Some fake social network site pages become the subject of lawsuits for trademark infringement, dilution, and other violations of federal and state laws. An example is the fake Nine West—Model Auditions group page on Facebook created by a user with the alias Nine West Shoes that solicited females interested in model auditions to send photographs of their faces, bodies, and toes with their contact information.¹² According to Nine West’s Complaint,

8. See Posting of Jeremiah Owyang to Web Strategy, *How “Janet” Fooled the Twittersphere (and Me) She’s the Voice of Exxon Mobil*, <http://www.web-strategist.com/blog/2008/08/01/how-janet-fooled-the-twittersphere-shes-the-voice-of-exxon-mobil/> (Aug. 1, 2008, 13:15) [hereinafter Owyang, *How “Janet” Fooled the Twittersphere*]; Posting of Jeremiah Owyang to Web Strategy, *When Brands Under Fire Step into the Fracas: Exxon Joins Twitter*, <http://www.web-strategist.com/blog/2008/07/29/when-brands-under-fire-step-into-the-fracas-exxon-joins-twitter/> (July 29, 2008, 3:35).

9. Compare Posting of Jeff Trexler to Uncivilsociety.org, *Is the Exxon Mobil Twitterer a Fake?*, <http://uncivilsociety.org/2008/08/is-the-exxon-mobil-twitterer-t.html> (Aug. 2, 2008, 22:04) (suggesting that Janet may be an employee), and Posting to Grey Review, *“I am an Employee of Exxon Mobil,” Said Janet*, <http://www.greyreview.com/2008/08/08/exxon-mobil-janet/> (Aug. 8, 2008, 22:00) (showing screenshot of post by Janet), with Posting of Ted McKenna to The Cycle, *Exxon Requests Control of Fake Twitter Account*, <http://www.prweekus.com/exxon-requests-control-of-fake-twitter-account/article/152700/> (Aug. 13, 2008) (noting that the company says Janet is not an employee).

10. Tom Fowler, *‘Exxon’ on Twitter? Not so, Company Says*, HOUSTON CHRON., Aug. 2, 2008, at D1; Posting of Shel Holtz to A Shel of My Former Self, *ExxonMobil Situation Shows “Brandjacking” is for Real*, http://blog.holtz.com/index.php/exxonmobil_situation_shows_brandjacking_is_for_real/ (Aug. 1, 2008, 13:11); Owyang, *How “Janet” Fooled the Twittersphere*, *supra* note 8.

11. Grey Review, *supra* note 9; Not_EM C on Twitter, http://twitter.com/Not_EM C (last visited June 10, 2010).

12. Complaint at 7-9, ¶¶ 15-18, *Nine West Dev. Corp. v. Does 1-10*, No. 07-cv-7533 (S.D.N.Y. filed Aug. 24, 2007), available at

at least 400 Facebook members joined the Nine West—Model Auditions group and possibly sent personal information and photographs to an imposter.¹³ Another example is the Twitter account set up with the username TannerFriedman that sent out embarrassing posts—called “tweets” on Twitter—that purported to be from the public relations firm Tanner Friedman.¹⁴ Upon discovering the existence of this fake account, Tanner Friedman filed suit. According to news reports, the fake account may have been set up by an employee working for a competitor.¹⁵

Such unauthorized uses of trademarks may frustrate markholders, but it is unclear whether trademark infringement law applies where the mark is not being used to advertise or sell goods or services.¹⁶ Markholders will

<http://www.counterfeitchic.com/Cases/cic/3/ninewest.pdf> [hereinafter *Nine West Complaint*]; Posting of Susan Scafidi to Counterfeit Chic, *Couture in Court 3*, http://www.counterfeitchic.com/2007/09/couture_in_court_3.php (Sept. 17, 2007, 20:51) (linking to a copy of the Complaint with the comment “Foot fetish: Facebook creeps lure ‘models’ by pretending to be Nine West”); Posting of Rebecca Tushnet to Rebecca Tushnet’s 43(B)log, *Facebook Fraud*, <http://tushnet.blogspot.com/2007/12/facebook-fraud.html> (Dec. 20, 2007, 13:21) [hereinafter Tushnet, *Facebook Fraud*].

13. *Nine West Complaint*, *supra* note 12, at 9, ¶ 20. After the fake account was removed from Facebook, another fake Nine West—Model Auditions group page appeared on Facebook. This one targeted women as young as 13 years of age, and 226 members joined the group before the site was shut down. *Id.* at 12-13, ¶¶ 32-35.

14. Complaint at 5, ¶¶ 14-17, *TFSC, LLC v. Doe*, No. 2:09-cv-12017 (E.D. Mich. filed May 27, 2009), available at 2009 WL 3227408 [hereinafter *Tanner Friedman Complaint*]; *Tanner Friedman Sues over False Twitter Account*, WWJ NEWSRADIO 950, June 2, 2009, <http://www.wwj.com/Tanner-Friedman-Sues-Over-False-Twitter-Account/4519407> [hereinafter *False Twitter Account*].

15. *Tanner Friedman Wins Back Control of Twitter Account*, WWJ NEWSRADIO 950, June 24, 2009, <http://www.wwj.com/Tanner-Friedman-Wins-Back-Control-Of-Twitter-Accou/4668160>; see also Posting of Andrew Moshirnia to Citizen Media Law Project, *Brandjacking on Social Networks: Twitter, Malicious Ghostwriting, and Corporate Sabotage*, <http://www.citmedialaw.org/blog/2009/brandjacking-social-networks-twitter-malicious-ghost-writing-and-corporate-sabotage> (July 15, 2009, 13:10).

16. See, e.g., Lee, *supra* note 1 (“[U]nless an interloper is using the brand name to masquerade as that brand and possibly even sell products that are trading on that name, brand owners are relatively powerless.”) (interview of Australian attorney Frances Drummond); Tushnet, *Facebook Fraud*, *supra* note 12 (“The obvious problem is whether any of these causes of action can apply if the deceptive Does were operating only for their own perverted gratification,

likely argue these third parties are engaged in “brandjacking,” or the “illegal use of trademarked brand names online.”¹⁷ Infringement law prohibits use of another’s mark that is likely to cause confusion,¹⁸ and consumers may be confused regarding the source of expression posted on a social network site by an individual who signed up with a username or account name that incorporates another’s trademark. Accused infringers will likely contend their use of the mark is not actionable under trademark doctrine and is protected by the First Amendment right to freedom of expression.¹⁹

This Article explores how current federal trademark infringement and free speech law applies to alleged brandjacking on social networks. To focus the discussion, this Article only considers infringement law, and not trademark dilution or other federal or state laws.²⁰ After discussing in Part I how individuals and brands use social network sites, Part II analyzes whether markholders will be able to satisfy the elements of a federal trademark infringement claim when their marks are used without authorization on these sites. The markholder must prove its

rather than for commercial purposes. I’m willing to accept that pretending to offer services in the ordinary market—here, the market for modeling services—ought to count under these (hopefully unique) facts. But bad conduct makes bad law; using Nine West’s name in a noncommercial context should not, as a rule, subject the user to the risk of trademark etc. liability. And that’s so even if the noncommercial context is highly objectionable—e.g., the L.L. Bean sex catalog case.”).

17. See, e.g., Shaun Waterman, *Brand-jacking Rises as Top Online Abuse*, WASH. TIMES, Mar. 9, 2009, available at <http://www.washingtontimes.com/news/2009/mar/09/brand-jacking-rises-as-top-online-abuse/>; see also Tim Lynch, *The Art of Self Defense Against Brand-jacking*, IMEDIA CONNECTION, Nov. 12, 2008, <http://www.imediaconnection.com/content/21110.asp>.

18. See *infra* Part II.A.

19. U.S. CONST. amend. I.

20. Federal trademark dilution law only applies if the plaintiff’s mark is famous, 15 U.S.C. § 1125(c)(1) (2006), and does not apply to certain fair uses of the mark, news reporting and news commentary, and noncommercial use of a mark. *Id.* § 1125(c)(3). A markholder may also claim the unauthorized use of its mark on a social network site violates laws prohibiting defamation, deceptive trade practices, false advertising, unfair competition, or intentional interference with contractual or business relations, among other federal or state laws. Whether these are viable claims is beyond the scope of this Article.

distinctive mark is used “in commerce” and in connection with goods, services, or commercial activities.²¹ Courts in some circuits will also require evidence of commercial use and/or trademark use of the mark for a prima facie trademark infringement claim.²² If these threshold requirements are met, the court must then determine if the third party’s use of the mark is likely to cause confusion.²³ Some courts may conclude that social network site pages are akin to artistic or literary works and refuse to find infringement unless this use of the mark explicitly misleads as to the source or the content of the expression.²⁴

If the accused infringer is using the mark to impersonate the markholder and cause confusion about the source of expression on the social network site, some courts may find infringement even where the third party is not advertising or selling goods or services.²⁵ The risk of “impersonation is extremely high” on those sites where “the username becomes the identity of the poster.”²⁶ Impersonation of markholders is not unique to social network sites—it also takes place on informational websites and in the brick-and-mortar world.²⁷ Yet due to the “real name” culture of certain social network sites like Facebook and Twitter, users may be more likely to believe false statements of identity and authorship, and rely to their detriment on the imposter’s expression.²⁸ The markholder’s reputation may be harmed by the third party’s disclosure of untruthful information, or posts that are offensive or inappropriate. As noted by one commentator with regard to Janet’s tweets from the ExxonMobilCorp account: “when someone raised the Exxon Valdez issue, Janet noted that, while tragic, the Valdez spill didn’t rank among the top 10 such incidents. Clearly, Janet has had no communication

21. See *infra* Part II.A.1-2.

22. See *infra* Part II.A.3-4.

23. See *infra* Part II.A.5.a.

24. See *infra* Part II.A.5.b.

25. See *infra* Part II.A.5.c.

26. Posting of Elisa Cooper to MarkMonitor Blog, *Protecting Online Identities in the World of Web 2.0*, <http://www.markmonitor.com/mmblog/?p=58> (Feb. 12, 2009, 12:19).

27. See *infra* Part II.A.5.c.

28. See *infra* Part I.

training, since that response would provoke anger and hostility.”²⁹

To address the concerns of individuals and entities who are the subject of fake accounts, some social network sites prohibit impersonation of others and the unlawful use of trademarks on these sites.³⁰ Sites that implement notice-and-takedown procedures may consider banning all unauthorized uses of trademarks to avoid potential contributory liability under trademark law.³¹ (An analysis of whether the sites are liable in these circumstances is beyond the scope of this Article; this Article assumes that social network sites may be liable for contributory trademark infringement if they do not remove infringing uses of marks after notice of specific instances of infringement.) If these sites require authorization for every use of another’s mark, however, this approach could seriously harm the free flow of information and ideas on social network sites. A third party may have a legitimate reason for using another’s trademark on the site. That trademarked term may be the person’s first or last name, or the third party may have concurrent trademark rights, a fair use defense, or a free speech interest in using the term

29. Holtz, *supra* note 10.

30. *See infra* Part I.

31. Per the Supreme Court in *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844 (1982), “if a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorily responsible for any harm done as a result of the deceit.” *Id.* at 854. Lower courts have applied the *Inwood* test to Internet service providers if they exercise sufficient control over the infringing conduct. *See Lockheed Martin Corp. v. Network Solutions, Inc.*, 194 F.3d 980, 984 (9th Cir. 1999) (holding that the *Inwood* test for contributory trademark infringement applies to Internet service providers that exercise “[d]irect control and monitoring of the instrumentality used by a third party to infringe the plaintiff’s mark”); *Louis Vuitton Malletier, S.A. v. Akanoc Solutions, Inc.*, 591 F. Supp. 2d 1098, 1111-12 (N.D. Cal. 2008) (denying Akanoc’s motion for summary judgment on the contributory trademark infringement claim where Akanoc hosted websites that sold counterfeit products and routed Internet traffic to and from those websites); *see also Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 104-10 (2d Cir. 2010) (assuming that the *Inwood* test applies without deciding the issue and finding no contributory trademark infringement in a dispute involving the sale of counterfeit products by third parties on the online auction site eBay); 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION §§ 25:17-25 (4th ed. 2009) (discussing contributory infringement law).

in parody, satire, criticism, comparative advertising, news reporting, or other commentary.³² Not all unauthorized uses of marks are illegal, and Congress and the courts have limited trademark rights in certain ways to protect free speech interests.³³

Some accused infringers may argue they have a free speech right to use another's mark to impersonate the markholder on a social network site and communicate information or ideas purporting to come from the markholder. It is unlikely that courts will construe the scope of the right to freedom of expression to be this broad today. The First Amendment protects anonymous and pseudonymous expression, but does not protect knowingly false statements of fact.³⁴ If reasonable members of the public believe the false statements of identity and authorship of expression on a social network site, the First Amendment may not provide a defense for third parties who use trademarks to falsely state that the markholder is the author of the imposter's expression.

In Part III, this Article argues that courts and social network sites should consider both trademark and free speech interests in disputes involving the unauthorized use of marks on these sites. More markholders today are disseminating information, entertainment, and advertising to consumers via social network sites, and they often use their mark in the username, account name, and content of

32. See *infra* Part II.A.6 & II.B. For an analysis of how current U.S. federal trademark law may violate the First Amendment and a discussion of the types of unauthorized uses of marks that are protected by the First Amendment, see Lisa P. Ramsey, *Increasing First Amendment Scrutiny of Trademark Law*, 61 SMU L. REV. 381, 404-47 (2008) [hereinafter Ramsey, *Increasing Scrutiny*]. For a discussion of whether international trademark law permits the United States to revise its domestic trademark law to make it more speech-protective, see generally Lisa P. Ramsey, *Free Speech and International Obligations to Protect Trademarks*, 35 YALE J. INT'L L. 405 (2010).

33. See generally Lisa P. Ramsey, *First Amendment Limitations on Trademark Rights*, in 3 INTELLECTUAL PROPERTY AND INFORMATION WEALTH: ISSUES AND PRACTICES IN THE DIGITAL AGE 147 (Peter K. Yu ed., 2007) [hereinafter Ramsey, *First Amendment Limitations*] (explaining how Congress and the courts have protected free speech interests in trademark law, such as by requiring marks to be distinctive for trademark protection, limiting the scope of trademark rights, and allowing certain defenses to trademark claims).

34. See *infra* Part II.B.

the site to indicate authorship of that expression.³⁵ If third parties are allowed to use another's mark in the same way to impersonate the markholder, this may confuse social network site users about the source of the imposter's expression and increase consumer search costs by making it more difficult for people to use trademarks to quickly identify the author of the expression. Yet the free flow of information and ideas could also be harmed if courts and social network sites prohibit expressive uses of trademarks where the third party is not advertising or selling goods or services, the expression is noncommercial, and/or the third party is not using the mark to designate the source of goods, services, or expression on the site.

To balance trademark and free speech interests, this Article proposes that infringement law should apply to the unauthorized use of a mark on a social network site that is likely to cause confusion about the source of expression unrelated to the advertising or sale of goods or services, but only where (1) the mark is used to impersonate the markholder and falsely suggest the markholder is the author of the third party's expression, (2) reasonable people believe the imposter's false statements of identity and authorship, and (3) the content of the social network site page does not dispel the confusion regarding the source of the expression. If the third party is not advertising or selling any goods or services on the social network site *and* consumers are only confused about whether the markholder authorized this use of its mark or is affiliated with or sponsors the third party's expression, this expressive use of the mark should be outside of the scope of the trademark infringement laws.

The focus of the infringement analysis should not be on whether the markholder consented to this use of its mark or whether the third party is free riding on the goodwill in the mark, but rather on whether the third party is using the mark to falsely indicate that the markholder is the source or author of the imposter's expression. Unless the third party is using the mark in a confusing way to impersonate the

35. Cf. Laura A. Heymann, *The Birth of the Authonym: Authorship, Pseudonymity, and Trademark Law*, 80 NOTRE DAME L. REV. 1377, 1379, 1398, 1406-09 (2005) [hereinafter Heymann, *Birth of the Authonym*] (noting marks are used in screen names or usernames in online communications as statements of corporate authorship).

markholder, trademark law will stifle much valuable expression if infringement is found in cases where the third party is simply using the mark in parody, satire, criticism, comparative advertising, news reporting, or other commentary. Courts and social network sites should narrowly construe the scope of trademark infringement law in such circumstances. Unauthorized use of a trademark is not equivalent to brandjacking.

I. SOCIAL NETWORK SITES AND THE BRANDS THAT USE THEM

Social network sites are “web-based services that allow individuals to (1) construct a public or semi-public profile within a bounded system, (2) articulate a list of other users with whom they share a connection, and (3) view and traverse their list of connections and those made by others within the system.”³⁶ Users of these sites can add information about themselves, photographs, and other content to personalize their pages or profiles (hereinafter “pages” or “page”). Each unique page of a social network site can usually be accessed through a Uniform Resource Locator (URL) that includes the domain name for that site followed by the file name for the specific page on that site (e.g., facebook.com/southwest).³⁷ Some social network sites

36. Danah M. Boyd & Nicole B. Ellison, *Social Network Sites: Definition, History, and Scholarship*, J. COMPUTER-MEDIATED COMM., 210, 211 (2008). Early social network sites include Classmates.com (founded in 1995), Six Degrees of Separation (1997), and LiveJournal (1999). Next came Friendster (2002), LinkedIn (2003), MySpace (2003), Orkut (2004), Facebook (for Harvard students only, 2004), Yahoo! 360 (2005), YouTube (2005), Facebook (for high school networks, 2005), Facebook (for corporate networks, early 2006), Twitter (2006), and Facebook (for everyone, late 2006). *Id.* at 212-13. For more information about social network sites, see generally *id.*; James Grimmelman, *Saving Facebook*, 94 IOWA L. REV. 1137 (2009) (discussing how Facebook users socialize and misunderstand the privacy risks associated with their disclosure of information on Facebook); William McGeeveran, *Disclosure, Endorsement, and Identity in Social Marketing*, 2009 U. ILL. L. REV. 1105 (2009) (providing an analysis of the potential concerns with “social marketing” on social network sites and various legal responses to these problems); Lori E. Lesser, *Social Networks and Blogs* (PLI Patents, Copyrights, Trademarks, & Literary Prop., Course Handbook Series No. 962, 2009), available at WL, 962 PLI/Pat 23.

37. *E.g.*, Facebook, Usernames: General Information, <http://www.facebook.com/help.php?page=897> (last visited June 10, 2010). This file name may contain numbers identifying the file (the method used by Facebook prior to June 2009), or it may contain words or other content

require users to input a username, account name, profile name, or other alias that is publicly displayed to other users in the content of the site and identifies the author of content posted by that user.³⁸

What makes social network sites unique is that “they enable users to articulate and make visible their social networks” and identify “friends,” “contacts,” or “others in the system with whom they have a relationship.”³⁹ In addition to allowing users to indicate bi-directional ties with friends, family, and co-workers, many social network sites allow users to create one-directional ties with celebrities, music bands, businesses, organizations, and other entities.⁴⁰ Examples include signing up as a “follower” of professional basketball player Shaquille O’Neal on Twitter, a “friend” of the rock group U2 on MySpace, or a “fan” of Coca-Cola on Facebook.⁴¹ Users can also create and join groups based on common interests or events. For example, many schools have increased attendance at reunions by setting up group pages on Facebook.⁴²

As more people are spending time checking their Facebook account or reading tweets from other Twitter users, it is not surprising that many brands are migrating to social network sites. Brands use these sites as a tool to “keep in touch with and engage their customers.”⁴³ More

consisting of alphanumeric characters (A-Z, 0-9) or symbols, such as the name of a person or company (the method used by Facebook starting in June 2009). *Id.* The latter type of file name is often called a “username” or “vanity URL.” Posting of Blaise DiPersia to The Facebook Blog, *Coming Soon: Facebook Usernames*, <http://blog.facebook.com/blog.php?post=90316352130> (June 9, 2009, 15:11); Posting of Caroline McCarthy to The Social, *Facebook Vanity URLs Coming This Week*, http://news.cnet.com/8301-13577_3-10261009-36.html?tag=mncol (June 9, 2009, 14:20 PDT).

38. *E.g.*, Twitter: Create an Account, <https://twitter.com/signup> (last visited June 15, 2010) (“Your full name will appear on your public profile”).

39. Boyd & Ellison, *supra* note 36, at 211, 213.

40. *Id.* at 213.

41. THE_REAL_SHAQ on Twitter, http://twitter.com/THE_REAL_SHAQ (last visited June 10, 2010); U2 on MySpace, <http://www.myspace.com/u2> (last visited June 10, 2010); Coca-Cola on Facebook, *supra* note 7.

