

Towards an Improved Framework for Trade-mark Law and Regulation in Social Media Usernames:

A study of the Canadian, U.S. and U.K. positions

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As society embraces newer technologies, as well as different ways of using such technology, the legal world seems to fall behind addressing the resulting legal issues. For example, the law has not caught up with addressing legal issues relating to the use of trade-marks in social media. Trade-marks can be used in many ways on a social media platform, including, but not limited to, usernames, handles, pages and accounts, etc. However, the law is less than clear regarding the specific use of trade-marks in such a forum and there have been very few cases to guide social media users and trade-mark owners in this space. This article compares the position in Canada with that in the U.S. and the U.K. concerning trade-marks in social media and outlines the gaps in the law and current framework including social media terms and complaint procedures. It then elaborates on a solution which considers the benefits and drawbacks of adopting a uniform dispute resolution procedure (UDRP) for social media usernames similar to the procedure available for domain names. It ends with a recommendation to adopt a revised version of the UDRP called the Uniform Social Media Username Dispute Resolution Policy (USMUDRP) to fill the identified gaps.

Alors que la société découvre de nouvelles technologies et différentes manières d'utiliser cette technologie, la communauté juridique semble accuser un certain retard à traiter les questions de droit qui en découlent. Ainsi, on n'a pas encore réussi à encadrer juridiquement l'utilisation des marques de commerce dans les médias

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sociaux. Les marques de commerce peuvent être utilisées de différentes façons sur les plateformes des médias sociaux, y compris, entre autres, les noms d'utilisateurs, les noms de code, les pages, les comptes, etc. Toutefois, le droit n'est pas de la plus grande clarté concernant l'utilisation spécifique de marques de commerce dans un tel espace de discussion et très peu de décisions ont été rendues permettant aux usagers de médias sociaux et détenteurs de marques de commerce de guider leur conduite dans ce type d'espace. Dans cet article, l'auteur établit une comparaison entre la position du Canada et celle des États-Unis et du Royaume-Uni au sujet de l'utilisation des marques de commerce dans les médias sociaux et souligne les lacunes dans l'état du droit et l'encadrement actuel, y compris les conditions d'utilisation et les procédures de plaintes dans les médias sociaux. L'auteur élabore ensuite une piste de solution laquelle prend en considération les avantages et désavantages d'adopter une procédure uniforme de résolution de conflit (PURC) relativement aux noms d'emprunt utilisés dans les médias sociaux similaire à la procédure applicable pour les noms de domaine. Enfin, l'auteur recommande l'adoption d'une version révisée d'une PURC appelée Uniform Social Media Username Dispute Resolution Policy (en français, politique uniforme de résolution de conflit des noms d'emprunt dans les médias sociaux) afin de répondre aux lacunes identifiées.

1. INTRODUCTION

As society embraces newer technologies, as well as different ways of using such technology, the legal world seems to fall behind addressing the resulting legal issues. For example, the law has not evolved quickly enough to address legal issues relating to the use of trade-marks in social media.¹ Within the ambit of Internet use, there is an ever-increasing use of social media sites and these sites have changed the way people communicate throughout the world. It would be difficult to argue that these developments have not had profound effect in many spheres. However, complexities within the law have arisen in the age of Web 2.0 and social media networking.

¹ Canada uses the spelling "trade-mark" as well as "trademark," whereas in the U.K. it is "trade mark." The U.S. uses "trademark." This article will use the version "trade-mark" except where otherwise quoted or for reference to specific legislation, etc. Also, trade-mark includes service mark where relevant.

The complexities are especially compounded by the fact that trade-marks can be used in many ways on a social media platform, including, but not limited to, in usernames, handles, pages and accounts and within the pages of the social media accounts itself. However, the law is unclear regarding the specific use of trade-marks in such a forum and there have been very few cases to guide social media users and trade-mark owners in this space. It is submitted that the law on this topic is insufficient and the current legal framework is lacking. This article compares the position in Canada with those in the U.S. and the U.K. concerning trade-marks in social media. The Canadian trade-mark system is undergoing several changes and it is interesting to look at the Canadian position versus that of the U.S., where many social media companies are located and have been founded, as well as the U.K. system, which may have direct impact from the EU system.

O'Reilly says that "Web 2.0 is the network as platform, spanning all connected devices" and works by networking through an "architecture of participation."² However, Wood argues that "user names, personalized sub-domain names, virtual products, and avatars" can cause confusion.³ This article reviews username trade-mark issues relating to five key social media sites, being top ranked on user traffic by an eBusinessMBA study in May 2015: Facebook, Twitter, LinkedIn, Pinterest and Google+.⁴ It is expected that coverage of these sites will provide an overview of the major social media position, as these key sites boast a large number of users. This article concentrates on social media sites in which users can set up usernames, account names, identities, profiles, pages, hashtags, handles, and the like (hereinafter referred to as just "username"). Who can claim rights to a social media username which includes a trade-mark is unclear, partially because a trade-mark can be registered by different people or organizations

² Tim O'Reilly, "What is Web 2.0: Design Patterns and Business Models for the Next Generation of Software" (2007) First Quarter, No. 1, p. 17, online: <<http://ssrn.com/abstract=1008839>> .

³ Douglas J. Wood, "Network Interference: A Legal Guide to the Commercial Risks and Rewards of the Social Media Phenomenon" (2009) *The National Law Review*, online: <<http://www.natlawreview.com/article/network-interference-legal-guide-to-commercial-risks-and-rewards-social-media-phenom>> .

⁴ "Top 15 Most Popular Social Networking Sites | May 2015" (May 2015), online: *Top 15 Most Popular Social Networking Sites | May 2015*, online: <<http://www.ebizmba.com/articles/social-networking-websites>> .

in different countries, the legal framework may differ and jurisdictional issues arise.⁵

This is not the first time the law has not evolved with technology. The current legal framework requires reliance on general trade-mark laws or availing of social media complaint procedures for each site. Simply put, a common balance needs to be struck between this technology and the legal problems it raises. This article analyzes the existing trade-mark legal framework in Canada, the U.S. and the U.K. specifically relating to social media usernames involving trade-marks, along with the complaint procedures under each of the social media companies to outline the gaps in these areas. It also discusses an alternative yet uniform approach to resolution of disputes.

2. OVERVIEW OF KEY SOCIAL MEDIA SITES AND RESULTING TRADE-MARK LAW ISSUES

It is useful to have a brief background of the various social media companies and their offerings, such that the trade-mark context can be established for usernames.

Facebook was founded in 2004 and its mission “is to give people the power to share and make the world more open and connected.”⁶ Headquartered in Menlo Park, California, it has 1.44 billion monthly active users as of March 2015.⁷ The social media platform allows users to create accounts and pages and “post” pictures, messages and communicate with many users. On Facebook, a potential dispute may occur when someone registers a username such as facebook.com/trademarkname.

Twitter’s headquarters is located in San Francisco, California and its mission is to help people “create and share ideas and information instantly, without barriers.” There are about 302 million unique monthly users and about “500 million Tweets are

⁵ Teresa Scassa, “The Perils of Social Media Under the Laws of the United States and Canada: A Cautious Tale for Lawyers and Clients” (August 2011), *Slaw RSS*, online: < <http://www.slaw.ca/2011/08/08/the-perils-of-social-media-under-the-laws-of-the-united-states-and-canada-a-cautious-tale-for-lawyers-and-clients/> > accessed 9 November 2012.

⁶ “Company Info | Facebook Newsroom,” *Facebook Newsroom*, online: < <http://newsroom.fb.com/company-info> > accessed 8 May 2015.

⁷ *Ibid.*

sent per day.”⁸ A Tweet is “an expression of a moment or an idea and can contain text, photos, and videos.”⁹ A sample problematic Twitter username may be @trademarkname.

LinkedIn is a professional online network which officially launched in 2003 and is headquartered in Mountain View, California.¹⁰ The mission is to “connect the world’s professionals to make them more productive and successful” and claims to be “the world’s largest professional network with more than 300 million members in over 200 countries and territories.”¹¹ Registering linkedin.com/company/trademarkname can raise a dispute.

Pinterest is also located in San Francisco and markets itself as “a place to discover ideas for all your projects and interests, hand-picked by people like you.”¹² It has an estimated 250 million unique monthly visitors.¹³ Trade-mark issues may be raised with an account such as pinterest.com/trademarkname.

Google+ is a site that enables people to “chat, share ideas, post photos and videos, stay in touch . . .” *etc.* and is headquartered in Mountain View, California.¹⁴ It is estimated to have approximately 120 million unique monthly visitors.¹⁵ A username can be created on Google+ as a profile and a “custom URL for your Google+ profile” can be created such as google.com/+trademarkname.¹⁶

Overall, these five social media giants, their services and target being somewhat different from each other, utilize key Internet

⁸ “Company | About,” *Company | About*, online: < <https://about.twitter.com/company> > accessed 8 May 2015.

⁹ “Company | About, The Story of a Tweet,” *Company | About*, online: < <https://about.twitter.com/what-is-twitter/story-of-a-tweet> > accessed 8 May 2015.

¹⁰ “About Us,” online: < <https://linkedin.com/about-us> > accessed 10 June 2015; “About LinkedIn,” < <https://linkedin.com/company/linkedin> > accessed 19 June 2016.

¹¹ *Ibid.*

¹² “About Pinterest,” online: < <https://about.pinterest.com/en/browser-button> > accessed 8 May 2015.

¹³ *Supra* note 4.

¹⁴ “Introduction-Google+ Help,” online: < <https://support.google.com/plus/answer/2409856?hl=en> > accessed May 2015.

