

# Trade Marks, Twitter and Twittersquatters!

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Social media sites are the current craze in the online environment. Users can enjoy a range of online experiences including social networking sites (such as Facebook, Twitter and MySpace), file sharing sites (such as YouTube and Flickr) and blogs.

Increasingly, organisations are embracing Twitter as a means of connecting with customers, attracting new clients and driving and purchasing sales.

With the increased use of Twitter by organisations, "Twittersquatters" are becoming a new problem for trade mark owners. A Twittersquatter is a term used to describe a Twitter user who has registered a third party's brand name as its Twitter user name with a view to selling the account to the trade mark owner. Twittersquatters have effectively taken over where domain squatters left off.

This update provides trade mark owners with some tips as to how to protect the integrity of their trade marks that are threatened by third parties on Twitter.

## Features of Twitter

- Twitter is the world's third largest social networking service.
- It is a 'real time' information network that connects a user to the latest information that he or she chooses to follow.
- Every Twitter user has a unique user name.
- To create an account, users are only required to submit their name, date of birth, gender and email address.

## Twitter Problems for Trade Mark Owners

- Twittersquatters can register unique Twitter user names that include a person's or organisations' registered trade marks.
- Twittersquatters can force trade mark owners to buy the unique Twitter user name that encapsulates the brand.
- Twittersquatters can cause commercial detriment to an organisation by mocking the brand or making false and defamatory statements through a tweet.
- It is difficult for trade mark owners to identify and locate the Twittersquatter account holder to enforce their rights.

## Legal Position on Twittersquatting in Australia

Australian courts have not yet considered the rights of brand owners against Twittersquatters.

However, it is likely that an Australian court would find that the mere registration of a name incorporating a brand will not be sufficient grounds to establish a trade mark infringement or passing off action.

In Australia, to establish a trade mark infringement action, a brand owner must be able to establish that there was a 'use' of the registered trade mark on goods and services of the same class. Similarly, an action for passing off requires that consumers be misled or deceived by a suggested connection between rival products 'in the course of trade'.

In the UK domain name case of *British Telecommunications v One in a Million* (1998) 42 IPR 289, the UK Court of Appeal held that cybersquatting may constitute both trade mark infringement and passing off where there is a sale of squatted usernames.

The court found that the plaintiff's registered and common law rights would be infringed and there would be likely damage to support an action in passing off. It was also confirmed that use 'in the course of trade' means use by way of business and not necessarily as a trade mark.

The *One in a Million* case has been referred to with approval in several Australian cases such as *Architects (Australia) Pty Ltd t/a Architects Australia v Witty Consultants Pty Ltd* (2002) QSC 139 and is likely to be a persuasive authority.

Brand owners may also, in cases where the Twittersquatter is attempting to sell the Twitter user name, rely on the *Australian Competition and Consumer Act 2010*.

### **What Trade Mark Owners Can Do**

- Ensure that your brands are registered as trade marks in the countries in which you use the brand.
- Register your brand as a unique Twitter user name as quickly as possible. Defensive registration of Twitter user names is a must, even if you do not have an interest in actively maintaining a Twitter account.
- Develop and or reassess your brand strategies and ensure that you have adequate protections in place.
- If Twittersquatting occurs, immediately lodge a complaint directly with Twitter Inc.
- Twitter offers several tools that brand owners can use to address infringement without the need to commence proceedings in court. In particular, brand owners who register Twitter user names should review:
  - Twitter's Terms of Use;
  - Twitter's Name Squatting Policy that provides that attempts to sell or extort other forms of payment in exchange for usernames will result in account suspension;
  - Twitter's Trade Mark Policy that provides that 'using a company or business name, logo or other trade mark protected materials in a manner that may mislead or confuse others' may result in account suspension.
- Litigation against Twitter itself is unlikely to succeed as the website itself does not involve itself in the creation of infringing content.

### ***For further information please contact***

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