42. See Gilbert Cruz, *How Facebook Is Affecting School Reunions*, TIME, June 15, 2009, <http://www.time.com/time/nation/article/0,8599,1904565,00.html>.

43. Posting of Eric Goldman to Technology & Marketing Law Blog, *Twitter, Email and Brand Engagement*, <http://blog.ericgoldman.org/archives/2009/06/>

brands are interacting with the public in new and creative ways that may strengthen the brand image and ultimately increase sales of their goods and services.

Some brands use their social network site accounts to answer questions, respond to complaints, or provide information about products, prices, and discounts. For example, in the summer of 2009, Dell claimed it “surpassed \$2 million in revenue” by posting offers and responding to questions on its DellOutlet account on Twitter, and noted the account drove “interest in new product as well.”⁴⁴ Dell also posts coupons on its Twitter account, which are “retweeted and picked up by coupon sites—both of which spread the brand name.”⁴⁵ Some mom-and-pop stores and restaurants find social media to be “accessible, free and very simple,” and tweet about discounts or “lure customers with mouth-watering descriptions of food.”⁴⁶ Coca-Cola’s Twitter account not only has random facts about the company and its products, but in early September 2009 it had tweets about sporting events, recycling, and the Heroes for Hope tour sponsored by the breast cancer survivor organization Susan G. Komen for the Cure.⁴⁷

(June 17, 2009, 7:03). Recent books that discuss how brands can use social network sites or “social media” include JOEL COMM, *TWITTER POWER: HOW TO DOMINATE YOUR MARKET ONE TWEET AT A TIME* (2009); ERIK QUALMAN, *SOCIALNOMICS: HOW SOCIAL MEDIA TRANSFORMS THE WAY WE LIVE AND DO BUSINESS* (2009).

44. Posting of Stefanie N. to Direct2Dell, *@DellOutlet Surpasses \$2 Million on Twitter*, <http://en.community.dell.com/dell-blogs/b/direct2dell/archive/2009/06/11/delloutlet-surpasses-2-million-on-twitter.aspx> (June 11, 2009, 23:01).

45. Twitter, *Twitter 101—Case Study: Dell*, http://business.twitter.com/twitter101/case_dell (last visited June 10, 2010).

46. Claire Cain Miller, *Mom-and-Pop Operators Turn to Social Media*, N.Y. TIMES, July 23, 2009, at B6.

47. Postings of CoTweet to Coca-Cola on Twitter, <http://twitter.com/cocacola> (Sept. 10, 2009, 6:30; Sept. 10, 2009, 9:30; & Sept. 12, 2009, 7:04) [hereinafter *Coca-Cola on Twitter*]. The nature of such posts may make it difficult for courts to determine whether this expression should be treated as advertising or information. Cf. Lisa P. Ramsey, *Intellectual Property Rights in Advertising*, 12 MICH. TELECOMM. & TECH. L. REV. 189, 237-45 (2006) (discussing how recent developments in the advertising industry, such as product placement, “advertainment,” “experiential marketing,” and viral advertising, make it more difficult for courts to distinguish between advertising and entertainment).

In addition to providing a new forum for brands to promote their goods or services in non-traditional ways, social network sites also permit markholders to learn more about their customers. Many sites allow users to control who sees what information about them. Users often share their personal information and other content on their social network site page with those people or entities with whom they have a connection, including brands.

Unfortunately, users sometimes accidentally become a friend, fan, or follower of an imposter who has created a fake social network site page.⁴⁸ The individual behind the fake account may use a person's or entity's name or trademarks in the username, account name, or in other identifying information on the site.⁴⁹ Social network sites vary in terms of the extent to which pages or profiles are deemed to be authentic.⁵⁰ For example, users of LiveJournal often do not identify themselves using their real names,⁵¹ while Facebook encourages members to use their "true name" and trust the accuracy of user profiles in this online

48. Users may also knowingly choose to link to a fake account because they find the posts to be entertaining. For example, after it was disclosed that one popular Twitter feed from *30 Rock* star Tina Fey was fake, the number of followers jumped from 50,000 to 200,000. Mike Musgrove, *Is It Twitter or Is It Baloney?*, GRAND RAPIDS PRESS, Apr. 5, 2009, at A14.

49. Social network site users have impersonated movie stars, politicians, food critics, and athletes, among other individuals. See Kevin Courtney, *Con Text: Fakebooking*, IR. TIMES, Feb. 24, 2009, at 18; Gregory B. Hladky, *Republicans Overtweet*, HARTFORD ADVOC., Oct. 22, 2009, at 8, available at <http://www.hartfordadvocate.com/featured-news/republicans-overtweet-2.html>; Kim Severson, *Fight Escalates over Twitter Parody of N.Y. Food Critic*, INT'L HERALD TRIB., Apr. 24, 2009, at 18; Ralph Vacchiano & Michael O'Keeffe, *Athletes Are All Aflutter over Social Site, but Don't Believe All You Read*, DAILY NEWS, June 7, 2009, at 70; Richard Wilson, *Rising Profile of Facebook Fakers*, SUNDAY TIMES (U.K.), Aug. 24, 2008, at 7, available at 2008 WLNR 16353666.

50. See generally Danah Boyd, *None of This Is Real: Identity and Participation in Friendster*, in STRUCTURES OF PARTICIPATION IN DIGITAL CULTURE 132 (Joe Karaganis ed., 2008) (discussing the use of fake identities or invented profiles by "Fakesters" on the social network site Friendster).

51. Posting of Rebecca Tushnet to Rebecca Tushnet's 43(B)log, *IPSC: Trademark and the Consumer*, <http://tushnet.blogspot.com/2009/08/ipsc-trademark-and-consumer.html> (Aug. 6, 2009, 13:13) (comment by Rebecca Tushnet on a presentation by Lisa Ramsey).

environment.⁵² At the time of this writing, Twitter was experimenting with a “Verified Account” feature “[t]o prevent identity confusion”; once Twitter determines an account is authentic, that Twitter account will display a “Verified Account” badge “in the top-right portion of a user’s profile page just above the name, location, and bio.”⁵³

The public is more likely to be confused into thinking a fake social network site account is authentic if it appears on a “true name” site like Facebook or indicates it is “verified” on Twitter. Confusion is also likely if there are explicit statements that the account is “official” or “real,” or that posts are written by the markholder’s representatives. Other content that may suggest a fake account is official includes posts that seem authentic or that are actually copied from other official social network site accounts or blogs,⁵⁴ links to the official company website, an email address that contains the mark, the display of photographs of the company’s products or offices (often copied from the Internet),⁵⁵ or the display of the markholder’s logos or stylized marks. Of course, a social network site page may include some of this content but not actually confuse anyone because other content indicates the page is fake.

There are various ways a social network site user can communicate that a fake account is *not* official and

52. Facebook, Usernames: Intellectual Property Rights Holders, <http://www.facebook.com/help/?page=899> (follow “What are the guidelines around creating a username?” hyperlink) (last visited June 10, 2010) (“Your username should be as close as possible to your true name”); *see also* Justin Smith, *Exclusive: Discussing the Future of Facebook with CEO Mark Zuckerberg*, INSIDE FACEBOOK, June 3, 2009, <http://www.insidefacebook.com/2009/06/03/exclusive-discussing-the-future-of-facebook-with-ceo-mark-zuckerberg/> (“Facebook has always focused on establishing real identity and user profiles, and that identity continues to be foundational for all the company’s products and monetization plans today.”).

53. Twitter, Verified Account, <http://twitter.com/help/verified/> (last visited June 10, 2010).

54. *E.g.*, *False Twitter Account*, *supra* note 14 (“Most [posts] re-wrote or twisted tweets from our personal pages or portions of blogs from TannerFriedman.com so that their meanings were lost or compromised.”).

55. *E.g.*, Nine West Complaint, *supra* note 12, at 7-9, ¶¶ 18-19 (alleging the Nine West Shoes account holder linked to the official company site, used a Gmail account that contained the Nine West mark (ninewest.audition@gmail.com), and copied official photos posted on the Nine West website).

discourage any notion that it is authored by the markholder even though the username, account name, or other content incorporates another's mark. Identity confusion may be eliminated by inclusion of the words "fake," "parody," "satire," or similar words in a prominent place within the content of the page. The user can also provide accurate information about the registrant's exact relationship (or lack thereof) with the markholder in a disclaimer. In addition, confusion can be dispelled or reduced by inserting certain words before or after the mark in the username, account name, or other identifying information on the site to describe the content of the page (e.g., fake[mark], [mark]sucks, not[mark], [mark]news, or [mark]info) or to indicate the author of information on the site (e.g., [mark]employee, [mark]fan, [mark]customer, [mark]repair, [mark]reseller, or [mark]victim). If the content of the page is outrageous or inconsistent with past information provided by the markholder, this may also raise a "red flag" to readers that the social network site page is not official.⁵⁶

Impersonation of brands on social network sites may cause a variety of harms if users believe and rely on the imposter's false statement of identity. If users disclose personal information to the imposter, identity theft, phishing, or an increase in spam emails may occur.⁵⁷ Even if the user suffers no financial harm, he or she may feel violated—think of the women who sent photos and contact information to the fake Nine West Shoes account holder on Facebook. If goods or services promoted on the page are falsely represented to come from the markholder, customers may mistakenly purchase another company's products, which may be of lower quality. If the imposter posts false or misleading information about the company or its products, this can harm the markholder and the public if stock prices drop, or if individuals or entities forgo future purchases, employment, partnerships, or other interaction with the company due to the untruthful information. While it may be difficult to prove causation for some types of harms, it is not

56. See Holtz, *supra* note 10 (noting the ExxonMobilCorp account "should have raised some red flags immediately" because of graphic images on the account that were inconsistent with statements made by Exxon and responses to questions that would provoke anger and hostility).

57. See Tom N. Jagatic et al., *Social Phishing*, 50 COMM. ACM 94, 94-100 (2007).

unreasonable to assume that certain unauthorized uses of a mark to impersonate a brand on social network sites can cause significant harm.

To prevent username squatting and the creation of fake pages, some brands are preemptively registering usernames incorporating their marks on Facebook, Twitter, and other social network sites.⁵⁸ Registration is often free and quick, but the time, money, and energy it takes to register the company's trademarks (and variations of them) as usernames on several sites is not insignificant. Adding content and posting regularly to the account will consume even more company resources, but some users may complain if brands do not use their account after registering the username. Markholders who are diligent about registering their marks as domain names with all the current top level domains will likely find it impossible to keep track of the increasing number of social network sites and register usernames with each one. Even if markholders register usernames on all the top sites today, this will not prevent future username squatting or fake pages on new sites. Regardless, commentators still urge markholders to acquire the usernames or account names "that are most likely to be construed as official accounts" on popular social network sites, as past incidents of brandjacking "should make it painfully clear just how easy it is for somebody to step in and represent your organization with inaccurate and even damaging information using these very channels."⁵⁹

Of course, not all registrants of usernames or account names containing another's marks are actually impersonating markholders on social network sites. An individual may register his or her personal name as a username, but that name may be identical or similar to a trademark owned by someone else. In addition, companies or organizations may have concurrent trademark rights to

58. Markholders may also consider contractually requiring employees and others with whom they have a relationship to refrain from using the marks in certain ways without authorization on social network sites. Such a rule would give the brand more control over its marks, but this approach could harm the free flow of information and ideas.

59. Holtz, *supra* note 10.

the term in different geographic areas or product categories, such as Apple Computers and Apple Records.⁶⁰

Moreover, some social network site users may be engaging in expression protected by the First Amendment when they use another's mark without authorization to convey information or ideas. Fans of a brand may set up an unauthorized page for that brand because one does not currently exist, and they want to link to the brand and thereby communicate that they like the product. An example is the Coca-Cola Facebook fan page created by Dusty Sorg and Michael Jedrzejewski.⁶¹ An individual with personal knowledge about a company or organization may set up a social network site account that provides information about the markholder that is relevant to employees, stockholders, potential investors, competitors, customers, or the general public. This person's commentary may be critical or laudatory. Representatives of a company may use another's trademarked term (*e.g.*, Amazon) in good faith to describe the qualities or characteristics of that company's own goods or services, such as Amazon River Cruises.⁶² Third parties may also use another's marks on a social network site to engage in parody or satire, or as a prank. In some cases, pretending to be the markholder may be part of the joke. This is not really *impersonation*, however, unless a reasonable person would actually think the markholder maintains the site and that the posts are written by the markholder's representatives.

Popular social network sites such as Facebook, MySpace, and Twitter prohibit impersonation of others and the posting of content that violates the law, including trademark laws.⁶³ Some sites also permit markholders to

60. See Apple, <http://www.apple.com> (last visited June 10, 2010); The Complete Apple Records, <http://www.schomakers.com> (last visited June 10, 2010).

61. See *supra* note 7.

62. While "Amazon" is a well-known mark for a popular online store, Amazon.com, <http://www.amazon.com> (last visited June 10, 2010), Amazon is also the name of a river in South America, and some companies use this word to describe their cruise services on the Amazon River. See, *e.g.*, Amazon River Cruises, <http://www.amazonrivercruises.com> (last visited June 10, 2010).

63. See, *e.g.*, Facebook, Statement of Rights and Responsibilities, §§ 4.1, 5 (Apr. 22, 2010), <http://www.facebook.com/terms.php> (last visited June 14, 2010); MySpace.com, Terms of Use Agreement, §§ 8.16, 8.26 (June 25, 2009), <http://www.myspace.com/index.cfm?fuseaction=misc.terms> (last visited June 14,

file a complaint when third parties use their trademarks without authorization in usernames or other content on the site.⁶⁴ If the social network site deems the complaint to be valid, it will likely remove (or ask the user to remove) the infringing content, and may suspend or even terminate the user's account. Such private notice-and-takedown procedures for resolving trademark disputes are usually quicker and less expensive than trademark litigation,⁶⁵ and may help social network sites avoid allegations of contributory infringement.⁶⁶

One important question, however, is whether social network sites will properly balance trademark and free speech interests when they privately resolve these disputes. To avoid lawsuits or liability under trademark law, some social network sites may err on the side of deleting all allegedly infringing content that incorporates another's marks. This approach could stifle the free flow of

2010); Twitter, Terms of Service (Sept. 18, 2009), <https://twitter.com/tos> (last visited June 10, 2010); Twitter, Twitter Support: Impersonation Policy (Jan. 14, 2009), <http://twitter.zendesk.com/forums/26257/entries/18366> (last visited June 14, 2010); Twitter, Twitter Support: The Twitter Rules (Jan. 14, 2009), <http://help.twitter.com/forums/26257/entries/18311> (last visited June 10, 2010).

64. See, e.g., Facebook, Facebook Copyright Policy: How to Report Claims of Intellectual Property Infringement, http://www.facebook.com/legal/copyright.php?howto_report (last visited June 14, 2010) (providing links to automated forms to report copyright infringement and other claims of intellectual property infringement by a Facebook user); Twitter, Twitter Support: Trademark Policy (Jan. 14, 2009), <http://twitter.zendesk.com/forums/26257/entries/18367> (last visited June 10, 2010) (providing guidelines for filing a complaint when third parties misuse trademarks).

65. Some commentators propose the creation of a private "Uniform Username Dispute Resolution Policy" for resolving trademark disputes involving usernames, similar to the Uniform Domain Name Dispute Resolution Policy adopted by registrars accredited by the Internet Corporation for Assigned Names and Numbers. See, e.g., Posting to ErikJHeels.com, *How to Twittersquat the Top 100 Brands*, <http://erikjheels.com/?p=1298> (Jan. 8, 2009) (recommending that social network sites work together to create a Uniform Username Dispute Resolution Policy); see also Internet Corporation for Assigned Names and Numbers, Domain Name Dispute Resolution Policies, <http://www.icann.org/en/udrp/> (last visited June 14, 2010) (providing information about the Uniform Domain Name Dispute Resolution Policy and other policies that apply to domain name disputes). Evaluation of such a proposal is beyond the scope of this Article.

66. See *supra* note 31.

information and ideas.⁶⁷ Some sites may claim they allow marks to be used without authorization in fan accounts, parody, and other commentary,⁶⁸ but their decision-making process for allowing or banning certain content may not be transparent or predictable.

Another problem is that it is unclear whether and how trademark law applies to certain unauthorized uses of marks on social network sites. Markholders have recently filed lawsuits against social network sites and their users,⁶⁹ but, as of this writing, there is no specific statutory provision or binding common law that directly addresses whether accused infringers are liable in this context.⁷⁰ This

67. Although there is likely no “state action,” and thus no First Amendment violation, if a private social network site provider prohibits the use of another’s trademarks on its site, free speech interests will still be harmed by this decision. If a markholder files a trademark lawsuit and asks a court to enjoin or punish the third party’s use of its mark, however, this would constitute “state action” and implicate the First Amendment under constitutional law. *See Ramsey, Increasing Scrutiny*, *supra* note 32, at 407-09.

68. For example, “Twitter users are allowed to create parody, commentary, or fan accounts . . . [But a]ccounts with the clear intent to confuse or mislead may be permanently suspended.” Twitter, Twitter Support: Impersonation Policy (Jan. 14, 2009), <http://twitter.zendesk.com/forums/26257/entries/18366> (last visited June 14, 2010); *see also* Twitter, Twitter Support: Parody, Commentary, and Fan Accounts Policy (Feb. 1, 2009), <http://help.twitter.com/forums/26810/entries/106373> (last visited June 14, 2010).

69. *See, e.g.*, *New York City Triathlon, LLC v. NYC Triathlon Club, Inc.*, __ F. Supp. 2d __, 2010 WL 808885 (S.D.N.Y. Mar. 9, 2010) (granting a preliminary injunction to the owner of the marks “The New York City Triathlon,” “The NYC Triathlon” and “The NYC Tri” after finding infringement by the seller of triathlon equipment that registered and used the username “nyctriclub” and ordering the defendant to refrain from using the marks on Facebook, Twitter, LinkedIn, and other websites); *Complaint, Oneok, Inc. v. Twitter, Inc.*, No. 09-CV-00597 (N.D. Okla. Sept. 15, 2009), *available at* 2009 WL 3146140; *Tanner Friedman Complaint*, *supra* note 14; *Nine West Complaint*, *supra* note 12; *Complaint, LaRussa v. Twitter, Inc.*, No. CGC-09-488101 (Cal. Super. May 6, 2009), *available at* 2009 WL 1569936.

70. Past court decisions and commentary regarding the unauthorized use of marks in domain names, blog names, and parts of a URL other than the second-level domain may provide some guidance to courts and social network sites in resolving these disputes. *See, e.g.*, *Interactive Prod. Corp. v. a2z Mobile Office Solutions, Inc.*, 326 F.3d 687, 696-98 (6th Cir. 2003) (holding that unauthorized use of the Lap Traveler mark for portable computer stands in the URL a2zsolutions.com/desks/floor/laptraveler/dkflt-lt.htm is not likely to confuse consumers because the post-domain path of a URL does not typically indicate source); *Patmont Motor Werks, Inc. v. Gateway Marine, Inc.*, No. C 96-2703

will make it more difficult for social network sites to develop trademark policies that are fair to both markholders and users, and also protect themselves from claims of contributory trademark liability.

As discussed in the next Part, some courts will likely conclude there is no trademark infringement if the mark is not used in connection with the advertising or sale of goods or services. Other courts may find an infringement violation if the third party uses another's mark to impersonate a markholder and cause confusion about the source of expression on the site. Courts and social network sites should try to balance trademark and free speech interests in these disputes, and consider whether a decision to restrict a certain unauthorized use of another's mark may harm the public's interest in freedom of expression.

