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WALKING, TALKING TRADEMARKS:

HOW INFLUENCER MARKETING IS AFFECTING TRADEMARK ENFORCEMENT ON SOCIAL MEDIA.

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The Journal of Business Law

Wayne State University Law School

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I. INTRODUCTION

Social media usage has grown substantially over the past eighteen years.¹ In 2005, only 5% of Americans used social media.² That figure grew substantially by 2021, as 72% of Americans were using social media platforms.³ Brands regularly utilize social media as a marketing tool to share content in order to promote and advertise events, products, celebrity collaborations, and more.⁴ The rise of the Social Media Influencer has created opportunities for brands to take advantage of Influencers' large number of followers by compensating Influencers to post branded content to reach a specific target audience for their product or service.⁵ For example, 80% of Instagram users in 2018 engaged with at least one brand through the app, and 60% of users were exposed to a new product while using the app."⁶ In 2022, there were 4.62 billion social media users worldwide.⁷ Specifically, Instagram gained one billion followers worldwide in 2020.⁸ An example of this concept coming to life is singer Ariana Grande, who in January 2022 had 289 million followers on Instagram and made \$1,510,000 per branded social media post.⁹

With the number of users growing on social media platforms who are sharing and posting content, it is no surprise that social media is posing unprecedented complications under the

¹ *Social Media Fact Sheet*, PEW Rsch. CTR. (Apr. 7, 2021), <https://www.pewresearch.org/internet/fact-sheet/social-media/?menuItem=45b45364-d5e4-4f53-bf01-b77106560d4c> (chart showcasing "Social Media Use Over Time" presents data from 2005 to 2021).

² *Id.*

³ Brooke Auxier & Monica Anderson, *Social Media Use in 2021*, PEW Rsch. CTR. (Apr. 7, 2021), <https://www.pewresearch.org/internet/2021/04/07/social-media-use-in-2021/>.

⁴ See generally Joel Mathew, *Understanding Influencer Marketing And Why It Is So Effective*, FORBES (July 30, 2018, 8:00 AM), <https://www.forbes.com/sites/theyec/2018/07/30/understanding-influencer-marketing-and-why-it-is-so-effective/?sh=1b0f204771a9>.

⁵ *Id.*

⁶ Tom Ward, *How to Use Instagram Stories: A Guide For Brands*, FORBES (May 18, 2018, 11:52AM), <https://www.forbes.com/sites/tomward/2018/05/18/how-to-use-instagram-stories-a-guide-for-brands/?sh=79f3497d5b94>.

⁷ *Digital 2022 Report Finds Social Media Users Now Equivalent to 58 Percent of the World's Total Population*, BUS. WIRE (Jan. 26, 2022 03:01 AM), <https://www.businesswire.com/news/home/20220126005361/en/Digital-2022-Report-Finds-Social-Media-Users-Now-Equivalent-to-58-Percent-of-the-World%E2%80%99s-Total-Population>.

⁸ Jasmine Enberg, *Global Instagram Users 2020: The Pandemic Propels Worldwide User Base to 1.00 Billion for the First Time*, EMARKETER: INSIDER INTELLIGENCE (Dec. 8, 2020), <https://www.emarketer.com/content/global-instagram-users-2020>.

⁹ Gladys Lai, *The 10 Highest-Paid Celebrities on Instagram in 2022*, GQ (Jan. 10, 2022), <https://www.gq.com.au/success/finance/the-rock-tops-the-list-of-instagams-highest-paid-celebrities-in-2020/image-gallery/0a945a4c8e6d7edd12df2f3fc93ff6e0?pos=9>.

Lanham Act.¹⁰ In *Petunia Products, Inc. v. Rodan + Fields, LLC et al.*, the court decided to hold a Social Media Influencer responsible alongside the partnered beauty company for claims of trademark infringement and false advertisement for her branded content post.¹¹ The court held that through reasonable inference of the content of Sims' blog post and based on the allegations contained in the Complaint that Sims' blog post was a paid advertisement.¹²

Even with the overwhelming number of social media users, Influencer Marketing still overwhelmingly affects women with 84% of all Social Media Influencers being women.¹³ In 2021, 78% of women were social media users in the United States compared to the 66% of men users.¹⁴ Of those 78% of women who use social media, those "aged 16 to 24 are 31% more likely to follow Social Media Influencers."¹⁵

This is a new, developing subject matter that will continue to grow and adapt over time with the use and development of new social media platforms and the continuance of a digitally connected e-commerce world. It is important for social media users and brands to understand how their content may be infringing upon a trademark and how they may be held liable for that infringement. This note will analyze how the Lanham Act is being utilized by brands and Social Media Influencers for claims of trademark infringement and unfair competition over social media content and how Influencers are now being held legally liable under the Lanham Act for promoting and commercializing infringing products and services through their branded content.

¹⁰ See *Petunia Products, Inc. v. Rodan + Fields, LLC*, No. 8:21-cv-00630, 2022 U.S. Dist. LEXIS 135324 (C.D. Cal. S.D. Aug. 06, 2021) (court denied dismissal of the Plaintiff's direct trademark infringement claim against Molly Sims, but as of July 28, 2022, the parties settled the case, and the case has been dismissed with prejudice).

¹¹ *Id.*

¹² *Id.* at *5.

¹³ See Elise Dopson, *30+ Influencer Marketing Statistics You Need To Know (2022)*, SHOPIFY (July 5, 2022), <https://www.shopify.com/blog/influencer-marketing-statistics> (stating "women aged 16-24 are more than 31% more likely to follow social media influencers than men").

¹⁴ *Social Media Fact Sheet*, PEW Rsch. CTR. (Apr. 7, 2021), <https://www.pewresearch.org/internet/fact-sheet/social-media/?menuItem=45b45364-d5e4-4f53-bf01-b77106560d4c> (chart showcasing "Who Uses Social Media" data can be filtered by gender, which presents data from 2005 to 2021).

¹⁵ Dopson, *supra* note 13.

The remainder of this note will be organized into four primary sections. Section II provides background on the basics of trademarks, an overlook of the “Social Media Influencer,” and describes how Influencers earn income from their Influencer marketing contracts. Section III will cover three subtopics exploring leading cases in this field. And lastly, Section IV will conclude and provide commentary on what the future for Social Media Influencer Marketing holds for both parties involved.

II. THE RISE OF SOCIAL MEDIA INFLUENCERS AND THE USAGE OF INFLUENCER MARKETING

A. What Influencers Bring to the Marketing Table for Companies

Some readers may be curious as to why brands utilize Influencers and Influencer Marketing if legal disputes are inevitable. Influencer Marketing can be a lucrative and convenient way for brands to reach their product’s target audiences since it allows a cultivation of a relationship between brands and Influencers that permits the brand to trust Influencers to promote products or services on social media platforms.¹⁶ The diversification of the internet has given consumers the opportunity to curate the content they wish to digest, and this freedom is actively spreading brands’ target audiences across various platforms of media, which leads to the issue of brands not being able to reach their desired audience.¹⁷

To solve this issue, brands have begun to use Influencer Marketing to locate and target specific market audiences to direct their advertising to.¹⁸ This has proven successful, as brands have discovered that Influencers build trust with their followers, ultimately alleviating consumers’ skepticism of the brand.¹⁹ Brands, through Social Media Influencers, are promoting

¹⁶ Mathew, *supra* note 4.

