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Halve the Baby: An Obvious Solution to the Troubling Use of Trademarks as Metatags, 18 J. Marshall J. Computer & Info. L. 643 (2000)

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HALVE THE BABY: AN OBVIOUS SOLUTION TO THE TROUBLING USE OF TRADEMARKS AS METATAGS

By DAN McCUAIG†

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I. INTRODUCTION

The purpose of this paper is to suggest a simple and efficient solution to an emerging problem in the law of cyberspace: deciding when the use as “Keywords” metatags of other companies’ trademarked terms¹ should be allowed.

This paper begins by describing what metatags are and how they work. The article then provides a relatively brief discussion of the aspects of trademark law relevant to the trademark-metatag issue. Next this paper discusses the apposite cases that have thus far been decided, paying particular attention to the two most important cases in the field, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*² and *Playboy Enters., Inc. v. Welles*.³ After briefly surveying the other academic literature discussing the trademark-metatag issue, this article proposes a solution to the troubling use of trademarks as metatags.

The ultimate suggestion is that the creation and utilization of a “Trademarks” metatag should be strongly encouraged. Within the “Trademarks” metatag, a company would be allowed to list any and all terms in which it holds trademark rights and none in which it does not. As a means for encouraging compliance, either Congress could create a cause of action for any company whose trademarked terms are used as “Trademark” metatags in sites whose owners do not also hold rights in those terms, or courts could evaluate the actions of alleged trademark misusers in light of whether the appropriated terms were listed as “Keywords” metatags or “Trademarks” metatags, with a much harsher test presented to defendants who listed others’ trademarked terms in their “Trademarks” section.⁴

II. WHAT ARE METATAGS AND HOW DO THEY WORK?

“Metatags” is a fairly inclusive term that encompasses a number of different Hypertext Markup Language (HTML) code devices designed to impart information about the particular web page within which the de-

1. An illustration of which would be a pornography site completely unaffiliated with Playboy Enterprises, Inc. listing “Playboy” within the “Keywords” section of its metatags. See generally *Playboy Enters., Inc. v. AsiaFocus Int’l, Inc.*, 1998 WL 724000 (E.D. Va. 1998), discussed *infra* Part IV.D.

2. *Brookfield Communications v. West Coast Entertainment*, 174 F.3d 1036 (9th Cir. 1999).

3. *Playboy Enter. v. Welles*, 7 F. Supp. 2d 1098 (denial of preliminary injunction), *aff’d without op.*, 162 F.3d 1169 (9th Cir. 1998); *Playboy Enter. v. Welles*, 78 F. Supp. 2d 1066 (S.D. Cal. 1999) (summary judgment granted to defendant).

4. The only viable defenses in such a situation would be (1) the defendant has a valid trademark in the term; and (2) the defendant had a reasonable and good faith belief that he had a valid common law trademark right in the term.

vices exist.⁵ Metatags provide information that does not appear on the page as displayed to web surfers, though the tags can be seen through the use of the "view source" option on a browser.⁶ Rather the details in the metatags that explain what a page is "about" are meant to be communicated directly to search engines' "spiders" for indexing purposes.

While there exist a number of different metatags,⁷ the specific metatag this article focuses on is "Keywords." The "Keywords" metatag is, in its intended, benign form, a tool for communicating to search engines what a specific web page is about, such that the search engines can then properly index the page for web surfers relying on search engines to tell them what is where in cyberspace.⁸

For example, a web page that contained nothing but Hamlet's "To be, or not to be" soliloquy might contain these metatags:

```
<META NAME = "Keywords" CONTENT = "Hamlet, Shakespeare,
Shakespear, Shakspeare, Shakspear, Bard, William, Soliloquy, Suicide,
Tragedy, Globe">
```

Note that none of the keywords would actually appear on the visible page displaying the soliloquy, but all would help a search engine, to a greater or lesser extent, properly place the page in an index of Internet sites. The end result would be that a web surfer looking for the text of Hamlet's famous soliloquy would be able to go to a search engine's site, type in, for example, "Hamlet, Soliloquy, Shakespear," and have a link to the "To be, or not to be" page show up near the top of the results list returned by the search engine.

More troubling, and the focus of this paper is what happens when the same site contains metatags such as these:

```
<META NAME = "Keywords" CONTENT = "Hamlet, Shakespeare,
Shakespear, Shakspeare, Shakspear, Bard, William, Soliloquy, Suicide,
Tragedy, Globe, Coke, Pepsi, Nike, Reebok, Playboy, Mercedes, BMW,
```

5. See Brian Kennan, *Diverting Traffic on the Web*, 1999 Internet Law & Regulation Special Report 1, 2-3 (1999). A web page, in fact, is really nothing more than a text file that includes instructions telling a web browser – like Netscape Navigator or Internet Explorer – how to display its contents. *Id.* For the most part, these instructions for the browser are given in the form of various "tags." *Id.* Tags tell the browser such things as which text to display bold – – and which text should be italicized – <i> – as well as what to tell the various search engine "spiders" that "crawl" through the page what the page is "about." *Id.*

6. *Id.* at 3 n.19.

7. See generally Scott Clark, *Back to Basics: META Tags, Part 2* (visited Mar. 17, 2000) <http://www.webdeveloper.com/html/html_metatags_part2.html>. For example, the metatag, "Refresh," specifies the time in seconds before the web browser is to reload the page; "Set-Cookie" is one way of placing a cookie in a web surfer's browser. *Id.*

8. See, e.g., *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1104 (S.D. Cal. 1998), *aff'd without op.*, 162 F.3d 1169 (9th Cir. 1998) (noting that "meta tags are not visible to the websurfer although some search engines rely on these tags to help websurfers find certain websites. Much like the subject index of a card catalog, the meta tags give the websurfer using a search engine a clearer indication of the content of a website.").

bay rather than as ends sought for their own worth.¹⁴ Justice O'Connor has made clear the proper focus of trademark law:

The law of unfair competition has its roots in the common-law tort of deceit: its general concern is with protecting consumers from confusion as to source. While that concern may result in the creation of "quasi-property rights" in communicative symbols, the focus is on the protection of consumers, not the protection of producers as an incentive to product innovation.¹⁵

C. TRADEMARK INFRINGEMENT

Trademark infringement is considered a commercial tort.¹⁶ At the federal level, infringement is now governed by the Lanham Act.¹⁷

The basic test for trademark infringement – "likelihood of confusion" – is the same for both common law trademark infringement actions¹⁸

14. *Id.* § 2.06. "Hence, any 'property' in trademarks is created and defined by the mental state of consumers." *Id.*

15. *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141, 157 (1989). *See also* *International Order of Job's Daughters v. Lindeburg & Co.*, 633 F.2d 912, 919 (9th Cir. 1980), *cert. denied*, 452 U.S. 94 (1981) ("A trademark owner has a property right only insofar as is necessary to prevent customer confusion as to who produced the goods and to facilitate differentiation of the trademark owner's goods."); *Kentucky Fried Chicken Corp. v. Diversified Packaging Corp.*, 549 F.2d 368 (5th Cir. 1977) ("Property" in a trademark is defined solely by the likelihood of confusion); *James Burrough, Ltd. v. Sign of Beefeater, Inc.*, 540 F.2d 266, 274 (7th Cir. 1976), *appeal after remand*, 572 F.2d 574 (7th Cir. 1978) ("A 'trademark' is not that which is infringed. What is infringed is the right of the public to be free of confusion and the synonymous right of a trademark owner to control his product's reputation. . . . The trademark laws exist not to 'protect' trademarks, but . . . to protect the consuming public from confusion, concomitantly protecting the trademark owner's right to a non-confused public."); *Smith v. Chanel*, 402 F.2d 562, 566 (9th Cir. 1968) ("The rule rests upon the traditionally accepted premise that the only legally relevant function of a trademark is to impart information as to the source or sponsorship of the product. . . . The courts have generally confined legal protection to the trademark's source identification function for reasons grounded in the public policy favoring a free, competitive economy.").

16. *See* McCARTHY, *supra* note 9, § 2.02.

17. The Lanham Act § 43(a)(1), 15 U.S.C.A. § 1125(a)(1) (2000), reads as follows: Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, 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, shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

Id.

18. *See American Steel Foundries v. Robertson*, 269 U.S. 372 (1926); *McLean v. Fleming*, 96 U.S. 245 (1878).

and federal trademark infringement actions under the Lanham Act.¹⁹ The precise test for a claim of infringement of a federally registered mark is whether the defendant's use is "likely to cause confusion, or to cause mistake, or to deceive."²⁰ For a claim of infringement of an *unregistered* mark, the test is whether the defendant's use "is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association" of the defendant with the holder of the unregistered trademark.²¹

It is important also to note that, for infringement to be found, the trademark holder must establish that the defendant is using its trademark, *as a trademark*, in a commercial manner that is likely to cause consumer confusion and is unmitigated by necessity.²² Non-trademark uses of others' trademarks – uses which often do not serve to confuse consumers – are not prohibited by the law of trademark infringement.

However, whether or not such uses are sometimes actionable under the theory of trademark dilution is a closer question. Trademark infringement and trademark dilution may be alleged in the alternative.²³

D. TRADEMARK DILUTION

While "Dilution" is defined in the Lanham Act,²⁴ the gloss applied by courts and commentators is more important here than with respect to infringement. Professor McCarthy offer a clear and concise explanation of the basics of trademark dilution:

The dilution theory grants protection to strong, well-recognized marks even in the absence of a likelihood of confusion, if defendant's use is such as to diminish or dilute the strong identification value of the plaintiff's mark even while not confusing customers as to source, sponsorship, affiliation or connection. The underlying rationale of the dilution

19. See, e.g., *International Ass'n of Machinists & Aero. Workers v. Winship Green Nursing Ctr.*, 103 F.3d 196, 200 (1st Cir. 1996) ("likelihood of confusion often is the dispositive inquiry in a Lanham Act case"); *Jordache Enters. v. Hogg Wyld, Ltd.*, 828 F.2d 1482 (10th Cir. 1987); *Carl Zeiss Stiftung v. VEB Carl Zeiss Jena*, 433 F.2d 686 (2d Cir. 1970), *cert. denied*, 403 U.S. 905 (1971); *David Sherman Corp. v. Heublein, Inc.*, 340 F.2d 377 (8th Cir. 1965); *Fleischmann Distilling Corp. v. Maier Brewing Co.*, 314 F.2d 149 (9th Cir. 1963), *cert. denied*, 374 U.S. 830 (1963).

20. Lanham Act § 32(1), 15 U.S.C. § 1114(1) (2000).

21. Lanham Act § 43(a), 15 U.S.C. § 1125(a) (2000).

22. See, e.g., *New Kids on the Block v. New America Publ'g, Inc.*, 971 F.2d 302, 306-08 (9th Cir. 1992) (holding that newspapers using the "New Kids on the Block" trademark to describe the subject of pay-to-play polls about the band – polls which were in no way affiliated with or licensed by the band – being conducted via 1-900 numbers were protected fair uses of the New Kids' trademark).

23. MCCARTHY, *supra* note 9, § 24.90.

24. Lanham Act § 45, 15 U.S.C. § 1127 (2000) (defining "Dilution"):

The term "dilution" means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of

doctrine is that a gradual attenuation or whittling away of the value of a trademark, resulting from use by another, constitutes an invasion of the senior user's property right in its mark and gives rise to an independent commercial tort.²⁵

Prior to 1996, dilution was governed solely by state law, as federal law did not recognize the doctrine.²⁶ In 1996, however, Congress amended the Lanham Act to include an anti-dilution cause of action.²⁷

Courts have traditionally held that trademark dilution can occur via

- (1) competition between the owner of the famous mark and other parties, or
- (2) likelihood of confusion, mistake, or deception.

25. McCARTHY, *supra* note 9, § 24.70.

26. *Id.* § 24.83; *see also id.* § 24:67.

27. The Lanham Act § 43(c)(1), 15 U.S.C.A. §1125(c)(1) (2000). reads as follows:

The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to

- (A) the degree of inherent or acquired distinctiveness of the mark;
 - (B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;
 - (C) the duration and extent of advertising and publicity of the mark;
 - (D) the geographical extent of the trading area in which the mark is used;
 - (E) the channels of trade for the goods or services with which the mark is used;
 - (F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;
 - (G) the nature and extent of use of the same or similar marks by third parties;
- and
- (H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 35(a) and 36, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

- (A) Fair use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark.
- (B) Noncommercial use of a mark.
- (C) All forms of news reporting and news commentary.

Id.

either “blurring” or “tarnishment.”²⁸ More recently, the possibility of dilution by “elimination” has been recognized.²⁹

It should be noted that while McCarthy argues that the non-trademark use of a mark can never serve to dilute the mark,³⁰ this issue is still subject to some dispute.³¹ It is also important to keep in mind that in order to qualify for dilution protection, the mark must be strong.³²

The article now offers a brief explanation of each of the three forms trademark dilution can take.

