

# The Trademark Reporter®



**The Law Journal of the International Trademark Association**

Eveready and Squirt—Cognitively Updated

*Jerre B. Swann*

A Plea for the Proper Citation of the Lanham Act

*Paul Horton*

*Commentary:* Fashion Dos: Acknowledging Social Media Evidence as Relevant to Proving Secondary Meaning

*Ronald Coleman*

*Commentary:* “The Donald” Trumps Claim for Misrepresentations by Licensee

*Sheldon Burshtein*

*Commentary:* Descriptive, or Not Descriptive—That Is the Question: A Review Under Turkish Law of Likelihood of Confusion When Trademarks Share Descriptive Terms

*Uğur Aktekin, Güldeniz Doğan Alkan, and Zeynep Çağla Özcebe*

**COMMENTARY****FASHION DOS:  
ACKNOWLEDGING SOCIAL MEDIA  
EVIDENCE AS RELEVANT TO PROVING  
SECONDARY MEANING**

*By Ronald Coleman\**

The tests routinely recited by courts for determining whether secondary meaning exists in an alleged trademark are decades old. Do they properly reflect what it means to establish a new brand—that is, to designate a trademark as a source identifier—in the social media era? Taken literally, most do not. The legal interests the tests reflect, however, should permit such consideration. Indeed, if courts fail to adjust these formulations in recognition of recent innovations in brand development and technology, the law will fail to protect important trademark rights as a matter of course.

Proving secondary meaning in trademark infringement litigation is obviously an issue of critical importance for new entrants into a market. This is especially true for plaintiffs seeking relief for infringement of as-yet unregistered trademarks, because they come to court without even the presumption of distinctiveness to which a registered mark is entitled by statute.<sup>1</sup> The problem could be even more severe for claimants fighting the uphill battle of reverse confusion claims, where the alleged junior user has, even according to the claimant, overwhelmed at least some segment of the original secondary meaning that had been achieved by the claimant's mark. For fashion-related start-ups asserting claims for "designs" that, separate and apart from the narrow protection available via copyright, may fall into the murky territory between trade dress and product configuration, the problem may be magnified even further. Absent a registration or other solid basis on which to assert inherent distinctiveness, such claims may well be dead on arrival, or at least on summary judgment.<sup>2</sup>

---

\* Partner, Archer & Greiner, PC, New York, New York, and Hackensack, New Jersey, Associate Member, International Trademark Association; author, Likelihood of Confusion blog.

1. United States Trademark Act of 1946, Pub. L. No. 79-489, 60 Stat. 427, as amended through 2016 ("Lanham Act"), § 7(b), 15 U.S.C. § 1057(b) (2012).

2. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000) (holding that a product's "design"—i.e., the way the goods themselves look, compared to the look of their boxes or labels—can never be inherently distinctive).

How quickly can a start-up entry into the fashion market “acquire” distinctiveness? Under the traditional formulation for evaluating proof of secondary meaning, the answer may all too often be “not quickly enough.” If secondary meaning is defined solely by criteria requiring large budgets, such as substantial advertising expenditures, many years in the market, or “substantial” sales, it is clear that start-ups, especially in the fashion or design sectors, will almost inevitably fail to prove acquired distinctiveness. Even if the mark at issue is otherwise protectable and achieves a bona fide “following” as understood in contemporary marketing terms, a start-up’s mark may fail to achieve these traditional milestones. As a result, potential infringers may be understood as having a license to commit precisely the wrongs that theories of recovery such as reverse confusion claims are meant to prevent.

Close examination of the underlying judicial rationale for that formulation, however, demonstrates that while the courts have not quantified the tools, metrics, or methodologies by which to measure social media impact of brand building, there is ample basis for courts to revise the traditional formulation and make allowance for the digital, new media era. Not only can they do so without departing in any way from the Lanham Act’s purpose, but a failure to do so would, in fact, have the contrary effect.

