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AN online shopper, conducting her holiday shopping, opens a Google search page and types in "Company A" as her query. Google returns a list of results based on that query but also includes a column of "Sponsored Links." Competitor "Company B" is prominently displayed as the first entry under the Sponsored Links. The online shopper sees Company B's sponsored advertisement and decides to click on that link instead of looking for Company A's link among the search results as she originally intended. At Company B's website, the shopper purchases a number of items and completes her holiday shopping. Now imagine this scenario repeated hundreds of times a day with online shoppers across the country and throughout the world, leading to a substantial redirection of Internet traffic from Company A to Company B.

This exact scenario has grown more frequent over the past several years and presents a thorny issue for online retailers. Many Internet shoppers use search engines such as Google and Yahoo! to locate online retailers. When a user enters a query, the search engine returns results based on the search terms (natural search results) and also provides a second column of websites under the title Sponsored Links in Google or Sponsored Results in Yahoo. These results often confuse shoppers and potentially divert a substantial amount of internet traffic away from its intended destination. At least one study has concluded that only one in six internet users can distinguish between natural search results and paid advertisements.¹



BY ALEXANDRA ROSS,
ANDREW LEIBNITZ, AND
EUGENE MAR

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PROTECTING
YOUR

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TRADEMARK FROM
BEING MISUSED ON



SEARCH
ENGINES



Search engines like Google and Yahoo! have created lucrative programs to sell keywords to companies and individuals who want to advertise their websites on these search engines. For instance, Google's AdWords program allows advertisers to purchase specific keywords for use as metatags.² When a user searches for those words, links to advertisers' websites appear in the Sponsored Links column of the search results page. Although many metatags are not visible to online users, they essentially publish the content of websites to search engines. More recently, Google has also unveiled its AdSense program, which analyzes a website and automatically generates conceptually related advertising. The related advertising appears in a bubble on the user's screen known as a parked page or advertising page and contains hyperlinks to the advertisers' websites. Each time a user clicks on one of these hyperlinks, the domain site owner receives a small click-through or pay-per-click fee.

Advertising programs like AdSense are growing in prominence, populating more than 80 percent of the typosquatting sites found in a recent study conducted by McAfee Avert Labs.³ A typosquatter registers a domain name that is a close misspelling of a popular domain name (e.g. *www.walmrat.com*) and attempts to capitalize on a user's mistake by placing advertising links such as AdSense on the typosquatter's site.

While none of the search engines specifically encourage a competitor to bid on another company's trademarks, they do not explicitly prohibit a competitor from purchasing and using trademarks that are owned by others.⁴ In fact, if you type in Wal-Mart into Google's keyword tool, it suggests eBay as a potential keyword to purchase. Keyword bidding presents a real danger that another person or entity could use a company's trademark to divert search engine traffic or even cannibalize the brand name. But measures exist to address this risk. This article examines the legal issues surrounding an advertiser's unauthorized use of trademarks in metatags and suggests business and legal measures that a company can employ to protect its trademarks.

The Legal Landscape

Congress created the Lanham Act to provide trademark holders with a legal recourse if their protected marks are being used by others without authorization:

1. 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



ALEXANDRA ROSS is director associate general counsel for Walmart.com USA, LLC. She manages ecommerce legal issues including licensing, intellectual property, advertising, privacy, compliance, and litigation for the internet division of Wal-Mart Stores, Inc. She serves as the cochair of the ACC San Francisco Bay Area Chapter Privacy/Ecommerce Committee. She can be contacted at aross@walmart.com.



ANDREW LEIBNITZ is an intellectual property partner at Farella Braun + Martel LLP, a Meritas member firm. Meritas is a non-profit alliance of more than 170 independent commercial law firms located in over 60 countries. Mr. Leibnitz represents some of the nation's most well-known corporations in legal matters and disputes regarding e-commerce, patents, trademarks, copyrights, and trade secrets. He can be contacted at aleibnitz@fbm.com.



EUGENE MAR is an associate with the intellectual property group at Farella Braun + Martel LLP. He litigates high-stakes patent and trademark infringement cases, drawing upon experience with clients in such fields as computer software, online retailing, manufacturing, banking and credit, computer hardware, and digital media. He can be contacted at emar@fbm.com.

