



Intellectual Property
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Sandra Eke

WHY YOU NEED TO PROTECT YOUR BUSINESS HASHTAGS AND CATCHPHRASES¹

1. INTRODUCTION

Whilst most business owners in Nigeria are familiar with the need to trademark business signs, logos, designs and symbols; it is not so apparent that they can also protect their business *hashtags* and *catchphrases*. Social media channels have proven to be a very vital tool for brand owners.² In the 10 years since the hashtag (#) emerged as an online marketing tool, interest in registering hashtags or catchphrase trademarks has taken off globally.³

Hashtags and catchphrases allow consumers to connect with and engage other social media users based on a common interest, theme, or topic. Social media has become a popular means for stimulating interest in and eliciting reactions to any imaginable event, product or service. They are built around a culture of sharing and openness, and “real-time” marketing. While these tools have become a normal feature of the digital landscape, the sharing culture on which they depend can present some conceptual challenges.

¹ Sandra Eke, NYSC Associate, Corporate Finance & Capital Market, SPA Ajibade & Co., Lagos, NIGERIA.

² Claire Jones, “Hashtag trademarks: what can be protected?” available at: https://www.wipo.int/wipo_magazine/en/2017/05/article_0009.html, accessed 17th April 2019.

³ Ibid.

2. WHAT IS A HASHTAG OR CATCHPHRASE?

A *hashtag* is defined as a word or phrase prefixed by the symbol ‘#’ that classifies or categorizes the accompanying text.⁴ However, a hashtag is more than the mere addition of a symbol to common discourse; a hashtag is a type of metadata.

A *Catchphrase* on the other hand, is a phrase that is often emphasised and repeated by business owners and therefore becomes connected with a particular organization or person, especially someone famous such as a television entertainer.⁵ It is a well-known motto, phrase, slogan, quote or watchword that is associated with a particular famous person or enterprise.

Both a hashtag and a catchphrase can be protected by intellectual property rights, usually by registering them as trademarks.

3. BRANDING HASHTAGS & CATCHPHRASES VIA TRADEMARK PROTECTION

It is important to note that your business hashtags or catchphrases are all part of an individual’s or organisation’s branding. While your brand represents your reputation and business in the public eye, a trademark legally protects those visually perceptible aspects of your brand that are unique to your company.⁶ The word “Trademark” and “brand” are commonly used interchangeably, however this is a mistake as they have very important differences.

In its simplest form, your brand is your image. It is what the public sees and thinks about your company. A trademark is a specific aspect of your brand which enjoys legal protection.⁷ Just the same way a brand helps to identify the company and its products or services; a registered trademark helps to prevent competitors from stealing the brand image or creating substantially similar identities that result in marketplace confusion.⁸

4. TRADEMARKING OF HASHTAGS AND CATCHPHRASES

A trademark is a sign that is capable of distinguishing the goods and services of one company from those of another. A word or a combination of words, letters, and numerals can constitute a trademark. Trademarks may also consist of drawings,

⁴ Jason O. Gilbert, “Selfie,’ ‘Tweet,’ and ‘Hashtag’ Added to Merriam Webster Dictionary, YAHOO TECH” (May 19, 2014), available at: <https://www.yahoo.com/tech/selfie-tweep-and-hashtag-added-to86215489849.html>, accessed 22nd April 2019.

⁵ Cambridge dictionary, available at: <https://dictionary.cambridge.org/dictionary/english/catchphrase>, accessed 22nd April 2019.

⁶ Upcounsel, “Trademark vs. Brand: Everything You Need to Know” available at: <https://www.upcounsel.com/trademark-vs-brand>, accessed 20th April 2019.

⁷ Ibid.

