



Trade Mark Enforcement in Social Media

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Abstract

In the era of mobile internet, the social media platform is not only a way for people to share experiences, to establish interpersonal communication, but also a tool for advertising and marketing. In modern business society, trademarks are not just representative of specific goods, services or activities, it is also an important intangible asset for trademark holders to obtain brand benefits. With the good interactivity of social media, the brand influence of trademarks, the efficiency of marketing has multiplied. However, it was followed by trademark infringement caused by brand hijacking, trademark dilution, and proliferation of counterfeit goods.

This article will discuss the enforcement of trade marks in social media from four aspects. First, a comprehensive description of the concept, content and impact of digital marketing and social media marketing. Explain in detail the business background of social media marketing and the three major challenges that trademarks face in social networking marketing. Secondly, it expounds the meaning of brand hijacking and analyzes the first major challenge of social media marketing trademark infringement. Again, discuss the second challenge facing social media marketing, namely trademark dilution. Finally, discuss the issue of counterfeit goods in social media marketing.

Key Words: trade mark enforcement, social media, digital marketing, social media marketing, brandjacking, dilution, counterfeit goods.

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The Trade Mark Enforcement in Social Media

1 Introduction

Trade marks serve more and more as a crucial marketing and advertising tools and less as a means of identifying a product's source or sponsorship in the digital era. This change in the function of trademarks has been described as a transformation from 'signals' to 'symbols'.¹ More recently, trademarks have taken on new roles.² Trademarks give way to provide consumers with an identity, such as FORD "driver", COCO-COLA "drinker" or DIOR "fashionista". When consumers buy a product with a trade mark closely linked, they purchase an 'experience envelope' that helps to construct their identity. The concept of a trademark can be seen in the increased attention given to 'brands'.³ In fact, in modern commercial society, especially in the internet-based e-commerce era, the brand has exceeded its function as product identification. Trademarks, as a key-words in the searching engine, social media account, and the sign of the e-commerce platform, have become the essential element in digital marketing and e-commercial trade. Moreover, through marketing, advertising and packaging of the product, trademarks have acquired new function and commercial value to become important commercial assets. Nike and Adidas are more than sports equipment, they stand for a spirit of sport even a way of life. In the era of digital media, the development of mobile internet technology has made the channels of trademark communication more diversified, and the influence of brand diffusion has broken geographical restrictions. Brand marketing is more direct and more efficient. Looking back at history, every technological innovation will lead to new forms of trademark infringement. There may be several potential

¹ T. Drescher, 'The Transformation and Evolution of Trademarks: From Signals to Symbols to Myth' (1992) 82 TM Rep 301.

² T. Dreyfuss, 'Expressive Genericity: Trademarks as a language in the Pepsi Generation' (1990) 65 Notre Dame L Rev 397,397-8.

³ J. Davis, 'The value of Trade Marks: Economic Assets and Cultural Icons', in Y. Gendreau (ed.), *Propriete intellectuelle: entre l'art et l'argent* [Intellectual Property: Bridging Aesthetics and Economics] (2006)97-125.

infringements in this newly commercial development online such as brand reputation management, “brand jacking”, the new forms of dilution in the social media world etc.

The greatest change, in the Modern Commercial Society, was that a trademark not only represented the origin of the goods but also became a valuable asset in their own right.⁴ As professor Bently stated, “Some marks, by virtue of their distinctiveness or appeal, were able to convey some sort of emotional allure to potential consumers.” Indeed, the mark was not only seen as a sign of origin or quality but as a result of a so-called ‘advertising’ quality.⁵

Along with the diversification of trademark function, marketing methods have changed accordingly. The improvement of production technology promotes mass production, and businessmen focus more on enhancing the competitiveness of products by increasing the influence of trademarks. Therefore, how to improve the efficiency of marketing and expand the influence of branded goods has become an important issue for marketing tools and strategies in the digital environment. Consumers initially talk about the information of products and services to their friends and families within a very small social network. This type of marketing has emerged as a “word-of-mouth marketing”. The impact of brand transmission has become more narrow. Consequently, this phenomenon has significantly changed marketing and advertising in the digital era. It is easy for millions of consumers to get information about the products through television and radio broadcasting. The marketing mode has also changed from word-of-mouth to multimedia communication with graphics and sound. Although the use of multimedia has improved marketing efficiency, it has also increased the number of audiences for trademark communication and improved the influence of product brands. The use of multimedia marketing has remained within regional areas. The impact of the brand is still confined to certain areas where the advertisement takes place. With the

⁴ *Eastman Photographic Material Co. v John Griffith Cycle Corp.* [1898] 15 RPC 105.

⁵ R. Brown, 'Advertising and the Public Interest: The Legal Protection of Trade Symbols' (1948) 57 Yale LJ 1165, 1189.

advent of the Internet, information dissemination and interpersonal communication have broken the geographical restrictions. The development of information technology has led to the advancement of Internet-based e-commerce. The mode of marketing, in the era of the internet, have also changed dramatically. The emergence of the mobile internet, especially as the social media boom, enables consumers to share information anywhere and anytime. Because of the new development of Internet technology, especially the mobile internet technology, the new set of methods of marketing called digital marketing, has appeared. It does not only focus on the consumers but also attempting to create a new system including different clients, sellers, and producers. As the definition made by American Marketing Association, "Marketing is the activity, set of institutions, and processes for creating, communicating, delivering, and exchanging offerings that have value for customers, clients, partners, and society at large."⁶ When the interactive social platform built by the mobile Internet, namely the social network, is highly integrated with the marketing activity, marketing through mobile networks will become the most efficient and widespread digital marketing method in the Internet era. Therefore, the internet technology not enhances the influence of the trademark but also makes the digital marketing methods much more diversified.

This article will discuss the enforcement of trade marks in social media from four aspects. First, a comprehensive description of the concept, content and impact of digital marketing and social media marketing. Explain in detail the business background of social media marketing and the three major challenges that trademarks face in social networking marketing. Secondly, it expounds the meaning of brand hijacking and analyzes the first major challenge of social media marketing trademark infringement. Again, discuss the second challenge facing social media marketing, namely trademark dilution. Finally, discuss the issue of counterfeit goods in social media marketing.

⁶ American Marketing Association, 'Definition of marketing' (2013, July). Available at: <https://www.ama.org/AboutAMA/Pages/Definition-of-Marketing.aspx>. (Accessed: 6 July 2018)

2 Introducing Digital and Social Media Marketing

The definition of the digital marketing is very simply: Achieving marketing objectives by applying digital technologies and media.⁷ With the development of the internet and other digital media technologies, modern marketing has taken great changes. Different digital technology will produce different marketing activities on different technology platforms.

2.1 Mobile Phone and Tablet Platforms

In recent, years, the number of people who access through the Internet by using mobile phone and tablet has been rising constantly. According to a survey conducted by the Pew Research Center in January 2018, with the popularity of smartphones and other mobile devices, 26% of American adults now report that they are “almost constantly” online, up from 21% in 2015. Meanwhile, the hours which the netizen spend on also have been increasing steadily. Overall 77% of Americans go online every day. This figure includes 26% of people who are almost online, 43% say they go online several times a day, and 8% go online once a day. About 11% of people go online several times a week or less, while 11% say they don't go online at all. (see below Figure 1)

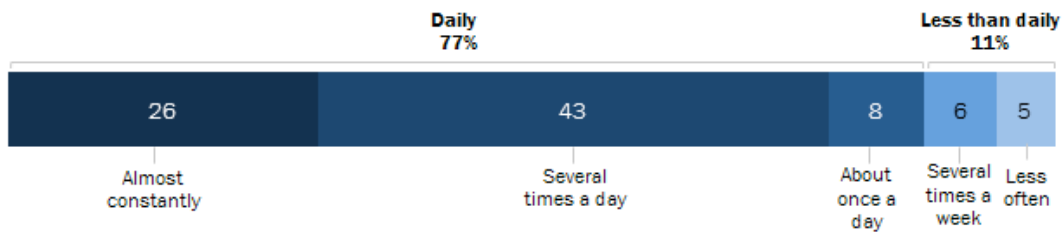
Figure 1: ⁸

⁷ Dave Chaffey & Fiona Ellis-Chadwich, *Digital Marketing: Strategy, Implementation, and Practice*, (6th edn, PEARSON, 2016)

⁸ Andrew Perrin and Jingjing Jiang, 'About a quarter of U.S. adults say they are 'almost constantly' online,' (2018) Pew Research Center. Available at: <http://www.pewresearch.org/fact-tank/2018/03/14/about-a-quarter-of-americans-report-going-online-almost-constantly/> (Accessed: July 20, 2018)

Roughly three-quarters of Americans go online at least daily

% of U.S. adults who say they go online ...

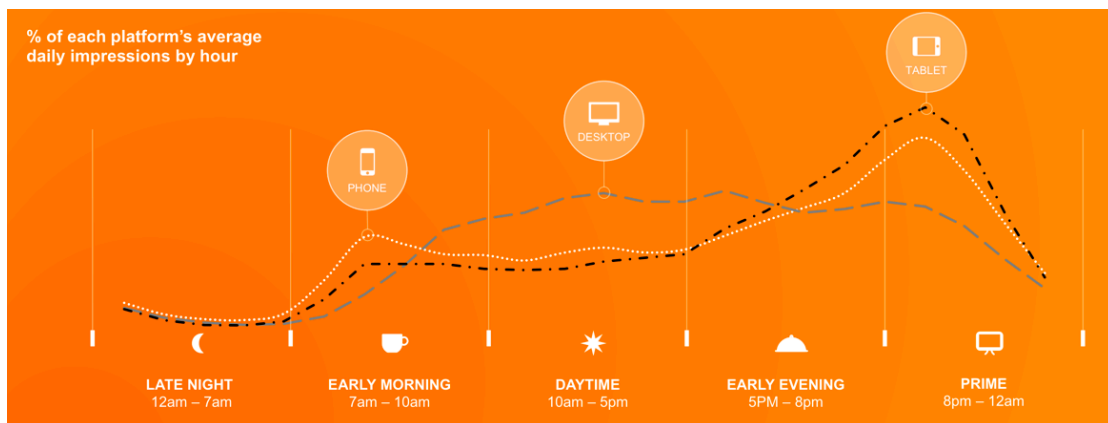


Note: Figures do not add up to 100% because non-internet users were not asked the question.
Source: Survey conducted Jan. 3-10, 2018.