It has been years since Professor Thomas McCarthy wrote, well before the advent of social media: “With the advent of massive advertising campaigns on television and in national news magazines, a new trademark may achieve wide usage and ‘secondary meaning’ within a matter of days or weeks, compared to the many years required in the days of more leisurely advertising.”<sup>3</sup> Still, the typical formulation of the test for whether a purported trademark has acquired distinctiveness pays this truism little heed. The United States District Court for the Southern District of New York—a court that often hears fashion disputes because of its location in the heart of the fashion business—routinely dismisses trade dress claims at the summary judgment stage because so many start-up claimants fail to meet the standard formulation, which reads as follows and appears in scores of cases:

While the Second Circuit has characterized the question of secondary meaning as an essentially factual determination, and therefore an unlikely candidate for summary judgment, proof of secondary meaning entails vigorous evidentiary requirements, and the plaintiff bears a heavy burden to prove that its trade dress has acquired secondary meaning. Among the factors that may be considered to determine whether a

---

3. J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 15:56 (4th ed. 2016).

product's design has acquired secondary meaning are advertising expenditures, consumer studies linking the name to a source, sales success, unsolicited media coverage of the product, attempts to plagiarize the mark, and length and exclusivity of the mark's use. No one of these factors is determinative, and accordingly each factor need not be demonstrated in order to establish secondary meaning.<sup>4</sup>

Read and applied literally, there is no apparent role here for consideration of how social media might affect the development of secondary meaning. Closely examining the underlying rationale for this formulation, however, and keeping the admonition of Professor McCarthy in mind, demonstrates that there is ample justification for courts to acknowledge the Internet age and revise this list of factors to be considered accordingly.

Social media has provided independent designers historic access to independent fashion media and markets, enabling them to bypass intermediaries such as the fashion press, buyers in leading boutiques, and other historic barriers to entry. At the same time, their creations instantaneously come to the attention of potential infringers. The motivation of free riders to monitor and analyze grass-roots and commercial interest in new designs as reflected in social media is great. Social media provides a virtual window into what excites and interests at least some segments of "the street," and the incentive to copy is obvious. Copying, which under the law is often characterized as "bad faith," can, on the basis of sufficient evidence, virtually supplant a likelihood of confusion analysis and provide grounds for infringement liability.<sup>5</sup> But such an analysis is only germane where the plaintiff has a trademark in the first place. Thus, where a defendant is called on to answer for copying an otherwise protectable design whose brand penetration is "merely" virtual (i.e., sales, revenue, and other traditional criteria of brand entrenchment are not yet in place, but there is unquestionable achievement, through social media, of the effect of bona fide source identification), the defendant will inevitably deny that social media has legal significance for purposes of acquiring distinctiveness. Indeed, that defendant may even acknowledge copying while denying liability based on the failure of the plaintiff to prove any protectable right in its "famous on the Internet" but still commercially nascent creation.

What principles, then, militate against such an argument?

---

4. *Kaufman & Fisher Wish Co. v. F.A.O. Schwarz*, 2001 U.S. Dist. LEXIS 17064, at \*16-17 (S.D.N.Y. Oct. 17, 2001) (quotation marks and internal citations omitted).

5. *See Gucci Am., Inc. v. Guess?, Inc.*, 868 F. Supp. 2d 207, 249 (S.D.N.Y. 2012) ("Gucci has submitted evidence that MFF knowingly and in bad faith copied Gucci's GRG Stripe. This conduct was so egregious that a full Polaroid analysis is not necessary to conclude that there is a likelihood of confusion with Gucci's GRG Stripe.")

In addition to the general comment by Professor McCarthy quoted above, the best analogy to consideration of social media evidence is the ample precedent for admitting non-survey expert testimony regarding consumer behavior and brand penetration from marketing experts, and from industry and marketing professionals. Mid-twentieth-century cases include those admitting testimony from witnesses with “extensive experience as a professional buyer of women’s coats for major department stores”;<sup>6</sup> or whom the court described merely as being in “the merchandising business”;<sup>7</sup> or “experts on the fashion industry” who were knowledgeable about the strength of the plaintiff’s brand.<sup>8</sup> More recent cases include “an attorney [who] has taught ‘Trademarks’, ‘Intellectual Property’ and other related classes”<sup>9</sup>; a lawyer who specialized in “legal and regulatory compliance” who was deemed qualified to testify as an expert on “distribution channels for branded and non-branded jewelry,” based on her wide-ranging work experience;<sup>10</sup> an academic expert on the restaurant industry (not marketing per se) who was found competent as an expert witness regarding trade dress in a case involving competing restaurants;<sup>11</sup> and a guitarist and guitar maker who was deemed competent to testify on the subject of the distinctiveness of guitar shapes in a Trademark Trial and Appeal Board *inter partes* proceeding.<sup>12</sup> And in *Louis Vuitton Malletier S.A. v. Sunny Merchandise Corp.*,<sup>13</sup> the plaintiff, Louis Vuitton, successfully argued that an expert in economics was qualified to testify on brand erosion, even though her testimony was “qualitative rather than quantitative,” and despite the defendant’s objection that the expert’s conclusions about the effect of its sales on the plaintiff’s brand value were “subjective belief or unsupported speculation.”<sup>14</sup>

Significantly, in all these cases, “subjective” testimony based on the experts’ understanding of the industry in question, as well a

---

6. *McGregor-Doniger Inc. v. Dizzle Inc.*, 599 F.2d 1126, 1138 n.7 (2d Cir. 1979).