¹⁷ *Id.*

¹⁸ *Id.*

¹⁹ *Id.*

their products and services to a niche community of social media users who are viewing, engaging with, relating to, and trusting the Influencer's content daily.²⁰ Ultimately, consumers' online relationships with the Influencers they follow can convince consumers to purchase products or services promoted by these Influencers based on their online use and enjoyment of the products or services.²¹

There are risks for brands using Influencer Marketing due to the high level of trust required between the brand and the Influencer, wherein the Influencer is essentially handling the brand's reputation in front of thousands of viewers and potential consumers.²² Brands must vet Influencers to confirm that the reputation and image of both parties coincide and that the Influencer gained followers naturally instead of purchasing fake followers.²³ Overall, Influencer Marketing can help companies reach their desired market by allowing them to take advantage of the established, developed connection between the Influencer and their followers.

B. The Specs of Social Media Influencers and Marketing

Merriam-Webster defines an Influencer as: “one who exerts **influence**: a person who inspires or guides the actions of others / *often, specifically* : a person who is able to generate interest in something (such as a consumer product) by posting about it on social media.”²⁴ There are three levels of Influencers: a Micro-Influencer, who has less than 50,000 followers, a Macro-Influencer, who has more than one million followers, and a Mega-Influencer, who is a mainstream celebrity.²⁵ Influencers are compensated based on their own “following, engagement metrics, and niche” and can include fees like usage rights and exclusivity.²⁶ Some Influencers

²⁰ *Id.*

²¹ *Id.*

²² *Id.*

²³ Mathew, *supra* note 4.

²⁴ *Influencer*, MERRIAM-WEBSTER, <https://www.merriam-webster.com/dictionary/influencer> (last visited Dec. 12, 2022).

²⁵ Lauren Meltzer, *How Instagram's Verification Rollout Will Impact Social Media Influencers*, ABC NEWS (Sept. 11, 2018, 5:24AM), <https://abcnews.go.com/Business/instagrams-verification-rollout-impact-social-media-influencers/story?id=57660490>.

²⁶ *Id.*

instead rely on formulas to determine their rate solely based on their follower amounts, such as “charging brands \$100 for every 10,000 followers.”²⁷

Compared to celebrity endorsements, where a celebrity’s name is simply associated with a product or brand, Influencers “possess specific knowledge or experience about what they are advertising” and are, therefore, “trusted figures within a niche community [who] retain a loyal following.”²⁸ Typically, the Influencer has independent creative control of their branded content, that allows them to intertwine how they want to portray the brand’s message with their brand.²⁹ Influencers must utilize loyalty and trust, which celebrity endorsements may lack, to promote authenticity within their follower base, which allows Influencers to promote, or “influence,” content that is outside of their expertise to a specific target market.³⁰

There are two types of Influencer Marketing “content” that Influencers will typically post when promoting brands – sponsored content or affiliate marketing.³¹ Sponsored content can take many forms, but the most common uses are Influencers posting a picture of a brand’s product or service to their main feed or “sharing swipe-up links in a series of Stories” that contain website links that viewers directly to the brand’s product website.³² Affiliate marketing utilizes brand affiliate links or discount codes that allow Influencers to earn a percentage of the sales received through the use of the link or discount code.³³ Influencers use affiliate marketing to sell products and merchandise direct to consumers through Instagram’s shopping features.³⁴

²⁷ *Id.*

²⁸ Mathew, *supra* note 4.

²⁹ *Id.*

³⁰ *Id.*

³¹ Sydney Bradley, *How Much Money Instagram Influencers Make*, BUS. INSIDERS, <https://www.businessinsider.com/how-much-money-instagram-influencers-earn-examples-2021-6> (last updated Dec. 23, 2022, 8:44 AM).

³² *Id.*

³³ *Id.*

³⁴ *Id.*

C. How Statutory Legislation Protects Consumers Through the Lanham Act, False Advertising, and False Endorsement

After years of common law protection and reformations of trademark law, Congress enacted the Lanham Act in 1946.³⁵ Article I, Section 8, Clause 8 of the Constitution grants Congress the power “[t]o promote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries.”³⁶ Under the Commerce Clause, Congress may regulate three categories of activity: (1) “the use of the channels of interstate commerce”; (2) “instrumentalities of interstate commerce, or persons or things in interstate commerce, even though the threat may come only from intrastate activities”; and, (3) “those activities having a substantial relation to interstate commerce, ..., i.e., those activities that substantially affect interstate commerce.”³⁷ Commerce is defined in the Lanham Act as “all commerce which may lawfully be regulated by Congress.”³⁸

A trademark can be a “word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others.”³⁹ The categories of distinctiveness in ascending order of eligibility for trademark status and protection are: “(1) generic, (2) descriptive, (3) suggestive, and (4) arbitrary or fanciful.”⁴⁰ A mark may be entitled to trademark protection if it is merely descriptive or if it has acquired secondary meaning, which is when consumers place the primary significance of the mark not on the product but on the producer.⁴¹ However, a generic mark which “refers... to the

³⁵ See generally Kelly Knoll, *Confusion Likely: Standing Requirements for Legal Representatives Under the Lanham Act*, 115 Colum. L. Rev. 983 (2016).

³⁶ U.S. CONST. art. 1, § 8, cl. 8.

³⁷ *Lancaster v. Bottle Club, LLC*, No. 8:17-CV-634-T-33JSS, 2017 WL 3008434, at *4 (M.D. Fla. July 14, 2017) (citing *United States v. Lopez*, 514 U.S. 549, 558–59 (1995)).

³⁸ *Id.* (citing 15 U.S.C. § 1127).

³⁹ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (AM. LAW INST. 1995).

⁴⁰ *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976).

⁴¹ *Welding Servs. v. Forman*, 509 F.3d 1351, 1358 (11th Cir. 2007).

genus of which the particular product is a species,” may never acquire secondary meaning and may not be entitled to trademark protection.⁴² To be entitled to trademark protection without secondary meaning, a mark needs to be either suggestive or arbitrary/fanciful.⁴³

C.1. Advantages of Trademark Protection

Registering a trademark is not a requirement for trademark ownership or protection entitlement; simply using the trademark in commerce with your goods or services establishes ownership under common law.⁴⁴ Common law rights are limited only to the geographic area of trademark use.⁴⁵ However, federally registering a trademark creates federal ownership rights in the trademark across the United States.⁴⁶ Consequently, a common law trademark user will usually have inferior rights as compared to a registered trademark user.⁴⁷ However, this does not apply if the use of the common law trademark occurred before a registered trademark.⁴⁸

Under Section 43 of the Lanham Act, one who believes that they are or are likely to be damaged by trademark infringement can file a civil action against:

(a) (1) Any person who...uses in commerce any word, term, name, symbol, or device ... which— (A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or (B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person’s goods, services, or commercial activities.⁴⁹

To establish a case of trademark infringement under 15 U.S.C.A. §1114, a plaintiff must show

(1) that it had rights in the mark at issue, and (2) the other parties allegedly infringing mark “was

⁴² *Abercrombie*, 537 F.2d 4 at 10.

