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SEARCH ENGINE MANIPULATION: CREATIVE USE OF METATAGS OR TRADEMARK INFRINGEMENT?

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I. INTRODUCTION

The exponential growth of the World Wide Web^{40 IDEA 451) and footnotes(n1);.FTNT n1} has had a profound impact on commerce. This popularity boom, however, gives rise to novel intellectual property issues, the contours of which have yet to be defined. When lawsuits arise, courts and attorneys are forced to grapple with legal ambiguities in modern Internet problems such as hyperlinking, cybersquatting, and metatagging.^{40 IDEA 451) and footnotes(n2);.FTNT n2} Such issues are of first impression for many courts, and yet judicial responses have largely been rooted in the past.^{40 IDEA 451) and footnotes(n3);.FTNT n3} Does the Internet's characteristics make application of established laws problematic? Should result-oriented courts find a means to apply established laws, or should Congress enact specific legislation to sufficiently protect intellectual property rights on the Internet?

Although applications of copyright and trademark law to Internet issues have been successful in several instances, the use of trademark laws in the metatag context is an awkward fit. While the law of trademarks, under the Lanham Act of 1946^{40 IDEA 451) and footnotes(n4);.FTNT n4} and common law, is well-developed, Internet law is not. Generally, the purpose of trademark law is to protect the goodwill associated with a business. source-identifying mark from piracy and customer confusion.^{40 IDEA 451) and footnotes(n5);.FTNT n5} Metatags are the hidden codes that identify a web site.^{40 IDEA 451) and footnotes(n6);.FTNT n6} Because the use of another's trademarks in a site's metatags are typically not seen by customers, a fundamental problem arises with regards to source identification and customer confusion.^{40 IDEA 451) and footnotes(n7);.FTNT n7} This problem has properly been labeled as "invisible infringement."^{40 IDEA 451) and footnotes(n8);.FTNT n8} Are customers likely to be confused as to the source of goods and services even when their

trademarks are not in view? Does it matter that the improper use of metatags is designed to confuse search engines, rather than customers? Is the problem further exacerbated by the global reach of the Internet?

Part of the inadequacy in protecting trademarks used on the Internet was remedied in the cybersquatting context when Congress enacted the Anticybersquatting Consumer Protection Act.^{40_IDEA_451)_and_footnotes(n9);.FTNT n9} The new law strengthens the rights of trademark holders by prohibiting others from registering, in bad faith, well-known marks as Internet domain names.^{40_IDEA_451)_and_footnotes(n10);.FTNT n10} Specifically, the law seeks to prevent others from registering a domain name that is identical to, confusingly similar to, or dilutive of a trademark.^{40_IDEA_451)_and_footnotes(n11);.FTNT n11} However, why should Congress stop here when Internet businesses are infringing registered marks in the metatag context? Should Congress remedy the deficiency by strengthening trademark rights and providing trademark owners with an avenue to seek damages against metatag infringers?

Before deciding on a remedy, it is important to understand that the burgeoning amount of information on the Internet has given rise to a reliance on search engines as an information retrieval tool.^{40_IDEA_451)_and_footnotes(n12);.FTNT n12} Search engines use a web site's metatags as the primary means of identifying and associating the site to the keywords of a web surfer's search.^{40_IDEA_451)_and_footnotes(n13);.FTNT n13} Web designers are aware of this association and attempt to bury trademarked terms in the web site's metatags to increase customer traffic.^{40_IDEA_451)_and_footnotes(n14);.FTNT n14} Such infringing uses render searches imprecise and results over-inclusive.^{40_IDEA_451)_and_footnotes(n15);.FTNT n15} Therefore, the tidal wave of information and the improper use of metatags have made information retrieval by search engines inefficient.^{40_IDEA_451)_and_footnotes(n16);.FTNT n16} Should Congress respond to this inefficiency, or can this inefficiency be remedied by the courts. application of trademark law?

Without congressional guidance, courts and attorneys have struggled to apply trademark law as a remedy against the metatag infringer. Until recently, this application was awkward and inadequate to protect trademark rights on the Internet. As we will see, the first cases addressing the issue provided very little guidance. However, by applying the pre-sale confusion doctrine in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,^{40_IDEA_451)_and_footnotes(n17);.FTNT n17} the U.S. Court of Appeals for the Ninth Circuit provides a judicial response that is congruent with established laws and lessens the need for a congressional response.^{40_IDEA_451)_and_footnotes(n18);.FTNT n18}

Before advocating a remedy, this article provides a review of the Internet and the current state of the law. The review begins in Part II, which explores the development of the Internet, web sites, search engines, and metatags. Part II also explains how search engines use metatags to identify particular web sites. Part III explains the current state of federal trademark infringement and dilution laws. Part IV then charts the development of metatag jurisprudence and exposes the awkwardness courts have experienced in applying established trademark law to the metatag problem. Part V examines the Ninth Circuit's

response in Brookfield and concludes by advocating the use of the pre-sale confusion doctrine as a remedy to the metatag infringer.