Although social network site usernames may seem akin to Internet domain names, the bad faith registration and use of another's mark in a username does not appear to violate federal law prohibiting cybersquatting of domain names. The Anticybersquatting Consumer Protection Act (ACPA) only applies to the registration, trafficking in, or use of a "domain name that . . . is identical or confusingly similar to [another's] mark" with a bad faith intent to

TEH, 1997 WL 811770, at *4 n.6 (N.D. Cal. Dec. 18, 1997) ("Nothing in the post-domain path of a URL indicates a website's source of origin, and Patmont has cited no case in which the use of a trademark within a URL's path formed the basis of a trademark violation."); Margreth Barrett, *Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries*, 39 CONN. L. REV. 973 (2007) [hereinafter Barrett, *Domain Names*] (discussing trademark disputes involving domain names and arguing that many court decisions do not adequately protect free speech interests); Jacqueline D. Lipton, *Commerce Versus Commentary: Gripe Sites, Parody, and the First Amendment in Cyberspace*, 84 WASH. U. L. REV. 1327 (2006) (same); Posting of Eric Goldman to CircleID, *Google Sued for Trademark Infringement Based on Third-Level Subdomain*, http://www.circleid.com/posts/google_sued_for_trademark_infringement_on_third_level_subdomain/ (Dec. 30, 2005, 10:19 PDT) (noting use of another's mark in a blog name can give rise to trademark infringement, but noting there may be a difference in the trademark analysis when the mark is used in a third-level subdomain rather than a second-level domain name); Posting of Marty Schwimmer to The Trademark Blog, *Can Similar Blogs Names Co-exist? Should Blogs Obtain Trademark Protection?*, http://www.schwimmerlegal.com/archives/2005/07/can_similar_blo.html (July 11, 2005, 18:44) (concluding that blog titles can be protected as trademarks); see also Anupam Chander, *The New, New Property*, 81 TEX. L. REV. 715 (2003) (discussing various methods for allocating property rights in domain names).

profit.⁷¹ The federal trademark statute defines a “domain name” as “any alphanumeric designation which is registered with or assigned by any domain name registrar, domain name registry, or other domain name registration authority as part of an electronic address on the Internet.”⁷² This definition does not cover usernames on social network sites, as they are not registered with or assigned by a domain name registrar or registry.⁷³ Of course, courts may apply trademark infringement law to username squatting by third parties, just like they did in cases of domain name squatting before the enactment of the ACPA.⁷⁴

Impersonation of markholders on the Internet is not a new phenomenon. Third parties have been registering the trademarks of others as Internet domain names with corresponding fake websites for years.⁷⁵ Yet usernames and account names on Facebook, Twitter, and similar social network sites often communicate more information about identity than domain names. There is a higher risk of impersonation on sites where the username or account name becomes the identity of the poster. Unless a particular site encourages the use of pseudonyms or fake identities, use of another’s mark in a username or account name is generally more likely to cause confusion about the source of expression linked to that name. This is especially true if the social network site has a true name culture like Facebook or verifies the accounts of its users like Twitter. If reasonable persons believe a fake account on a social network site is real—if they believe the author of the expression is an official spokesperson for the markholder due to the content of the social network site page—this confusing use of another’s mark may violate trademark infringement law.

71. 15 U.S.C. § 1125(d) (2006).

72. 15 U.S.C. § 1127 (2006).

73. *See id.*; H.R. REP. NO. 106-412, at 15 (1999); 145 CONG. REC. S14715 (daily ed. Nov. 17, 1999), *discussed in* 4 MCCARTHY, *supra* note 31, § 25:78 n.66.

74. 4 MCCARTHY, *supra* note 31, § 25:77 (citing cases).

75. *See, e.g.*, Planned Parenthood Fed’n of Am., Inc. v. Bucci, 42 U.S.P.Q.2d (BNA) 1430 (S.D.N.Y. Mar. 19, 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998) (finding infringement where a pro-life activist used the Planned Parenthood mark in the domain name *plannedparenthood.com* and the related website home page that said “Welcome to the PLANNED PARENTHOOD HOME PAGE!”).

II. IMPERSONATION OF MARKHOLDERS ON SOCIAL NETWORK SITES: UNLAWFUL BRANDJACKING OR PROTECTED SPEECH?

As noted previously, it is not entirely clear whether trademark infringement law covers certain unauthorized uses of a mark on a social network site. If the accused infringer is not advertising or selling goods or services, that third party may claim trademark law does not apply or that this expression is protected by the First Amendment. These arguments may not prevail under current trademark and free speech doctrine, however, if the mark is being used to impersonate the markholder and cause reasonable people to be confused about the source of the third party's expression on the site. In such circumstances, markholders may be able to satisfy the elements of a federal claim for trademark infringement, and refute the accused infringer's claims of fair use or a First Amendment defense. On the other hand, courts are more likely to find there is no infringement liability where the third party is using the mark in expression on a social network site to accurately describe that person's own goods or services, refer to the markholder (such as in comparative advertising or news reporting), or communicate parody, satire, criticism, or other commentary.

A. *Trademark Infringement on Social Network Sites*

Two provisions in the federal trademark statute—also known as the Lanham Act—provide a cause of action for infringement: 15 U.S.C. § 1114(1)(a), which applies only to marks registered on the federal principal register, and 15 U.S.C. § 1125(a)(1)(A), which applies to both registered and unregistered marks. To infringe another's registered mark, § 1114(1)(a) provides that the third party must engage in "use in commerce" of the mark "in connection with the sale, offering for sale, distribution, or advertising of any goods or services" in a context that "is likely to cause confusion, or to cause mistake, or to deceive."⁷⁶ A third party is liable for infringement under § 1125(a)(1)(A) if it "uses in commerce" another's mark "on or in connection with any goods or services" where that use is likely to cause confusion, mistake, or deception regarding the "affiliation, connection, or association" of that person with the markholder, or as to

76. 15 U.S.C. § 1114(1)(a) (2006).

the “origin, sponsorship, or approval” of that person’s “goods, services, or commercial activities.”⁷⁷

Thus, to establish a *prima facie* claim of trademark infringement under the Lanham Act, the markholder must establish that the third party used the markholder’s valid and protectable mark without authorization in commerce in connection with goods, services, or commercial activities where this use of the mark is likely to cause confusion.⁷⁸ Courts in some circuits may also require proof of commercial use and/or trademark use of the mark. An accused infringer will likely argue the markholder has not established one or more of these elements—(1) use in commerce; (2) use in connection with goods, services, or commercial activities; (3) commercial use; (4) trademark use; or (5) likelihood of confusion—and may also argue this is permissible fair use of the mark or is protected expression under the First Amendment.

1. *Use in Commerce*

Sections 1114(1)(a) and 1125(a)(1)(A) both require use of a mark “in commerce” for infringement liability. Courts and commentators note the term “commerce” in both infringement statutes is jurisdictional—Congress may only regulate commerce within its control, and thus a mark must be used in commerce for the federal trademark statute to apply.⁷⁹ Use of a mark in the username, account name, or content of a social network site page that is accessible to

77. 15 U.S.C. § 1125(a)(1)(A) (2006).

78. For examples of the elements of a claim for federal trademark infringement, see *McZeal v. Sprint Nextel Corp.*, 501 F.3d 1354, 1358 (Fed. Cir. 2007); *Lamparello v. Falwell*, 420 F.3d 309, 313 (4th Cir. 2005); and 4-5 MCCARTHY, *supra* note 31, §§ 23:11.50, 27:13. National trademark laws are generally territorial. Markholders must have trademark rights within a nation’s borders to sue under that nation’s trademark laws and the allegedly unlawful use of the mark should generally take place within that nation’s borders. This Article assumes that the markholder has valid and protectable rights under U.S. trademark law and that the mark is being used without authorization within the U.S. sufficiently to trigger the applicability of our national trademark laws.

79. See, e.g., *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005); *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997); 4 MCCARTHY, *supra* note 31, § 25:57; see also U.S. CONST. art. I, § 8, cl. 3, 8; 15 U.S.C. § 1127 (2006) (defining “commerce” as “all commerce which may lawfully be regulated by Congress”).

other users on the Internet will generally satisfy the Lanham Act's jurisdictional use "in commerce" requirement, as Congress's power to regulate commerce is quite broad.⁸⁰

Some courts and commentators contend that the "use[s] in commerce" language in §§ 1114(1)(a) and 1125(a)(1)(A), together with the definition of "use in commerce" in § 1127, contain an additional or different requirement for a prima facie infringement claim which limits infringement law to certain types of uses of a mark.⁸¹ Section 1127 defines the term "use in commerce" to mean "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."⁸² The provision further states that a mark is "deemed to be in use in commerce" when the mark is visibly placed on goods "sold or transported in commerce" (such as Nike shoes) or is "used or displayed in the sale or advertising of services and the services are rendered in commerce" (such as an advertisement for Southwest Airlines travel services).⁸³ Under this view, the markholder must establish as a threshold requirement one of these types of "use" of its mark by the accused infringer; "use" and "in commerce" are distinct elements of an infringement claim.⁸⁴

Other courts and commentators argue § 1127's narrow definition of "use in commerce" is solely for purposes of qualifying for registration in the first instance, and does not apply to the type of use of a mark required by third parties

80. *See, e.g.*, *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1054 (10th Cir. 2008); *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1239-40 (N.D. Ill. 1996).

81. *See, e.g.*, *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 414 F.3d 400, 406-08, 412 (2d Cir. 2005); *DaimlerChrysler AG v. Bloom*, 315 F.3d 932, 936, 939 (8th Cir. 2003); *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 757-61 (E.D. Mich. 2003); *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 727-28 (E.D. Va. 2003); *WHS Entm't Ventures v. United Paperworkers Int'l Union*, 997 F. Supp. 946, 949 (M.D. Tenn. 1998); Barrett, *Domain Names, supra* note 70, at 983-84; Margreth Barrett, *Internet Trademark Suits and the Demise of "Trademark Use,"* 39 U.C. DAVIS L. REV. 371, 382-86 (2006) [hereinafter Barrett, *Internet Trademark Suits*].

82. 15 U.S.C. § 1127 (2006).

83. *Id.*

84. *1-800 Contacts*, 414 F.3d at 407-12.

to trigger trademark liability.⁸⁵ Under this view, the relevant language in §§ 1114(1)(a) and 1125(a)(1)(A) is the jurisdictional word “commerce,” not “use in commerce.”⁸⁶ According to the Second Circuit, “[t]he history and text of the Lanham Act show that ‘use in commerce’ reflects Congress’s intent to legislate to the limits of its authority under the Commerce Clause, rather than to limit the Lanham Act to profit-seeking uses of a trademark.”⁸⁷ A full discussion and resolution of the debate over the meaning of the phrase “use in commerce” in §§ 1114(1)(a) and 1125(a)(1)(A) is beyond the scope of this Article.

In those circuits that apply the § 1127 definition of “use in commerce” to limit infringement claims, courts are likely to hold that certain types of third party uses of another’s mark on a social network site do not count as “use in commerce.” When marks are only used in usernames, account names, or the content posted on social network sites, there is no affixation of the mark to any goods that are sold or transported in commerce. There is also no “use in commerce” of the mark for services in trademark disputes involving the use of another’s mark in parody, satire, criticism, and other commentary if the third party is not using the mark in the sale or advertising of services rendered in commerce. On the other hand, if the accused infringer is using another’s mark on the social network site in advertising for its own services rendered in commerce, this could qualify as “use in commerce” under the definition in § 1127. An example would be a post on the social network site that is a comparative advertisement for travel services by a competitor of Southwest Airlines; the competitor may

85. See, e.g., *Playboy Enters. v. Netscape Commc’ns Corp.*, 354 F.3d 1020, 1024 n.11 (9th Cir. 2004); 4 MCCARTHY, *supra* note 31, §§ 23:11.50, 25:57; Graeme B. Dinwoodie & Mark D. Janis, *Confusion Over Use: Contextualism in Trademark Law*, 92 IOWA L. REV. 1597, 1609-12 (2007) [hereinafter Dinwoodie & Janis, *Confusion Over Use*]. For a recent discussion of the meaning of the “use[s] in commerce” language in §§ 1114(1)(a) and 1125(a)(1)(A), see the Second Circuit’s Appendix in *Rescuecom Corp. v. Google Inc.*, 562 F.3d 123, 131-41 (2d Cir. 2009).

86. See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 677 (9th Cir. 2005).

87. *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 92-93 (2d Cir. 1997); see also *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1434 (S.D.N.Y. Mar. 19, 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998).

claim in the post that it has less expensive airline tickets or better service than Southwest Airlines.

2. Use of the Mark in Connection with Goods, Services, or Commercial Activities

To be liable for infringement under the Lanham Act, an accused infringer must also use a registered mark “in connection with the sale, offering for sale, distribution, or advertising of any goods or services” per § 1114(1)(a), or use a registered or unregistered mark on or in connection with any “goods,” “services,” or “commercial activities” per § 1125(a)(1)(A).⁸⁸ Even if use of a mark on a social network site satisfies the “use in commerce” requirement, this use may not necessarily be deemed a use in connection with goods, services, or commercial activities; these are both independent requirements.⁸⁹

In some cases involving the unauthorized use of marks in usernames, account names, and/or the content of social network sites, it will be easy for the markholder to prove that the accused infringer used the mark in connection with goods, services, or commercial activities. For example, assume a competitor of Dell, rather than Dell, registers DellComputers as a username on Facebook or Twitter and indicates that the account name of the social network site registrant is Dell Computers. In its posts, the third party provides information about deals for its “Dell” computers with links to a website or street address of a store where the goods can be purchased, but it is really advertising and selling its own brand of computers, not Dell computers. This third party competitor is using another’s mark in connection with the sale, offering for sale, distribution, and advertising of goods in an attempt to divert consumers to its own product. This is classic trademark infringement—misleading use of a mark by a competitor in commercial speech that falsely represents the source of the goods to be Dell.

On the other hand, it may also be clear that the social network site user is *not* using the mark in connection with goods, services, or commercial activities. For example, courts will likely find that merely registering a

88. 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A) (2006).

89. See *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1054 (10th Cir. 2008).

trademarked word as a username on a social network site does not, in and of itself, constitute use of the mark in connection with goods, services, or commercial activities under the Lanham Act. The third party would need to add additional content to the social network site page linked to that username before it could be liable for infringement.⁹⁰

In some cases, the accused infringer may concede the second element is satisfied, but still argue this use of the mark in connection with goods, services, or commercial activities causes no likelihood of confusion. Examples include use of another's mark by those who distribute, resell, or repair the markholder's goods to refer to the markholder (a referential or "nominative" use of the mark), or use of another's trademarked descriptive term to describe the qualities or characteristics of the third party's goods or services (a "descriptive" use of the mark). Another example is nominative use of a competitor's mark in the content of comparative advertising for competing goods or services that are less expensive or of higher quality, or use in an advertisement for goods or services that comments on, criticizes, or pokes fun at the competitor.

The more difficult cases for this second element involve an accused infringer who is not advertising or selling any goods or services on a social network site, and who is not engaged in any commercial activities, but who is using the mark in connection with the distribution of information or other expression on the site. To satisfy the goods, services, or commercial activities requirement for a prima facie infringement claim in such circumstances, a markholder may argue that its mark is being used in connection with "services" on the social network site because the provision of information to others qualifies as an "information service."

News organizations use trademarks to identify and distinguish their information goods and services. They can also obtain federal trademark registrations for such marks. For example, The New York Times Company owns a

90. *Cf.* *Lamparello v. Falwell*, 420 F.3d 309, 318 (4th Cir. 2005) (holding that courts must look at the underlying content of the website linked to an allegedly infringing domain name); 4 MCCARTHY, *supra* note 31, § 25:76 ("In the author's view, neither merely reserving a domain name nor use of a domain name solely to indicate a site on the Internet, in and of itself, constitutes 'goods or services' in the Lanham Act sense. Rather, one must consider the content of the site identified by the domain name.").

registration for the trademark “The New York Times” for “Daily Newspapers” (goods) and a service mark for the same term for “computer on-line services, namely, providing a wide range of general interest news and information via a global computer network” (services).⁹¹ To readers of *The New York Times*, the mark indicates that the markholder is the one distributing the expression contained in the print newspaper or online news service located at the domain name nytimes.com.⁹² Moreover, political, religious, and charitable groups and other nonprofit organizations, such as Planned Parenthood Federation of America, use trademarks to identify and distinguish their goods and services. As noted by Professor McCarthy, “[t]he retention of a distinct identity here is just as important as it is to a commercial company.”⁹³ If third parties can be liable for infringement if they use “The New York Times” or the “Planned Parenthood” marks in connection with the distribution of their own information,⁹⁴ why not individuals who use another’s mark in connection with the distribution of information and other expression on Facebook, Twitter, and other social network sites?

Some courts have broadly interpreted the definition of “services” where the defendant was using another’s mark in connection with the dissemination of information.⁹⁵ For

91. U.S. Trademark Reg. No. 0,227,904 (filed Jan. 27, 1927) (issued May 17, 1927); U.S. Trademark Reg. No. 2,120,865 (filed Feb. 9, 1996) (issued Dec. 16, 1997).

92. See Heymann, *Birth of the Authonym*, *supra* note 35, at 1440-41; see also *id.* at 1379, 1398, 1406-09 (noting that corporate entities that create expression—sometimes through the works of several individuals—often use their trademarked name to identify the source of their expression).

93. 1 MCCARTHY, *supra* note 31, § 9:5.

94. See, e.g., *Planned Parenthood Fed’n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 498 N.E.2d 1044, 1048 n.8 (Mass. 1986) (“We also point out that it makes no difference whether either PPLM or PP, Inc. is a charitable corporation for purposes of maintaining a common law service mark infringement action [under state law].”).

95. E.g., *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89 (2d Cir. 1997); see also *Lamparello*, 420 F.3d at 314 (noting courts have been reluctant to define the terms “goods” and “services” narrowly to exclude information); 4 MCCARTHY, *supra* note 31, § 25:76; cf. *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 365-66 (4th Cir. 2001) (“To use PETA’s mark ‘in connection with’ goods or services, Doughney need not have actually sold or advertised goods or services on the www.peta.org website.

example, the Second Circuit found a political organization used the “United We Stand America” mark in connection with services when it engaged in political activities, including the provision of political information to the public.⁹⁶ The Southern District of New York recently held that the activities of a nonprofit organization that promotes the rights of restaurant workers “qualify as ‘services’ as defined by the Lanham Act” where that group tried to raise awareness of the work conditions of restaurant employees by circulating informational leaflets with the restaurant’s logo on the front.⁹⁷ When pro-life activist Richard Bucci operated a fake Planned Parenthood website at the domain name *plannedparenthood.com*, the Southern District of New York held Bucci “offers informational services for use in convincing people that certain activities, including the use of [Planned Parenthood’s] services, are morally wrong,” and thus Bucci used the organization’s mark “in connection with the distribution of those services over the Internet.”⁹⁸ Some courts may apply a similar analysis in trademark disputes involving the unauthorized use of marks on social network sites and conclude the mark is being used in connection with the distribution of information services in a context covered by the infringement provisions of the Lanham Act.

A fictional example may be helpful in clarifying how courts may find the use in connection with goods, services, or commercial activities requirement satisfied in these circumstances. Assume that our fictional registrant of *DellComputers* on Twitter or Facebook mentioned above is not trying to pass off its own computers as Dell computers, but is instead disseminating information under the *DellComputers* name. This person posts comments about the features of Dell computers, future Dell products in development, the activities of the company, and general news and information about computers and the computer industry, among other things. The posts contain no

Rather, Doughney need only have prevented users from obtaining or using PETA’s goods or services, or need only have connected the website to other’s goods or services.”).

96. *United We Stand*, 128 F.3d at 89-92.

97. *SMJ Group, Inc. v. 417 Lafayette Rest. LLC*, 439 F. Supp. 2d 281, 287 (S.D.N.Y. 2006).

98. *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1434 (S.D.N.Y. Mar. 19, 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998).

advertisements for computers or computer services, and there are no links to websites or directions to places where consumers can purchase goods or services related to computers. Each day when this individual writes about Dell, its products, and the computer industry, the posts may be read by stockbrokers, consumers, employees, competitors, and other members of the public. If there is nothing to indicate otherwise, some people might think this account is an official social network site page authored by Dell representatives. Members of the public followed the ExxonMobilCorp and TannerFriedman accounts on Twitter and joined the Nine West—Model Auditions group page on Facebook believing official representatives of the markholders had created the content on those sites.

If consumers are truly confused about the author of information disseminated on a social network site, the markholder will likely want to get control of the account or close it down. This is especially the case where the third party is disseminating false or misleading information in the content of the site. Using the fictional DellComputers account example, the imposter could provide erroneous advice about Dell computers that allows a virus to infect the user's computer. That person could also disseminate false statements of fact—such as a newly-discovered product defect, a delay in a product launch, or the illness of a key executive in the company—that could cause members of the public to forgo purchasing the markholder's goods, sell their stock, decline future employment or partnerships with the company, or make other decisions harmful to themselves or the markholder. In such circumstances, it is possible that courts will find the mark is being used by that person in connection with the provision of information services.