⁴³ *Id.*

⁴⁴ *Id.* at 14.

⁴⁵ *Why Register Your Trademark?*, THE U.S. PAT. AND TRADEMARK OFF. (Mar. 31, 2021), <https://www.uspto.gov/trademarks/basics/why-register-your-trademark>.

⁴⁶ *Id.*

⁴⁷ *Id.*

⁴⁸ J. Thomas McCarthy, *Common Law Senior User's Defense Under Lanham Act § 15*, 15 U.S.C.A. § 1065 § 26:53 (5th ed.).

⁴⁹ 15 U.S.C. § 1125 (2012).

the same or confusingly similar to its mark such that consumers [are] likely to confuse the two.”⁵⁰ However, under common law, the trademark owner must additionally establish that their mark was in use.⁵¹

To establish a likelihood of confusion, the court will examine many variables including:

(1) the strength of his mark, (2) the degree of similarity between the two marks, (3) the proximity of the products, (4) the likelihood that the prior owner will bridge the gap, (5) actual confusion, (6) the reciprocal of defendant’s good faith in adopting its own mark, (7) the quality of defendant’s product, and the (8) sophistication of the buyers.⁵²

As to the degree of similarity, courts will also consider the pronunciation of the word marks; the translation of foreign words; overall impressions created by the mark; “verbal translation of any pictures, illustrations, or designs contained in the [mark]”; and “suggestions connotations, or meanings of the [mark].”⁵³

Overall, trademarks are meant to help and protect consumers by allowing them to easily identify the source of the goods or services they are purchasing while also shielding both themselves and brands from counterfeits or fraudulent products.⁵⁴

C.2. False Advertising and Making a Claim

Under Section 43(a) of the Lanham Act, false advertising occurs when a person or brand uses a false description or representation in connection with any goods or services.⁵⁵ Any person who is under the belief that they are damaged or is likely to become damaged by the use of the false description may hold the violating brand or person liable.⁵⁶ For a plaintiff to prevail on a false advertisement claim, they must prove that there would be a likelihood of confusion about

⁵⁰ *Commodores Entm’t Corp. v. McClary*, 879 F.3d 1114, 1130-31 (11th Cir. 2018).

⁵¹ *Donchez v. Coors Brewing Co.*, 392 F.3d 1211, 1219 (10th Cir. 2004).

⁵² *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

⁵³ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 21.

⁵⁴ *What Is A Trademark?*, THE U.S. PAT. AND TRADEMARK OFF. (Mar. 31, 2021), <https://www.uspto.gov/trademarks/basics/what-trademark>.

⁵⁵ 15 U.S.C. § 1125.

⁵⁶ *Id.*

the endorsement.⁵⁷ Consumers do not have to believe that the mark's owner produced the goods or services.⁵⁸ Instead, to satisfy the confusion requirement, consumers need to prove their belief that the mark's owner sponsored or approved of the use of the trademark.⁵⁹

A false advertising claim must initially prove that the mark was actually "used in commerce" and that the "misrepresented service affects interstate commerce."⁶⁰ Commerce includes "intrastate transaction which 'affects' interstate commerce" and "all commercial intercourse between different States and all the component parts of that intercourse."⁶¹

Advertising and solicitations that cross "state lines or between citizens of the United States and citizens... of a foreign nation is therefore commerce within the meaning of the Lanham Act."⁶²

The factors that must be proven include: "(1) the defendant's statements were false or misleading; (2) the statements deceived, or had the capacity to deceive, consumers; (3) the deception had a material effect on the consumers' purchasing decision; (4) the misrepresented service affects interstate commerce; and (5) it has been, or likely will be, injured as a result of the false or misleading statement."⁶³

C.3. False Endorsement and How to Protect Consumers

False advertisement and false endorsement, under Section 43(a) of the Lanham Act, may share the similarity that a person or brand uses a false description or representation in connection with any goods or services.⁶⁴ However, unlike false advertisement, false endorsement involves the commercial value of a person's identity being exploited by the usage of the "person's name,

⁵⁷ *Clorox Co. Puerto Rico v. Proctor & Gamble Com. Co.*, 228 F.3d 24, 36 (1st Cir. 2000).

⁵⁸ *Dall. Cowboys Cheerleaders, Inc. v. Pussycat Cinema, Ltd.*, 604 F.2d 200, 204 (2d Cir. 1979).

⁵⁹ *Id.* 204-05 (2d Cir. 1979).

⁶⁰ *Lancaster*, 2017 WL at *4.

⁶¹ *Id.* at 11.

⁶² *Shatel Corp. v. Mao Ta Lumber & Yacht Corp.*, 697 F.2d 1352, 1356 (11th Cir. 1983).

⁶³ *Lancaster*, 2017 WL at *4.

⁶⁴ 15 U.S.C. § 1125.

likeness, or other indicia of identity for purposes of trade” without their consent.⁶⁵ “Purposes of trade” can consist of use in advertisements and promotions, use on marketed merchandise, or use in connection with services offered, but it does not usually refer to “news reporting, commentary, entertainment, works of fiction or nonfiction, or in advertising that is incidental to such uses.”⁶⁶ One who believes he or she is or may become injured by the use of the false description or designation can hold the violating brand or person liable.⁶⁷

False endorsement claims are typically categorized by courts as claims falling under Section 43(a) because the plaintiff’s endorsement, approval, or sponsorship of the defendant’s products involves a likelihood of confusion to the consumer.⁶⁸ A celebrity’s persona or identity is treated as a trademark and identifiable as intellectual property; therefore, subjecting it to the protections of the Lanham Act.⁶⁹ Infringement of this intellectual property can be caused by the “use of a false or misleading representation that is likely to confuse as to either the plaintiff’s connection with the defendant’s goods or services or as to the sponsorship or approval by the plaintiff of the defendant’s goods, services, or commercial activities” which ultimately will confuse and harm consumers.⁷⁰

Circuit courts differ on the test required to prove a false endorsement claim. The Ninth Circuit utilizes a multi-factor test. These factors are very similar to the likelihood of confusion factors, but are tailored for use in false endorsement claims and include:

- (1) the level of recognition that the plaintiff has among the segment of the society for whom the defendant’s product is intended;
- (2) the relatedness of the fame or success of the plaintiff to the defendant’s product;
- (3) the similarity of the likeness used by the defendant to the actual plaintiff;
- (4) evidence of actual confusion;
- (5) marketing channels

⁶⁵ RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46.

⁶⁶ *Id.* at §47.

⁶⁷ *Id.*

⁶⁸ J. Thomas McCarthy & Roger E. Schechter, *Rights of Publicity and Privacy* § 5:31 (2d ed. 2022).

