

Bereskin Parr LLP

# Getting your handle on Twitter, channelling YouTube, and what about Facebook?

## What to do when your trademark is being used on social media sites

With over 1 billion Facebook users, half a billion Twitter users and hundreds of millions of YouTube users, the popularity of social media has created opportunities for businesses – but also room for mischief when it comes to usernames. So what can a trademark owner do when it discovers that someone has used its trademark as a username? Twitter, YouTube and Facebook each have policies that address usernames. Their policies have changed over time and may still change. Although the sites do not mediate disputes, they are prepared to take action and may reclaim or release usernames in certain circumstances. If their policies do not help, a trademark owner can attempt to negotiate; if this is unsuccessful, the courts may provide recourse. However, consideration must first be given to whether the use of the username relates to a clear case of trademark infringement or impersonation, whether the content is fan or criticism content, whether the account is inactive, what response might be received and whether there is a risk that the complaint may go ‘viral’.

### Trademark infringement

If a username is being used on a social media feed, channel, page or profile in a way that is likely to confuse visitors into believing that the trademark owner created, is affiliated with, has endorsed or has sponsored it, a trademark owner can complain to the site to try to get the username cancelled and possibly transferred.

YouTube and Facebook encourage trademark owners first to reach out to the user (eg, by using YouTube’s private messaging feature) to try to resolve the dispute directly. If resolution is not possible, or if it is impractical to contact the user directly, the trademark owner can send a claim through a complaint form. Both sites

have forms specific to username abuse. A trademark owner should identify its trademark and describe how the username infringes its rights.

Facebook also has a form that can be used to complain about infringement by app developers. Again, Facebook encourages trademark owners first to try to resolve disputes directly with the developer (eg, through the “contact developer” link in the gear menu on the app’s Facebook page).

Twitter requires a registered trademark owner to submit a trademark complaint. Owners of unregistered marks can still submit complaints for brand impersonation, for example, if a Twitter user is using the company or brand name, photo, image, contact information or other content as its own. Trademark owners can request that a username and account be removed, or that the username be transferred to an existing company account. Twitter suspends accounts and notifies account holders if there is a clear intent to mislead. If Twitter determines that the account may unintentionally confuse users, it may give the account holder an opportunity to clear up potential confusion or release the username for the trademark owner’s active use. Twitter has a separate policy for promoted products (ie, tweets, trends and account profiles). A trademark owner complaining to Twitter should detail the nature of the confusion (eg, passing off) and include specific descriptions of the objectionable content or behaviour.

In social media, fan and criticism content is common, and the line between infringement and fair use is not always clear. What constitutes fair use may be up for debate, but generally, social media sites are unlikely to mediate disputes between a trademark owner and a user that is a fan or critic. For example, Twitter permits newsfeeds, commentary or fan accounts.

However, an account’s profile information should make clear that the account is not actually owned by the company or business entity that is the subject of the newsfeed/commentary/fan account; Twitter suggests that users distinguish the account with a qualifier such as ‘not’, ‘fake’ or ‘fan’. The username should not be the trademarked name of the subject of the newsfeed, commentary or fan account.

When dealing with fans and critics, trademark owners should consider the possibility of consumer backlash against taking an aggressive approach. There are several examples of users ‘rebelling’ against an overly aggressive IP owner, and of media picking up on the ‘rebellions’, thereby amplifying the problem from the trademark owner’s perspective by drawing attention to the troublesome username. Sometimes it is wise simply to leave a troublesome username alone. It is prudent for legal and marketing departments to collaborate in order to devise a balanced approach to address the concern.

### Inactive accounts

Trademark owners often have concerns about usernames that have been registered by a third party and are objectionable and/or desired, but are not being actively used – in other words, ‘squatted’ usernames. It can be challenging to determine how to proceed in such cases, in part out of fear of ‘waking’ a potential infringer and providing opportunity to feign fair use.

Users of social media sites are expected to be active; however, not all activities are publicly visible, so it is possible that an account that appears to be inactive is not. While there is no uniform bright-line test to deem accounts inactive, various social media sites have established their own tests. YouTube considers an account to be inactive if the user has not logged in for six months,

has never uploaded any video content and has not actively partaken in watching or commenting on videos or channels. YouTube may reclaim an account that it considers to be inactive.