¹⁵ *Supra* note 4.

¹⁶ “Get a custom URL for your Google+ profile,” online: < support.google.com/plus/answer/2676340?hl=en > accessed May 2016.

technologies to provide a social user experience. Part of this experience is now the subject of debate as to trade-mark concerns.

The new issues brought about by the proliferation of the use of social media stem partially from the fact that usernames are created on various social media sites. The ability to register trade-mark usernames on social networking websites is likened to cybersquatting and “one which extends beyond the infringement of personal names.”¹⁷ Cybersquatting is “when a person other than the owner of a well-known trademark registers that trademark as an Internet domain name and then attempts to profit . . .”.¹⁸ However, social media usernames are different from traditional Internet domain names and do not come under that definition.¹⁹

As social media becomes a key medium for promoting business, users can register “famous brands as usernames which can allow the impostor to use brands in hashtags to deceptively lure unsuspecting Internet users to an infringing profile.”²⁰ Purposely registering someone else’s trade-mark as a username can redirect profits and “damage the reputation of a famous brand name.”²¹ This can create confusion as to the source of the information and user association. The traditional trade-mark problem of dilution also presents itself in the context of social media such as when there is a tarnishing or blurring of the trade-mark. Also, people can register trade-marked usernames from anywhere in the world with minimal technical skill. If there is no resolution, the trade-mark problems in social media will only be compounded. Although, many trade-mark issues may arise in the context of social media, this article looks at violation of trade-marks (and some related concerns like passing off or impersonation) on social media from the perspective of social media usernames such as @trademarkname or facebook.com/trademarkname to provide a more focused study.

¹⁷ Thomas J. Curtin, “The Name Game: Cybersquatting and Trademark Infringement on Social Media Websites” (2010-2011) 19 J.L. & Pol’y 353.

¹⁸ “Cybersquatting,” online: accessed May 2016.

¹⁹ Adapted from Janet M. Garetto, “Trademark Issues in Social Media” (*Nixon Peabody*), online: < http://www.nixonpeabody.com/linked_media/publications/Garetto_Trademark_Issues_Social_Media.pdf > accessed 8 May 2015.

²⁰ Curtin, *supra* note 17.

²¹ *Ibid.*

3. CURRENT LEGAL FRAMEWORK FAILS TO ADEQUATELY ADDRESS SOCIAL MEDIA TRADE-MARK ISSUES

In the jurisdictions under this study, there has been little change in trade-mark law affecting social media, specifically. There are general trade-mark laws, mostly applicable to the use of trade-marks anywhere, including online and in social media. However, there is no major legislation or common alternative dispute resolution mechanism in Canada, the U.S. or the U.K., which specifically addresses enforcement of trade-mark problems in social media. We will now compare the positions in each jurisdiction with regards to these matters.

(a) Existing Trade-mark Legislation and Application to Social Media

The definitive Canadian trade-mark legislation is the *Trade-marks Act* (R.S.C. 1985, c. T-13). Some changes are underway and some to be implemented at a later stage, including the Canadian amendments to the *Trade-marks Act* and updated *Trade-marks Regulations*.²² These new laws aim to bring Canada closer to the international position with respect to trade-marks and to exhibit “international best practices.”²³ The changes will allow for implementation of some international treaties which the U.S. and the U.K. have already implemented.

In the U.S., the key federal legislation is the *Lanham Act, 1946*, 15 U.S.C. §§ 1051 *et seq.* (as amended in 1996).²⁴ Also, the *Trademark Dilution Revision Act of 2006* amends the *Lanham Act* to disallow actions that may cause dilution of famous marks. In the U.K., the single major legislation pertaining to trade-marks is the *Trade Marks Act 1994* (1994 chapter 26, as amended implementing the European Trademarks Directive into local law).

However, unlike the other jurisdictions, the U.S. has enacted specific domain name trade-mark legislation. The

²² “Trademark legislative changes and international treaties,” *Industry Canada*, online: < ic.gc.ca/eic/site/cipointernet-internettopic.nsf/eng/wr03964.html > accessed 1 August 2015.

²³ *Ibid.*

²⁴ “Intellectual Property in Cyberspace-Domain Names,” *Harvard Law*, online: < <http://cyber.law.harvard.edu/metaschool/fisher/domain/tm.htm> > accessed 2 September 2013.

Anticybersquatting Consumer Protection Act (ACPA) 1999, 15 U.S.C. § 1125(d) and the formerly used *Federal Trademark Dilution Act of 1995*, 15 U.S.C. § 1125(d), have been used “to assert claims against domain name infringers such as cybersquatters.”²⁵ Again, this is not social media specific and covers Internet domain names. A more commonly available proceeding is the Uniform Dispute Resolution Policy (UDRP) which can be availed of from other jurisdictions and covers domain name disputes.

Although major legislation is in place concerning trade-marks more generally, none of these specifically address trade-mark violations in social media usernames. Canada is aligning, in other trade-mark respects, with other international jurisdictions. However, the changes have not squarely addressed social media trade-mark issues. Despite this, the above legislation can be used to protect trade-marks in social media subject to jurisdictional requirements, or users may avail of social media policies and procedures to resolve concerns through the social media company itself. The question is how effective the current framework may be. First, we will examine the broader legal framework before looking at complaint procedures available under the social media company’s policies.

(b) Definition of Trade-mark and Social Media Context

In Canada, section 2 of the *Trade-marks Act* defines trade-mark as follows: “(a) a mark that is used by a person for the purpose of distinguishing or so as to distinguish goods or services manufactured, sold, leased, hired or performed by him from those manufactured, sold, leased, hired or performed by others. . . .” “Trademarks may be one or a combination of words, sounds or designs used to distinguish the goods or services of one person or organization from those of others in the marketplace.”²⁶ Comparing this with the U.S. position, under 15 USC §1127, “a trademark is defined as any word, name, symbol, or device, or any combination thereof — (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register

²⁵ *Internet Law Practice in California* (Continuing Education of the Bar, The Regents of the University of California, 2015).

²⁶ “A Guide to Trademarks,” *Industry Canada*, online: < http://www.ic.gc.ca/eic/site/cipointernetinternetopic.nsf/eng/h_wr02360.html?Open&wt_src=cipotmain&wt_ext=learn > accessed 2 September 2015.

. . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.”²⁷

Under subsection 1(1) of the U.K. *Trade Marks Act 1994*, a trade-mark is “any sign capable of being represented graphically which is capable of distinguishing goods or services of one undertaking from those of other undertakings” and can “consist of words (including personal names), designs, letters, numerals or the shape of goods or their packaging.” The definitions of trade-mark in Canada and the U.K. focus on the distinguishing aspect of trade-marks, whereas the U.S. definition uses a similar “identify and distinguish.” Canada requires “distinctiveness” under subsection 12(2) of the *Trade-marks Act*, as does the U.K., under paragraph 3(1)(b) of the *Trade Marks Act 1994*. Additionally, descriptive marks pose a special problem on the Internet (see 15 USC §1052(f)) because the United States Patent and Trademark Office (USPTO) will not register a trade-mark until it gains secondary meaning, which could take a long time.²⁸

In the social media context being explored, we are mostly concerned with the trade-mark when it is defined as a word, name, letters or numerals which are used as or in social media usernames. The above definitions of trade-mark do not seem to conflict with categorizing a username as including a trade-mark.

(c) Confusion and Social Media Trade-mark Infringement

Under subsection 6(1) of the Canadian *Trade-marks Act*, confusion is a factor in trade-mark infringement. Subsection 6(5) also spells out the factors which are considered for confusion and include “inherent distinctiveness,” “time used,” “nature of goods, service or business,” “the trade” and “degree of resemblance.” One of the prohibitions against registration includes that a mark must not be “confusing with a registered trade-mark” under paragraph 12(1)(d). Further, section 7 of the Canadian *Trade-marks Act* addresses “Unfair Competition” and requires confusion or “passing off” with respect to “goods, services or business.” Under U.S. federal law, specifically 15 U.S.C. § 1114 and 15 U.S.C. § 1125(a), where “use of the mark to identify goods or

²⁷ *Supra* note 25.

²⁸ *Ibid.*

services causes a likelihood of confusion” is prohibited.²⁹ Section 10 of the U.K. *Trade Marks Act 1994* prohibits use where “there exists a likelihood of confusion on the part of the public, which includes the likelihood of association with the trade mark.” Thus, all jurisdictions under this study apply some sort of confusion test and, in each, a statute or the courts have promulgated various factors that are taken into consideration when determining confusion.

Further, there are different possible types of confusion. Ramello says there could be a “market failure caused by the information asymmetry to consumers” because they cannot know where the product comes from, or its source.³⁰ Such confusion may occur on social media, in the sense that a username can confuse others as to the source of whatever is being marketed. For example, a Facebook username may be a trade-mark of another and confuse people as to source when used to advertise. Likewise, if one tweets using another’s trade-marked Twitter username, this can cause confusion as to source. On the other hand, “Dreyfuss . . . and Kozinski . . . note that many trademarks have developed a standalone value ... wholly apart from any product or service that might be manufactured by the trademark owner” which raises further issues in the social media context when a username is identified as a trade-mark and users automatically associate it with the original brand.³¹

McKenna argues that “trademark law should only be concerned with confusion that actually affects consumer decision making.”³² However, in social media it is not always about consumer decisions, though it certainly can be. The issue is that use may be made

²⁹ “Trademark Infringement,” online: < https://www.law.cornell.edu/wex/trademark_infringement > accessed May 2016.