⁶⁹ *Id.*

⁷⁰ *Id.*

used; (6) likely degree of purchaser care; (7) defendant's intent on selecting the plaintiff; and (8) likelihood of expansion of the product lines.⁷¹

The Second Circuit expects the plaintiffs to show the following elements: “(1) involvement of goods or services, (2) effect on interstate commerce, and (3) a false designation of origin or false description of the goods or services.”⁷² Finally, the Eleventh Circuit views false endorsement the same as trademark infringement and, thus, requires the Plaintiffs to prove the same factors as trademark infringement claims, including a showing of secondary meaning: “(1) that it had trademark rights in the mark or name at issue and (2) that the other party had adopted a mark or name that was the same, or confusingly similar to its mark, such that consumers were likely to confuse the two.”⁷³

III. RECENT CASES SHOWCASING COURTS BEING MORE PROTECTIVE OF BOTH CONSUMERS AND TRADEMARKS

A. Social Media Influencers’ Protecting Their Brand and Images Against Non-Consensual Company Usage

Unfortunately, the twenty plaintiffs in *Lancaster v. Bottle Club, LLC* do not have a unique story. The plaintiffs were professional models or actresses who were working as independent contractors for different entities providing their modeling, hosting, or acting services, who ultimately had their images used without their permission in the promotion of events, services, and products for clubs or bars, including the defendant *Bottle Club, LLC*.⁷⁴ All twenty women relied on their reputation and substantial follower count on social media to financially support themselves by commercializing their image and likeness to brands and media

⁷¹ *Id.*

⁷² *Allen v. Nat'l Video, Inc.*, 610 F. Supp. 612, 625 (S.D.N.Y. 1985).

⁷³ *Lancaster*, 2017 WL at *6. (citing *Suntree Techs., Inc. v. Ecosense Int'l, Inc.*, 693 F.3d 1338, 1346 (11th Cir. 2012)).

⁷⁴ *Id.* at *1.

outlets through modeling, acting, and other opportunities that aligned with their typical services.⁷⁵

Reputation played a crucial part in the women's work.⁷⁶ They must vet "potential professional engagements" because if they "endors[ed], promot[ed], advertis[ed] or market[ed] the 'wrong' product, service or corporate venture" or even affiliated with a "disreputable industry [it could] severely impact [the women's] careers by limiting or foreclosing future modeling or brand opportunities."⁷⁷ Accurately vetting opportunities was necessary because the reputational information surrounding the women was considered during negotiations of compensation for work relating to the time, travel, and usage of her image.⁷⁸

The defendants were officers and managers of the Bottle Club, LLC, which operates commercially as Eyz Wide Shut.⁷⁹ Eyz Wide Shut is a "swingers club that engages in the business of entertaining its patrons with alcohol, music, hotel rooms, and several amenities including a nightclub."⁸⁰ The defendants operated and managed the business operations of Eyz Wide Shut and held the decision-making authority over activities, including promotions, endorsements, and advertisements.⁸¹

The defendants frequently advertised Eyz Wide Shut's events and parties on their business's website and social media by using "explicit and lewd imagery to depict sex acts performed at Eyz Wide Shut."⁸² By utilizing "vehicles of interstate commerce," like social media, the defendants targeted consumers across the United States, thus allowing them to

⁷⁵ *Id.*

⁷⁶ *Id.*

⁷⁷ *Id.*

⁷⁸ *Id.*

⁷⁹ *Id.* at *2.

⁸⁰ *Id.*

⁸¹ *Id.*

⁸² *Id.*

participate in interstate commerce.⁸³ The defendants advertised and promoted events and parties for Eyz Wide Shut on social media by including an image of each of the plaintiffs at least once in branded content postings, and did not hire, contract, seek permission, or offer payment for use of the plaintiffs' images.⁸⁴

The court found that the defendants engaged in interstate commerce through their use of "social media to advertise their events and entice out-of-state individuals to attend those events" or to purchase memberships to their business by relying on the Eleventh Circuit Court's holding that "when local businesses solicit out-of-state tourists, they engage in activity affecting interstate commerce."⁸⁵

The defendants argued that the plaintiffs failed to plead a claim regarding the defendants' individual liability.⁸⁶ The court found the defendants individually liable for the Lanham Act claims due to the defendants' authority over the promotional, advertising, and endorsement activities of Eyz Wide Shut, and being the "moving force in the decision to engage in the infringing acts."⁸⁷ A natural person acting as a business entity's agent who "actively caused the infringement as a moving, conscious force" may be held liable under the Lanham Act for trademark infringement, similar to a corporation.⁸⁸ Furthermore, and without regard to the corporate veil, "a corporate officer who directs, controls, ratifies, participates in, or is the moving force behind the infringing activity, is personally liable for such infringement."⁸⁹

⁸³ *Id.*

⁸⁴ *Id.*

⁸⁵ *Lancaster*, 2017 WL at *5; See *907 Whitehead St., Inc. v. Sec'y of U.S. Dep't of Agric.*, 701 F.3d 1345, 1351 (11th Cir. 2012).

⁸⁶ *Lancaster*, 2017 WL at *3.

⁸⁷ *Id.* at *5.

⁸⁸ *Chanel, Inc. v. Italian Activewear of Fla., Inc.*, 931 F.2d 1472, 1477-1478 (11th Cir. 1991).

⁸⁹ *Babbit Elecs., Inc. v. Dynascan Corp.*, 38 F.3d 1161, 1184 (11th Cir. 1994).

B. *Protecting Consumers from Sponsorship and Endorsement Confusion While Protecting Influencer Reputation*

The twenty women in *Lancaster v. Bottle Club, LLC* also alleged a claim of sponsorship or endorsement confusion under the Lanham Act.⁹⁰ The women must prove the following to show a claim of trademark infringement or false endorsement: “(1) that [they] had trademark rights in the mark or name at issue and (2) that the other party had adopted a mark or name that was the same, or confusingly similar to its mark, such that consumers were likely to confuse the two.”⁹¹

Celebrity personas have been widely recognized to be trademarks. The Ninth Circuit Court held that in “cases involving confusion over endorsement by a celebrity plaintiff, ‘mark’ means the celebrity’s persona.”⁹² The Eleventh Circuit Court has held that courts routinely recognize a property right in celebrity identity akin to that of a trademark owner under Section 43(a).⁹³ Further, a federal district court held that the “Lanham Act itself does not have a requirement that a plaintiff is a celebrity,” but rather, “the Lanham Act ‘is designed to protect reasonable commercial interests in marks, including identities.’”⁹⁴

The defendants challenged the idea of the women’s images being protectable marks by relying on the holding from *ETW Corp. v. Jierh Pub. Inc.*, which stated that because a “person’s image or likeness cannot function as a trademark,” therefore, “the images and likenesses of the models are not protectable as a trademark because they do not perform the trademark function of designation.”⁹⁵ The defendants claimed that “[the women] have not and cannot allege anything about the photographs that distinguish or identify a specific source of goods” and that the women

⁹⁰ See *Lancaster*, 2017 WL 3008434 (M.D. Fla. July 14, 2017).