1. *Blurring*

“Blurring” is the classic form of trademark dilution. The compelling principle is that if customers – or potential customers – see a famous mark being used to identify sources on a number of different goods and/or services, “[t]he unique and distinctive significance of the mark to identify and distinguish one source may be diluted and weakened.”³³ This is the case even if “no confusion as to source, sponsorship, affiliation or connection has occurred.”³⁴

The New York legislature has listed hypothetical examples of “blurred” trademarks: DuPont Shoes, Buick aspirin, Schlitz varnish, Kodak pianos and Bulova gowns.³⁵

2. *Tarnishment*

“Tarnishment” occurs when the defendant’s unauthorized use of the plaintiff’s mark results in the mark being degraded or its distinctive

28. MCCARTHY, *supra* note 9, § 24.67.

29. See *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316 (9th Cir. 1998), *discussed infra* Part III.D.3.

30. MCCARTHY, *supra* note 9, § 24.103. “There is no dilution of the trademark meaning of plaintiff’s word mark if the defendant is not using the word as a trademark. . . . When defendant does not use the word in a trademark sense, then the required novel association with a ‘new and different source’ cannot occur. Thus, only trademark-type uses can dilute the unique link between plaintiff’s word mark and plaintiff as a commercial source.” *Id.*

31. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 25(2), cmt. i (1995) (“Non-trademark uses, because they do not create an association with a different user’s goods, services or business, are *unlikely* to dilute the distinctiveness of a mark.”) (emphasis added); *Cf. Hormel Foods Corp. v. Jim Henson Prods.*, 73 F.3d 497, 506 (2d Cir. 1996) (finding that the use of “Spa’am” as name of character in puppet movie does not dilute SPAM meat product mark because use as a character name is not a trademark use: “[Defendant] is not using the name ‘Spa’am’ as a product brand name. . . . This tends to dissipate the fear that SPAM will no longer be considered a unique product identifier.”).

32. MCCARTHY, *supra* note 9, § 24.109.

33. MCCARTHY, *supra* note 9, § 24.68.

34. *Id.*

35. See *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625 (2d Cir. 1983); *see also* *Mead Data Cent., Inc. v. Toyota Motor Sales, Inc.*, 875 F.2d 1026, 1031 (2d Cir. 1989).

quality diluted.³⁶

The most famous – and quite illustrative – example of dilution by tarnishment is the “ENJOY COCAINE” case.³⁷ In that case, the defendant was enjoined from selling posters reading “ENJOY COCAINE” in a color and script identical to that used by Coca-Cola.

Trademark dilution by tarnishment has also been recognized, in the “Candyland” case,³⁸ in the Internet domain name context. In that case, the court found that a pornography site located at www.candyland.com tarnished Hasbro’s trademark “Candyland,” which is the name of a children’s board game.

As these two examples illustrate, “tarnishment” is most viable when the plaintiff’s mark is both strong and “wholesome,” and the defendant’s use of the mark is to promote a vice.

3. *Elimination*

“Elimination” is a recent, judge-made hybrid which first saw use in the district court opinion of a “cybersquatter” case.³⁹ In *Panavision*, the entrepreneurial Dennis Toeppen eliminated Panavision’s ability to use its corporate name as its domain name when he registered www.panavision.com.⁴⁰ This action diluted Panavision’s “Panavision” mark by effectively eliminating it from one medium of communication.⁴¹

At this point it seems likely that “elimination” cases will be confined to Internet domain name, “cybersquatter” / “cyberpirate” controversies.

E. DEFENSES AVAILABLE IN TRADEMARK ACTIONS

Section 33(a) of the Lanham Act provides that even if a mark is registered, use by a non-holder may be allowable according to, *inter alia*, the provisions set forth in Section 33(a).⁴² A broad range of defenses to

36. See, e.g., *Ameritech, Inc. v. American Info. Techs. Corp.*, 811 F.2d 960, 965 (6th Cir. 1987) (defining dilution as a use that causes a “gradual diminution in the mark’s distinctiveness, effectiveness and, hence, value. This kind of infringement corrodes the senior user’s interest in the trademark by blurring its product identification or by damaging positive associations that have attached to it.”) (case remanded for consideration of an Ohio common law dilution charge).

37. *Coca-Cola Co. v. Gemini Rising, Inc.*, 346 F. Supp. 1183 (E.D.N.Y. 1972).

38. *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, 40 U.S.P.Q.2d 1479 (W.D. Wash. 1996).

39. *Panavision Int’l, L.P. v. Toeppen*, 945 F. Supp. 1296 (C.D. Cal. 1996), *aff’d*, 141 F.3d 1316 (9th Cir. 1998).

40. *Id.* at 1304.

41. *Id.*

42. Lanham Act § 33(a), 15 U.S.C. § 1115(a) (2000) reads as follows:

Any registration issued under the Act of March 3, 1881, or the Act of February 20, 1905, or of a mark registered on the principal register provided by this Chapter and owned by a party to an action shall be admissible in evidence and shall be

trademark actions is set forth in Section 33(b).⁴³

Of these defenses, the most important for this paper are Fair Use⁴⁴

prima facie evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the registration subject to any conditions or limitations stated therein, *but shall not preclude another person from proving any legal or equitable defense or defect, including those set forth in subsection (b), of this section which might have been asserted if such mark had not been registered.*

Id. (emphasis added)

43. The Lanham Act § 33(b), 15 U.S.C. §1115(b) (2000), reads as follows:

To the extent that the right to use the registered mark has become incontestable under section 1065 of this title, the registration shall be conclusive evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce. Such conclusive evidence shall relate to the exclusive right to use the mark on or in connection with the goods or services specified in the affidavit filed under the provisions of section 1065 of this title, or in the renewal application filed under the provisions of section 1059 of this title if the goods or services specified in the renewal are fewer in number, subject to any conditions or limitations in the registration or in such affidavit or renewal application. Such conclusive evidence of the right to use the registered mark shall be subject to proof of infringement as defined in section 32, and shall be subject to the following defenses or defects:

(1) That the registration or the incontestable right to use the mark was obtained fraudulently; or

(2) That the mark has been abandoned by the registrant; or

(3) That the registered mark is being used, by or with the permission of the registrant or a person in privity with the registrant, so as to misrepresent the source of the goods or services on or in connection with which the mark is used; or

(4) *That the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin; or*

(5) That the mark whose use by a party is charged as an infringement was adopted without knowledge of the registrant's prior use and has been continuously used by such party or those in privity with him from a date prior to (A) the date of constructive use of the mark established pursuant to section 7(c), (B) the registration of the mark under this Act if the application for registration is filed before the effective date of the Trademark Law Revision Act of 1988, or (C) publication of the registered mark under subsection (c) of section 12 of this Act: Provided, however, That this defense or defect shall apply only for the area in which such continuous prior use is proved; or

(6) That the mark whose use is charged as an infringement was registered and used prior to the registration under this Act or publication under subsection (c) of section 12 of this Act of the registered mark of the registrant, and not abandoned: Provided, however, That this defense or defect shall apply only for the area in which the mark was used prior to such registration or such publication of the registrant's mark; or

(7) That the mark has been or is being used to violate the antitrust laws of the United States; or

(8) *That the mark is functional, or*

(9) That equitable principles, including laches, estoppel, and acquiescence, are applicable. (emphases added).

44. See 15 U.S.C. §1115(b)(4) (2000).

and Functionality.⁴⁵ Fair Use comes into play when a trademark is being used for a non-trademark function⁴⁶ or when the use of the trademark is necessary for descriptive purposes. Functionality is generally invoked when the physical structure of the trademark serves some utilitarian, non-source-identifying purpose.

F. LICENSING

Finally, it is important to note that a trademark holder can generally license the use of his trademark to others.⁴⁷

IV. CASE LAW

Given that metatags have only been used since the advent of Internet search engines has made them useful, it is hardly surprising that the case law considering their alleged improper use is still quite scant. There have been enough cases decided, though, for a clear pattern of holdings to have emerged: except in the most rare of situations,⁴⁸ the trademark holder will win at least an injunction when bringing suit against another company for the use of its trademarked terms in the other company's metatags.

Unfortunately, the leading case on the topic is *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*⁴⁹ Judge O'Scannlain's analysis in *Brookfield* is choked by formalism and distorted by O'Scannlain's imperfect understanding of how Internet search engines function. This article strongly suggests that, even if the proposals made in this paper are never effectuated, other Circuits decline to follow the "initial interest confusion" path Judge O'Scannlain has charted for the Ninth.

Welles is the other major case of the first wave of trademark-metatag decisions and the reasoning employed therein by Judge Keep offers hope for the adaptation of trademark law to the Internet even in the absence of congressional or industry action. Though it is only a second-best solution for the reasons explained in this paper, *Welles* does provide a far better model for judicial action than does *Brookfield*.

45. See 15 U.S.C. §1115(b)(8) (2000).

46. See 17 U.S.C. §107 (2000).

47. McCARTHY, *supra* note 9, § 3.04.

48. So far, in fact, "most rare" might be an understatement and "unique" more appropriate. For a detailed description of *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998) (preliminary injunction denied), *aff'd without op.*, 162 F.3d 1169 (9th Cir. 1998); 78 F. Supp. 2d 1066 (S.D. Cal. 1999) (summary judgment granted to defendant), the only case to date in which a trademark holder has lost in an action brought over the use of its trademarks as metatags by another party, see *infra* Part IV.F.

49. *Brookfield v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999). See *infra* Part IV.E.

With the exception of *SNA, Inc. v. Array*,⁵⁰ which is held aside until last because it is something of an outlier, the cases discussed in this section are presented in chronological order.

A. *INSTITUFORM TECHNOLOGIES, INC. v. NATIONAL ENVIROTECH GROUP, LLC*

In *Instituform Technologies, Inc. v. National Envirotech Group, LLC*,⁵¹ the plaintiff, an industrial plumbing supplier, brought a motion for a preliminary injunction against a competitor claiming that the defendant was using the plaintiff's federally registered marks "Instituform" and "Institupipe" in the metatags of the defendant's web site. The parties stipulated to a permanent injunction barring the defendant from using the plaintiff's marks as metatags in any web site. The defendant agreed to remove the metatags, notify search engines of the injunction, submit its web pages sans infringing metatags to the search engines for re-indexing, and file a report certifying its compliance with the injunction.

Because this matter ended in a stipulated order, the court never passed on the legality of National Envirotech's metatag use of Instituform's trademarks.

B. *OPPEDAHL & LARSON v. ADVANCED CONCEPTS*

In *Oppedahl & Larson v. Advanced Concepts*,⁵² a patent law firm brought suit against a company that listed "Oppedahl" and "Larson" multiple times in the metatags of each of its web pages despite never actually referencing the firm in the text of its site. The parties stipulated to an injunction permanently forbidding the defendants from using the plaintiff's mark "Oppedahl & Larson" or either of the words "Oppedahl" and "Larson" in the defendant's web pages without the authorization of the plaintiff.

As in *Instituform*, the court's grant of the parties' Joint Motion for Entry of Final Judgment and Permanent Injunction meant that the court never passed on the legality of Advanced Concepts' use of Oppedahl & Larson's trademark or names.

C. *PLAYBOY ENTERS., INC. v. CALVIN DESIGNER LABEL*

Playboy Enterprises, Incorporated (PEI) has long been at the forefront of the rush of trademark holders to protect their trademarks from unscrupulous use on the Internet. This is more likely attributable to the

50. *SSA, Inc. v. Array*, 51 F. Supp. 2d 554 (E.D. Pa. 1999). See *infra* Part IV.J.

51. Civ. Action No. 97-2064 (E.D. La. consent judgment entered August 27, 1997).

52. Civ. Action No. 97-Z-1592 (D. Colo. consent judgment entered December 19, 1997).

relative commercial value of PEI's marks as metatags than to any super-litigious nature of PEI.⁵³ PEI's suit against Calvin Designer Label was the second that PEI filed alleging that its trademarks had been infringed through others' use of them as metatags, and the first in which a ruling on the issue came down.

In its suit against Calvin Designer Label, PEI alleged that its trademarks were being infringed, diluted, and counterfeited by the defendant's use of the URLs www.playmatelive.com and www.playboyxxx.com, and by the placement of "Playboy" and "Playmate" within the "Keywords" metatags embedded in those sites. In *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1218 (N.D. Cal. 1997), PEI won a temporary restraining order prohibiting the defendant from, *inter alia*, "using in any manner of the PLAYMATE or PLAYBOY trademarks . . . in buried code or metatags on their home page or Web pages."⁵⁴ In *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1220 (N.D. Cal. 1997), PEI won an identical preliminary injunction. In *Playboy Enters., Inc. v. Calvin Designer Label*, 1999 WL 329058 (N.D. Cal. 1999), PEI won summary judgment on the issue of liability.

Because the defendant in this case was using infringing domain names as well as PEI's trademarks in its metatags, this decision should not be considered a pure "metatag holding."