³⁰ Giovanni B. Ramello, “What’s in a Sign? Trademark Law and Economic Theory, Department of Public Policy and Public Choice — POLIS,” Working paper n. 73, March 2006.

³¹ Peter S. Menell, “Intellectual Property: General Theories”, online: < levine.sscnet.ucla.edu/archive/ittheory.pdf > accessed May 2016.

³² See Mark P. McKenna, “A Consumer Decision-Making Theory of Trademark Law” (2012) 98 Va. L. Rev. 67, 73-76 & n.14 (citing William M. Landes & Richard A. Posner, “Trademark Law: An Economic Perspective, (1987) 30 J.L. & Econ. 265, 265-69); see also *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159 at 163-164 (1995) (“Trademark law ... ‘reduces the customer’s costs of shopping and making purchasing decisions’”) as seen in Lisa Larrimore Ouellette, “The Google Shortcut to Trademark Law, California Law Review” (2014) 102 Calif. L. Rev. 351.

outside the commercial sense as discussed more in-depth in the section below. Also, as rightly noted by Dinwoodie and Janis “[n]ot all forms of confusion are actionable under trademark law, and thus, a third party may be permitted to engage in some uses of a mark notwithstanding the fact that such uses cause confusion.”³³ Even in a social media context, fair use may be applicable despite the likelihood of confusion.³⁴ Defences are further explored below.

Therefore, confusion can pose significant problems in the social media context and needs to be addressed.

(d) Use Requirements and Social Media

Use can be a challenge in the social media context, particularly in how and where use is made. Under the Canadian *Trade-marks Act* use is “in association with goods or services.” However, social media use does not always occur in association with particular goods or services. Under subsection 4(2), with respect to “services,” “if it is used or displayed in the performance or advertising of those services” it can be classified as use. It is not entirely clear whether using a trade-mark in a username can be interpreted as advertising, depending on the context and the jurisdiction. Also, interpretation of use in “commerce” can be a problem and is required under 15 U.S.C.A. 1125(c)(1). The use requirement has been interpreted, at least, to include some types of online use, and even some social media instances, as will be seen in the cases discussed below. However, as Garretto recognizes, some social media use under U.S. law will not qualify as using the “mark in commerce” such as when no goods or services are being sold.³⁵ Under subsection 10(1) of the U.K. *Trade Marks Act 1994*, “there would be no infringement unless the trademark was used in the course of trade” and under paragraph 10(4)(d), use may occur if one uses the sign on business papers or in advertising.³⁶ Social media is used for business and

³³ Graeme B. Dinwoodie & Mark D. Janis, “Confusion Over Use: Contextualism in Trademark Law” (2007) 92 Iowa L. Rev.

³⁴ Adapted from Dinwoodie & Janis, *ibid.* (referencing *KP Permanent Make-Up, Inc. v. Lasting Impression I, Inc.*, 543 U.S. 111 (2004)).

³⁵ Janet M. Garetto, “Trademark Issues in Social Media,” *Nixon Peabody*, online: <http://www.nixonpeabody.com/linked_media/publications/Garetto_Trademark_Issues_Social_Media.pdf> accessed 8 May 2015.

³⁶ George Sevier & Dan Smith, “Social Media and Trademarks: making a hash of it,” online: <trademarksandbrandsonline.com/article/making-a-hash-of-it> accessed 8 May 2015.

advertising nowadays. The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) also recognizes “course of trade” and likelihood of confusion, under Article 16, section 1. Therefore, “casual use” in “personal social media” will probably not meet the use in commerce requirement and this can be problematic in such context.³⁷

(e) Unregistered Marks and Social Media

Unregistered marks in Canada and the U.K. can enjoy some protection under common law. In Canada, a lawsuit against an alleged infringer may be brought under a tort passing off claim or under section 7 of the *Trade-marks Act*.³⁸ Likewise, trade-marks in the U.K. may be protected under U.K. common law, though goodwill is a special requirement of the tort of passing off and misrepresentation and damages need to be proven.³⁹ Suits often allege trade-mark infringement as well as passing off claims.⁴⁰ In the U.S., unregistered marks also have some legal protection “but trademark rights at common law are not as extensive as the rights granted under federal law for federally registered marks.”⁴¹ Those using unregistered trade-marks may have a very difficult time to prove to a court or social media company that they have rights in the unregistered trade-mark. This could be an uphill battle depending on the jurisdiction and who the decision maker is. All may have a different view of an unregistered mark and the outcome of a dispute may vary accordingly.

³⁷ Robert McHale & Eric Garulay, “Navigating Social Media Legal Risks” (Que Publishing Pearson Education 2012).

³⁸ See “Passing Off” (*Duhaime*), online: < duhaime.org/LegalDictionary/P/PassingOff.aspx > accessed 2 September 2015.

³⁹ “Trademark and passing off disputes, Elements of passing off — goodwill,” online: < lexisnexis.com/uk/lexispsl/ipandit/synopsis/93915:94170/Trade-marks-passing-off/Trade-marks-and-passing-off-disputes > accessed 2 September 2015.

⁴⁰ *Ibid.*

⁴¹ *Supra* note 25.

(f) Depreciation of Goodwill and Trade-mark Dilution in Social Media

It has been recognized that “trademark dilution is premised on the need to prevent against harming the trademark.”⁴² Canada recognizes the concept of “depreciation of goodwill” in relation to trade-marks.⁴³ This is conceptually similar to trade-mark dilution under the U.S. *Trademark Dilution Revision Act of 2006*, 15 U.S. Code §1125(c)(2)(B) protecting against “dilution by blurring” which “is association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.” Also, under 15 U.S. Code §1125(c)(2)(C) “dilution by tarnishment” is association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark. In the U.K., subsection 10(3) prohibits using an “identical” or “similar” reputable mark “being without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”

Social media usernames can be registered with the intent to blur or tarnish a famous trade-mark. For example, blurring may occur when a user utilizes a trade-mark as a username for another type of product like facebook.com/trademarknamecomputers and facebook.com/trademarknameclothing when the trade-mark is actually for a famous company that sells branded paper. Eventually, if this depreciates the goodwill, or impairs the distinctiveness or sufficient unfair advantage is taken, then a claim can be made. A key concern is the simplicity with which (often free) registration of an available social media username can be done. As such, there are opportunities for those that are interested to dilute the trade-mark or otherwise take detrimental action towards its reputation.

(g) Jurisdiction, Forum and Venue issues in Social Media

Social media transcends borders. Analogous to the jurisdictional issues raised by the Internet more generally, social media brings about some serious jurisdictional, forum and venue considerations. Not only are social media used by people from

⁴² Danny Friedmann, “Trademarks and Social Media: Towards Algorithmic Justice” (Edward Elgar Publishing, 2015).

⁴³ Trademark Dilution, online: < <http://www.inta.org/TrademarkBasics/Fact-Sheets/Pages/TrademarkDilution.aspx> > updated March 2016.

many jurisdictions, but they are accessed through numerous jurisdictions. The question becomes what jurisdiction and forum/venue might a social media trade-mark dispute fall under and which rules would apply? One way of addressing this issue is discussed in the social media terms section below whereby terms may set the jurisdiction and venue. While such terms may be enforceable by a court and have been honoured, some courts have refused to be bound by such clause (see: (g) Jurisdiction, Choice of Law, Forum and Venue, in Part 5).⁴⁴ Normal contract jurisdictional rules often apply to the social media terms and this can result in forum in any jurisdiction because of the complicated and differing rules. Social media companies may argue for jurisdiction in their principal place of business or location of its head office, and users could potentially argue jurisdiction anywhere in the world.

Unlike under the Uniform Dispute Resolution Policy (UDRP) for domain name disputes, the current social media framework does not provide a uniform system in which a complaint can be lodged and alternative dispute resolution procedures be taken within a defined setting and broadly available framework across jurisdictions.

(h) Identity of the Social Media User and Enforcement

Sometimes the identity of a user may be unknown, as some sign up for social media using false names and information. Even in clear infringement cases, this makes enforcement through a court process difficult. As we will see from the cases discussed below, some plaintiffs list those defendants that are unknown and are therefore named as “Does,” at least initially.

Under the UDRP, registrars can take action relating to domain names as can social media companies for usernames within their terms and conditions or under the law. This may require the social media company to be named as a party to the dispute or otherwise, under local procedure, be properly attributed such that a court order may be enforceable. However, under the UDRP, it is often possible to obtain the names of the registrant of the particular domain. Nevertheless, social media companies would appear to have the capability to take action without having all of the correct user information, though this can get quite complicated.

⁴⁴ See section on Social Media Terms.

(i) Complications Raised by Nature and number of Social Media Platforms

As many people and businesses use various social media, and register trade-marks across various platforms, enforcing trade-marks can potentially be a daunting task. This might involve suing or lodging complaints against several users, social media companies and third parties possibly in various different forums and cases. Unlike domain names, social media usernames can exist across different platforms and currently have to be resolved using many different mechanisms, rather than through a single procedure. This can result in considerable court expense and legal fees, additional procedures, added delay, and is overall an ineffective solution to the problem. Also, under each individual social media complaint procedure, different results may occur and it is conceivable that one may disable the username, and another may not, even under similar circumstances. Therefore, results are unpredictable whereas consistency is desired being that the issues are similar.

(j) Issue of Necessity of Prompt Address in Social Media Sphere

Sometimes much damage can be done by using a trade-mark in social media. For example, even one damaging tweet sent using someone else's trade-marked username may result in undue and extensive harm to a trade-mark holder, causing long term-damage to their brand. Therefore, it may be necessary to have a system of prompt address in some circumstances. While it is possible to obtain an injunction through the courts, legal hurdles that may arise, including identity problems and jurisdictional issues.

