

#trademarks - Can you own a hashtag TM (S3E73)

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00:07 Autumn Witt Boyd (AB): Welcome to the Legal Road Map® podcast for online and e-commerce entrepreneurs. I'm your host, lawyer Autumn Witt Boyd. I'm an experienced copyright and trademark lawyer. With my team at the AWB Firm, I leverage, grow, and protect multimillion dollar online businesses. My goal in every episode is to teach you about the sophisticated legal and business strategies to build your own seven- or eight-figure business. If you're a new business owner, go back and listen to episodes 1-12; you'll learn the basics to set up a strong legal foundation. The Legal Road Map® podcast is sponsored by the AWB Firm. You can find show notes for every episode and learn more about how we help our clients achieve their next level goals at awbfirm.com.

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00:52 A(: Hi friends, this is lawyer Autumn Witt Boyd here for our weekly Facebook Live and Legal Road Map® podcast installment. We are continuing our series on trademarks this week with today's episode, which is going to go into hashtags, so we'll call this Hashtag Trademarks, can you register or own or protect or have any rights in a hashtag?

01:14 A(: We have seen, since the rise of social media in the last 10-20 years... It's crazy to think that it has started to be that long, the rise of hashtags. And so I get a lot of questions about if I'm using a hashtag to identify my business, or if I have a catch phrase or something that I use all the time, can I register that as a trademark? And the answer, as it often is, is it depends. So we're gonna dig into what to think about with all of those issues today.

01:42 A(: Before we dive in, I want to remind you, if you haven't already signed up to hear my new master class on the three legal steps every course creator needs to be taking to protect your course legally, please go ahead and do that. Those are gonna be a part of the Online Course Success Summit, and it is going live on February 11th, so this episode is airing on February 11th on the podcast, so everything is going to be live and ready for you to watch. I am one of about 60 speakers in this summit; it is an insane group of people. We've got the likes of... I'm gonna look at my Post-it note, Molly Pittman, Chris Winfield, my friend Reina Pomeroy, and like I said, there's over 60. There's way too many for me to even mention. But I'm the only one talking about legal, so if you have a course already, if you're thinking about building one, if you're trying to scale a course business, this summit is for you, there's gonna be really something for everyone.

02:33 A(: And admission is totally free for the first couple days, but if you want all access for long time, I think a lot of us are gonna have things that maybe don't apply to our business today, but might apply in the future, so you might wanna come back and listen to it later, that is gonna be available for purchase. That link to sign up is on my website, it's awbfirm.com/ocss, and that's the Online Course Success Summit. It's co-sponsored by Thinkific, which is a platform that allows you to host all of your course content, and they have done a phenomenal job with a course education company called Of-Course that helps people put together their courses, putting together just this

incredible roster of speakers. So everything you need to learn about putting together a course from creating the content to marketing to scaling is gonna be part of this summit, so you definitely don't wanna miss that.

03:25 A(: All right, let's dive into hashtags and trademarks. I gonna give my standard disclaimer which is I am a lawyer but I'm not your lawyer, unless we decide to work together one-on-one, so everything that I'm talking about today, please take it as information, it is not meant to be legal advice. If you have a specific question for your particular business, please meet with your own attorney to make sure you get good individual information for your particular question.

03:48 A(: All right, so I'm gonna talk about... Let's see, about four things today as we're going through whether a hashtag can be a trademark. So the first thing I wanna hit on... And if you have listened to other episodes in this series you've heard me talk about this, but I'm gonna reiterate it because it's such an important foundational principle as we're talking about trademarks, and that is what the heck is a trademark, actually? It's really important, it will make the rest of this episode makes sense. So if you've already heard this, you can fast-forward a minute or so, but if this is your first time tuning in, welcome first, and let's talk about what is a trademark.