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On the other hand, the proportion of using the desktop and using a smartphone to surf the Internet alternates over time for the whole day. (see below Figure 2)⁹ It is obvious to see that the desktop is still dominating the daytime, but mobile terminals have become the leading role in the evening. It is important to note that the leisure time is the main battlefield for marketing. In other words, if the merchant cannot attract the consumers or potential consumers through the mobile search or display, or they are not able to provide great visual experience and satisfactory mobile experience, they will surrender their territory to their competitors.¹⁰

Figure 2:¹¹



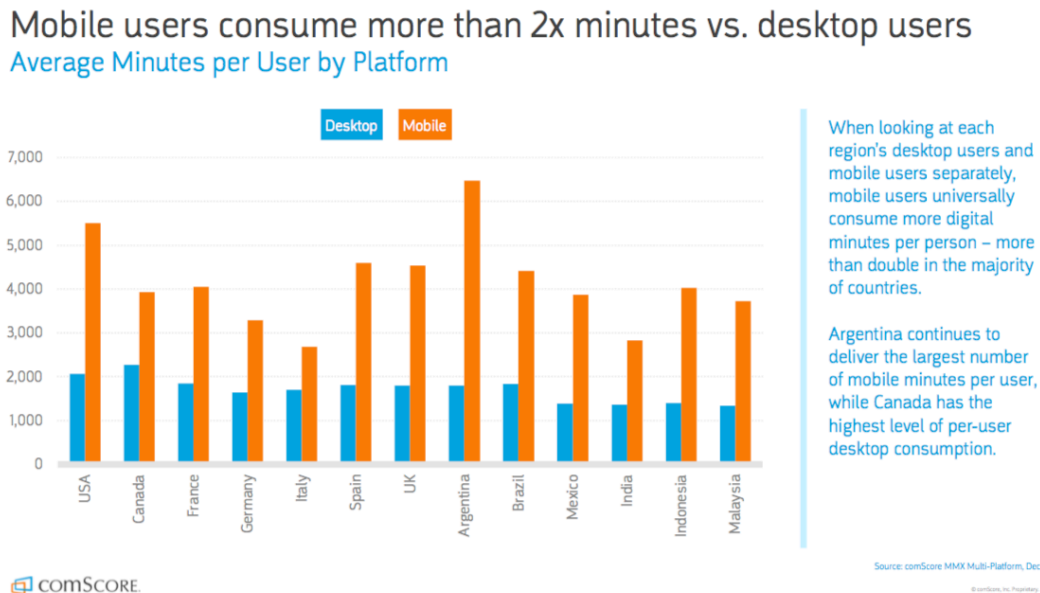
⁹ Dave Chaffey, 'Mobile Marketing Statistics compilation' (2018) Smart Insights. Available at: <https://www.smartinsights.com/mobile-marketing/mobile-marketing-analytics/mobile-marketing-statistics/> (Accessed: July 18, 2018)

¹⁰ Id.

¹¹ Available at: <https://www.smartinsights.com/mobile-marketing/mobile-marketing-analytics/mobile-marketing-statistics/attachment/2017-mobile-use-through-day/> (Accessed: July 18, 2018)

Moreover, according to the comScore Digital Future in focus report, the survey indicates how mobile dominates in minutes in 9 global markets (USA, Canada, UK, Spain, Italy, Brazil, Mexico, China and Indonesia)¹²(see below Figure 3)

Figure 3:¹³



Obviously, the smartphones and tablets have surpassed the desktop platform to become the main tools for users to obtain information or make commodity transactions.

2.2 The Crucial Types of Digital Media Marketing Tools

Marketers must review many online communication tools as part of their communication strategy or as part of planning online marketing campaigns. According to Chaffey and Smith (2012)¹⁴, these online marketing tools are divided into the six main categories:

(1) Search engine marketing. It is to place the message on the search engine to encourage clicks into the site when the user types a particular keyword phrase. The two main types of search marketing techniques are pay-per-click paid placements or

¹² Id.

¹³ Available at:

<https://www.smartinsights.com/wp-content/uploads/2018/01/Mobile-vs-desktop-Average-minutes-per-platform.png> (Accessed: July 15, 2018)

¹⁴ Chaffey, D & Smith, P.R. *Emarketing Excellence, Planning and optimizing your digital marketing*, (4th edn, Taylor & Francis, 2012).

sponsored links, and the use of SEO (search engine optimization) placements in natural or organic lists, where no search engine clicks are charged.¹⁵

(2) Online PR. It is to maximize the mention of your company, branded product, or website on a third-party website, such as a social network, blog, podcast, or feed that a target audience might access. It also includes responding to negative references and conducting public relations through the website through social media news centers or blogs.¹⁶

(3) Online partnerships. It is to create and manage long-term arrangements to promote your online services on third-party websites or via email communications. Different forms of partnerships include link building, affiliate marketing, aggregators such as price comparison sites, online sponsorships, and co-branding.¹⁷

(4) Display advertising. It is to use online advertising such as banners and rich media ads to increase brand awareness and encourage clicks on targeted sites.¹⁸

(5) Opt-in email marketing. It is to loan an email list or place an ad in a third-party e-newsletter or use an internal list for customer activation and retention.¹⁹

(6) Social media marketing. It is that companies engage and advertise in social networks and communities to attract and engage their audience. Viral marketing²⁰ or online word of mouth information is closely related to this.²¹

In the past few years, social media marketing has become an important type of digital marketing. More and more companies and the organizations are communicating with the public by using social network sites such as Twitter, Facebook, WeChat and Weibo (especially in China). As Dave and Fiona (2016) state, it can be applied as a traditional multi-media tool to send messages to customers or partners by using social network sites. However, the benefit of the social media does

¹⁵ See Supra Note 10, p.33

¹⁶ Id.

¹⁷ Id.

¹⁸ Id.

¹⁹ Id.

²⁰ See supra note10 p. 33, "Viral marketing: a marketing message is communicated from one person to another, facilitated by different media, such as word-of-mouth, email or websites, in particular, social network or blog sites. Viral marketing implies rapid transmission of messages is intended."

²¹ Id.

not only release a message, it is important to make a group which the customers, producers, and sellers can take part in.²² It is clear that the function of the social networks has integrated the interactive capabilities and traditionally publish message functionality by using different social media marketing channels.

2.3 Different Types of Social Media Marketing Channels

Marketers can send their messages directly to consumers and be achieving original objectives by using different types of social media marketing channels. There are six main categories listed below²³:

(1) Social networks. The core social platforms in most countries where people interact through social networks are Facebook for consumers, LinkedIn for business audiences, and Twitter for both.²⁴

(2) Social publishing and news. Almost all newspapers and magazines, whether broad or niche, now have an online presence and can be reached through comments on articles, blogs or the community.²⁵

(3) Social commenting in blogs. Corporate blogs can form the center of your social media strategy, and you can view other people's blogs, whether they are corporate or personal, or promote through blogs.²⁶

(4) Social knowledge. These are like Yahoo! Such references to social networking answers, Quora, Zhihu (China) and similar, plus Wikipedia. They show how any business can engage its audience by solving their problems and subtly showing how their products can help others.²⁷

(5) Social search. Search engines are increasingly social, able to mark results, comment on them, and recently vote on them via Google + 1²⁸

(6) Social commerce. It is closely related to the retail industry. It shares comments

²² Id.

²³ See Supra Note10. p.35

²⁴ Ibid 35

²⁵ Ibid 35

²⁶ Ibid 35

²⁷ Ibid 36

²⁸ Ibid 36

and ratings on products and coupons for details.²⁹

2.4 Benefits of Digital Media Marketing

Digital marketing communication is very different from traditional marketing communication since it provides a new marketing mode of interaction and style of information transmission. The key characteristics of the digital media marketing which distinguishes the traditional marketing are summarized by McDonald and Wilson (1999)³⁰, namely '6 is of the e-marketing mix'. This principle fully summarizes the advantages of digital media marketing and helps the marketers to exploit digital media marketing effectively.

2.4.1 Interactivity

Although the traditional media has always dominated the push media where marketing messages are released by broadcast or TV, digital medium like websites, social media pages or smartphone apps can directly send the messages to the consumers. Consumers can seek information by searching engine independently. It differs from the push media when the consumers are searching for information relevant to the products or services online. This new approach, which the consumer is proactive in seeking out information for their needs, and interactions with brands attracted through content, search and social media marketing³¹, is now known as inbound marketing. (Shah and Halligan, 2009)³² Inbound marketing is powerful since the interactive nature of digital media marketing has reduced the number of simple advertisements and improved the efficiency of information transmission.

²⁹ Ibid 36

³⁰ M. McDonald and H. Wilson, 'E-marketing Improving Marketing Effectiveness in a Digital World' (1999) Financial Times/Prentice Hall, Harlow.

³¹ See Supra Note 10. p.37

³² D. Shah and B. Halligan, 'Inbound Marketing: Get Found Using Google, Social Media, and Blogs' (2009) NJ Wiley.

2.4.2 Individualization

Interactive marketing communication refers to that they can be customized for individuals at relatively low cost. Unlike traditional media, the same message is often broadcast to everyone. This personalization is based on collected information about site visitors, which is then stored in a database and then used to locate and personalize communications with customers to achieve relevance for all media.³³

2.4.3 Integration

The Internet makes a large room for integrating the various marketing communication channels. As Dave & Fiona (2016) stated, the Internet can be used as a direct response tool to enable customers to respond to offers and promotions posted on other media. The site can have a built-in direct response or callback function. The Internet can be used to support purchase decisions, even if the purchase amount is not through the website through real-time chat or phone assistance sales.³⁴

2.4.4 Independence of Location

Electronic media has also introduced the possibility of increasing corporate communications to the global market. This provides an opportunity for international markets that might not have been possible before. The Internet makes it possible to sell to countries without local sales or customer service departments.³⁵ Moreover, with the development of the mobile Internet, more advantages of digital communications are emerging, such as accountability, testing, flexibility, Micro-targeting, Cost-control and so on. Today, these advantages of digital media marketing have been exploited by more and more companies. Social media sites, particularly, provide great opportunities to merchants for their marketing to the

³³ Ibid 38

³⁴ Ibid 39

³⁵ Ibid 39

global consumers.

In summary, digital marketing uses the Internet to break the geographical restrictions of traditional marketing models, making marketing purposes more targeted. At the same time, social media marketing enhances the interaction between trademark holders and consumers, enabling peer-to-peer marketing. However, due to the high privacy of social networks and the establishment of social accounts, the spontaneity of sharing information. The uniqueness of trademarks may be due to the lack of effective restrictions on social networking platforms and the difficulty of supervision and the proliferation of trademark infringement. When a trademark is run on a very open and relatively closed social network, it will always face the risk of infringing the trademark rights of the merchant caused by the establishment of false social accounts, the distribution of false advertising information and even the sharing of false advertising links. Therefore, we will discuss trademark protection issues in social media platforms one by one.

2.5 Brand and Trademark Protection

For companies using digital media marketing, the essential issue is to increase the identification of trademarks and brands. Online brand and trademark protection include following aspects, namely use of a brand name within domain names, use of trademarks within other websites and in online adverts. (Dave & Fiona, 2016)³⁶ For example, in China, companies such as Xiaomi (Digital Terminal Company) and three squirrels (food companies) rely on the Internet, especially the marketing of social networking platforms to enhance trademark influence and become a well-known brand.

2.5.1 Domain Name Registration

Few companies, in the Internet era, just only have one domain name. On the contrary, they always own many domains for different product lines or countries or

³⁶ Ibid 159

for specific marketing campaigns. (Dave & Fiona, 2016)³⁷ In practice, there is a problem when an individual or company has registered a domain name which another entity also claims the same one. Moreover, it is not uncommon for trademarks to be preempted by others to register domain names. This is always called 'cybersquatting'. For example, as a world-renowned food and beverage brand, McDonald's has a great emphasis on brand name protection. Under its name, it has brand names such as mcdonalds.com/.com.cn/.co/.biz, and even Maile.cn and maidanlao.com, 4008-517-517.cn/.com.cn and other domain names, domain protection work can be described as very thoughtful. Even so, there are still some domain names involving McDonald's being squatted. Obviously, these are all the risks of trademark enforcement in the context of digital media marketing.

2.5.2 Using Competitor Names and Trademarks in Meta-tags

The meta-tag is part of the site's HTML code and is used to market the site so that it appears prominently in the search engine as part of search engine optimization. Some companies have tried to put the names of competitor companies on the meta tags. (Dave & Fiona, 2016)³⁸ This is not legal since the dilution of the trademark will take place in this situation. It will be explained in detail in the following third part of this article.