II. THE INTERNET

What is known today as the Internet was at first a military communication system developed during the Cold War.^{40 IDEA 451) and footnotes(n19);.FTNT n19} Its purpose was to provide interconnected government computers with a network of redundant communication channels that made communication possible even if some of the channels were damaged by war.^{40 IDEA 451) and footnotes(n20);.FTNT n20} Communication between separate computers is possible via common data transfer protocols.^{40 IDEA 451) and footnotes(n21);.FTNT n21}

Today, the Internet has become an international medium for commerce and information and operates under the same principles of interconnectability and common data transfer protocols.^{40 IDEA 451) and footnotes(n22);.FTNT n22} In its initial commercial uses, the Internet was considered a passive environment which users accessed only to gather information from newsgroups, mailing lists, or to communicate via e-mail.^{40 IDEA 451) and footnotes(n23);.FTNT n23} The Internet's application to commerce has fueled its growth to become an interactive network which not only provides information but also goods, services, and entertainment internationally.^{40 IDEA 451) and footnotes(n24);.FTNT n24}

In 1981, there were less than 300 computers linked to the Internet.^{40 IDEA 451) and footnotes(n25);.FTNT n25} However, at the end of the 1980.s, there were approximately 90,000 computers connected to the Internet.^{40 IDEA 451) and footnotes(n26);.FTNT n26} By 1993, that number had reached a million, and just three years later, there were over 9,400,000 computers linked to the Internet.^{40 IDEA 451) and footnotes(n27);.FTNT n27} Counting the number of people who access the Internet with personal computers in 1996 provides a total of about 40 million people worldwide.^{40 IDEA 451) and footnotes(n28);.FTNT n28} By the end of the millennium, that number was estimated to soar above 200 million.^{40 IDEA 451) and footnotes(n29);.FTNT n29} Moreover, as a testament to the increasing importance of Internet commerce, in 1995 there were about 100,000 domain names; that number exploded to 4.8 million at the beginning of 1999.^{40 IDEA 451) and footnotes(n30);.FTNT n30}

The most common method of accessing the Internet is through a commercial Internet service provider that offers modem or other telephone access to a computer linked to the network or to the Internet itself.^{40 IDEA 451) and footnotes(n31);.FTNT n31} Many of these providers, such as America Online, CompuServe, and Prodigy, provide access to the Internet for a monthly fee or hourly rate. Once on the Internet, there are various forms of communication, such as e-mail, listserv, and the World Wide Web, just to name a few.^{40 IDEA 451) and footnotes(n32);.FTNT n32}

Besides e-mail, the Web is the most widely used and fastest grow-ing part of the Internet.^{40 IDEA 451) and footnotes(n33);.FTNT n33} It is a collection of information contained in documents on separate computers around the world, and it operates on a computer language called hypertext markup language ("HTML").^{40 IDEA 451) and footnotes(n34);.FTNT n34} With HTML, computer

programs that browse or surf the Web, such as Netscape Navigator or Microsoft's Internet Explorer, can display documents containing text, graphics, sounds, and moving videos.40_IDEA_451)_and_footnotes(n35);.FTNT n35

The individual documents on the separate computers are called web sites.40_IDEA_451)_and_footnotes(n36);.FTNT n36 To better organize the display of information on a site, each site may have several individual web pages each linked together with a device or associating tool called a hyperlink.40_IDEA_451)_and_footnotes(n37);.FTNT n37 Hyperlinks enable the web user to easily move from page to page within the web site and retrieve information without having to perform complex searches.40_IDEA_451)_and_footnotes(n38);.FTNT n38 Some hyperlinks provide access to other web sites that contain common information. The very nature of these hyperlinks and interconnections between web pages and other web sites gives rise to the term "Web".40_IDEA_451)_and_footnotes(n39);.FTNT n39

There are several ways to access specific web sites. If users know the web site's address or domain name, they can enter it in the web browser's address window.40_IDEA_451)_and_footnotes(n40);.FTNT n40 If not, users can enter one or more keywords or search terms into a commercial search engine, such as Yahoo, Lycos, or Webcrawler, to name a few.40_IDEA_451)_and_footnotes(n41);.FTNT n41 Common to each search engine are programs called spiders or crawlers that collect web site addresses.40_IDEA_451)_and_footnotes(n42);.FTNT n42 Once collected, these programs index the web sites by analyzing the displayed text, titles, and addresses so that search engines can associate a user's search terms with the indexed web sites.40_IDEA_451)_and_footnotes(n43);.FTNT n43 When conducting a search, search engines, comb through their databases and return a list of related web sites or "hits" with the corresponding hyperlinks.40_IDEA_451)_and_footnotes(n44);.FTNT n44

Aside from analyzing and associating a web site's text, title, and address, search engines primarily use metatag keywords in the indexing process.40_IDEA_451)_and_footnotes(n45);.FTNT n45 Metatags are buried in the web site's HTML codes and are typically hidden from view.40_IDEA_451)_and_footnotes(n46);.FTNT n46 There are different types of metatags, but those of concern are the types that web page designers specifically use to identify and describe the web site.40_IDEA_451)_and_footnotes(n47);.FTNT n47 Search engines primarily use metatags as an associating tool, for they are often unable to properly index a web site based on the text, title, and address alone.40_IDEA_451)_and_footnotes(n48);.FTNT n48 This metatag indexing process is similar to an index card for a library's card catalog system.40_IDEA_451)_and_footnotes(n49);.FTNT n49 Sony's web site, for example, contains the metatags:

Sony, music, Columbia, Epic, movies, motion picture, Columbia, Tri-Star, home theater, electronics, mini-disc, minidisc, walkman, VAIO, vaio, computers, Playstation, playstation, The Station, station, games, television, video games, A/V, entertainment, home video, shopping, shop, mall, buy, products, services, questions, store.40_IDEA_451)_and_footnotes(n50);.FTNT n50

These metatags, comprised of trademarked terms and non-trademarked terms, are used to describe the web site so that web surfers that enter any of the terms into a search engine can easily find Sony's site when conducting a search.

The problem, however, arises when web site owners improperly use another's trademark in their site's metatags to cause search engines to associate the sites with those trademarked businesses. For instance, would Sony be liable for trademark infringement if it had placed the term "Panasonic" in its metatags? Moreover, by repeatedly placing trademarks in a site's metatags, it is likely that the web site will appear high on a list of results generated from a search.^{40_IDEA_451)_and_footnotes(n51);.FTNT n51} This higher priority, as we will see, has spawned at least one lawsuit.

III. THE LANHAM ACT

A. Trademark Infringement

To understand the legal impact of the improper use of trademarks in metatags, a review of the current state of the law is necessary. The Supreme Court has articulated the fundamentals of trademark law by stating that its objective is to

prevent[] others from copying a source-identifying mark, which "reduces the customer's costs of shopping and making purchasing decisions," for [this process] quickly and easily assures a potential customer that this item -- the item with this mark -- is made by the same producer as other similarly marked items that he or she liked (or dis-liked) in the past. At the same time, the law helps assure a producer that it (and not an imitating competitor) will reap the financial, reputa-tion-related rewards associated with a desirable product.^{40_IDEA_451)_and_footnotes(n52);.FTNT n52}

As an initial matter, a federally registered trademark is a mark that provides the registrant with its exclusive use in commerce or in connection with the goods or services specified in the registration.^{40_IDEA_451)_and_footnotes(n53);.FTNT n53} Specifically, a trademark is defined as:

Any word, name, symbol, or device, or any combination thereof.

(1) used by a person, or

(2) which a person has a bona fide intention to use in commerce and applies to register on the principal register . . . , to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.^{40_IDEA_451)_and_footnotes(n54);.FTNT n54}

To prove trademark infringement a registered holder must prove that:

Any person who shall, without the consent of the registrant.

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.^{40_IDEA_451)_and_footnotes(n55);.FTNT n55}

Congress has also defined the use in commerce requirement:

A mark shall be deemed to be in use in commerce.

(1) on goods when.

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce, and

(2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.^{40_IDEA_451)_and_footnotes(n56);.FTNT n56}

Therefore, to succeed on a federal trademark infringement claim, complainants must prove: 1) they have a valid, protectable trademark;^{40_IDEA_451)_and_footnotes(n57);.FTNT n57} 2) the infringer used the mark in commerce;^{40_IDEA_451)_and_footnotes(n58);.FTNT n58} and most importantly, 3) the infringed use creates a likelihood of customer confusion as to the source of goods or services.^{40_IDEA_451)_and_footnotes(n59);.FTNT n59} It is clear from the weight of treatment in trademark disputes that the core element of trademark infringement is the likelihood of customer confusion.^{40_IDEA_451)_and_footnotes(n60);.FTNT n60}

Although each United States Circuit Court has devised its own standards for determining whether the registrant has succeeded in proving the likelihood of confusion, commonly scrutinized factors include "strength of the conflicting marks, degree of similarity between the marks, proximity of the goods or services, the junior user's good faith in choosing its marks and the sophistication of the purchasers."^{40_IDEA_451)_and_footnotes(n61);.FTNT n61}

In addition, courts have found no consumer confusion when the infringer is in a different geographic area or in a different industry.^{40_IDEA_451)_and_footnotes(n62);.FTNT n62} Furthermore, in assessing the similarity of the marks, courts examine the marks in terms of sight, sound, and meaning.^{40_IDEA_451)_and_footnotes(n63);.FTNT n63} Because of the international reach of the Internet and the invisible nature of metatags, the traditional customer

confusion analysis as to analyzing the sight, sound, and meaning of trademarks in specific geographic areas becomes problematic.

Before moving on, it is important to distinguish the concepts of pre-sale confusion and point-of-sale confusion. Point-of-sale confusion obviously occurs when purchasers experience confusion as to the services or goods at time of purchase.^{40 IDEA 451) and footnotes(n64);FTNT n64} Pre-sale confusion or initial interest confusion occurs when the purchasers are misdirected or lured into situations where they may purchase goods or services because of a similar mark.^{40 IDEA 451) and footnotes(n65);.FTNT n65} Once purchasers dispel the initial confusion, they may decide to pay for the goods or services simply out of convenience.^{40 IDEA 451) and footnotes(n66);.FTNT n66} Courts have recognized such concepts and have ruled that they are consistent with the Lanham Act.^{40 IDEA 451) and footnotes(n67);.FTNT n67} The importance here, as we will see, is whether the similar mark is likely to attract potential customers.