⁸ Ibid.

symbols, three-dimensional features such as the shape and packaging of goods, non-visible signs such as sounds or fragrances, or colour shades used as distinguishing features – the possibilities are almost limitless. It allows consumers to identify the source of a product or service. A hashtag (#) on the other hand is a generic symbol with no source-identifying significance, used in conjunction with a product name or campaign catchphrase.⁹ It may also function in the same way as a trademark and be registered as such.¹⁰

A hashtag or catchphrase is a strong interest stimulant to an event, product or service. It should be noted that despite the fact that its use can boost brand recognition and increase business sales, it does not automatically make the brand name a registerable trademark.¹¹

It is important to note that the types of goods or services identified directly affects whether the hashtag is protectable. The hashtag should not be used generically to identify a product or service. For instance, using the hashtag “#coffee” for a coffee shop does not identify the source of the coffee but merely identifies the relevant product class. On the other hand, “#Starbucks” signifies a specific source of coffee.¹² In the same vein, just because a company uses a hashtag for its brand advertisement on social media platforms doesn’t automatically warrant a trademark protection.¹³ The hashtag must be used like any other trademark as a source identifier to a product or service.

5. THE RIGHTS CONFERRED BY TRADEMARK REGISTRATION

Trademark registration confers a legal right to the use of a registered trademark to the exclusion of any other person or entity. This implies that the trademark can be exclusively used by its owner, or licensed to another party for use in return for payment. Registration provides legal certainty and reinforces the position of the right holder, for example, in case of litigation.¹⁴

Trademarking a hashtag or catchphrase doesn’t mean that other social media users won’t be able to use it on social media platforms. It should be noted that others may use the Twitter hashtag, and a trademark may not give you a cause of action if

⁹ Claire Jones, “Hashtag trademarks: what can be protected?” available at: https://www.wipo.int/wipo_magazine/en/2017/05/article_0009.html, accessed 17th April 2019

¹⁰ Ibid

¹¹ Ibid

¹² Daliah Saper, “Are Hashtags Intellectual Property?” available at: <https://www.business.com/articles/are-hashtags-intellectual-property/> accessed 17th April 2019.

¹³ Ibid

¹⁴ World Intellectual property Organisation (WIPO), “what rights does trademark registration provide?” <https://www.wipo.int/trademarks/en/> accessed 18th April 2019.

someone uses it in a way that you disagree with. Trademark protection serves to prevent companies and service providers within the same industry from using your hashtag to compete with you or commercially benefiting from it. While Twitter responds to trademark violations, they only do so when one party is using another party's trademark to mislead consumers.¹⁵

6. SOME INSTANCES OF HASHTAGS AND CATCHPHRASES REGISTERED AS TRADEMARKS ACROSS DIFFERENT JURISDICTIONS

Large companies in the United States have taken to registration of their branded twitter hashtags as trademarks. For example, Coca-Cola specifically registered **#cokecanpics**, **#smilewithacoke** and the slogan **"Coke is it!"** Similarly other companies like McDonald's trademarked **#McDstories** and **#makeitcount** by Nike. In 2016, Pepsi embarked on a campaign around a trademarked hashtag **#sayitwithpepsi**, and Walt Disney similarly registered a trademark for the phrase **"Hakuna Matata"** for their merchandise.

In the United Kingdom, a large cheese producer, Wyke Farms became the first to successfully trademark its branded hashtag **#freecheeseFriday** for a campaign on social media. To achieve this successfully, the cheese company had to show evidence of distinctive use acquired by the mark overtime.¹⁶ This helps us understand that the use of hashtags on social media channels can help in proving acquired distinctiveness. It reflects the readiness of the UK IP Office to accept social media usage as evidence of acquired distinctiveness.¹⁷

In Nigeria, sometime in Dec 2013, the Trade Marks Registry published an application by Ajojib JV Limited, under class 41, for the trademark of a popular controversial catchphrase **"My Oga at the Top"** in the Trademarks, Patents and design Journal Vol. 3 No. 1 of December 2013. More recently, a Nigerian betting company successfully registered the catchphrase/slogan **"Whogobet"**.

Aside from these companies, some celebrities have also made attempts to register their catchphrases and hashtags. Recently, Cardi B, a popular Grammy award winning singer and rapper filed to trademark her famous catchphrase, **"Okurrr"** which she repeatedly used throughout her Grammy-winning debut album, *Invasion of Privacy*. The application was made by her company, Washpoppin, with intent to

¹⁵ Xavier Morales, "Can I Trademark a Hashtag?" available at: <https://secureyourtrademark.com/can-you-trademark/trademark-a-hashtag/>, accessed 20th April 2019.

¹⁶ Claire Jones, "Hashtag trademarks: what can be protected?" available at: https://www.wipo.int/wipo_magazine/en/2017/05/article_0009.html, accessed 21th April 2019.

