

September 2020

# Revisiting Hashtag Trademarks After Ten Years: From Sextiles and Octothorpes to #Metalepsis

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## Introduction

From a legal perspective the issue of hashtag trademarks is now a little more than a decade old. It has lost a bit of the excitement it had just five years ago, but it still bears indicia of being a valuable legal and commercial tool. This article attempts to demonstrate why, if deployed correctly, traditional trademark laws and procedures—with only minor modifications—are up to the legal task of registering and enforcing investments in hashtag trademarks on par with other common types of trademarks. In an attempt to answer the question why trademark a hashtag, this article explores the history of hashtag trademarks, the history of the hashtag and then how hashtags use a rhetorical technique called narrative metalepsis (*#what?*) to help authenticate customer engagements and build brand loyalty with particular goods and services, on and off social media.

## I – HASHTAG TRADEMARKS

In the United States, a mark that is arbitrary or suggestive can be federally registered on the Principal Register.<sup>1</sup> A mark that is only descriptive may be banished to a secondary register, known as the Supplemental Register, until it acquires distinctiveness after long-term and extensive use, also called secondary meaning. Upon achieving secondary meaning, a new application can be filed to register the mark on the Principal Register.<sup>2</sup> A mark that is generic is just less fun for everyone.<sup>3</sup> Australia and many other countries do not have a secondary trademark register, but recognize the need for acquired distinctiveness of otherwise descriptive marks.

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1 Why register any trademark? Registration on the Primary Register enables use of the ® symbol (which looks cool at the end of the hashtag), nationwide priority, incontestable status after five years, and better legal presumptions, enforcement options, and domain name protection.

2 For example, #ChatAutism® for online blogs in the field of autism in class 41 was initially registered on the Supplemental Register (U.S. Trademark Reg. No. 4,650,746).

3 Unless of course the trademark was the victim of its own success (called genericide) such as Aspirin, Laundromat, Thermos, Trampoline, TV Dinner and Yo-Yo.

Into this ageing world of trademark law the modern hashtag was born in mid-2007. Common wisdom is that by 2010, only seven companies had applied to register hashtag trademarks with the U.S. Patent and Trademark Office (USPTO).<sup>4</sup> Distinguishing early hashtag trademark applications from other applications that only look like hashtags can be difficult. Consider these examples:

- #OCTOTHORPE - consisting of a design, a number sign,<sup>5</sup> and what looks like a made-up word, filed on 27 December 2006 and listing a first use in commerce of 1 November 2006, for voice over internet protocol (VOIP) services (U.S. Trademark Reg. No. 3,390,856, now cancelled);
- # HAITI NOT JUST A TRENDING TOPIC - consisting of a design including a number sign and a heart symbol, filed in 2010 for various apparel (U.S. Trademark Appl'n Ser. No. 77/918,457, now abandoned); and
- #BAIL®, #BOND® and #DWT® - each filed in 2010 for telecommunication services in the legal industry and registered on the Supplemental Register in the United States.

With many searching tools, it is difficult to identify hashtag trademark applications and registrations for reasons described above. Likewise, it is sometimes difficult to understand whether or not a hashtag is functioning as a trademark, meaning as an indicator of source. For example, a trademark application for the protest slogan #ICANTBREATHE for various garments (U.S. Trademark Appl'n. Ser. No. 86/485,865) was abandoned after being denied registration on the basis of false connection to Eric Garner (under section 2(a)), but also for being an informal slogan (under sections 1, 2, 3 and 45) that the “public would not perceive ... as source-identifying matter” (Office Action, March 5, 2015).<sup>6</sup>

More recently, L'Oréal USA Creative, Inc. filed a trademark application in the U.S. for the mark BLONDEAF for “hair coloring preparations,” listing a first use date in March 2017. (U.S. Trademark Reg. No. 6,003,467). The examiner initially rejected the application due to the marks' failure “to indicate the source of applicant's goods and to identify and distinguish them from others.” To support the rejection, the examiner cited numerous Internet locations where people have been using #BLONDEAF, sometimes thousands or tens-of-thousands of times, dating as far back as 2011. Applicant responded, arguing among other things that: (a) widespread use on the Internet does not preclude registration and “could be found for virtually any mark,” (b) use by others should be evaluated for use as a trade mark, and (c) the USPTO had previously allowed its application for BLONDEAF. The examiner then approved the application for publication. After publication, Applicant submitted a specimen of use and an amendment to change the application to show the mark as “#BLONDEAF” instead of “BLONDEAF,” which was consistent with the specimen submitted at

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4 Australian clothing retailer Rivers Retail Holdings Pty Ltd appears to be one of the first to file a hashtag trademark in Australia. In January 2013, it filed a trademark application (Australian trade marks registration no. 1538130) for “#What” for “clothing, footwear and headgear” in class 25. Four months later, Rivers Retail Holdings filed a trademark application for “HASHTAG” for the same goods (Australian trade marks registration no. 1557202). Both trademarks are still registered in Australia.

5 Although known by many names, the symbol that is a prefix to an operand is referred to as the number sign or the hash symbol in this article to distinguish it from the entire tag, called the hashtag, unless you are French.

6 In contrast, #ICANTBREATHE® was registered in the U.S. in class 5 for dietary and nutritional supplements, on June 24, 2014 (U.S. Trademark Reg. No. 4,556,994).

the same time (Post Publication Amendment, Oct. 24, 2019). The trademark examiner rejected this amendment as materially altering the mark (Office Action, Nov. 25, 2019). In response, Applicant argued that “[t]he hashtag is clearly equated with mere punctuation, and like other punctuation, its presence in a mark typically does not change the mark’s commercial impression” (Response to Office Action, Dec. 2, 2019). The amendment was accepted, and the mark was registered as #BLONDEAF.