B. Trademark Dilution

Some have advocated the use of trademark dilution as a remedy to prevent the improper uses of a mark in a site's metatags.^{40 IDEA 451) and footnotes(n68);.FTNT n68} However, this argument is difficult to apply in the Internet medium. Instead, as will be discussed in Part V, the stronger argument is the initial interest confusion doctrine.

The concept of dilution adds greater protection to trademarks by shifting the focus from the "likelihood of confusion" test to the "gradual whittling away of a trademark[']s distinctiveness through use by third parties on non-confusing, non-competing products."^{40 IDEA 451) and footnotes(n69);.FTNT n69} Where the originally enacted Lanham Act focused more on the public injury theory of customer confusion, trademark dilution grants greater protections and is a shift in focus more akin with traditional property rights.^{40 IDEA 451) and footnotes(n70);.FTNT n70}

As an initial matter, trademark dilution is described as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of -- (1) competition between the owner of the famous mark and other parties, or (2) likelihood of confusion, mistake, or deception."^{40 IDEA 451) and footnotes(n71);.FTNT n71}

To press a federal trademark dilution claim, the complainant has the burden of proving: 1) that it owns a famous mark, rather than simply holding a registered trademark; and 2) that the infringer's mark dilutes the famous mark.^{40 IDEA 451) and footnotes(n72);.FTNT n72} In determining whether a mark is famous, Congress has provided several factors for courts to consider:

- (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 geographic 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 registered40_IDEA_451)_and_footnotes(n73);FTNT n73

Although Congress has provided some guidance in determining whether a mark is famous, ironically it has not specified how a mark "causes dilution." Courts, however, may fill this void by analyzing state legislative statutes and general theories of state dilution claims.40_IDEA_451)_and_footnotes(n74);FTNT n74

Specifically, courts have defined dilution "as either the blurring of a mark's product identification or the tarnishment of the affirmative associations a mark has come to convey."40_IDEA_451)_and_footnotes(n75);FTNT n75

Tarnishment occurs when inferior or unwholesome goods or services are linked to a famous mark, and the linking may cause a negative association with the famous mark.40_IDEA_451)_and_footnotes(n76);FTNT n76 An excellent example of tarnishment can be found where a federal district court judge ruled against an adult entertainment company that tarnished Hasbro Toy Company's Candy Land mark by using "Candyland" to name its sexually explicit web site, candyland.com.40_IDEA_451)_and_footnotes(n77);FTNT n77

Dilution by blurring, on the other hand, is where the infringer diminishes the distinguishing and identifying power of a famous mark by misappropriating the mark.40_IDEA_451)_and_footnotes(n78);FTNT n78 A typical example of blurring would be Nike chewing gum or Budweiser palm pilots. In these examples, it is clear that the infringer means to pirate the famous marks in an attempt to associate Nike's or Budweiser's good will to the non-competing products.

Trademark dilution, under 15 U.S.C. § 1125(c), therefore, aims to preserve the value of a famous mark in its representation of the owner's goods or services, and the ability of the mark to serve as a unique symbol of the source of goods or services to consumers, regardless of competition and customer confusion.40_IDEA_451)_and_footnotes(n79);FTNT n79

Trademark dilution, without the customer confusion requirement, would at first glance resolve the deficiencies of an infringement claim in a metatag suit. However, the dilution requirement that the mark be famous presents greater problems for trademark holders on the Internet. Given the international reach of the Internet, can many marks be famous? Does the difficulty in meeting the famous requirement mean that only a handful of marks will receive dilution protection? Luckily, we can avoid answering these questions because, as is discussed in Part V, the U.S. Court of Appeals for the Ninth Circuit's opinion in Brookfield Communications, Inc. v. West Coast Entertainment Corp.40_IDEA_451)_and_footnotes(n80);FTNT n80 goes a long way to resolving the customer confusion problem under an infringement claim.

C. Fair Use

A common defense to both infringement and dilution claims is that the actions of the infringer or diluter constituted fair use.^{40_IDEA_451)_and_footnotes(n81);FTNT n81} Generally, the fair use defense "forbids a trademark registrant [or owner] to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods."^{40_IDEA_451)_and_footnotes(n82);.FTNT n82}

Fair use has been described as:

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^{40_IDEA_451)_and_footnotes(n83);.FTNT n83}

Likewise, the law recognizes that fair use is an affirmative defense in dilution claims.^{40_IDEA_451)_and_footnotes(n84);.FTNT n84} The fair use defense, moreover, applies equally to the Internet as it does to the real world.^{40_IDEA_451)_and_footnotes(n85);.FTNT n85} *Playboy Enterprises, Inc. v. Welles*^{40_IDEA_451)_and_footnotes(n86);.FTNT n86} provides a good example of a successful fair use defense in an Internet setting and will be discussed below in Part IV.