Twitter considers inactivity to be based on a combination of tweeting, logging in and the date on which an account was created. Generally, a Twitter account may be considered inactive if there has been no activity for six months. YouTube and Twitter may release squatted usernames in case of a valid trademark complaint.

To the extent possible, a complaint should be framed accordingly. For example, Twitter will consider various factors, such as the number of accounts created, intent to prevent others from using the username, attempts to sell accounts and using feeds of third-party content to update and maintain accounts under the names of those third parties. A Twitter account that has no updates or profile image, with no intent to mislead, will not usually be considered username squatting. Additional evidence (eg, evidence that the user has offered to sell the username) may assist in supporting a trademark complaint. Twitter will release a username for a trademark holder's active use only if the trademark is registered. Twitter is working on a policy to release all inactive usernames in bulk, if the trademark is unregistered, but it has not yet set a timeframe. In the meantime, Twitter suggests using an available variation.

#### Other considerations

Unlike domain names, usernames are not sold on the open market, so negotiating settlement can be difficult, since paying for transfer of the username may not be straightforward given valuation problems. There is also no industry or legal standard to valuing social media assets (see the US case *PhoneDog v Kravitz*, ND Cal, January 30 2012), which discussed, but did not decide, valuation issues for a Twitter account.

The plaintiff contended that the industry standard was to value each Twitter follower at US\$2.50, whereas the defendant claimed that multiple factors should be considered, including the number of followers, the number of tweets, the content of the tweets, the person publishing the tweets and the person placing the value of the account). Moreover, Twitter prohibits the buying and selling of usernames.

Options are available to help identify a trademark owner's 'official' social media page, feed or channel. For example, Twitter 'verifies' accounts. Twitter does not accept requests for 'verified accounts' from the



**Catherine Lovrics**  
Associate  
[clovrics@bereskinparr.com](mailto:clovrics@bereskinparr.com)

Catherine Lovrics is an associate, barrister, solicitor and registered trademark agent with Bereskin & Parr LLP. Her practice focuses on trademarks, copyright, new media, privacy, consumer protection, and marketing and advertising law, as well as domain names.



**Scott MacKendrick**  
Partner  
[smackendrick@bereskinparr.com](mailto:smackendrick@bereskinparr.com)

Scott MacKendrick is a partner, barrister, solicitor and registered trademark agent with Bereskin & Parr LLP. His practice focuses on trademark, copyright, patent, industrial design and trade secret litigation, and he has been involved in domain name dispute resolution and internet IP infringement issues.

general public. However, Twitter may reach out to the public to verify the account of a trademark owner that Twitter regards as

having a certain profile. Trademark owners can also use links from their website to direct traffic to the right account (eg, a 'Follow us on Twitter' button).

#### Dealing with usernames and accounts

Usernames and accounts may be separated. For example, it is possible to change the username for a Twitter account while still maintaining the account. Trademark owners that have secured their username and account should ensure that the agreement with the party charged with populating content separately covers who 'owns' the username, the account and the content. These elements should also be dealt with when acquiring a new business. Likewise, when settling trademark disputes involving social media, consideration should be given to each of these elements separately. For example, if a username infringed a trademark owner's rights, the trademark owner may want the account to be closed in addition to the username being changed (so that the benefit gained from the username is not retained by the user).

If it is not possible to resolve the dispute using a social media site's own policy or through a negotiated settlement, a trademark owner can consider litigation. The facts of the case may support a claim for trademark infringement, depreciation of goodwill, tarnishment or passing off. There also may be more novel claims that could be advanced. While Canadian courts have not yet squarely accepted and adopted the doctrine of initial interest confusion – a concept which is of particular interest in the context of username-driven confusion – the Supreme Court of Canada recently opened the door to the doctrine (or a variation of it) being accepted in Canada. In *Masterpiece Inc v Alavida Lifestyles Inc* (2011 SCC 27), the Supreme Court stated that "before source confusion is remedied, it may lead a consumer to seek out, consider or purchase the wares or services from a source they previously had no awareness of or interest in. Such diversion diminishes the value of the goodwill associated with the trademark and business the consumer initially thought he or she was encountering in seeing the trademark. Leading consumers astray in this way is one of the evils that trademark law seeks to remedy".

Ultimately, protecting trademarks in social media can be a daunting task. When responding to username issues in the social media sphere, it is important to remember the nature of the social media beauty and beast, and the potential fallout that a trademark owner can suffer if its approach is not adequately tempered. [WTR](#)