*“While the USPTO treats hashtag trademarks as similar to generic top-level domain (gTLD) trademarks and punctuation marks, it also begins the section on hashtags by defining them as “a form of metadata...”*

Despite these difficulties, it is commonly believed that nearly 1,400 hashtag trademark applications were filed globally in 2015, representing nearly half of all the hashtag trademark applications filed up until that point in time. The largest source of these applications can be found in the United States. However, to date, the United States has registered fewer than 1,500 hashtag trademarks.<sup>7</sup> In contrast, there are roughly a dozen hashtag trademark applications in Australia.

## #REGISTRABILITY

In 2013, the USPTO first promulgated procedures in its Trademark Manual of Examining Procedure (TMEP) to advise trademark examiners and applicants how to assess registrability of hashtags. *See* TMEP § 1202.18 (2013). By April 2017, the TMEP’s approach acknowledges registrability, but remained cautious in describing circumstances for refusing registration. The 2017 TMEP suggested that in general hashtags “merely facilitate categorization and searching within online social media,” but advised “careful consideration should be given to the overall context of the mark,” including how it is used, the specimens and the goods and services listed. TMEP § 1202.18 (2017).

The TMEP required refusal of registration in only two circumstances: (1) where “the relevant public will not view the hash symbol ... in the mark as identifying the source of the goods or services,” such as where “the specimen shows the” number sign “as merely a tag used to reference or organize keywords or topics of information to facilitate searching a topic;” and (2) where the wording in the hashtag “is merely descriptive or generic for the goods or services” *Id.*<sup>8</sup> One of the few substantive

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<sup>7</sup> Many of these registrations relate to social and personal causes, clever puns that suggest applicant’s business, ideas for marking clothing, and catchy innuendos using borderline adult content. These include: #ENOUGH for goods and services related to preventing gun violence (U.S. Trademark Reg. No. 5,832,605) and #GETNAKED for melanoma awareness advocacy (U.S. Trademark Reg. No. 5,081,634); #VampireTint for tinting car windows (U.S. Trademark Reg. No. 5,813,527) and #GETFLOATY for inflatable water toys (U.S. Trademark Reg. No. 5,520,319); #thenewwhiteflour, registered by Cali’flour Foods for pasta, pizza and pizza crusts (U.S. Trademark Reg. No. 5,883,845); #SUPPLYCHAINGEEK by Barcoding, Inc. for supply chain related services (U.S. Trademark Reg. No. 5,207,965); and “#BLACKLINESMATTER for tattooing related goods (U.S. Trademark Reg. No. 4,997,812).

<sup>8</sup> *See, e.g.,* #BABY for baby bags in class 18, refused registration as merely descriptive, and now abandoned (U.S. Trademark Appl’n Ser. No. 86/924,011).

changes between 2013 and 2017 was that the TMEP in 2017 provided for the possibility that adding a number sign “to an otherwise unregistrable mark” may “render it registrable.” *Id.* (changing “cannot render” to “typically will not render”). #babysteps

There is room for improvement to this section of the TMEP, as it suggests the number sign “should be disclaimed” where “separable from otherwise registrable material” instead of using the term such as “may require” disclaimer. If filed, there is no inherent reason why an application like #COKE for beverages should disclaim the number sign. Additionally, the TMEP appears to confuse the hash symbol with the hashtag in suggesting that it is the hashtag’s prefix, the “hash symbol,” rather than the entire hashtag (the hash symbol and the operand) that is the “tag used to reference or organize keywords or topics of information to facilitate searching a topic.” TMEP §1202.18(a).

The TMEP was last updated with respect to hashtags in October 2018, adding reference to a 2018 case decided by the Trademark Trial and Appeal Board (TTAB) in support of the proposition that adding a hash symbol “generally adds little or no source-indicating distinctiveness to a mark.” *See, In re i.am.symbolic, llc*, 127 USPQ2d 1627, 1633 (TTAB 2018) (noting that will.i.am’s “use of a hashtag [#WILLPOWER] in the social media context plays a functional role in facilitating searches on social media platforms” and that “a hash symbol . . . generally adds little or no source-indicating distinctiveness to a mark,” and also affirming the denial of registration on likelihood of confusion grounds over a prior registration with the wording “WILLPOWER WEAR” and “HAVE THE WILL”).

While the USPTO treats hashtag trademarks as similar to generic top-level domain (gTLD) trademarks and punctuation marks, it also begins the section on hashtags by defining them as “a form of metadata,” which as explained in above is very different than other traditional and non-traditional trademarks. *Id.*

In Australia, IP Australia’s Trademarks Office Manual of Practice and Procedure (most recently amended in relevant part in 2016) also recommends treating hashtag trademark applications in a manner similar to domain names, namely by focusing on other elements of the mark. Either the word(s) following the hash symbol are descriptive or non-distinctive elements of the mark and are not *prima facie* capable of distinguishing,<sup>9</sup> or the hashtag and the words following it are part of a composite mark and may be registrable “due to the overall presentation.” IP Australia also acknowledges that use of a hashtag for a sufficient period may result in sufficient secondary meaning to be registrable,<sup>10</sup> however it does not yet articulate what would be required in circumstances where the hashtag in its entirety may be registrable prior to customers coming to recognize it as identifying a brand.

For the relatively few number of hashtag trademark applications to date, these practices and procedures largely serve their purpose. This is because, as used, the traditional hashtag generally is either:

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<sup>9</sup> We may see whether Hemmes Trading Pty Limited’s application for #malbec for “alcoholic beverages; wine” and various related hotel, restaurant and cafe services received an adverse report in Australia for at least this reason (Australian trade marks application no. 1972166).

<sup>10</sup> *See*, [http://manuals.ipaustralia.gov.au/trademarks/Part\\_22.pdf](http://manuals.ipaustralia.gov.au/trademarks/Part_22.pdf) (¶14.5, between “Phonewords” and “Cryptocurrency”).