Courts consider several different factors when assessing whether the use of a mark amounted to improper use or fair use. Specifically, courts look at the manner in which the mark was characterized^{40_IDEA_451)_and_footnotes(n87);.FTNT n87} and whether the use was in good faith and was not meant to confuse consumers.^{40_IDEA_451)_and_footnotes(n88);.FTNT n88}

In assessing the characterization of the mark, courts review whether the mark was used in its descriptive sense or as a trademark.^{40_IDEA_451)_and_footnotes(n89);.FTNT n89} If a defendant uses a registered or famous mark accurately to describe the defendant's goods or services, rather than in an attempt to misappropriate the plaintiff's goodwill, then the mark was used in a descriptive manner.^{40_IDEA_451)_and_footnotes(n90);.FTNT n90} In addition, if the mark was used in good faith and not meant to confuse customers, the defendant will prevail with a fair use defense.^{40_IDEA_451)_and_footnotes(n91);.FTNT n91}

IV. METATAG JURISPRUDENCE

Before moving on, it would be helpful to understand the current state of metatag jurisprudence by charting its development in the courts.^{40_IDEA_451)_and_footnotes(n92);.FTNT n92} One of the first cases to deal with the issue of metatags was *Institutform Technologies, Inc. v. National Envirotech Group, L.L.C.*^{40_IDEA_451)_and_footnotes(n93);.FTNT n93} In this case, National Envirotech buried its competitor's registered trademark INSITUFORM in its web site's metatags.^{40_IDEA_451)_and_footnotes(n94);.FTNT n94} Although this case provides minimal guidance because it was settled prior to a decision on the merits, the district court judge entered a consented-to final judgment which was based on the settlement

agreement between Insituform and National Envirotech.^{40_IDEA_451)_and_footnotes(n95);FTNT n95} The settlement called for National Envirotech to remove Insituform's registered trademark from its web site's metatags.^{40_IDEA_451)_and_footnotes(n96);.FTNT n96}

Similarly, *Oppedahl & Larson L.L.P. v. Advanced Concepts*^{40_IDEA_451)_and_footnotes(n97);FTNT n97} provides little direction because the court-ordered injunction was without a judicial opinion. In this case, the plaintiff, a Colorado law firm specializing in intellectual property, copyright and trademark law, successfully alleged that Advanced Concepts, a web-hosting services company, improperly placed the terms "Oppedahl" and "Larson" in its web site's metatags numerous times to attract the plaintiff's customers by being positioned high on a list of hits generated by a search engine.^{40_IDEA_451)_and_footnotes(n98);FTNT n98} Although this case provides some precedential value, it provides very little guidance without a judicial opinion.^{40_IDEA_451)_and_footnotes(n99);FTNT n99}

Another early metatag case was *Niton Corp. v. Radiation Monitoring Devices, Inc.*^{40_IDEA_451)_and_footnotes(n100);FTNT n100} Here, Niton alleged that the defendant improperly attracted customers to its web site when it directly copied Niton's metatags for its own site's metatags.^{40_IDEA_451)_and_footnotes(n101);FTNT n101} Recognizing the novelty of the issue, but also recognizing the unfairness and the lack of good faith in the defendant's actions, the judge cautiously ordered a preliminary injunction subject to modification.^{40_IDEA_451)_and_footnotes(n102);FTNT n102} Although this case did not involve any trademark claims, it helps to illustrate how a lack of good faith affects the customer confusion analysis.

By contrast, *Playboy Enterprises, Inc. v. Calvin Designer Label*,^{40_IDEA_451)_and_footnotes(n103);.FTNT n103} does provide guidance in the trademark setting. Here, a district court judge granted Playboy a preliminary injunction, enjoining the defendant from using the terms "Playboy" and/or "Playmate" in its domain name and metatags. The judge ruled that Playboy successfully demonstrated:

- 1) a sufficient likelihood of success on the merits of its trademark infringement, unfair competition and dilution claims,
- 2) irreparable harm if it is not granted a temporary restraining order pending hearing on its motion for a preliminary injunction,
- 3) the balance of hardships tipping in its favor, and
- 4) the absence of any public interest factors militating against the interim relief sought in its application, to merit and constitute good cause for the issuance of a preliminary injunction.^{40_IDEA_451)_and_footnotes(n104);.FTNT n104}

The decision, however, has been criticized as being ambiguous because it did not rest solely on the metatags issue.^{40_IDEA_451)_and_footnotes(n105);FTNT n105} The court did not clearly provide whether its emphasis was on the defendant's improper use of Playboy's trademarks in its metatags, or defendant's infringing use of the marks in its

domain names, www.playboyxxx.com and www.playmatelive.com, or whether the court's decision was a result of some combination of the two.^{40_IDEA_451)_and_footnotes(n106);.FTNT n106}