04:22 A(: So in the United States, a trademark is an indicator of the source of a product or good. So what does that mean? It is meant to help your customers figure out does this product come from Autumn, from where I'm looking to find it, or is it from her competitor, from Ash... I just am making this up, I don't know if there's Ashley who's my competitor. Well, let's say you're in a store, and you're looking for a bottle of Coke. So think about the ways that you know that what you're reaching for on that shelf is actually Coke and not Pepsi. You think about things like the name, obviously Coke and Pepsi are quite different names. You think about the shape of the bottle, so the Coke bottle has a very distinctive shape; that's actually a registered trademark. The label, all of the graphics and designs, those are registered trademarks, so that scripty font that we see with Coca-Cola, that design is a registered trademark. So these are all ways that you know when you open that bottle you know what you're getting, it's going to be what you expect, you know what the quality's gonna be, where it came from. You are getting what you wanted. You don't wanna open your bottle of Coke and find that you have accidentally grabbed a bottle of Pepsi and it is not at all what you wanted. People are very particular about their Coke versus Pepsi, especially here in the South. I live in Chattanooga, which is part of the early history of Coca-Cola.

05:36 A(: So when we think about trademarks, it's helpful to remember that the whole goal of trademarks is to help people, help customers really, make sure that they're getting the right thing. Kind of the secondary benefit, and why companies like to register trademarks, is that it helps the company stop their competitors from basically free-loading on their brand goodwill, on all of the brand awareness that they've built. So Coke doesn't want some other upstart competitor to come up and basically have a very similar packaging and very similar name so that it's sneaky taking customers away from Coke who think they're getting Coke, and then they end up getting this competitor's products. So again, this is the whole reason we have trademark law is really to protect consumers. And then the benefit to the company is they're able to protect and keep their competitive edge.

06:26 A(: So when we think about trademarks as the indicator of the source of a product or service,

when we think about hashtags, they are typically used on social media, so it's an online, it's usually not on a physical product. And we can have trademarks on social media, like the word Facebook is a registered trademark and all of their logos are registered trademarks. So again, similar to my Coke example, when you log in to Facebook you want to make sure you're actually going to Facebook. If there were another company that was allowed to operate with the same name or maybe only one letter different or Facebook but spelled with an A-I instead of just an A-C-E, that would be very confusing, and you could end up in the wrong place on accident, and that's what we don't want for our customers. We don't want them to be confused and accidentally buying things when they think they're getting one and then it's a bait and switch and they end up with another.

07:15 A(: So the ways that we use hashtags are typically very different than the ways that we are using trademarks. So think about the ways that we typically use trademarks. I talked about the Coca-Cola example, but here are a couple of other examples, especially in the online context. So if you, let's say, log on to... I just had to buy ski equipment, my husband's taking my kids skiing for spring break. He was on the Dick's Sporting Goods website buying a bunch of ski stuff, helmets [chuckle] and boots and things. So if you log on to most e-commerce websites, you will see the name of the company or the logo in either the very top header, maybe in the middle or on the far left, that is a very standard way to indicate the store name or the brand name of the place where you're shopping. So you'll start to notice this now as you're browsing around the web, that it's a very common way to indicate the trademark, the brand name of what website you're on is to have it right there on the top and the footer. So when we think of a brand name, if you're on a website that's typically where it's going to go.

08:19 A(: What I often find clients come to me asking to register a trademark, it's maybe not for a brand name, it's not their company name or a product name, but it's more just something they say a lot or it's a key phrase that they've developed for a concept in their business. A lot of this is with coaching, they may have a key sentiment that they talk about a lot, but it's not used as a trademark in the way that the US Patent and Trademark Office would require if you wanted to actually register that. So when I go to look for evidence of how they're using their trademark I have to follow these really specific rules that the USPTO has in their regulations; it has to be actually used as a trademark. And typically when you're using a hashtag, it's going to be in social media posts, it's going to be included in the body of a paragraph, it's not typically going to be on a label for a shirt, [chuckle] so not just across the front of a shirt; that's what we sometimes think of as a decorative use. You may think that that's used as a trademark, it typically isn't.