Procedures under current dispute resolution mechanisms for domain names include the Uniform Rapid Suspension (URS) which "is intended to offer a lighter complement to the existing UDRP."⁴⁵ The URS is designed to provide a quick resolution and for use in clear-cut cases rather than complicated ones.⁴⁶ No such mechanism exists for social media except those under various social media terms discussed below for which each procedure needs to be availed of with no assurance as to resolution time frame.

⁴⁵ "Rights Protection Mechanisms for New Top-Level Domains (TLDs)," Uniform Rapid Suspension, online: < wipo.int/amc/en/domains/rpm#e > .

⁴⁶ *Ibid.*

(k) Limited Procedural Specifics regarding Trade-mark Usernames for Social Media

Registration of a Canadian trade-mark can be done through the Canadian Intellectual Property Office and, in the U.K., through the U.K. Intellectual Property Office (IPO), or, if applicable, at the Community level for a Community Trademark. In the U.S., trade-marks are registered with the USPTO.⁴⁷ As mentioned, domain names and Twitter social media accounts may be registered as trade-marks, according to the USPTO Manual of Examining Procedure.⁴⁸ The manual refers to hashtags on Twitter and allows their registration, if otherwise registerable, with the hashtag part disclaimed.⁴⁹ This is one example of how trade-mark procedure recognizes novel issues in social media. However, this does not cover the many issues that can arise in different social media contexts. Nevertheless, it is a step forward in recognizing that social media issues need to be specifically addressed. In 2015, Coca-Cola filed applications for Twitter hashtag marks.⁵⁰ That is not to say that social media usernames that include trade-marks are unrecognized under law; it is that no broad procedure exists to directly identify most of them.

(l) Country Top Level Domain Name Policies and Similar Social Media Issues

Canadians, residents and Canadian mark holders can register a .ca level domain with Canadian Internet Registration Authority (CIRA).⁵¹ Registering the .uk country code top level domain for the U.K. is possible since 2014.⁵² The .us country code top level domain is open to those who are citizens, residents, U.S. businesses and those with a “bona fide presence in the United States of

⁴⁷ “TTAB,” online: < uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab > accessed 2 September 2015.

⁴⁸ “Hashtag Marks, Trademark Manual of Examining Procedure,” TMEP 1202.18, online: < tmep.uspto.gov/RDMS/mashup/html/page/manual/TMEP/Oct2013/ch1200_d1ff5e_1b5ad_3bc.xml > accessed 2 September 2015.

⁴⁹ *Ibid.*

⁵⁰ “#Trending: hashtag trademarks,” online: < lexology.com/library/detail.aspx?g=404856a1-dc9c-4f76-a224-6ff83bea1ee1 > accessed 2 September 2015.

⁵¹ *Ibid.*

⁵² “Choosing Your Domain Name,” online: accessed 2 September 2015.

America or any of its possessions.”⁵³ There is a specific dispute resolution policy relating to these country top level domains.⁵⁴ Each may have different requirements such as “legitimate interest,” “confusion” and/or “bad faith.”⁵⁵ However, in social media, a complaint must be filed with each authority separately and under certain procedures and rules. Also, it is sometimes difficult to distinguish country-related usernames in social media which may have a unique ending or beginning, such as in @trademarknameca or pinterest.com/usatrademarkname. Not all such uses will violate a given law, though in Canada there are restrictions relating to use of “certain official marks unless you have the permission from the organization that controls the mark.”⁵⁶

(m) Policing Trade-marks in Social Media

In Canada, as in the U.S. and the U.K., monitoring a trade-mark and instituting legal action is the responsibility of the trade-mark owner.⁵⁷ Direct trade-mark usernames such as @trademarkname or google.com/+trademarkname may not be so difficult to find. For example, you may search and find particular trade-marks quite easily in social media through search functions or by trying to register a Facebook or a Twitter username and finding that it has been taken. However, there is no uniform approach to deal with any potential abuse once found. Also, if a trade-mark is used within a username along with other variables such as pinterest.com/buyfromtrademarkname or @trademarkname1, this could be more difficult to police partially due to the many possible variations.

⁵³ “The usTLD Nexus Requirements Policy,” online: accessed 2 September 2015.

⁵⁴ See CIRA Dispute Resolution Policy (CDRP), Nominet’s DRP (Dispute Resolution Policy) or Administrative proceedings under usTLD.

⁵⁵ *Ibid.*

⁵⁶ “A guide to trademarks, Canadian Intellectual Property Office,” online: < ic.gc.ca/eic/site/cipointernet-internettopic.nsf/eng/h_wr02360.html#whatYouCanAndCannotRegister > .

⁵⁷ “A Guide to Trademarks,” online: < http://www.ic.gc.ca/eic/site/cipointernet-internettopic.nsf/eng/h_wr02360.html?Open&wt_src=cipotmmmain&wt_cxt=learn > accessed 2 September 2015.

(n) Trade-mark Defences and Related Issues in Social Media

Defences to trade-mark infringement may affect the ability of mark-holders to be successful in actions based on use in social media. Although a detailed discussion of defences is beyond the scope of this article, it is helpful to include a brief review of these matters which are covered to some degree in other works. This includes a brief review of fair use, parody, freedom of speech, and freedom of expression. The section on social media terms below will examine how some of these are incorporated into the terms when one registers a new social media account.

(i) Fair Use

Under U.S. law, “some courts may find a descriptive use of another’s trade-marked 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.”⁵⁸ However, this may pose a specific problem when it comes to social media usernames because the mark holder will argue that the username itself is being used as a trade-mark regardless of the content that may follow on any page associated with the username.⁵⁹ Also, nominative fair use may be used to “refer to the mark’s owner or its product, rather than to the defendant” and that would be considered “fair.”⁶⁰ Ramsey looked at the defence of fair use in a trade-mark context more closely and considered how the courts may allow the mark to be used as “parody, criticism, or commentary about the markholder” under nominative fair use.⁶¹ Scassa indicated, “[w]hile no such nominative fair use doctrine expressly exists in Canadian law, it is clear that such activity would not violate §19 (of the *Trade-marks Act*).”⁶² Just referencing a trade-marked good by identifying it would not necessarily violate Canadian law. In the U.K., fair use is recognized under subsection 10(6) which allows use “for the purpose of

⁵⁸ Lisa P. Ramsey, “Brandjacking on Social Networks: Trademark Infringement by Impersonation of Markholders” (2010) *Buff. L. Rev.*

⁵⁹ *Ibid.*

⁶⁰ Linda A. Friedman, “Online Use of Third Party Trademarks: Can Your Trademark Be Used without Your Permission?,” online: < americanbar.org/publications/blt/2016/02/03_friedman.html > .

⁶¹ Ramsey, *supra* note 58.

⁶² Teresa Scassa, “Canadian Trademark Law,” online: < <http://www.duhaime.org/LegalDictionary/N/NominativeFairUse.aspx> > .

identifying goods or services as those of the proprietor or a licensee” but can be infringing if not “in accordance with honest practices in industrial or commercial matters” . . . “if the use without due cause takes unfair advantage of, or is detrimental to, the distinctive character or repute of the trade mark.” Also, article 17 of the TRIPS agreement provides for a fair use exception.⁶³

All three jurisdictions allow for some kind of fair use exception, but apply them differently. The challenge in social media stems from where the trade-mark is being used and how. A trade-mark name as a username is quite different from a trade-mark logo being used on an internal page of a social media site. If all the consumer can see is a username such as facebook.com/trademarkname, there is no way for the consumer to distinguish from authentic and other use of the trade-mark. Only when the consumer visits the page or site related to that username can the consumer find out more. Fair use may apply on such internal pages, for example, when it is clear that the trade-mark name is simply being referred to and no unlawful use is being made. As discussed by Ramsey, usernames have some separate concerns in this regard.

(ii) *Parody*

In Canada, a “parody may attract a claim for trade-mark infringement, depreciation of goodwill or passing off.”⁶⁴ The court may look very closely at the type of parody and the specific circumstances; it is not as simple as making fun of someone’s trade-mark. “Given the difficult task of proving infringement of a mark by a parody mark, trademark owners often rely on the dilution provisions of the Trademarks Act and argue that the parody has depreciated the goodwill in the original trademark.”⁶⁵ In the U.S., the “TDRA allows non-commercial uses of a mark and allows fair use such as parody when the use is not as the junior mark holder’s designation of source.”⁶⁶ In the U.K., under paragraph 10(3)(b) of the Act, parody may be jeopardized under use “being without due

⁶³ TRIPS, online: < https://www.wto.org/english/docs_e/legal_e/27-trips_04_e.htm > .

⁶⁴ Sharon Groom, “The Perils of Parody,” online: < mcmillan.ca/Files/perils%20cover.pdf > .

⁶⁵ “The not-so-funny side of parody,” Smart & Biggar, November 14, 2012, online: < smart-biggar.ca/en/articles_detail.cfm?news_id=687 > .