2.5.3 Reputational Damage in Advertising

At the moment, brands and trademarks become important assets of the company. The company is concerned that brand and trademark values are reduced due to improper advertising. They are concerned that because ads are not necessarily related to what their ads are associated with on social networks or ad networks, they will not advertise their reputation damage.³⁹ Trademark dilution is an important factor to measure the trademark enforcement in digital media marketing. It will be

³⁷ Ibid 159

³⁸ Ibid 160

³⁹ Ibid 161

explained in detail in the following third part of this article.

2.5.4 Monitoring Brand Conversations in Social Networks and Blogs

The online brand reputation management and alerting software tool provides real-time statements when comments about the brand are posted or references are posted online at different locations, including blogs and social networks.⁴⁰ There are more sophisticated online reputation management services that can take a further look at whether emotions are positive or negative and cover other issues, such as unauthorized use of logos and trademarks. But regulating online trademark infringement, considering the scope of such opportunities and the lag between what is prescribed by law and what is possible through the technology, is still challenging. According to Rob White, regardless of how well digital media marketing, especially social media marketing, prevents trademark infringement, the following three issues remain an important issue in trademark enforcement, such as:

- (1) fake account or usernames and name squatting
- (2) misappropriation of a company's trademark or copyright; and
- (3) the sale of infringing or counterfeit goods.⁴¹

3 Brandjacking on Social Networks

The holders of trade marks often create a social media account to advertise and promote their goods, services, and activities. They usually put their own logo or other trademarked terms on the platform as a distinctive characteristic to identify themselves on these sites. However, in the vast majority of cases, some people have pre-registered the trademark holder's social media account and hope to sell the trademarked social network usernames originally owned by the trademark holders

⁴⁰ Ibid 161

⁴¹ Rob White, 'Social media takedown: surveying the available tools' (2017) 07 FEB World Trademark Review, Available at: <http://www.worldtrademarkreview.com/Intelligence/Online-Brand-Enforcement/2017/Chapters/Social-media-takedown-surveying-the-available-tools> (Accessed: June 16, 2018).

to the trademark holders for benefits. For example, KEVIN RUDD, NICOLE KIDMAN, COCA-COLA, and NIKE have been all considered "victims of squatters of their Twitter identities, in what appears to be a growing phenomenon on the burgeoning social media network."⁴²

Brandjacking is the act of acquiring or assuming the online identity of a company, brand, or person. The term is a blend of "brand" and "hijacking" coined by Mark Monitor (US brand protection software company). The word made its first appearance in print in 2007 in a Business Week article. Typically, brand jackers set up bogus social media accounts, or hack legitimate accounts to spread anti-commercial, misleading or provocative messages inconsistent with communication strategy of a given company.⁴³

Brandjacking usually aims at damaging the reputation of its target, not necessarily for financial reasons. However, companies who fall victim to brandjacking often report financial losses, as well as customer trust issues.

Fake social network site pages, also known as "brandjacking", an American, have been the crucial problem which triggers the infringement, dilution, and other violation of federal and state laws. For example, in *Nine West Dev. Corp. v. Does 1-10* case, the fake Nine West auditions group page on Facebook which was created by a user with allonym Nine West Shoes that applied for females interested in model auditions to send the photographs of their faces, bodies, and toes with their contact information.⁴⁴ The Nine West's Complaint stated that at least 400 Facebook members joined the Nine West-Model Auditions group and possibly sent personal information and photographs to an imposter.⁴⁵

Undoubtedly, such unauthorized uses of trademarks will hinder trademark holders,

⁴² Julian Lee, 'Squatters creating twittering confusion', (2009) 30 April The Sydney Morning Herald, Available at: <https://www.smh.com.au/business/squatters-creating-twittering-confusion-20090429-andk.html> (Accessed: June 16, 2018)

⁴³ Karolina Piwec, 'Brandjacking: How to protect your online reputation in 4 easy steps', Available at <https://brand24.com/blog/brandjacking-protect-online-reputation-4-easy-steps/> (Accessed: June 16, 2018)

⁴⁴ *Nine West Dev. Corp. v. Does 1-10*, [2007] No. 07-cv-7533 S.D.N.Y. filed, Available at: <http://www.counterfeitchic.com/Cases/cic/3/ninewest.pdf> (Accessed: June 16, 2018)

⁴⁵ Id.

but there is still a gray zone that is whether trademark infringement law comes into force where the mark is not put into use to business practices which contain advertising, marketing, servicing and so forth.⁴⁶ Mark holders should have right to dispute “brandjacking” or “The illegal use of trademarked brand names online”⁴⁷ against the third parties who carried it out. According to Professor Ramsey, the infringement law prohibits the use of trademarks that may lead to confusion. Consumers may be confused by the source of the information posted on the social networking site by the individual who registered with the username or account name that involves another's trademark.⁴⁸ The alleged infringers may debate that their use of the trademark does not comply with the principles of the trademark and are protected by the First Amendment on freedom of speech.⁴⁹ In my opinion, it is not necessary to simply attribute the use of trademarks through social media platforms to commercial activities as a standard for trademark infringement, nor can it simply defend the infringer's freedom of protection from the First Amendment as a defense. It should be examined whether there is an inevitable causal link between the infringement and the commercial activity. When this causal link exists, the trademark infringement can be determined.

3.1 Trademark Run on Social Networks

As Boyd and Ellison defined,” Social network sites as web-based services that allow individuals to (1) construct a public or semi-public profile within a bounded system, (2) articulate a list of other users with whom they share a connection, and (3) view and traverse their list of connections and those made by others within the system.

⁴⁶ See Supra Note 66, “[U]nless an interloper is using the brand name to masquerade as that brand and possibly even sell products that are trading on that name, brand owners are relatively powerless.” (interview of Australian attorney Frances Drummond)

⁴⁷ Shaun Waterman, ‘Brand-jacking Rises as Top Online Abuse’, (2009) Mar. 9 WASH TIMES, Available at: <https://www.washingtontimes.com/news/2009/mar/09/brand-jacking-rises-as-top-online-abuse/> (Accessed: June 17, 2018)

⁴⁸ Lisa P. Ramsey, ‘Brandjacking on Social Networks: Trademark Infringement by Impersonation of Mark holders’, (2010) Vol. 58, No.4 Buffalo Law Review 851.

⁴⁹ U.S. CONST. amend. I.

The nature and nomenclature of these connections may vary from site to site.”⁵⁰ The most notable feature of social media networks is that “they enable users to articulate and make visible their social networks” and identify “friends,” “contacts,” or “others in the system with whom they have a relationship.”⁵¹ It allows users to create a bi-directional channel with friends, family, and other users. It also allows users to establish monodirectional ties with businesses, organizations and other entities.⁵² With the social media networks becoming the most important way of interpersonal communication, it has been the best way for brand and trademark owners to enhance brand influence and increase sales of goods and services.

Based on the unique feature of the social media network, it has become a new commercial marketing system integrating advertising, information release, after-sales service, data collection and data analysis. More importantly, compared with traditional marketing methods, social media network marketing, on one hand, can achieve better marketing effects with relatively low marketing costs. On the other hand, it helps the mark-holders to collect the data like comments, page views and so on. These will provide data support for users to improve products, improve services, and change marketing strategies. In other words, the collected data is also an important digital asset for users. As Miller said, “Small businesses outnumber the big ones on the free microblogging service, and in many ways, Twitter is an even more useful tool for them.”⁵³ Social network sites provide a great opportunity for small companies that can't afford to pay high marketing fees. Therefore, using social network marketing is not only the patent of big companies, it has become an important tool for small companies to develop rapidly and enhance their brand influence.

Unfortunately, viewers sometimes accidentally become friends, fans or fans of

⁵⁰ Danah M. Boyd and Nicole B. Ellison, ‘Social Network Sites: Definition, History, and Scholarship’, (2008) J. COMPUTER-MEDIATED COMM. 210.

⁵¹ Ibid 211, 213

⁵² Ibid 213

⁵³ Clarie Cain Miller, ‘Marketing Small Businesses With Twitter’, (2009) N.Y. TIMES, Available at: <https://www.nytimes.com/2009/07/23/business/smallbusiness/23twitter.html> (Accessed: July 2, 2018).

imposters who create fake social networking pages. (Ramsey, 2010)⁵⁴ If a public virtual social networking site account appears on a "real name" website like Facebook, or if it is "verified" on Twitter, then the public is more likely to be confused. Confusion may also arise if the account is explicitly stated to be "official" or "real" or if the post is written by a trademark representative.⁵⁵ If the user believes and relies on the fake identity statement of the imposter, then pretending to be a brand on a social networking site can cause various hazards. If a user discloses personal information to an imposter, identity theft, phishing or spam may increase. (Tom et al, 2007)⁵⁶

There are two main ways that are from the perspective of social media operators and users respectively to prevent the creation of user-name cybersquats and fake pages. On one hand, for the social media operator, the main approach is to prevent fake accounts through "real-name authentication". For example, in China, Sina Weibo, which is similar to Twitter, is a popular platform used by more than 22 percent of Chinese Internet users. It began requiring "real identity" registration in early 2012, requiring users to provide their names and mobile phones, and then had to verify them. Those who refuse are prohibited from Posting messages and restricted to reading other people's entries. This makes Weibo's execution and protection more straightforward.⁵⁷ On the other hand, for social media users, some brands are pre-registering usernames containing their trademarks on Facebook, Twitter, and other social networking sites. Registration is usually free and fast, but the time, money and effort spent registering a company logo (and its variants) as a username on several sites are not trivial. Adding content and posting it to your account on a regular basis will consume more company resources, but some users

⁵⁴ See Supra Note 72.

⁵⁵ Id.

⁵⁶ Tom N. Jagatic, et al., 'Social Phishing', (2007) Vol. 50 No.10 Communications of the ACM 94. Available at: <https://cacm.acm.org/magazines/2007/10/5556-social-phishing/pdf> (Accessed: June 20, 2018)

⁵⁷ Trevor Little, 'Protecting your brand in the social media environment', (2012) Issue 39 World Trademark Review Available at: <http://www.worldtrademarkreview.com/Magazine/Issue/39/Roundtable/Protecting-your-brand-in-the-social-media-environment> (Accessed: July 20, 2018)

may complain if the brand does not use their account after registering their username. (Ramsey, 2010)⁵⁸ What's more, even if trademark holders register their names on all the top websites today, they won't stop future users from squatting on fake pages or on new websites.

As mentioned before, many individuals have established unauthorized social networking accounts for brands on Facebook, Twitter, WeChat, Weibo, and other sites.⁵⁹ Some social network accounts, like the Coca-Cola fan page on Facebook⁶⁰, have been accepted by trademark holders who believe that these unauthorized accounts are conducive to the promotion and marketing of their products, services, and activities. Other social network accounts, once they are discovered, are investigated, and shut down or taken over. (Lisa Ramsey, 2010)⁶¹ For example, "Janet" had created an account on Twitter by name of Exxon Mobil Corp and used the account to answer questions about the direction of the company, where philanthropy resources are being spent, and even responding about the Exxon Valdez. Unfortunately, she was not a real employee. Exxon's official spokesperson, Alan Jeffers, stated that Exxon has been "brand jacked", they were caught off guard because they were not monitoring and responding to their own online brand.⁶² The key point, in this case, is that it is difficult to identify whether the person who set up the social network account is qualified to represent the trademark holder or be an employee of that company or organization.

In addition, according to Professor Ramsey, some social networking site users may be protected by the First Amendment when they use unauthorized tags to convey information or ideas. Fans of the brand may set up an unauthorized page for the

⁵⁸ See Supra Note 72.