7. *Triangle Publ’ns v. Rohrlich*, 167 F.2d 969, 972 (2d Cir. 1948) (testimony by “qualified witnesses who were in the merchandising business” on issues of secondary meaning and likelihood of confusion; no further detail is available in the reported appellate or trial court decisions).

8. *Scarves by Vera, Inc. v. Todo Imps., Ltd.*, 544 F.2d 1167, 1170 (2d Cir. 1976).

9. *HealthONE of Denver, Inc. v. UnitedHealth Grp., Inc.*, 2012 U.S. Dist. LEXIS 4506, at \*7 (D. Colo. Jan. 12, 2012).

10. *Pandora Jewelers 1995, Inc. v. Pandora Jewelry, LLC*, 2011 U.S. Dist. LEXIS 62969, at \*21 (S.D. Fla. June 7, 2011).

11. *Hi Ltd. P’ship v. Winghouse of Fla., Inc.*, 2004 U.S. Dist. LEXIS 30687, at \*27-30 (M.D. Fla. Oct. 5, 2004).

12. *Yamaha Int’l Corp. v. Hoshino Gakki Co.*, 840 F.2d 1572, 1582 (Fed. Cir. 1988).

13. 97 F. Supp. 3d 485 (S.D.N.Y. 2015).

14. *Id.* at 504-05.

degree of generalization based on the expert's observation of very large universe of data, was received. This argues for a model in which the introduction of social media evidence is made either by general authentication and is considered on its own merits, or, alternatively, through the testimony of an expert whose qualifications may, but need not, include knowledge of the relevant underlying field of commerce—such as luxury or consumer goods, depending on the market involved—related to the product or service to the which the trademark relates, but who can, above all, testify, in a manner sufficiently sophisticated for purposes of guiding the court, concerning the relevant merchandising or marketing channel as to whether secondary meaning was actually achieved.

“Social media” is not itself an academic discipline that has matured into a single recognized field of study at a mature level. Yet there is no shortage of practitioners of the art who could, in theory, be presented as potential experts in product merchandising and brand development in social media, similar to those market experts in the earlier cases set forth above. At the same time, the role of academic experts, who predominate in the area of surveys, may have a place—and, arguably, a superior one to that of practitioners—in understanding the impact of social media as well, considering the level of sophistication required to adequately understand the interaction and synergy among evolving social media phenomena that affect brand development, such as semiotics, memes, technological/platform differentiations, and the relevant universe of consumers considering such factors as ethnicity and income disparity. Thus, considering a challenge to the proffer of an academic as a likelihood of confusion expert in an advertising case, in *Beastie Boys v. Monster Energy Co.*<sup>15</sup> the Southern District court rejected the argument that the academic's experience in academia and publishing in the advertising field was “too general”<sup>16</sup> or that secondary meaning testimony must, even if it is not a survey, still be entirely “objective” in nature, and is methodologically invalid absent quantitatively “reproducible” formulae, or if its results do not feature a full complement of statistical terms such as “error rates.” Such concerns, the court held, “go to the persuasiveness and credibility of [the expert]’s testimony,” not its admissibility under *Daubert*.<sup>17</sup> Rather, the court ruled, the appropriate attack on such an expert is via “[v]igorous cross-examination, presentation of contrary evidence, and careful instruction on the burden of proof.”<sup>18</sup>

---

15. 983 F. Supp. 2d 354 (S.D.N.Y. 2014).

16. *Id.* at 363.

17. *Id.*, citing *Daubert v. Merrell Dow Pharms.*, 509 U.S. 579 (U.S. 1993).

18. *Id.* at 363-64.