09:22 A(: Or... I'll show you my cup, if you're watching this on video, you can see I have a branded water cup that I keep at my desk that has our AWB Firm logo on it. That would probably be considered by the trademark office to be merely decorative, so I don't sell water cups, I have just put my logo on a water cup. If I actually were a water cup company, so think about like the YETI brand, then that might be used as a trademark, it's a little bit different. So the same use on the same product may be a trademark use in one instance, and it may not be. But again, all of these things typically we're not seeing with hashtags, so when I'm submitting evidence to the USPTO of how someone is using their trademark, I have to make sure that I'm following these rules or I could get what's called an office action, which is a denial of the trademark application. It means they're not gonna let it through. Usually you get a chance to try again. [chuckle] This is one of the most common mistakes that I see, especially if I have a client who tried to file a trademark registration

application on their own, or if they went through LegalZoom, this is a very common area of making mistakes. Can be fixed sometimes, but when I'm confronted with a hashtag, I usually can't find evidence of it being used in this way.

10:32 A(: So again, the tag on a shirt, not the front of the shirt, use on a product but in a trademark way, so indicating this a brand or a source, so the name of the store, the name of the company or a product, not just a company logo thrown on some merch. These are the kinds of ways that you would have to be using a hashtag in order to actually have trademark rights. And what I typically see is that hashtags are used typically on social media as kind of a search tool. So when you think about if you're at a conference, a lot of times the conference will have a special hashtag and they say, "Tag all your posts with whatever, lawyercon2019." [chuckle] That would be a very boring conference. So that if I wanna see who else is here or what are other people posting about I can type that into the search bar and that's how I can identify. But that's not being used as a trademark, that's just being used as giving people a way to search for posts.

11:31 A(: If I wanted to use a hashtag as a trademark, I would have to be using it in other ways. I'd have to maybe have an ad campaign that used it... Featured it very prominently, had the hashtag maybe in magazine ads or in videos, in some way that's not just as part of a social media post, because one of the other requirements that USPTO has is that your trademark has to stand apart from the other content, especially if it's on a website or if it's on merchandise it would be the same thing. But it needs to be either... There's lots of different ways you can do this, but maybe bolder type or larger font or a different color or some sort of graphic element around it. So again, when you're just putting a hashtag as part of a social media post to identify something that you feel like corresponds, maybe it's an idea or something you identify with.

12:22 A(: For example, in my corner of the internet, I'm involved in a lot of mom entrepreneur groups, and so a lot of people use the hashtag the bossmom or beingboss, which is another client of mine. Rising Tide Society, there are all these very common hashtags that people use to identify that the content they're posting on social media is identified with a movement or with a topic. But those are typically not going to be actually used as trademarks, it's one hashtag in a series of 12 or 15 or 20 hashtags. And that can be very effective for helping people find you on social media, again, if it's used as a search function, but that's typically not going to be used as a trademark. So if you are actually using a hashtag in your business in ways other than just tagging things on social media, then that's possible, and I'll give you a couple examples of things that actually have been registered as trademarks with the USPTO.

13:14 A(: So going back to... Coke's one of my favorite examples 'cause they have an enormous [chuckle] trademark portfolio, so I have lots of examples I can get from them. So they did a campaign that was #smilewithacoke. And so the hashtag was used by people on social media, but they had a whole advertising campaign around it also. So it wasn't just used on social media posts by random people like me, Coke was actually using it as a branding initiative to try and encourage that, and they had other things that they were doing with that hashtag other than just throwing it up on social media on a couple posts. Same thing as McDonald's, McDStories was also a hashtag that they promoted and used in other ways than just including it in with other text on a social media post. Those are two examples.