⁹¹ *Lancaster*, 2017 WL at *6.

⁹² *White v. Samsung Elecs. Am. Inc.*, 971 F.2d 1395, 1400 (9th Cir. 1992).

⁹³ *Parks v. LaFace Recs.*, 329 F.3d 437, 447 (6th Cir. 2003).

⁹⁴ *Arnold v. Treadwell*, 642 F. Supp. 2d 723, 735 (E.D. Mich. 2009).

⁹⁵ *Lancaster*, 2017 WL at *6.

are attempting to be “declared ‘as walking, talking trademarks.’”⁹⁶ However, in *ETW Corp.*, the court acknowledged the recognition of false endorsement claims in case law where a “celebrity’s image or persona is used in association with a product so as to imply that the celebrity endorses the product” under Section 43(a) of the Lanham Act.⁹⁷

The women asserted they are protectable, distinctive marks because their images and their actual identities “acquired secondary meaning” due to “using their images (identities) to build a brand around themselves.”⁹⁸ The women also stated there is a designating function of their images and likeness “because ‘each [woman’s] persona is inseparable from her brand’” and that the defendants’ use of the plaintiffs’ images and likeness creates a false representation that the defendants’ goods or services, i.e. swinger activities, are endorsed or sponsored by the women’s brands.⁹⁹

The infringed marks were the women’s own images or likeness, and the women proved why they warranted the degree of protection they were arguing for by showing “their extensive work history in the modeling industry and their numbers of followers on social media.”¹⁰⁰ Additionally, the women alleged that the defendants’ use of their images led to “actual consumer confusion about [the women’s] association with Eyz Wide Shut.”¹⁰¹ The court found that the women adequately advocated for their position and stated a claim for relief.¹⁰²

C. The Future: Companies Protecting Their Trademarks Through Claims Against Influencers Under the Lanham Act

Petunia Products is an international cosmetics company that owns the BROW BOOST ® trademark, “which it uses in connection with its ‘Billion Dollar Brows’ eyebrow primer and

⁹⁶ *Id.*

⁹⁷ *Id.*

⁹⁸ *Id.* at *7.

⁹⁹ *Id.*

¹⁰⁰ *Id.*

¹⁰¹ *Id.*

¹⁰² *Id.*

conditioner product.”¹⁰³ Petunia Products alleged that Rodan + Fields (hereinafter R+F), a competing cosmetics company that sells a product called “Brow Defining Boost,” infringed its BROW BOOST ® trademark due to the product’s similar functionality, packing, and marketing.¹⁰⁴ Petunia Products also alleged trademark dilution of its social media presence caused by “consultants who [sold] [R+F’s “Brow Defining Boost” product] [and were] promot[ing] the product on social media using the hashtag ‘#BROWBOOST.’”¹⁰⁵ These R+F “consultants” are “Influencer Bloggers” whom R+F used to market the “Brow Defining Boost” product.¹⁰⁶

Molly Sims is a fashion model and an Influencer who promotes various cosmetic products on her website.¹⁰⁷ Sims promoted R+F’s “Brow Defining Boost” product on her website through a blog post she authored.¹⁰⁸ Sims began her blog post by “thanking R+F for sponsoring her post,” then included a link to the product on R+F’s website, and concluded the post with a favorable review and an image of the “Brow Defining Boost” product along with the price.¹⁰⁹

Sims filed a motion to dismiss Petunia Products’ claims against her for direct infringement, contributory infringement, false advertisement, and unlawful and unfair business practices.¹¹⁰ Sims claimed that Petunia Products failed to adequately allege under direct infringement that the blog post would cause confusion as to the source of the product, that third parties who authored sponsored blog posts “without confirming that the product does not violate

¹⁰³ *Petunia Products, Inc v. Rodan + Fields, LLC.*, No. 8:21-cv-00630-CJC-ADS, 2021 U.S. Dist. LEXIS 333879 (C.D. Cal. Aug. 06, 2021).

¹⁰⁴ *Id.*

¹⁰⁵ *Id.*

¹⁰⁶ *Id.*

¹⁰⁷ *Id.* at *2-3.

¹⁰⁸ *Id.* at *3

¹⁰⁹ *Id.*

¹¹⁰ *Id.* at *4.

trademark rights” should not be held liable for trademark infringement, and that Petunia Products failed to adequately prove Sims “used the Trademark in commerce.”¹¹¹

Sims insisted that Petunia Products failed to adequately assert facts as to its contributory infringement claim that Sims “induced any infringement or had any knowledge of [Petunia Products], its trademark, or its claim that R+F’s product infringed on Petunia Products’ trademark.”¹¹² The court upheld the direct infringement claim but dismissed the claims of contributory infringement, false advertisement, and unlawful and unfair business practices for the fact that Petunia Products did not state adequate facts and allegations for those claims to be upheld.¹¹³ It should be noted that the court did not find that an Influencer could not be held liable under the dismissed claims or that these claims do not apply to a third-party “consultant” or “Influencer Blogger.”¹¹⁴

C.1. Direct Infringement

The court quoted *ACI Int'l. Inc. v. Adidas-Salomon*: “[t]o prevail on a trademark infringement claim, a plaintiff must show that the defendant used the plaintiff’s trademark in commerce and that the use was likely to confuse customers as to the source of the product.”¹¹⁵ The court disagreed with Sims’ motion to dismiss the direct infringement claim because Sims’ wrote and published the blog post reviewing the “Brow Defining Boost” product to her website, which was ultimately, a use in connection with the advertising and promoting of R+F’s brow product.¹¹⁶ The court found that there is a reasonable inference that the blog post was a paid advertisement, and supported this conclusion by considering several factors, including the fact

¹¹¹ *Id.* at *4-5.

¹¹² *Id.* at *9.

¹¹³ *Id.* at *13.

¹¹⁴ *See Id.*

¹¹⁵ *Id.* at *4.

¹¹⁶ *Id.* at *5.

Sims “thank[ed] R+F for sponsoring the post,” provided a link to the product on R+F’s website, and included an image and pricing of the product.¹¹⁷

Sims did express concerns about how holding Social Media Influencers directly liable may hinder commentary made by Influencers.¹¹⁸ The court did not share these concerns since it found the “[b]log [p]ost reflect[ed] more than mere commentary” but was still protected by the First Amendment as commercial speech.¹¹⁹ The court cited to the Ninth Circuit’s holding in *Bosley Med. Inst., Inc. v. Kremer* to explain its finding of “more than mere commentary”, where “the defendant’s use of the plaintiff’s mark on his website, which was critical of the plaintiff’s business, was noncommercial in part because the defendant’s website did not directly link to any commercial sites.”¹²⁰ Unlike the defendant in *Kremer*, Sims did link to R+F’s product in the blog post which crossed the line from “protected consumer commentary to commercial use” and, thus, made the blog post a paid advertisement.¹²¹

Next, Sims claimed that Petunia Products inadequately alleged that her blog post caused consumer confusion.¹²² The court used the eight-factor test to determine the likelihood of confusion caused by her blog post and ultimately disagreed with Sims’ claim and determined there is a similarity of the marks “BROW BOOST ®” and “Brow Defining Boost,” which can be determined by factors such as “appearance, sound, [and] meaning of the marks when considered in their entirety.”¹²³ Using these factors, the court found that the marks are quite similar due to the uses of the terms “Brow” and “Boost.”¹²⁴ Even though R+F’s product name does separate “Brow” and “Boost” with the usage of “Defining,” the court refused to find this separation to be

¹¹⁷ *Id.*

¹¹⁸ *Id.*

¹¹⁹ *Id.*

¹²⁰ *Id.* at *5-6 (citing to *Bosley Med. Inst., Inc. v. Kremer*, 403 F.3d 672, 676, 678 (9th Cir. 2005)).