(1) merely for the purpose of tagging and searching and not intended to distinguish the source of goods or services, or (2) it incorporates language or images registrable without the number sign. Hashtags in the first category are used freely by all, unprotected by trademark law for a number of reasons including that they are merely descriptive, because of the social need to avoid pre-empting free speech, or they tend towards the generic.<sup>11</sup>

Hashtags clearly in the second category are capable of registration and thus unauthorized use by others in a trademark sense (identifying the source of goods or services, or distinguishing goods or services from others) may result in legal liability with or without the hashtag. The language following the number sign in this second category is by definition fanciful, arbitrary, suggestive or has acquired distinctiveness. The addition of a number sign (and sufficient acquired distinctiveness where required) is unlikely to diminish these qualities absent genericide (not addressed in this article). *See, e.g., #TBT*<sup>®</sup> for wine (U.S. Trademark Reg. No. 4,785,880).

There are at least two other categories of hashtags to consider: (3) those capable of distinguishing goods and services even though the same language without the number sign may not be registrable for the same goods or services; and (4) hashtag logos. The third category arises either where the mark is generic without the number sign, or where it is descriptive and acquires distinctiveness only in a form bearing the number sign.

Category 3 includes the subject of a recent U.S. Supreme Court decision with respect to the registrability of the domain name *Bookings.com*. Following its first day of arguments heard by telephone ever, on 4 May 2020, the U.S. Supreme Court rejected a *per se* rule that adding “.com” to a generic term could not convey source-identifying meaning. *See USPTO et al v. Bookings.com B.V.*, 140 S.Ct. 2298 (2020). However, the Court did note that only one entity can own a domain name at a time – the owner of the top-level domain indicated by the “rightmost component of the domain name.” *Id.*, at 2303. The Court used this to distinguish domain name trademarks from terms like “Wine, Inc.” and “The Wine Company,” which presumably are generic, but might acquire distinctiveness. *Id.* at 2312-13. This contrasts with hashtags, and specifically (the leftmost component of the hashtag), which may signify to its audience that the entirety of the hashtag refers to a context-specific referent, unless as suggested here is it being used as a trademark to refer to a specific—though perhaps unknown—provider or goods or services.

The European Union may have an early example a Category 3 hashtag mark with #CASH (EUTM Trademark Reg. No. 5,512,843), filed on November 30, 2006, which includes class 36 (financial services including those carried out over mobile phone services) and class 38 (telecommunication services including computer aided transmission of messages and images).<sup>12</sup> #PLAY was recently

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<sup>11</sup> Correspondingly, attempts to register marks that are otherwise widely used on or off social media are generally denied. *See, e.g., In re DePorter*, 129 USPQ2d 1298 (TTAB Jan. 29, 2019) (precedential) (unsuccessfully seeking to register #MAGICNUMBER108 relating to the Chicago Cubs break in their drought after 108 years); *In re Gillard*, (TTAB Jan. 11, 2019) (nonprecedential) (unsuccessfully seeking to register #COVFEFE) (<http://ttabvue.uspto.gov/ttabvue/ttabvue-87469115-EXA-15.pdf>).

<sup>12</sup> #OCTOTHORPE for VOIP services may also be in this category.

registered in class 9, 35 and 38 for, among other things, downloadable computer game software and video broadcasting services over the Internet (U.S. Trademark Reg. No. 5,000,287). In 2013, IP Australia registered “# What” in class 25 for “clothing, footwear and headgear” for River Retail Holdings Pty Ltd.

*“Of course, registration is only the first step, and has limited value if you cannot protect your rights. To date there are no reported decisions in the U.S. or Australia involving enforcement of trademark rights in registered hashtag trademarks.”*

Perhaps one day we will see #DATE for on-line dating services organized over social media or #LOVE for prophylactics. But for now, this third category would be the smallest by number of applications, if at least for no other reasons than because hashtags are relatively new for a descriptive mark to have acquired sufficient distinctiveness and because of the inherent marketing difficulties in using less distinctive marks. If the registrations for telephone vertical service codes (explained above) and #BAIL, #BOND and #DWI serve as examples, hundreds if not thousands of Category 3 hashtag applications might have been headed our way, but they have not yet arrived.

Category 4 hashtag logos can operate in precisely the same manner as a traditional logo, and because of the unique nature of hashtags, may do so even more adroitly. Both logos and hashtags can send different messages to different audiences at the same time using something much easier to read than long-winded written text.



One example of this is from Ceno Company Ltd in Japan, which owns a few edgy brands, including #FR2 with Australian and U.S. trademarks for #FR2 in a stylized font (Australian trade marks registration no. 1962923; U.S. Trademark Reg. No. 5736609), and “Fxxkingrabbits” (Australian trade marks application no. 1981017; U.S. Trademark Reg. No. 5992995). Ceno Company often uses one or both of these trademarks alongside adult bunnies at least one of which is also a registered trademark (U.S. Trademark Reg. No. 5986627). In the U.S., the application for “Fxxkingrabbits” was initially rejected by the USPTO as “extremely offensive and vulgar” and the application was suspended pending resolution by the U.S. Supreme Court of *Iancu v. Brunetti*, 139 S. Ct. 2294 (2019). The #FR2 application received no such rejection in the U.S., despite the parallel source indicating significance. Ceno’s use of these word, hashtag and design trademarks may also present a good study of how a company can play with different types of trademarks including hashtag trademarks to build broader consumer recognition of a company and the ability of its consumers to associate those brands with its goods and services. It also permits the company to incorporate or at least adapt to quickly changing cultural events. *See, e.g.*, [https://ceno.jp/FR2/topics/200114\\_fr\\_saveaustralia](https://ceno.jp/FR2/topics/200114_fr_saveaustralia) (in relation to the Australian fires in 2019).



Another interesting example of the hashtag logo in branding that may be headed toward broader notoriety—at least in legal circles—is #NOFAUX (<https://nofaux-thebrand.com/>). The owner of these marks appears to sell hand-held fans (non-electric) and other related clothing in association with two trademark applications in Australia: #NOFAUXFANS (Australian trade marks registration no. 2041109) and #NOFAUX with a logo that itself incorporates a hash symbol along with the letter “N” and “F” (Australian trade marks registration no. 2046226).