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.

15 U.S.C. §1125(a); *see also* 15 U.S.C. §1114.

In order to prevail, trademark holders must prove that their trademark is protected, that another party used the trademark in commerce, and that this use of the trademark created a likelihood of confusion. However, courts have struggled with applying this traditional framework to the rapidly evolving world of the internet, and the applicability of the Lanham Act to the unauthorized usage of trademarks in a metatag.

Do Trademarks in Hidden Metatags Constitute a Use in Commerce?

Two leading decisions have focused on whether the use of a trademark in a hidden directory or metatag constitutes a use in commerce under the Lanham Act. In 2005, in *1-800 Contacts, Inc. v. WhenU.com*, 414 F.3d 400 (2d. Cir. 2005), the 2nd Circuit concluded that the use of 1-800 Contact's trademark in a hidden directory to trigger pop-up advertisements did not qualify as a use in commerce. When WhenU's software customers typed *www.1800contacts.com* in their web browser, WhenU's software recognized the trademark/domain name in its hidden directory and triggered a competitor's pop-up ad to appear on the screen.⁵ The 2nd Circuit described pop-up

ads as "[a] company's internal utilization of a trademark in a way that does not communicate it to the public" and compared such ads to "a[n] individual's private thoughts about a trademark."⁶ Because the trademark was not displayed to potential customers or third parties, the court found that WhenU's use of the trademark in a metatag to trigger pop-up ads did not infringe 1-800 Contact's trademark.⁷

The *1-800 Contacts* decision sent a strong message that trademarks in metatags hidden from the public view did not meet the use in commerce requirement of the Lanham Act, and some district courts subsequently followed that holding.⁸ However, other district courts departed from this view,⁹ culminating with the Eleventh Circuit's opinion this year in *North American Medical Corp. v. Axiom Worldwide Inc.*, 522 F.3d 1211 (11th Cir. 2008). In that case, when Google users typed in the trademarks "IDD Therapy" and "AccuSpina," the results page listed the plaintiff's website followed by a short description of the defendant's website that highlighted the two trademarks in question.¹⁰ The Eleventh Circuit split with the Second Circuit, stating that trademarks embedded in metatags *do* constitute a use in commerce.¹¹ The 11th Circuit also distinguished the 2nd Circuit opinion by contrasting the fact that the appropriated trademarks in question here were visibly displayed to online customers, whereas 1-800 Contacts' trademark was hidden from public view.¹² The *North American Medical* opinion also suggested that whether a trademark can be visibly seen is a fact relevant to likelihood of confusion, not use in commerce.¹³

Although the split between the courts creates ambiguity, there are facts that help identify cases that fall on each end of the spectrum. First, if the trademarks appear in the text, abstract description, or title of competitor's website, a stronger case for trademark infringement exists. Second, if a competitor's website fails to include a disclaimer on each page of the website clarifying the lack of connection with the trademarked keyword, an illusion of sponsorship emerges. Lastly, a court's understanding about how specific metatags function impacts judicial reasoning. Indeed, George Shingler of Axiom Worldwide attributed the defendant's loss in *North American Medical* to a failure to educate the court: "The guy who did the searches [for North American Medical] can't explain why my client came up in a Google search. He can't say if the metatag had an impact on how the search came up."¹⁴ Thus, the difference between whether a party is liable or not for trademark infringement will often turn on how well the court was educated about the functionality of the specific, accused metatag.

Does the Use of Trademarks in Metatags Create Initial Interest Confusion?

Some courts have found that the traditional likelihood of confusion analysis is inappropriate for search engine technology and have chosen to examine the issues under the doctrine of initial interest confusion. Under this theory, customers are initially confused by the competitor's use of the trademark, subsequently realize that the two entities are unrelated, but ultimately decide to complete the transaction with the competitor anyway. In this scenario, the competitor arguably used the trademark holder's good reputation to attract potential customers. Courts have repeatedly held that initial interest

confusion is also actionable under the Lanham Act.