¹²¹ *Id.*

¹²² *Id.* at *6.

¹²³ *Id.* at *6-7 (quoting *Conversive, Inc. v. Conversagent, Inc.*, 433 F. Supp. 2d 1079, 1091 (C.D. Cal. 2006)).

¹²⁴ *Id.*

sufficiently different enough to avoid being considered confusingly similar to consumers.¹²⁵

Additionally, Petunia Products highlighted the fact that they are in direct competition with R+F, both companies use similar marketing channels, and both companies' brow products are used for similar purposes.¹²⁶

Sims also argued that because she identified R+F in the blog post as the source of the "Brow Defining Boost" product, and since she made no references to Petunia Products or its "BROW BOOST ®" product, there cannot be consumer confusion.¹²⁷ The court found that due to the similarity of the product name "readers of Sim's blog post could believe that the ['Brow Defining Boost'] is affiliated with [Petunia Products]."¹²⁸ Further, the court denied Sims' argument because "identifying R+F as the source does not necessarily mean a consumer will not infer an affiliation between R+F and Petunia Products."¹²⁹

Further, Sims' allegations completely ignored reverse confusion, which "occurs when consumers dealing with the senior mark holder believe that they are doing business with the junior one."¹³⁰ The blog post identifying R+F could lead consumers to believe that R+F is the senior mark and that Petunia Products is their source.¹³¹ This could further lead consumers to mistakenly believe that in purchasing Petunia Products, they are purchasing a product or brand of R+F.¹³²

C.2. Contributory Infringement

The court stated that for Sims to be held liable for contributory infringement she must have "(1) 'intentionally induced' the primary infringer to infringe, or (2) continued to supply an

¹²⁵ *Id.* at *7.

¹²⁶ *Id.*

¹²⁷ *Id.*

¹²⁸ *Id.*

¹²⁹ *Id.*

¹³⁰ *Id.* at *8 (quoting *Ironhawk Techs., Inc. v. Dropbox, Inc.*, 2 F.4th 1150, 1160 (9th Cir. 2021)).

¹³¹ *Id.* at *8.

¹³² *Id.*

infringing product to an infringer with knowledge that the infringer is mislabeling the particular product supplied.”¹³³ Petunia Products cited the defendants’ actions to support their contributory infringement claim, specifically that “[R+F] provided or cause[d] to be provided to co-Defendant Sims the infringing product with knowledge, expectation, and/or intention Defendant Sims would use the infringing product in connection with the marketing, offering for sale, and sale of the infringing product.”¹³⁴

Petunia Products further alleged that “[R+F] ha[d] intentionally induced or contributed to or knowingly participated in the infringement of [Petunia Products’] BROW BOOST TRADEMARK by [R+F’s] Consultants and [I]nfluencers such as Defendant SIMS.”¹³⁵ The court granted Sims’ motion to dismiss Petunia Products’ contributory infringement claim due to Petunia Products’ lack of adequate facts to support either prong of the contributory infringement test.¹³⁶ Ultimately, Petunia Products made no allegations that Sims intended to induce infringement or had knowledge of the alleged infringement.¹³⁷

IV. FUTURE OF TRADEMARK ENFORCEMENT FOR COMPANIES, INFLUENCERS, AND CONSUMERS

A. Enforcing the Lanham Act

Courts believe infringing use of trademarks on social media platforms in connection and promotion with marketing or sales “gives rise to a viable Lanham Act claim.”¹³⁸ All major domestic social media platforms such as Twitter, Facebook, Instagram, and YouTube have

¹³³ *Id.* at *9 (quoting *Perfect 10, Inc. v. Visa Int’l Serv. Ass’n*, 494 F.3d 788, 795 (9th Cir. 2007)).

¹³⁴ *Id.* at *10 (quoting Complaint at para. 88, *Petunia Products, Inc. v. Rodan + Fields, LLC et al.*, No. 8:21-cv-00630-CJC-ADS at para. 2, 2022 U.S. Dist. LEXIS 135324 (C.D. Cal. S.D. Aug. 06, 2021)).

¹³⁵ *Id.* at *10.

¹³⁶ *Id.* at *11.

¹³⁷ *Id.*

¹³⁸ *Thousand Island Park Corp. v. Welser*, 314 F. Supp. 3d 391, 398 (N.D.N.Y. 2018).

implemented trademark policies with ways to file complaints; illustrating that they are aware that trademark infringement occurs on their platforms.¹³⁹

For example, Instagram's trademark infringement policy explicitly states:

Under Instagram's Terms of Use and Community Guidelines you can only post content to Instagram if it doesn't violate the intellectual property rights of another party, including trademarks. Please note that as an Instagram user, you are responsible for the content you post. If your content violates Instagram's policies or is reported to Instagram as infringing the intellectual property rights of another party, Instagram may remove that content.¹⁴⁰

Another example of a social media platform's trademark infringement policy is YouTube's, which states:

Trademark infringement is improper or unauthorized use of a trademark in a way that is likely to cause confusion as to the source of that product. YouTube policies prohibit videos and channels that infringe trademarks. If your content uses someone else's trademarks in a way that might cause confusion, your videos can be blocked. Your channel may also be suspended.¹⁴¹

However, these infringement policies rarely are successful in real infringement scenarios.

Unfortunately, the only way for the trademark owner to enforce their rights is to be vigilant in scouring social media postings to find these infringing posts in order to report them.¹⁴² Once the trademark owner identifies infringing content, then the trademark owner will have to complete the platform's trademark infringement complaint form.¹⁴³ The social media platform will then takedown, or remove, the infringing post.¹⁴⁴ If all goes well, the infringer will never infringe on the trademark owner's mark again, and the trademark owner would have won this one single battle over their trademark rights. In reality, this is not what happens. Typically, once the trademark owner reports the infringing use, the social media platform does remove the post.¹⁴⁵

¹³⁹ See *infra* notes 141-42, 153-54.

¹⁴⁰ *How Can I Make Sure the Content I Post to Instagram Doesn't Violate Trademark Law* Comment to *Trademark: Trademark and Posting Content*, INSTAGRAM, <https://help.instagram.com/222826637847963> (last visited Dec. 12, 2022).

¹⁴¹ *Trademark, Subheading to YouTube Help*, YOUTUBE, <https://support.google.com/youtube/answer/6154218?hl=en> (last visited Dec. 12, 2022).