D. *PLAYBOY ENTERS., INC. v. ASIAFOCUS INT'L, INC.*

PEI's suit against AsiaFocus International, Inc.⁵⁵ was the first legal action taken by the company to protect its trademarks from cyberpoachers. PEI alleged that AsiaFocus was infringing and diluting PEI's trademarks through its use of the URLs www.asian-playmates.com and www.playmates-asian.com, and its placement of "Play-

53. See *Playboy Enters., Inc. v. Chuckleberry Publ'g, Inc.*, 687 F.2d 563, 566-67 (finding the "Playboy" mark to be distinctive, widely recognized, and of great value). "Playboy" is almost assuredly the strongest and most valuable mark within the pornography industry, though "playmate" is possibly not far behind. Cf. *id.* See also *Welles*, 7 F. Supp. 2d 1098, 1102 (noting that "[t]he term Playboy has gained widespread public recognition and is distinctive due in large part to the long-standing success and popularity of Playboy magazine and related publications from PEI."). The pornography industry was the first – and is still one of the few – to realize significant and wide-spread direct commercial gains from the Internet. The ability of pornographers to sell their very *product* instantaneously via the Internet eliminates the order-fulfillment hurdles facing practically every other "Web-based" business. The combination of quick money to be made and one dominant, potential-customer attracting, mark meant that PEI had more to lose than any other company by not rushing to the courthouse.

54. *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1218, 1219 (N.D. Cal. 1999).

55. *Playboy Enters., Inc. v. AsiaFocus Int'l, Inc.*, 1998 WL 724000 (E.D. Va. 1998).

boy” and “Playmate” within the “Keywords” metatags embedded in those sites.

The defendants in this case were all based in Hong Kong, and all failed to answer the charges brought against them.

Reasoning that:

The defendants have purposefully employed deceptive tactics to attract consumers to their Web site[s] under the guise that their sites are sponsored by or somehow affiliated with PEI. Specifically, the defendants embedded PEI’s trademarks “playboy” and “playmate” within the Web sites’ computer source code which is visible to “search engines” that look for Web sites containing specific words or phrases specified by computer users. . . . Thus, a consumer conducting a search for PEI’s Web site by typing in the trademark “Playboy” or “Playmate” would receive a search engine-generated list which included the asian-play-mates Web site.

the court found the defendants’ actions to be willful, and entered a default judgment in PEI’s favor “in the amount of \$3,000,000 plus costs and, upon tender of supporting affidavit, reasonable attorneys’ fees.”⁵⁶

Given the scant likelihood that PEI will be able to collect damages from a Hong Kong-based Internet company, it seems quite plausible that the three-million-dollar award was meant more to send a message than to make PEI whole or to punish AsiaFocus.

E. *NITON CORP. V. RADIATION MONITORING DEVICES, INC.*

The facts of *Niton Corp. v. Radiation Monitoring Devices, Inc.*,⁵⁷ are a little unusual for trademark infringement via metatags cases. Instead of utilizing just the trademarks of their competitor as metatags, RMD lifted Niton’s *entire* meta descriptions and pasted them directly into RMD’s pages.⁵⁸

Not surprisingly, RMD was preliminarily enjoined from continuing this practice or adopting any other that would cause confusion among web users as to the identity of RMD and/or Niton.⁵⁹

F. *PLAYBOY ENTERS. INT’L, INC. V. GLOBAL SITE DESIGNS, INC.*

Playboy Enters. Int’l, Inc. v. Global Site Designs, Inc.,⁶⁰ presents a familiar fact pattern. In this case the URLs utilized by the defendants in

56. *Id.* at *1.

57. *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102 (D. Mass. 1998).

58. *Id.* at 104. “[T]he ‘META’ descriptions of RMD’s web sites were identical to those [of] the Niton web site.” *Id.*

59. *Id.* at 105.

60. *See Playboy Enters. Int’l, Inc. v. Global Site Designs, Inc.*, 1999 WL 311707 (S.D. Fla. 1999).

their effort to cash in on the notoriety of PEI's marks were www.playboyonline.net and www.playmatesearch.net.

The defendants were preliminarily enjoined from, *inter alia*, "[u]sing in any manner the PLAYBOY, PLAYMATE or RABBIT HEAD design trademarks, and any other term or terms likely to cause confusion there-with . . . in buried code or meta tags on their home page or Web pages. . . ."61

G. *BROOKFIELD COMMUNICATIONS, INC. V. WEST COAST ENTERTAINMENT CORP.*

In *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,⁶² Judge O'Scannlain carefully separated the trademarks-as-metatags issue from the other questions presented by the case and dealt with it in great depth. This conscientious approach to considering a cutting-edge problem by a respected jurist turned out to be unfortunate for two reasons: first, O'Scannlain's fundamental misunderstanding about how Internet search engines operate led him to the wrong result in *Brookfield*; second, O'Scannlain's stature in the judicial community, combined with his impressive level of inquiry into the issue in this case, has afforded more weight to his holding in *Brookfield* than the decision would otherwise merit.

The importance of *Brookfield* to the current state of the law dictates that the case be presented in some detail here.

The case came before the Ninth Circuit on plaintiff Brookfield's appeal from the district court's denial of its motion for a preliminary injunction prohibiting defendant West Coast "from using in commerce terms confusingly similar to Brookfield's trademark, 'MovieBuff.'"63 Brookfield gathers data about the entertainment industry and sells searchable software applications containing this information.⁶⁴ Brookfield sells a professional-level application, "The Studio System," and a less extensive consumer-targeted alternative, "MovieBuff."⁶⁵ Brookfield began using the "MovieBuff" mark around December of 1993.⁶⁶ Sometime in 1996 or 1997, Brookfield began selling "MovieBuff" online at www.brookfieldcomm.com and www.moviebuffonline.com, and also began offering customers use of an Internet-based searchable database under the "MovieBuff" mark at www.inhollywood.com.⁶⁷ The Patent and

61. *Id.* at *2.

62. *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999).

63. *Id.* at 1041.

64. *Id.*

65. *Id.* at 1041-42.

66. *Id.* at 1041.

67. *Id.* at 1042.

Trademark Office registered Brookfield's "MovieBuff" trademark on September 29, 1998.

West Coast Video is one of the nation's largest video rental store chains.⁶⁸ Since 1991, it has utilized the federally registered service mark, "The Movie Buff's Movie Store."⁶⁹ On February 6, 1996, West Coast Video registered the domain name www.moviebuff.com.⁷⁰ On November 11, 1998, "West Coast Video issued a press release announcing the imminent launch of its web site full of 'movie reviews, Hollywood news and gossip, provocative commentary, and coverage of the independent film scene and films in production.'"⁷¹ The press release further announced that the site would contain "an extensive database, which aids consumers in making educated decisions about the rental and purchase of movies and would allow consumers to purchase movies, accessories, and other entertainment-related merchandise on the web site."⁷²

Brookfield immediately filed a complaint in the United States District Court for the Central District of California.⁷³ Brookfield sought to enjoin West Coast Video from using "MovieBuff" both in its domain name and as a metatag.⁷⁴ The district court construed Brookfield's motion for a temporary restraining order as one for a preliminary injunction and denied it.⁷⁵ The district court held that West Coast Video was the senior user of the mark "MovieBuff" and that Brookfield had not shown a likelihood of confusion.⁷⁶ Brookfield sought and received expedited appellate review.⁷⁷

After discussing the facts and procedural history of the case, Judge O'Scannlain proceeded to describe "the basics of the Internet and the World Wide Web."⁷⁸ Except for some minor oversimplification of how Internet search engines operate,⁷⁹ Judge O'Scannlain's basic presenta-

68. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp*, 174 F.3d at 1041. At the time this case was decided, West Coast Video had over 500 stores. *Id.*

69. *Id.* West Coast Video had also used the term "Movie Buff" in advertising campaigns since at least 1988. *Id.* at 1042.

70. See *id.*

71. *Id.*

72. *Id.* at 1042-43.

73. See *id.* at 1043.

74. See *id.*

75. See *id.*

76. See *id.*

77. See *id.* at 1043-44.

78. *Id.* at 1044.

79. See Danny Sullivan, *How Search Engines Rank Web Pages*, (visited Mar. 12, 2000) <<http://www.searchenginewatch.com/webmasters/rank.html>>. Contrary to O'Scannlain's description, not all search engines utilize metatags in their algorithms for determining search results. *Id.* Likewise, repetition of the same term within the "Keywords" section of a page's metatags will not necessarily cause that page to rise on the results list of every search engine, and might even lead to blackballing by some search engines. See *id.* Also,

tion of the workings of the Internet is fundamentally correct.

Judge O'Scannlain then proceeded to consider the issue of whether West Coast Video's use of the URL www.moviebuff.com infringed upon Brookfield's trademark, "MovieBuff." While an in-depth analysis of trademark-infringing domain names is beyond the scope of this paper, it is important to note that O'Scannlain did find infringement in this case, and that he considered the domain name issue separately from the metatag issue.⁸⁰

O'Scannlain next turned to the question of "whether West Coast can, consistently with the trademark and unfair competition laws, use 'MovieBuff'⁸¹ or 'moviebuff.com' in its HTML code."⁸² Judge O'Scannlain correctly observed that, as compared to the issue of trademark infringement via a domain name, "[t]he question in the metatags context is quite different."⁸³ The use of a metatag identical to a competitor's trademark is less likely to be an infringing action than the use of a domain name identical to the same trademark:

Although entering "MovieBuff" into a search engine is likely to bring up a list including "westcoastvideo.com" if West Coast has included that term in its metatags, the resulting confusion is not as great as where West Coast uses the "moviebuff.com" domain name. First, when the user inputs "MovieBuff" into an Internet search engine, the list produced by the search engine is likely to include both West Coast's and Brookfield's web sites. Thus, in scanning such list, the Web user will often be able to find the particular web site he is seeking. Moreover, even if the Web user chooses the web site belonging to West Coast, he will see that the domain name of the web site he selected is "westcoastvideo.com" Since there is no confusion resulting from the domain address, and since West Coast's initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast's web site.⁸⁴

If Judge O'Scannlain had paused at this point and considered the "real world" parallel to the cyber situation facing him, and if he had

Yahoo! is technically *not* a search engine, but rather is a directory of sites, the compilation and management of which is executed largely by humans. Danny Sullivan, *How Search Engines Work*, (visited Mar. 12, 2000) <<http://www.searchenginewatch.com/webmasters/work.html>>.

80. See 174 F.3d at 1046-61.

81. Note that although I will follow Judge O'Scannlain's lead in presenting the "Keyword" metatag at issue here as "MovieBuff," "Keywords" metatags are not case sensitive: "MovieBuff" in the metatag sense is the same as "MOVIEBUFF," "moviebuff," and "moVieBUff." In *Brookfield*, O'Scannlain enjoined West Coast from using "moviebuff" as a metatag, no matter how many of the letters therein are capitalized.

82. *Brookfield v. West Coast Entertainment*, 174 F.3d at 1061.

83. *Id.* at 1062.

84. *Id.*

pondered how best to effectuate the fundamental purpose of trademark law – providing information to consumers, *not* creating a patent-like property right in producers – he would have reached the proper answer to the question of whether or not West Coast Video's use of "moviebuff" within its metatags infringed upon Brookfield's trademark, "MovieBuff." He would have found that it did not.

Translating the cyber situation in *Brookfield* to its "real world" version demonstrates why a finding of no infringement in this case would have been the correct one. Suppose that instead of surfing the Web for her Hollywood Insider information needs, O'Scannlain's hypothetical consumer drives to her local shopping mall and visits the ubiquitous movies/music/video games/computer software superstore there. Instead of milling randomly around the store hoping to stumble across the perfect product, the consumer asks the clerk – who is playing the role of "real world search engine" – "Where do you keep your MovieBuff software?"⁸⁵ The clerk, with arm held aloft to point our consumer on her way, smiles and cheerfully replies, "Near the end of Aisle Six." When she arrives at the designated section of the store, the consumer does not find Brookfield's "MovieBuff" database surrounded by Chris Farley movies and Backstreet Boys albums, rather she finds it in the midst of other computer software products. Likely, "MovieBuff" is surrounded most closely by other programs related to the entertainment industry. In fact, West Coast Video's "The Movie Buff's Entertainment Industry Database" is probably stocked right next to Brookfield's "MovieBuff."⁸⁶

At this point, our consumer would have the option of picking up "MovieBuff" and heading to the checkout counter – as she likely would do if she had been sure when she entered the store that what she wanted was Brookfield's database, specifically – or she could instead examine and compare West Coast Video's offering with Brookfield's – as would be likely if, in her mind, she had asked the clerk about "software for movie buffs" rather than for any particular database.

85. Or, "Where do you keep your movie buff software?" O'Scannlain holds that West Coast Video may place "Movie Buff" in its metatags but not "MovieBuff." *Id.* at 1066. ("We agree that West Coast can legitimately use an appropriate descriptive term in its metatags. But 'MovieBuff' is not such a descriptive term. Even though it differs from 'Movie Buff' by only a single space, that difference is pivotal. The term 'Movie Buff' is a descriptive term, routinely used in the English language to describe a movie devotee. 'MovieBuff' is not. The term 'MovieBuff' is not in the dictionary. . . . The proper term for 'motion picture enthusiast' is 'Movie Buff,' which West Coast certainly can use. It cannot, however, omit the space.")