14:00 A(: Alright, so the last thing I wanna talk about is, kind of some advantages and disadvantages to registering something that you use in your business as a hashtag versus just registering the name, the words, the actual words themselves. And I'll go just very briefly into what kinds of things can you register as a trademark. So most of the time when a client comes to me, it's going to be something involving words, it's either a company name, or a brand name, a slogan, a tag line, maybe it's a logo, but it includes either their brand or company name or a product name. So typically when we're thinking about trademarks, that's most of what we think about is branding, so visual things that include words and maybe visual elements. So it can also be though, as I mentioned, it can be a color, it can be the shape of a bottle, it can be the packaging for a product. It can be all kind... It can be a sound. There's all kinds of things that you can register as a trademark; we're not gonna talk about all that other stuff. But when we're thinking about most trademarks, it's either a logo or a phrase or a group of words.

15:01 A(: So typically you have to make a decision: Are you going to register just the words, which is what we call a wordmark, or a logo, or something with visual elements to it, which we call a design mark, and there's pros and cons to both. Typically I will advise most of my clients, especially if this is their first trademark filing and it's for their main either product or company name, typically we will start by just registering the words. So that gives them some flexibility and they can change their logo. A lot of people go through lots of different branding, especially if they're just getting started and they're trying to figure out what's gonna resonate with their audience, they may try lots of different things, so they make the words the same but they change the visuals. And when you register a design mark with the USPTO, it's kind of frozen in time, so whatever you submit to the USPTO... You have to submit a drawing or a picture, a graphic of your image, that is the thing that gets protected. So if you change it two years later, you would have to go through that whole process again of registering your new design.

16:00 A(: So typically just registering the words is gonna give you more flexibility if you think you might not stick with your logo, and typically the words are really the important thing anyway; that's really what you would just [chuckle] absolutely be crushed if you found a competitor that had a name that was similar to yours. Typically, a logo that's close to yours, especially in online business, which is where I mostly... And most of my clients are operating, people are searching, we're doing word searches on Google, we're not so much being confused by similar logos. It can happen, especially on social media, which is more visual, but typically the wording is gonna be really the critical trademark, not necessarily the design.

16:37 A(: So when you're thinking about do I register with a hashtag or without the hashtag, I want you to think of how you're using it. So a lot of my clients, they may use it as a hashtags sometimes. Let's say it's a key concept that they teach about, a lot of my clients are in the education space, so maybe it's a concept they teach about. But maybe it's also a book title, or maybe it's also the name of a live event that they put on, or a group coaching program, or an online course, so they're using it as a hashtag but also they're using it without the hashtag. So you've gotta consider, if you include that hashtag you're kind of limiting yourself, if you have an infringer there's a chance that if they're not using it with a hashtag they could argue, this is very different, it looks different, there's a whole different sense because hers has a hashtag, or the registered version, has a hashtag, and mine does not have a hashtag or vice versa. So you've gotta think about that, where are you seeing, or where do you think you'll see copycats, and where are you mostly using it, are you using it mostly as a

hashtag on social media in your posts or are you using it mostly without the hashtag?

17:44 A(: Now, we do see examples of this where someone really does have a brand that is tied to a hashtag. So one of my favorite examples of this is the hashtag girlboss, so that's... I'm gonna butcher her last name, [chuckle] Sophia Amoruso, I think is how you say that. And she has primarily used that with the hashtag, but not just on social media, it has become a true brand for her. So I believe she has registered it with hashtag and also without. So if you have lots of resources and money to work with a lawyer and to pay the USPTO filing fees, you could do it both ways, and that would give you a lot of extra protection, but most people are gonna have to choose one or the other.

18:20 A(: And so there are pros and cons to both. I can never make that black and white, and you should always do one or the other. But I will tell you, typically for my clients, registering it without the hashtag is going to give them more bang for their buck. They're typically using it more as a brand without the hashtag, so if you go to their website, and maybe it's the name or course, they don't include the hashtag on their website where they talk about the course, [chuckle] it's just the name of the course, it's not the hashtag. But maybe if one of their students is posting about how great the course is on social media, maybe they would include a hashtag there.