⁶⁶ 15 U.S.C. § 1025(c)(3) (2012) as seen in Deborah J. Kemp, Lynn M. Forsythe &

cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trade mark.”⁶⁷ In a social media setting, it is important to look at how parody might be applied. For example, simply using a direct trade-mark name could be problematic whereas using other words in front of or after it, such as “facebookcom/laughingattrademarkname” or “pinterest.com/borntomakefunoftrademarkname” might be acceptable in some jurisdictions.⁶⁸

(iii) *Freedom of Speech*

Lipton looked at free speech rights as they relate to domain names which may be informative here.⁶⁹ Under the U.S. Constitution, the First Amendment guarantees freedom of speech and “as a matter of policy” should “override an intangible property right to the extent that the exercise of the property right creates an unacceptable burden on speech.”⁷⁰ Burrell and Gangjee correctly explained that “there will be an inevitable temptation to oversimplify the relationship between trade marks and speech.”⁷¹ They also opined that there may be “privileged treatment of predetermined categories” like “parody” and that is important to look at the original free speech reasoning before applying such exceptions blindly.⁷² Considering this, in a social media context, some clarity in certain areas is required such as how specifically a free speech defence would apply and whether original principles are being applied. The current state of the law is certainly confusing to the detriment of the average social media user as well as mark holders alike.

Ida M. Jones, “Parody in Trademark Law: Dumb Starbucks Makes Trademark Law Look Dumb” (2015) 14 J. Marshall Rev. Intell. Prop. L. 143.

⁶⁷ Adapted from Danny Friedmann, “Trademarks and Social Media: Towards Algorithmic Justice” (Edward Elgar Publishing, 2015).

⁶⁸ Ramsey, *supra* note 58.

⁶⁹ Jacqueline Lipton, “Internet Domain Names, Trademarks and Free Speech” (Edward Elgar Publishing, 2010).

⁷⁰ *Ibid.*

⁷¹ Robert Burrell & Dev Gangjee, “Trade Marks and Freedom of Expression: A Call for Caution,” Research Paper No. 10-05, 2010, online: <ssrn.com/abstract=1593258>.

⁷² *Ibid.*

Ramsey noted that “it is not entirely clear whether trade-mark infringement law covers certain unauthorized uses of a mark on a social network site” and asserted that non-commercial use may not impede a free speech defence whereas impersonation could cause confusion.⁷³ Impersonation on social media is a serious problem. Therefore, a clear and distinct rule for social media specifically would be welcomed.

(iv) Freedom of Expression

Freedom of expression in Canada stems from section 2(b) of the *Charter of Rights and Freedoms*.⁷⁴ The famous Canadian case of *Source Perrier SA v. Fira-Less Marketing Co.*, decided that the “most liberal interpretation of ‘freedom of expression’ does not embrace the freedom to depreciate the goodwill of registered trademarks.”⁷⁵ In the U.S., this is protected under the First Amendment as it is in the U.K. under the *Human Rights Act 1998*, chapter 42. However, Sakulin opined that “trademark law fails to sufficiently differentiate between commercial purpose and the social, political, or cultural meanings carried one and the same sign.”⁷⁶ Likewise, Burrell and Gangjee convincingly argued the “limited effectiveness” of “freedom of expression to constrain trade mark rights” outside the U.S.⁷⁷ These views raise serious concerns about freedom of expression and its relation to current trade-mark law and show the marked difference among jurisdictions. In a social media context, it is yet another complicating factor that can burden the resolution of social media disputes.

4. LIMITED SOCIAL MEDIA TRADE-MARK CASES PROVIDE MINIMAL GUIDANCE

Relatively few cases exist concerning trade-mark infringement on the social media sites covered by this article. However, the cases

⁷³ Ramsey, *supra* note 58.

⁷⁴ Daniel Bereskin, “Trademark and Free Expression Rights: Are They Reconcilable?” *Who’s Who Legal*, WWL, February 2009, online: < whoswholegal.com/news/features/article/12861/trademark-free-expression-rights-reconcilable > .

⁷⁵ *Ibid.*; (1983), 70 C.P.R. (2d) 61 (F.C.T.D.).

⁷⁶ Wolfgang Sakulin, “Trademark Protection and Freedom of Expression,” Summary, Kluwer Law International, 2010.

⁷⁷ Burrell & Gangjee *supra* note 71.

below may help shed light on how trade-marks have been dealt with in social media — though this is not a review of all such cases. Some of these cases have been settled before the filing of or shortly after the filing of a lawsuit, resulting in a further want of guidance in this area. Some cases are from lower courts or other forums, and/or are relatively new, and may not be the last word on these matters. Complaints often involve trade-mark infringement and additional claims. Often, we see traditional trade-mark laws applied, though this is insufficient because of the international nature of social media, different rules across jurisdictions and the complexity arising as a result of the nature of social media.

Additionally, few statistics are available regarding trade-mark complaints to social media giants, but Twitter recently published some helpful statistics in their transparency report.⁷⁸ Between January and June, 2015, Twitter (including Vine) received a total of 12,911 trade-mark notices affecting 938 Twitter accounts.⁷⁹ Material was reportedly removed in seven per cent of those cases. However, Twitter noted several reasons why they may not take action on all trade-mark requests.

(a) **Alternative Resolution Strategy**

(i) ***Coca-Cola***

One of the world's most popular brand names, Coca-Cola, faced a dilemma in 2008 over how to handle an extremely popular Facebook page that was put up by fans using the Coca-Cola brand.⁸⁰ Facebook notified Coca-Cola about this and, in a unique move, Coca-Cola decided to take ownership of the Facebook page

⁷⁸ “Twitter Transparency Report,” online: < <https://transparency.twitter.com> > accessed 8 August 2015; “Twitter Issues New Transparency Report” < scomagazine.com/twitter-issues-new-transparency-report/article/432414/?DCMP=EMC-SCUS_Newswire&spMailingID=12127984&spUserID=MTEyMTEzMDU5NTk2SO&spJobID=600918378&spReportId=NjAwOTE4Mzc4SO > accessed 8 August 2015.

⁷⁹ *Ibid.*

⁸⁰ John Deighton & Leora Kornfield, “Coca-Cola on Facebook” *Harvard Business School*, 15 February 2011, Case 511-110, Description, online: < hbr.org/product/Coca-Cola-on-Facebook/an/511110-PDF-ENG > accessed 8 August 2015.

and let it be run by fans, rather than shutting it down.⁸¹ That matter was settled without court action. In today's context, it is mostly up to trade-mark holders to enforce their trade-marks.

(b) Jurisdictional Concerns in Social Media

(i) James Dean

A case filed in the U.S. involving an English personality, was that concerning the use of a Twitter account @JamesDean and other accounts relating to the use of James Dean.⁸² The estate of James Dean, the deceased English cricketer, filed suit against Twitter (and defendants named as "Does") for trade-mark infringement, among other things.⁸³ Twitter filed to move this case to Federal Court. In this case, the "unauthorized" account was removed from Twitter and the case was dismissed without prejudice.⁸⁴ The other accounts may not have been removed, though the major target was the @JamesDean account.⁸⁵ Jurisdiction was again an issue in this case and can be a challenge in social media.

(ii) Ahmed

In *Ahmed v. Hosting.com*, Ahmed sued Facebook, Inc. (and hosting.com and "Does") for alleged trade-mark infringement on Facebook pages.⁸⁶ Ahmed's cease and desist letter was given in accordance with the *Digital Millenium Copyright Act*, 17 U.S.C. 101. The court dismissed the claim for reasons including Ahmed's lack of standing based on absence of U.S. registered ownership in the alleged trade-marks and on lack of reasonable interest in the alleged mark. Further, there was a failure to establish diversity of citizenship because the plaintiff and defendants were in Pakistan.

⁸¹ K.M. Srivastava, "Social Media in Business and Governance" (Sterling Publishers Private Limited, 2013).

⁸² "James Dean estate drops lawsuit against Twitter" (*USA Today*, 17 December 2014). <usatoday.com/story/news/nation/2014/12/17/james-dean-estate-drops-lawsuit-against-twitter-/20572815> accessed 8 August 2015.

⁸³ *Ibid.*

⁸⁴ *Ibid.*

⁸⁵ *Ibid.*

⁸⁶ 28 F.Supp.3d 82 (2014) as seen in gpo.gov/fdsys/pkg/USCOURTS-mad-1_13-cv-13117/pdf/USCOURTS-mad-1_13-cv-13117-0.pdf.

This is an example of how specific local U.S. law can impact the proceedings, and that jurisdiction is a very important consideration in matters of social media trade-mark legal disputes.

(c) Traditional principles applied in Social Media

(i) *Monte Carlo*

The court found that there was confusing evidence about whether “a sign closer to the Mark had been used to set up the Facebook page.”⁸⁷ The LinkedIn address was found to be even less “similar to the Mark” as was the Twitter username, devoid of the word casino and adding a number to the end.⁸⁸ All were deemed “less similar” and the claim, which included other claims, was dismissed.⁸⁹ From this we can see that traditional U.K. law trade-mark principles are applied to social media account names, though numbering and other issues that are common in social media were raised. It is unclear what a Canadian or U.S. court would decide in similar circumstances in relation to social media.

(ii) *Queen of Tarts*

In Canada, the name Queen of Tarts was being used by a bakery for its store as well as on Facebook and Twitter. The Federal Court in this case of *Pick v. 1180475 Alberta Ltd. (Queen of Tarts)* ordered the bakery and its owner to refrain “from using any trade-name or trade-mark utilizing the words THE QUEEN OF TARTS, QUEEN OF TARTS or any confusingly similar variant thereof” and a permanent injunction “from either directly or indirectly using the words THE QUEEN OF TARTS, QUEEN OF TARTS, or any confusingly similar variant thereof, in any trade-name or trade-mark.”⁹⁰ Although the judgment did not specifically mention the Facebook and Twitter accounts, a news report mentions that “Pick has already shut down Kearney’s Facebook and Twitter accounts that use the name Queen of Tarts.”⁹¹ The general language in the

⁸⁷ [2013] EWPC 38

⁸⁸ *Ibid.*

⁸⁹ *Ibid.*

⁹⁰ 2011 FC 1008 (CanLII), online: <<http://canlii.ca/t/fmtrd>> accessed 2 September 2015.