86. As anyone who has ever been to a brick-and-mortar store knows, it is common practice to place like products with like. Consumers demand this arrangement so that they can easily make comparisons between similar offerings. Any store owner following the practice of physically isolating products from their competitors would quickly find herself out of business.

Returning for a moment to the parallel cyberworld, it is apparent that a search engine's results list is meant to mimic the physical display of products within a brick-and-mortar shop.⁸⁷ Responding to an ambiguous query,⁸⁸ the search engine returns a list of options most likely to interest the consumer. The surfer is then free to move either straight to the site for which she was searching – if she did indeed have such a definite goal in mind – or to use the search list's hyperlinks and her browser's "Back" button to perform the functional equivalent of picking up a number of boxes and looking them over before deciding which product to buy.

However, Judge O'Scannlain does not stop to make this analysis following the portion of his opinion most recently quoted in this paper.⁸⁹ Instead he goes on immediately to assert:

Nevertheless, West Coast's use of "moviebuff.com" in its metatags will result in what is known as initial interest confusion. Web surfers looking for Brookfield's "MovieBuff" products *who are taken by a search engine to "westcoastvideo.com"* will find a database similar enough to "MovieBuff" such that a sizable number of consumers who were originally looking for Brookfield's product will simply decide to utilize West Coast's offerings instead. Although there is no source confusion in the sense that consumers know they are patronizing West Coast rather than Brookfield, there is nevertheless initial interest confusion in the sense that, by using "moviebuff.com" or "MovieBuff" to *divert* people looking for "MovieBuff" to its web site, West Coast improperly benefits from the goodwill that Brookfield developed in its mark.⁹⁰

And thus does O'Scannlain's jamming West Coast Video's use of the metatag, "MovieBuff," into the category of "initial interest confusion" rest on a fundamental misunderstanding of the way in which Internet search engines operate. Search engines do not "take" web surfers to any site, rather they respond to requests for information by providing lists of sites that, depending on the situation-specific accuracy of the search en-

87. See Thomas F. Presson & James R. Barney's *Trademarks as Metatags: Infringement or Fair Use?*, 26 AIPLA Q. J. 147, 166-67 (1998) (providing a useful grocery store analogy).

88. Just as most consumers do not speak the Queen's English – and so "MovieBuff" could readily be mistaken by a listener to have been "movie buff," and vice versa – most web users do not consult a dictionary while surfing. In fact, it is common practice for companies to include misspellings within their "Keywords" metatags so as to be able to garner the attention of phonetically-challenged potential customers while still maintaining the professional quality of their visible site. See Presson & Barney, *supra* note 87 at 149 (noting that "[t]he metatag section allows Web site operators to include large lists of related words and phrases, including commonly misspelled terms and multiple variations of the same phrase, which would (1) not fit within the text of the site or (2) detract from the site's aesthetic, literary, or artistic presentation.") (emphasis added).

89. See *supra* text accompanying note 84.

90. *Brookfield v. West Coast Entertainment*, 174 F.3d at 1062 (emphases added).

gines' individual algorithms, are most likely to meet the surfer's needs. The surfer then chooses from amongst the list of hyperlinks returned which site(s) she wishes to examine.⁹¹ West Coast Video's use of the metatag, "MovieBuff," would likely suffice to earn it a place on the results lists returned by most search engines,⁹² but it could do no more than that. The surfer would still have to pick out the hyperlink to West Coast Video's site from among all those returned before being "taken" to that site.

Thus, the only "consumer confusion" that could result from West Coast Video's use of the metatag, "MovieBuff," is confusion over why www.westcoastvideo.com was included on the particular search engine's results list. Given that the fundamental purpose of trademark law is to provide consumers with information, this hint of "confusion" seems like a small price to pay when compared to the option – embraced by the Ninth Circuit in *Brookfield* – of hiding from poor-spelling, Web-surfing movie buffs a database meant to fill the same market niche as Brookfield's "MovieBuff." Trademarks do not provide their holders with patent-like property rights and they should not be enforced by courts in such a manner as to suppress competition.⁹³

Judge O'Scannlain's holding in *Brookfield* seems to be driven by a difficulty in finding the proper cyberworld-to-"real world" parallelism. Rather than realizing that a search engine's results list is closely akin to a brick-and-mortar store's display case, O'Scannlain insists on forcing an analogy utilizing the overworked and not terribly accurate "Information Superhighway" cliché:

Suppose West Coast's competitor (let's call it "Blockbuster") puts up a billboard on a highway reading—"West Coast Video: 2 miles ahead at Exit 7"—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there. Even consumers who prefer West Coast may find it not worth the trouble to continue searching for West Coast since

91. See *supra* text accompanying notes 84-88.

92. Though not all: Lycos, for example, does not utilize "Keywords" metatags in its algorithm. See Danny Sullivan, *How Search Engines Rank Web Pages*, (visited Mar. 12, 2000) <<http://www.searchenginewatch.com/webmasters/rank.html>>.

93. This is particularly true when even a surfer who chooses from a search engine's results list a hyperlink to a web site she does not really want to patronize can cure her mistake in seconds with a single click of her browser's "Back" button. "Initial interest confusion" in cyberspace does not involve the same sunk costs as its "real world" namesake, and so should be called upon by courts far less often. Cf. *Teletech Customer Care Management (Cal.), Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1414 (C.D. Cal. 1997) (finding likelihood of initial interest confusion in a *domain name* case, but holding that such "brief confusion is not cognizable under the trademark laws").

there is a Blockbuster right there. Customers are not confused in the narrow sense: they are fully aware that they are purchasing from Blockbuster and they have no reason to believe that Blockbuster is related to, or in any way sponsored by, West Coast. Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that Blockbuster would be misappropriating West Coast's acquired goodwill.⁹⁴

However, this analogy does not fit with the case presented by West Coast Video's use of the metatag, "MovieBuff." Even holding aside the obvious differences between getting off a highway and driving around and following a hyperlink and scanning a web page, the hypothetical situation presented by Judge O'Scannlain is inapposite. In order for the facts of *Brookfield* to parallel those presented by O'Scannlain's Blockbuster example, the hyperlink to West Coast Video's site – returned on the results list generated by a search engine queried for "moviebuff" – would have to read something to the effect of "MovieBuff – searchable database of Hollywood Insider information brought to you by Brookfield Communications," and the West Coast Video URL to which the entry was linked – www.westcoastvideo.com – would have to be hidden from the surfer. No such facts are presented in *Brookfield*, nor would West Coast Video's use of the metatag, "MovieBuff," on its www.westcoastvideo.com site lead to any.

While Judge O'Scannlain arrived at the wrong result in *Brookfield* because he misunderstood how search engines operate and was taken in by the omnipresent "Information Superhighway" cliché, it is important to note that the case presented such a difficult problem because search engines currently do not allow the surfer who types in "MovieBuff" desiring specifically to find Brookfield's "MovieBuff" database to differentiate herself from the surfer who types in "moviebuff" seeking information generally of interest to movie buffs.

H. *PLAYBOY ENTERS., INC. v. WELLES*

The other leading case on the use by one web site owner of another company's trademarks as "Keywords" metatags is *Playboy Enters., Inc. v. Welles*.⁹⁵

The fact pattern presented by *Welles* is more interesting than that of *Calvin Designer Label*,⁹⁶ *AsiaFocus*,⁹⁷ or *Global Site Designs*.⁹⁸ First, Terri Welles, the defendant in this case, did not use a PEI trademark

94. *Brookfield v. West Coast Entertainment*, 174 F.3d at 1064.

95. *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998) (preliminary injunction denied), *aff'd without op.*, 162 F.3d 1169 (9th Cir. 1998); *Playboy Enters., Inc. v. Welles*, 78 F. Supp. 2d 1066 (S.D. Cal. 1999) (summary judgment granted to defendant).

96. *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1220 (N.D. Cal. 1997). See *supra* Part IV.C.

within the domain name of her web site.⁹⁹ This fact necessarily prevented Judge Keep from conflating the metatag infringement issue with any domain name infringement question – a separation not always firmly kept by the three earlier PEI cases. Second, because Welles was PEI's "Playmate of the Year for 1981,"¹⁰⁰ she had a plausible fair use defense with respect to the use of the terms "Playboy" and "Playmate" within her "Keywords" metatags that the earlier defendants simply could not claim.¹⁰¹ Third, Welles seems to have acted in good faith in indexing her web site,¹⁰² rather than having simply tried to siphon off profits from PEI.

1. *PEI's Action for a Preliminary Injunction*

In PEI's action to preliminarily enjoin Welles from, *inter alia*, using the terms "Playboy" and "Playmate" within the "Keywords" metatags of her web site, Judge Keep began her examination of the trademark questions at issue by noting that the relevant facts before the court were not in dispute. She established that "PEI owns federally registered trademarks for the terms Playboy, Playmate, Playmate of the Month, and Playmate of the Year."¹⁰³ At the same time, "[d]efendant uses the terms Playboy and Playmate along with other terms within the keywords section of the meta tags, which constitutes the internal index of the website used by some search engines."¹⁰⁴

Judge Keep then launched into a thoughtful and cogent analysis of the merits of Welles' fair use defense to PEI's claims of trademark infringement, false designation of origin, and trademark dilution. Keep

97. *Playboy Enters., Inc. v. AsiaFocus*, 1998 WL 724000 (E.D. Va. 1998). See *supra* Part IV.D.

98. *Playboy Enters., Inc. v. Global Designs*, 1999 WL 311707 (S.D. Fla. 1999). See *supra* Part IV.F.

99. *Playboy Enters. v. Welles*, 7 F. Supp. 2d at 1104, (noting that Ms. Welles "does not use Playboy or Playmate in her domain name"). The domain name of Ms. Welles' web site is www.terriwelles.com. *Id.*

100. *Id.* at 1103.

101. "The problem in this case is that the trademarks that defendant uses, and the manner in which she uses them, describe her and identify her." *Id.* This raises a question of whether there is a 'fair use' of these marks pursuant to 15 U.S.C. §§ 1115(b)(4) and 1125(c)(4)." *Id.*

102. "Since May of 1997, defendant has been in contact with plaintiff about the design and creation of her web site." *Id.* at 1101. "Ms. Welles has minimized her references to Playboy on her website and has not attempted to trick customers into believing that they are viewing a Playboy-endorsed website." *Id.* at 1103-04. "Finally, it appears that defendant has used the trademarks in good faith." *Id.* "She has removed some of the references per PEI's request, has not used the bunny logo, and has added a disclaimer to the vast majority of her free web pages." *Id.* at 1104.

103. *Id.* at 1100.

104. *Playboy Enters. v. Welles*, 7 F. Supp. 2d at 1101.

first noted that Welles is a Playboy Playmate: "Much like Academy Award winners, crowned Miss Americas, and Heisman Trophy winners, Playboy Playmates are given a title which becomes part of their identity and adds value to their name."¹⁰⁵ As such, Keep found Welles' use of PEI's trademarks in her "Keywords" metatags – "She has also used the terms Playboy and Playmate as meta tags for her site so that those using search engines on the Web can find her website if they were looking for a Playboy Playmate."¹⁰⁶ – to be fair:

Ms. Welles' use of the terms Playmate and Playmate of the Year constitute identification of herself. The use of those terms, in the website and in the meta tags, allows websurfers and potential customers to identify her services, whether it be her line of cigars, her promotional services, or her nude photographs. Given that Ms. Welles is the "Playmate of the Year 1981," there is no other way that Ms. Welles can identify or describe herself and her services without venturing into absurd descriptive phrases. In cases where the trademarked term must be used to identify the individual or good, infringement and dilution laws do not apply.¹⁰⁷

In forcefully coming to such a conclusion, Judge Keep became the first Jurist presented with the question of whether one web site's use in its "Keywords" metatags of another company's trademarks constituted trademark infringement or dilution to find that it did not. Judge Keep's holding in PEI's action for a preliminary injunction predated *Brookfield*,¹⁰⁸ but unfortunately did not prove to be as persuasive to the Ninth Circuit as it might have. The lesson that metatags are tools to aid *web surfers* was lost. As was the notion that when a surfer enters a descriptive term into a search engine in an attempt to find sites related to that term, the surfer's goal should not be frustrated by the courts' overprotection of trademarks, which are often not being used by the surfer in their trademark sense.

While *Welles* did undoubtedly present a stronger case for the defendant than did *Brookfield*, it is important to note also that Judge Keep's understanding of how metatags fit into the architecture of cyberspace is more nuanced and more correct than is Judge O'Scannlain's (i.e., Judge Keep is not under the misapprehension that search engines "take" web surfers anywhere), and this better understanding of the form and function of metatags allowed her to evaluate the trademark issues surrounding them with a clearer eye:

105. *Id.* at 1102.

106. *Id.* at 1103.

107. *Id.* at 1105.

108. *Playboy Enters. v. Welles* was in fact cited by Judge O'Scannlain in *Brookfield* as "the case most on point," 174 F.3d 1036, 1065, immediately before O'Scannlain launched into his rather tortured discussion of the difference between "MovieBuff" and "Movie Buff." See *supra* note 85.

