

Reflections on the Use of Trademarks in Social Networking Website Vanity URLs

By Eric Joseph Shimanoff

I. Introduction

The rise in popularity and legitimacy of social networking websites has changed the face of the Internet, not just for Internet users but also for businesses that advertise through the medium. Many businesses now put effort into directing consumers to their Facebook pages and Twitter streams equal to that devoted to their own websites. However, as with any new medium, advertising through social networking websites opens up the possibility that third parties may misappropriate the trademarks of these businesses in violation of their valuable intellectual property rights.

While traditional principles of trademark law should protect trademark owners against many unlawful third-party uses, case law holding that the use of trademarks in post-domain paths of the URL is non-infringing could pose an obstacle to businesses that seek to prevent third parties from misappropriating their trademarks in Facebook and Twitter vanity URLs.

This article posits that the conventional view that post-domain paths of the URL merely show how data is organized within a website, and thus that uses of trademarks therein are not indicators of source or sponsorship, is most likely inapplicable in the context of social networking websites URLs. To the contrary, the content that follows the “.com” in a Facebook or Twitter URL may be just as source-indicative as the content that precedes it.

II. Social Networking Websites

Social networking websites such as Facebook and Twitter have opened new marketing channels for businesses seeking to promote their goods and services via the Internet. Just as businesses in the mid- to late-1990s began to recognize the Internet as a valuable marketing medium, businesses today have begun to recognize the importance of advertising via social networking websites to reach a larger audience.¹

Social networking sites provide a unique advertising experience for consumers. For example, businesses can easily and at minimal cost set up a “page” on Facebook on which to post and frequently update information about the company and its goods and services. Similarly, businesses can establish Twitter accounts and post “tweets” about their goods and services, including information about time-sensitive discounts and promotions. Through each website, consumers can elect to follow and be notified immediately of these Facebook posts and Twitter “tweets,” such that information is passed from the business to consumer nearly instantaneously.

Given its interactive nature, unlike traditional one-way advertising through print, television, and radio, Facebook and Twitter allow users to forward content posted by businesses to other users on the network, to post their own comments about and become fans of businesses that establish pages or send tweets, and to share their own comments and fan status with other users on the network. Social network users who partake in these activities essentially become, perhaps unwittingly, unpaid advocates for the business, dramatically increasing consumer exposure and brand recognition at no additional cost to the business. Moreover, the overall media costs to businesses for advertising on social networking websites are significantly lower than via traditional advertising media. It thus should come as no surprise that numerous businesses, including multi-national corporations such as Coca-Cola and McDonald’s, have set up their own Facebook pages and Twitter accounts.²

III. Vanity URLs

Just as domain name registrars allow businesses to set up source-identifying domain names utilizing their trademarks (e.g., mcdonalds.com, coca-cola.com), Facebook and Twitter allow users to establish “vanity” user name URLs where businesses can select a personalized address utilizing their trademark to point to their Facebook page or Twitter account (e.g., <http://www.facebook.com/mcdonalds>, <http://twitter.com/mcdonalds>). But what can a business do if an unauthorized third party decides to set up a Twitter or Facebook account utilizing a business’s trademark in the vanity URL? In the early days of domain name registration, before many corporations had registered their trademarks as domain names, cybersquatting was rampant, as third parties cheaply purchased and hijacked domain names comprised of famous marks in hopes of ransoming them for profit. The offering of vanity URLs by social networking sites creates similar concerns.

IV. Website Policies

Aware of the potential for trademark infringement, prior to offering vanity URLs, Facebook allowed businesses to pre-register their federally registered trademarks with Facebook so that once the URLs were offered, no other user could misappropriate the trademark. However, those users without federally registered trademarks, whose rights in their trademarks may have arisen under the common law, were not afforded the opportunity to take advantage of this pre-registration process and instead were left to fend for themselves when Facebook began to grant vanity URLs on a first come, first served basis. Twitter had no such registration process for holders of feder-

ally registered trademarks. What recourse would businesses have against potential trademark infringement via the Facebook and Twitter vanity URLs?