In response, accused infringers will likely argue that the District Court for the District of Columbia was correct when it held that “[p]urveying points of view is not a service” within the meaning of the Lanham Act.⁹⁹ There are

99. *Lucasfilm Ltd. v. High Frontier*, 622 F. Supp. 931, 934 (D.D.C. 1985) (holding that a public interest group's use of the phrase “star wars” in television messages to criticize the Reagan Administration's strategic defense initiative did not infringe a filmmaker's “Star Wars” mark). Moreover, the court said “[e]ven if promoting of ideas was considered to be conducting an educational ‘service,’ television messages that are only used to express those ideas do not sell or advertise them.” *Id.*; see also Eric Goldman, *Online Word of Mouth and its Implications for Trademark Law*, in *TRADEMARK LAW AND THEORY: A*

good reasons to define “services” narrowly to exclude the dissemination of expression where the accused infringer is not advertising or selling expression available for purchase (unlike The New York Times Company). Otherwise, markholders may attempt to use trademark infringement lawsuits to stop people from talking about them or to prevent the use of their marks in public discourse outside the context of trade.¹⁰⁰ If it is easy for markholders to satisfy the threshold requirement of use in connection with goods, services, or commercial activities, it will be more difficult for judges to get rid of frivolous, speech-harmful infringement lawsuits on a motion to dismiss or motion for summary judgment and avoid a fact-intensive, case-by-case analysis of likelihood of confusion. Litigation is expensive and time-consuming, and accused infringers may settle and remove the mark from the social network site rather than fight for their right to use another’s marks to convey information or ideas. Trademark infringement law will be quite expansive, and risks stifling the free flow of information and ideas, if courts deem any dissemination of information and other expression to be a service under the Lanham Act. This broad interpretation would cover use of another’s mark in emails, blog posts, cybergripe and parody websites, and

HANDBOOK OF CONTEMPORARY RESEARCH 404, 420 (Graeme B. Dinwoodie & Mark D. Janis, eds., 2008) [hereinafter Goldman, *Online Word of Mouth*] (arguing that cybergrippers who complain about markholders on the Internet “are espousing their opinions, not offering goods or services”). According to the Second Circuit in *United We Stand*, the *Lucasfilm* “court reached the right result but did not correctly describe the reason. If the court were right that communicating ideas and purveying points of view is not a service subject to the controls established by trademark law, then one who established a learning center would be free to call it Harvard or Yale University. We do not think the *Lucasfilm* court intended such a rule. In our view, the justification for denial of relief in [*Lucasfilm*] lay in the fact that the defendants were using plaintiff’s mark not in a manner that would create confusion as to source, but rather as part of a message whose meaning depended on reference to plaintiff’s product.” *United We Stand*, 128 F.3d at 91.

100. See *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 680 (9th Cir. 2005) (“Any harm to Bosley arises not from a competitor’s sale of a similar product under Bosley’s mark, but from Kremer’s criticism of their services. Bosley cannot use the Lanham Act either as a shield from Kremer’s criticism, or as a sword to shut Kremer up.”); *Lucasfilm*, 622 F. Supp. at 934-35 (“These laws do not reach into the realm of public discourse to regulate the use of terms used outside the context of trade.”).

many other communications that do not advertise or sell goods or services.

Although courts would better protect speech interests if they narrowly interpreted “services” in the infringement provisions to exclude the dissemination of information to others, such an interpretation may conflict with current practices at the U.S. Patent and Trademark Office (PTO). Under current trademark law, it is possible to procure a trademark registration for a mark used to identify the source of information services even if this is not the markholder’s primary focus.¹⁰¹ Per the PTO, an informational website is more like a service than a good, and there are various types of information services for which a trademark registration may be obtained.¹⁰² Specimens of use submitted to the PTO with an application for registration must show that the mark is being used in commerce in such a way that consumers will associate the mark as a service mark identifying the applicant’s information services, not just its primary goods or services.¹⁰³ For example, an informational website for a computer company must contain some “value-added” activity beyond the mere advertising or selling of computers or computer services to qualify for a separate registration for the mark for the provision of information services.¹⁰⁴

Communications about the markholder’s primary goods or services on an official website are merely normal and

101. See 3 MCCARTHY, *supra* note 31, § 19:89.

102. U.S. PAT. & TRADEMARK OFFICE, TRADEMARK MANUAL OF EXAMINING PROCEDURE §§ 1215.01-1215.10, 1202.07(b) (6th ed. 2009) [hereinafter TMEP], *quoted in* 1 MCCARTHY, *supra* note 31, § 7:17.50. A search of the terms “information” and “services” in the PTO’s Trademark ID Manual on June 10, 2010, resulted in a list of 171 entries, most of which are for different classes of services related to the provision of information services. U.S. PAT. & TRADEMARK OFFICE, U.S. ACCEPTABLE IDENTIFICATION OF GOODS & SERVICES MANUAL, *available at* <http://tess2.uspto.gov/netacgi/nph-brs?sect2=THESOFF§3=PLURON&pg1=ALL&s1=information+services&l=MAX§1=IDMLICON§4=HITOFF&op1=AND&d=TIDM&p=1&u=%2Fnetahhtml%2Ftidm.html&r=0&f=S> (last visited June 10, 2010).

103. *In re Walters*, No. 77120372, 2009 WL 1719379, at *2-3 (T.T.A.B. May 28, 2009); *In re Ralph Mantia Inc.*, 54 U.S.P.Q.2d (BNA) 1284, 1286 (T.T.A.B. 2000); TMEP, *supra* note 102, § 1301.04.

104. 1 MCCARTHY, *supra* note 31, § 7:17.50 & n.13 (quoting TMEP, *supra* note 102, §1215.02(b) (1996 statement of policy)).

ancillary to the sale of these goods or the rendering of the principal service, and are not by themselves a service as that term is used in the Lanham Act.¹⁰⁵ On the other hand, a markholder can register its mark for information services if the content it disseminates includes information unrelated to the markholder or its primary goods or services, such as news about the markholder's industry, tips for leading a healthy life, or similar value-added expression.¹⁰⁶ An example is the pharmaceutical company Pfizer Incorporated—owner of the registered trademark “Viagra” for a “compound for treating erectile dysfunction”¹⁰⁷—who in 2007 obtained a registration for the service mark “Viva Viagra” for “[m]edical information services, namely, providing information relating to men's sexual health.”¹⁰⁸

105. See *id.* §§ 7:17.50, 19:89; see, e.g., *In re Dr Pepper Co.*, 836 F.2d 508 (Fed. Cir. 1987) (holding that conducting a contest to promote the sale of goods does not qualify as rendering a separate “service” to others under the Lanham Act because the contest was part of selling the applicant's primary goods); *In re Moore Bus. Forms Inc.*, 24 U.S.P.Q.2d (BNA) 1638 (T.T.A.B. 1992) (holding that a paper manufacturer does not render a separate “service” to others when it rates the recycled content and recyclability of its own paper products because it is simply providing information about its products to potential purchasers).

106. See 1, 3-4 MCCARTHY, *supra* note 31, §§ 7:17.50, 19:89, 25:76 & n.12.

107. U.S. Trademark Reg. No. 2,162,548 (filed Apr. 12, 1996) (issued June 2, 1998).

108. U.S. Trademark Reg. No. 3,690,609 (filed Nov. 14, 2006) (issued Sept. 29, 2009). At the time of this writing, Pfizer had also applied to register the word mark “Viva Viagra” as a trademark and service mark for “[p]rinted materials, namely, booklets, pamphlets, paper displays and posters on the topic of men's sexual health” and “on-line information services, namely, providing information relating to men's sexual health via a global computer network.” U.S. Trademark Ser. Application No. 77,043,506 (filed Nov. 14, 2006). Recently, Pfizer successfully enforced the “Viva Viagra” mark in a suit against JetAngel.com—a firm that sells outdoor mobile advertising on decommissioned military equipment such as fighter jets and missiles—and its owner Arye Sachs. *Pfizer Inc. v. Sachs*, No. 08 Civ. 8065(WHP), 2008 WL 4525418 (S.D.N.Y. Oct. 8, 2008). When Sachs used the stylized “Viva Viagra” mark without authorization alongside a large yellow JetAngel.com banner on a decommissioned U.S. Air Force missile to promote his advertising services, the court found infringement because “consumers are likely to be confused as to the relationship between Plaintiff and Defendants' advertising.” *Id.* at *1, *4. The court rejected a First Amendment defense after finding the mark was used in a way “to suggest that Pfizer is the source of Defendants' activities” and concluded this use of the mark

Today, some markholders maintain social network site accounts that disseminate information about their products *and* other topics. Recall that Coca-Cola representatives posted tweets on the brand's Twitter account about sporting events, recycling, and a fundraiser for a breast cancer awareness group.¹⁰⁹ Information about the markholder's products may assist current and potential customers, while the other information may strengthen the markholder's brand image. Certain consumers may think a brand is more hip or interesting—and buy the company's branded goods, services, or stock—if the markholder's representatives are actively participating on social network sites by posting links to quirky news stories on the Internet or funny videos on YouTube. If such uses of a mark are sufficient to justify registration of the mark for information services (which is unclear), some courts may find third parties are using the mark in connection with information services if they use the mark to identify the source of expression posted on the site. For example, a person may be deemed to be rendering a medical information service when he or she uses the "Viva Viagra" mark in the username, account name, and/or content of a social network site page that disseminates information relating to men's sexual health.

If the accused infringer is just using the mark to communicate about the markholder or its products, however, this expression may not qualify as use of the mark in connection with information services. A markholder cannot get trademark rights in a mark for the rendering of information services simply by discussing its own products,¹¹⁰ and thus some courts will likely conclude that a third party also cannot be deemed to be using the mark for information services when it is only posting comments about the markholder or its products.¹¹¹ If the third party is using the mark to impersonate the markholder, however, it

was "likely to cause significant consumer confusion in the marketplace." *Id.* at *5.

109. Coca-Cola on Twitter, *supra* note 47.

110. *See supra* note 105 and accompanying text.

111. This may not matter for those courts and commentators who believe that the use requirements for obtaining trademark rights, such as the "use in commerce" requirement defined in § 1127, are different than the use requirements that are sufficient to violate another's trademark rights. *See supra* Part II.A.1.

may not matter if the focus is on the markholder's products. Courts may deem this use of the mark to be in connection with the advertising of the markholder's primary goods or services (albeit fake advertising), and find the second element of §§ 1114(1)(a) and 1125(a)(1)(A) satisfied for this reason.

3. Commercial Use of the Mark

Appellate courts in some circuits hold the use in connection with goods, services, or commercial activities language in the infringement statutes also implicitly requires the markholder to establish "commercial use" of the mark for a prima facie infringement claim.¹¹² According to the Sixth Circuit, "[t]he Lanham Act is constitutional because it only regulates commercial speech, which is entitled to reduced protections under the First Amendment."¹¹³ The infringement provisions do not expressly apply to "noncommercial use of a mark," and thus interpreting §§ 1114(1)(a) and 1125(a)(1)(A) to include an implied commercial use limitation is not inconsistent with the text of these provisions.¹¹⁴ Moreover, Professor McCarthy has stated that use of another's mark is not "actionable under the Lanham Act" unless the accused infringer uses "the challenged designation in some commercial sense."¹¹⁵

Courts in these circuits have found there is no commercial use of the mark where an accused infringer used another's mark in a domain name that linked to a noncommercial website that parodied, criticized, or

112. See, e.g. *Utah Lighthouse Ministry v. Found. for Apologetic Info. & Research*, 527 F.3d 1045, 1051-52 (10th Cir. 2008); *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 674, 676-77 (9th Cir. 2005); *Taubman Co. v. Webfeats*, 319 F.3d 770, 774-75 (6th Cir. 2003).

113. *Taubman*, 319 F.3d at 774; see also *Bosley*, 403 F.3d at 677 ("As a matter of First Amendment law, commercial speech may be regulated in ways that would be impermissible if the same regulation were applied to noncommercial expressions.") (citing *Florida Bar v. Went For It, Inc.*, 515 U.S. 618, 623 (1995)). When the commercial and noncommercial aspects of speech are "inextricably intertwined," the Supreme Court has held that courts should evaluate the constitutionality of restrictions of that speech using the "test for fully protected expression." *Riley v. Nat'l Fed'n of the Blind*, 487 U.S. 781, 796 (1988).

114. See 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A) (2006).

115. 4 MCCARTHY, *supra* note 31, § 25:76.

otherwise commented on the markholder.¹¹⁶ If a third party uses another's mark without authorization in the username or account name of a social network site and communicates about the markholder in similar noncommercial expression, some courts may conclude the markholder has not established a prima facie case of infringement due to failure to satisfy the commercial use requirement.

Other courts have held there is no commercial use requirement for infringement liability in §§ 1114(1)(a) or 1125(a)(1)(A).¹¹⁷ Neither provision refers to "commercial use of a mark" or use of the mark in "commercial speech." Section 1125(a)(1)(A) does use the phrase "commercial activities" and the legislative history suggests this language was intended to exclude political activities.¹¹⁸ Yet § 1114(1)(a) "contains no commercial activity requirement" and the word "commercial" does not appear immediately before "goods" or "services" in §§ 1114(1)(a) or 1125(a)(1)(A).¹¹⁹ Moreover, the text of the federal dilution statute expressly exempts "noncommercial use of a mark" from its application, but there is no such exception in the infringement statutes.¹²⁰ When construed in context, the text of the infringement provisions suggests that Congress either did not intend to limit the Lanham Act's infringement provisions to commercial use of a mark, or decided to allow courts to determine whether the

116. See, e.g., *Utah Lighthouse*, 527 F.3d at 1052-54 (finding no commercial use of the "Utah Lighthouse" mark in a domain name and parody website); *Bosley*, 403 F.3d at 677-80 (finding no commercial use of the "Bosley Medical" mark in a domain name linked to a cybergrape website).

117. See, e.g., *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 89-93 (2d Cir. 1997); *Browne v. McCain*, 612 F. Supp. 2d 1125, 1131 (C.D. Cal. 2009); *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1434 (S.D.N.Y. Mar. 19, 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998).

118. 5 MCCARTHY, *supra* note 31, §§ 27:71, 27:95 (quoting 134 CONG. REC. 31,852 (1988) (remarks of Rep. Kastenmeier)).

119. *Bucci*, 42 U.S.P.Q.2d at 1434; see 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A).

120. 15 U.S.C. § 1125(c)(3)(C) (2006); see also *Lamparello v. Falwell*, 420 F.3d 309, 313-14 (4th Cir. 2005) (noting the difference between the infringement and dilution statutes, but declining to resolve "the difficult question" of what constitutes commercial speech or determine whether the infringement provisions apply exclusively to commercial speech because this use of the mark did not cause a likelihood of confusion).

infringement statutes should apply to noncommercial uses of trademarks.

Courts have applied infringement law in trademark disputes where there is no commercial use of the mark in connection with the advertising or sale of commercial goods or services. For example, courts have found political, religious, and social organizations infringed the trademarks of others under the Lanham Act when they used the marks to identify their own goods, services, or activities.¹²¹ Moreover, the terms “goods” and “services” in the infringement statutes need not be interpreted as synonymous with commercial use of the mark. A nonprofit organization may distribute goods for free, such as donated food or clothing, or provide noncommercial services, such as religious services or voter registration services.¹²² According to one court, the Lanham Act’s “purpose of reducing consumer confusion supports application of the Act to

121. *E.g.*, *United We Stand*, 128 F.3d at 86, 90-93 (stating that courts have applied the law “to defendants furnishing a wide variety of non-commercial public and civic benefits” and applying the Lanham Act to a political organization that used the “United We Stand America” mark for its political activities and services); *Gen. Conference Corp. of Seventh-Day Adventists v. Perez*, 97 F. Supp. 2d 1154, 1164 (S.D. Fla. 2000) (holding that enforcement of a religious organization’s “Seventh-Day Adventist” and “SDA” marks for religious goods and services against an unaffiliated church will not violate any constitutional rights); *MGM-Pathe Commc’ns Co. v. Pink Panther Patrol*, 774 F. Supp. 869, 874-77 (S.D.N.Y. 1991) (applying the Lanham Act to use of the “Pink Panther” mark and paw print design by a gay rights activist group as part of their logo and rejecting a First Amendment argument); *cf. Browne*, 612 F. Supp. 2d at 1127, 1131 (holding that Browne could state a claim for false endorsement based on a presidential candidate’s use of his *Running on Empty* song in the background of a political advertisement because the Lanham Act applies to noncommercial speech).

122. For example, an entity established by a religious organization registered the mark “Seventh-Day Adventist” for religious books and services, among other things. *Seventh-Day Adventists*, 97 F. Supp. 2d at 1156, 1158; U.S. Trademark Reg. No. 1,177,185 (filed May 7, 1980) (issued Nov. 10, 1981). In addition, the political organization United We Stand America, Inc. obtained a federal registration for “United We Stand America” as a mark for various services, including “conducting voter registration drives” and “dissemination of information in the field of public policy.” U.S. Trademark Reg. No. 1,844,852 (filed Dec. 7, 1992) (issued July 12, 1994); *see also United We Stand*, 128 F.3d at 88 (discussing the registration).

political speech, where the consequences of widespread confusion as to the source of such speech could be dire.¹²³

Courts have also applied the infringement provisions of the Lanham Act to the unauthorized use of marks in the titles or content of books, magazines, films, and other artistic and literary works.¹²⁴ Artistic and literary works are often sold for profit, but they are not pure commercial speech, which is defined by the U.S. Supreme Court as speech that “does no more than propose a commercial transaction.”¹²⁵ Some courts use speech-protective doctrines, such as the *Rogers* balancing test, to limit the applicability of trademark infringement law in cases involving artistic and literary expression.¹²⁶ These courts do not categorically hold that infringement law only applies to commercial use of a mark or expression that qualifies as pure commercial speech under the Court’s First Amendment jurisprudence.¹²⁷

In those circuits where commercial use of a mark is a requirement for infringement liability, one interesting issue to consider is whether judges in those circuits will interpret “commercial use of a mark” more broadly than use of a mark in commercial speech. To fit a certain harmful use of a mark within their commercial use requirement, courts may

123. *Browne*, 612 F. Supp. 2d at 1131.

124. *E.g.*, *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1396 (9th Cir. 1997) (book); *Anheuser-Busch, Inc. v. Balducci Publ’ns*, 28 F.3d 769, 771-72 (8th Cir. 1994) (magazine); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202 (2d Cir. 1979) (film); *Am. Dairy Queen Corp. v. New Line Prods., Inc.*, 35 F. Supp. 2d 727, 728-29 (D. Minn. 1998) (film).

125. *United States v. United Foods, Inc.*, 533 U.S. 405, 409 (2001); *Bd. of Trs. of State Univ. of N.Y. v. Fox*, 492 U.S. 469, 473-74, 482 (1989); *Va. State Bd. of Pharm. v. Va. Citizens Consumer Council*, 425 U.S. 748, 761-62 (1976) (quoting *Pittsburgh Press Co. v. Human Relations Comm’n*, 413 U.S. 376, 385 (1973)).

126. *See, e.g.*, *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02 (9th Cir. 2002) (applying the test in *Rogers v. Grimaldi*, 875 F.2d 994, 999 (2d Cir. 1989)). The *Rogers* balancing test is discussed in detail below. *See infra* Part II.A.5.b.

127. *Id.* According to the Second Circuit, “[m]ovies, plays, books, and songs are all indisputably works of artistic expression and deserve protection. Nonetheless, they are also sold in the commercial marketplace like other more utilitarian products, making the danger of consumer deception a legitimate concern that warrants some government regulation . . . Poetic license is not without limits. The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product.” *Rogers*, 875 F.2d at 997.

characterize noncommercial use of a mark on a social network site as commercial even if the mark is not used to propose a commercial transaction. This may be more likely to occur if the social network site user provides links to other commercial websites in posts on the site,¹²⁸ or makes money from advertisements displayed alongside the noncommercial expression on the site.

In trademark disputes involving impersonation of markholders, courts could also treat the imposter's expression as akin to commercial use of the mark because consumers think the markholder is using the mark on the social network site for commercial purposes. Markholders are increasingly providing information about their goods, services, and commercial activities on official websites and social network site accounts. Thus, even if the third party has a noncommercial motive for using the mark to impersonate the markholder and is not advertising or selling real commercial goods or services (such as the person who created the fake Nine West—Model Auditions group page on Facebook), courts may find this use of the mark is commercial if reasonable consumers would think the expression has a commercial purpose.¹²⁹

Accused infringers will likely argue that a commercial use requirement for a prima facie trademark infringement claim better protects speech interests. It may reduce frivolous lawsuits against individuals who complain about or parody markholders, discourage courts from applying trademark infringement law to noncommercial speech, and make it easier for judges to dismiss speech-harmful trademark claims early on a motion to dismiss or motion for summary judgment.¹³⁰

128. *Cf.* *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 366 (4th Cir. 2001) (holding that Doughney used the People for the Ethical Treatment of Animals' mark PETA in connection with the sale of goods or services by providing links to 30 commercial websites offering goods or services). For criticism of this case, see Goldman, *Online Word of Mouth*, *supra* note 99, at 416, 419-20.