⁹¹ “Edmonton bakery infringes on Ontario chef’s trademark,” (*The Canadian Press*, 22 January 2012), online: <cbc.ca/m/news/Canada/Toronto/Edmon>

injunction would probably cover any future violating use on social media even if it was not clear. This is an example of a case in which court action was required to obtain an injunction. However, beyond the specific use in this case, there could be many other uses of the trade-mark names on social media which could conceivably require a plaintiff to seek legal remedy through the courts in each instance. Also, traditional principles of confusion were applied in this case.

(iii) Naugles

Another U.S. case resulted in a March 2015 non-precedential decision by the Trademark Trial and Appeal Board who cancelled fast food restaurant, Del Taco's "registration for the mark Naugles for restaurant services, finding its owner, . . . had beginning in 1995 abandoned the use of the mark for a period of more than three consecutive years without an intent to resume use."⁹² Zeibarth, who brought the action against Del Taco, had registered a @naugles account on Twitter and has "actively 'tweeted' under the handle 'Señor Naugles'."⁹³ The Board's order specifically mentioned that this, along with other use, was evidence that he "had a bonafide intent to use the mark."⁹⁴

(d) Action by Social Media Company

(i) La Russa

In 2009, Anthony La Russa — manager of the St. Louis Cardinals — filed suit in a California Court against Twitter (and Does 1-25) because an "unknown Twitter user created an account at twitter.com/TonyLaRussa and pretended to post updates as La Russa."⁹⁵ Shortly after the lawsuit, Twitter removed the page and

ton-bakery-infringes-on-ontario-chef-s-trademark-1.1159266 > accessed 8 August 2015.

⁹² "Del Taco dinged at TTAB," online: < insidecounsel.com/2015/06/01/new-life-for-naugles-del-taco-dinged-at-ttab > accessed 2 September 2015.

⁹³ *Ibid.*

⁹⁴ See *Christian M. Zeibart v. Del Taco, LLC*, Trademark Trial and Appeal Board, United States Trademark and Appeal Board Decision, Cancellation No. 92053501 against Registration No. 1043729, mailed March 31, 2015.

⁹⁵ "*La Russa v. Twitter, Inc.*," (*Digital Media Law Project*, 2009), online: < dlmp.org/threats/la-russa-v-twitter-inc > accessed 8 August 2015.

eventually the case was eventually dismissed voluntarily,⁹⁶ although, because of the “parodic” tweets, it is unclear whether Mr. La Russa would have succeeded in a court action.⁹⁷ Despite being able to register the name of another as a username, the plaintiff in this case might have lost. This raises concerns in a social media context because if one obtains a social media account such as the one in this case, it can be used or abused at different intervals. Social media is not static in the sense that some people may view particular tweets, or information on a Facebook account, yet some tweets might be parodic while others are not. Therefore, the situation is not as clear as one would think. Further the trade-mark username does raise its own issues as discussed above.

(e) Recognition of Username as Problematic

(i) NYC Triathlon Club

New York City Triathlon, LLC v. NYC Triathlon Club, Inc. involved a preliminary injunction motion involving use of trademarks on, *inter alia*, Facebook, Twitter and LinkedIn accounts/pages.⁹⁸ The court ordered the defendant to “immediately refrain from using infringing marks on its site and all other webpages within its control, such as, but not limited to, its Facebook, Twitter, and LinkedIn pages.”⁹⁹ In fact, the defendant had a Twitter handle username of “nyctrclub” and even though not accepting more followers, and despite protecting tweets, the username was still visible.¹⁰⁰ Unlike the La Russa case above, this case concerned more of the username itself and shows that a username alone can be infringing. This is another example where the use of multiple social media can cause enforcement complications, however, the court recognizes that usernames alone can be problematic.

⁹⁶ *Ibid.*

⁹⁷ Kieth A. Welsch & Peter I. Bernstein, “Trademark Enforcement in Social Media,” Scully, Scott, Murphy & Presser, P.C., online: <http://www.ssmpp.com/pdfs/CT_1308_Trademark-Enforcement.pdf>.

⁹⁸ 704 F.Supp.2d 305 (S.D. N.Y., 2010).

⁹⁹ *Ibid.*

¹⁰⁰ *Ibid.*

(f) Use in Commerce and Social Media**(i) Avepoint**

In, *AvePoint, Inc. v. Power Tools, Inc.*, it was alleged that a LinkedIn account was created “for a fictitious AvePoint representative using the AvePoint mark.”¹⁰¹ The court held that the use in commerce requirement was met through LinkedIn because the site is often used for establishing business and customer relationships. This was because, the LinkedIn page was used to “profit from AvePoints goodwill and divert business to Axceler” and not just as a resumé page for potential employers.¹⁰² Therefore, use was established recognizing modern purposes of social media.

(g) Resolution where User Unknown**(i) Coventry First**

Another Twitter case involves the Twitter account @coventryfirst.¹⁰³ This lawsuit was filed against a John Doe and did not actually name Twitter as a party.¹⁰⁴ Again, soon after a lawsuit was filed, the case was withdrawn so there was no decision in this case, though the alleged offender and account-holder changed the Twitter name to @coventryfirstin.^{105, 106}

(ii) ONEOK

Likewise, the 2009 case against Twitter by ONEOK, Inc. was voluntarily dismissed after the @ONEOK account was transferred to them.¹⁰⁷ As can be seen from a few cases, often the user is unknown. Therefore, local procedure, such as suing a fictitious defendant needs to be utilized.

¹⁰¹ 981 F.Supp.2d 496 (2013) as seen in vavd.uscourts.gov/OPINIONS/CONRAD/avepointpowertoolopor.pdf.

¹⁰² *Ibid.*

¹⁰³ As seen in *McHale supra* note 37.

¹⁰⁴ “Twittersquatting Cases Arise,” online: < insidecounsel.com/2011/06/13/twitter-squatting-cases-arise > accessed 8 August 2015.

¹⁰⁵ As seen in *McHale supra* note 37.

¹⁰⁶ *Ibid.*

¹⁰⁷ *Ibid.*

A look at these cases and scenarios shows that, as compared to Canada and the U.K., the U.S. has had more activity in this sphere. Although, it is clear that some of the action is based upon the fact that the social media companies are located in the U.S. and many require disputes to be brought under local U.S. or California laws as per the terms. These cases also illuminate the social media specific problems that were identified above including infringement issues, jurisdictional concerns, user identities and complications in applying use and confusion requirements and addressing defences. Some of the cases did not make it far, and, as a result, there are still many unknowns. Thus, the cases can only provide some indication.

5. SOCIAL MEDIA TERMS AND CONDITIONS AS A SOLUTION

When signing up for a social media account, terms and conditions must be agreed to, which can form a key basis on which disputes regarding trade-mark infringement are determined. Below, is an overview of the key terms of the social media companies, relating to trade-marks. The social media company is often the arbitrator of the complaint and decides the outcome, including the validity of any defense. However, there is no uniform standard to make these decisions. Individual terms of social media companies differ in some respects, though they do have some commonalities. Terms are also subject to change, which can alter the situation from time to time. However, some articulate concerns regarding this mechanism of dispute resolution and prefer a uniform approach as discussed towards the end of the article.

(a) Facebook

Facebook terms, section 5, number 2 states that “We can remove any content or information you post on Facebook if we believe that it violates this Statement or our policies” thus providing the social media giant to retain the broad power to decide what content gets removed.¹⁰⁸ Number 3 provides a mechanism to “report claims of intellectual property infringement.” Section 4, number 10 covers usernames and states “If you select a username or similar identifier for your account or

¹⁰⁸ “Facebook Statement of Rights and Responsibilities,” online: <[facebook.com/legal/terms](https://www.facebook.com/legal/terms)> .

Page, we reserve the right to remove or reclaim it if we believe it is appropriate” and it goes on to refer to trade-mark complaints as an example.¹⁰⁹ Facebook’s trade-mark complaint form includes usernames as an option, and has issued guidelines which state that the “username must adhere to the Facebook Statement of Rights and Responsibilities.”¹¹⁰ “Imposter Accounts aren’t allowed on Facebook.”¹¹¹ If a mark holder decides to complain, and not all do (in fact many do not even know about certain violations or do not actively police their marks, whereas others choose not to, for instance fearing looking like a bully, *etc.*), Facebook can decide whether a username like Facebook.com/trademarkname will be reclaimed or removed based on the policy.

(b) Twitter

Twitter’s Terms of Service in section 8 authorizes Twitter to “. . . remove or refuse to distribute any Content on the Services, to suspend or terminate users, and to reclaim usernames without liability to you.”¹¹² Under section 9, the company says that “Twitter respects the intellectual property rights of others and expects users of the Services to do the same.”¹¹³ Here, it specifically is addressing intellectual property, though under the Copyright head. Mark holders may welcome the position that Twitter reserves the right to reclaim usernames, however, in this section, no reason is given by Twitter as to when a username may be reclaimed. Twitter’s Trademark Policy states that “[w]hen we determine that an account appears to be confusing users, but is not purposefully passing itself off as the trade-marked good or service, we give the account holder an opportunity to clear up any potential

¹⁰⁹ *Ibid.*

¹¹⁰ “What are the guidelines around creating a custom username for my Page or profile,” online: < <https://m.Facebook.com/help/105399436216001?refid=69> > accessed May 2016.