Both Facebook and Twitter have internal policies that prohibit the unauthorized use of a business's trademark in a vanity URL that would result in consumer confusion, and they each have procedures and forms for reporting such violations.³ However, social networking websites are not necessarily in the best position to make determinations on complex trademark issues such as likelihood of confusion. In some circumstances, they may refuse to make any determination at all. If a trademark holder with a claim of infringement based on the use of a trademark in a vanity URL is unable to obtain relief from the social networking site, what remedies might it obtain from the courts? Given past precedent concerning the use of trademarks in domain names and URLs, the answer is unclear.⁴

V. How Domain Names Differ from Vanity URLs

Before delving into that issue, a review of the basics of domain names is in order. Domain names are divided into different levels. The top level domain name (TLD) is the end of the domain name, such as ".com," ".gov," ".org" and ".biz." Immediately to the left of the TLD is the second level domain (SLD). Thus, in the domain name facebook.com, ".com" is the TLD and "facebook" is the SLD.⁵ Because consumers typically expect the name of the business controlling or authorizing the website to be the name in the SLD, trademark infringement or cyberspiracy may be found when another party uses without authorization a trademark that is not its own as an SLD in manner that is likely to cause consumer confusion as to the source of the website.⁶ Thus, a consumer who is directed to the website located at <http://www.coca-cola.com> would likely expect that website to be controlled by or affiliated with the Coca-Cola beverage corporation.⁷

The use of a business's trademark in a Facebook or Twitter vanity URL, however, is *not* the use of a trademark in a domain name, since the user's trademark does not appear within the SLD.⁸ Instead, in the vanity URL, the trademark appears to the right of the TLD in what is known as the post-domain path of the URL (e.g., <http://www.facebook.com/coca-cola>, <http://twitter.com/mcdonalds>) (bolding added).

VI. Case Law Concerning the Post-Domain Path of the URL

Read literally, the decisions concerning the unauthorized use of trademarks in the post-domain path of a URL have not been favorable to trademark holders. In *Interactive Prods. Corp. v. a2z Mobile Office Solutions, Inc.*,⁹ the leading case on the issue, the plaintiff, owner of the trademark LAP TRAVELER for portable computers, filed a suit for trademark infringement against computer

resellers for the use of the mark in the post-domain path of the defendants' URL, which appeared as <http://www.a2zsolutions.com/desks/floor/laptraveler/dkfl-lt.htm> (bolding added). The URL at issue, however, did not resolve to a webpage offering plaintiff's LAP TRAVELER branded computer for sale. Instead, it led to one offering a competitor's model for sale.

Although the Sixth Circuit found there was no likelihood of confusion by the use of the plaintiff's LAP TRAVELER trademark, the court made the sweeping statements that, unlike a SLD, "[t]he post-domain path of a URL... does not typically signify source. The post-domain path merely shows how the website's data is organized within the host computer's files.... Because post-domain paths do not typically signify source, it is unlikely that the presence of another's trademark in a post-domain path of a URL would *ever* violate trademark law."¹⁰ Based on this broad generalization about consumer perception of domain names and URLs, subsequent courts have refused to find infringement in cases involving the post-domain path of the URL.¹¹

This precedent represents a significant obstacle for a trademark owner who is compelled to seek judicial intervention to prevent the unauthorized use of its trademark in a Facebook or Twitter vanity URL.¹²

VII. Inapplicability of Existing Case Law

In a Web 2.0 world, is the Sixth Circuit's reasoning about the source-identifying properties of a post-domain path of a URL truly applicable to a situation involving a Facebook or Twitter vanity URL? Social network vanity URLs do much more than "show[] how the website's data is organized within the host computer's files."¹³ Indeed, their primary function is to make a user's or business's vanity URL their personal destination or home on the Internet and to provide an easy-to-remember way to find a user or a page.¹⁴

Unlike the unwieldy post-domain URL path at issue in *Interactive Prods. Corp.*, which the court reasoned would probably not be typed into a browser by a consumer searching for the plaintiff's LAP TRAVELER products,¹⁵ a consumer looking for information from a business via a social networking website, especially information about discounts, promotions, or new products and services, likely would type a business's Facebook or Twitter vanity URL directly into a browser. Indeed, many businesses now include the URL of their Twitter and Facebook pages in their traditional television, radio, and print advertising. Also, using a vanity URL helps ensure that a business's Facebook Page or Twitter account will come up near the top of the results of a search engine like Google, the top results usually being business-sponsored links.

Thus, unlike the post-domain path of the URL in *Interactive Prods. Corp.*, vanity URLs on social networking

websites may function as source indicators, and it may be that a high percentage of consumers likely would believe that the page located at <http://www.facebook.com/mcdonalds> and the tweets posted on the URL <http://www.twitter.com/mcdonalds> were authorized by the McDonald's restaurant chain.

VIII. Conclusion

Like the broader Internet, social networking websites such as Facebook and Twitter serve a multitude of functions for an expansive and diverse community. In a sense, they are like their own mini-Internets. Just as consumers became more familiar with the Internet and came to expect SLDs to be the indicators of source for traditional domain names, in many social networking platforms, consumers may now have come to recognize the post-domain paths of the URLs as source indicators.