Another case that only provides minimal direction is *Playboy Enterprises, Inc. v. AsiaFocus International, Inc.*^{40_IDEA_451)_and_footnotes(n107);.FTNT n107} Here, the infringer, AsiaFocus, not only used Playboy's trademarks in its metatags and domain name, www.asian-playmate.com, but also used them to promote the sale of its consumer goods, such as Asian-playmate playing cards, calendars, wrist watches, and key chains.^{40_IDEA_451)_and_footnotes(n108);.FTNT n108} Given the blatant infringement, the significance of the metatag issue is ambiguous. Additionally, the significance of the case is further reduced because the magistrate judge entered a default judgment when AsiaFocus failed to appear.^{40_IDEA_451)_and_footnotes(n109);.FTNT n109}

However, one interesting and important aspect of the case was that the magistrate judge specifically found that AsiaFocus. actions in burying the terms "Playboy" and "Playmate" in their web site's metatags amounted to willfulness and purposefully deceptive tactics.^{40_IDEA_451)_and_footnotes(n110);.FTNT n110} Such actions demonstrate a lack of good faith and can counter a fair use defense.^{40_IDEA_451)_and_footnotes(n111);.FTNT n111}

By contrast, *Playboy Enterprises, Inc. v. Welles*^{40_IDEA_451)_and_footnotes(n112);.FTNT n112} is particularly instructive. In this case, Welles was a Playboy Playmate of the Year in 1981.^{40_IDEA_451)_and_footnotes(n113);.FTNT n113} As such, Welles used the terms "Playmate of the Year," "PMOY '81," "Playboy," and "Playmate" in her site's metatags and web pages.^{40_IDEA_451)_and_footnotes(n114);.FTNT n114} Playboy sought to enjoin Welles from using the terms based on a trademark infringement and dilution claim; Welles countered with a fair use defense.^{40_IDEA_451)_and_footnotes(n115);.FTNT n115} In ruling for Welles, the district court judge found that her use constituted fair use,^{40_IDEA_451)_and_footnotes(n116);.FTNT n116} and the U.S. Court of Appeals for the Ninth Circuit affirmed.^{40_IDEA_451)_and_footnotes(n117);.FTNT n117} The district court judge ruled that the terms were used in good faith and that they fairly and accurately described her, thus were not used in a trademark sense.^{40_IDEA_451)_and_footnotes(n118);.FTNT n118}

Of note is that Welles did not try to trick consumers into believing that they were viewing a Playboy-endorsed site.^{40_IDEA_451)_and_footnotes(n119);.FTNT n119} By displaying disclaimers on eleven of the fifteen pages of her web site, indicating that she had no affiliation with Playboy, Welles greatly reduced any likelihood of customer confusion.^{40_IDEA_451)_and_footnotes(n120);.FTNT n120}

The judge, specifically addressing the metatag issue, found no infringement when Welles used the marks "in good faith to index the content of her website."^{40_IDEA_451)_and_footnotes(n121);.FTNT n121} In addressing the fact that metatags are invisible, the judge suggested that a search engine's reliance on such tags to accurately index the web site is sufficient to create customer

confusion.⁴⁰ IDEA 451) and footnotes(n122); FTNT n122 Since the judge quickly glossed over this suggestion before moving on to the merits of the fair use defense, any notions of creating some sort of legal device, such as constructive or transferred customer confusion via search engine confusion, have not been addressed by the courts.

V. BROOKFIELD V. WEST COAST ENTERTAINMENT: THE 9TH CIRCUIT'S APPLICATION OF THE INITIAL INTEREST CONFUSION DOCTRINE.

Not until *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*⁴⁰ IDEA 451) and footnotes(n123); FTNT n123 did any court specifically and comprehensively address the trademark implications in a metatag context. Brookfield, a software company that also maintains a searchable database containing entertainment-industry related information, alleged that West Coast, a video rental chain, infringed its registered trademark *MovieBuff* by operating a web site with the domain name *moviebuff.com* and by placing Brookfield's trademark in the web site's metatags.⁴⁰ IDEA 451) and footnotes(n124); FTNT n124 After first ruling against West Coast in the domain name dispute, the court went on to make an important distinction between trademark infringement in domain names and infringement in the metatags context.⁴⁰ IDEA 451) and footnotes(n125); FTNT n125

According to the court, "the question in the metatags context is quite different."⁴⁰ IDEA 451) and footnotes(n126); FTNT n126 Analyzing the metatags issue to make a clear distinction, the court questioned whether West Coast could use *MovieBuff* in the metatags of an alternate fictitious web site, such as *westcoastvideo.com* for example, rather than *moviebuff.com*.⁴⁰ IDEA 451) and footnotes(n127); FTNT n127 By framing the issue around an alternate domain name, the court resolves the ambiguity, which arose in *Playboy Enterprises, Inc. v. Calvin Designer Label*,⁴⁰ IDEA 451) and footnotes(n128); FTNT n128 regarding the allocation of judicial weight between domain names and metatags.

