

Killing the trademark joke

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Today's trademark article is from *Slate*, entitled Facebook now believes it owns the English language too¹. Final sentence of the article: "According to a database search of the United States Patent and Trademark Office, Facebook also holds a trademark on the word 'like.' " [Thanks, Ms SK of Washington, Columbia.] In the back catalog, there's the one where the University of Texas sent a cease-and-desist for a program's use of the word Texas²; or the time when McDonald's C&D'ed a Special Olympics fundraiser organized by a 19-year old named McClusky³ (though McDonald's has lost a couple abroad⁴); or the thing about yoga moves that some thought was about patents or copyright, but was really just a trademark issue over the use of the name Bikram⁵, which is attached to a yoga mogul who explains—and this can't be repeated enough—"I have balls like atom bombs, two of them, 100 megatons each. Nobody fucks with me."

Sorry, but I've gotta kill the joke here. Facebook, UT, and even (to the extent that he is capable) Bikram is being entirely rational, and the USPTO is not doing anything very interesting here.

Trademark is supremely simple, especially when compared to the entirely distinct problems of patents and copyrights. The question underlying a claim of a trademark violation is this: *will it create confusion in the marketplace?*

If I create a product named Acebook, it's pretty clear that I'm referring to Facebook in some way; add in a bluish color scheme and some blocky design and I could get something that really could drive viewers to think that this is somehow related to Facebook, maybe a spinoff or such. Lest you think this is hypothetical, go check that site now—you'll be redirected to a 'survey' that really does use Facebook-type graphics as an attempt to mislead you into providing your personal info.

So at its core, trademark is based on the entirely reasonable, entirely un-funny desire to prevent companies from misleading consumers by implying that its products are associated with, endorsed by, or produced by some other company. [I'm not even touching dilution today.]

¹<http://www.slate.com/blogs/blogs/scocca/archive/2010/08/26/facebook-now-believes-it-owns-the-english-language-too.aspx>

²<http://www.techdirt.com/articles/20100216/1034448184.shtml>

³http://www.naturalnews.com/028891_McDonalds_trademarks.html

⁴http://mccurryrecipe.com/index.php?option=com_content&view=article&id=100&Itemid=204

⁵http://www.dnaindia.com/lifestyle/report_saving-yoga-from-copyright-mongers_1411206

This is really fair enough, but then hazy questions crop up, and the lawyers come in. The first to file the trademark gets to put ®s everywhere, but what if a later company becomes better recognized? What if a party failed to register with the US government; do they have any recourse when somebody dishonestly uses their insignia? Can these things be revoked if they turn out to be too broad? Who decides on the breadth to begin with?

The really big question in that offhand list is breadth. Every trademark must have a context: to give a common example, there is no confusion at all between Domino's Pizza and IBM's Domino email system and toy manufacturers who sell games named dominos. If you as a consumer are confused into thinking that the Domino email server is from the pizza company, the USPTO officially rules that it's on you, and they set the breadth of the pizza chain's trademark accordingly. But if somebody sold Domino's pasta, maybe it would confuse a few buyers, and Domino's may have more of a case.

Monster cable. They have a trademark on the name Monster in the context of audio and computer cables. So they might have a reasonable case if they send a cease & desist missive to Monster Cellular store⁶, which seems to exist only as an eBay storefront.

But when they file over 100 trademark complaints⁷ against folks who use product names like Monster Truck Nationals!, Creative Monster Productions, Junk Food Monster, Monster Mini Golf, Mr. Sea Monster, Monster Baby, Boobie Monster, Monster Ballad Tour, and Monster Pup, things start to seem a bit detached from reality.

[Now that you hate them, go read this live-blogging of a Monster press conference⁸ (OK, maybe skim the middle part).]

So when the Obama campaign uses *Yes, we can!*, the English translation of Cesar Chavez's *¡Si se puede!*, and gets sued by the National Canning Center⁹ for trademark infringement, you can rest assured that the contexts don't match even though the words do. Anyway, The United Farm Workers has defended *Si se puede* as their trademark, preventing its use by AeroMexico¹⁰.

Yes Facebook, Inc, really does have a trademark on the word *like*—in fourteen different contexts, in fact. A trademark in the narrow context of voting on inane comments from acquaintances that you don't really want to say anything to would be appropriate, and would only be enforceable in the case of other social networking sites that somehow couldn't come up with a synonym for the word *like*. Valley girls would be unaffected.

Before I got sick of reading all 14 contexts (the trademark search engine is one of those sites that imposes a really short timeout on your session, for no apparent reason) I had already amassed a pretty broad list of contexts in which the word is trademarked by Facebook:

Social introduction, networking and dating services; . . . self-improvement,

⁶<http://stores.ebay.com/Monster-Cellular-Store>

⁷<http://ttabvue.uspto.gov/ttabvue/v?qt=adv&procstatus=All&pno=&propno=&qs=&propnameop=&propname=&pop=&pn=monster+cable&pop2=&pn2=&cop=&cn=>

⁸<http://gadgets.boingboing.net/2009/01/07/ces-this-liveblog-ma.html>

⁹<http://www.politickernj.com/joey-novick/24687/yes-we-can-obama-campaign-sued-trademark-infringem>

¹⁰http://www.ufw.org/_board.php?mode=view&b_code=news_press&b_no=185&page=16&field=&key=&n=53

self-fulfillment, charitable, philanthropic, volunteer, public and community services, and humanitarian activities.