¹⁷ Ibid.

cover merchandise like caps, t-shirts and hoodies.¹⁸ On this same trend, following an ongoing rivalry between, popular award winning Rap Artist, 50 Cent and rapper Tearri Mari, 50 Cent went ahead to file at the US Patent & Trademark Office to register the popular catchphrase **#I Aint Got It**, used by his rival, Tearri Mari.

The rapper is not the first star to have attempted to trademark catchphrases and lyrics. In 2004, Paris Hilton trademarked her signature catchphrase **"That's hot"** used in the *Simple Life* reality television show for merchandising reasons, this decision was a step in the right direction, especially after she got into a dispute about the use of her trademark with Hallmark cards a few years later.¹⁹ Tennis legend, John McEnroe trademarked his famous 1981 Wimbledon rant against a line call **"You cannot be serious"**, with the US Patent and Trademark Office²⁰. Similarly, Boxing ring announcer Michael Buffer known for his pre-fight gambit: **"Let's get ready to rumble!"** has taken steps to protect that phrase. In the mid-1990s he trademarked the use of the phrase on everything from merchandise like t-shirts, hoodies, beachwear, and coffee cups, to entertainment and advertising²¹.

In 2015, Taylor Swift filed to protect phrases including **"this sick beat"** and **"we never go out of style"** from her hit album *1989*; while Britney Spears made a failed attempt to trademark the song title *Toxic* in 2005.²²

7. WHY DID THESE PERSONALITIES PURSUE TRADEMARK REGISTRATION?

The most pressing reason is to prevent infringement or any unauthorized use or to pre-empt third-parties from commercially benefitting from the use of their trademarks without permission. Without a trademark registration for these hashtags or catchphrases, interlopers are likely to appropriate these terms and the goodwill associated with them for their own financial gain.

8. HOW DO YOU ENFORCE YOUR TRADEMARK

In Nigeria, some of the ways of enforcement of trademarks include:

8.1 Opposition Proceedings: A Notice of Trademark opposition is filed within two months of the proposed mark's publication in the Trade Mark Journal, by a party who seeks to oppose a trademark application that has been accepted

¹⁸ Mark Savage, "Cardi B applies to trademark 'Okurr'" available at: <https://www.bbc.com/news/entertainment-arts-47665949>, accessed 20th April 2019.

¹⁹ BBC News, 'Hakuna Matata' and other unlikely trademarked phrases" available at <https://www.bbc.com/news/world-46384204> accessed 22nd April 2019.

²⁰ Ibid.

²¹ Ibid.

²² Ibid.

by the Trade Marks registry on any of the grounds for rejection set out in the Trade Marks Act. After the filing and responses to all the required processes within the stipulated time, the Trade Mark Registrar will then give a notice of hearing of the opposition proceedings and shall decide the case based on evidence presented by both parties.

8.2 Infringement Lawsuit: A trademark infringement is the unauthorized and illegal use of a registered trademark without the consent of the proprietor of the mark, whereby it is used to cause confusion in the course of trade in relation to any goods in respect of which it was registered. For an action for infringement to succeed in court, the unauthorised use of the mark must be one likely to cause confusion in the minds of the consumers.

8.3 Suing for Passing off: “Passing-off” is an enforceable right whose origin can be traced to tort. It is the protection of an established trade goodwill already acquired by an unregistered trademark or trade name²³. For an action for ‘passing-off’ to succeed, certain ingredients must be established.

In *Reckitt and Coleman Products v. Borden*,²⁴ the House of Lords adopted the ‘Trinity Test’ in establishing the ingredients of ‘passing-off’.

- a. The claimant must establish the goodwill or reputation attaching to the goods or service in question and the identifying ‘get up’ under which the goods and services are offered to consumers;
- b. The claimant must also establish that there has been a misrepresentation by the defendant which has caused or has the potential of causing the members of the public to believe that goods or service emanate from the claimant;
- c. The claimant must demonstrate that he has suffered or is really likely to suffer losses by the reason of the defendant’s misrepresentation as to the source of defendant’s goods or services, which seems to suggest that they emanate from the claimant

9. SOME POPULAR LAWSUITS RELATING TO HASHTAGS AND CATCHPHRASES

Trademark infringement lawsuits have witnessed a new emergence of Hashtag-related claims. Although, there are not a lot of these claims or decisions in Nigerian

²³ Joseph Jar kur, “Action for passing off and infringement of unregistered mark in Nigerian court...” available at: <http://irepos.unijos.edu.ng/jspui/bitstream/123456789/1774/1/actions%20for%20passing%20off.pdf> accessed 22nd April 2019.

