



Denied Mark for 'Tweet,' Twitter Pecks Out Complaint

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The early bird gets the trademark, a lesson Twitter Inc. is learning the hard way.

"Tweet" may be ubiquitous slang for the microblogging site's 140-character posts. But Twitter has struggled unsuccessfully to trademark the word. The U.S. Patent and Trademark Office has suspended the site's trademark applications for tweet because other companies applied to trademark various versions of the mark before Twitter did.

Now Twitter has gone to federal court. The company filed a suit this month in the Northern District asking a judge to cancel a registered trademark for the phrase "Let Your Ad Meet Tweets." Twittad, an online advertising company, registered the phrase.

"Twitter's organic growth has taken many forms, including a widespread, dictionary-documented association of the word 'Tweet' with the use of Twitter," the company said in a statement. "It is in the best interests of our users and developers for the meaning of 'tweet' to be preserved to prevent any confusion, so we are taking action to protect its meaning."

It's an all-too-typical situation for many startups, said Marlene Williams, an IP partner at Nixon Peabody in San Francisco who specializes in trademark portfolio management. They don't realize just how valuable a certain mark may become, and they wait too long to apply for a trademark.

"If they become wildly successful, this can follow," Williams said. "Now, instead of spending a few thousand dollars for a trademark application, Twitter will spend tens of thousands of dollars if not more, just to get their mark registered."

Twitter filed its first application to trademark tweet in April 2009, according to USPTO records. Twitter's request was suspended, or put on hold, in January 2010 because applications for "tweetmarks," "cotweet" and "tweetphoto" had already been submitted.

Twitter tried again in August 2010, and the PTO declined to grant the mark, citing the conflict with Twittad's "Let Your Ad Meet Tweets," which was registered on Oct. 20, 2009. Twitter amended its application, and it was put on hold. Officials from Twitter, and its lawyers at Fenwick & West, declined to elaborate on why the company waited to file a trademark application for tweet.

IP lawyers speculate there could be many reasons, from financial constraints to wanting business partners to use the word tweet and help generate buzz. Twitter may have thought it could rely on common law rights, which are based on use and priority of use, and could choose to wait until it became successful before prosecuting the marks.

But proving common law rights can be difficult, even when a company's mark is successful, lawyers said. And now overuse of tweet is becoming a problem for Twitter. So it's taking steps to rein it in.

"Twitter doesn't want tweet to become generic for that type of communication," said Susan Hollander, an IP partner at K&L Gates in Palo Alto. "Theoretically, anyone could use that mark. And if that happens, it will no longer be associated with Twitter."

Companies have a few options in these situations. They can oppose rival trademark applications. Twitter did not oppose the trademark application for "Let Your Ad Meet Tweets." But it has opposed applications for "25 Tweets," "Tweetmarks," "Tweetiator," "Luvtweet" and others.

Companies can buy the companies that own rival trademarks. Tweetdeck, an application for organizing the display of tweets, applied to trademark its name in April 2009. Twitter bought the company in May for more than \$40 million.

Or companies can take their grievances to court, as Twitter has done with Twittad. It's an unusual step but it sends a clear message, said Neil Smith, an IP partner at Ropers Majeski Kohn & Bentley in San Jose.

"They want to set the tone of being aggressive," Smith said. "It sends a signal to the world, we may have a little dispute with the trademark office, but we will file suit against you in San Francisco, which may make your life miserable."