¹⁴² Michael Dvoren, *When Social Media Takedown Notices Aren't Enough*, JABURG WILK, <http://www.jaburgwilk.com/news-publications/when-social-media-takedown-notices-arent-enough> (last visited Dec. 12, 2022).

¹⁴³ *Id.*

¹⁴⁴ *Id.*

¹⁴⁵ *Id.*

Despite the trademark owner's efforts, repeat infringers continue to infringe.¹⁴⁶ Repeat infringers are users who have been reported for infringement but will continue to post infringing content.¹⁴⁷ This can take the form of infringers simply reposting the reported content after it is removed and the infringement claim has been resolved by the platform or posting of other new infringing content.¹⁴⁸

An obstacle trademark owners may not have realized they will face is the actual social media platform's infringement policies and procedures for reporting trademark infringement. First, some policies may require that the trademark be a registered trademark.¹⁴⁹ Consequently, the platform is not providing enforcement for common law use.¹⁵⁰ For example, Twitter requires a registered trademark to file a trademark infringement complaint stating: "[a] federal or international trademark registration number is required. Pending trademark applications are not sufficient."¹⁵¹

Second, since platforms do not have the tools to mediate or adjudicate trademark infringement disputes between users, platforms will only remove content even though it is clearly infringing.¹⁵² These policies leaves trademark infringement not being addressed by social media platforms and almost creates a loophole for infringers to continue gaining from the goodwill and reputation of the infringed brands.¹⁵³ For example, the YouTube trademark infringement complaint states: "YouTube is not in a position to mediate trademark disputes between creators and trademark owners. YouTube is willing to perform a limited investigation of

¹⁴⁶ *Id.*

¹⁴⁷ *Id.*

¹⁴⁸ *Id.*

¹⁴⁹ *Id.*

¹⁵⁰ *See Id.*

¹⁵¹ *Help With Intellectual Property Issues*, Subheading to *Help Center*, TWITTER, <https://help.twitter.com/en/forms/ipi/trademark/trademark-owner> (last visited Dec. 14, 2022).

¹⁵² *File A Trademark Complaint*, Subheading to *YouTube Help*, YOUTUBE, <https://support.google.com/youtube/answer/6154228?hl=en#:~:text=The%20easiest%20way%20to%20file,in%20clear%20cases%20of%20infringement> (last visited Dec. 12, 2022).

¹⁵³ Dvoren, *supra* note 143.

reasonable complaints and will remove content in clear cases of infringement.”¹⁵⁴ This leaves much to be desired when trademark owners attempt to enforce their rights by following the guidelines set by the social media platforms they are encouraged to be members of to stay relevant with their target consumer market.

B. Solutions to Enforcement

If platforms want to be able to help users enforce their trademark rights, they need to expand enforcement to all recognized rights, including common law users. Even though unregistered trademark owners have common law rights only in the geographic area in which they operate and do not have the breadth of protection as registered marks, they can still be protected against infringement.¹⁵⁵ Common law trademark users can have superior rights to other subsequent common law users as well as subsequent registered trademark owners in a dispute.¹⁵⁶

A possible solution to assist trademark owners would be for platforms to implement stricter enforcement policies to completely removing repeat infringers from their platforms by replacing current platform policies that allow for repeat infringers to continue violating trademark ownership rights.¹⁵⁷

Another solution could be a trademark infringement equivalent to the Copyright Digital Millennium Copyright Act (DMCA), requiring a duty of social media platforms and online service providers to detect and deal with infringing content. The DMCA helps copyright holders to protect their copyrights online by:

- (1) establishing protections for online service providers in certain situations if their users engage in copyright infringement, including by creating the notice-and-takedown system, which allows copyright owners to inform online service providers about infringing material so it can be taken down;
- (2) encouraging copyright owners to give greater access to their works in digital formats by providing them with legal protections against

¹⁵⁴ *Id.*

¹⁵⁵ THE U.S. PAT. & TRADEMARK OFF., *supra* note 45

¹⁵⁶ *Id.*

¹⁵⁷ Dvoren, *supra* note 143.

unauthorized access to their works...; and (3) making it unlawful to provide false copyright management information...or to remove or alter that type of information in certain circumstances.¹⁵⁸

Section 512 of the Copyright Act specifically deals with safe harbors and the notice-and-take-down system for online service providers when copyright infringement occurs on their platforms.¹⁵⁹ This section assists with the removal of infringing online content without copyright owners needing to engage in litigation and shields online service providers from liability for copyright infringement on their platforms when they cooperate to “expeditiously remove infringing content.”¹⁶⁰

Section 512 also requires “online service providers to designate an agent to receive copyright owners’ notices.”¹⁶¹ The process of copyright owners using Section 512 comprises of copyright owners sending a takedown notice to the online service provider requesting the removal of infringing content from their site along with required information that needs to be provided in the request.¹⁶² Then, the online service provider may accept the notice and remove the infringing content, or the online service provider may refuse, and instead accept any potential secondary liability.¹⁶³

The DMCA is not a perfect solution. The online service provider can refuse to takedown the infringing content, which does open it up to secondary liability for encouraging the use of infringing content, but does not assist with the removal of infringing content.¹⁶⁴ Additionally if the accused infringer believes it is not infringing, they can file a counter-notice fighting the

¹⁵⁸ *The Digital Millennium Copyright Act*, U.S. COPYRIGHT OFF., <https://www.copyright.gov/dmca/> (last visited Dec. 15, 2022).

¹⁵⁹ *Id.*

¹⁶⁰ *Id.*

¹⁶¹ *Id.*

¹⁶² *Id.*

¹⁶³ *Copyright Alliance FAQs: What Is The DMCA Notice and Takedown Process?*, COPYRIGHT ALL., <https://copyrightalliance.org/faqs/what-is-dmca-takedown-notice-process/> (last visited Dec. 15, 2022).

¹⁶⁴ *Id.*

takedown notice and explain why they believe they are not infringing.¹⁶⁵ This counter-notice puts a ten to fourteen-day hold on the allegations, where the online service provider must replace the infringing content on their site, and the copyright owner will have time to file a suit against the alleged infringer.¹⁶⁶ If no suit is filed against the alleged infringer by the copyright holder, then the online service provider will allow the content to remain on their site.¹⁶⁷ If a suit is filed, then the online service provider must remove the content.¹⁶⁸

Social media platforms are already utilizing tools similar to the DMCA by having complaint forms available on their websites for trademark owners to use to file a complaint of infringing use.¹⁶⁹ Having a trademark law counterpart requiring something similar to DMCA might offer a legal avenue for trademark owners to hold social media platforms liable when they do not remove infringing content.

A final solution for trademark owners would be to become federally registered as a trademark with the United States Patent and Trademark Office. As was discussed above, federally recognized registered trademark owners have more legally recognized rights across the United States users can rely on to protect their mark across state lines and typically have preference over common law or nonregistered mark usage.¹⁷⁰ Newly registered trademarks are published weekly in the USPTO Official Gazette and filed in the USPTO trademark database, where they are searchable using the Trademark Electronics System Search.¹⁷¹ Additionally, as

¹⁶⁵ *DMCA Counter-Notice Process*, COPYRIGHT ALL., <https://copyrightalliance.org/education/copyright-law-explained/the-digital-millennium-copyright-act-dmca/dmca-counter-notice-process/> (last visited Dec. 15, 2022).