⁵⁹ Charlotte McEleny, 'Brand Identities at Risk as Fakers Take Their Place on Twitter', (2009) B2 New Media Age, available at 2009 WLNR 8073054.

⁶⁰ As explained in a video posted on Facebook, Dusty Sorg and Michael Jedrzejewski created a Facebook fan page for Coca-Cola without first obtaining authorization from Coca-Cola. Videos Posted by Coca-Cola: We Made a Facebook Page, <http://www.facebook.com/video/video.php?v=57458127013>

⁶¹ See Supra Note 2.

⁶² Posting of Jeremiah Owyang to Web Strategy, 'How "Janet" Fooled the Twitter-sphere (and Me) She's the Voice of Exxon Mobil', Available at: <http://www.web-strategist.com/blog/2008/08/01/how-janet-fooled-the-tittersphere-shes-the-voice-of-exxon-mobil/> (Posted on August 1st)

brand because a brand does not currently exist and they want to link to the brand to convey the products they like. Third parties may also use other trademarks on social networking sites. It may engage in parody or satire, or as a prank. In some cases, posing as a tag may be part of a joke. Actually, this is not really impersonation.⁶³ Today, many famous social network sites like Facebook, Twitter, Weibo, and Wechat have set up their own policies to address the problem of impersonation of a trademark. Although these policies can help social media networks curb trademark infringement, there is a more important question whether they can properly balance trademark and free speech interests.⁶⁴

Although there are some precedents to deal with trademark infringement in digital marketing on the Internet, it is still a problem that applies the trademark law to make sure unauthorized uses of marks when dealing with trademark infringement issues on social networks. Under the American legislation, there is no specific provision or general principles of common law that clearly states whether trademark infringement is constituted in this context. (Ramsey, 2010)⁶⁵ In the US, according to Ramsey, if a trademark is not used for advertising or for the sale of goods or services, some courts may consider that there is no trademark infringement. Other courts may find infringement if a third party uses another person's mark to impersonate a mark-holder and confuse the source of the expression on the site.⁶⁶ In the social media marketing, in particular, this will affect the security of trademark holders' digital assets. Therefore, courts and social networking sites should try to balance a mark holder's benefit and free speech interests in these disputes. In my view, the latter will become more reasonable in promoting trademark infringement legislation social network marketing.

3.2 Trademark Infringement on Social Networking Sites

At present, trademark infringement is still a legislative gap in the social network

⁶³ See Supra Note 72.

⁶⁴ Id.

⁶⁵ Id.

⁶⁶ Id.

environment. The core issue is how to determine whether a trademark is implemented in a business environment. Under the US legislation, there are two provisions in the Lanham Act for trademark infringement: 15 U.S.C. § 1114(1)(a), which applies to registered marks, and 15 U.S.C. § 1125(a)(1)(A), which applies to both registered and unregistered marks. (Ramsey, 2010)⁶⁷ According to 15 U.S.C. § 1114(1)(a), the third party must engage in “use in commerce” of the mark” in connection with the sale, offering for sale, distribution, or advertising of any goods or services” in a context that “is likely to cause confusion, or to cause mistake, or to deceive.”⁶⁸ The third party should take responsibility under § 1125(a)(1)(A) if it “uses in commerce” another’s mark “on or in connection with any goods or services” where that use is likely to cause confusion, mistake, or deception regarding the “affiliation, connection or association” of that person with the mark-holder, or as to the “origin, sponsorship or approval” of that person’s “goods, services, or commercial activities.”⁶⁹

Therefore, in order to establish a prima facie claim of trademark infringement under the Lanham Act, the trademark holder must prove that the use of the trademark by a third party without authorization in commercial activities which are linked with goods, services or other activities where the mark may cause confusion. (Ramsey, 2010)⁷⁰ According to Ramsey, there are five elements for mark-holders to judge trademark infringement by third party, namely (1) use in commerce; (2) use in connection with goods, services, or commercial activities; (3) commercial use; (4) trademark use; and (5) likelihood of confusion. Meanwhile, Fair use of the trademark and the First Amendment that protects free expression should also be considered.⁷¹

3.2.1 Use in Commerce

According to Bosley v. Kremer Case, Sections 1114(1)(a) and 1125(a)(1)(A) both

⁶⁷ Id.

⁶⁸ 15 U.S.C. § 1114(1)(a) (2006).

⁶⁹ 15 U.S.C. § 1125(a)(1)(A) (2006).

⁷⁰ See Supra Note 72.

⁷¹ Id.

require the use of a mark "in commerce" for infringement liability. Some courts and scholars note the term "commerce" in both infringement statutes is jurisdictional—Congress may only regulate commerce within its control, thus a mark must be used in commerce for the federal trademark statute to apply.⁷² Broadly speaking, when the third party uses a mark as an account name that others can access on the social network site, this will generally be satisfied with the definition of the Lanham Act's jurisdictional use "in commerce" requirement.

Some courts and scholars believe that the definition of "use in commerce" in §§ 1114(1)(a) and 1125(a)(1)(A) should combine with § 1127, include different requirement for a prima facie infringement claim which restricts the infringement law to certain types of use of a mark.⁷³ The term "use in commerce" in section 1127 states, "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."⁷⁴ Moreover, it states that a mark is "deemed to be in use in commerce" when the mark is visibly placed on goods "sold or transported in commerce" or is "used or displayed in the sale or advertising of services and the services are rendered in commerce".⁷⁵ From this view, "use" of the mark by the accused infringer should be considered as one element for infringement requirement, also "use" and "in commerce" are different elements of the infringement claim.⁷⁶

Based on the above argument, in those circuits that apply the definition of §1127 "use in commerce" to limit infringement claims, the court may consider that certain types of third parties using other's trademarks on social networking sites are not considered "used in commerce." When a trademark is used only for a username, account name, or content posted on a social networking site, there is no sale or shipment of any merchandise in the trademark. There is also no "use in commerce" where the third party does not use the mark in the service provided by the sale or

⁷² *Bosley Med. Inst. Inc. v Kremer*, (2005) 9th Cir. 403 F.3d 672, 677.

⁷³ See Supra Note 2.

⁷⁴ 15 U.S.C. § 1127 (2006).

⁷⁵ *Id.*

⁷⁶ See Supra Note 72.

advertisement, and use of another person's trademark in parody, satire, criticism and other comments in business. However, if the alleged infringer uses another's trademarks on the social networking site to advertise the services it provides in business per se, this may be referred to as "used in commerce" as defined in §1127. This situation usually occurs in the case of comparative advertising. (Ramsey, 2010)⁷⁷

3.2.2 Use in Connection with Goods, Services, or Commercial Activities

Under the Lanham Act, the infringement of the trademark should be "in connection with the sale, offering for sale, distribution, or advertising of any goods or services."⁷⁸ Although it can be determined that use of mark in the commerce on a social network site, it still need to judge whether this use in connection with goods, services, or commercial activities. It is clear that these are two separate principles.⁷⁹

Normally speaking, it will be easy for the right holder of the trademark to proof that the unauthorized use of marks which are in usernames, account names, and/or content of social network sites is connected with goods, services, or commercial activities or not. For example, unofficial account posts information about the official product and compares the original one with its own products, the true purpose is to advertise or sell its own products by using comparative advertising. On the other hand, it may also be clear that the unofficial account is not using the mark in connection with goods, services, or commercial activities, if the third party shows clearly that it is an unofficial account and just uses the letters or images of the registered trademark as a username or account name on the social network sites. (Ramsey, 2010)⁸⁰ The difficult case is that the accused infringer does not connect with advertising, selling goods or services, but distribute the information or another expression on the social network site. From a social media marketing perspective, communication with the public is an important part of advertising services. As

⁷⁷ Id.

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

⁷⁹ *Utah Lighthouse Ministry v Found. for Apologetic Info. & Research*, (2008) 10th Cir. 527 F.3d 1045, 1054.

⁸⁰ Supra Note 72.

Ramsey stated, in order to satisfy the requirements for goods, services or commercial activities for a prima facie infringement claims in this case, the trademark holder can argue that its trademark is used in conjunction with the “service” on the social networking site because the information provided to others is qualified as “Information service.”⁸¹

In practice, there are obvious differences between different courts in the definition of “information service”. Some courts have broadly interpreted the definition of “service” in which the defendant used another trademark when it disseminated information.⁸² For example, the Southern District of New York held Bucci “offers informational services for use in convincing people that certain activities, including the use of services, are morally wrong, thus Bucci used the organization's mark in connection with the distribution of those services over the Internet.”⁸³ Some courts have narrowly interpreted the definition of “service” which excludes the dissemination of expression that the accused infringer does not use the relevant statement about advertising or selling.⁸⁴ For example, the District Court for the District of Columbia held that “purveying points of view is not a service within the meaning of the Lanham Act.”⁸⁵

Today, as mentioned in part I, information has become an important type of assets called “digital asset” in social media marketing. A trade mark holder collects the data to analyze the market distribution, anticipate potential customers and improve the product. From this point of view, If the accused infringer merely using the trademark to comment or disseminating relevant information cannot be deemed as an information service, that means the mark-holders will lose its asset. In another word, the trademark holders are not protected by law when their rights are infringed.

⁸¹ Id.

⁸² *United We Stand Am., Inc. v United We Stand, Am. N.Y., Inc.*, (1997) 2d Cir.128 F.3d 86, 89.

⁸³ *Planned Parenthood Fed'n of Am., Inc. v Bucci*, (1997) S.D.N.Y. 42 U.S.P.Q.2d (BNA) 1430,1434, (1998) 2d Cir.152 F.3d 920.

⁸⁴ See Supra Note 72.

⁸⁵ *Lucasfilm Ltd. v High Frontier*, (1985) D.D.C. 622 F. Supp. 931, 934.

3.2.3 Commercial Use of the Mark

Some courts hold that the infringement statutes in connection with goods, services or commercial activities also implicitly requires the trademark holder to establish the "commercial use" of the mark for the purpose of making a prima facie infringement claim. (Ramsey, 2010)⁸⁶ But other courts have taken the opposite view. They stated there is no obvious requirement of commercial use according to the §§ 1114(1)(a) and 1125(a)(1)(A).⁸⁷ In the social media circumstance, these arguments are more heated. The point of contention is when a third party uses another's mark without authorization in context of noncommercial expression on the social networking sites, the mark holder can constitute a prima facie case of infringement or not.⁸⁸

In practice, the court applies tort law in trademark disputes when there is no commercial use in a trademark in connection with the advertising or sale of goods or services. The court also applied the infringement provisions of the Lanham Act to unauthorized use of trademarks in the titles or content of books, magazines, films and other artistic and literary works.⁸⁹

However, in the context of social media marketing, even if a third party has a non-commercial motivation to use a trademark to impersonate a trademark, nor to advertise or sell a real good or service, the court should ascertain the fact that it is commercial use of mark, if the reasonable consumer believes the mark links with commercial activities or the use of the trademark was found in the commercial environment. The scope of the "commercial use of the mark" need to be more broadly than the use of a mark in a commercial environment. As Professor Ramsey stated that in trademark disputes involving impersonation of a trademark, the court may also treat the impostor's expression as a commercial use similar to a trademark because consumers perceive the trademark owner to use the trademark on a social

⁸⁶ See Supra Note 72.

⁸⁷ Id.

⁸⁸ Id.

⁸⁹ Id.

networking site for a commercial purpose.⁹⁰ In my opinion, the above teleology is not enough to determine trademark infringement. The determination of the infringement requires not only the motivation of the test but also the factual behavior. Therefore, we also need to further determine whether the infringement does exist.