Among other personal fans, the owner of these trademark applications appears to sell fans and matching apparel bearing names such as “#LVSTONER FAN” (bearing Louis Vuitton marks mixed with marijuana leaves), “#COCO FAN” (with a modified Chanel symbol on a pink background), and “#SUEME FAN” (with a picture of Audrey Hepburn behind a red block with the white letters “#SUEME”). #NoLegalAdviceBeingProvidedHere

### #ENFORCEABILITY

Of course, registration is only the first step, and has limited value if you cannot protect your rights. To date there are no reported decisions in the U.S. or Australia involving enforcement of trademark rights in registered hashtag trademarks.<sup>13</sup>

Several early hashtag disputes and litigations were resolved out of court or before entry of judgment, and involved use (e.g., dilution or hijacking) of a competitor’s non-hashtag trademark in the form of a hashtag on and off social media. Over time, we have seen more of these cases proceed part or all the way through the courts where for example the trademark is registered,<sup>14</sup> where the trademark is not registered,<sup>15</sup> where there may appear to be defenses of nominative fair use,<sup>16</sup> and where the hashtag incorporates both the registered trademark and defendant’s own name.<sup>17</sup>

The first U.S. hashtag trademark adjudication addressing the registrability of hashtags was *Eksouzian v. Albanese*, No. CV 13-00728-PSG-MAN (C.D. Cal. Aug. 7, 2015) (#CLOUDPEN and #CLOUDPENZ, neither registered). While *Eksouzian* also involved interpretation of an agreement settling a prior dispute, the magistrate judge decided that use of a trademark in the form of a hashtag did not violate a provision of the agreement because “hashtags are merely descriptive devices, not trademarks, unitary or otherwise, in and of themselves.”

<sup>13</sup> Hashtags have been used in litigation as evidence of use, to establish other trademark rights, to establish intent to cause confusion, or as part of enjoined behavior. *See, e.g., Pub. Impact, LLC v. Boston Consulting Grp., Inc.*, 169 F. Supp. 3d 278, 294-95 (D. Mass. 2016) (use of #publicimpact was likely to infringe the PUBLIC IMPACT registered trademark).

<sup>14</sup> *See, e.g., Frank Industries Pty Ltd v Nike Retail BV*, [2018] EWHC 1893 (Ch) (25 July 2018) (partially enjoining Nike’s use of the hashtag #LDNR in social media in the U.K. as infringing and passing off the registered trademark “LDNR” (U.K. Trademark Reg. No. 3095285) owned by Australian company Frank Industries in both the U.K. and Australia).

<sup>15</sup> *See, e.g., Fraternity Collection, LLC v. Fagnoli*, 2015 WL 1486375 (S.D. Miss. Mar. 31, 2015) (denying motion to dismiss state common law trademark claims for use of plaintiff’s name in the hashtags #fratcollection and #fraternitycollection).

<sup>16</sup> *See, e.g., Align Technology, Inc. v. Strauss Diamond Instruments, Inc.*, 2019 WL 1586776 (N.D. Cal. April 12, 2019) (use of a third party’s trademark in a hashtag to refer to the third party’s own goods or services).

<sup>17</sup> *See, e.g., Chanel, Inc. v. WGACA, LLC*, 2018 WL 4440507 (S.D.N.Y. 2018) (relating to WGACA’s second-hand sale of authentic Chanel products using #WGACACHANEL in social media).

Despite *Eksouzian's* position that hashtags are “merely descriptive,” the USPTO has continued to register hashtag trademarks.<sup>18</sup> Similar to keyword litigation, it is likely that even when we see relevant litigation it will take some time before we see consistent and predictable results. In the end, hashtags can and should be analysed for registrability and enforcement as trademarks like any other potential trademark subject matter, including sounds, scents, motions, and gTLDs, each of which seek to apply standard trademark concepts to new types of source-indicating signifiers.

*“Although there are many critiques of protecting hashtag use with trademarks, they largely come from outside trademark theory.”*

Australia has not yet had a case proceed through trial and opinion on this issue, although it came close in *In-N-Out Burgers, Inc v Hashtag Burgers Pty Ltd* [2020] FCA 193, ¶ 93 (26 February 2020) (respondent unsuccessfully “contend[ing] that the use of the hashtag [replacing the first internal letter “O” in “Down N Out”]... is also a significant point of distinction. Not only is it missing from the applicant’s mark, ... it ‘requires the viewer to pause and interpret’ the sign.”).

## #CRITICISM

Although there are many critiques of protecting hashtag use with trademarks, they largely come from outside trademark theory. For example, marketers and bloggers criticize hashtag trademarks as defeating and annoying, largely because they overwhelm the functional tagging and trend-tracking value of hashtags. Culture and especially commerce likely will have their way.

From within trademark theory two types of criticism are often raised: that consumers cannot or do not understand hashtags to be source identifiers (such concerns have already found their way into trademark examining manuals), and that hashtags are not capable of being more than descriptive (as suggested by *Eksouzian*). Even to the extent this is true with respect to a particular hashtag, it is also true of many non-hashtag trademark applications, and it will not be true for all hashtags. In principal, whether used in print or online, hashtags are similar to the #BAIL, #BOND and #DWI registered trademarks for telecommunication services in that they initiate machine-readable functions (telecommunications or internet), they can identify a particular source of goods or services, and they can be understood to do both at the same time by the same person. Caution and case-by-case review makes sense, as recommended by many trademark offices.

Given the relative novelty of hashtags as we use them now, the difficulties in registering and enforcing them as trademarks, the similar rights available from registering the trademark without the number sign, why even bother seeking trademark protection for hashtags? These concerns are

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<sup>18</sup> Many countries permit hashtag registrations with rules roughly similar to those found in the U.S. and Australia. The European Union’s Trademark and Design Guidelines do not explicitly articulate a position unique to hashtags, however the EUIPO has granted registration of hashtag trade mark, such as #sayitwithpepsi (E.U. Trademark Reg. No. 014653968).



compounded by the very real risks that come from legal or marketing misfire, such as launching #QANTASLUXURY around a lockout and union pay dispute (#badtiming), McDonald's loss of control over publicity with its #McDStories campaign in 2012, and Blackberry's 2012 hashtag used to announce available jobs.