With respect to the meta tags, the court finds there to be no trademark infringement where defendant has used plaintiff's trademarks in good faith to index the content of her website. The meta tags are not visible to the websurfer although some search engines rely on these tags to help websurfers find certain websites. Much like the subject index of a card catalog, the meta tags give the websurfer using a search engine a clearer indication of the content of a website.¹⁰⁹

2. *Welles' Motion for Summary Judgment*

In her opinion, which grants defendant Welles summary judgment on all of PEI's claims,¹¹⁰ Judge Keep went even further in her attempt to provide a framework for evaluating claims of trademark infringement and dilution arising in cyberspace. In contrast to O'Scannlain's rather strained opinion in *Brookfield*, which forces the Internet to conform to the ("real world") Law, Keep provided an analysis which is "flexible and reflective of emerging technologies."¹¹¹ She was, in writing her second *Welles* opinion, ever mindful that the courts "must not lose sight of either common sense or the important, foundational and underlying principles of trademark law."¹¹² Judge Keep found a way to adapt the fiction of the Law to the reality of the Internet.

After drawing on her preliminary injunction opinion to set forth the general background facts of the dispute,¹¹³ Keep made absolutely clear what the relevant point of contention was: "Plaintiff alleges that Ms. Welles' use of its trademarks, 'Playboy,' 'Playmate,' and 'Playmate of the Year' in the HTML source code of her website constitutes an infringing and diluting trademark use of its marks."¹¹⁴ Rather than launching immediately into her analysis from that point, though, Judge Keep presented a clear, concise, and accurate description of how metatags work and how search engines utilize them:

Users searching for a specific website can either type it into a web browser to access the site directly, or they can utilize a "search engine" available on the Web to search for a specific website by keywords and phrases. Listings or results are the end product of a search. There are two basic types of search engines: human powered and web-crawler. Human-powered search engines produce human-compiled listings which have been approved and categorized by human search engine editors, much like how a librarian might catalog books in the library.

109. *Playboy Enters. v. Welles*, 7 F. Supp. 2d at 1104.

110. *Playboy Enters. v. Welles*, 78 F. Supp. 2d 1066.

111. *Id.* at 1095 (internal quotation marks omitted).

112. *Id.*

113. *Id.* at 1071-72.

114. *Id.* at 1091 (noting that "[t]he metatag keywords on Ms. Welles' website reads, 'terri, welles, playmate, playboy, model, models, semi-nudity, naked, breast, breasts, tit, tits, nipple, nipples, ass, butt.'").

Changes to a website's meta tag descriptors, keywords, or HTML title have no impact on human-compiled listings or search results unless a human editor decides to follow or endorse these changes. However, due to the inordinate amount of websites, human editors cannot classify everything, and consequently, some search engines are more reliant on the web-crawler than the human-powered engines, or human editors.

Web crawlers "read" individual web pages by reading much of the text in the HTML source code and store in cyberspace memory the text they find on each page. In addition to providing a listing of search results which was initiated by the consumer's typing of keywords or phrases into a browser, search engines enable consumers to sort through their listings by ranking pages so that the pages which best match their relevancy criteria are listed first, then continuing in chronological order. The criteria or algorithm used by search engines to rank search results in response to a particular search query varies among different search engines and even within search engines, as these formula continue to change from time to time. These criteria or algorithms are a combination of many various factors, including but not limited to, the frequency of words on a page, the location of words, the HTML title, and metatags (meta descriptors and meta keywords). The title tag is text that is used as the title of a web page in the listings of a crawler-based search engine. Metatags are mostly used to provide additional information about a web page and are not ordinarily viewed by users. The meta descriptors allows web page authors to state the exact description they would like to have for their web pages as listed in the search results of a web crawler search engine, and the meta keyword tags allow page authors, at least in theory, to identify or add words to their pages in order to better define or accurately relate the contents of the page for the web crawler search engine.¹¹⁵

Against this backdrop, Judge Keep presented her analysis of whether PEI's trademark claims against Terri Welles could withstand summary judgment. She began by noting that "[p]laintiff relies on *Brookfield Communications*."¹¹⁶ PEI's reliance on *Brookfield* was hardly surprising – it was, after all, a recently-decided Ninth Circuit case very nearly on point – and shows the danger that a poorly reasoned decision early in the development of a body of law can pose to the entire area of law. Fortunately, Judge Keep was able to distinguish *Welles* from *Brookfield*. Unfortunately, in so doing she cited with approval O'Scannlain's application of "initial interest confusion" to trademark metatag cases.¹¹⁷

Keep's path around *Brookfield* ran directly through the fair use doc-

115. *Id.* at 1091-92. (citations omitted)

116. *Id.*

117. "Although Plaintiff is correct in citing *Brookfield* for the proposition that 'likelihood of confusion can be shown on the basis of initial interest confusion,' Plaintiff's reliance on *Brookfield* is misplaced as applied to Ms. Welles' case." *Id.*

trine.¹¹⁸ While this utilization of fair use did allow Judge Keep to come to the proper conclusion in *Welles*, it is important to note that such an analysis *necessarily assumes* that the terms being used are indeed being used *as trademarks*, and that the specific use of the trademarked terms is allowable only because it is fair and/or necessary. As the goal of this article is to explain the necessity of the disaggregation of the trademark use of metatags from the descriptive use of metatags, it is essential to emphasize here that Judge Keep's employment of the fair use doctrine to find her way to the correct holding in *Welles* is a second-best solution.

There is, in fact, a sense about *Welles* that *Brookfield* is not quite right, and that the consistent application of a *Brookfield* analysis over the cases to arise in the future will lead to some odd results.¹¹⁹ Even when relying upon *Brookfield* to determine the method of evaluating PEI's claims in *Welles*, Judge Keep cited the "difficult to say that a customer is likely to be confused about whose site he has reached" language from the early stages of Judge O'Scannlain's analysis,¹²⁰ *see supra* text accompanying note 84, rather than any part of *Brookfield* coming up after O'Scannlain took a wrong turn on his "Information Superhighway."

Instead of breaking away from *Brookfield*,¹²¹ though, Keep chose to limit the damage of the *Brookfield* holding by stressing that a finding of "initial interest confusion" did not mean the end of the trademark inquiry: "*Dr. Seuss*, like *Brookfield*, held that initial interest confusion is actionable under the Lanham Act, not that a finding of initial interest confusion compelled a finding of trademark infringement or barred a finding of fair use."¹²² Keep further advanced the case for a flexible doctrine with a foundation in common sense by noting that *Welles*' use of PEI's trademarked terms in her metatags was done in good faith, and that such lack of foul motive was important.¹²³

Though Judge Keep carefully confined the basis of her actual holding to the fact that *Welles*' use of PEI's trademarked terms was "a nominative fair use,"¹²⁴ her dicta concerning the policy of trademark law and

118. "[A]lthough *Brookfield* concerned the use of the plaintiff's trademarked terms in the metatags of the defendant's website, it did not involve the use of the fair use defense within the metatags context." *Id.* at 1093.

119. "Thus, the court finds that insofar as Plaintiff relies on *Brookfield* to support its position, *Brookfield* is distinguishable since the defendant's use in *Brookfield* of the word 'MovieBuff' was found not to have been a descriptive use (although the court noted that the term 'Movie Buff' (with a single space) is a descriptive term and that the difference was pivotal)." *Id.*

120. *See id.* at 1093-94.

121. Which is, of course, controlling law for district courts within the Ninth Circuit.

122. *See Playboy Enters. v. Welles*, 78 F. Supp. 2d at 1094.

123. "Furthermore, there is no evidence in this case that Ms. Welles has intended to divert Plaintiff's customers to her website by trading on PEI's goodwill." *Id.* at 1095.

124. *Id.* at 1096.

the structure and potential of the Internet deserve careful consideration. Keep did not fall prey to thinking of the Internet in clichéd terms. Instead she suggested that intellectual property doctrines designed for application to other media should be probed carefully for their relevance to and effectiveness in dealing with the unique challenges posed by the Internet:

The World Wide Web is a commercial marketplace and a free speech marketplace. To give consumers access to it, the court must also be careful to give consumers the freedom to locate desired sites while protecting the integrity of trademarks and trade names. The court stresses that the underlying or foundational purpose of trademark protection is not to create a property interest in all words used in a commercial context, but rather "[t]he policies of free competition and free use of language dictate that trademark law cannot forbid the commercial use of terms in their descriptive sense."¹²⁵

Judge Keep's description of how trademark law *should* be applied in the context of the Internet is exactly right. Unfortunately, the current method of utilizing metatags by search engines coupled with the passivity of Congress and the Ninth Circuit's holding in *Brookfield* make the realization of such lofty goals unlikely.

After holding that "[p]laintiff has failed to raise a material issue of fact concerning the fair use of PEI terms in [Welles'] metatags,"¹²⁶ and granting summary judgment to defendant Welles on PEI's claims of trademark infringement,¹²⁷ Judge Keep went on to make short shrift of PEI's trademark dilution¹²⁸ claims, holding that "as a matter of law [] Defendant Welles' use of the terms 'Playboy Playmate of the Year 1981,' 'Playmate of the Year 1981,' 'PMOY '81,' 'Playmate,' and 'Playboy' does not dilute PEI's trademarks."¹²⁹

Of course, in the world this paper suggests that we move toward, the distinction in the metatag context between trademark infringement and trademark dilution would become irrelevant.

125. *Playboy Enters. v. Welles*, 78 F. Supp. 2d 1066, 1095 (quoting 1 J. McCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 11.45, at 82 (1999)).

126. *Id.* at 1096.

127. *Id.*

128. "Dilution is defined as 'the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of . . . (2) likelihood of confusion, mistake, or deception.'" 15 U.S.C. § 1127 (1999). Under the Federal Trademark Dilution Act, a dilution claim is not actionable if there is a "[f]air use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark." 15 U.S.C. § 1125(c)(4)(A) (1999).

129. *Playboy Enters. v. Welles*, 78 F. Supp. 2d at 1096.

I. *NEW YORK STATE SOC'Y OF CERTIFIED PUBLIC ACCOUNTANTS V. ERIC LOUIS ASSOCS., INC.*

In *New York State Soc'y of Certified Public Accountants v. Eric Louis Assocs., Inc.*,¹³⁰ the New York State Society of Certified Public Accountants sued an accountant placement firm for an injunction and attorneys' fees on theories of false designation of origin and trademark dilution. The NYSSCPA alleged that that defendant ELA's use of the NYSSCPA's unregistered "NYSSCPA" mark in ELA's Internet domain name¹³¹ and as a metatag constituted infringement. ELA consented to the entry of a permanent injunction,¹³² and the court awarded the NYSSCPA attorneys' fees.¹³³

While this case is noteworthy because Judge Sand found that the defendant's conduct (essentially ignoring the NYSSCPA's cease-and-desist letters) rose to the level of willfulness required to award attorneys' fees,¹³⁴ it is of limited import with respect to the question of when the metatag use of another's trademarked terms constitutes a violation of the Lanham Act for two separate reasons. First, Judge Sand consistently considered ELA's use of the metatag "NYSSCPA" in conjunction with its use of the domain name *www.nysscpa.com*. Second, Sand exhibits some amount of the misunderstanding of how search engines operate that plagued Judge O'Scannlain's *Brookfield* opinion.

Judge Sand's conflation of the metatag issue in this case with the domain name issue necessarily makes relatively hollow his finding that ELA's use of the NYSSCPA's trademarked term as a metatag was improper. In considering the secondary meaning prong of the NYSSCPA's false designation of origin claim, Sand stated that, "[d]efendant's use of the 'nysscpa.com' domain name *and* the 'NYSSCPA' meta-tag is clear evidence of an attempt to plagiarize the Society's mark."¹³⁵ In considering the likelihood of confusion prong, Judge Sand's subheading number one reads: "The 'nysscpa.com' Domain Name and the 'NYSSCPA' Meta-Tag."¹³⁶ Sand's holding on issue of likelihood of confusion was similarly a holding based on the combined effect of the domain name and the metatag:

130. *New York State Soc'y of Certified Public Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999) (decided on December 2, 1999, one day after Welles was granted summary judgment in *Playboy Enters., Inc. v. Welles*, 78 F. Supp. 2d 1066).

131. On January 9, 1999, ELA registered the domain name *www.nysscpa.com*. *Id.* at 339.

132. The permanent injunction order was issued on June 1, 1999. *Id.* at 333.

133. The court used the lodestar method of calculating attorneys' fees and awarded NYSSCPA \$46,818.48. *Id.* at 352, 357.

134. *Id.* at 350.

135. 79 F. Supp. 2d at 340 (emphasis added).