3.2.4 Trademark Use of the Mark

Scholars have noted that the threshold for trademark use requirements can be used to limit the expansion of trademark rights, promote competition and freedom of expression, and other social interests.⁹¹ Regrettably, if the court needs to consider consumer perceptions to determine whether a particular type of use is eligible for trademark use, then this classification rule may not provide a true gatekeeper function for a definitive motion or a brief judgment of the motion.⁹² According to Professor McCarthy, trademark use requirements are implicit in requirements that may require confusion for infringement. Therefore, "trademark use" is not a separate element of the plaintiff's case, but only one aspect of the possibility of infringement.

In a trademark dispute involving unauthorized use of a trademark on a social networking site, the alleged infringer may consider the trademark to be used as a tort liability and in such cases does not satisfy this requirement. If a third party uses a trademark only in an expression, rather than identifying or distinguishing goods or services that are sold on the market, the court may need to use the trademark in the circuit to use the term "§1127" and/or no definition of the "Use in Business" logo. Use Mark's "trademark" or specify the source of the goods or services. However, if the court determines that information dissemination and other expressions are eligible for service, the third party uses the mark to specify the source of the

⁹⁰ Id.

⁹¹ Margreth Barrett, 'Domain Names, Trademarks and the First Amendment: Searching for Meaningful Boundaries', (2007) 39 CONN. L. REV. 973

⁹² Mark P. McKenna, 'Trademark Use and the Problem of Source', (2009) 773 Illinois Law Review 775 Available at: <https://illinoislawreview.org/wp-content/ilr-content/articles/2009/3/McKenna.pdf> (Accessed: July 20, 2018)

expression to qualify for use as a trademark and to meet the requirements specified by any source.⁹³ Therefore, if a third party registers a username or account on the social network without the authorization of the trademark holder, courts are more likely to find use of trademarks to specify the source of expression on social networking sites, and for trademark purposes, where the trademark is used for the username or account name on the social networking site to identify the account and distinguish it from others.⁹⁴

3.2.5 Likelihood of Confusion

Because the uniqueness of a trademark is at the heart of trademark protection, the likelihood of confusion is an important factor in determining whether a trademark has been infringed. If the court finds that §§1114(1)(a) or 1125(a)(1)(a) is satisfied under the threshold requirement for tort liability, it will consider whether the consumer is likely to be confused. The current trademark principle states that when the defendant's infringer uses the trademark to impersonate the trademark holder and causes confusion to the source of the expression, the court is usually more likely to discover the infringement. If a reasonable person does not think that the page on the social networking site is the official page of the trademark holder, then the possibility of infringement will be reduced. (Ramsey, 2010)⁹⁵

According to the Ninth Circuit, the traditional likelihood of confusion theory may contain following eight factors, namely (1) strength of the mark, (2) relatedness of the goods, (3) similarity of the marks, (4) evidence of actual confusion, (5) marketing channels used, (6) type of goods and the degree of care likely to be exercised by purchasers, (7) defendant's intent in selecting the mark, and (8) likelihood of expansion of the product lines.⁹⁶ However, involving the expression or the unauthorized use of marks in social media circumstance, the traditional likelihood of confusion principles often cannot sufficiently prevent trademark infringement.

⁹³ See Supra Note 72.

⁹⁴ Id.

⁹⁵ Id.

⁹⁶ *AMF Inc. v Sleek craft Boats*, (1979) 9th Cir. 599 F.2d 341, 348-49.

(Ramsey, 2010)⁹⁷ There are two ways---Rogers balancing and the initial interest confusion doctrine---which is used by courts to deal with an issue.⁹⁸

A user of a social network accused of infringement may argue that the content of his or her social networking site is similar to an art or literary work, so the language-protected Rogers balancing test should be used instead of the traditional confusion possibility analysis.⁹⁹ In trademark disputes involving artistic or literary works, the Rogers balancing test stipulates that the court should determine that the interests of the First Amendment take precedence over trademark rights, unless (1) the use of the mark “has no artistic connection with the underlying work”, or (2) “If it has some artistic relevance, unless [it] explicitly misleads the source or content of the work.”¹⁰⁰ If the third party’s use of the mark has some artistic relevance to the underlying work, then the first factor in the Rogers balance test will be met.¹⁰¹ According to the second factor of the Rogers balancing test, the use of trademarks must also “clearly” mislead “about the source or content of the work”.¹⁰² The analysis will require checking the way the trademark is used and what it is being expressed, as well as determining what to convey to the consumer by using the trademark in the username, account name or content of the social networking site page.

In cases involving unauthorized use of trademarks to attract social networking sites, trademark owners may argue that the court should apply the initial interest confusion doctrine when assessing the liability of the alleged infringer under the Lanham Act's infringement clause. (Ramsey, 2010)¹⁰³ This theory applies only to certain circuits, stipulating that the Lanham Act prohibits competitors from taking potential customers from producers by initially using their goods as producers, even

⁹⁷ See Supra Note 72

⁹⁸ Id.

⁹⁹ *Rogers v Grimaldi*, (1989) 2d Cir. 875 F.2d 994, 998-99.

¹⁰⁰ Elizabeth L. Rosenblatt, ‘Rethinking the Parameters of Trademark Use in Entertainment’, (2009) 61 REV.1011 FLA. L.

¹⁰¹ See Supra Note 72.

¹⁰² See Supra Note 58.

¹⁰³ See Supra Note 72.

if the source of the goods is confusing, any sales will be eliminated."¹⁰⁴ According to the Ninth Circuit Court, the use of others to mark the defendant who caused the initial interest confusion" improperly benefited from the goodwill developed by [the plaintiff] in its trademark."¹⁰⁵

The alleged infringer may respond that the doctrine does not apply to third parties who do not advertise or sell any goods or services on the Internet.¹⁰⁶ The scholars also complain that the original principle of confusion of interests may stifle expression and competition on the Internet.¹⁰⁷ Thus, in cases involving suspected impersonation of trademark rights on social networking sites, the court should balance the trademark rights of trademark owners, the public to avoid confusion and the accuracy of the ability to trust identity and authorship statements, and the freedom of expression of third parties.¹⁰⁸ However, in my opinion, excessive protection of freedom of speech can cause substantial damage to trademark protection. As a symbol of goods, trade marks are still essentially an expression method. Social media is not only a platform for speech communication, but also an important information sharing tool when it is used as a marketing platform. From this perspective, the excessive protection of the freedom of expression of the alleged trademark infringer actually infringes the trademark rights unique to the trademark holder.

3.3 Fair Use

Even if the trademark holder can establish a prima facie case, the defendant infringer may argue that the use of the trademark in the username, account name or social networking page content is consistent with the principle of descriptive fair use or nominal fair use.

Some courts may find a descriptive use of another trademark term in the content of

¹⁰⁴ *Dorr-Oliver, Inc. v Fluid-Quip, Inc.*, (1996) 7th Cir. 94 F.3d 376, 382.

¹⁰⁵ *Brookfield Commc'ns. Inc. v W. Coast Entm't Corp.*, (1999) 9th Cir. 174 F.3d 1036, 1062.

¹⁰⁶ *Lamparello v Falwell*, (2005) 4th Cir. 420 F.3d 309, 316.

¹⁰⁷ Stacey L. Dogan and Mark A. Lemley, 'Trademarks and Consumer Search Costs on the Internet', (2004) 41 REV. 777 HOUS. L. 813.

¹⁰⁸ See Supra Note 72.

a social networking web page to describe a third party's goods or services as acceptable trademark use. However, if a trademark descriptive term is used in the username or account name and the name identifies the source of the third party's expression on the social networking site, the court may determine that this is the "trademark use" of the term and is not a use "otherwise than as a mark".¹⁰⁹ In addition, in the case of impersonating a driver, it is difficult to establish a descriptive fair use defense, as the court may find that the imposter who deliberately pretends to be a public offender does not use the "fair and goodwill" mark. And/or not using the trademark to describe the party's own goods or services.¹¹⁰

Nominative fair use is a common law principle used in some circuits that allows third parties to use other people's trademarks to refer to trademark holders or their goods or services. In order to apply this doctrine, the defendant infringer must prove that (1) the mark holder's goods or services are not easy to identify without using the mark, (2) the third party used only has so many marks necessary to identify the mark holder's goods or services, and (3) The third party has not done anything, it will be with Mark, and the proposal is sponsored or endorsed by mark holder.¹¹¹

If the accused infringer spoofs on social networking sites, uses it in criticism or other comments, including in news reports or comparative advertisements, it is likely to satisfy the first factor. Commenters often need to use other people's tags to identify the goals or topics they express. If the third party only uses non-stylized text tags to identify the tag holder, then the second factor is more likely to be satisfied. Some courts may find that it is not necessary to use a stylized version of a trademark or a trademark logo on a social networking site page. The satisfaction of the last factor is likely to depend on whether the third party is impersonating the mark holder or whether it is using the logo to communicate with the mark holder.¹¹² From this view, If the content of the social networking page confuses the source of the consumer's expression, the imposter will not be able to claim that this is a sign of a fair

¹⁰⁹ *TCPIP Holding Co. v Haar Commc'ns, Inc.*, (2001) 2d Cir. 244 F.3d 88, 103-04.

¹¹⁰ See Supra Note 72

¹¹¹ *New Kids on the Block v News Am. Publ'g, Inc.*, (1992) 9th Cir. 971 F.2d 302, 304.

¹¹² Supra Note 72

nomination for the license. On the other hand, on social networking sites, users only use tags when they imitate, criticize or comment. If the content of the trademark clearly indicates that the third party is the source of the trademark expression, the court may find that this is the nominal use of the trademark.¹¹³

4 Trademark Dilution

Since social media is highly open and relatively closed, the second serious challenge facing the use of trademarks in social media is trademark dilution. The fundamental principle of trademark dilution law, is to protect a famous trademark to protect it against any negative effects that may arise in its particularity, personality, creativity, uniqueness, identity, reputation, goodwill, meaning, drawing ability, sales ability, advertising, business glamour , and prestige.¹¹⁴ Handler tersely said: "Dilution protects the mark while confusion protects the business."¹¹⁵ Frank Schechter introduced the trademark dilution theory in the 1927 Harvard Law Review article.¹¹⁶ According to Schechter, trademarks convey quality, and the value of trademarks comes from their ability to sell.¹¹⁷ Since this sales capability is magnified by the uniqueness of the trademark, the owners of arbitrary or fancy trademarks, such as ROLLS-ROYCE and AUNT JEMIMA, should be protected to prevent unauthorized use, thereby reducing the association with the product.¹¹⁸ According to Schechter, dilution refers to "a gradual weakening or dispersing of identity and adherence to the public mindset of a trademark or name."¹¹⁹ Traditional trademark infringement laws protect consumers from confusion, while dilution laws protect trademark

¹¹³ Id.

¹¹⁴ *Frankfurter J. in Mishawaka Rubber & Wollen Mfg. v S.S. Kresge Co. (Mishawaka Rubber)*, (1942) 316 U.S. 203, 205.

¹¹⁵ Milton W. Handler, 'Are the State Antidilution Laws Compatible with the National Protection of Trademarks.' (1990) *Trademark Rep* 48:806-807.

