

Authored by Jill J. Chalmers and Glenn S. Bacal

June 11, 2009

IMMEDIATE ACTION REQUIRED TO TRY TO PREVENT FACEBOOK USERNAME SQUATTING – NEEDS TO BE DONE BY FRIDAY, JUNE 12, 2009

As you likely know, Facebook is a popular social network.

Facebook has just announced that beginning Saturday, June 13, 2009 at 12:01 a.m. EDT, Facebook users will be allowed for the first time to create personalized URLs for their Facebook pages (facebook.com/yourname). However, Facebook is also providing trademark owners the chance to prevent others from registering usernames that contain trademarks owned by third parties. This means that trademark owners will have a very short period of time (until this Friday, June 12) to provide notice to Facebook of trademark registrations which may preempt others from registering them as Facebook usernames (process begins on Saturday, June 13).

If you haven't done so already, you should strongly consider immediately registering your key trademarks with Facebook in an attempt to prevent others from using them as Facebook usernames. If you do not take this action, preventing others from registering usernames containing your trademarks at a later date might be more difficult and could have a greater expense.

Here is the protocol and the reasons why you should do this:

- Each trademark owner needs to complete a trademark registration owner form for each mark it owns in order to preempt others from registering its name on Facebook.
- If the trademark owner does not assert its ownership pre-infringement (except for copyright infringement), then the owner will need to submit an infringement of Intellectual Property (IP) infringement form, which appears to require a higher form of proof – i.e., a submission of a statement stating exactly how the "infringer" infringes the IP of the owner, which may be more difficult in the trademark sense, since the existing case law arguably requires the use of the mark in connection with goods or services, not just use of the mark as a username.

Our recommendation would be to complete a trademark registration form for every key trademark or service mark that you own.

It is a relatively quick process, and we suggest that you do this prior to the end of the day on Friday, June 12, 2009.

Here is a link to the Facebook page at which you can register your trademarks and/or service marks: http://www.facebook.com/help/contact.php?show_form=username_rights

You will need to submit a different form for each mark, referencing one registration that you own for the mark.

This article is a periodic publication of Holme Roberts & Owen LLP and should not be construed as legal advice or legal opinion on any specific facts or circumstances, nor is it intended to address specific disclosure or compliance issues that may arise in particular circumstances or provide an exhaustive discussion of the topics discussed herein. The contents are intended for general informational and educational purposes only, and you are urged to consult counsel concerning your particular situation and any specific legal questions you may have. For further information regarding the topics described herein, please contact any of the attorneys listed.

HRO CONTACTS Intellectual Property, Technology and Media

COLORADO SPRINGS
Susan D. Campbell
susan.campbell@hro.com
Jill J. Chalmers
jill.chalmers@hro.com
Steven B. Smith
steve.smith@hro.com

DENVER
Scott Bialecki
scott.bialecki@hro.com
Paul Sung Cha
paul.cha@hro.com
Lynn P. Hendrix
lynn.hendrix@hro.com
Donald L. Samuels
donald.samuels@hro.com
Samantha Sturgis
samantha.sturgis@hro.com

PHOENIX
David M. Andersen
david.andersen@hro.com
Glenn S. Bacal
glenn.bacal@hro.com
Steven C. Lawrence
steve.lawrence@hro.com
Christine Meis McAuliffe
christine.mcauliffe@hro.com

SALT LAKE CITY
Craig A. Buschmann
craig.buschmann@hro.com
Lin C. Hsu
lin.hsu@hro.com
Thomas J. Rossa
thom.rossa@hro.com
David O. Seeley
david.seeley@hro.com

SAN FRANCISCO
Katherine Keating
katherine.keating@hro.com
Rachel Matteo-Boehm
rachel.matteo-boehm@hro.com
Roger R. Myers
roger.myers@hro.com

BOULDER
Jason D. Haislmaier
jason.haislmaier@hro.com



Holme Roberts & Owen LLP.
Attorneys at Law