Computer services, namely, creating virtual communities for registered users to organize groups and events, participate in discussions, and engage in social, business and community networking; hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions . . . hosting computer software applications of others; . . . software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; . . . a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple websites; . . . Providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks; . . . non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; . . . customized web pages featuring user-defined or specified information, personal profiles, audio, video, photographic images, text, graphics and data. . .

I cut heavily, because this goes on, for a long time. Effectively, Facebook did get the USPTO to grant them a trademark on the word *like* for the use of any marker on the web. Valley girls are still, like, exempt, because there's no confusion created and no implied endorsement by Facebook when somebody has that vocal tic. But if you're an online service provider and you have a button labeled *like*, you're at risk. We don't have Facebook to blame for having the audacity to make such broad claims; we have the Trademark Office to blame for not rejecting those claims and granting Facebook only a more narrow context in which their trademark holds.

This is another one of those corners of law where the only ones who know about it and the only ones who bother to lobby the three branches of government about it are the ones who stand to profit from its expansion. The rest of us are satisfied with humorous but indignant articles.

Abandonment There are a few ways in which you could abandon your trademark. The most sensible is that if you haven't used the trademark for a few years, then it's not yours anymore—you can't just save it for later.

Google's lawyers have a stupendously cute post about Google as a verb¹¹. In it, they basically explain if the name Google becomes a generic kleenex/thermos/xerox sort of term, then it becomes an unenforceable (and therefore basically annulled) trademark. So, they ask that you please not do that. I expect that they're asking nicely because they realize that you can't stop becoming a generic term. By definition, it involves a few million parties making frequent, small uses of a name, which is not a situation you can

¹¹<http://googleblog.blogspot.com/2006/10/do-you-google.html>

litigate your way out of—not without winding up with a whole lot of megacorp versus the virtuous little guy¹² articles being written about you.

If you don't stop others when they use your trademark, then it is also considered to be abandoned. This creates the perverse problem that lawyers feel that they are compelled to sue every time they perceive something that may be a trademark violation, which in turn leads to that large class of articles about Goliaths suing li'l Davids for their choice of name or the color of their logo.

Starbucks has a legal department that loves to do this, suing a two-shop operation in Michigan with a circular green logo¹³, a shop owned by Ms Sam Buck¹⁴, the doubleshot coffee company¹⁵, and everybody else¹⁶. It doesn't have to be this way: if Etsy.com, a site where folks sell their handmade goods, finds you using their name or logo on your hand-made product, then they will make you fill out a trademark permission application¹⁷ and then grant you permission to use their trademark. Policing requirements fulfilled, nobody sued.

I just went over three abandonment means—non-use, genericization, and failure to police—as if they're on equal legal ground, but they're not. The abandonment of a trademark due to failure to defend is basically a judicially-created rule which, unlike the other two, is not in the definition of an abandoned mark in 15 USC 22 (III) §1127¹⁸. Some folks in the past lost their trademark suit against a violator because a court had ruled that, because they'd failed to adequately police their trademark in the past, they had implicitly abandoned it, so the current violators got off. Later lawyers learned the lesson that they need to remain vigilant at all times against small and insignificant violations, lest the past slide be brought up as evidence when a serious violation comes up. And so, a law is born. Past judges led us to this position, but future judges could get us out by rejecting the failure-to-vigorously-police defense.

I don't question that the judges who arrived at this law did so via sound legal reasoning. But as a matter of public policy, they've created a monst—they've created a beast, because lawyers absolutely delight in the thought of being required to sue, obligated to threaten to sue, and otherwise mandated to accrue billable hours. Further, the Trademark Office gave them the power to do so, because it does not have the political will to set its policies to push for narrower breadth, leaving us with the sort of overbroad mess that is Facebook's *like* trademark—which Facebook's lawyers will now explain that they are obligated to aggressively defend. All of which is how a law that is really sensible at its core, with a credo of preventing confusion in the marketplace, became a lawyer-driven machine whose credo is that it shall convict a hundred innocent logos before it lets one guilty logo walk free.

¹²<http://www.foxnews.com/us/2010/08/17/best-buy-takes-priest-copyright-violation-god-squad-mobile/>

¹³<http://consumerist.com/2007/11/starbucks-to-sue-small-michigan-coffee-shop-for-trademark-infring.html>

¹⁴<http://abcnews.go.com/2020/GiveMeABreak/story?id=1390867>

¹⁵<http://blog.doubleshotcoffee.com/2006/04/coffee.html>

¹⁶http://internationaltrade.suite101.com/article.cfm/starbucks_fights_copycats

¹⁷<http://www.etsy.com/storque/how-to/etsy-trademark-permissions-program-this-aint-no-cess-and-de>

¹⁸http://www.law.cornell.edu/uscode/uscode15/uscode15_usc_sec_15_0001127-----000-.html