¹¹⁶ Frank I. Schechter, 'The Rational Basis of Trademark Protection', (1927) 40 *HARV. L. REV.* 813

¹¹⁷ *Ibid* 831

¹¹⁸ *Ibid* 829

¹¹⁹ *Ibid* 825

owners and the commercial value of trademarks.¹²⁰ Unlike trademark infringement, dilution does not require consumers to be confused in the market or competition.¹²¹ Because even if the consumer is not confused by the junior use, the presence of a trademark by a senior user for goods or services from two different sources can undermine the ability of the trademark to identify and differentiate senior users.¹²²

4.1 The Requirements of Trademark Dilution

In the United States, state and federal dilution laws coexist.¹²³ Prior to the entry into force of the Federal Trademark Dilution Act (FTDA) in 1996, trademark holders relied on state regulations to prevent dilution.¹²⁴ According to the FTDA, the owner of a well-known trademark has the right to ban the use of the trademark for the primary user's trademark, if the trademark is used after the trademark is known, and it will weaken the unique quality of the trademark.¹²⁵ FTDA aims to promote the predictable and uniform protection of well-known trademarks. However, the subsequent division of the circuit court of appeals on the following three issues illustrates the ambiguity of the statute : (1) whether the FTDA requires actual dilution or merely the possibility of dilution; (2) Does FTDA only protect trademarks with intrinsic characteristics, but not protecting distinctive trademarks; (3) whether FTDA protects niche trademarks.¹²⁶

Congress, in 2006, made the Trademark Dilution Revision Act (TDRA) in effect.¹²⁷ There are several revisions made by TDRA to the FTDA, such as: (1) a dilution claim only requires a likelihood of dilution, rather than actual dilution; (2) dilution by tarnishment is explicitly recognized and defined; (3) dilution by blurring is redefined

¹²⁰ Kathleen Goodberlet, 'The Trademark Dilution Revision Act of 2006: Prospective Changes to Dilution Definition', (2006) *Claim Analyses, and Standard of Harm*, 6J. HIGH TECH. L. 249, 252.

¹²¹ *Ibid* 253-54

¹²² *Hershey Foods Corp. v Mars, Inc.*, (1998) M.D. Pa. 998 F. Supp. 500, 503.

¹²³ J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, (4th edn.2017 §24:93).

¹²⁴ *Id.*

¹²⁵ Federal Trademark Dilution Act of 1995, Pub. L. No. 104-98, 109 Stat. 985 (formerly codified at 15 U.S.C. § 1125(c)).

¹²⁶ Marc L. Delflache, S. Silbert, and C. Hillson, 'Life after Moseley: The Trademark Dilution Revision Act.' (2007) *Texas Intellectual Property Law Journal*.

¹²⁷ See *Supra* Note 147

and six non-exclusive factors for court consideration are included; (4) niche fame is excluded; and (5) famous marks that are distinctive, inherently or through acquired distinctiveness, are protected.¹²⁸ Under the TDRA:” [T]he owner of a famous mark that is distinctive, inherently or through acquired distinctiveness, shall be entitled to an injunction against another person who, at any time after the owner's mark has become famous, commences use of a mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark, regardless of the presence or absence of actual or likely confusion, of competition, or of actual economic injury.”¹²⁹ Therefore, the dilution claim filed by the federal government requires ownership of a well-known trademark that is unique and may be diluted by third parties using such trademarks in commerce.¹³⁰

4.1.1 Fame Requirement

According to TDRA, “a mark is famous if it is widely recognized by the general consuming public of the United States as a designation of source of the goods or services of the mark’s owner.”¹³¹ That means that a trademark that has been infringed must be a well-known trademark throughout the country¹³²- a reputation in a niche market or local market.¹³³ Because holders of the marks that are only famous in the limited territory must rely on state dilution law. The statute lists several relevant factors that courts should consider about determining whether a mark has a reputation," (i) The duration, extent, and geographic reach of advertising and publicity of the mark, whether advertised or publicized by the owner or third parties. (ii) The amount, volume, and geographic extent of sales of goods or services offered under the mark. (iii) the extent of actual recognition of the mark. (iv)

¹²⁸ *Id.*

¹²⁹ 15 U.S.C. § 1125(c)(1).

¹³⁰ *Id.*

¹³¹ 15 U.S.C. § 1125(c)(2)(A).

¹³² *Id.*

¹³³ Scot A. Duvall, ‘The Trademark Dilution Revision Act of 2006: Balanced Protection for Famous Brands’, (2007) 97 TRADEMARK REP. 1252, 1261-62.

whether the mark was registered...on the principal register.”¹³⁴

Diluting reputation is a strict standard, which the federal circuit court of appeals acknowledged was "hard to prove".¹³⁵ There are few truly famous marks like “Dell”, “Barbie Dolls” could be included in the scope of fame.¹³⁶ Otherwise, the delicate balance between fair competition and the protection of the goodwill of trademark holders will be jeopardized by the overly broad grounds of litigation for any copy of the mark.¹³⁷ In addition, the plaintiff Mark must become famous before the defendant first used his trademark in business.¹³⁸

4.1.2 Distinctiveness Requirement

According to the 15 U.S.C. § 1125(c)(1), a mark that should be protected must be “distinctive, inherently or through acquired distinctiveness.”¹³⁹ If a trademark is associated with the senior user, the trademark is unique even if it encounters a well-known trademark in a context unrelated to the senior user's goods or services.¹⁴⁰ In *Hormel Foods Corp. v Spam Arrest, LLC*, the owner of the Canned Meat SPAM logo requested cancellation of the registration of the SPAM ARREST trademark, which is designed to filter unsolicited emails.¹⁴¹ The Commission believes that spam marking does not have the uniqueness required for dilution purposes, as "spam" is the "general term for unsolicited commercial email."¹⁴² In other words, the trademark holder failed to prove that the common meaning of "spam" was eclipsed by the trademark meaning of the term.¹⁴³

¹³⁴ 15 U.S.C. § 1125(c)(2)(A).

¹³⁵ *Coach Servs., Inc. v Triumph Learning LLC*, (2012) Fed. Cir. 668 F.3d 1356, 1373.

¹³⁶ *Bd. of Regents, Univ. of Tex. Sys. v KST Elec., Ltd.*, (2008) W.D. Tex. 550 F. Supp. 2d 657, 679.

¹³⁷ See Supra Note 147

¹³⁸ *Rosetta Stone Ltd. v Google, Inc.*, (2012) 4th Cir. 676 F.3d 144, 172.

¹³⁹ 15 U.S.C. § 1125(c)(1)

¹⁴⁰ *Hormel Foods Corp. v Spam Arrest, LLC*, (2007) T.T.A.B. Cancellation No. 92042134, 2007 WL 4287254, at *17.

¹⁴¹ *Id.* at*1

¹⁴² *Id.* at*18

¹⁴³ *Id.*

4.1.3 Commercial Use Requirement

Under the TDRA, the defendant is prohibited to “use of mark or trade name in commerce that is likely to cause dilution by blurring or dilution by tarnishment of the famous mark.”¹⁴⁴ It is obvious that the defendant in the commercial environment using the mark associated with the business activities is an important factor to constitute a trademark dilution.¹⁴⁵ As Professor Burstein said, “the junior user must use the famous mark-or something similar to it to indicate the source of his or her own goods or services.”¹⁴⁶ For example, in *Nat’l bus. Forms & Printing, Inc. v. Ford Motor Co.*, the website, which contained the various logos that can be selected by the potential customers, including Ford’s marks, operated by the NBFP. It creates different catalogs for customers to print designs.¹⁴⁷ The Fifth Circuit agreed with the judgment of the district court that Ford failed to prove the dilution because “NBFP did not ‘use’ Ford’s marks... in identifying or distinguishing its own goods or services merely by reproducing them for customers as part of its commercial printing business.”¹⁴⁸

4.1.4 Dilution by Blurring

Under the 15 U.S.C. § 1125(c)(2)(B), dilution by blurring proposes an “association arising from the similarity between a mark or trade name and a famous mark that impairs the distinctiveness of the famous mark.”¹⁴⁹ According to Professor Schechter, “if you allow Rolls Royce restaurants and Rolls Royce cafeterias, and Rolls Royce pants, and Rolls Royce candy, in 10 years you will not have the Rolls Royce mark anymore”.¹⁵⁰ That means dilution by blurring can diminish the distinctiveness of the trademark and trademark degradation take place.

¹⁴⁴ 15 U.S.C. § 1125(c)(1)

¹⁴⁵ Sarah L. Burstein, ‘Dilution by Tarnishment: The New Cause of Action’, (2008) 98 TRADEMARK REP.1189, 1221.

¹⁴⁶ *Id.*

¹⁴⁷ *Nat’l Bus. Forms & Printing, Inc. v Ford Motor Co.*, (2012) 5th Cir. 671 F.3d 526, 530.

¹⁴⁸ *Id.* at 536.

¹⁴⁹ 15 U.S.C. § 1125(c)(2)(B)

¹⁵⁰ See Supra Note 3

Although Professor Barber had summarized three factors for determining whether dilution by blurring, namely “(1) the degree of fame of the plaintiff’s mark, (2) the uniqueness of the plaintiff’s mark and (3) the similarity of the defendant’s mark to the plaintiff’s mark.”,¹⁵¹ the TDRA provision affirms more extensive and following non-exhaustive factors for courts judging whether the infringement of dilution by blurring has occurred:” (i) the degree of similarity between the mark or trade name and the famous mark. (ii) The degree of inherent or acquired distinctiveness of the famous mark. (iii) The extent to which the owner of the famous mark is engaging in the substantially exclusive use of the mark. (iv) The degree of recognition of the famous mark. (v) Whether the user of the mark or trade name intended to create an association with the famous mark. (vi) Any actual association between the mark or trade name and the famous mark.”¹⁵²

Above six factors will be evaluated based on their compatibility when automating trademark identification on social media. There are two factors, 1 and 5, related to the role of the so-called diluter. Factor 1, the similarity between the junior trademark logo and the famous senior trademark logo, can be determined objectively and automatically.¹⁵³ From this perspective, it is easier to find a static trademark logo. However, since the intention is subjective, it is difficult to determine whether the user of the trademark or brand name intends to establish contact¹⁵⁴ with the famous trademark.¹⁵⁵ Thus, factor 5 is not suitable for automated testing. In factor 2 and factor 3, the trademark holder is the main character. To determine the degree to which a trademark is an inherent or acquired salience, factor 2 seems redundant, as the trademark has passed the required minimum salience criteria, otherwise, it will not be registered first.¹⁵⁶ In any case, one can argue that it is

¹⁵¹ William G. Barber, ‘A ‘Rational’ Approach for Analyzing Dilution Claims: The Three Hallmarks of True Trademark Dilution’, (2005) 33 AIPLA Q.J. 25, 40.

¹⁵² 15 U.S.C. §1125(c)(2) (B3) (i)-(vi).

¹⁵³ U.S. Code, Title 15, Chapter 22, subchapter III, § 112 (c)(2)(B)(i)

¹⁵⁴ Alexander Simonson, ‘How and When Do Trademarks Dilute: A Behavioral Framework to Judge Likelihood of Dilution’, (1993) 83 TMR 149, 159–62.

¹⁵⁵ U.S. Code, Title 15, Chapter 22, subchapter III, § 112 (c)(2)(B)(v)

¹⁵⁶ *Id.*, § 112 (c)(2)(B)(ii)

entitled to protection. The third factor is irrelevant,¹⁵⁷ that is, to what extent the owner of a famous trademark has a complete monopoly on the use of the trademark. It is entirely up to the owner to decide whether or not to engage in the exclusive use of his trademark, or whether or not to license his trademark.