In *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999), West Coast Video created a metatag with the trademark "MovieBuff" that belonged to a competing online video store by the same name. When a consumer entered MovieBuff into a search engine, the search results displayed both MovieBuff and West Coast Video's websites.¹⁵ The Court noted that a consumer could find MovieBuff's website by simply scanning all the search results on the page.¹⁶ Even if the consumer clicked on the competitor's website, the Court acknowledged that "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 website."¹⁷ Nevertheless, the Court concluded that the competitor's use of the trademark "in metatags will still result in what is known as initial interest confusion." "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 website, West Coast improperly benefits from the goodwill that Brookfield developed in its mark."¹⁸ Thus, the Court enjoined West Coast from using MovieBuff in its metatags.

In contrast, at least one district court has stated that initial interest confusion is a "material mischaracterization of the operation of Internet search engines."¹⁹ Because potential consumers are never taken by a search engine to a competitor's website, there is no initial source confusion.²⁰ The court determined that Sponsored Links are just one of many choices for potential consumers to investigate, and that it is unreasonable to assume that consumers will be confused simply by the fact that Sponsored Links exist.²¹ Although this district court opinion appears to be a unique aberration at this point, this issue will surely arise again in the future.

Are Search Engines Liable for Supporting Keyword Advertising?

Over the past year, litigants have begun suing search engines that supported keyword advertising on the theory that they are directly or indirectly committing trademark infringement. One of the first cases involved American Airlines accusing Google of contributing to trademark infringement by selling American's registered trademarks, including "American Eagle," "American Airlines," "AA," and "AAdvantage," as keywords.²² As a result, when a user typed in any one of American's registered marks in Google's search engine, the results page returned a number of paid advertisers' websites under the Sponsored Links section. The parties settled this litigation before it proceeded into any substantive stage. Subsequent to this litigation, Google has removed all Sponsored Links related to any

of American's trademarks. In October 2008, American Airlines filed a near-identical suit against Yahoo!.²³ In the second complaint, American alleges that Yahoo! has the ability to prevent third parties from purchasing trademarks as keywords because Yahoo! does not permit this practice in Europe.²⁴ Finally, a group of businesses filed a putative class action suit against Google in 2007, accusing Google of contributing to trademark infringement and being unjustly enriched by the use of AdSense on typosquatters' websites.²⁵ Both the putative class action and the case against Yahoo! are currently pending. The passage of each successfully settled case against Yahoo! and Google may invite and embolden other companies to follow suit and sue these search engines to stem the tide of keyword advertising.

Is There a Nominative Fair Use Defense?

Some online retailers defend use of trademarked metatags as being analogous to putting two competing products side-by-side in a store shelf, and thus conducive to competition. Using a competitor's trademark to identify your own products is permissible under a theory known as nominative fair

use. Courts have found nominative fair use only when:

- a company's own product is not readily identifiable without the trademark,
- only so much of the trademark may be used as is reasonably necessary, and
- the user did nothing that would suggest sponsorship or endorsement by the trademark holder.²⁶

A dispute between Trans Union and Credit Research in 1999 led to one of the first court decisions addressing whether the use of trademarks in metatags can qualify as nominative fair use. Credit Research's website offered comprehensive credit reports to online customers, and Credit Research was contractually authorized to draw some of its data from Trans Union's database. The court decided that Credit Research's use of "Trans Union" as a metatag for its website was fair use since Credit Research collected information from Trans Union's credit database.²⁷ The court also noted that Credit Research was not cyberstuffing or trying to raise its page rank since it limited its usage of the Trans Union trademark to only one metatag.²⁸

The Ninth Circuit offered an in-depth analysis of the

ACC Extras on... Trademarks

Article

Trademarks and the Internet (2002). Some basics and recent developments; originally presented at the MCCA CLE Expo in April 2002. www.acc.com/resource/v3492

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nominative fair use defense in *Playboy Enterprises, Inc. v. Terri Welles, et al.*, 279 F.3d 796 (9th Cir. 2002). Ms. Welles, a former Playmate of the Year, created a website that included the trademarks “Playmate of the Year,” “Playboy,” and “Playmate” as headlines, banner ads, words on a wallpaper, and in metatags.²⁹ The court determined that Ms. Welles only used the marks in good faith to identify and describe herself.³⁰ Indeed, the court found that there was no other way for Ms. Welles to identify herself as a former Playmate and Playmate of the Year without using those trademarks.³¹ Welles was credited with refraining from using the Playboy insignia, the bunny logo, or the Playboy font.³² Welles also inserted disclaimers on every page of her website stating that her site was not affiliated or sponsored by Playboy.³³