129. *Cf.* Tushnet, *Facebook Fraud*, *supra* note 12 ("I'm willing to accept that pretending to offer services in the ordinary market—here, the market for modeling services—ought to count under these (hopefully unique) facts.").

130. Ramsey, *First Amendment Limitations*, *supra* note 33, at 154-55; Ramsey, *Increasing Scrutiny*, *supra* note 32, at 454-56.

Markholders will likely respond that there are good reasons for legislatures and courts not to implement such a rigid categorical rule in infringement actions. These types of inflexible rules may be unfair to markholders and allow some confusing uses of marks to continue that would otherwise be found infringing under the likelihood of confusion analysis.¹³¹ There is a compelling government interest in protecting consumers against misleading uses of the marks of political, religious, or other nonprofit groups in noncommercial expression to falsely designate the source of the imposter's own goods, services, or activities.¹³² Even if this use of the mark is noncommercial, impersonation of markholders can significantly harm the public if reasonable persons believe the false statements of identity and authorship and rely to their detriment on that expression. If the speech is noncommercial *and* the mark is not used to designate the source of expression, a third party may have a better argument in favor of categorically excluding this expression from infringement liability.

4. *Trademark Use of the Mark*

As discussed earlier, some courts hold that the “use[s] in commerce” language in §§ 1114(1)(a) or 1125(a)(1)(A) implicitly limits infringement liability to circumstances where there is a certain type of “use” of the mark that satisfies § 1127’s definition of “use in commerce.”¹³³ Other courts may read a “trademark use” requirement into the infringement law using other provisions of the Lanham Act. Section 1127’s definitions of “trademark” and “service mark” refer to use of a mark “to identify and distinguish” the person’s goods or services from those of others, “and to indicate the source” of the person’s goods or services.¹³⁴ Some courts may use this language to conclude that third parties are not liable for infringement unless they use the mark as a trademark or as a designation of source for their own goods or services.¹³⁵ Scholars note a threshold

131. Ramsey, *Increasing Scrutiny*, *supra* note 32, at 457.

132. *Id.* at 444.

133. *See supra* note 81.

134. 15 U.S.C. § 1127 (2006).

135. Professor Goldman advocates such an approach. *See* Goldman, *Online Word of Mouth*, *supra* note 99, at 418-19 (arguing that “a use in commerce

trademark use requirement could be used to limit the expansion of trademark rights and promote competition and free speech interests, among other societal benefits.¹³⁶ Unfortunately, this categorical rule may not serve a true gatekeeper function on motions to dismiss or motions for summary judgment if courts need to consider consumer perceptions to decide the question of whether a particular type of use qualifies as a trademark use.¹³⁷

Recently, some courts have questioned whether the Lanham Act contains a separate statutory requirement of trademark use and have refused to dispose of infringement claims on this ground on motions to dismiss.¹³⁸ There is no explicit “trademark use” requirement in the infringement statutes, although this concept appears in other parts of the Lanham Act. For example, the statutory descriptive fair use defense only applies to the use of a mark “otherwise than as a mark.”¹³⁹ Some scholars note this provision would be superfluous if there were a trademark use requirement for a

should occur only when the defendant uses the plaintiff’s trademark to designate the source of the defendant’s goods or services” and noting the definition of a trademark supports this “source-designation requirement”). This “designation of source” language can be found in the federal dilution statute, which exempts certain “fair” uses of marks from its application if the mark is used “other than as a designation of source for the person’s own goods or services.” 15 U.S.C. § 1125(c)(3)(A) (2006).

136. See, e.g., Barrett, *Domain Names*, *supra* note 70, at 983-85; Barrett, *Internet Trademark Suits*, *supra* note 81, at 379, 382-86; Stacey L. Dogan & Mark A. Lemley, *Grounding Trademark Law Through Trademark Use*, 92 IOWA L. REV. 1669, 1674, 1690-98 (2007) [hereinafter Dogan & Lemley, *Grounding Trademark Law*]; Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L.J. 507, 593-94 (2005) [hereinafter Goldman, *Deregulating Relevancy*]; see generally Margreth Barrett, *Finding Trademark Use: The Historical Foundation for Limiting Infringement Liability to Uses “In the Manner of a Mark,”* 43 WAKE FOREST L. REV. 893 (2008) (arguing common law and legislative history establish that there is a trademark use limitation in the infringement provisions of the Lanham Act).

137. Mark P. McKenna, *Trademark Use and the Problem of Source*, 2009 U. ILL. L. REV. 773, 775-76.

138. See, e.g., *Vulcan Golf, LLC v. Google, Inc.* 552 F. Supp. 2d 752, 766 & n.7 (N.D. Ill. 2008); *Google, Inc. v. Amn. Blind & Wallpaper Factory*, No. C 03-05340 JF, 2005 WL 832398, at *5 (N.D. Cal. Mar. 30, 2005).

139. 15 U.S.C. § 1115(b)(4) (2006).

prima facie claim of infringement.¹⁴⁰ Professor McCarthy's view is that "[a] requirement of trademark use is implicit in the requirement that there be a likelihood of confusion for infringement to occur. Thus, 'trademark use' is not a separate element of plaintiff's case, but is only one aspect of the likelihood of confusion requirement for infringement."¹⁴¹ Despite the potential speech-related benefits of a trademark use requirement, it could also create some problems, including a risk that courts will allow socially harmful uses of marks to continue because the defendant's particular type of use does not satisfy this threshold requirement.¹⁴²

In trademark disputes involving the unauthorized use of marks in expression on social network sites, accused infringers will likely argue that trademark use of the mark is required for infringement liability and this requirement is not satisfied in these circumstances. If the third party is using another's mark only in expression, and not to identify or distinguish goods or services for sale in the marketplace, courts in circuits that require trademark use may find there is no "use in commerce" of the mark as the term is defined by § 1127 and/or no use of the mark as a "trademark" or designation of source for goods or services. If the court concludes that the dissemination of information and other expression qualifies as a service, however, then third party use of a mark to designate the source of the expression could qualify as a trademark use and satisfy any source-designation requirement (although there is still no "use in commerce" per § 1127 unless the mark is used or displayed in the sale or advertising of the information services).

140. Dinwoodie & Janis, *Confusion Over Use*, *supra* note 85, at 1617; Ramsey, *First Amendment Limitations*, *supra* note 33, at 168 n.66. *But see* Margreth Barrett, *Reconciling Fair Use and Trademark Use*, 28 CARDOZO ARTS & ENT. L.J. 1, 4-5 (2010) ("[C]onclud[ing] that the trademark use requirement and the fair use defense are consistent and work together to strike the balance of competing interests that Congress sought to establish in the Lanham Act."); Dogan & Lemley, *Grounding Trademark Law*, *supra* note 136, at 1683-85 (arguing the trademark use requirement does not make the statutory fair use provision superfluous).

141. 4 MCCARTHY, *supra* note 31, § 23.11.50, *quoted in* *Vulcan*, 552 F. Supp. 2d at 766 n.7.

142. For the argument that there is no statutory or policy basis for a trademark use requirement, *see generally* Dinwoodie & Janis, *Confusion Over Use*, *supra* note 85; Graeme B. Dinwoodie & Mark D. Janis, *Lessons from the Trademark Use Debate*, 92 IOWA L. REV. 1703 (2007).

Courts are more likely to find that use of a mark designates the source of expression on a social network site, and is a trademark use, where the mark is used in a username or account name on a social network site to identify the account and distinguish it from others. This is especially true if the third party is impersonating the markholder. If the mark is only used in the content of the social network site page, and not in the username or account name, it is unlikely courts will find the mark is being used to designate the source of the expression. Examples of such nontrademark uses of a mark include use in the content of parody, satire, criticism, or other commentary, use in comparative advertising or news reporting to refer to the markholder, and use of a trademarked term to describe the qualities or characteristics of the defendant's goods or services rather than identify their source.¹⁴³

Finally, it is important to note that even where a mark is used in a username or account name for a social network site page, that name may not designate the source of expression on the site. For example, a fan page for a brand on a social network site will usually contain posts or comments from several different people. If the content on the page indicates the site was created by someone other than the markholder and the third party who set up the site does not post comments on the site, that third party is not using the mark to identify the source or author of expression on the site. The registrant of the social network site page is using the mark to describe the content of the page.

On the other hand, if that third party posts content on the site under the username or account name, this may qualify as a trademark use of the mark regardless of whether the name contains additional words that inform other users that posts are not authored by the markholder's representatives. Words like "fake" or "parody" may notify others that the markholder is not the source of the expression, but the username or account name often indicates the author of any expression posted on the site. In such circumstances, the markholder may be able to prove the accused infringer is using the mark as a trademark or

143. Cf. Barrett, *Internet Trademark Suits*, *supra* note 81, at 386 (citing cases where courts declined to find infringement in such circumstances).

designation of source for expression, but not establish that this trademark use of the mark causes a likelihood of confusion.

5. *Likelihood of Confusion*

If the court determines that the threshold requirements for infringement liability under §§ 1114(1)(a) or 1125(a)(1)(A) are satisfied, it will next consider whether consumers are likely to be confused by this use of another's mark.¹⁴⁴ In trademark cases involving social network sites, courts may engage in a traditional likelihood of confusion analysis and/or apply the speech-protective *Rogers* balancing test or the speech-harmful initial interest confusion doctrine. The discussion below will primarily focus on how these doctrines could be applied in trademark disputes involving the use of marks solely in expression on social network sites, and not use of marks in connection with the advertising or sale of non-informational goods or services. Current trademark doctrine suggests that courts are generally more likely to find infringement where the accused infringer is using the mark to impersonate the markholder and cause confusion about the source of the expression. If a reasonable person would not think a page on a social network site is the markholder's official page, a finding of infringement is less likely.

a. Traditional Likelihood of Confusion Analysis

When determining whether a likelihood of confusion exists due to unauthorized use of another's mark, courts consider a number of factors. For example, courts in the Ninth Circuit consider, among other things, the: (1) strength of the mark, (2) relatedness of the goods or services, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) type of goods and the degree of care likely to be exercised by purchasers, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.¹⁴⁵ The discussion below explains how the likelihood of confusion

144. See 15 U.S.C. §§ 1114(1)(a), 1125(a)(1)(A) (2006).

145. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979); see also 4 MCCARTHY, *supra* note 31, § 24:39 (discussing the Ninth Circuit's likelihood of confusion test, which was first articulated in *Sleekcraft*).

factors may apply in unique ways in disputes involving social network sites, but readers should note this section does not provide a comprehensive summary of the law relating to these factors.¹⁴⁶

Strength of the Mark. In his empirical research, Professor Beebe notes a strong correlation between the inherent distinctiveness of a mark and a finding by courts of likelihood of confusion.¹⁴⁷ In disputes involving the use of another's mark in expression on social network sites, however, use of a stronger, more distinctive mark—such as the fanciful mark “Exxon” for gasoline, the arbitrary mark “Apple” for computers, or the suggestive mark “Tide” for laundry detergent—will not necessarily increase the likelihood of confusion caused by this use of the mark. Some consumers may expect that owners of such well-known marks have registered the social network site username consisting of the trademarked term. Yet they may also know that third parties use such marks in parody, satire, criticism, and other commentary on social network sites, and that common words in our language and personal names are often registered as usernames on a first-come, first-served basis by someone other than the most famous markholder.¹⁴⁸

If the mark is being used to impersonate the markholder and falsely identify the source of expression on a social network site, this use may cause a likelihood of confusion regardless of whether the mark is an inherently distinctive mark or a descriptive term with acquired distinctiveness. On the other hand, if the third party is clearly parodying, criticizing, or commenting on the markholder or is using the mark in satire, the fanciful, arbitrary, or suggestive nature of the mark would not necessarily increase confusion in these circumstances. Rather, “the strength of the mark may actually make it easier for the consumer to realize that the use is a parody” or other type of commentary.¹⁴⁹ The strength of the mark

146. For such a summary, see 4 MCCARTHY, *supra* note 31, §§ 24:30-43 (discussing the likelihood of confusion tests in the various circuits).

147. See Barton Beebe, *An Empirical Study of the Multifactor Tests for Trademark Infringement*, 94 CAL. L. REV. 1581, 1636-37 (2006).

148. Cf. *Interstellar Starship Servs., Ltd. v. EPIX, Inc.*, 304 F.3d 936, 943-45 (9th Cir. 2002).

149. *Lyons P'ship v. Giannoulas*, 179 F.3d 384, 389 (5th Cir. 1999).

factor will therefore generally not be a useful measure of whether consumers are likely to be confused when the mark is solely used in expression on a social network site rather than in connection with the advertising or sale of goods or services.

Relatedness of the Goods or Services / Likelihood of Expansion of Product Lines. If the parties' goods or services are identical or related, courts are more likely to find a likelihood of confusion.¹⁵⁰ In disputes involving the use of marks only in expression on social network sites, some courts will likely find this factor favors a finding of no infringement where the accused infringer is not selling any goods or services. If the court determines that the defendant's dissemination of information qualifies as a service, however, this factor may favor the markholder if both parties are using the mark in connection with their information services.

Yet even if the markholder has only used its mark in connection with the advertising and sale of its primary goods or services, the parties' goods or services need not be identical or even closely related for courts to find a likelihood of confusion under §§ 1114(1)(a) or 1125(a)(1)(A).¹⁵¹ Moreover, the markholder can argue it plans to use its mark in connection with the provision of information services in the future and thereby expand its line of products. As discussed in Part I, many brands are moving beyond traditional advertising in the brick-and-mortar world and now provide information to others via social network sites in addition to official websites and blogs.

As with the strength of the mark factor, satisfaction of the relatedness of the goods or services factor (or failure to satisfy it) may not be an accurate predictor of the likelihood of confusion in cases involving social network sites. When the third party is using the mark in parody, satire, criticism, or other commentary on the site, the fact that the markholder also provides information services on the Internet does not make this third party use more or less confusing. If the accused infringer is instead engaging in impersonation of the markholder on the site, this use of the

150. See 4 MCCARTHY, *supra* note 31, §§ 24:22-50.

151. *Id.* § 24:22.

mark may cause significant confusion about the source of the expression even where the markholder has no presence on the Internet and the third party does not sell any goods or services. Moreover, if the markholder has set up an official social network site page on Facebook, Twitter, or another site, and consumers already use that site, those consumers are less likely to believe a different, fake site is also the official site for that brand even where the “information services” of the parties are identical. (Of course, members of the public who have not already used the markholder’s official social network site may be confused by an imposter’s site.) For these reasons, the relatedness of the goods or services factor—along with the likelihood of expansion of product lines factor—may not be very useful in evaluating likelihood of confusion when marks are used without authorization in expression on social network sites.

Similarity of the Marks. Use of a term identical to another’s protected mark in the username or account name of a social network site could increase the likelihood that consumers will be confused about the source of expression on that site. But if the accused infringer is using the exact mark in news reporting, parody, criticism, or commentary about the markholder, and the content of the page makes it clear that this third party is responsible for the expression on the site, then use of the exact mark to refer to the markholder may not cause any confusion once the user begins to read the expression on the site. Use of a mark to refer to the markholder in comparative advertising, or to describe the goods or services of the third party, also may not cause confusion even if the third party is using the identical trademarked term.

Adding words to the mark used in a username or account name on a social network site could either increase or decrease consumer confusion depending on the words. Consumers may be more likely to be confused if the username or account name that incorporates the mark includes words like “real” or “official,” and not just the exact mark. Such words may be used by imposters who are impersonating the markholder on the site. Confusion is less likely if words like “fake,” “sucks,” or “victim” appear before

or after the mark in the name.¹⁵² Some third parties clearly indicate they are engaging in parody or satire, not impersonation, by including the word “fake” in their name when they pretend to be someone else on blogs and social network sites. For example, Dan Lyons became famous for writing a blog on the Internet under the alias “Fake Steve Jobs.”¹⁵³

Actual Confusion. Evidence of actual confusion is not required for a finding of infringement.¹⁵⁴ If it exists, however, courts may find this use of the mark is more likely to cause confusion in the future.¹⁵⁵ Consumer surveys or other evidence may show that people believe the expression on the third party’s social network site page is authored by the markholder’s representatives. On the other hand, lack of evidence of any actual confusion by social network site users for a long period of time may instead contribute to a finding of no likelihood of confusion.¹⁵⁶

Some courts may question whether there is really any actual confusion that is material if the accused infringer’s false statements of identity and authorship do not affect the purchasing decisions of consumers or otherwise cause any measurable injury.¹⁵⁷ Other courts may conclude the actual

152. *Cf.* Bally Total Fitness Holding Corp. v. Faber, 29 F. Supp. 2d 1161 (C.D. Cal. 1998) (finding no confusion regarding source when the “Bally” mark was used in the subdomain compupix.com/ballysucks because it is improbable that the markholder would use the term “ballysucks”); *see also* Taubman Co. v. Webfeats, 319 F.3d 770 (6th Cir. 2003) (finding no confusion about the source of information on websites where domain names contained the word “sucks”).

153. Brad Stone, *A Mystery Solved: ‘Fake Steve’ is an Editor*, N.Y. TIMES, Aug. 6, 2007, at C1. Someone has also created a Facebook profile using the name “Fake Steve Jobs.” Posting of Owen Thomas to Gawker, *A Fake Steve Jobs Pops up on Facebook*, <http://gawker.com/5070568/a-fake-steve-jobs-pops-up-on-facebook> (Oct. 29, 2008, 14:60 PDT); Fake Steve Jobs on Facebook, <http://www.facebook.com/pages/Fake-Steve-Jobs/6291744229> (last visited June 10, 2010).

154. 4 MCCARTHY, *supra* note 31, § 23:12.

155. *Id.* §§ 23:13-17. However, Professor Beebe’s empirical research suggests that “survey evidence, thought by many to be highly influential, is in practice of little importance.” Beebe, *supra* note 147, at 1622.

156. *See* 4 MCCARTHY, *supra* note 31, § 23:18.

157. Some courts hold that a Lanham Act plaintiff must prove actual confusion resulting in actual injury to obtain damages. *See, e.g.*, Web Printing Controls Co. v. Oxy-Dry Corp., 906 F.2d 1202, 1205-06 (7th Cir. 1990).

confusion factor is satisfied as long as consumers are truly confused about the source of the imposter's expression. If social network site users believe the information is coming directly from the markholder, they may be more likely to conclude it is accurate and rely on it to their detriment, especially if the information is negative (such as news of a product defect or delay, or an illness of the CEO) or contains details usually only known to insiders.¹⁵⁸ Consumers may sell the markholder's stock, forgo future employment or partnership relationships with the markholder, or provide the imposter with personal information. Unlike confusion about whether the markholder consented to the third party's use of its mark in expression, which should not constitute actionable confusion per some commentators,¹⁵⁹ actual confusion about the source of an imposter's expression may cause consumers some real harm, and justify a presumption of materiality.

One important question in markholder impersonation cases will be how long the public must be confused by the false statements of identity and authorship for the court to find the actual confusion factor satisfied. If the imposter only confuses the public regarding the source of expression for a few seconds or minutes, and causes no other confusion, some courts will likely find this is not sufficient evidence of actual confusion because any harm caused by this type of confusion is minimal compared to the harm caused by confusion that affects purchasing decisions.¹⁶⁰ If users do not discover the deception until after spending a significant

158. *Cf.* *McIntyre v. Ohio Elections Comm'n*, 514 U.S. 334, 348 n.11 (1995) (discussing the value of knowing "the identity of the source" for the purpose of judging the truthfulness of ideas contained in a writing).

159. *See* Mark A. Lemley & Mark McKenna, *Irrelevant Confusion*, 62 STAN. L. REV. 413, 415 (2010) (arguing that trademark infringement law—which includes a presumption of materiality—should only apply in cases involving actual source confusion or confusion about whether the markholder is responsible for the quality of the third party's goods or services). Professors Lemley and McKenna contend that trademark law should "refocus on confusion that is actually relevant to purchasing decisions," *id.* at 414, but they do not explicitly address whether use of a mark to cause actual confusion about the source of expression should be covered by infringement law where the third party is not advertising or selling expression that can be purchased by the public.