Factors 4 and 6 use external information from the relevant public: recognition of famous trademarks,¹⁵⁸ and the actual connection between trademarks or trade names and famous trademarks.¹⁵⁹ In order to find the relevant public and test whether they recognize that tags, factor 4 can be expensive and difficult to automate. The same is true of factor 6, which measures the actual connection between logos and famous trademarks. Thus, these factors are not suitable for automation.

Therefore, from the above six factors, only factor 1 can be used to affirm whether there is a case of trademark dilution by blurring automatically.

4.1.5 Dilution by Tarnishment

It is generally believed that trademark dilution by tarnishment is easier to identify than trademark dilution by blurring. *Deere & Co. v. MTD Products Inc.* (Inc. 91) explained that trademark dilution by tarnishment is “usually refers to the appearance of obvious signs in the context of sexual behavior, obscenity or illegal behavior”.¹⁶⁰ The concept of dilution by tarnishment is stated as “association arising from the similarity between a mark or trade name and a famous mark that harms the reputation of the famous mark.”¹⁶¹ The main content of dilution by tarnishment is that the defendant's unauthorized use damages the positive meaning of the plaintiff's trademark.¹⁶²

The dilution by tarnishment will occur in two main contexts. First, dilution by tarnishment will take place in the context of sex, drugs, and adult content. For

¹⁵⁷ *Id.*, § 112 (c)(2)(B)(iii)

¹⁵⁸ *Id.*, § 112 (c)(2)(B)(iv)

¹⁵⁹ *Id.*, § 112 (c)(2)(B)(vi)

¹⁶⁰ *Deere & Co. v MTD Products, Inc.*, (1994) 2nd Cir. 41 F.3d 39, 43.

¹⁶¹ 15 U.S.C. § 1125(c)(2)(C).

¹⁶² *Hormel Foods Corp. v Jim Henson Prods., Inc.*, (1996) 2d Cir. 73 FE3 497, 507.

example, at *Lorillard Tobacco Co. v. Cal. Imps.*, the manufacturer of NEWPORT cigarettes takes actions on companies that sell NEWPORT "spice", a product that consumes a floral fragrance "sprayed a synthetic chemical similar to THC, which is an active ingredient in cannabis."¹⁶³ The court found the defendant Diluted by confusion because NEWPORT is advertised to "customers interested in legally high prices", while synthetic cannabis is a controversial topic in the media.¹⁶⁴ In another case, luxury car manufacturer Rolls-Royce filed a lawsuit against a musician using the stage name ROLLS ROYCE RIZZY.¹⁶⁵ In this case of the plaintiff's injunctive relief, the court concluded that the defendant had diluted the federal and New Jersey laws because the musicians express clear lyrics and sexual themes.

Second, dilution by tarnishment will take place when a mark is improperly linked to the fake goods or services. For instance, in the case of *Steinway & Sons v. Robert Demars & Friends*, the court found that the defendant's "cheap, mass-produced" clip-on beverage could handle the name STEIN-WAY dilution of the famous STEINWAY mark associated with high-quality pianos.¹⁶⁶ At *Burberry Ltd. v. Euro Moda, Inc.* In the case, the court held that the high-end fashion brand Burberry itself had been diluted because the counterfeit Burberry goods sold by the defendant were "made of substandard materials".¹⁶⁷

In short: dilution by tarnishment is part of the established case law even before it was compiled in TDRA. Contrary to the trademark dilution by blurring, there is no test that can be applied by the court through the trademark dilution by tarnishment. We can, however, draw the conclusion from jurisprudence that for famous trademarks to be used in a disgusting manner, especially in cases involving sex, obscenity or illegality. The court recognizes that they can be characterized as tarnishment.

¹⁶³ *Lorillard Tobacco Co. v. Cal. Imps., LLC*, (2012) E.D. Va. 886 F. Supp. 2d 529, 533 n.4.

¹⁶⁴ *Id.*

¹⁶⁵ *Rolls-Royce Motors Cars Ltd. v. Davis*, (2016) D.N.J. 118 U.S.P.Q.2d 1581, 1583.

¹⁶⁶ *Steinway & Sons v. Robert Demars & Friends*, (1981) C.D. Cal. 210 U.S.P.Q. (BNA) 954,961.

¹⁶⁷ *Burberry Ltd. v. Euro Moda, Inc.*, (2009) S.D.N.Y. 08 Civ. 5781, 2009 U.S. Dist. LEXIS 53250, at *39.

4.1.6 Association Arising from Similarity

Both tarnishing and blurring dilution requires that "association arising from the similarity between a mark or trade name and a famous mark."¹⁶⁸ At first glance, tort confusion and dilution association seem to refer to the same psychological concept. However, trademark infringement requires consumers to wrongly attribute the trademarks of junior users to senior users.¹⁶⁹ In contrast, the relevance in dilution context occurs when the consumer encounters the junior user's markup but recalls the well-known markup of the senior user.¹⁷⁰ For example, when consumers look at an advertisement for KFC, they think about the brand of fast food but doesn't necessarily get confused about the overlap.

However, an example of consumer confusion is the proof of association and thus dilution. For instance, in the *Bath & Body Works brand management company v. Summit Entm't LLC*, the court ruled that the association between Bath and Body Works and Summit Entertainment may be supported by evidence of consumer confusion between the former. The Twilight Woods and the Twilight Crush logo are used in personal care products, and the latter's film is the Twilight franchise.¹⁷¹ Similarly, *Starbucks v. Wolfe's Borough Coffee, Inc.* The Second Circuit Court pointed out that the investigation evidence showed that source confusion may indicate an association because the mark of advanced users is bound to attract people's attention.¹⁷²

Moreover, "not just any psychological connection is sufficient. It must be an association resulting from the similarity or identity of two markers."¹⁷³ Although TDRA remains silent on similarity, case law suggests that it does not need to have substantial similarities. At Starbucks Case, the Second Circuit Court held that the

¹⁶⁸ 15 U.S.C. §§ 1125(c)(2)(B)-(C).

¹⁶⁹ See Supra Note 147.

¹⁷⁰ Id.

¹⁷¹ *Bath & Body Works Brand Mgmt., Inc. v Summit Entm't, LLC*, (2014) S.D.N.Y.7 F. Supp. 3d 385, 400-401.

¹⁷² *Starbucks Corp. v Wolfe's Borough Coffee, Inc.*, (2013) 2d Cir.736 F.3d 198, 211 n.14.

¹⁷³ Trademark Dilution Revision Act of 2005: Hearing on H.R. 683 Before the Subcomm. On Courts, the Internet, & Intellectual Prop. of the H. Comm. on the Judiciary, 109th Cong. 11 (2005)

District Court incorrectly required substantial similarity between the CHARBUCKS and STARBUCKS markers to show a dilution by blurring.¹⁷⁴ The Ninth Circuit Court and *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*'s Second Circuit Court reached an agreement that the TDRA's simple language suggests that jeans retailer Levi Strauss does not need to prove that its "Arcuate" back pocket stitching design is "same, almost identical or substantially similar to Abercrombie's "Ruehl" design. ".¹⁷⁵

4.2 Dilution in the Social Media Marketing

As a very important part of digital marketing, social media marketing has become more prevalent and expected to trigger a variety of trademark consequences. Trademark holders are enthusiastic about advertising their brand by using the social media platform. A company could transfer a competitor's information or advertisement to get the comparative advantage through social media.

4.2.1 Digital Dilution of Trademark

In some analogous areas, such as domain name cases and key word advertising, the novel issue of digital dilution has already arisen. In the area of internet domain names, the dispute of digital dilution of the trademark has occurred. In the *Archdiocese of St. Louis v. Internet Entm't Grp., Inc.*, the commemoration of the Pope's 1999 visit to St. Louis's trademark owner sued the Internet Entertainment Group Inc., which used the trademark as a public domain for pornographic content on the Internet.¹⁷⁶ The court held that the defendant diluted the PAPAL 1999 logo and its changes by "inconsistent with the positive and spiritual image of the adult entertainment venue and the plaintiff's efforts to create and maintain...".¹⁷⁷ Accordingly, When social media platforms integrate domain names, user names and information sharing functions, their communication role will surpass the traditional Internet marketing mode. The trademark dilution infringement will further expand

¹⁷⁴ *Starbucks Corp. v. Wolfe's Borough Coffee, Inc.*, (2013) 2d Cir.736 F.3d 198, 211 n.14.

¹⁷⁵ *Levi Strauss & Co. v. Abercrombie & Fitch Trading Co.*, (2011) 9th Cir.633 F.3d 1158, 1172.

¹⁷⁶ *Archdiocese of St. Louis v Internet Entm't Grp., Inc.*, (1999) E.D. Mo. 34 F. Supp. 2d 1145, 1145-46.

¹⁷⁷ *Id.* at 1146.

and even extend to the field of traditional media marketing.

4.2.2 Use a Mark or Trade Name in the Commercial Context.

Keyword advertising has become the main marketing method of digital marketing, especially search engine platform. Due to the peer-to-peer communication characteristics of social networks, social media marketing makes traditional search engine platforms into a more accurate marketing tool. Keyword advertising cases provide a similar factual pattern because a keyword could be searched by the search engine on the social media, and a link of advertisement also be found on the relevant account by using the social media platform. Therefore, keyword advertising on the social media marketing will face the same problem that happened in the online marketing. In *Tiffany (New Jersey) Inc. v. eBay, Inc.*, the online auction company eBay buys sponsored links to promote the goods offered by its luxury jewelry retailer Tiffany, as long as search terms such as "Tiffany" enter the search engine.¹⁷⁸ According to Tiffany, eBay diluted the use of the TIFFANY logo to promote counterfeit and shoddy products, thereby weakening the ability of the trademark to identify the real Tiffany brand and its authentic jewelry.¹⁷⁹ Tiffany also believes that eBay has the responsibility to make up for it by smudging because it uses the TIFFANY mark to create a negative link between Tiffany and low-quality products.¹⁸⁰ The Second Circuit Court affirmed that the District Court rejected Tiffany's dilution statement, but agreed that eBay did not use the TIFFANY mark to identify its products. Instead, eBay uses only these marks to directly promote the Tiffany brand. Since eBay only uses the TIFFANY mark to identify Tiffany jewelry available on eBay, rather than identifying eBay's own products or services. The Second Circuit seems to indicate that eBay uses these trademarks for permitted non-trademark use.¹⁸¹ In short, eBay did not use the TIFFANY mark to identify eBay, but rather to identify the Tiffany product offered on eBay. Similar scenarios may arise in social media

¹⁷⁸ *Tiffany (NJ) Inc. v. eBay Inc.*, (2010) 2d Cir. 600 F.3d 93, 101.