To be sure, there are many legitimate economic and branding reasons to step carefully into the world of hashtag trademarks. But value exists (as further explored below) and it can be protected with careful trademark practices from selecting appropriate specimens evidencing use in commerce, using appropriate descriptions of goods and services, and considering consumer surveys, through to marrying experienced attorneys with marketing teams when establishing brand strategy and deploying the new hashtag trademark. The following history of the hashtag and exploitation of a rhetorical technique are intended to provide a deeper understanding that might help some of us get this advice right for our clients.

## #RECOMMENDATIONS

Although otherwise outside the scope of this article, a few practical recommendations arise from this review of hashtag trademark registrations, enforcement actions and hashtag fails. First, when merely adding a hashtag in front of an existing trademark, consider whether the additional cost is worth the effort. Second, before using a new hashtag (especially where you are using it to signify a source of goods or services) prospective trademark owners should conduct a trademark clearance search on the characters following the hash symbol to identify potential conflicts. Further, the clearance search should include common law uses as they may be in the process of acquiring source indicating significance. Third, borrowing from trademark practice in the pharmaceutical space, it may be advisable for a client seeking to launch a brand campaign with a registrable hashtag trademark to also have one or more related marks that may be able to survive loss of registration or genericide, a hashtag misfire, and to facilitate evolution of the brand to keep pace with the culture in which it operates.

## II – HISTORY OF THE HASHTAG

Trademark law is ready to protect hashtags by applying principles already common to trademark law. But what value comes from brand owners using and protecting hashtags with trademarks?

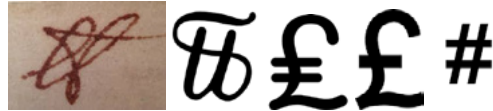
### #HISTORYMATTERS

The first use of the symbol that now serves as the prefix to a hashtag is believed to have come from a 14th century abbreviation of “libra,” itself an abbreviation of the Roman unit of weight “libra pondo,” meaning a pound by weight.<sup>19</sup> As one common story goes, the abbreviation “lb” was written with a horizontal line through the top of the letter “L” so as to distinguish it from the

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<sup>19</sup> In Latin the word “libra” refers to balance and scales (think of the symbol for the seventh Zodiac sign), or a unit of mass or weight. Later it became “livre” (the French currency before 1795) and “lira” (Italian), while the word “pondo” ultimately became “pound,” which is another modern translation for “libra.”

number “1” or to show that the two letters are connected. Over time the abbreviation was stylized with a second horizontal line, and since has been used in various forms, including the symbol for Italian and British currencies.



This symbol became commonly known in the U.S. as the number sign when it precedes a number, and the pound sign when it follows a number. In the U.K., where the word “pound” continues to serve double duty in reference to both currency and weight, the symbol is referred to as a hash, square or gate, and as a pound sign but not in relation to the currency.<sup>20</sup> In other cultures the symbol is referred to as a hex.<sup>21</sup>

## #TECHNOLOGYMATTERS

In the hundred years during which we saw the development of early communication devices like the telegraph, teletype and teleprinters, the lack of standardization in character sets and the signals they sent risked product failure, confusion, and financial ruin.

Then, in the early 1960s, engineers at Bell Labs invented the dual-tone multi-frequency band (DTMF) for use over telephone lines as a replacement for the time-consuming rotary wheel. AT&T registered this as TOUCH-TONE.<sup>22</sup> #rotaryiscool #luddite #kidswillneverunderstand. Bell Labs then needed a way to engage telephone extensions and various menu functions, called vertical service codes.<sup>23</sup> Its solution was to add function keys on either side of the zero key on a fourth row at the bottom of the 3x3 key pad.<sup>24</sup> The function keys could be pressed to signal to the network that it was about to receive a code in the form of more numbers (more dual-tones) to engage pre-defined functions.

Inventing extra keys was the easy part. But as every trademark attorney knows, naming them requires true creativity. Which symbols to use? At first, Bell Labs considered a diamond and a five-pointed

20 The author’s multiculturally-sensitive conference call system insists on offering both: “after the tone, say your name and push the number or hash key.”

21 Some readers may also distinguish the pound sign, the number sign, the hash and hex symbols from other symbols that look similar, but which have different historical roots and meanings such as the music symbol for a sharp note (#), the indication in chess for a move resulting in checkmate (#), the insertion of a space in proofreading (#), and of course a Chinese character for a water bearing well (#). #okigoogledit

22 U.S. Trademark Reg. No. 737,312, with a first use in commerce of July 5, 1960 (cancelled March 13, 1984).

23 These services grew to include an alert when a busy number is free (\*66), call blocking (\*60 and \*77), redialling the most recent incoming call (\*69), call forwarding (\*72 and 72#) and assigning one-digit codes for frequently called numbers (74#). This technology later led to dozens of trademark registrations for telecommunication services, and later to #BAIL®, #BOND®, #DWI® and perhaps #OCTOTHORPE and #CASH®.

24 In addition to the keys on either side of the number zero on the bottom row of the handset, early “special purpose” versions of the phone included a fourth column of keys on the right side that was used by the military, including the top-right FO key that would enable the U.S. president to “flash override” in cases of emergencies. Similar keys are still found on ham radios.

star. However, neither symbol existed on the typewriters of the day, nor were they being included in ASCII. ASCII was being developed at the same time in part by IBM and Bell Labs to standardize the machine code equivalent of numbers, letters, punctuation marks and control characters (like back-space, delete, escape and control-z). So, Bell Labs and AT&T settled on using the number sign and the six-pointed asterisk.<sup>25</sup>

Unfortunately, the word asterisk was not well known at the time and was hard to spell. And as alluded to above, there was little consensus as to the proper name for the number sign / hash / hex symbol. #woops Although subject to some disagreement, two prevailing theories are that Bell Labs called its number sign an octothorpe or octotherp, “octo” coming from the symbol’s eight points, and “Thorpe” presumably in honour of a lab director’s favourite Olympian (Jim, not Ian).<sup>26</sup> #greek-geeks It did not stick.