160. Some courts call this type of confusion "initial interest confusion," as discussed later in the Article. *See infra* Part II.A.5.c (discussing the initial interest confusion doctrine).

amount of time reading the expression, then courts may find this use of the mark to impersonate the markholder is actually confusing, and is more likely to cause confusion in the future.

Finally, if an imposter eventually reveals his or her true identity and is no longer using the mark to impersonate the markholder, it is unclear whether courts will find the past actual confusion favors a finding of likelihood of confusion. The disclosure of the prank makes future confusion less likely.

One example of a later-disclosed impersonation of a markholder that caused confusion involves “The Yes Men.” Per their website, The Yes Men are “[i]mpersonating big-time criminals” on television, at business conferences, and online “in order to publicly humiliate them”; their past targets include the World Trade Organization and Exxon.¹⁶¹ In the fall of 2009, The Yes Men used the marks of the U.S. Chamber of Commerce (“Chamber”) to impersonate this nonprofit organization on a fake website at the domain name chamber-of-commerce.us and in fake press releases that looked official.¹⁶² On October 19, 2009, representatives of The Yes Men held a fake press conference under the Chamber’s name to announce the organization’s alleged new position on climate change legislation. The prank was revealed at the press conference when a real Chamber representative entered the room and challenged the identity of the speaker.¹⁶³ At the time of this writing, there is also no longer a fake Chamber website at the domain name chamber-of-commerce.us. In such circumstances, the court may find the actual confusion factor favors the markholder and a finding of infringement, but decline to award an

161. The Yes Men, <http://www.theyesmen.org/> (last visited June 10, 2010).

162. First Amended Complaint at 7-11, ¶¶ 16, 19-24, Chamber of Commerce of United States v. Servin, No. 1:09-cv-02014 (D.D.C. filed Nov. 6, 2009), available at <http://www.eff.org/files/filenode/yesmen/YESMEN-amendedcomplaint.pdf> [hereinafter Chamber of Commerce Complaint]; Anne C. Mulkern, *U.S. Chamber Sues Activists over Climate Stunt*, N.Y. TIMES, Oct. 27, 2009, <http://www.nytimes.com/gwire/2009/10/27/27greenwire-us-chamber-sues-activists-over-climate-stunt-50982.htm>.

163. Chamber of Commerce Complaint, *supra* note 162, at 10-11, ¶¶ 23-25.

injunction if there is no future risk of actual or lingering confusion.¹⁶⁴

Marketing Channels. Courts generally find that the likelihood of confusion increases if the parties advertise their goods or services in similar media, or sell their products in the same stores. If the accused infringer is not advertising or selling any goods or services and is simply using the mark in expression on the social network site, then courts will likely find the marketing channels factor to be irrelevant when determining likelihood of confusion. Both the imposter and markholder may use the Internet to disseminate information, but it is quite common for markholders today to have a presence online. In disputes involving the use of another's mark in expression that is not advertised or sold, the marketing channels factor will not be a good predictor of whether confusion is likely to occur in these circumstances.

Type of Goods and Degree of Purchaser Care. Consumers are more likely to be confused by a third party's unauthorized use of another's mark if they do not exercise care at the time they purchase goods or services. In cases involving the use of marks solely in expression on social network sites, some courts may find this factor is irrelevant because there are no "purchasers" of goods or services.

Yet even if social network site users spend no money, they do spend valuable time consuming information on these sites. Moreover, some consumers may be careless because no money is at stake when they decide to read a markholder's posts on its Facebook page or follow the markholder on Twitter. Other users may spend a significant amount of time confirming that this social network site page is official, especially if this relationship results in the disclosure of the user's personal information to the markholder. If a certain social network site is known for encouraging participants to use their real identities, such as Facebook, then consumers may exercise less care when reading the expression on a site that is purportedly

164. *See, e.g.,* SMJ Group, Inc. v. 417 Lafayette Rest. LLC, 439 F. Supp. 2d 281, 293-95 (S.D.N.Y. 2006) (finding infringement because consumers were initially confused by defendants' use of the plaintiffs' logo on the front of a leaflet, but refusing to grant plaintiffs' request for a preliminary injunction after noting there was no risk of actual or lingering confusion once the contents of the leaflet were examined).

authored by a markholder. For these reasons, some courts may still consider this factor in trademark disputes involving expressive uses of trademarks on social network sites.

Both sophisticated and clueless users will likely encounter social network site pages that incorporate another's mark and exercise varying degrees of care when they obtain information on these sites. When the "buyer class" contains both professional and casual buyers, some courts hold "the standard of care to be exercised by the reasonably prudent purchaser will be equal to that of the least sophisticated consumer."¹⁶⁵ If courts apply this rule in the context of information consumption, then the degree of purchaser care factor will favor markholders. Even if the content on a fake page clearly suggests it is a parody, at least some users new to social network sites or inattentive readers will likely believe the markholder is the source of the third party's expression.

In trademark disputes involving the dissemination of expression, courts have focused on the standard of care from the perspective of reasonable people or ordinary consumers of information with normal intelligence.¹⁶⁶ In other contexts where the First Amendment right of free speech is implicated, the U.S. Supreme Court has held that *reasonable* persons must believe the false statement for the defendant to be liable.¹⁶⁷ As noted by the Fourth Circuit, the judge or jury in a trademark dispute should "determine whether a likelihood of confusion exists by 'examin[ing] the allegedly infringing use *in the context in which it is seen by the ordinary consumer*.'"¹⁶⁸ This approach better protects the free flow of information and ideas because a few careless consumers may be confused by the third party's expression for irrational or random reasons.

165. *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991).

166. *See, e.g., Int'l Ass'n of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201, 204-07 (1st Cir. 1996).

167. *See infra* Part II.B.

168. *Lamparello v. Falwell*, 420 F.3d 309, 316 (4th Cir. 2005) (quoting *Anheuser-Busch, Inc. v. L&L Wings, Inc.*, 962 F.2d 316, 319 (4th Cir. 1992)) (emphasis added in *Lamparello*).

Defendant's Intent. If the plaintiff is able to present evidence that the defendant is impersonating the markholder on a social network site with the intent to deceive the public, this could be determinative on the issue of likely confusion.¹⁶⁹ Professor Beebe's empirical research shows a finding of bad intent creates "a nearly un-rebuttable presumption of a likelihood of confusion."¹⁷⁰ A fake social network site account could be set up by a disgruntled former employee or an unscrupulous competitor with a bad faith intent to harm the company and malign its reputation. In such circumstances, some courts will probably find that the use is likely to confuse consumers.

Individuals with good intentions may also use a company's marks in a username or account name of a social network site to disseminate truthful information about the company or its products, possibly as a public service or as a form of self-expression. Despite the accused infringer's good faith, the public can still be confused by this use of the mark if the content of the page suggests that the third party is a representative of the markholder. A third party's good faith may therefore not be a useful predictor of the likelihood of confusion if that individual does not take steps to reduce confusion on the social network site page, such as by indicating his or her actual relationship (or lack thereof) with the markholder.

* * *

As demonstrated above, in cases involving the unauthorized use of marks in expression on social network sites, some of the traditional likelihood of confusion factors often do not seem to apply and/or do not sufficiently protect free speech or trademark interests. The next two sections discuss the common law doctrines created by courts to address these concerns—specifically, the *Rogers* balancing test and the initial interest confusion doctrine—which may be used by courts in these types of disputes.

169. According to Professor Beebe, "the intent factor, thought by some to be irrelevant, is of decisive importance." Beebe, *supra* note 147, at 1622.

170. *Id.* at 1628.

b. The *Rogers* Balancing Test for Uses of Marks in Artistic or Literary Works

A social network site user accused of infringement may argue that the content of his or her social network site page is akin to an artistic or literary work, and therefore the speech-protective *Rogers* balancing test should be used in lieu of the traditional likelihood of confusion analysis.¹⁷¹ Per the Second Circuit in *Rogers v. Grimaldi*, courts should construe the Lanham Act to apply to artistic or literary expression “only where the public interest in avoiding consumer confusion outweighs the public interest in free expression.”¹⁷² The *Rogers* balancing test was created by the Second Circuit in a case involving the unauthorized use of Ginger Rogers’ name in the title of a film—*Ginger and Fred*—about two dancers, but it has also been applied by the Ninth Circuit to allow use of another’s mark in the content of expression.¹⁷³

In trademark disputes involving artistic or literary works, the *Rogers* balancing test provides that courts should find First Amendment interests prevail over trademark rights unless (1) this use of the mark “has no artistic relevance to the underlying work whatsoever,” or (2) “if it

171. *Rogers v. Grimaldi*, 875 F.2d 994, 998-99 (2d Cir. 1989); see also *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900, 901, 905-07 (9th Cir. 2002) (adopting the *Rogers* balancing test and finding no infringement of the Barbie mark when used in the title and content of the band Aqua’s *Barbie Girl* song). The *Rogers* balancing test protects free speech interests in trademark disputes, but it is more limited than actual First Amendment scrutiny of trademark laws applied to noncommercial artistic and literary expression. See Ramsey, *Increasing Scrutiny*, *supra* note 32, at 445.

172. *Rogers*, 875 F.2d at 999.

173. See, e.g., *E.S.S. Ent. 2000, Inc. v. Rock Star Videos, Inc.*, 547 F.3d 1095, 1099-1101 (9th Cir. 2008) (finding no infringement of the “Play Pen” mark for a strip club where the third party used “Pig Pen” for the name of a virtual strip club in a video game). As noted by Professor McCarthy, “courts have expanded the *Rogers* balancing approach to encompass all ‘works of artistic expression.’” 2 MCCARTHY, *supra* note 31, § 10:22 (quoting *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publ’g Group*, 886 F.2d 490, 495 (2d Cir. 1989) (applying the test in a case involving the use of a protected trade dress for the cover of a parody book)).

has some artistic relevance, unless [it] explicitly misleads as to the source or the content of the work.”¹⁷⁴

It is likely that some courts will apply this test in disputes involving the use of marks without authorization in usernames, account names, and/or the content of social network site pages. Like an informational website, the content of a social network site page is generally more like the content of an artistic or literary work, such as a magazine, than the content of a label on a can of peas or a commercial advertisement for the peas. The username or account name for that page may also be found to be analogous to the title of a magazine or other expressive work, as courts have held such an analogy may be appropriate for certain domain names.¹⁷⁵ In *Bucci*, the court applied the *Rogers* balancing test to the unauthorized use of the “Planned Parenthood” mark in a domain name and home page address on a website, but it found the defendant did not satisfy either factor of the test.¹⁷⁶ More markholders and third parties today are disseminating information and entertainment online via websites and social network site pages. If this type of content is deemed to be an “artistic or literary work,” then courts will likely apply the *Rogers* balancing test to a third party’s use of another’s mark on a social network site page that disseminates information or

174. *Rogers*, 875 F.2d at 999. For scholarship that discusses this test and proposes revisions to it, see, e.g., Pratheepan Gulasekaram, *Policing the Border Between Trademarks and Free Speech: Protecting Unauthorized Trademark Use in Expressive Works*, 80 WASH. L. REV. 887 (2005); Elizabeth L. Rosenblatt, *Rethinking the Parameters of Trademark Use in Entertainment*, 61 FLA. L. REV. 1011 (2009).

175. See *Name.Space, Inc. v. Network Solutions, Inc.*, 202 F.3d 573, 585 & n.12 (2d Cir. 2000) (analogizing a domain name to the title of an expressive work, such as book or movie titles, may be appropriate in some cases); see also Barrett, *Domain Names*, *supra* note 70, at 1009-10 (“In the case of forum websites, the domain name that identifies the website is analogous to a book, magazine, or movie title . . . Under the *Rogers* line of cases, if book, movie and song titles are fully protected speech, then domain names identifying websites that serve as forums and do not sell goods or services surely must be too.”).

176. *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1440-41 (S.D.N.Y. Mar. 19, 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998) (“[E]ven treating defendant’s domain name and home page address as titles, rather than as source identifiers, I find that the title ‘plannedparenthood.com’ has no artistic implications, and that the title is being used to attract some consumers by misleading them as to the web site’s source or content.”).

other expression. Some courts may decline to apply this test, however, if the expression on the social network site is classified as commercial speech.¹⁷⁷

The first factor of the *Rogers* balancing test is satisfied if the third party's use of the mark has some artistic relevance to the underlying work. Use of another's mark in the username, account name, or other content on the site would clearly be artistically relevant to the entire content of the social network site page if the expression is about the markholder. Yet the use may also be relevant for artistic reasons even if the site does not focus on the markholder or its products. Per the Ninth Circuit, this factor is satisfied as long as the work has more than "zero" relevance, which is a very low standard.¹⁷⁸

Under the second factor of the *Rogers* balancing test, this use of the mark must also not "explicitly" mislead "as to the source or the content of the work."¹⁷⁹ This analysis will require examination of how the mark is used and the content of the expression, and a determination of what is actually communicated to consumers by this use of the mark in the username, account name, or content of the social network site page. If the mark is used to impersonate the markholder and people believe the false statements of identity and authorship due to the content of the page, courts will likely find this use of the mark explicitly misleads the public regarding the source and content of the expression on the social network site.¹⁸⁰

On the other hand, if a court examines the content of a social network site page and determines it clearly contains parody, satire, criticism, or other commentary, it will likely find this use of the mark does not explicitly mislead other users as to the source or content of the expression. Although it is not required to satisfy the second factor of the *Rogers* balancing test, use of a disclaimer or words like "fake" or "parody" in the username, account name, or content of the

177. See *Facenda v. N.F.L. Films, Inc.*, 542 F.3d 1007, 1017-18 (3d Cir. 2008) (declining to apply the *Rogers* balancing test in a false endorsement case because the expression—a television production called "The Making of Madden NFL" that promoted a video game—was deemed to be commercial speech).

178. *E.S.S. Entm't*, 547 F.3d at 1100.

179. *Rogers*, 875 F.2d at 999.

180. *Cf. Bucci*, 42 U.S.P.Q.2d at 1440-41.

page may further discourage any notion that the site is authored by representatives of the markholder. Unless the third party is impersonating the markholder and falsely suggesting the markholder is the source of the expression on the social network site, courts that have adopted the *Rogers* balancing test will likely find the public interest in free expression prevails when marks are used without authorization in expression on social network sites.

c. The Initial Interest Confusion Doctrine

In cases involving the unauthorized use of marks to attract attention on social network sites, markholders will likely argue that courts should apply the initial interest confusion doctrine when evaluating an accused infringer's liability under the Lanham Act's infringement provisions. This doctrine, which is only applied in some circuits,¹⁸¹ provides that "the Lanham Act forbids a competitor from luring potential customers away from a producer by initially passing off its goods as those of the producer's, even if confusion as to the source of the goods is dispelled by the time any sales are consummated."¹⁸² According to the Ninth Circuit, a defendant who uses another's mark to create initial interest confusion "improperly benefits from the goodwill that [the plaintiff] developed in its mark."¹⁸³ Under this theory, use of another's mark in a manner calculated "to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may still be an infringement."¹⁸⁴ When applying this doctrine, courts often focus on the fact that consumers are confused as to why they are seeing certain content presented to them, such as an advertisement displayed by an Internet search engine or a company's website located at a particular domain name address.¹⁸⁵

181. 4 MCCARTHY, *supra* note 31, § 23:6.

182. *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996); *see also* *Elvis Presley Enters. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

183. *Brookfield Commc'ns. Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999).

184. *Id.* (quoting *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997)) (internal quotations omitted).

185. *See, e.g., Playboy Enters. v. Netscape Commc'ns Corp.*, 354 F.3d 1020 (9th Cir. 2004); *Brookfield*, 174 F.3d at 1062-66; *see also* Goldman, *Online Word of*

Accused infringers will likely respond that this doctrine does not apply to expression on the Internet where the third party is not advertising or selling any goods or services. Some courts, including the Fourth Circuit, have refused to adopt the initial interest confusion doctrine.¹⁸⁶ Per the Fourth Circuit, “[t]he few appellate courts that have followed the Ninth Circuit and imposed liability under this theory for using marks on the Internet have done so only in cases involving . . . one business’s use of another’s mark for its own financial gain.”¹⁸⁷ “Profiting financially from initial interest confusion is thus a key element for imposition of liability under this theory.”¹⁸⁸ The Third Circuit is similarly critical of the initial interest confusion doctrine when applied to parties who are not competitors of the markholder or where the “confusion has little or no meaningful effect in the marketplace.”¹⁸⁹ Scholars have also complained that the initial interest confusion doctrine may stifle expression and competition on the Internet.¹⁹⁰

Despite such criticisms of the doctrine, some courts have found infringement in trademark disputes involving the dissemination of expression where the confusion did not affect any purchase decisions and the third party did not profit financially from its use of the mark. In many of these types of initial interest confusion cases, however, the

Mouth, *supra* note 99, at 425 (referring to this type of confusion as “content source confusion”).

186. *See, e.g.*, *Lamparello v. Falwell*, 420 F.3d 309, 316 (4th Cir. 2005).

187. *Id.* at 317 (citing *PACCAR Inc. v. Telescan Techs., LLC*, 319 F.3d 243, 253 (6th Cir. 2003); *Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 812 (7th Cir. 2002); *Brookfield*, 174 F.3d at 1055-56).

188. *Lamparello*, 420 F.3d at 317; *see also* Hannibal Travis, *The Battle for Mindshare: The Emerging Consensus that the First Amendment Protects Corporate Criticism and Parody on the Internet*, 10 VA. J.L. & TECH. ¶¶ 3, 85 (2005).

189. *Checkpoint Sys. Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 296-97 (3d Cir. 2001).

190. *See, e.g.*, Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 813-31 (2004); Goldman, *Deregulating Relevancy*, *supra* note 136, at 575-95; Michael Grynberg, *The Road Not Taken: Initial Interest Confusion, Consumer Search Costs, and the Challenge of the Internet*, 28 SEATTLE U. L. REV. 97 (2004); Jennifer E. Rothman, *Initial Interest Confusion: Standing at the Crossroads of Trademark Law*, 27 CARDOZO L. REV. 105 (2005).

accused infringer used the mark not just to attract attention to its expression, but also to cause confusion about the source of the expression.¹⁹¹

For example, both in the brick-and-mortar world and on the Internet, Planned Parenthood has been the target of pro-life activists who used its marks to try to confuse women into learning about their alternate point of view. Planned Parenthood uses the marks “Planned Parenthood” and a stylized mark consisting of the letters “PP” (with one P enclosing the other) for medical and educational services in the areas of birth control and abortion. In one trademark dispute, a pro-life group called Problem Pregnancy of Worcester, Inc. put “PP” on the door of an office on the same floor as the Planned Parenthood office to intentionally confuse and intercept women who were seeking Planned Parenthood’s offices for abortion counseling services.¹⁹² A few years later, pro-life activist Richard Bucci created a fake Planned Parenthood website at the domain name *plannedparenthood.com*, and used the phrase “Welcome to the PLANNED PARENTHOOD HOME PAGE!” on the website’s home page.¹⁹³ The women who entered the pro-life group’s office and who spent time on Bucci’s website eventually discovered the pro-life message, but the courts still found the defendants liable for infringement. It seemed

191. For a discussion of cases involving use by third parties of another’s mark that may cause trade identity confusion, see 4 LOUIS ALTMAN & MALLA POLLACK, CALLMAN ON UNFAIR COMPETITION, TRADEMARKS AND MONOPOLIES §§ 22:2, 22:3 (4th ed. 2010).

192. *Planned Parenthood Fed’n of Am., Inc. v. Problem Pregnancy of Worcester, Inc.*, 498 N.E.2d 1044, 1045 (Mass. 1986). The “PP [was] followed by smaller letters, ‘Inc. of Worc.’ and then the words: ‘Free pregnancy testing and counseling, walk-in’ . . . Approximately one foot from the bottom of the door was the full title ‘Problem Pregnancy of Worcester, Inc.’ in letters measuring about one-half inch.” *Id.* “According to the affidavits of three women, on separate occasions, each entered 340 Main Street on her way to have either a pregnancy test or an abortion at PPLM and by mistake entered the offices of PP, Inc. There the women conversed with staff members and filled out medical history forms before realizing they were at the wrong place. They were distressed over this confusion and complained to PPLM. Their claims triggered the present action.” *Id.* at 1045-46.