¹⁶⁶ *Id.*

¹⁶⁷ *Id.*

¹⁶⁸ *Id.*

¹⁶⁹ Dvoren, *supra* note 143.

¹⁷⁰ THE U.S. PAT. & TRADEMARK OFF., *supra* note 45.

¹⁷¹ *Trademark Official Gazette*, THE U.S. PAT. & TRADEMARK OFF., <https://www.uspto.gov/learning-and-resources/official-gazette/trademark-official-gazette-tmog> (last visited Dec. 15, 2022).

long as mark owners continue to use their trademark in commerce, their “registration can last forever.”¹⁷²

C. *Brand Enforcement*

There are some alternative ways in which brand owners can manage infringement on their own. Brands should register their company on all social media platforms so other users cannot claim their brand name first as their handle on social media platforms.¹⁷³ Unless the handle is already in use, nothing can stop another user from using a name of a brand while registering their account handle.¹⁷⁴ It can lead to a brand being unable to register and use their name as their account handle and could lead to consumer confusion when attempting to identify a brand’s real profile.¹⁷⁵ Brands should aim to have consistency across all social media platforms to create an identity for their brand that will translate to consumers and hopefully allow easy identification of fake and infringing accounts for consumers.¹⁷⁶

A risk that brands could potentially face if they aggressively protect their brands online is potential backlash from consumers.¹⁷⁷ Negative publicity can take a toll on a brand, so reacting appropriately to infringement is vital.¹⁷⁸ An example of a positive public reaction to a cease-and-desist letter is from the company Jack Daniels, which sent a polite cease-and-desist letter to an author who had used a very similar-looking bottle to the iconic whiskey brand on the cover of their book.¹⁷⁹ The author posted the cease-and-desist letter on social media, which gave Jack Daniels free, positive publicity.¹⁸⁰

¹⁷² THE U.S. PAT. & TRADEMARK OFF., *supra* note 45.

¹⁷³ *Fact Sheet: Protecting a Trademark, Enforcement in Social Media*, INT’L TRADEMARK ASS’N (updated Jan 10, 2022), <https://www.inta.org/fact-sheets/enforcement-in-social-media/>.

¹⁷⁴ *Id.*

¹⁷⁵ *Id.*

¹⁷⁶ *Id.*

¹⁷⁷ *Id.*

¹⁷⁸ *Id.*

¹⁷⁹ Deanne Katz, *Jack Daniel’s Cease, Desist Letter Earns Good Publicity*, FINDLAW (July 26, 2012, 6:49 AM),

<https://www.findlaw.com/legalblogs/small-business/jack-daniels-stops-trademark-infringement-earns-good-publicity/>.

¹⁸⁰ *Id.*

D. Influencer Enforcement

Enforcement can be easier for companies than for Influencers because companies can use their financial and employee resources to locate infringing posts, which a single Influencer who may have a small team supporting them cannot do.¹⁸¹ Influencers should also consider applying for federal trademark registration of their mark. Registration could help not only to legitimize their infringement claims but also allow for the advantages of having a federal trademark.¹⁸² Their trademark published in the Official Gazette could also help inform the public and other businesses of their trademark ownership.¹⁸³

There is not enough case law to provide reasonable inferences on how future courts will proceed with claims against Social Media Influencers. It would be wise to assume that courts will continue to hold Influencers responsible for promoting infringing products in connection with sponsorship or promotional agreements, like the court did in *Petunia Products*.¹⁸⁴ A significant issue will be determining what trademark infringement claims courts will hold Social Media Influencers liable for in the future.

The court in *Petunia Products* dismissed the contributory infringement claims against Sims but upheld the direct infringement claims.¹⁸⁵ Do we want our legal system to find people who are essentially everyday social media users with a large following liable for trademark infringement? Conversely, do we want to protect consumers who have come to trust the reviews of these social media users? These questions and the true intentions of the Lanham Act will have to be considered by courts in the future when deciding what claims to uphold against Influencers.

¹⁸¹ INT'L TRADEMARK ASS'N, *supra* note 173.

¹⁸² See THE U.S. PAT. & TRADEMARK OFF., *supra* note 45.

¹⁸³ THE U.S. PAT. & TRADEMARK OFF., *supra* note 45.

¹⁸⁴ See generally *Petunia Prods, Inc.*, Case 8:21-cv-00630-CJC-ADS, 2022 U.S. Dist. LEXIS 135324 (C.D. Cal. S.D. Aug. 06, 2021).

¹⁸⁵ *Petunia Products, Inc.*, 2022 U.S. Dist. LEXIS at *13.

Could Influencers somehow create a loophole using the First Amendment as a defense? The court found that Sims' blog post was protected under the First Amendment as commercial speech, which did not ultimately help her argument against the court's decision.¹⁸⁶ This is due to the First Amendment offering a sort of second-rate protection to commercial speech as compared to speech of individuals in a noncommercial setting.¹⁸⁷ The court listed several aspects of Sims' blog post that proved it was a promotional post, such as the use of a link or stating it was a sponsored post by R+F.¹⁸⁸ If it was not clear on its face that this was a promotional post, is there a way for Influencers to argue their speech as an individual making commentary under the First Amendment as a defense like the court found in *Kremer*? Will this lead to Influencers concealing they are receiving compensation for their posts to the public? Will this ultimately have a ripple effect for consumers who follow these Influencers, whom the Lanham Act is supposed to protect?

V. CONCLUSION

Influencer Marketing is a lucrative marketing technique that companies can and should use to reach their target market.¹⁸⁹ Through affiliate and promotional marketing, Influencers can use their follower count on social media to reach thousands of potential consumers. When brands knowingly use an Influencer's images without their consent to promote events and products, they not only lead consumers to think these goods are endorsed by the Influencer, but they hurt the Influencer's reputation.

The lack of efficient and convenient enforcement policies brands and Influencers can use to protect their trademarks is concerning as the number of those engaged in Influencer Marketing

¹⁸⁶ *Id.* at *6.

¹⁸⁷ *R.A.V. v. City of St. Paul, Minn.*, 505 U.S. 377, 422 (1992) (Stevens, J., concurring).

¹⁸⁸ *Petunia Products, Inc.*, 2022 U.S. Dist. LEXIS at *5.

¹⁸⁹ Dopson, *supra* note 13 (includes data showing businesses are making \$5.20 for every \$1 spent on influencer marketing).

on social media is growing.¹⁹⁰ Concern should also be growing over the new and uncertain liability Influencers can face regarding trademark infringement in the future. Influencers will need to start participating in due diligence concerning brands and products they are promoting to protect themselves from not only a bad reputation but from trademark infringement.

¹⁹⁰ Dopson, *supra* note 13 (includes data showing 42% increase in the Influencer marketing industry from 2020 to 2021).