So to fill in the history a bit, how did we get from the number sign or hash symbol to hashtag? In the early 1970s, DEC used the number sign in the operating system for its PDP-11 minicomputers to engage an immediate address mode, indicating to the computer that the data to be acted on (the ‘operand’) was to be found in the characters immediately following the number sign, rather than requiring the computer to go to a register or memory. Shortly thereafter, the computer programming language C began using the number sign to signal the start of a pre-processor directive, a command to be processed according to a different set of rules, and before sending the surrounding source code to the compiler.

In the late 1980s, Internet Relay Chat (IRC) networks used the number sign as a prefix to identify channels (or rooms) available across the entire network, in contrast to channels available only locally on one’s server, which were preceded by the ampersand “&.” A user first joins a room by typing “join/ #channelname.” Only after entering the room digitally could the user read or leave messages for other similarly interested people. At their height there were an estimated several hundred thousand of these channels.

This brings us to the world wide web, blogging, tagging and hyperlinking. On May 15, 2007, Helsinki based microblogging service Jaiku<sup>27</sup> introduced channels to its mobile phone application for sharing contacts, locations and other personal information. These channels, like IRC chat, enabled the same person to have multiple conversations and multiple people to post to the same

25 The 3x3 number grid used today was chosen because it was believed to provide the quickest key entry times. Like the arrow in the FedEx logo, the negative space in the 3x3 grid has negative space that forms the number sign. #Coincidence?

26 In an attempt to appeal to the more technically minded IP professional, the first U.S. patent containing the name “octothorpe” was filed in 1976. U.S. Patent No. 4,042,787. This patent also used the word “sextiles” instead of the words “asterisk” or “star,” in reference to six equal divisions or a 60-degree angle (sex and sextilis in Latin referring to the number six, and one-sixth). #notpatentablesubjectmatter #neededforagoodtitle

But this is an article about trademarks, so it was not until thirty years later—immediately before the invention of the modern hashtag—that a company called Lylix.net applied for the aforementioned U.S. trademark #OCTOTHORPE.

27 A combination at least in name of the short Japanese poem called the Haiku with a Norwegian short story called “joiks.” Both perhaps predecessors to the modern tweet.

conversation – something that was not possible with posting only to personal channels. Friends and followers could be directed to join the channel to “follow the conversation.” To post, you would text “#channelname” followed by your message.<sup>28</sup>

Twitter, which was launched the month after Jaiku in early 2006, began to see a need to enable searching across its growing mass of content. In August 2007, a blogger named Chris Messina suggested a solution for tagging particular content so that it can be made available to interested groups across the entire Twitter network: “How do you feel about using # (pound) for groups. As in #barcamp [msg]?” A few days later he described his motivation as wanting to improve his eavesdropping experience on Twitter, and he described it as a solution similar to IRC and Jaiku. Stowe Boyd, commenting on and generally supporting Messina’s idea wrote a few days later in a blog post called “Hash Tags = Twitter Groupings:” “My sense is that tags in Twitter, as elsewhere, define shared experience of some kind, involving all those using the tag. And the use can be either actively putting a hash tag (like “#hashtag”) into a tweet, or more passively opting to follow a stream of tweets related to a tagged theme.” If only Stowe knew the fuller history. #standingonbacksofgiants

*“As the function of the hash symbol and the hashtag evolved, so too has our ability to manipulate it to communicate more complex, contextually derived meaning.”*

Twitter management is reported to have thought the use of the hashtag as too clunky and nerdy. Google bought Jaiku less than two months later. In very little time, utility won out. Placed anywhere within the tweet, the hashtag could be used to identify relevant tweets, and the hashtag spread alongside the forest fires in San Diego in October 2007. By 2009, searchable, hyperlinked, released from standing sentry at the doors to chat rooms, and freed to exist anywhere within the content of the message, the modern hashtag became content in its own right. Over time, other social networks like Tumblr, Instagram, Flickr and Facebook adopted, linked to, and together with Twitter accelerated the use of hashtags. The hashtag now operates as the connector between more than a billion people sharing experiences. But quantity isn’t everything.

The hashtag functions in a world where we no longer have entirely separate largely private conversations, in real or virtual rooms, with people who have similar interests. We now have interconnected, searchable, multimedia conversations. These conversations are accessed at different times by different people, for different reasons, with different interests and different understandings of the world, and different uses of the same or translated language. All of these different conversation participants attempt to use tags that are applied according to different privacy and platform rules in order to share their experiences and eavesdrop on others. Given this diversity and the number sign’s long functional history, it should not be surprising that many people have come to use hashtags for reasons entirely separate from tagging and searching, including as content to add and vary meaning. And of course, for hashtag humour. #fallon&timberlake

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<sup>28</sup> See, <http://web.archive.org/web/20071224141340/http://www.jaiku.com/blog/page/2/> (May 15, 2007).

### III - #HASHTAGMETALEPSIS

The history of the hashtag is not just about users or eyeballs, or the evolution of a symbol, or even just about its use in tagging and searching on social media. As the function of the hash symbol and the hashtag evolved, so too has our ability to manipulate it to communicate more complex, contextually derived meaning. To understand how this works and why it can be valuable in the trademark and brand space, it is necessary to step back into history for a third time – this time the history of post-modern narrative. #Ugh Roughly halfway between the abbreviation of “libra pondo” and Bell Labs’ invention of the dual tone phone, Miguel de Cervantes wrote the two part *El Ingenioso Hidalgo Don Quixote de la Mancha* (1605 and 1615). Like the names of many law and accounting firms today, the name has been shortened, perhaps to fit into the Twitter world and to minimize the chance of losing paying eyeballs. #TL;DR

*Don Quixote* was one of the first major works of literature where the narrator becomes a part of (literally a character in) the story he is narrating, making the narration self-reflexive and demonstrating to the audience that the narrator is self-conscious. By doing so, Cervantes forces his audience outside the base narrative – seeing the character Don Quixote as more than the parody of chivalry in part one – and invites the audience to add its own interpretation alongside his own. #theauthorisdead This point is intended not to elevate Cervantes’ contributions alongside those of the engineers at Bell Labs or even Chris Messina, but to introduce one way our post-modern culture plays with and thereby creates and further differentiates meaning.