193. *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, 42 U.S.P.Q.2d (BNA) 1430, 1432 (S.D.N.Y. Mar. 19, 1997), *aff’d*, 152 F.3d 920 (2d Cir. 1998). The website also included a scanned image of the cover of the book *The Cost of Abortion* which linked to passages from the book. *Id.*

important to these decisions that the defendants used Planned Parenthood's marks to intentionally confuse women seeking the markholder's services and information into hearing or reading their own pro-life message.¹⁹⁴

Like the *Bucci* court, other courts have found certain uses of the marks of nonprofit organizations in domain names linked to informational websites to be infringing even though the defendant was not selling or advertising commercial goods or services. For example, in *Jews for Jesus v. Brodsky*, the defendant used a religious organization's "Jews for Jesus" mark in the domain name *jewsforjesus.org* and an unofficial website about this religious group.¹⁹⁵ The court held this use of the mark was likely to cause confusion among Internet users who were looking for the official Jews for Jesus website.¹⁹⁶ As in *Bucci*, the *Jews for Jesus* defendants admitted they used the plaintiff's mark because they wanted to intercept members of the public interested in the markholder's message.¹⁹⁷

In addition, the Southern District of New York recently found infringement under the initial interest confusion doctrine where a trademark was used without authorization on the front of a leaflet to cause confusion about the identity of the author of the message contained therein. In *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, a nonprofit organization that promotes the rights of restaurant workers distributed leaflets that displayed the plaintiffs' trademarked logo on the cover with the phrase "SPECIAL FOR YOU" in front of two of plaintiffs' restaurants.¹⁹⁸ Inside

194. *Id.* at 1433 ("Defendant's counsel also admitted that Bucci was trying to reach Internet users who thought, in accessing his web site, that they would be getting information from plaintiff . . . [D]efendant's motive in choosing plaintiff's mark as his domain name was, at least in part, to attract to his home page Internet users who sought *plaintiff's* home page.") (emphasis in original); *Problem Pregnancy*, 498 N.E.2d at 1049, 1053 (affirming injunction because defendant's intent was to confuse women in order to further its goals).

195. 993 F. Supp. 282, 290, 301-05 (D.N.J. 1998), *aff'd* 159 F.3d 1351 (3d Cir. 1998).

196. *Id.*

197. *Bucci*, 42 U.S.P.Q.2d at 1433; *Jews for Jesus*, 993 F. Supp. at 308 ("[Defendant] has created, in his words, a 'bogus "Jews for Jesus" site intended to intercept, through the use of deceit and trickery, the audience sought by the Plaintiff Organization.").

198. 439 F. Supp. 2d 281, 285 (S.D.N.Y. 2006).

the leaflet, a message critical of the plaintiffs appeared alongside the phrase “DO YOU REALLY WANT TO EAT HERE?”¹⁹⁹ The parties agreed that recipients of the leaflet would initially think the plaintiffs were the source of the message, but would realize the leaflet was not associated with the markholder upon opening it because of the critical message.²⁰⁰ Although the court thought it was admirable that “[d]efendants seek to educate the public,” it concluded that defendants’ use of the plaintiffs’ logo on the front of the leaflet was infringing and explained that “an individual being educated should not be misled about the source of that education, just as an individual purchasing a can of peas should not be misled about the source of those peas.”²⁰¹ The court held that the doctrine of initial interest confusion was not limited to use of another’s mark by a business for its own financial gain,²⁰² and could be applied in this case to the defendants’ use of the plaintiffs’ mark in noncommercial expression.²⁰³

Courts and commentators have criticized the *Bucci*, *Jews for Jesus*, and *SMJ Group* decisions for a variety of reasons, including the potential harm to free speech interests if courts find infringement without considering whether the content of the message dispels confusion about the source of the message.²⁰⁴ In some circuits, accused

199. *Id.*

200. *Id.* at 288.

201. *Id.* at 287.

202. *Id.* at 289 (quoting *Lamparello v. Falwell*, 420 F.3d 309, 317 (4th Cir. 2005)).

203. *Id.* at 288-91. The court held that plaintiffs were likely to prevail on their infringement claim, and rejected a First Amendment defense because defendants used the “marks as a source identifier.” *Id.*

204. *See, e.g., Lamparello*, 420 F.3d at 318 n.6 (“[B]oth [the *Bucci* and *Jews for Jesus*] cases were wrongly decided to the extent that in determining whether the domain names were confusing, the courts did not consider whether the websites’ content would dispel any confusion. In expanding the initial interest confusion theory of liability, these cases cut if off from its moorings to the detriment of the First Amendment.”); Jon H. Oram, Note, *The Costs of Confusion in Cyberspace*, 107 YALE L.J. 869 (1997) (discussing *Bucci*); Posting of Eric Goldman to Technology & Marketing Law Blog, *Trademark Travesty of the Month—SMJ Group v. 417 Lafayette Restaurant*, http://blog.ericgoldman.org/archives/2006/07/trademark_trave.htm (July 13, 2006, 12:05); *supra* note 190 (listing scholarship critical of the initial interest confusion doctrine).

infringers may be able to avoid a finding of infringement under the initial interest confusion doctrine or the traditional likelihood of confusion test if the underlying content of the social network site page dispels any potential confusion about the source of the expression.²⁰⁵ For example, in *Lamparello v. Falwell*, Reverend Jerry Falwell sued Christopher Lamparello after he set up a website at the domain name fallwell.com that was critical of the religious leader and his “untruths about gay people.”²⁰⁶ On the home page, Lamparello prominently included the disclaimer “[t]his website is NOT affiliated with Jerry Falwell or his ministry” and provided a link to Reverend Falwell’s actual website.²⁰⁷ After examining the content of the website, the Fourth Circuit found there was no likelihood of confusion caused by this use of the religious leader’s trademarked name (with an extra “l”) in the domain name.²⁰⁸

The First Circuit also found no likelihood of confusion after considering the content of the expression when it evaluated the infringement claims in *International Association of Machinists and Aerospace Workers v. Winship Green Nursing Center*.²⁰⁹ In this case, an employer attempting to defeat a union organizing campaign used the marks of the union in fake flyers, letters, and invoices that purported to come from the union and disseminated these fictitious documents to employees.²¹⁰ The court found this expression was not likely to cause confusion because the employees could readily identify the employer as the source of the message upon reading the content of the message. According to the court, no reasonable employee would be confused about the source of the materials after reading the content.²¹¹

205. *Lamparello*, 420 F.3d at 316 n.4, 318 (citing *Parks v. LaFace Records*, 329 F.3d 437, 452-54 (6th Cir. 2003); *Mattel, Inc. v. MCA Records, Inc.*, 296 F.3d 894, 900-02 (9th Cir. 2002); *Westchester Media v. PRL USA Holdings, Inc.*, 214 F.3d 658, 667-68 (5th Cir. 2000); *Rogers v. Grimaldi*, 875 F.2d 994, 1000-01 (2d Cir. 1989)).

206. *Id.* at 311.

207. *Id.* at 314-18.

208. *Id.*

209. 103 F.3d 196, 198-99, 207 (1st Cir. 1996).

210. *Id.*

211. *Id.* at 201-02, 205-07.

In cases involving alleged impersonation of markholders on social network sites, courts may balance the trademark rights of markholders, the public's interest in avoiding confusion and in being able to trust the accuracy of statements of identity and authorship, the free speech rights of third parties to use another's mark to express themselves, and the right of the audience to receive that expression. Courts are more likely to find infringement if reasonable people are truly confused about the source of the accused infringer's expression, and the content of the social network site page does not dispel that confusion. Yet if the mark is just used to attract attention to expression on a social network site, and there is no confusion about its source, a finding of infringement is unlikely where the third party is not advertising or selling goods or services.

6. *Fair Use*

Even if the markholder can establish a prima facie case of infringement, the accused infringer may argue this use of the mark in the username, account name, or content of the social network site page is justified under the descriptive fair use or nominative fair use doctrine. Under the Lanham Act, it is a defense to infringement to "use, otherwise than as a mark," a word or phrase "which is descriptive of and used fairly and in good faith only to describe the goods or services of [a] party, or their geographic origin."²¹² For example, the Second Circuit found a competitor's use of the phrase "Seal it with a Kiss!!" in promotional displays for lipstick was a descriptive fair use of another company's registered mark "SEALED WITH A KISS" for lip gloss.²¹³

Some courts may find a descriptive use of another's trademarked term in the content of a social network site page to describe the third party's goods or services to be an acceptable fair use of the mark. If the trademarked descriptive term is used in the username or account name, however, and the name identifies the source of expression by this third party on the social network site, the court may conclude this is a "trademark use" of the term, and not a use

212. 15 U.S.C. § 1115(b)(4) (2006); 2 MCCARTHY, *supra* note 31, §§ 11:45-49.

213. *Cosmetically Sealed Indus. v. Chesebrough-Pond's USA Co.*, 125 F.3d 28 (2d Cir. 1997).

“otherwise than as a mark.”²¹⁴ Moreover, in cases involving impersonation of markholders it will be difficult to establish a descriptive fair use defense because courts will likely find that an imposter who is intentionally pretending to be the markholder to confuse the public is not using the mark “fairly and in good faith” and/or is not using the mark to describe that party’s own goods or services.

Nominative fair use is a common law doctrine adopted in some circuits that permits third parties to use another’s mark without authorization to refer to the markholder or its goods or services.²¹⁵ An example is a newspaper’s use of the trademark of the musical group “New Kids on the Block” in a survey to ask readers to vote for their favorite member of the band.²¹⁶ For the nominative fair use doctrine to apply, the accused infringer must prove (1) the markholder’s goods or services are not readily identifiable without use of the mark, (2) the third party has only used so much of the mark as is reasonably necessary to identify the markholder’s goods or services, and (3) the third party has not done anything that would, in conjunction with the mark, suggest sponsorship or endorsement by the markholder.²¹⁷

If the accused infringer is using the mark in parody, criticism, or other commentary about the markholder on the social network site, including in news reporting or comparative advertising, it will likely be able to satisfy the first factor. Commentators generally need to use another’s mark to identify the target or subject of their expression. The second factor is more likely to be met if the third party

214. *Cf.* TCPIP Holding Co. v. Haar Commc’ns, Inc., 244 F.3d 88, 103-04 (2d Cir. 2001) (holding that the “The Children’s Place” mark for clothing was used “as a mark” in the domain name thechildrensplace.com for a website and thus the statutory fair use defense did not apply).

215. 4 MCCARTHY, *supra* note 31, § 23:11.

216. *New Kids on the Block v. News Am. Publ’g, Inc.*, 971 F.2d 302, 304 (9th Cir. 1992).

217. *Id.* at 308; *see also* *Mattel, Inc. v. Walking Mountain Prods.*, 353 F.3d 792, 810-12 (9th Cir. 2003) (holding use of the trademarked Barbie doll in parody photographs was nominative fair use); *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150–55 (9th Cir. 2002) (holding use of the trademarked name and likeness of Princess Diana in memorabilia and ads was nominative fair use). A variation of this common law doctrine has been developed and applied in the Third Circuit. *See Century 21 Real Estate Corp. v. LendingTree, Inc.*, 425 F.3d 211, 217–21 (3d Cir. 2005).

only uses non-stylized word marks to identify the markholder. Some courts may find it is unnecessary to use the stylized version of the mark or trademarked logos on the social network site page. Satisfaction of the last factor will likely depend on whether the third party is impersonating the markholder or is using the mark to communicate about the markholder. If the content of the social network site page confuses consumers about the source of the expression, the imposter will not be able to claim this is a permissible nominative fair use of the mark. On the other hand, where the social network site user is simply using the mark in parody, criticism, or commentary about the markholder, courts will likely find this is a nominative fair use of the mark if the content clearly indicates the third party is the source of the expression.

B. *A First Amendment Defense*

In addition to attacking a trademark infringement claim on doctrinal grounds, an accused infringer may also argue that this expression on the social network site is protected by the First Amendment right to freedom of expression. Some courts may decide to independently evaluate the constitutionality of the infringement statutes as applied to this expression on the social network site, especially if the speech is noncommercial. In trademark cases involving noncommercial speech that is not categorically excluded from First Amendment protection, application of trademark law to that expression is only constitutional if the law is narrowly tailored and is the least restrictive means to promote a compelling government interest. Few laws survive such strict scrutiny analysis.²¹⁸

A full constitutional analysis of infringement law regulating the use of marks in different types of expression on social network sites is beyond the scope of this Article. It is possible to conclude, however, that a First Amendment defense could prevail in trademark cases involving noncommercial speech on social network sites in many, but not all, of these disputes. Trademark infringement law is unlikely to survive strict constitutional scrutiny where the

218. See generally Ramsey, *Increasing Scrutiny*, *supra* note 32, at 389, 421-47 (discussing the Supreme Court's First Amendment doctrine and explaining how it should be used to evaluate the constitutionality of federal trademark laws).

accused infringer is not advertising or selling goods or services and that person's noncommercial expression does not contain false statements of fact. On the other hand, some courts could reject a First Amendment defense in trademark cases involving noncommercial expression, and find application of infringement law to be constitutional, where the accused infringer is using the mark on the social network site to impersonate the markholder and reasonable persons believe the third party's false statements of identity and authorship.²¹⁹

A person may effectively communicate certain ideas or information by impersonating a markholder on a social network site.²²⁰ This prank may grab the attention of the public more than traditional means of communication, and make everyone more likely to focus on the underlying message. But just because a particular method of communication is effective in achieving its goal does not mean that the expression is protected by the First Amendment. When an imposter uses another's mark to say "I am the markholder" and disseminate information on a social network site purporting to come from the markholder, this individual is falsely claiming to be the markholder's representative. This expression is not constitutionally-protected anonymous speech or pseudonymous speech.²²¹ It

219. *Cf. id.* at 444 ("[T]rademark infringement laws banning the misleading use in noncommercial speech of the distinctive marks of political, religious, or other noncommercial groups could satisfy strict scrutiny analysis if the marks were used by the defendant as marks to falsely designate the source of its activities. Protecting the ability of consumers to identify and distinguish among the activities of noncommercial entities is a compelling government interest. If these laws are narrowly tailored to protect expression and the least restrictive means to further this interest, they should be found constitutional.").

220. For an argument that parody blogs are protected by the First Amendment, see Hannibal Travis, *Of Blogs, eBooks, and Broadband: Access to Digital Media as a First Amendment Right*, 35 HOFSTRA L. REV. 1519, 1530-43 (2007).

221. For a discussion of the law relating to anonymous and pseudonymous speech, see generally David G. Post, *Pooling Intellectual Capital: Thoughts on Anonymity, Pseudonymity, and Limited Liability in Cyberspace*, 1996 U. CHI. LEGAL F. 139 (proposing reforms to the law in the context of cyberspace); Ken D. Kumayama, Note, *A Right to Pseudonymity*, 51 ARIZ. L. REV. 427 (2009) (same). There is a First Amendment right to speak anonymously. See *Watchtower Bible & Tract Soc'y of N.Y., Inc. v. Vill. of Stratton*, 536 U.S. 150, 165-67 (2002); *Buckley v. Am. Constitutional Law Found., Inc.*, 525 U.S. 182, 199-200 (1999); *McIntyre v. Ohio Elections Comm'n*, 514 U.S. 334, 341-43 (1995); *Talley v.*

is a knowingly false statement of fact. Per the U.S. Supreme Court, “[f]alse statements of fact are particularly valueless; they interfere with the truth-seeking function of the marketplace of ideas, and they cause damage to an individual’s reputation that cannot easily be repaired by counterspeech, however persuasive or effective.”²²²

Some false statements *about* a markholder may be protected speech depending on the circumstances. Under the law of defamation, “public figures . . . may recover for injury to reputation only on clear and convincing proof that the defamatory falsehood was made with knowledge of its falsity or with reckless disregard for the truth.”²²³ When an individual impersonates a markholder on a social network site, however, he or she knows these statements of identity and authorship are false. Moreover, the U.S. Supreme Court has rejected a First Amendment defense in a defamation case involving false attribution of expression to an individual. In *Masson v. New Yorker Magazine, Inc.*,²²⁴ psychoanalyst Jeffrey Masson sued a writer, magazine, and book publisher for libel when the writer made up quotes and attributed them to Masson in a magazine article. The Court noted that reasonable persons would believe the quotations were nearly verbatim reports of statements made by Masson, and thus held the fabricated quotations could

California, 362 U.S. 60, 64-65 (1960). This right, however, is not absolute and may be limited by defamation law and other laws. *See* *Beauharnais v. Illinois*, 343 U.S. 250, 266 (1952); *Chaplinsky v. New Hampshire*, 315 U.S. 568, 572 (1942).

222. *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 52 (1988); *see also* *Gertz v. Robert Welch, Inc.*, 418 U.S. 323, 338, 340 (1974) (“[T]here is no constitutional value in false statements of fact”); *N.Y. Times Co. v. Sullivan*, 376 U.S. 254, 270 (1964) (stating that falsehoods do not materially advance society’s interest in “uninhibited, robust, and wide-open” debate on public issues); *Chaplinsky*, 315 U.S. at 572 (“[S]uch utterances are no essential part of any exposition of ideas, and are of such slight social value as a step to truth that any benefit that may be derived from them is clearly outweighed by the social interest in order and morality.”).

223. *Gertz*, 418 U.S. at 342; *see also* *N.Y. Times*, 376 U.S. at 279-80 (“[Plaintiff must] prove[] that the statement was made with ‘actual malice’—that is, with knowledge that it was false or with reckless disregard of whether it was false or not.”). The test is whether there is “sufficient evidence to permit the conclusion that the defendant in fact entertained serious doubts as to the truth of his publication.” *St. Amant v. Thompson*, 390 U.S. 727, 731 (1968).

224. 501 U.S. 496, 499-508 (1991).

“giv[e] rise to a conceivable claim of defamation.”²²⁵ If the First Amendment does not prevent a plaintiff from pursuing a defamation claim based on a false attribution of expression in such circumstances, courts may also find it is constitutional to allow a markholder to pursue a trademark infringement claim when reasonable persons are confused by a third party’s use of a mark to impersonate a markholder on a social network site.

Some courts have refused to recognize a First Amendment right to use another’s mark to cause confusion about the source of the third party’s expression. For example, in *SMJ Group, Inc. v. 417 Lafayette Restaurant LLC*, the Southern District of New York held that defendants’ use of plaintiffs’ logo as a source identifier on the front of leaflets was not protected by the First Amendment.²²⁶ According to the court, “[t]he First Amendment protects an individual’s right to speak out against a markholder, but it does not permit an individual to suggest that the markholder is the one speaking.”²²⁷ However, the court declined plaintiffs’ request for a preliminary injunction for a variety of reasons, including the fact that there was no proof of irreparable harm, no risk of actual or lingering confusion once the contents of the leaflet were examined, and a concern that an injunction would be a prior restraint of speech.²²⁸ In *Coca-Cola*

225. *Id.* at 510-14, 519. In the *Hustler v. Falwell* libel dispute, there was a similar focus on whether the defendant’s false statements about the plaintiff were “reasonably believable.” See *Hustler*, 485 U.S. at 57 (accepting the jury’s finding that the *Hustler* ad parody about Falwell was not “reasonably believable” and could not “reasonably be understood as describing actual facts about [Falwell] or actual events in which [he] participated”). In *Masson*, the Court explained that “[a] fabricated quotation may injure reputation in at least two senses, either giving rise to a conceivable claim of defamation. First, the quotation might injure because it attributes an untrue factual assertion to the speaker. An example would be a fabricated quotation of a public official admitting he had been convicted of a serious crime when in fact he had not. [¶] Second, regardless of the truth or falsity of the factual matters asserted within the quoted statement, the attribution may result in injury to reputation because the manner of expression or even the fact that the statement was made indicates a negative personal trait or an attitude the speaker does not hold.” *Masson*, 501 U.S. at 511.

226. 439 F. Supp. 2d 281, 285-86, 291 (S.D.N.Y. 2006).

227. *Id.* at 291.

228. *Id.* at 293-95.

Company v. Purdy, the defendant Purdy “linked the domain names my-washingtonpost.com and drinkcoke.org to a website displaying what appeared to be a front page originating from washingtonpost.com” and included a headline that said “The Washington Post proclaims Abortion is Murder.”²²⁹ According to the Eighth Circuit, “Purdy has the right to express his message over the Internet,” but “he has not shown that the First Amendment protects his appropriation of plaintiffs’ marks in order to spread his protest message by confusing Internet users into thinking that they are entering one of the plaintiffs’ websites.”²³⁰

Impersonating a markholder may be an effective way to attract attention to expression on a social network site, but this use of the mark may not be protected speech if it causes ordinary consumers to be confused about the source of the expression. Courts may find that knowingly false statements of identity and authorship are only entitled to First Amendment protection if reasonable persons would not believe the statements to be truthful, such as a clear parody impersonation of a markholder.²³¹ The First Amendment is implicated when trademark laws regulate protected expression, but trademark laws are still constitutional if a categorical exception applies to that speech or the law satisfies constitutional scrutiny.²³²

III. PROPOSAL TO FOCUS THE INFRINGEMENT ANALYSIS ON IMPERSONATION WHEN MARKS ARE USED IN NONCOMMERCIAL EXPRESSION ON SOCIAL NETWORK SITES

When usernames and account names on social network sites become the identity of the person who posts content to the site, these names generally communicate more information about the source of expression than Internet domain names for websites or the titles of traditional artistic or literary works. If a third party incorporates the trademark of another into a username or account name and impersonates the markholder, this may cause consumers to

229. 382 F.3d 774, 779 (8th Cir. 2004) (internal quotations omitted).