In cases involving social networking websites, where numerous sources may be affiliated with one domain name through various vanity URLs, courts should avoid reliance on the broad generalization made by the Sixth Circuit that post-domain name URL paths do not serve as source indicators. Instead, courts should take a different approach more in keeping with likely consumer perception in the social networking website context. New media uses have always altered traditional notions of consumer perception, and new uses on social networking websites should be no exception.

Endnotes

1. Facebook boasts over 500 million active users who collectively spend over 700 billion minutes per month on the website. Facebook Press Room, *Statistics*, <http://www.facebook.com/press/info.php?statistics> (last visited Feb. 28, 2011). Twitter has over 16 million users. SFGate, *(Almost) Everybody's on Facebook*, http://www.sfgate.com/cgi-bin/blogs/techchron/detail?entry_id=83924 (last visited Mar. 1, 2011).
2. The Coca-Cola Page on Facebook has over 22,000,000 fans. See <http://www.facebook.com/cocacola> (last visited Feb. 28, 2011). Over 200,000 Twitter users have subscribed to receive Coca-Cola's tweets. See <http://twitter.com/cocacola> (last visited Feb. 28, 2011). The McDonald's page on Facebook has over 7,000,000 fans. See <http://www.facebook.com/McDonalds> (last visited Feb. 28, 2011). Almost 90,000 Twitter users have subscribed to receive McDonald's' tweets. See <http://twitter.com/McDonalds> (last visited Feb. 28, 2011).
3. Twitter Help Center, <http://support.twitter.com/groups/33-report-a-violation> (last visited Feb. 28, 2011); Facebook Help Center, <http://www.facebook.com/help/#!/help/?page=439> (last visited Feb. 28, 2011).
4. No court has yet ruled on this precise issue. Although at least one case was brought against Twitter alleging false association due to the unauthorized of a celebrity's name to post tweets purportedly attributable to the celebrity, the case was voluntarily dismissed after the parties reached a settlement. See *LaRussa v. Twitter*, No. 09 Civ. 2503 (N.D. Cal.).
5. See *GoForIt Entm't, LLC v. DigiMedia.com L.P.*, No. 08 Civ. 2011, 2010 U.S. Dist. LEXIS 120338, at *6-*7 (N.D. Tex. Oct. 25, 2010).
6. See, e.g., *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999) (holding that defendant's use of domain name moviebuff.com violated plaintiff's trademark rights in the mark MOVIEBUFF); *Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc.*, 202 F.3d 489, 499 (2d Cir. 2000) (holding that defendant's registration and use of sportys.com domain name in violation of plaintiff's rights in its SPORTY'S trademark constituted cyberpiracy under Anti-cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d)).
7. See *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1177 (9th Cir. 2010) ("When a domain name consists *only* of the trademark followed by .com, or some other suffix like .org or .net, it will typically suggest sponsorship or endorsement by the trademark holder.") (emphasis in original); *Sporty's Farm*, 202 F.3d at 493 ("The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com.").
8. See *GoForIt Entm't*, 2010 U.S. Dist. LEXIS 120338, at *20 ("Defendants maintain that a third level domain—the level in question in this case—is outside the scope of the statute, because it is not 'registered with or assigned by' a domain name registrar. The court agrees. The only part of a web address that must be registered is the second level domain.").
9. 326 F.3d 687 (6th Cir. 2003).
10. *Id.* at 696-98 (emphasis added).
11. See, e.g., *Nagler v. Garcia*, 370 Fed. Appx. 678, 680 (6th Cir. 2010) (use of mark DIET RESULTS in post-domain path of URL as <http://www.beautyinaflash.com/dietresults.html> "cannot support a claim for trademark infringement"); *Knight-McConnell v. Cummins*, 2004 U.S. Dist. LEXIS 14746, at *8 (S.D.N.Y. July 29, 2004) ("defendant's use of the plaintiff's name in the post-domain path of a URL and placement of URLs using the plaintiff's name in the post-domain paths on chat forums, discussion boards, and search engines do not give rise to any source confusion").
12. Resort to relief under the Anti-Cybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d), or the Uniform Domain Name Dispute Resolution Policy likely would be unsuccessful, since both provide remedies for the use of a trademark in a "domain name" and not in the post-domain path of the URL.
13. *Interactive Prods. Corp.*, 326 F.3d at 696-97.
14. See The Facebook Blog, *Coming Soon: Facebook Usernames*, <http://blog.facebook.com/blog.php?post=90316352130> (last visited Feb. 28, 2011).
15. 326 F.3d at 697.

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