One year later, the Ninth Circuit elaborated on the nominative fair use defense. A company placed its competitor’s trademark, Pycnogenol, as a metatag on its website to sell its own competing pine bark extract.³⁴ After the plaintiff sued for trademark infringement, the defendant argued that this was nominative fair use. The court disagreed, finding that the trademark had been willfully infringed. The court cited to the fact that the defendant failed to place any disclaimers on its website, and the metatags would lead potential customers to arrive at the defendant’s website and think that plaintiff sponsored the defendant’s products.³⁵

The issue of nominative fair use continues to arise in courts across the country, and two factual questions appear to permeate all these cases.³⁶ First, companies need to include disclaimers on every page of their website if they intend to use another company’s trademark to promote their own products. Second, as the *Trans Union* and *Playboy* courts suggested, the trademark should be limited to one metatag to qualify as fair use. If either of these limitations is not practiced, the nominative fair use defense is likely to fail.

Recommendations for In-house counsel

Protecting your trademark on the internet requires a combination of business and legal solutions. There is no perfect solution, and each option varies in cost and efficacy. Nonetheless, every company should conduct a cost-benefit analysis as to what combination provides the best return for their investment, and in-house and outside counsel should consider the following recommendations when advising on best options.

Protecting Your Trademark Through Litigation

Pursuing litigation can be risky and costly, but it presents the only option where a trademark holder can recover monetary damages and enjoin the infringer from using a company’s registered trademark. If an entity uses a trademark in its ad text or title, there is a stronger case that this constitutes trademark infringement. If a trademark holder chooses to sue an entity for its use of a trademark as a metatag, the case

is more difficult. Selecting the proper venue is an important first consideration because, as discussed above, different courts have often arrived at different conclusions. In addition, it is vital for both plaintiffs and defendants to educate the court early on about how the metatags in question function. If you are the trademark holder, you should argue that the use of your trademark in a metatag infringes under both the traditional likelihood of confusion analysis and the initial interest confusion framework. You will need to demonstrate this to the court so they understand how a company embeds your trademark in metatags to generate search results/hits when keyword searches are entered into a search engine. Plaintiffs should introduce evidence that search results which include both natural search results and paid advertisements confuse online users. Such evidence can come in many forms, including: surveys and/or expert testimony, consumer focus groups, parties’ marketing budgets, empirical evidence found in materials published by trade associations, statistics tracking consumer use of defendant’s sponsored link, and empirical studies of general internet use.

If you’re the defendant, you will want to educate the court about the myriad types of metatags and convey the message that not every metatag operates in the same manner. For instance, a defendant may convince a court that a descriptive metatag that merely summarizes the content of a website as part of abstract, as opposed to a metatag that triggers search engine results, does not create consumer confusion. Other courts, such as the ones in the *J.G. Wentworth* and *1-800 Contacts* cases, have refused to find trademark infringement where the metatags can only be seen by search engines and are not visible to online users. A court’s grasp on the exact function performed by a defendant’s metatag could mean the difference between whether the court finds that there was initial consumer confusion or use in commerce as defined by the Lanham Act.

Protecting Your Trademark Through Business Options

For any company that conducts internet commerce or runs the risk of having its trademarks misused by keyword bidding, a strong intellectual property policy is mandatory. An important component of this policy is a robust search-monitoring service. Companies such as LinkShare, Semonics and AdGooRoo provide a wide range of services that monitor keyword usages hourly or daily on Google, Yahoo!, and MSN. The search-monitoring services can also monitor usage of trademarks and negative matches³⁷ in URLs, titles of advertisements, and descriptions of websites that appear in search results. The services provide reporting regarding which region or country is generating the keyword hits and what order the sponsored links appear on the search-results pages. By monitoring negative matches, you can learn how much traffic is being diverted through negative matches

and to what extent your brand is being cannibalized. All of this information will help fully inform you as to how your trademark is being used and what persons or entities are committing the violations. While hiring a search-monitoring service can be expensive, some online retailers have defrayed these costs by entering into an arrangement whereby some percentage of revenue generated from search engine traffic is shared with the monitoring service.