18:55 A(: So a great example of this, one of my clients, Amy Porterfield, has a new course called Digital Marketing Academy, and she does not use a hashtag with that in her marketing, but on social media some of her students have used that hashtag, so it's a great example of the two different ways that it might be used. And if she were gonna register that trademark, she would have to think about, do I wanna protect it as a hashtag or is the real value in just the name of the course and the words without the hashtag? So those are the kinds of things that you have to think about and evaluate.

19:28 A(: The other downside I wanna mention about having a hashtag as your trademark is enforcement. So you may not know this, but when you pay all your money to the USPTO, you get to the end of a year or more of waiting to get your trademark registration certificate. It's a long, arduous process. Basically what you have received is the right to tell other people to stop using your name. So it's kind of like congratulations, now you get to spend more time and money going out and telling people not to do things. So you actually have the requirement of going after people who you find who are using your trademark or who have a similar trademark that they're using with the same products or services as you. And if you don't do this enforcement, if you're not monitoring the marketplace and going after people, you can actually lose your trademark rights, so it's a really important part of having a trademark is actually taking that next step of enforcing your trademark rights.

20:23 A(: And the problem with hashtags is that they go viral, they spread by people using them. And so it's very, very difficult to enforce trademark rights in a hashtag because you're basically telling people to stop doing the thing that hashtags were created to do, which was to allow people to search for lots of things on the same topic. And typically when you see people infringing a hashtag, it's just on social media, it's very hard to track down, and it's hard to do in a way that makes any sense or that you can do efficiently without just kind of beating your head against the wall. So I think there is a big risk when you have a hashtag as your trademark that it's practically unenforceable. It's very, very difficult to go after people if it does the thing that you want it to do,

which is become very widespread.

21:12 A(: If you have a good trade mark, you're gonna... Or if you have a good hashtag, something that's popular, you're gonna find all kinds of other people wanting to hitch their wagon to it because they know people are searching for it. And I think we've seen this happen with Whole30, the nutrition plan. You have all kinds of people now using that hashtag who may or may not have anything to do with the actual Whole30 brand, so that becomes then very tricky. You kind of have no way to control how other people are using your brand name if you are registering it as a hashtag. So that is one downside that I just want to give you a heads up about.

21:44 A(: That is gonna wrap up this episode about hashtags as a trademark. I hope this was helpful. If you have any questions, I encourage you to hop on over to our Legal Road Map Facebook group. It is totally free to enter, just let us know a little bit about you and your business, and we will let you right in. And we've got a bunch of entrepreneurs, and I pop in there once or twice a week as well to answer legal questions. And we've been talking a lot about trademarks lately because that's been the content of the podcast, so it's been kind of top of mind. And I will remind you one more time, if you haven't done it already, please go register so that you can see my free master class at the Online Course Success Summit, that's gonna be the three simple legal steps that you need to take if you are a course creator to protect your course legally. And that's at awbfirm.com/ocss.

22:33 A(: Next week, I'm going to be the second to last installment in our trademark series, we're about to wrap up, and I'm going to be talking about what you can do if you find out that someone else has registered your trademark. So let's say you are ready to register your own trademark, you do a search of the USPTO records, and you find, horror of horrors, [chuckle] that someone else has already either filed an application or actually gotten a trademark certificate for your trademark. It is very upsetting, but there are some things that you can do. So we're gonna go through some of those steps that you can take next week. I hope you will join me then.

[music]

23:10 A(: Did you know that you could be making more money from your copyrights and trademarks? Intellectual property is probably the most valuable asset in your creative business, but most entrepreneurs don't know how to identify it, and you can't monetize what you can't find. Download my free five-minute IP Audit Worksheet at awbfirm.com/podcast. You'll find out what parts of your brand, logo, images, website, courses, digital downloads, or other content could be protected by intellectual property laws, and you'll create an inventory of your most valuable trademarks, copyrights, patents, or trade secrets, so you'll know what's worth protecting as you build a more profitable and sustainable business. Get your five-minute IP Audit Worksheet now at awbfirm.com/podcast.

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