136. *Id.*

we find that Defendant's use of the "nysscpa.com" domain name and the "NYSSCPA" meta-tag caused a likelihood of confusion because it created initial interest confusion. Having also found that Plaintiff's NYSSCPA mark has acquired secondary meaning, the Court holds that these actions constitute false designation of origin under § 43(a) of the Lanham Act.¹³⁷

As can be presumed from the language quoted above, Judge Sand cited with approval Judge O'Scannlain's *Brookfield* holding.¹³⁸ In addition to following suit in endorsing the application of "initial interest confusion" to claims arising in cyberspace, Sand demonstrated the same fundamental misapprehension of the manner in which search engines operate that led O'Scannlain to fret over the possibility that unsuspecting web surfers would be "taken" to sites they did not intend to visit due to the unscrupulous use by those sites in their metatags of other companies' trademarked terms. In his Findings of Fact, Judge Sand asserted that "each of [ELA's] sites used 'NYSSCPA' as a 'meta-tag' within its HTML code, such that an internet search for NYSSCPA would lead to each of the three sites."¹³⁹ Judge Sand also accepted the NYSSCPA's assertion that "ELA's placement of meta-tags using the Society's NYSSCPA mark in the HTML code of each of its three web sites ensur[ed] that anyone seeking out the Society on the World Wide Web by using its well-known servicemark would be diverted to [ELA's] web site."¹⁴⁰

While this case was decided quite recently, and while it did emanate from the Southern District of New York, its analysis of the metatag issue is polluted enough with domain name considerations, and its misapprehension of the functioning of search engines is fundamental enough, that the case itself deserves little more consideration than as a vote for *Brookfield*.

J. *SNA, INC. v. ARRAY*

In *SNA, Inc. v. Array*,¹⁴¹ the manufacturer of kits for Seawind amphibious airplanes sued one company, Turbine Design, which assembled Seawinds for kit purchasers and another company, Horizon Unlimited, which published a newsletter called "The Seawind Builders Newsletter" for, *inter alia*, trademark infringement and unfair competition. Each of the defendants in this action operated a web site that "currently or in the past have discussed plaintiffs."¹⁴² However, Judge Katz focused on the

137. *Id.* at 342.

138. *See id.*

139. *New York State Soc'y of Certified Public Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d at 339 (emphasis added).

140. *Id.* at 347 (internal quotation marks omitted).

141. *SNA, Inc. v. Array*, 51 F. Supp. 2d 554 (E.D. Pa. 1999).

142. *Id.* at 558.

actions of Horizon Unlimited with respect to his discussion of possible trademark violations through Horizon Unlimited's use in its domain name and as a metatag of SNA's common law trademark, "Seawind."

This case is important for two reasons. First, while both the use of a domain name and the use of a metatag were challenged as infringing upon the same trademark, Judge Katz was careful to consider the issues separately.¹⁴³ Second, while Judge Katz relied heavily on Judge Keep's first *Welles* decision for both his description of metatags and his analysis of them in the trademark context,¹⁴⁴ he went beyond Judge Keep's holding in *Welles* and *required* a showing that the use of a *descriptive* trademarked term be in good faith in order for the metatag user of another's trademark to avoid infringement liability:

Plaintiffs argue that the use of the word "Seawind" in meta tagging the seawind.net site is an unfair trade practice. See Pl.Ex. 62 at 102, 106 (illustrating defendants' practice of typing a block of text repeating the words "Seawind," "SEAWIND," and "seawind" many times). The court agrees that defendants intentionally use plaintiffs' mark in this way to lure internet users to their site instead of SNA's official site. This is true whether the meta tagging is visible or hidden in the code, and no matter what the website's domain name is. This case can be distinguished from *Playboy Enterprises, Inc. v. Welles*, 7 F.Supp.2d 1098 (S.D.Cal.1998), in a crucial way: In that case, the court found that defendant "used plaintiff's trademarks in good faith to index the content of her website." *Id.* at 1104. Here, based on the repetitious usage and the evidence of defendants' general intent to harm plaintiffs, the court cannot find that this use is a similar good faith effort simply to index the content of the website; instead, it is a bad faith effort to confuse internet users that is likely to succeed. Defendants' meta tagging will thus be enjoined.¹⁴⁵

In the court's final judgment, both defendants were "enjoined from meta tagging their websites, whatever the domain name, with the word 'Seawind.'"¹⁴⁶

This holding is overly broad. Both of the defendants in this case performed legitimate business functions that were peripheral to the plaintiff's business of manufacturing Seawind kits. Each of the defendant's web sites "currently or in the past have discussed plaintiffs."¹⁴⁷ Horizon Unlimited, in particular, made its *entire business* the discussion of SNA's Seawind aircraft. Clearly, using the term "Seawind" in its metatags would comport with Judge Katz's stated notion of what purpose metatags serve: "Much like the subject index of a card catalog, the meta

143. *See id.* at 562-63.

144. *See id.* at 562-63 & n.10.

145. *Id.* at 562-63.

146. *Id.* at 569.

147. *Id.* at 558.

tags give the websurfer using a search engine a clearer indication of the content of a website.¹⁴⁸ Rather than merely enjoining Horizon Unlimited from “stuffing,”¹⁴⁹ though, Judge Katz forbid the company from *any* use of the term, “Seawind” within its metatags.

While this was no doubt an effective punishment for Horizon Unlimited, it also effectively punishes the web surfing Seawind enthusiast who now may not be able to find Horizon Unlimited’s Seawind newsletter. One can imagine that a site containing “The Seawind Builders Newsletter” is *precisely* the result many surfers who input “Seawind” into an Internet search engine would be hoping for. They would be looking not only for SNA’s official site, but also sites discussing Seawinds, offering to sell accessories for Seawinds, advertising the capability to repair Seawinds, providing contact information for Seawind enthusiast clubs, and so forth. In each case, the term, “Seawind” in the site’s “Keywords” metatags would be part of an accurate description of the content of the site. In each case, the web surfer should not have to surmount judicially imposed barriers in order to find the site.

Taken at face value, the holding of *SNA* is even more extreme than that of *Brookfield*. I suggest, however, that it was the totality of the circumstances – not the least of which being Horizon Unlimited’s use of the domain name, “www.seawind.net” – that led Judge Katz to his hasty ruling that a site *discussing* another company’s product may not use the trademarked name of that product within its “Keywords” metatags, and that such a ruling will soon clearly be an outlier, regardless of whether or not the suggestions made by this paper are adopted.

K. SUMMARY OF THE CURRENT CASE LAW

Though there have still been very few cases considering the alleged improper use of trademarked terms within the metatags of non-trademark holders’ web sites, a number of important trends have emerged. First, the use of another company’s trademarked term(s) by a company with absolutely no purpose for using the term(s) other than to misleadingly associate itself with the company or organization holding the trademark – particularly when coupled with the use of a deceptive domain name – will be enjoined and damages may be assessed.¹⁵⁰ Second,

148. *Id.* at 562 (quoting *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1104).

149. See Mark Everett Chancey, *Meta-Tags and Hypertext Deep Linking: How the Essential Components of Webauthoring and Internet Guidance Are Strengthening Intellectual Property Rights on the World Wide Web*, 29 STETSON L. REV. 203, 208 n.31 (1999) (describing “stuffing” as the repetition of a word many times in a row within a site’s “Keywords” metatags in order to improve the site’s position within a search engine’s results list generated with relation to web surfer queries containing the repeated word).

150. See *New York State Soc’y of Certified Public Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999); *Playboy Enters. Int’l, Inc. v. Global Site Designs*,

courts have so far been erring on the side of overprotecting the rights of trademark holders.¹⁵¹ Finally, in the one case where the right of the non-trademark holder to use the trademarked terms was absolutely clear *and* was executed in good faith, Judge Keep allowed the use in a pair of detailed and cogent decisions.¹⁵²

V. ACADEMIC COMMENTARY

Just as there are is a dearth of case law addressing the trademark-metatag issue, there is not very much academic commentary dealing explicitly with the subject. However, as the number of cases being filed alleging Lanham Act violations by way of metatags grows, so grows the amount and variety of commentators' responses.

For the most part, articles written that address the subject of trademark disputes over the use of one company's trademarked terms in the metatags of another company's web site tend to do little more than recount the language and standard interpretations of the Lanham Act and describe the fact patterns and holdings of the few metatag cases decided thus far. There are, however, a few articles that offer their readers more probing analyses and even cogent suggestions for the manner in which the law ought to develop.

This section of the paper provides a broad overview of the academic commentary that currently exists in regard to the trademark-metatag issue. A number of representative pieces are briefly discussed, with more time spent on those articles with more to offer.

A. EARLY, PRESCIENT ARTICLES

The best example of an article ahead of its time on this issue is Marcelo Halpern's *Meta-Tags: Effective Marketing or Unfair Competition?*¹⁵³ In quite a short piece, Halpern lays out nicely a number of the issues just about to explode into the American judicial system. He examines trademark and unfair competition problems raised by the use of trademarked terms within metatags, and correctly anticipates that such use could give rise to infringement, dilution, and unfair competition suits

Inc., 1999 WL 311707 (S.D. Fla. 1999); *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102 (D. Mass. 1998); *Playboy Enters., Inc. v. AsiaFocus Int'l, Inc.*, 1998 WL 724000 (E.D. Va. 1998); *Playboy Enters., Inc. v. Calvin Designer Label*, 985 F. Supp. 1220 (N.D. Cal. 1997).

151. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999); *SNA, Inc. v. Array*, 51 F. Supp. 2d 554 (E.D. Pa. 1999).

152. See *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998) (preliminary injunction denied), *aff'd without op.*, 162 F.3d 1169 (9th Cir. 1998); 78 F. Supp. 2d 1066 (S.D. Cal. 1999) (summary judgment granted to defendant).

153. Marcelo Halpern, *Meta-Tags: Effective Marketing or Unfair Competition?*, 2 No. 7 CYBERSPACE LAW. 2 (October, 1997).

under United States law. Halpern even anticipates the application of "initial interest confusion" to the use of trademarked terms in metatags.¹⁵⁴

While, since it was written before the vast majority of the case law in the field existed, Halpern's article is really of very little use anymore, it remains a truly impressive piece of premonition.

B. ARTICLES TOUCHING ON THE TRADEMARK-METATAG ISSUE ONLY IN PASSING

There have been a number of articles written that deal with one or another aspect of trademark law as it relates to the Internet that also briefly touch on the metatag issue.

Jason R. Berne's *Court Intervention But Not in a Classic Form: A Survey of Remedies in Internet Trademark Cases*¹⁵⁵ is concerned mainly with the many domain name cases that have been decided recently. However, it does also provide a fairly detailed analysis of the facts and holdings of the PEI metatag cases, *Oppedahl & Larson*, and *Brookfield*.¹⁵⁶

Karen M. Shorofsky's *Advertising and Promotions on the Internet*¹⁵⁷ is a solid representative of the PLI offerings concerning the trademark issues arising in cyberspace. The article's coverage of the various issues is broad and shallow; the metatag cases are grouped together and their facts and holdings are listed very briefly.

Matthew A. Kaminer's *The Limitations of Trademark Law in Addressing Trademark Keyword Banners*¹⁵⁸ is an interesting article focusing on the keying of query terms entered into Internet search engines to the banner advertisements that appear on the results lists pages gener-

154. "However, a likelihood of confusion does not require the customer to be actually deceived upon arriving at the site; it may be sufficient to show that the customer was deceived by being drawn into the site in the first instance. The underlying premise of trademark and unfair competition law is that no one should be permitted to trade and profit off the good name or mark of another. Thus, when the search engine is 'deceived' into believing that Competitor's site is a relevant response to the search for Sample Co., and this information is furnished to the end user, there may be a likelihood of confusion as to the association or affiliation of the website to the company or product for which the end user was searching. The original misrepresentation to the search engine is the source of the confusion and the fact that Sample Co.'s distinctive mark was used to cause that confusion creates grounds for an action for trademark infringement." *Id.* at 4.

155. Jason R. Berne, *Court Intervention But Not in a Classic Form: A Survey of Remedies in Internet Trademark Cases*, 43 ST. LOUIS U. L. J. 1157 (1999).

156. *Id.* at 1178-88.

157. Karen M. Shorofsky, *Advertising and Promotions on the Internet*, 563 PLI/Pat 659 (1999).

158. Mathew A. Kaminer, *The Limitations of Trademark Law in Addressing Trademark Keyword Banners*, 16 SANTA CLARA COMPUTER & HIGH TECH. L. J. 35 (1999).

ated in response to the query. Kaminer argues that trademark keyword banners ("TKB") should not be seen as a violation of the Lanham Act, and he provides a favorable comparison of TKB to "manipulative metatagging" in order to support his argument.¹⁵⁹

C. ARTICLES OFFERING A GREATER LEVEL OF ANALYSIS AND/OR ARGUMENT

A relatively small number of articles have gone beyond listing the facts and holdings of the trademark-metatag cases and additionally offer analyses of how the law is performing and/or suggestions for the direction its development should take.