Google's AdWords trademark complaint procedure presents one of the most cost-efficient mechanisms for a company to protect its trademark.⁵⁸ If a company submits a complaint form to Google listing its protected trademarks, Google will investigate the Sponsored Links to determine if the protected mark is being used in the ad text. Once Google determines that a paid advertiser is using the trademark, Google will require the advertiser to remove the trademark from the ad text and prevent them from using it in the future. Future applicants who wish to use the trademark as part of their ad text will need express authorization from the trademark holder. However, Google's service does *not* investigate or require removal of a trademark in an advertiser's keyword metatags.⁵⁹ In addition, a company does have to undertake substantial administrative and overhead costs to identify these issues and submit them to Google as search engines do not automatically scour the Web to screen for trademark compliance.

Another cost-efficient solution may be to approach your competitors and agree not to bid on each other's respective trademarks and negative matches as a keyword. Although written agreements cause the least misunderstanding, even oral agreements between business executives could stem the tide on competitive keyword bidding. However, this option may only be available to online retailers with significant market power and brand recognition. In addition, a gentleman's agreement among competitors can be a moderately risky zero-sum game where, as soon as one party decides to breach the agreement, the entire agreement falls apart. Additionally, attention must be paid to any antitrust concerns as agreements among competitors with market power to refrain from any sort of commercial activity must be carefully crafted.

A strong intellectual property plan should also include a standard vendor contract where business partners and advertising affiliates are precluded from bidding on your trademarks and negative matches. To further support this policy, a search monitoring services can track affiliates' internet traffic generated by keyword searches to ensure that they are not bidding and using your company's trademarks in metatags to generate internet traffic. Although advertising affiliates help promote an online retailer's website by posting advertisements and hyperlinks for that retailer on

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the affiliates' own websites, they are often the first bidders on your trademarks or negative matches. Because affiliates are typically compensated by the amount of click-through traffic they generate, they hope to increase traffic to their own site(s) by using trademarks or negative matches as metatags. Finally, although costly and perhaps not always administratively feasible, a company could always try to bid on its own trademark and negative matches to protect it from being used by other companies.

Regardless of what solution a trademark holder pursues, effective trademark protection on the internet requires vigilance and an investment of human and monetary resources. The implementation of a robust intellectual property plan that polices its business partners and monitors its competitors' usage of keywords effectively prevents large diversion of search-engine traffic and preserves the strength of your company's brand. ❏

Have a comment on this article? Email editorinchief@acc.com.