Given this precedent, if an expert is to testify with respect to cause and effect—that is, to opine as to whether, by virtue of a social media campaign, secondary meaning had actually been achieved when the infringement took place—it may be proper to permit an expert whose bona fides have satisfied the court with respect to thoroughness and qualifications to analyze whether a social media campaign has penetrated the relevant market for the alleged mark and achieved secondary meaning. Such testimony could be permitted to include summary, subjective impressions, and analysis of observed social media content—such as Twitter tweets, Facebook likes, Instagram posts, an account’s number of followers, post and tweet activity such as retweets, likes, and other metrics of engagement generated by third parties—observed and considered in the development of the expert’s opinion and the preparation of the expert report. This type of broad perusal, summary, analysis, and presentation is routinely deemed admissible with respect to a wide range of other sorts of testimony, and there is no reason at this point in history not to extend this type of expert testimony to social media.<sup>19</sup> The opposing party’s proper response is to respond in kind based on the same set of facts. This would include not only the usual attack on expert testimony based on the technical quality of the evidence on which the expert has relied, but also by challenging the expert with respect to social media sources, communities, demographics, and phenomena that the expert has omitted from consideration, and his or her explanations for such omissions.<sup>20</sup> Testimony going to whether secondary meaning has been achieved, or contributed to,

---

19. See *Louis Vuitton Malletier S.A. v. Sunny Merch. Corp.* 97 F. Supp. 3d at 504-507 (expert’s presentations were “summaries of the contents of voluminous data [which] will streamline the presentation of that data to the jury, saving the jury time and avoiding unnecessary confusion”) (quoting *Gill v. Arab Bank, PLC*, 893 F. Supp. 2d 523, 536 (E.D.N.Y. 2012); see also *Iacobelli Constr., Inc. v. Cnty. of Monroe*, 32 F.3d 19, 25 (2d Cir. 1994) (“Given the inherently voluminous and highly technical nature of the data in such cases, the parties in a construction-contract dispute usually must retain experts to summarize and interpret that data.”); *Linde v. Arab Bank, PLC*, 922 F. Supp. 2d 316, 332 (E.D.N.Y. 2013) (allowing expert to testify even though “his research was conducted solely on the Internet”); *Broadspring, Inc. v. Congoo, LLC*, No. 13-CV-1866 (JMF), 2014 U.S. Dist. LEXIS 116070, 2014 WL 4100615, at \*16 (S.D.N.Y. Aug. 20, 2014) (allowing an expert to testify who had “relied on his specialized knowledge in the field of information security to synthesize information from his diverse sources and to form an opinion”); cf. *Marvel Characters, Inc. v. Kirby*, 726 F.3d 119, 135-36 (2d Cir. 2013) (noting that a historian would be permitted to “helpfully synthesize dense or voluminous historical texts” or “offer background knowledge or context that illuminates or places in perspective past events”).

20. This would include, of course, attack based on the chain of evidentiary custody concerning social media posts, which are even more ethereal than modern-day proprietary digital commercial data. Obviously the proponent of such evidence will want make every effort to take and preserve “snapshots” of the entire relevant social media landscape at the earliest possible opportunity, once litigation is seen as a possibility—for third parties will not necessarily be complying with the litigation “hold” and their posts, “likes,” and comments may disappear into the ether before they are preserved as potentially valuable proof of secondary meaning.

based on the use of social media should be based on evidence that is shown to have a common-sense, observable correlation with commercial success.

Having said this, it is, again, necessary to distinguish between the inquiry of whether an expert is qualified to testify whether a mark has achieved secondary meaning based on social media activity, and the question of whether expert testimony is necessary for social media evidence to be admitted at all. There is nothing in the cases, in fact, that says social media evidence should not be admitted, and based on the authority cited above, much to suggest it should be. Properly authenticated, such information is admissible in its own right for consideration by the fact finder or by the court on a motion for summary judgment as relevant, useful, and common-sense proof on the question of source identification. Moreover, such evidence is particularly helpful and, as a matter of policy, desirable, considering the prohibitive cost of secondary meaning surveys.

While the foregoing argues for serious judicial engagement with evidence of intensive social media “engagement,” social media evidence is no panacea for a mark that is not a mark, or a brand that is not a brand. As any professional social media brand manager or would-be or so-called “social media guru” will attest, despite the best social media campaign, a product, service, or other “brand” will not capture the imagination of consumers if consumers are not ultimately interested in what is being sold. In this respect, social media is the same as every other avenue of merchandising or sales; it is sizzle, not steak. A brand proponent’s commitment to being “on social media” (or spending a lot of money on social media) is unlikely, standing alone, to be any more compelling to a finder of fact than proof such as significant advertising expenditures. This commentary only urges that social media evidence should, for purposes of establishing proof of secondary meaning, be no worse.

---