Brian Kennan's *Diverting Traffic on the Web*¹⁶⁰ offers both a solid technical primer on how metatags function within the architecture of the Internet and an evaluation of the judiciary's handling of the trademark-metatag cases so far. While Kennan's detailed analysis is limited to *Brookfield*, *Welles*, and *RMD*, he does strike out a position that so far the courts are properly fitting traditional trademark law to the Internet.¹⁶¹

Mark Everett Chancey's *Meta-Tags and Hypertext Deep Linking: How the Essential Components of Webauthoring and Internet Guidance are Strengthening Intellectual Property Rights on the World Wide Web*¹⁶² argues that dilution, rather than infringement, is the more suitable cause of action when one site incorporates within its metatags another company's trademarks.¹⁶³ The main thrust of his argument is that the basic "likelihood of confusion" test for an infringement claim will generally need to be twisted in order for courts to reach just results, whereas courts could reach the same results while remaining true to the notions of "blurring" and "tarnishment."¹⁶⁴ Chancey also expresses disappointment with the *Brookfield* court for twisting and expanding the scope of infringement rather than evaluating the case under the dilution framework.¹⁶⁵

Katherine E. Gasparek's *Applying the Fair Use Doctrine in Traditional Infringement and Dilution Cases to Internet Meta Tagging or Link-*

159. *Id.* at 45-53.

160. Brian Kennan, *Diverting Traffic on the Web*, 1999 INTERNET LAW & REGULATION SPECIAL REPORT 1 (1999).

161. *Id.* at 4-9 (arguing that all three cases were properly decided).

162. Mark Everett Chancey, *Meta-Tags and Hypertext Deep Linking: How the Essential Components of Webauthoring and Internet Guidance are Strengthening Intellectual Property Rights on the World Wide Web*, 29 STETSON L. REV. 203 (1999).

163. *See id.* at 222-27.

164. *See id.* at 223-24.

165. *See id.* at 226-27.

*ing Cases*¹⁶⁶ offers both a wonderful history of the development of the Internet¹⁶⁷ and a cogent argument that the traditional fair use defense, operating within the traditional trademark infringement and trademark dilution paradigms, is all that courts need to properly evaluate trademark-metatag (and trademark-hyperlink) claims.¹⁶⁸ Gasparek's conclusion, however, is more caveat than assertion:

Even though the Internet is an emerging and constantly growing phenomenon, traditional legal rules are nonetheless useful in resolving conflicts. The traditional defense of fair use in trademark infringement and dilution cases is flexible enough to apply to meta tagging and linking cases on the Internet, *as long as the court can easily identify good faith and lack of consumer confusion*. The fair use defense is not concretely defined and its application has always depended on the circumstances of the individual case. This lack of structure is frustrating for trademark holders and accidental infringers, and even possibly for the courts, but its very flexibility will allow it to extend to the utmost boundaries of Internet meta tag and linking controversies. The fair use defense will provide courts with the flexibility to determine if the facts of the case, including likelihood of confusion and good faith, support its use.¹⁶⁹

D. TRADEMARKS AS METATAGS: INFRINGEMENT OR FAIR USE?

Easily the best article written to date on the trademark-metatag issue is Thomas F. Presson & James R. Barney's *Trademarks as Metatags: Infringement or Fair Use?*¹⁷⁰ Presson and Barney argue strongly against a per se rule barring the use of "invisible trademarks" from non-holders' web sites,¹⁷¹ and suggest, less forcefully and less explicitly, that the use of others' trademarked terms within metatags should almost always be considered fair.¹⁷²

After articulating a rather strained argument that that the use of trademarked terms within metatags might not be, as required for liabil-

166. Katherine E. Gasparek, *Applying the Fair Use Doctrine in Traditional Infringement and Dilution Cases to Internet Meta Tagging or Linking Cases*, 7 GEO. MASON L. REV. 787 (1999).

167. *See id.* at 789-91.

168. *See id.* at 818-23. It should be noted that Gasparek wrote her article before Brookfield was decided.

169. *Id.* at 823 (emphasis added).

170. Thomas F. Presson & James R. Barney, *Trademarks as Metatags: Infringement or Fair Use?*, 26 AIPLA Q. J. 147 (1998). What is perhaps most impressive about this article is that it was written before either Brookfield or Welles was decided.

171. *See id.* at 149-50, 176.

172. *See id.* at 165-78.

ity under the Lanham Act,¹⁷³ “use in commerce” at all,¹⁷⁴ Presson and Barney proceed to consider briefly the availability of First Amendment defenses to the users of others’ trademarks within their metatags.¹⁷⁵ Not surprisingly, the authors conclude that such defenses would better serve a noncommercial user than a commercial user.¹⁷⁶

Presson and Barney then move on to the meat of their article: Fair Use.¹⁷⁷ In their fair use analysis, the authors attempt to show where the line should be drawn between “comparative advertising” and “deceptive advertising” in the trademark-metatag context.¹⁷⁸ They note that comparative advertising is not only allowed,¹⁷⁹ but is actively encouraged.¹⁸⁰ Presson and Barney thoughtfully explain the manner in which some uses of others’ trademarked terms in metatags should be viewed as protected comparative advertising:

The argument that some trademark metatag uses may be acceptable forms of comparative advertising depends on a preliminary analytical step. Rather than focusing on the actual inclusion of the trademark term in the metatag section of a Web site, one must look instead at the results of such inclusion. This analysis is logical given the unique environment in which metatags are used. Since they are not visible to ordinary users and can only be read by search engines in the context of HTML, then to the extent that metatags are used in commerce at all, such use is not manifested until a search engine actually reads the metatags in HTML and returns the results in user-readable form.

In practice, when a Web site operator inserts another company’s trademark name into the metatag section of her Web site, she is ensuring her site’s address will appear on any list generated by a user’s search request for the other company’s trademark name.¹⁸¹

The authors then proceed to note that this action is functionally indistinguishable from the “clustering” of like products that occurs in practically all brick-and-mortar stores,¹⁸² and that consumers would best be served if it were similarly allowed.¹⁸³

173. *See id.* at 154 (noting that, under the Lanham Act, there can be no liability unless “a threshold element of Sections 32(1), 43(a), and/or] 43(c) [is] met: a determination that the allegedly infringing mark was used in commerce.”).

174. *See id.* at 154-59.

175. Presson & Barney, *supra* note 170 at 159-63.

176. *See id.* at 160-63.

177. *See id.* at 164-78.

178. *See id.* at 164-72.

179. *See id.* at 164 (citing *Saxlehner v. Wagner*, 216 U.S. 375 (1910)).

180. *See id.* at 165 (noting that “the official policy of the Federal Trade Commission is to promote truthful comparative advertising”).

181. Presson & Barney, *supra* note 170 at 165-66 (footnote omitted).

182. *See id.* at 166-67.

183. *See id.* (noting that “[t]he ability of consumers to compare products ‘side-by-side’ is absolutely essential to the success of the Internet as an electronic marketplace.”).

Presson and Barney focus on the "likelihood of confusion" test as the limiting principal to their comparative advertising analysis.¹⁸⁴ They note their concern that "the unauthorized use of trademarks as metatags might fall prey to a judicial ruling that such use is likely to create confusion *per se*,"¹⁸⁵ and "argue that such a rule would be overly broad and unjustified."¹⁸⁶

Turning to "actual confusion," the authors note that there may indeed be consumer confusion generated by the results list returned by the search engine the web surfer has just utilized.¹⁸⁷ However, rather than quitting their analysis there, Presson and Barney continue to describe the three possible actions a web surfer could take when faced with a results list that includes multiple "hits":

At this point, the user may click any Web site address on the list to visit that site. With respect to consumer confusion, there are three possibilities: (1) the user actually thinks he is visiting the trademark owner's site, when in fact he is not; (2) the user is unsure as to the affiliation of the Web site but visits to "check it out;" or (3) the user knows that the site is not affiliated with the trademark owner but visits it anyway out of curiosity or genuine interest.¹⁸⁸

The authors then note that (3) is clearly not indicative of consumer confusion, and that (2) might be, before focusing their analysis on (1), the "worst-case situation."¹⁸⁹ In implicitly rejecting the application of "initial interest confusion" to the trademark-metatag context, Presson and Barney note that, except in the case where the consumer arrives at the defendant's web site under the misapprehension that she has come to the plaintiff's site and remains so confused through the time that she makes a purchase,¹⁹⁰ in the situation where any consumer confusion that existed during the results list stage has been cleared up before a purchase decision has been made, a cause of action should not exist.¹⁹¹

After noting that there may be cause to treat competitive, "discrete" uses of others' trademarks as metatags differently from "hit-seeking," "indiscriminate" uses,¹⁹² the authors set their sights on exposing "The Information Super Highway" as an "unfortunate moniker."¹⁹³ Noting

184. *See id.* at 167.

185. *Id.*

186. *Id.*

187. Presson & Barney, *supra* note 170 at 168-69.

188. *Id.* at 169.

189. *Id.*

190. In this situation, the authors would find liability for trademark infringement reasonable. *Id.* at 170.

191. *See id.*

192. Presson & Barney, *supra* note 170 at 170-72 (suggesting that "discrete" uses should be treated more leniently).

193. *Id.* at 173-74.

that highway analogies are now omnipresent in the Internet context, the authors take issue with the suggestion that because the hypothetical owners of a small bed and breakfast would not be allowed to erect a "Sheraton" billboard by the side of the highway, they should not be able to place "Sheraton" in their web site's "Keywords" metatags:

While technically correct, this analogy is not inclusive of all the possible legitimate uses that a bed and breakfast owner could make of a trademark metatag. For instance, why is it necessarily true that the insertion of the term "SHERATON (R)" in the bed and breakfast owner's Web site is equivalent to saying, "this way to the Sheraton"? It could also be interpreted to mean: (1) "if you are interested in the SHERATON (R), we have cheaper rates;" or (2) "our bed and breakfast is located just minutes from the SHERATON (R);" or (3) "if the SHERATON (R) is full, try us;" or (4) "three out of four travelers prefer us to the SHERATON (R)." Likewise, the bed and breakfast owner could simply erect his billboard right next to SHERATON (R)'s billboard (zoning laws permitting) so that drivers would be forced to look at both signs at the same time. All of these would be considered legitimate forms of comparative advertising and as such are encouraged under FTC policy.¹⁹⁴

The stark contrast between this thoughtful analysis and O'Scannlain's mechanical application of the highway analogy in *Brookfield*¹⁹⁵ cannot be missed.

In their final analysis, Presson and Barney stress the familiar mantra "that confusion, not competition, is the touchstone of trademark infringement."¹⁹⁶ The authors caution against a per se rule prohibiting the use of others' trademarks as metatags,¹⁹⁷ and argue that

In a situation in which a competitor distinguishes its Web site from a trademark owner's Web site, it would be unfair to limit consumer choice in selecting goods on the Internet to only well-known products. This practice would preclude a lesser known vendor from exposure to potential purchasers, who may actually be seeking the lesser-known vendor's goods.¹⁹⁸

VI. THE SOLUTION: A "TRADEMARKS" METATAG

Presson and Barney would allow web site owners to use others' trademarks as metatags so long as the non-holder of the trademark

194. *Id.* (footnote omitted).

195. *See supra* text accompanying note 84.

196. *Id.* at 176 (quoting *Mutual of Omaha Ins. Co. v. Novak*, 836 F.2d 397, 399 (8th Cir. 1987)).

197. *See id.* at 177. Had they foreseen it, it is quite likely the authors would also have cautioned against the application – adopted by the Brookfield court – of "initial interest confusion" to the trademark-metatag issue, as such a standard comes extremely close to serving as a de facto prohibition.

198. *Id.*

“distinguish[e] its Web site from [the] trademark owner’s Web site.”¹⁹⁹ Gasperek asserts that the fair use defense can carry the necessary water in this field, “as long as the court[s] can easily identify good faith and lack of consumer confusion.”²⁰⁰ My suggestion is that the way to satisfy both of these interests is to encourage the widespread implementation of a “Trademarks” metatag.

The standard utilization of a “Trademarks” metatag to complement the established “Keywords” metatag would allow the source-identification purpose of trademarks as metatags to be separated from their functional descriptive purpose. In so doing, it would create the possibility for simple, bright-line rules. The proposal this article offers is that within the “Trademarks” metatag a company would be allowed to list any and all terms in which it holds trademark rights and none in which it does not. The corollary of such a rule would be that the “Keywords” metatag could then be utilized by all web site owners to list those trademarks that they felt were in some way descriptive of the content of their sites, whether or not they held any rights in the trademarked terms, without fear that they would be perceived as infringing upon or diluting others’ trademarks.²⁰¹

The reason why this disaggregation of the functions currently served by trademarks as “Keywords” metatags would be salubrious is that it would allow consumers to make their preferences known more clearly to the search engines they use to navigate the Internet. For example, in the her second *Welles* opinion, Judge Keep noted that “both parties’ experts agree, that an ‘appreciable number’ of people who plug in one of Plaintiff’s trademark terms into a web browser search engine are ‘look-

199. *Id.*

200. Gasperek, *supra* note 164 at 823.

201. This arrangement would abrogate the necessity of relying on “initial interest confusion” in the trademark-metatag context. The “initial interest confusion” standard is a tricky one to apply, and does not mesh perfectly with the realities of cyberspace. As Judge Keep noted,

[o]ther courts cited by the *Brookfield* court which acknowledged initial interest confusion as being actionable under the Lanham Act have indicated that other factors are relevant in a finding of a confusing trademark use, or infringement. Among these are: (1) evidence of the initial interest confusion as being ‘damaging and wrongful,’ *Koppers Co. v. Krupp-Koppers GmbH*, 517 F.Supp. 836, 844 (W.D.Pa.1981); (2) evidence that confusion between two products ‘will mistakenly lead the consumer to believe there is some connection between the two and therefore develop an interest in the [defendant’s] line that it would otherwise not have,’ *Kompan A.S. v. Park Structures, Inc.*, 890 F.Supp. 1167, 1180 (N.D.N.Y.1995); or (3) evidence that the ‘situation offers an opportunity for sale not otherwise available by enabling defendant to interest prospective customers by confusion with the plaintiff’s product.’ See also *Sara Lee Corp. v. Kayser-Roth Corp.*, 1992 WL 436279, at *24 (W.D.N.C. Dec.1, 1992).