In *Brookfield*, the U.S. Court of Appeals for the Ninth Circuit, the first court to grapple directly with the metatags issue, specifically ruled that the Lanham Act prohibits a party from using any metatags confusingly similar to another's trademark.⁴⁰ IDEA 451) and footnotes(n129); FTNT n129 To come to such a conclusion, the court applied an initial interest confusion doctrine, also known in other jurisdictions as the pre-sale confusion doctrine.⁴⁰ IDEA 451) and footnotes(n130); FTNT n130

The court concluded that West Coast improperly benefited from the goodwill in Brookfield's trademark by placing the mark in its metatags solely to divert customers to its web site.⁴⁰ IDEA 451) and footnotes(n131); FTNT n131 The court reasoned that "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 sizeable number of consumers who were originally looking for Brookfield's product will simply decide to utilize West Coast's offerings instead."⁴⁰ IDEA 451) and footnotes(n132); FTNT n132

Even if the initial confusion is dispelled and the misdirected customers do not make a purchase, the act of purposefully generating pre-sale confusion by attracting or

diverting potential customers by using another's trademark is sufficient to constitute trademark infringement.^{40 IDEA 451) and footnotes(n133);FTNT n133}

As mentioned in Part III-A, to determine the likelihood of confusion, courts in various jurisdictions apply several different tests, such as "strength of the conflicting marks, degree of similarity between the marks, proximity of the goods or services, the junior user's good faith in choosing its marks and the sophistication of the purchasers."^{40 IDEA 451) and footnotes(n134);FTNT n134} The application of such traditional tests becomes awkward in the invisible infringement context. Recognizing the awkwardness, the Ninth Circuit did not attempt to fashion their opinion to fit in any of the traditional infringement analyses.^{40 IDEA 451) and footnotes(n135);FTNT n135} Therefore, according to the court, the sole act of generating initial interest confusion is a sufficient cause of action for trademark infringement in the metatags context.^{40 IDEA 451) and footnotes(n136);FTNT n136}

By analyzing the problem in this manner, the court avoids the problematic task of comparing the marks. This avoidance is helpful because comparisons are premised on the fact that customers identified the mark and associated it to a business.
goodwill.^{40 IDEA 451) and footnotes(n137);FTNT n137} Web surfers, however, do not typically view trademarks in a site's metatags.^{40 IDEA 451) and footnotes(n138);FTNT n138} Consequently, the invisible infringement problem arises and such a comparison would only serve to satisfy the application of traditional confusion tests. Therefore, trying to prove confusion because of similarity of the marks, when a web surfer does not even see the marks, is inherently incongruent with the traditional applications of the Lanham Act. By avoiding comparisons through the application of the pre-sale confusion doctrine, the court avoids this discordance.

The court bolsters its argument by citing a long list of judicial authority that have employed the pre-sale confusion doctrine in one form or another. Specifically, the Ninth Circuit cites the U.S. Court of Appeals for the Second Circuit's ruling in *Mobil Oil Corp. v. Pegasus Petroleum Corp.*,^{40 IDEA 451) and footnotes(n139);FTNT n139} when it held that "such initial confusion works a sufficient trademark injury."^{40 IDEA 451) and footnotes(n140);FTNT n140} Accordingly, under the rule adopted by the Ninth Circuit, trademark infringement is actionable in the metatags context if trademark holders can prove they have a valid, protectable trademark^{40 IDEA 451) and footnotes(n141);FTNT n141} and the infringer created pre-sale confusion.^{40 IDEA 451) and footnotes(n142);FTNT n142}

Although problems may arise yet from a finding of trademark infringement on the basis of pre-sale confusion, a bad actor quality, as found in *Playboy Enterprises v. AsiaFocus*,^{40 IDEA 451) and footnotes(n143);FTNT n143} permeates the improper use of trademarks in the metatags context. To illustrate the lack of good faith, the Ninth Circuit in *Brookfield* analogized the metatags situation to purposefully posting an inaccurate sign or billboard on a highway.^{40 IDEA 451) and footnotes(n144);FTNT n144} Specifically, the court stated that the use of trademarks in metatags in this manner is equivalent to Company X posting a sign on a highway misdirecting customers of its competitor, Company Y.^{40 IDEA 451) and footnotes(n145);FTNT n145} The misdirected customers seeking Company Y are unable to find Company

Y.40_IDEA_451)_and_footnotes(n146);FTNT n146 They, however, find Company X and may simply decide to shop at Company X out of convenience.40_IDEA_451)_and_footnotes(n147);FTNT n147 The Court states that:

Customers are not confused in the narrow sense: they are fully aware that they are purchasing from [Company X] and they have no reason to believe that [Company X] is related to, or in any way sponsored by, [Company Y]. Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that [Company X] would be misappropriating [Company Y's] acquired goodwill.40_IDEA_451)_and_footnotes(n148);FTNT n148

Elements of bad faith, like those present in Brookfield and Asia-Focus, will not sit well with future courts. Such findings will help to support the application of the pre-sale confusion doctrine to future metatag suits. Therefore, future applications of pre-sale confusion, bolstered by elements of bad faith, will provide trademark holders the protections they need in the Internet medium, and render the need for a legislative response less likely.