²⁴ (1990) 1AER 873.

courts, however, some guidance can be taken from a plethora of US decisions on bordering on these claims²⁵.

In *LLC v. Fagnoli*,²⁶ a clothing maker called Fraternity Collection brought trademark infringement claims against a former designer based on use of the (unregistered) trademark hashtags #fratcollection and #fraternitycollection, the court ruled that “hash tagging a competitor’s name or product in social media posts could, in certain circumstances, lead to consumer confusion”.

Similarly, in *LLC v. Boston Consulting Grp. Inc.*,²⁷ the court found a likelihood of confusion based on the defendant's use of plaintiff's trademark "Public Impact" in defendant's Twitter username, "@4PublicImpact," and its frequently used hashtag, "#publicimpact." The court emphasized that the username was "almost identical to the plaintiff's mark," and the hashtag "#publicimpact" was, in fact, identical to the mark.

The 2015 US case, *Eksouzian v. Albanese*²⁸ was a dispute over the hashtag #cloudpen. In that case, two competing companies selling vaporizer pens had reached a settlement agreement concerning their use of the word “Cloud” as part of a trademark. From this settlement, a dispute arose over the use of the hashtag #cloudpen. The court had to determine whether use of the hashtag constituted a breach of the agreement. The court took the view that hashtags only facilitate categorization in a descriptive way, and should not be registrable trademarks.

This position has however been criticised by various renowned writers as being too restrictive as far as trademark law is concerned. For a hashtag to function as trademark there are certain requirements it must satisfy to be a registrable trademark. The addition of a hashtag to a generic word will not automatically transform it into a registrable trademark and also the fact that a hashtag has been used on a registrable mark will not make it non-registrable merely because of the addition of a hashtag.²⁹ Each mark should be evaluated based on the usual requirements of a registrable trademark and accessed on a case by case basis.³⁰

²⁵ Laura MacFarlane and Richard Stobbe, “#Hashmarks: Can A Hashtag Be A Trademark?” available at <http://www.mondaq.com/canada/x/751984/Trademark/Hashmarks+Can+a+Hashtag+be+a+Trademark> accessed 22nd April 2019.

²⁶ No. 3:13-CV-664-CWR-FKB, 2015 WL 1486375, at *1-2 (S.D. Miss. Mar. 31, 2015).

²⁷ No. 15-13361-FDS, 2016 WL 1048884, at *11 (D. Mass. Mar. 11, 2016).

²⁸ (2015) WL 4720478 (C.D. Cal. Aug. 7, 2015).

²⁹ Laura MacFarlane and Richard Stobbe, “#Hashmarks: Can A Hashtag Be A Trademark?” available at <http://www.mondaq.com/canada/x/751984/Trademark/Hashmarks+Can+a+Hashtag+be+a+Trademark> accessed 22nd April 2019.

³⁰ Ibid.

10. CONCLUSION

Trademarking a hashtag or catchphrase may be a smart business move, however, many unique factors must be considered before registering the Trademark. The use of hashtags or catchphrases has become a new cultural shorthand which business owners can no longer ignore. As these convenient descriptors have engrained themselves into the fabric of our daily lives, the question of ownership, from an intellectual property perspective, needs to be clearly delineated by lawmakers and our courts of law. It has become imperative in today's digital world for business owners to protect their brands by registering their hashtags and catchphrases as Trademarks in order to expand the scope of available protection for their goods and services. As with all things pertaining to emerging concepts, social media geeks are advised to proceed with caution.

For further information on this article and area of law, please contact

Sandra Eke at: S. P. A. Ajibade & Co., Lagos

by telephone (+234 1 472 9890), fax (+234 1 4605092)

Mobile: +234.7033442333 or Email: seke@spajibade.com

www.spajibade.com