¹⁷⁹ *Id.*

¹⁸⁰ *Id.*

¹⁸¹ *Id.*

marketing. If the mark is just a signal of the product on the social media platform or creating a social network account, there would be no dilution claim. Because social media platform is just a tool for business marketing. However, if a business uses is direct to advertise its own goods or services, in such a situation, this activity will diminish the distinctiveness of the other's trademark. This will satisfy that TDRA requires the defendant to use the trademark as a "trademark or trade name."¹⁸²

4.2.3 Use in Commerce

As a threshold issue, dilution requires the junior user to use the senior user's mark "in commerce".¹⁸³ Social media marketing may use programs like Google's AdWords and keyword suggestion tools. Google's keyword suggestion tool recommends keywords to advertisers, and AdWords allows advertisers to buy keywords that trigger sponsored link advertisement. However, whenever a user views certain physical objects or trademarks, a digital advertisement is generated instead of entering a search request into the search engine. If an entity like Google suggests and sells a trademark to an advertiser for prompting digital advertising, it may meet commercial requirements, as shown by *Rescuecom Corp. v. Google Inc.*

At *Rescuecom Corp.*, the Second Circuit Court held that Google's sale of *Rescuecom* marks to advertisers constituted "use in commerce".¹⁸⁴ The court reconsidered its previous decision, *1-800 Contacts, Inc. v. WhenU. Com, Inc.*, highlighting the significant differences between the facts behind the two cases.¹⁸⁵ Among the 1-800 contacts, the defendant *WhenU* provides the user with free proprietary software as part of the bundle downloaded from the Internet.¹⁸⁶ Based on the search term or website being accessed, the software generates relevant pop-up advertisements that are randomly selected from the catalog categories.¹⁸⁷ 1-800 is suspected of infringing trademark rights because the software advises competitors when they visit

¹⁸² 15 U.S.C. § 1125(c)(1).

¹⁸³ *Id.*

¹⁸⁴ *Rescuecom Corp. v. Google Inc.*, (2009) 2d Cir. 562 F.3d 123, 125-26.

¹⁸⁵ *Id.*

¹⁸⁶ *1-800 Contacts, Inc. v. WhenU.Com, Inc.*, (2005) 2d Cir. 414 F.3d 400,404.

¹⁸⁷ *Id.*

the 1-800 website.¹⁸⁸ The Second Circuit found that Internet marketing companies did not bear tort liability because it did not use the 1-800 CONTACTS mark.¹⁸⁹ In addition, Internet marketing company programs do not allow customers to purchase specific keywords.¹⁹⁰

Rescuecom corporation explained that 1-800 contacts are distinguishable in several important ways. First, in the 1-800 contacts, WhenU does not use or reproduce the 1-800 CONTACTS mark; instead, it uses the 1-800 contact's website address.¹⁹¹ However, at Rescuecom, Google sells the RESCUECOM logo to promote sponsored link advertising.¹⁹² Second, WhenU does not sell the trademark as a keyword for the advertiser, nor does it "spend other categories-related ads in response to any specific terms in the internal directory."¹⁹³ In other words, the proprietary software relies on categories associated with search terms or websites, rather than actual search terms or the website itself; however, Google allows advertisers to purchase RESCUECOM mark and use that mark to trigger specific sponsored ads.¹⁹⁴ Besides, Google uses its keyword suggestion tool to recommend advertisers to purchase the Rescuecom trademark.¹⁹⁵

4.2.4 Possibility of Dilution: Association caused by the Similarity

However, even if the use of trademarks and commercial use is met, the question remains whether there is a possibility of dilution. As mentioned above, both dilution by blurring and dilution by tarnishment require "association arising from the similarity between a mark or trade name and a famous mark."¹⁹⁶ The instant interoperability of social networks makes it easy for users to connect famous trademarks to unrelated products. Traditionally, blurring occurs when a company

¹⁸⁸ Id.

¹⁸⁹ Id.

¹⁹⁰ Id.

¹⁹¹ Id.

¹⁹² Id.

¹⁹³ Id.

¹⁹⁴ Id.

¹⁹⁵ Id.

¹⁹⁶ 15 U.S.C. §§ 1125(c)(2)(B)-(C).

uses a well-known trademark as its own trademark for an unrelated product.¹⁹⁷ When a company began to market McDonald's candy on its social networking platform, McDonald's trademark value would be weakened because its trademark's uniqueness to fast food was diluted by the above behavior. However, the connection between the new McDonald's and candy created by social media marketing. The link between the newly established trademark and the product substantially detracts from McDonald's inherent links to fast food products. More importantly, consumers, as recipients of marketing messages, are more likely to accept marketing messages from trademark holders' social network accounts. The specificity of social media accounts reduces the ability of consumers to identify the authenticity of marketing messages. From this perspective, social media marketing has greatly increased the possibility of trademark dilution.

To sum up, social media marketing, due to its point-to-point communication, specificity of social media accounts and instant messaging, not only improves marketing efficiency but also increases the risk of brand dilution. Although there are no cases of social media marketing, yet from the case of Internet marketing, in my view, it is not difficult to speculate that when the main mode of commercial marketing gradually changed from online marketing in the Internet era to social media marketing in the media era, the risk of trademark dilution will still remain and may present exponential growth.

5 Counterfeit Goods on the Social Media

In the past few years, the sales of counterfeit goods offered on or related to social media websites have increased dramatically. A recent study shows that counterfeit products are sold through targeted advertising on social media sites. Surprisingly, targeted advertising has become a common practice for top-ranking websites. When an ad is clicked, the user is received by a website that sells counterfeit goods that

¹⁹⁷ *Louis Vuitton Malletier, S.A. v My Other Bag, Inc.*, (2016) S.D.N.Y.156 F. Supp. 3d 425, 433.

appear to be authentic and legitimate, but after careful inspection, the products sold on those pages become fakes. Moreover, social media sites are currently being expanded to offer their users the option to sell products directly to other users. This trend will only make it more difficult for online counterfeit goods that are readily available through the Internet. Most social media sites have policies that require users to respect the copyrights of others. On some websites, the procedures to be followed are very clear, however, few top websites have an easy-to-follow policy to combat the sale of counterfeit goods.

The marketing week survey found that a range of brands, including Ugg Australia, Mulberry, ray-ban and Louis Vuitton, are being targeted by unauthorized websites that use social media to promote their claims to sell luxury goods. We found a number of unlisted sites in these brands' published dealer networks that use links and paid advertising space on platforms such as Facebook, Twitter, and Pinterest to bring in web traffic, using brand photos, logos and trademark vocabulary. According to the Intellectual Property Office, social networking is the biggest cause of consumer complaints about counterfeit products, and January is the most productive month of the reporting year.¹⁹⁸

As Trading Standards joint-lead officer Paul Thompson said, "Technology changes so fast that legislation can't keep up with the advances and criminals are one step ahead of law enforcement."¹⁹⁹ Today, while there are many online stores available for counterfeiters to sell their goods, including search engines, marketplaces, and websites on open websites, the problem of counterfeiting on social networks has recently become acuter.²⁰⁰ Many brands themselves have difficulty taking effective anti-counterfeiting measures because a social media account can be abandoned by a counterfeiter and a new person can be set up at any time. A case study conducted by NetNames, a drug protection brand for pharmaceutical customers, found that as

¹⁹⁸ Michael Barnett, 'Warning: how social media is a danger to brands', (2014) Marketing week, Available at: <https://www.marketingweek.com/2014/01/08/warning-how-social-media-is-a-danger-to-brands/> (Accessed: July 20, 2018)

¹⁹⁹ Id.

²⁰⁰ Id.

many as 4,500 suspicious accounts or groups in the industry were identified on Facebook and Twitter within six months.²⁰¹ Therefore, the proliferation of fake social media networks is mainly caused by two reasons: the lack of protection awareness of trademark holders and the use of social networks to sell fakes are difficult to detect.

5.1 The Lack of Protection Awareness of Trademark Holders

According to NetNames research, many marketers may not know the severity of the problems faced by their brands. More than half of the marketers surveyed rated their knowledge of brand protection issues as average or worse.²⁰² Chris Knight, the co-founder of the Swiss Eyewear Group and former marketing director of Polaroid glasses, said he barely saw evidence of the brand hiring experts in the field and generally lacked awareness at the executive level. Companies such as Deckers, which owns Ugg Australia, and pharmaceutical giant Roche, are looking to hire brand protectors with legal or research backgrounds. Roche focuses on people who understand social media and online marketing practices. Knight warned that marketers choose to turn a blind eye to counterfeit products, seriously jeopardizing consumers' perceptions of their brands.²⁰³

Today, major social media platforms such as Facebook, Twitter, Weibo, and WeChat (in China) have introduced corresponding management policies for the sale of counterfeit goods through social networking platforms, taking targeted measures such as A Facebook spokesman said: " Facebook takes intellectual property seriously. When a rights owner makes us aware of counterfeit goods being sold on Facebook, we take appropriate action. "²⁰⁴ Because marketers lack awareness of trademark protection, they are blind to counterfeit goods on social networking platforms, and the promotion of counterfeit goods through social media is still rampant. From this perspective, the risk of trademark infringement on social networking platforms

²⁰¹ Id.

²⁰² Id.

²⁰³ Id.

²⁰⁴ Id.

remains high.

5.2 The Use of Social Networks to Sell Fakes are Difficult to Detect.

According to Thompson at the trading standard, the personalization of Facebook advertising can also cause detection problems, as different ads will be shown to each user and changed frequently. Therefore, the user who has seen the suspected counterfeit advertisement must be sufficiently clear to take the screen for use as evidence before browsing the page.²⁰⁵

The industry-wide Digital Transaction Standards Organization (DTSG) announced that advertising space on social media was not included in a new initiative to avoid misplacement of online advertising.²⁰⁶ According to the head of IPA digital Nigel Gwilliam, social network advertising inventory is not within the scope of the principle, because the priority of DTSG negotiations is to manage the "open trading environment" on the wider Internet. He admits that there are concerns about dislocations on social media, but "with is a 'walled garden' environment where you know where to go", as an advertiser to solve these problems, refer to social networks.²⁰⁷ He believes that the problem of counterfeiters buying advertising space is slightly different, although legitimate advertisers may object to their ads appearing alongside counters of counterfeit dealers.²⁰⁸

Considering the scale of selling counterfeit goods through social networks, the wider Internet may pose a more challenging counterfeit threat to brands than social media. However, it is clear that the use of social networks to promote the growth of illicit merchandise trade is more rapid. More recently, Adidas and Reebok filed lawsuits against sellers selling counterfeit goods on eBay, Bonanza, iOffer, and Instagram. This lawsuit marks an important milestone in intellectual property law as it highlights the importance of online policing strategies for brands that are at risk of trademark

²⁰⁵ Id.

²⁰⁶ Id.

²⁰⁷ Id.

²⁰⁸ Id.

infringement.²⁰⁹

In conclusion, despite the gradual awakening of trademark holders' awareness of protection and social media platforms also have developed mechanisms to prevent counterfeit goods from spreading through social media platforms, social media marketing still maintains high risks on trademark protection because of its unique communication characteristics (described above). The good news is that industry giants like Adidas and Reebok have started litigation against fake social media platforms, and we will continue to focus.

²⁰⁹ Jenny Wolfram, 'Adidas Goes After Counterfeit Sellers on Instagram', (2018) Brand Bastion Blog, Available at: <https://blog.brandbastion.com/adidas-goes-after-counterfeit-sellers-on-instagram> (Accessed: July 20, 2018).

6 Conclusion

Social media enables brands to cross national borders and make significant changes in the lives of their users. Some people think it makes people move closer, and some people accuse the social media platforms of contributing to social conflicts. It can be seen that in social media marketing, the social media platform is regarded as a double-edged sword, which not only allows the brand to directly contact the consumer but also allows the trademark holder to understand the customer's motivation. However, such knowledge comes at a price. Unsatisfied customers have limited influence before blogs, Twitter and other forms of social media emerge. Today, equally dissatisfied customers can rely on a variety of social media networks to spread their news, experiences, and reactions to a wider audience. When social media marketing gradually becomes the most important way for trademark holders to expand their brand influence and enhance brand and customer interaction, they must face the high risk of trademark infringement caused by brandjacking, trademark dilution, and counterfeit goods on the social media platform. Therefore, the enforcement of trademarks in social media marketing is essentially the process by which trademark holders choose the best balance between opportunities and challenges.

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