In the second part of *Don Quixote*, written ten years later, the reader learns that the characters are aware not only of the narrative in the first part as a published work, but that the characters are also aware of an unauthorized part-two written by someone else in the intervening years. This technique creates a new narrative, literally within, but cognitively above the original narrative where Cervantes speaks more directly to his audience. He uses it to challenge them to think critically about not only chivalry in the Middle Ages, but also troubling aspects of Renaissance ideology seeking to displace chivalry in his time. #justreadthebook. By inviting his audience to reflect on his initial narrative from yet another, newer perspective, Cervantes can advance more complex ideas through various new and newly self-aware characters. Because he addresses his audience more directly and informally, and because he appears to be self-reflective, he encourages his audience to reflect on the narrative from their own perspective. #stopthemadness

This technique also creates a sense of shared experience. It feels more authentic because Cervantes’ audience is aware that they helped create the experience. It also gives the audience a perspective they are more likely to carry with them into their everyday lives long after they finish reading his two-part book. Cervantes does not stop with just two narrative levels, as many of his characters and multiple narrators have different levels of understanding. This helps Cervantes short-circuit narratives in different combinations, encouraging his audience to consider still more complex concepts.<sup>29</sup> Though

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<sup>29</sup> In *Invisible Planets*, science fiction author Hao Jingfang describes a world with membranous people called Jinjialin whose bodies “merge and mix ... and redistribute materials” as they meet and leave each other. He uses these membranous people as an analogy to the collaborative relationship between authors and their audiences: “We have been sitting here for an afternoon telling stories, and together, we possess a universe. But these stories are not something I tell you. This afternoon, you and I are both tellers, and both listeners.” See, *Lightspeed*, Author Spotlight (Dec. 2013), issue 43 (<http://www.lightspeedmagazine.com/fiction/invisible-planets/>).

the origins of this technique dates back at least two millennia to Quintilian, Cervantes is employing a rhetorical technique more recently conceived as narrative metalepsis. #pretentious It is a deliberate confusion between the story being narrated and the story in which the narrator (or author) exists and becomes a subject of interest to the audience. #*Inception*

A hashtag can accomplish the same result, though perhaps not to the same degree. It sits literally within, but cognitively above the text around it, creating a space to speak more directly to the reader. #cool #waithejustdidit #enoughalready Like its predecessors, we have learned to use the number sign as a signal that the hashtag is more important than, may require interpretation before, and may add to or alter the meaning of the surrounding text. And we have learned that we can use the number sign to signal transport to a discussion space about a topic related in some way to the meaning of the operand, the characters that follow the number sign.

Users of hashtags can alter their intended meaning in a number of ways. For example, they can vary when they use the hashtag, where they place it in relation to other content, and what they place in its semantic container, the operand. And the operand can have meaning on its own, and can convey meaning derived from the purported connection between the hashtag and what it to purports to link to on the Internet. We can also use the hashtag for summary or emphasis, to set tone (as with emoticons), to raise or relieve formality, to communicate familiarity or association with a particular culture or political or religious belief, to establish credibility with a particular audience or associate with a way of life (#ourkidswillneverunderstand), to create or resolve a paradox, to dissolve pretension (#firstworldproblem), or for comedic relief (#woops).<sup>30</sup>

Thus, the hashtag can create a space in the middle of otherwise fixed narrative into which different audiences bring different experiences, beliefs and understandings. The space is shared for a brief time through the use of one hashtag, or is kept open a bit longer with a running conversation through multiple hashtags or multiple uses of the same hashtag. In that space the audience can reflect alongside the author on the text, on culture generally, or even about the author. This shared space can also create a sense of community between the author and the audience. The audience then withdraws different meanings from the same fixed combination of content, context and hashtag, and walks away believing it shared a special connection with the author. All of this can be done without leaving the text through a hyperlink.

Of course, *Don Quixote* is roughly 500,000 words long, quality blogs average around 2,500 words, and tweets while initially limited to 140 characters, average only 30 characters. Unlike the length of this article—which feels at this point a bit too close to *Don Quixote*—blogs, posts and tweets are relatively short and require that any metalepsis exist in less space. The hashtag is a particularly nimble tool for creating these authentic connections in short spaces, not despite its functional qualities as evolved through history, but precisely because the modern audience is aware of these qualities and sometimes a bit of the history as well.

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30 Hashtags appear often on tee-shirts for these purposes, such as: #Jesus, #Love, #Geek, #DadLife, #ImTrending, #IdontTweet and #Hashtag.

But we also have learned that while we may intend to communicate a very precise meaning with the hashtag, like the telephone game (also known as Russian scandal and Chinese whispers), the process is prone to error in transcription. For brand owners, those errors present greater risks in loss of control of one's message. However, like DNA the errors can also present advantages. The hashtag connects its audience to a broader conversation between the brand owner's consumers as well as to a broader cultural conversation. At the same time, it invites the audience to bring to the post new meaning, and it enables distribution to unintended audiences. Why would a brand owner risk subjecting brand meaning to variation by the audience and by culture generally?

### #HEREISTHEBEEF

A brand owner can benefit from the sharing, sorting, categorizing, and trend-tracking descriptive use of hashtags without registering it as a trademark. But a brand owner wanting to benefit from being part of social media conversations reaching potentially tens-of-millions or more people (#theother-viral) and wanting to collaborate in forming a part of the culture social media can create around it, cannot simply rely on adding clever hashtags to its otherwise strictly controlled content. Marketing specialists advise us that to engage the social media enriched modern audience we need to find more authentic ways to connect, or at least connections that feel more authentic. We are hearing branding expressions like: "don't say you are authentic, be authentic," and "use real people to market your brands," even though some people are paying brand ambassadors to market on their behalves. How do we do this correctly?