Playboy Enters., Inc. v. Welles, 78 F. Supp. 2d 1066, 1094.

ing for Playboy's official site."²⁰² Obviously, it is also true that some number of "people who plug in one of [PEI]'s trademark terms into a web browser search engine" are *not* searching for PEI's official site. That is, some web surfers who enter "Playboy" into their search engine of choice are looking specifically for the official PEI site; while others are simply looking for pictures of naked women and using "Playboy" as a logical proxy. As Judge Keep noted:

In rendering an analysis which is flexible and reflective of "emerging technologies," this court is also mindful that it must not lose sight of either common sense or the important, foundational and underlying principles of trademark law. Finding that Ms. Welles' use of PEI's trademarked terms in the metatags of her website is a fair use comports with the fact web users must utilize identifying words to find their intended site. *Not all web searches utilizing the words "Playboy," "Playmate," and "Playboy Playmate of the Year 1981" are intended to find "Playboy" goods or the official "Playboy" site.*²⁰³

Adding a "Trademarks" metatag to complement the "Keywords" metatag would allow both sets of web surfers to find their intended sites. For example, after entering "Playboy" into her favorite search engine, the surfer would then have the option of checking the search engine's "Trademarks Only" box before submitting her query request, and thus being fairly certain that his results list would contain only links to PEI's official site(s),²⁰⁴ or leaving the box unchecked and thus availing herself to a much larger results list that would contain non-PEI sites that wished to be considered by surfers who searched for "Playboy" not as a trademark, but as a descriptor.

As a means for encouraging compliance with this new standard, either Congress could create a cause of action for any company whose trademarked terms are used as "Trademarks" metatags in sites whose owners do not also hold rights in those terms, or courts could evaluate the actions of alleged trademark misusers in light of whether the appropriated terms were listed as "Keywords" metatags or "Trademarks" metatags, with a much harsher test presented to defendants who listed others' trademarked terms in their "Trademarks" section.²⁰⁵

202. *Playboy Enters., Inc. v. Welles*, 78 F. Supp. 2d at 1094.

203. *Id.* at 1095 (emphasis added).

204. Note that as terms can be trademarked by different companies in different lines of products, it is possible that the surfer searching for sites with a "Playboy" trademark only might find links returned to, e.g., "Playboy Golf Clubs" or "Playboy Toner Cartridges," as well as to PEI's official site(s).

205. The only viable defenses in such a situation would be (1) the defendant has a valid trademark in the term; and (2) the defendant had a reasonable and good faith belief that he had a valid common law trademark right in the term.

A. CONGRESS SHOULD CREATE A CAUSE OF ACTION

Obviously, one way to kickstart the implementation of a "Trademarks" metatag would be for Congress to create a cause of action for companies whose trademarked terms are used as "Trademarks" metatags in sites whose owners do not also hold rights in the terms.

Because of the greater flexibility, vis-à-vis the courts, that Congress possesses in dealing with emerging legal issues, this article suggests that a congressionally created cause of action would be the superior alternative for giving force to "Trademarks" metatags. Congress could establish either that such improper use would lead to liability with standard tort damages, or it could create a scheme of statutory damages. Congress could also assign to the evaluation of trademark-metatag infringement claims to adjudicatory bodies other than the courts. Finally, Congress could specifically limit the right of trademark licensing in this context.

1. *A Scheme of Statutory Damages Should Be Established*

Due to the problems of proof bound to arise in any attempt to evaluate tort damages based on a claim of metatag-trademark infringement, the suggestion offered here is that a statutory scheme be enacted. Variables to consider in establishing a matrix of statutory damages would be: the absolute number of infringing "Trademarks" metatags employed by the defendant, the length of time these metatags existed on the defendant's web site(s), the strength of the infringed trademark(s), and the defendant's reactions to any cease-and-desist letters issued by the plaintiff.

2. *ICANN Dispute Resolution Procedures Could Be Incorporated*

In addition to presenting the possibility for statutory damages, one other way in which a congressionally created cause of action would be superior to the alternative of industry adoption coupled with judicial evolution is that Congress could assign the evaluation of these claims to adjudicators other than the courts. One obvious possibility would be the creation of a new administrative agency to handle the adjudication of trademark-metatag claims. Perhaps a better option would be to create a very focused tribunal within the Patent and Trademark Office.

Quite possibly the best alternative, though, would be to piggyback on the Internet Corporation for Assigned Names and Numbers' "Uniform Dispute Resolution Process," which is currently serving to provide the framework for resolving controversies over rights to Internet domain names.²⁰⁶ As the ICANN-certified arbiters are already familiar with the

206. See Jeri Clausing, *Wrestling Group Wins Back Use of Its Name on Internet*, N.Y. TIMES, January 17, 2000, at C4.

intersection of trademark law and the Internet, albeit in a slightly different context, and as they can resolve these relatively straightforward one-issue disputes far more expeditiously and economically than can the judiciary,²⁰⁷ it would seem ideal to put ICANN's talents to use in evaluating trademark-mettag claims.

3. *Trademark Owners Should Not Be Permitted To License the Use of Their Trademarked Terms as "Trademarks" Metatags to Others*

While the licensing of trademarked terms from the trademark owners to other companies is generally permitted,²⁰⁸ it should be prohibited in this context. The necessity of this constraint becomes apparent as soon as one considers that different companies in different industries are permitted to trademark the same term, and that cross-licensing of trademarked terms between companies in separate industries could thus make the gains from establishing a "Trademarks" mettag illusory.

Consider, for example, a hypothetical cross-licensing arrangement between American Airlines and United Van Lines. When, in our world with "Trademarks" metatags, a consumer enters "United" into her favorite search engine and checks the "Trademarks Only" box because she is searching specifically for United Airlines' official site, it is bad enough that her results list is bound to contain United Van Lines' site; it would be simply ridiculous if it also contained American Airlines' site.

B. ALTERNATIVELY, WEB SITE DEVELOPERS AND COURTS COULD COLLABORATE TO CREATE A NEW STANDARD

In the event that Congress does not act in the manner recommended above, a second-best solution could still be effectuated by the combination of industry adoption of the "Trademarks" mettag and judicial recognition of its significance. Widespread use of the "Trademarks" mettag would allow courts to move beyond the fuzzy and ill-fitting "initial interest confusion" standard and establish bright-line rules that would both enhance consumers' ability to find the web sites they desire and provide courts and web site developers with clear boundaries between the permissible and the impermissible.

1. *Courts Should Focus on the "Use as Trademark" Element of the Fair Use Defense in Evaluating Trademark-Mettag Claims*

Since adding a "Trademarks" mettag to the "Keywords" mettag already widely used would allow for the disaggregation of the two func-

207. See *id.* (noting that the decision "was handed down in 40 days – at a cost of a \$1,000 filing fee plus lawyers' fees for the wrestling federation.").

208. McCARTHY, *supra* note 9, §3.04.

tions trademarked terms serve in the metatag context – source identification and site description – courts should focus their inquiries in trademark-metatag claims on whether plaintiffs' trademarked terms were indeed used *as trademarks* in determining whether or not to find liability in defendants. That the "Trademarks" section of a site's metatags would be architecturally distinct from its "Keywords" section would obviously ease this inquiry.

2. *An Improper Use in the "Trademarks" Section of a Site's Metatags Would Be Clear Evidence of Infringement*

The placing of a term in the "Trademarks" metatags section of a web site would present dispositive evidence that the site owner meant to use the term *as a trademark*. Once a plaintiff is able to show (1) that it holds a valid trademark right in the term at issue and (2) that the defendant has listed the term within the "Trademarks" section of the defendant's web site's metatags, the only question before the court would be whether or not the defendant also holds (or possibly, whether the defendant reasonably and in good faith believes that it holds) a valid trademark in the term at issue.

Since willfulness would be established by the very act of placing a term within the "Trademarks" section, if the defendant were not able to prove its trademark rights in the mark (or at least its good faith and reasonable belief that it held such rights), it would then be liable for damages.²⁰⁹

3. *Concomitantly, Use in the "Keywords" Section of a Site's Metatags of Any Term, Whether Trademarked by Another or Not, Should Be Permitted*

Particularly in those cases where the defendant has created a "Trademarks" metatags section and does *not* list the plaintiff's trademarked term(s) within that section, use of the terms in the defendant's "Keywords" metatags section should be allowed. Once the "description" function of the trademarked terms has been effectively separated from their "source identification" function by the introduction of the "Trademarks" metatag, there is simply no reason to prohibit a web site owner from using another's trademarks *not as trademarks*, but as descriptors.

Allowing web site owners to use others' trademarked terms as descriptors would mean that the web surfer who, for example, enters "Playboy" into her favorite search engine as a proxy for "naked women" to see the broad results list he desires. This result would obviously be good for the consumer. And trademark law is, after all, meant to protect

209. The defendant would, of course, also be enjoined from continuing to use the mark within its "Trademarks" metatags.

her from confusion, not to limit the scope of available products to which he can find reference.

VII. ANTICIPATED MARKET REACTIONS TO THE “TRADEMARKS” METATAG

The introduction of a legally significant “Trademarks” metatag will produce subtle but important shifts in the way the Internet search market operates. First, search engines will adjust their algorithms to take into account the new metatag. Second, they will offer to web surfers the option of narrowing their searches such that the search engine would seek only to match the consumer-entered search terms with “Trademarks” metatags. The direct result of these refinements would be that the web surfing public would be able to request searches in such a manner that the results lists returned would be more specifically tailored to their individual tastes.

A. SEARCH ENGINES WILL ADJUST THEIR ALGORITHMS AND OFFER “TRADEMARKS ONLY” OPTIONS

There are literally dozens of serious entrants in the hyper-competitive search engine market.²¹⁰ With the exception of www.iwon.com, which gives away cash prizes to its users as a marketing tool,²¹¹ these search engines are competing for eyeballs, and thus advertising income, solely on the elements of ease of use and accuracy of results. At this stage in their evolution, ease of use does not vary much from one search engine to the next. Accuracy of results is therefore the key competitive concern of Internet search engine owners.

If a “Trademarks” metatag were to acquire legal significance, and thus offer the potential for simply creating more narrowly tailored searches, the search engines would react at the speed of the Internet. First, they would likely afford more weight in their “standard” searches to “Trademarks” metatags than to “Keywords” metatags.²¹² Second, they would offer click-the-box options for the consumer who is really seeking just the official PEI site to differentiate herself from the surfer who has entered “Playboy” as a stand-in for “naked women.”

210. See Danny Sullivan, *The Major Search Engines and Directories*, (visited Mar. 19, 2000) <http://www.searchenginewatch.com/links/Major_Search_Engines/The_Major_Search_Engines/index.html>.

211. See *id.*

212. For example, “Playboy” listed once in the “Trademarks” section of a web site’s metatags would trump 1000 “Playboy”s in the “Keywords” section of another site’s metatags.

B. CONSUMERS WILL BE ABLE TO GET THE RESULTS LISTS THEY
REALLY WANT

The readily apparent outgrowth of any kind of refinement on the part of search engines is the ability of web surfers to perform more perfect searches. Since the establishment of a legally-significant "Trademarks" metatag would eventually lead to the ability of consumers to specify whether they are using search terms as trademarks or merely as descriptors, and since such designations would in turn prompt the return of more individually tailored results lists, the creation and utilization of a "Trademarks" metatag would have obvious benefits for the web surfing public.

VIII. CONCLUSION

The use of the "Keywords" metatags has presented a legal issue with which the courts will continue to grapple. Thus far, it appears that courts are prone to err on the side of overprotecting trademark rights.²¹³ This trend is likely to continue, perhaps even to accelerate, in light of Judge O'Scannlain's application of "initial interest confusion" to the trademark-metatag context.²¹⁴ The fallout from this overprotection will be that consumers who are entering trademarked terms into search engines as proxies for the generic descriptive qualities that those terms exemplify to the consumers²¹⁵ will receive less inclusive results lists than they would desire.

The creation and utilization of a "Trademarks" metatag would serve a number of purposes. First, it would allow for the creation of bright-line rules defining for adjudicators and web site developers what is and what is not permissible with regard to the use of others' trademarked terms in metatags. Second, these clear rules would make possible subtle but significant search engine evolution. Finally, and most importantly, the improved search engines would allow the web surfing public easier access to more specifically tailored results lists in response to their Internet search queries.

213. See *supra* Part IV.

214. See *supra* Part IV.G.

215. For example, a consumer using "Playboy" to stand in for "naked women" would not be using "Playboy" in its trademark sense.