NOTES

- 1 See Fallows, Deborah. "Search Engine Users," Pew Internet & Am. Life Project II (2005), at www.pewinternet.org/pdfs/PIP_Searchengine_users.pdf (last visited Sept. 22, 2008).
- 2 A metatag is "an HTML tag that contains descriptive information about a webpage and does not appear when the webpage is displayed in a browser. A word that is in a metatag of a webpage will cause that webpage to turn up as a result of a search engine's search on that word, even if that word is not found in the webpage as viewed in a browser." *The American Heritage Science Dictionary*.
- 3 Edelman, Benjamin. "Unintended Adventures in Browsing," *McAfee Security Journal* 34, 36 (Fall 2008).
- 4 Google's stated policy is that each party is "responsible for the keywords you select and for ensuring that [the] use of the keywords does not violate any applicable laws." For more information, please refer to <https://adwords.google.com/select/KeywordToolExternal?defaultView=2>.
- 5 *1-800 Contacts, Inc. v. WhenU.com*, 414 F.3d 400, 404 (2d Cir. 2005).
- 6 *Id.* at 409.
- 7 *Id.* at 410.
- 8 See, e.g., *Merck & Co., Inc. v. Medioplan Health Consulting, Inc.*, 425 F. Supp. 2d 402 (S.D.N.Y. 2006) (act of purchasing ZOCOR mark for keyword advertising is not use in commerce because the mark was never displayed to the public); *Fragrancenet.com, Inc. v. Fragrancex.com, Inc.*, 493 F. Supp. 2d 545 (E.D.N.Y. 2007).
- 9 See, e.g., *Buying for the House, LLC v. Humble Abode, LLC*, 459 F. Supp. 2d 310 (D.N.J. 2006) (where defendant purchased competitor's mark to generate sponsored advertising for its competing furniture products, Court finds this to be a use in commerce even though the mark was not visible in text of advertisement); *Edina Realty, Inc. v. TheMLSOnline.com*, 2006 WL 737064 (D. Minn. Mar. 20, 2006); *J.G. Wentworth, S.S.C. Limited Partnership v. Settlement Funding LLC*, 2007 WL 30115 (E.D. Pa. Jan. 4, 2007).
- 10 *North Am. Medical Corp. v. Axion Worldwide, Inc.*, 522 F.3d 1211, 1220 (11th Cir. 2008).
- 11 *Id.* at 1219 n.6.
- 12 *Id.* at 1219 n.6.
- 13 *Id.* at 1219-20.
- 14 MacLean, Pamela A. "Courts Show Confusion Over Uses of 'Metatags'", *National Law Journal* at 6 (June 9, 2008).
- 15 *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999).
- 16 *Id.*
- 17 *Id.*
- 18 *Id.*
- 19 *J.G. Wentworth, S.S.C. Limited Partnership v. Settlement Funding LLC*, 2007 WL 30115, at *7 (E.D. Pa. Jan. 4, 2007); see also *Gov't Employees Ins. Co. v. Google Inc.*, 2005 WL 1903128 (E.D. Va. Aug. 8, 2005).
- 20 *J.G. Wentworth*, 2007 WL 30115 at *7.
- 21 *Id.*
- 22 See *American Airlines, Inc. v. Google, Inc.*, No. 4:07-cv-00487 (N.D. Tex.).
- 23 See *American Airlines, Inc. v. Yahoo! Inc., et al.*, No. 4:08-cv-00626 (N.D. Tex.).
- 24 *Id.*
- 25 See *Vulcan Golf LLC v. Google, Inc., et al.*, No. 1:07-cv-03371 (N.D. Ill.).
- 26 *New Kids on the Block v. News America Publ'g*, 971 F.2d 302, 308 (9th Cir. 1991).
- 27 *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029, 1040 (N.D. Ill. 2001).
- 28 *Id.* at n. 8.
- 29 *Playboy Enterprises, Inc. v. Terri Welles, et al.*, 279 F.3d 796, 801 (9th Cir. 2002).
- 30 *Id.* at 802-03.
- 31 *Id.*
- 32 *Id.*
- 33 *Id.* at 803.
- 34 *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036 (9th Cir. 2005).
- 35 *Id.* at 1041.
- 36 See *Syncsort inc. v. Innovative Routines Int'l Inc.*, 2008 WL 1925304 (D.N.J. Apr. 30, 2008) (finding fair use existed for trademark used in a metatag); *Designer Skin LLC v. S&L Vitamins Inc.*, 2008 WL 2116646 (D. Ariz. May 20, 2008) (accord); *Standard Process Inc. v. Banks*, 2008 WL 1805374 (E.D. Wis. Apr. 18, 2008) (accord); Cf. *Standard Process, Inc. v. Total Health Discount, Inc.*, 2008 WL 2337279 (E.D. Wis. June 6, 2008) (finding infringement where trademark was used in multiple metatags without any disclaimers).
- 37 Keywords that consist of a combination of a company's registered trademark and another word are commonly known as "negative matches." Examples include keywords such as "Walmart Electronics" or "Walmart Books."
- 38 For more information on Google's trademark complaint procedure, please refer to www.google.com/tm_complaint_adwords.html#auth/
- 39 Google recently stopped checking the usage of trademarks registered in the United Kingdom or Ireland in keyword metatags because they "want advertisers to use keywords that are most relevant to their business and our user's interests. Google's goal is to provide our users with the most relevant information, whether it is from our search results or advertisements. A key to achieving this goal with our ads is providing relevant choices and giving users the opportunity to determine which ads they find most relevant." <https://adwords.google.com/support/bin/answer.py?answer=92877>

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