¹¹¹ “How do I report a fake account that’s pretending to be me” (*Facebook*) < <https://m.Facebook.com/help/174210519303259?refid=69> > accessed May 2016.

¹¹² “Twitter Terms of Service” (Twitter, January 27, 2016), online: < twitter.com/tos?land=eng > .

¹¹³ *Ibid.*

confusion.”¹¹⁴ However, it is unclear exactly what would suffice under the policy or what would be required to clear such confusion.¹¹⁵

The Policy also states that “[w]e may also release a username for the trademark holder’s active use.”¹¹⁶ This provision gives enforcement power to Twitter to decide and take action against trade-mark infringement within its service. Specifically, “[w]e reserve the right to reclaim usernames on behalf of businesses or individuals that hold legal claim or trademark on those usernames.

Accounts using business names and/or logos to mislead others may be permanently suspended.”¹¹⁷ There is a specific Impersonation policy provisions include that “portraying another person in a confusing or deceptive manner may be permanently suspended”¹¹⁸ However, “similar usernames or that are similar in appearance . . . are not automatically in violation.”¹¹⁹ A profile which “clearly states it is not affiliated” does not get removed.¹²⁰ “Twitter users are allowed to create parody, commentary, or fan accounts.”¹²¹ Thus, many angles of protection are provided to trade-mark holders, although exceptions are recognized for users as well. Unlike other companies, Twitter’s Rules have a specific “username squatting policy” which lists factors Twitter will take into consideration such as “number of accounts created,” “purpose of preventing others from using,” “for the purpose of selling” *etc.*¹²² Under the impersonation policy, the account name may use words such as “not,” “fake,” or “fan” and be done in “such a way that would be understood by the intended audience.”¹²³

¹¹⁴ “Twitter, Trademark Policy” (*Twitter*, January 27, 2016), online: < support.twitter.com/articles/18367 > accessed May 2016.

¹¹⁵ *Ibid.*

¹¹⁶ *Ibid.*

¹¹⁷ “Twitter Rules, Content Boundaries and Use of Twitter,” online: < https://support.twitter.com/articles/18311 > accessed May 2016.

¹¹⁸ “Twitter, Impersonation Policy,” online: < support.twitter.com/articles/18366 > accessed May 2016.

¹¹⁹ *Ibid.*

¹²⁰ *Ibid.*

¹²¹ *Ibid.*

¹²² *Ibid.*

¹²³ *Supra* note 120.

(c) Pinterest

Pinterest's Acceptable Use Policy prohibits anything that "infringes anyone's intellectual property."¹²⁴ Users cannot "[i]mpersonate or misrepresent your affiliation with any person or entity."¹²⁵ Further, users cannot "[d]o anything that violates applicable law or regulations."¹²⁶ Additionally, to help prevent the social media version of cybersquatting, Pinterest says that you cannot "[s]ell your username or otherwise transfer it for compensation."¹²⁷ Pinterest also has a specific Trademark Policy. "Pinterest respects the trademark rights of others. Accounts with usernames, Pin Board names, or any other content that misleads others or violates another's trademark may be updated, transferred or permanently suspended."¹²⁸ There is a specific trade-mark form and "Pinterest will review your submission and take whatever action, in its sole discretion, it deems appropriate, including temporary or permanent removal of the trademark from the Pinterest site."¹²⁹

(d) LinkedIn

LinkedIn's user agreement under section 8.2, requires that users will not "[v]iolate intellectual property rights of others, including patents, trademarks, trade secrets, copyrights or other proprietary rights."¹³⁰ Also users, under section 8.1 agree to "[c]omply with all applicable laws, including, without limitation, privacy laws, intellectual property laws"¹³¹ If this is violated, under section 3.4, "LinkedIn reserves the right to restrict, suspend, or terminate your account if LinkedIn believes that you may be in breach of this Agreement or law or are misusing the Services (e.g.

¹²⁴ "Pinterest Acceptable Use Policy," online: < <https://about.pinterest.com/en/acceptable-use-policy> > accessed May 2016.

¹²⁵ *Ibid.*

¹²⁶ *Ibid.*

¹²⁷ *Ibid.*

¹²⁸ "Pinterest Trademark Policy" (*Pinterest*), online: < <https://about.pinterest.com/en/trademark> > accessed 8 May 2015.

¹²⁹ *Ibid.*

¹³⁰ "LinkedIn User Agreement" (*LinkedIn*, 23 October 2014), online: < <https://www.linkedin.com/legal/user-agreement?trk=uno-reg-join-mobile-user-agreement> > accessed May 2016.

¹³¹ *Ibid.*

violating any Do and Don'ts)."¹³² A policy as well as complaint procedure is available along with a form.¹³³ This provides an avenue for trade-mark owners to complain about alleged misuse of their trade-marks on LinkedIn.

(e) Google+

Google's Terms of Service do not specifically mention trademarks (but there is a copyright section). However, under Copyright in Gmail Program Policies, it states "[d]on't infringe on the intellectual property rights of others, (including patent, trademark, trade secret, copyright, and other proprietary rights), or encourage or induce infringement of intellectual property rights."¹³⁴ Section 12 of the Google+ User Content and Conduct Policy specifically prohibits impersonation and says that you cannot use the services to "mislead or confuse users by pretending to be someone else or pretending to represent an organization you do not represent."¹³⁵ Specific impersonation guidelines are available.¹³⁶ Google also provides a procedure to "report content that you would like removed from Google's services under applicable laws."¹³⁷

(f) Comparison Shows Common Trends and Marked Differences

As can be seen from the above analysis and the chart below, each social media outlet has some term(s), policy or form to complain about alleged trade-mark violations on their sites. These complaints will usually follow an investigation by the social media outlet, which is empowered to make the decision of whether the material gets taken down, or otherwise dealt with in accordance with the terms or applicable policies and the law. Action can include removal of content, transfer of usernames or other action, if a violation is found as per the terms. However, not all rules are

¹³² *Ibid.*

¹³³ *Ibid.*

¹³⁴ "Gmail Program Policies," online: <google.com/intl/en_us/mail/help/program_policies.html> accessed May 2016.

¹³⁵ "Google+ User Content and Conduct Policy," online: <google.com/intl/en/+/policy/content.html> accessed May 2016.

¹³⁶ "Impersonation," online: <support.google.com/plus/answer/2370152> accessed May 2016.

¹³⁷ "Removing Content From Google-Legal Help" (*Google*), online: <support.google.com/legal/troubleshooter/1149005?hl=en> accessed May 2016.

consistent. What might be acceptable under certain terms, may not work in others. Also, one social media company may apply the rules relating to confusion, use and defences differently than others.

Social Media Terms/Rules Comparison Chart¹³⁸

Social Media Outlet	Specifically mentions the word 'Trade-mark' on Main Terms page	Has Specific Trade-mark Term, Policy, etc.	Has Trade-mark Complaint/ Claim/ Report Form	Possible Action Listed	Applicable Law Stated	Forum/ Venue stated in Terms	Agreement with?
Facebook	Yes	Yes	Yes	Remove or Re-claim	Laws of the State of California (without regard to conflict of law provisions)	US District Court for the Northern District of California or a State Court in San Mateo County, California	Facebook, Inc. (USA) if within Canada and US Otherwise, Facebook Ireland Limited
Twitter	No (only indirectly)	Yes Specific Username Squatting Policy	Yes	Suspend Account and notify account holder Opportunity to clear up potential confusion when not purposely passing off as trademarked good/services Release username for trademark holders active use	Laws of the State of California (without regard to conflict of law provisions) Special rules for government entities in official capacity	Federal or state courts located in San Francisco County, California, USA	Twitter, Inc. (USA) if within the United States. Otherwise, Twitter International Company (Ireland)

¹³⁸ Information for this chart is from policies, rules and agreements, *etc.* of the social media companies

Social Media Outlet	Specifically mentions the word 'Trade-mark' on Main Terms page	Has Specific Trade-mark Term, Policy, etc.	Has Trade-mark Complaint/ Claim/ Report Form	Possible Action Listed	Applicable Law Stated	Forum/ Venue stated in Terms	Agreement with?
Pinterest	No	Yes	Yes	Updated Transferred Permanently Suspended Temporary or permanent removal	Laws of the State of California (without regard to conflict of law provisions)	State court located in San Francisco, California or the US District Court for the Northern District of California, for and actions not subject to Arbitration clause	Pinterest, Inc.
LinkedIn	Yes	Yes Also False Profile Policy (including impersonation)	Yes	restrict, suspend, or terminate	Laws of the State of California (without regard to conflict of law provisions)	Federal or State courts of Santa Clara County, California, USA	For notices/ services of process LinkedIn Corporation (USA) LinkedIn Ireland (Others)
Google +	No (but covered under intellectual property)	No (has impersonation policy and other terms)	Yes (but as part of a general tool for removing content)	Removal	Laws of the State of California (without regard to conflict of law provisions)	Federal or State courts of Santa Clara County, California, USA	Google Inc.