*"Marketing specialists advise us that to engage the social media enriched modern audience we need to find more authentic ways to connect, or at least connections that feel more authentic."*

If functioning as a trademark, the hashtag reaches through the surrounding text, grabs the audience's attention and tasks the audience with the job of identifying associations between the brand, its related goods or services, and a dialogue playing out around the hashtag. Because the audience has to consult its experiences, values and emotions to do this, the resulting associations are more likely to be meaningful and authentic to the audience.

In one empirical study, published in 2017 and currently undergoing a rewrite, the authors hint that "trademarking hashtags plays a pivotal role in increasing social media audience engagement and information dissemination."<sup>31</sup> The abstract to this study suggests that the less formal narrative writing style accompanying use of hashtag trademarks increased customer engagement. #watchthisspace

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<sup>31</sup> Naveen Kumar et al., *A Hashtag is Worth a Thousand Words: An Empirical Investigation of Social Media Strategies in Trademarking Hashtags*, Mays Business School Research Paper No. 2997653 (July 5, 2017) (abstract available at <https://ssrn.com/abstract=2997653>).

Our trademark laws have evolved over the past hundred years to help us capture value from other ways to reach our audiences, over common concerns of confusion, functionality and depletion. It took at least 80 years between early denials of protection for colour trademarks in the U.S. (under a colour depletion theory for Diamond Match Co.'s red and blue tipped matches) and the first registration (for Owens-Corning's pink insulation in 1986), and even then, only following extensive litigation. In resolving a split between circuits on the issue, the U.S. Supreme Court wrote: "human beings might use as a 'symbol' or 'device' almost anything at all that is capable of carrying meaning."<sup>32</sup> We also have seen trademark registration for motions in 1957 (a representation of a coin spinning on a hard surface), sounds in 1971 (NBC chimes), scents in 1990 (for thread and yarn), and holograms in 1991.

*"The next big leap may just be our own levelling up in our choice and use of trademarks that can bear the weight of narrative metalepsis. It is the author's hope that we will be better equipped to provide this advice with this deeper understanding of hashtags and their histories."*

How do hashtags compare to these other non-traditional marks? Sounds, colours, motion and scent are all capable of reaching into the human psyche beyond words and thus beyond word trademarks, or at least in different ways.<sup>33</sup> Hashtags can be used not only as words, but in speech, and even as gestures accompanying speech.<sup>34</sup> Hashtags can be manipulated more quickly and easily and in more circumstances than other types of trademarks. They can mean different things to different people at the same time, while still pointing to the same goods and services. Because they can be used as narrative metalepsis, hashtags can also assist brand owners in creating more complex connections between author and audience and by invoking more complex social emotions such as sarcasm and parody. Is this just theory, or does this really work?

#BLAMEMUCUS<sup>®</sup> was registered in 2014 in relation to various pharmaceutical preparations by the maker of Mucinex (U.S. Trademark Reg. No. 4,508,016).<sup>35</sup> It worked so well as a hashtag for some because they wanted an interesting way to tell their friends and family that they were feeling unwell. Others used it because it feels good to point a finger at any bad guy. It connects this author to Mucinex not because it is technically accurate or because of any pre-existing feelings for the brand, but because of two particular young kids from whom it is impossible to social distance. #enoughsaid Regardless of why or how, Mucinex gets to be part of the conversation that it started. The trademark registration helps Mucinex be the exclusive brand in that conversation in that it may be able to limit

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32 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 162 (1995).

33 Trade dress and design patents (registered designs in other countries) share similar capabilities.

34 Jimmy Fallon and Justin Timberlake demonstrated this aptly, though not as use in a trademark sense.

35 The owner did not attempt to register the mark without the number sign, which according to the current version of the TMEP, should be disclaimed.



others who try to use the same mark in commerce. It was also likely a more profitable choice of trademarks than “Mucinex In ... Mucus Out,”<sup>36</sup> at least before the world changed.

A similar success story might be told about Proctor & Gamble’s #LIKEAGIRL (U.S. Trademark Reg. Nos. 4,899,174, 5,157,592, and 4,785,927) for feminine hygiene products and female empowerment services, but in a conversation between a different author and audience. However, the registrability, enforceability, and commercial value of some registered hashtag trademarks is incontestable—or will be in two years. In 2017, the USPTO granted U.S. Trademark Reg. No. 5,194,603 for “entertainment services in the nature of hosting social entertainment events,” filed by a Los Angeles teacher with viral Instagram photos showing him wearing stylish outfits and making more complex connections between the brand owner and his audience (#MrStealYourGrandma).<sup>37</sup>

## Conclusion

The past 10 years have shown a constant din of applications for hashtags for tee shirts that may one-day acquire secondary meaning. Leaving these aside, the past 10 years have also shown some clever and likely commercially valuable applications for hashtag trademarks as well as a slow and nearly sufficient improvement in the way trademark cases and administrative advice accept hashtag trademarks. There is a little more room for improvement in the acceptance of hashtag trademark registrations that do not require proof of secondary meaning, without being stylized or a part of a composite mark, or without being dismissed as mere punctuation. The trademark laws can get there. The next big leap may just be our own levelling up in our choice and use of trademarks that can bear the weight of narrative metalepsis. It is the author’s hope that we will be better equipped to provide this advice with this deeper understanding of hashtags and their histories.

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<sup>36</sup> See, Australian trade marks application no. 1144130 (registered in 2007, not renewed in 2016); U.S. Trademark Reg. No. 3,171,332 (registered).

<sup>37</sup> For those interested, the USPTO found no similar marks during review of this hashtag trademark registration, the only issue raised was insufficiency of the original specimen in showing use in commerce, it was not opposed prior to registration, it has not been assigned, and under U.S. law it may become incontestable in only two years. However, under U.S. law assignment of a trademark also requires assignment of the associated good will. No similar application has been filed in Australia.