230. *Id.* at 787-88.

231. *Cf. Masson*, 501 U.S. at 512-13, 519; *Hustler*, 485 U.S. at 57.

232. Ramsey, *Increasing Scrutiny*, *supra* note 32, at 389, 421-47.

become confused regarding the author of the expression posted by that user on the social network site. Reasonable persons may think it is the markholder's representative, not some random individual, who is communicating with them. At the same time, many unauthorized uses of trademarks on these sites will not cause any consumer confusion. If social network sites respond to complaints of infringement by automatically removing all allegedly infringing uses of marks to protect themselves from contributory liability, this will stifle the free flow of information and ideas on these sites.

Markholders may not complain when a social network site user mentions in a post on Facebook or a tweet on Twitter that she spilled Coke on her new dress, bought Exxon stock, or thought her brother's new girlfriend reminded her of Barbie. Yet they may object to the use of their marks in the username, account name, or the content of a social network site page that parodies, criticizes, or otherwise comments on the markholder. Popular brands may want to prevent competitors from using their marks in comparative advertising about the cost or quality of competing products. Some brands may want to control all uses of their marks in expression on social network sites. A social network site may have a difficult time deciding what to do if, for example, a markholder demanded removal of posts similar to the following tweets by Coca-Cola on its Twitter account in March 2009 that included the Pepsi and Mentos marks with links to articles on the Internet: (1) "Rum and pepsi just isn't right"; (2) "Drink of choice for Obama administration? COKE—not pepsi!"; and (3) "Coke Geyser—Diet Coke+Mentos=ERUPTION!"²³³

233. Coca-Cola on Twitter, <http://twitter.com/cocacolaco> (Mar. 23, 2009, 08:18) (posting "Rum and pepsi just isn't right" and including a link to an article about the fact that Atlanta airline Delta is considering serving Pepsi products in addition to Coke on its flights); Coca-Cola on Twitter, <http://twitter.com/cocacolaco> (Mar. 12, 2009, 12:29) (posting "Drink of Choice for Obama Administration? COKE—not pepsi!" and including a link to a news article reporting that several senior level officials in the Administration are "committed cola drinkers"); Coca-Cola on Twitter, <http://twitter.com/cocacolaco> (Mar. 9, 2009, 16:46) (posting "Coke Geyser—Diet Coke+Mentos=ERUPTION!" and including a link to a related Wikipedia article). Note that these posts were to an old Coca-Cola Twitter account located at <http://twitter.com/cocacolaco>, which was closed on July 31, 2009 and moved to a new account located at <http://twitter.com/cocacola>. See Coca-Cola on Twitter,

If a markholder files a complaint with a social network site that has a notice-and-takedown procedure and alleges that a user has engaged in trademark infringement, will that site permit such expressive uses of the trademarks of others, or remove this content and/or terminate the accounts of users who are the subject of such complaints? Social network sites should balance free speech and trademark interests when they decide whether to allow or remove the allegedly infringing material. They will have to predict how courts will apply trademark infringement and free speech law to certain unauthorized uses of trademarks on these sites. This will be difficult under current law.

As discussed in Part II, most courts will likely find the mark is used “in commerce” in a trademark dispute if the social network site is accessible on the Internet. If the accused infringer is not using the mark to advertise or sell goods or services, however, some courts may decline to find infringement because there is no “use in commerce” of the mark, as that phrase is defined in 15 U.S.C. § 1127. For the use in connection with goods, services, or commercial activities element of an infringement claim, it is unclear whether courts will conclude that dissemination of expression is a service, or hold that free speech interests are better served by a narrow interpretation of the term “services.” In some circuits, courts may also protect the free flow of information and ideas by requiring commercial and/or trademark use of the mark for infringement liability. Other courts may decline to adopt one or more these threshold requirements, and focus on whether this expressive use of the mark is likely to cause confusion or qualifies as a fair use of the mark.

When third parties use marks without authorization but do not advertise or sell goods or services, free speech interests will be better protected if courts and social network sites determine that those users are not providing information services, or conclude there is a threshold use in commerce, commercial use, or trademark use requirement that is not satisfied. These bright-line rules would make it easier for trial courts to dispose of frivolous, speech-harmful trademark infringement claims on motions to dismiss or summary judgment. Such rules will also provide better

<http://twitter.com/cocacolaco> (July 25, 2009, 17:51) (“We will be closing this account on July 31—please follow us over at our new location”).

guidance to social network sites trying to determine whether to remove allegedly infringing content. Yet such categorical speech-protective rules may permit certain uses of trademarks that are harmful to the public and markholders, including use of another's mark to impersonate a markholder and cause confusion about the source of expression.

Protection of trademarks against such confusion can reduce consumer search costs.²³⁴ Markholders use trademarks as statements of identity and authorship, and the marks enable us to quickly and easily identify and distinguish among different types of expression competing for our attention. Just as consumers rely on marks to indicate the source or quality of shoes or travel services, they may rely on usernames, account names, or headings in the content of a social network site page to communicate information about the identity of the author of expression on the site.²³⁵ A person who encounters multiple social network site pages for a particular markholder may find it difficult to find the "real" or "official" site when they search for it.²³⁶

If the content of a social network site page suggests it is authored by the markholder, users will be required to engage in additional research to determine if the expression

234. The standard economic arguments for protecting trademarks include the benefit of reduced consumer search costs and the creation of incentives for markholders to maintain and improve product quality. *See* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995); *Ty Inc. v. Perryman*, 306 F.3d 509, 510 (7th Cir. 2002); WILLIAM M. LANDES & RICHARD A. POSNER, *THE ECONOMIC STRUCTURE OF INTELLECTUAL PROPERTY LAW* 168, 173 (2003); Robert G. Bone, *Enforcement Costs and Trademark Puzzles*, 90 VA. L. REV. 2099, 2101, 2105-08 (2004).

235. *Cf. Rogers v. Grimaldi*, 875 F.2d 994, 997-98 (2d Cir. 1989) ("The purchaser of a book, like the purchaser of a can of peas, has a right not to be misled as to the source of the product."); Heymann, *Birth of the Authonym*, *supra* note 35, at 1382-83 ("[T]he values that trademark law promotes . . . are equally valid goals when the 'customer' shops in the marketplace of ideas."). Professor Heymann suggests an infringement-like action should be available to an author when a third party brands a piece of writing with the name of a well-known author who is not in fact its source. Heymann, *Birth of the Authonym*, *supra* note 35, at 1433.

236. *See* Lee, *supra* note 1, at B2 ("Put Nike in the search Twitter box and it returns 175 results, with none of them clearly the global sporting brand's official account.").

is truly written by the markholder's representatives, and not an imposter. On the other hand, the content of the page can also reduce or eliminate confusion about its source. As discussed previously, the nature of the content (parody, satire, criticism, or other commentary), a prominent disclaimer, or words like "fake" or "parody" can indicate the markholder is not the author of this expression. Even if the third party is pretending to be the markholder, the content of the expression may be so outrageous or different than past communications of the markholder that reasonable persons are unlikely to think it is actually written by the markholder's representatives. While consumers of information should be able to use trademarks to identify and distinguish among competing sources of expression on social network sites, courts and social network sites should not deem a certain use of a mark to be infringing without considering the content of the information disseminated under that mark and how that content is understood by reasonable consumers of information on these sites.²³⁷

To protect both trademark and free speech interests, this Article proposes that infringement law should apply to the unauthorized use of a mark on a social network site that is likely to cause confusion about the source of expression unrelated to the advertising or sale of goods or services, but only where (1) the mark is used to impersonate the markholder and falsely suggest the markholder is the author of the third party's expression, (2) reasonable people believe the imposter's false statements of identity and authorship, and (3) the content of the social network site page does not dispel the confusion regarding the source of

237. Cf. *Masson v. New Yorker Magazine, Inc.*, 501 U.S. 496, 512-13, 519 (1991) (finding a reasonable reader would believe the false statement of attribution); *Hustler Magazine, Inc. v. Falwell*, 485 U.S. 46, 57 (1988) (accepting the jury's finding that the ad parody was not reasonably believable); *Lamparello v. Falwell*, 420 F.3d 309, 318 (4th Cir. 2005) (holding that courts must look at the underlying content of the website linked to an allegedly infringing domain name); *Int'l Ass'n of Machinists & Aerospace Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 201-02, 205-07 (1st Cir. 1996) (finding no infringement because employees would know the employer, not the union, was the author of the expression after reviewing the content of the fake documents bearing the union's marks), *discussed in* *United We Stand Am., Inc. v. United We Stand, Am. N.Y., Inc.*, 128 F.3d 86, 93 n.3 (2d Cir. 1997) (noting the fact that the content dispelled confusion regarding source in the *International* case is critical to the decision).

the expression.²³⁸ Courts would apply this three-part test only after they determined that the markholder had met all of the threshold requirements for a prima facie infringement claim *and* established this unauthorized use of the mark is likely to cause confusion regarding the source of the expression. If the third party is not advertising or selling any goods or services on the social network site *and* consumers are only confused about whether the markholder authorized this use of its mark or is affiliated with or sponsors the third party's expression, this expressive use of the mark should be outside of the scope of the trademark infringement laws.

This test attempts to balance trademark and free speech interests in different ways. It allows markholders to protect themselves against impersonation on social network sites and prevent confusion about the source of expression falsely attributed to the markholder. Yet it does not allow markholders to use trademark infringement law to suppress unauthorized uses of their marks that only cause confusion about whether the markholder consented to this use.²³⁹ Unlike this latter type of confusion, consumer confusion about the source of expression can cause real harm to the public and markholders if the public relies on false or misleading information provided by the imposter. Under the test, use of another's mark solely to attract the attention of social network site users should not alone justify a finding

238. Focusing on whether a reasonable person would be confused by the content of a fake account may currently be the approach used by some social network sites in deciding whether to remove the allegedly infringing content. *See, e.g., Marie Price, Is Your Trademark in Jeopardy?*, J. REC., June 16, 2009, at B1 ("Twitter . . . allows users to establish 'parody' impersonation accounts. 'They use a standard of, if an ordinary person would look at that and know the account is a joke account, Twitter will allow it[.]'" (quoting McAfee & Taft attorney Ryan Lobato). Although it may be difficult to determine the characteristics of the "reasonable person" in trademark law, courts already make this determination when they conduct the likelihood of confusion analysis. *See, e.g., Laura A. Heymann, The Reasonable Person in Trademark Law*, 52 ST. LOUIS U. L.J. 781 (2008).

239. Some courts have found infringement where the main type of confusion was about whether the markholder consented to this use of its mark in the expression. *See, e.g., Anheuser-Busch, Inc. v. Balducci Publ'ns*, 28 F.3d 769, 772-73 (8th Cir. 1994); *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 398 (8th Cir. 1987); *Dallas Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 202-03 (2d Cir. 1979).

of infringement if there is no impersonation of the markholder. Some free riding on the goodwill in the marks of popular brands may benefit consumers if the mark is used to convey information or ideas. Unauthorized use of a competitor's mark in expression on a social network site would still be actionable under this proposal if it causes a likelihood of confusion and affects purchasing decisions, yet the lack of similarity of the parties' goods or services or the noncommercial nature of the expression would not prevent a finding of infringement.²⁴⁰

Free speech advocates may complain that this test does not sufficiently protect speech interests. It is true that less speech will be chilled or suppressed on social network sites if there is a categorical free speech right to use trademarks in noncommercial expression to convey information or ideas. Such a rule would make it easier for commentators and pranksters to predict, and for courts and social network sites to decide, whether a particular use of a mark is protected speech or an infringing impersonation.

Yet there are good policy reasons not to adopt such a rigid threshold commercial use requirement that would apply in every trademark dispute. As discussed in Part I, consumers of noncommercial expression on social network sites can be harmed in various ways by a confusing impersonation of a markholder. This unauthorized use of the mark may cause members of the public to stop buying the markholder's goods or services, sell their stock, forgo employment or partnerships with the company, or send photos and personal contact information to an imposter, among other things. Trademark infringement law should protect consumers from the harm caused by the confusing use of marks to falsely designate the source of noncommercial expression. Congress and the courts could prevent such harms and protect speech interests by instead adopting an exemption from liability for nontrademark uses of a mark in noncommercial expression.²⁴¹ Regardless of whether such an exemption is adopted, this Article proposes that noncommercial use of a mark in expression on a social

240. Professor McKenna suggests that courts should treat the similarity of the goods as a threshold issue in infringement actions. Mark P. McKenna, *Testing Modern Trademark Law's Theory of Harm*, 95 IOWA L. REV. 63, 115-16 (2009).

241. Ramsey, *First Amendment Limitations*, *supra* note 33, at 155-56; Ramsey, *Increasing Scrutiny*, *supra* note 32, at 455-56.

network site can be actionable infringement, but only if the content of the expression causes reasonable persons to be confused about the source of that expression.

Criticism of this proposal may also come from the other side. Some advocates of strong trademark protection may argue this proposal improperly puts a thumb on the scale in favor of free speech interests in trademark disputes involving the unauthorized use of marks in expression on social network sites. As product placement is popular today in artistic and literary works, unauthorized use of a mark in expression on social network sites may cause confusion about whether the markholder gave permission for its mark to be used in this way.²⁴² Even if this is true, the infringement statutes do not require courts to adopt such a maximalist view of trademark rights and prohibit all unauthorized uses of marks that cause some type of confusion. The First Amendment right to freedom of expression requires courts to interpret the trademark infringement statutes narrowly to protect free speech interests.²⁴³ There is no evidence that Congress intended confusion about consent to use a mark in expression to be actionable confusion under trademark infringement law.

Markholders may also say this proposal should be rejected because it is more lenient than the *Rogers* balancing test for uses of marks in artistic or literary works. As discussed above, that test requires the third party's use of the mark to have some "artistic relevance to the underlying work" and not explicitly mislead as to the source or content of the work.²⁴⁴ Courts applying this proposal could permit uses of marks on social network sites that are not "artistically relevant" to the expression or that cause confusion about the content of the work, as the proposal focuses on confusion about the source of expression.

It is true that this proposal is more speech-protective than the *Rogers* balancing test, but it does not tip the balance too far in favor of accused infringers. It is troublesome from a free-speech perspective if courts are determining whether certain expression on a social network

242. Cf. Gulasekaram, *supra* note 174, at 940-41 (discussing the potential arguments of markholders in cases involving artistic and literary works).

243. Ramsey, *Increasing Scrutiny*, *supra* note 32, at 447-53.

244. See *supra* Part II.A.5.b.

site page is “artistically relevant,” as their biases may improperly influence this determination. In addition, any confusion about the content of the social network site page will be dispelled by viewing or reading the expression. Confusion regarding source is potentially more harmful than confusion regarding content because social network site users may still be confused about the source of the expression even after consuming the content on the page. Unless there is a disclaimer or words like “fake” or “parody” in the content, the content may not eliminate the source-confusion caused by this unauthorized use of the mark. For all of these reasons, source confusion should be the main focus of the infringement analysis in cases involving expressive uses of marks on social network sites.

Finally, critics may argue that trademark law does not apply to confusion about the source of expression because the U.S. Supreme Court held in *Dastar Corporation v. Twentieth Century Fox Film Corporation* that trademark law is not concerned with attribution of expression.²⁴⁵ Yet in *Dastar*, the third party used its own name on the markholder’s expression (which was in the public domain and no longer protected by copyright), not the other way around.²⁴⁶ As discussed in Part II, news organizations like The New York Times Company can obtain trademark rights in their marks which are enforceable against imposters who use the mark in connection with the sale of their own expression. Using another’s mark to impersonate a markholder and confuse consumers regarding the source of

245. 539 U.S. 23, 31-32 (2003).

246. The court concluded the phrase “origin of goods” in 15 U.S.C. § 1125(a)(1)(A) refers to “the producer of the tangible product sold in the marketplace, in this case the physical . . . videotape sold by Dastar” and not “the person or entity that originated the ideas or communications that ‘goods’ embody or contain.” *Id.* at 31-32. For an excellent discussion and criticism of the case, see Heymann, *Birth of the Authonym*, *supra* note 35; Laura A. Heymann, *The Trademark/Copyright Divide*, 60 SMU L. REV. 55, 62 (2007) (“[P]ropos[ing]: a recognition of the attribution interest in communicative goods during both the term of copyright and in the public domain, coupled with greater scrutiny of trademark-based claims masquerading as copyright-based ones.”). Some commentators note the Court’s interpretation of the meaning of the statute may be limited to the phrase “origin of goods.” *See, e.g.*, Rick Mortensen, *D.I.Y. After Dastar: Protecting Creators’ Moral Rights Through Creative Lawyering, Individual Contracts and Collectively Bargained Agreements*, 8 VAND. J. ENT. & TECH. L. 335, 342 (2006).

your expression is very different than affixing your own mark to someone else's expression (which may be protected by copyright) and removing their mark, which is what happened in *Dastar*. In the trademark disputes discussed in this Article, the plaintiff's expression is not at issue; the third party, not the markholder, is the author of the expression. For this reason, the analysis and holding in *Dastar* are irrelevant to trademark disputes involving expression created by third parties who use trademarks to impersonate markholders.

Consumers of information often use trademarks to identify the source of expression. Imposters may take advantage of consumers by using marks to impersonate markholders and falsely identify the markholder as the author of their own expression. Trademark infringement law should protect social network site users against information-source confusion if the content does not dispel that confusion for reasonable consumers. At the same time, trademark law should be interpreted narrowly to protect free speech interests when third parties use the marks of others in noncommercial expression, and not in connection with the advertising or sale of goods or services.

Many firms understandably want to control their brand image, but the First Amendment requires them to tolerate some expression by others that incorporates their marks. Filing lawsuits may deter future trademark violations, but it could harm the reputation of the markholder if people think the third party is just poking fun at the markholder or is otherwise engaging in expression protected by the First Amendment. Litigious markholders may risk creating a "Streisand effect," which is "an increasingly common backlash that occurs when someone tries to muzzle information on the Web."²⁴⁷ Named after Barbara Streisand and the response to her efforts to stop the dissemination of information about her in 2003, the Streisand effect "infects the online community in a pandemic of free-speech-fueled defiance, gaining far more attention than it would have had the [intellectual property] owners simply kept quiet."²⁴⁸ Rather than file a lawsuit or complain to the social network

247. Andy Greenberg, *The Streisand Effect*, FORBES.COM, May 11, 2007, http://www.forbes.com/2007/05/10/streisand-digg-web-tech-cx_ag_0511streisand.html.

248. *Id.*

site, markholders should consider tolerating certain unauthorized uses of their marks if the expression is not causing any significant confusion. Markholders may even benefit from social network site pages created for their brands by third parties in this age of user-generated content and word-of-mouth advertising.

CONCLUSION

Courts and social network sites should attempt to balance free speech and trademark interests in infringement disputes involving the unauthorized use of marks in expression on these sites. They may conclude that infringement law simply does not apply where the accused infringer is not advertising or selling any goods or services, the expression is noncommercial, and/or there is no use of the mark to designate the source of expression. Such a categorical approach will protect freedom of expression by allowing certain unauthorized uses of marks in parody, satire, criticism, comparative advertising, news reporting, and other commentary on the social network site.

Yet a case-by-case analysis of the facts of the trademark dispute may be more fair and just when third parties are using marks to impersonate markholders and cause confusion regarding the source of expression on social network sites. False statements of identity and authorship can increase consumer search costs and encourage consumers to rely to their detriment on false or misleading information. Banning third party use of marks to impersonate markholders will not violate the First Amendment if reasonable persons believe the imposter's false statements of identity and authorship after reviewing the content of the social network site page. Trademark infringement law should apply to impersonation of markholders in such circumstances, but it may harm the free flow of information and ideas if it is used outside this context to ban unauthorized uses of marks in noncommercial expression.