(g) Jurisdiction, Choice of Law, Forum and Venue

Social media companies often state jurisdiction and venue directly in their terms. This is important because it affects which laws may apply to disputes involving court action. Not surprisingly, all of the social media companies under the study have stated California law as the applicable law, without regard to conflict of law provisions. Where applicable, users have a “deal” with the U.S.

or Irish company. Unless a court finds otherwise, California laws will be applicable to lawsuits against the social media companies. Social media companies want lawsuits to be within the State and Federal courts of California as stated in each of the above companies' terms, partially to keep lawsuits local. In the 2015 Canadian case of *Douez v. Facebook, Inc.*, Facebook successfully appealed a certification of class action in which it was decided that "the forum selection clause should be enforced . . ." and the plaintiff must sue in Santa Clara, California if she wished.¹³⁹ Although, more generally, not all courts have upheld forum selection clauses in contracts or policies online and the law can differ widely in this regard causing much uncertainty.¹⁴⁰

(h) Domain Name Resolution Policies Do Not Apply to Social Media

The UDRP does not take into account social media usernames. It can be used by users in Canada, the U.K. and in the U.S. and many other countries and the procedure outlines rules for "binding arbitration proceeding that is administered by an ICANN-authorized arbitrator."¹⁴¹ Trade-mark holders can take advantage of "expedited administrative proceedings."¹⁴² Often, these can be cheaper than instituting court proceedings, though remedies may be limited as compared to a court of law. Also, with the introduction of new Top Level Domains (TLDs), ICANN has established a "range of Rights Protection Mechanisms (RPMs) notably for trademarks."¹⁴³ Some argue that the benefits of an application of such dispute resolution policies as the UDRP or legislation such as the *Anticybersquatting Consumer Protection Act* to social media usernames may be obvious, however, these jurisdictions have not

¹³⁹ 2015 BCCA 279, online: < documentcloud.org/documents/2107851-2015-bcca-279-douez-v-Facebook.html > accessed 1 September 2015; "Facebook Wins Appeal to Stop BC Class Action Lawsuit Over Privacy" (*CBC*), online: 1.3120849 > accessed 1 September 2015.

¹⁴⁰ Such as in *Ajemian v. Yahoo!*, 12-P-178 (Mass. Ct. App. May 7, 2013) as seen in V. Balasubramaniam, "Yahoo's User Agreement Fails in Battle Over Dead User's Email Account" Eric Goldman, Technology & Marketing Law Blog, online: < blog.ericgoldman.org/archives/2013/05/yahoos_user_agr.htm > .

¹⁴¹ "UDRP" (*ICANN*), online: < icann.org/resources/pages/help/dndr/udrpen > accessed 8 August 2015.

¹⁴² *Ibid.*

¹⁴³ "RPM" (*WIPO*), online: accessed September 2015.

mandated such a policy or legislation.¹⁴⁴ It is argued that a workable solution may include addressing common trade-mark violations within a social media context, such as unauthorized usernames under similar principles as those in the UDRP which we will now explore.

6. UDRP FOR SOCIAL MEDIA?

There is no doubt that the gaps in traditional trade-mark law brought about by the use of trade-marks in social media need to be filled. Currently, parties rely on the general trade-mark law and the courts or the complaint procedures set out by the individual social media companies to resolve trade-mark disputes, though jurisdictional and venue issues may arise. These raise concerns as identified above and these problems were not contemplated by the legislation. New technology has always given rise to novel intellectual property legal concerns and this is not the first time the law is slow to catch up, despite already having an alternative approach to domain name disputes.

However, some have suggested a UDRP for social media.¹⁴⁵ This is a plausible approach given the similarities between the trade-mark issues raised by domain names and social media usernames. This article proposes that such approach can resolve many of the gaps that have been identified in the current framework above and can provide a uniform mechanism in which social media usernames can be resolved. For purposes of this analysis, we will refer to this by a proposed name, Uniform Social Media Username Dispute Resolution Procedure (USMUDRP).

Below are discussed the various gaps that may be filled along with, as a practical matter, some UDRP provisions that can be transplanted to a USMUDRP.¹⁴⁶ A username will be specifically

¹⁴⁴ See for example Thomas J. Curtin, “The Name Game: Cybersquatting and Trademark Infringement on Social Media Websites” (2010-2011) 19 J.L. & Pol’y 353; “Domain Names & Social Media Committee”, *Intellectual Property Office*, online: < ipo.org/index.php/about-ipo/committees/internet-domain-names-committee/ > accessed 2 September 2015.

¹⁴⁵ *Ibid.*

¹⁴⁶ Provisions discussed below are taken from like provisions in the UDRP available at < <https://www.icann.org/resources/pages/policy-2012-02-25-en> > .

defined and a USMUDRP must be incorporated by reference into the social media terms and conditions of use when one signs up for a social media account as is done in the UDRP setting. Also, “Rules of Procedure” need to be set up for deciding social media username disputes in this alternative dispute resolution setting.¹⁴⁷

(a) Uniform Method across Jurisdictions

A USMUDRP can provide a single resolution method for major social media outlets and can be made available in multiple jurisdictions to avoid the current problems respecting jurisdiction, forum and venue. Having a pre-determined and specified approach such as a panel for decision making can simplify the process and avoid litigation and confusion concerning these matters. Also, the fees and process for a USMUDRP proceeding should generally reflect a more cost effective and faster process. Certain rules such as no transfer of usernames to any other party during a proceeding shall be instituted.

(b) Remedies Can Be Ordered; Identity Not Necessary

Like the UDRP, remedies can include a temporary block pending a determination and eventual cancellation or transfer of a social media username to a mark-holder if deemed appropriate. An administrative panel order may be enforced through the social media company and there will not be a need to know the identity of the violating user as the social media company would have access to the account and can take appropriate action. Of course, due process and related concerns need to be addressed by ensuring notice and opportunity under the circumstances. An email address is required on signup and this may be one available method to communicate with users.

(c) Uniform Infringement Rules and Defences

There is a need for consistency in the rules, as identified earlier. Mandatory proceedings can be required under certain circumstances, similar to the UDRP. For example, this can be when the social media username is “confusing similar” and there are “no rights or legitimate interests” and when the social media username has been “registered and is being used in bad faith”

¹⁴⁷ As seen in the UDRP available at < <https://www.icann.org/resources/pages/policy-2012-02-25-en> > .

including dilutive use.¹⁴⁸ Specific circumstances of bad faith may be listed. Even country specific prohibitions can be accommodated within the policy. Similarly, specific defences can be offered such as use of the social media username “in connection with a bona fide offering of goods or services” or “legitimate non-commercial or fair use” of the social media username.¹⁴⁹ These can offer consistency such that a social media user can be clear about what is acceptable or not with regard to social media usernames and the mark holder can enforce against violations. Currently this is not the case because of the differences in various jurisdictions and alternative methods of application.

(d) Avoid Inconsistent Decisions

Under social media terms, it is possible that inconsistent decisions could result from the different companies as each have set their own rules as seen above. A uniform policy can be a guiding force to consistent decisions if implemented properly and impartiality in decisions makers exists. Also, decisions may be published on the social media site for purposes of disclosure.

(e) Each Major Social Media Platform Can Be Considered

As analyzed through the terms of each social media company, it is evident that trade-marks are of concern in social media and all have attempted to address the same. It is not a far stretch to implement a uniform approach even if some differences exist. All major social media platforms can be incorporated in this uniform mechanism and similar rules and proceedings can apply to all because the main username trade-mark issues are generally the same. A USMUDRP can also require the user to confirm that, to the user’s knowledge, no infringement is taking place by registration of the username.

(f) System of Prompt Address; Rapid Suspension Orders

As with the URS system earlier discussed, a prompt mechanism of address may be offered which can result in rapid suspension

¹⁴⁸ As seen in the UDRP available at < <https://www.icann.org/resources/pages/policy-2012-02-25-en> > .

¹⁴⁹ As seen in the UDRP available at < <https://www.icann.org/resources/pages/policy-2012-02-25-en> > .

orders under specified circumstances such as clear username violations.

(g) Court Option Still Available

A court action may be filed after a USMUDRP panel decision and there could be a similar waiting period as in the UDRP before the administrative proceeding decision goes into effect to ensure no court action was taken and proof provided.

(h) Challenges Outweighed by Benefits

The approach is not without its challenges, however, the benefits described above can be tremendous and important gaps will be filled. There are several popular social media outlets and a uniform solution will need to be applied to at least all major social media. Even the UDRP includes some but not all of the country level domain names.¹⁵⁰ The specific social media covered will need to be clearly defined and a proceeding may be able to incorporate different platforms providing the username issues overlap and they were registered by the same party. Also, this approach may be adopted specifically for usernames, though it is recognized that not all trade-mark use in social media will be covered and alternative methods will need to be utilized in circumstances of other alleged violations. This, however, is not unlike the UDRP which does not deal with matters outside the specific domain name issues covered as seen in section 5 of such policy. Additionally, panel members will need well designed training such that decisions can be made consistently. Of course, the policy will need to be made considering information from stakeholders and coming up with what may be a workable solution in such an environment.

7. CONCLUSION

Under existing law, cancelling or obtaining a username which includes a trade-mark can be complicated. Social media raises novel issues not contemplated by the legislation when drafted. Additionally, the international context of social media raises several concerns and laws vary across jurisdictions at least in some regards. This leaves many gaps as identified in this article

¹⁵⁰ “UDRP,” online: < <https://www.icann.org/resources/pages/policy-2012-02-25-en> > .

which produce a clear want of a new framework. One solution is to have a UDRP related policy for social media.

The possibility of having uniform rules may be premised on a USMUDRP that is acceptable from an international perspective. This means that the rules covered must factor in common trends amongst jurisdictions. The UDRP appears to have taken like concepts from amongst jurisdictions and applied them within the domain name setting. Some of those provisions are directly applicable in a social media username setting and can prove to be a plausible solution.

Therefore, a carefully drafted policy can allow for many of the gaps under existing laws and mechanisms to be filled, and can be an effective tool for resolution of social media trade-mark disputes, especially from the perspective of usernames.

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