VI. CONCLUSION

Metatags are employed for the sole purpose of attracting potential customers to a web site. Therefore, the improper use of another's trademarks in a site's metatags amounts to a purposeful action to misdirect customers and generate pre-sale confusion. Because pre-sale confusion is not tolerated in typical business settings, it should not be tolerated on the Internet. Consequently, courts should apply a pre-sale confusion doctrine to provide trademark holders an avenue of relief in the Internet medium. A Congressional response, moreover, may still be necessary to create consistency between the courts in the event that this doctrine does not gain wide acceptance.

Interestingly, another remedy for the metatags problem, which does not require a judicial or legislative response, is driven by market forces. Some search engines, most notably Excite, have recognized the inefficiency in using metatags to index a web site.40_IDEA_451)_and_footnotes(n149);FTNT n149 Consequently, they do not use metatags at all to identify a particular web site.40_IDEA_451)_and_footnotes(n150);FTNT n150 Should market forces, however, prove to be inadequate in motivating a change by search engines in the use of metatags, courts should apply the pre-sale confusion doctrine to protect trademarks on the Internet.

Although the Internet is an evolving and dynamic form of commerce, courts can properly apply the pre-sale confusion doctrine to the metatag context and future issues because it is a flexible concept. Analysis should be on a case-by-case basis, with the focus on factors such as: the infringer's attempt to attract or misdirect potential customers, the misappropriation of the trademark holder's goodwill, and the infringer's lack of good faith. Such conditions, which are consistent with the Lanham Act, are flexible enough to adapt to the ever-changing medium of the Internet.

n1 See *ACLU v. Reno*, 929 F. Supp. 824, 831 (E.D. Pa. 1996) (finding 3); Richard Raysman & Peter Brown, Developments in Trademark and Domain Names Disputes, N.Y.L.J., Mar. 9, 1999, at 3; Users of Internet Top 100 Million, N.Y. Times, Nov. 12, 1999, at C8.

n2 See Martin J. Elgison & James M. Jordan III, Trademark Cases Arise from Meta-Tags, Frames: Disputes Involve Search-Engine Indexes, Web Sites Within Web Sites, as well as Hyperlinking, NAT'L L.J., Oct. 20, 1997, at C6; Robert C. Scheinfeld & Parker H. Bagley, Emerging Issues on the Internet, N.Y.L.J., Nov. 26, 1997, at 3; Wendy Leibowitz, Lawyers and Technology: Internet Jurisprudence, NAT'L L.J., Jan. 25, 1999, at A18.

n3 See Ed Krol, THE WHOLE INTERNET USER'S GUIDE & CATALOG 39 (2d ed. 1994) ("The law surrounding electronic communication has not kept pace with the technology.").

n4 See Trademark (Lanham) Act of 1946, ch. 540, 60 Stat. 427 (codified as amended at 15 U.S.C. § 1051.1096 (1994 & Supp. IV 1998)).

n5 See Edward Vassallo & Maryanne Dickey, Protection in the United States for "Famous Marks": The Federal Trademark Dilution Act Revisited, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 503 (1999).

n6 See Meeka Jun, Meta Tags: The Case of the Invisible Infringer, N.Y.L.J. Oct. 24, 1997, at 5.

n7 See *id.*

n8 G. PETER ALBERT, JR. & LAFF, WHITESEL & SARET, LTD., INTELLECTUAL PROPERTY LAW IN CYBERSPACE 187 (1999); see Jun, *supra* note 6, at 5.

n9 See Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, § 3002(a), 113 Stat. 1501, 1537-537 (1999) (to be codified at 15 U.S.C. § 1125(d)).

n10 See *id.*

n11 See *id.*

n12 See Ira S. Nathenson, Internet Infoglut and Invisible Ink: Spamdexing and Search Engines with Meta Tags, 12 HARV. J. L. & TECH. 43, 58 (1998).

n13 See *id.* at 62.

n14 See *id.* at 64.

n15 See *id.* at 49.

n16 See *id.* at 138.

n17 174 F.3d 1036, 50 U.S.P.Q.2d (BNA) 1545 (9th Cir. 1999).

n18 See *id.* at 1062, 50 U.S.P.Q.2d at 1564.

n19 See *ACLU v. Reno*, 929 F. Supp. 824, 831 (E.D. Pa. 1996) (finding 6).

n20 See *id.*

- n21 See *id.* at 832 (finding 11).
- n22 See *Brookfield*, 174 F.3d at 1044, 50 U.S.P.Q.2d at 1548-49.
- n23 See Jeffrey R. Kuester & Peter A. Nieves, Hyperlinks, Frames and Meta-Tags: An Intellectual Property Analysis, 38 *IDEA* 243, 244 (1998).
- n24 See *id.* at 245.
- n25 See *ACLU*, 929 F. Supp. at 831 (finding 3).
- n26 See *id.*
- n27 See *id.*
- n28 See *id.*
- n29 See *id.*
- n30 See Raysman & Brown, *supra* note 1, at 3.
- n31 See *ACLU*, 929 F. Supp. at 833 (finding 18).
- n32 See *id.* at 834 (finding 22).
- n33 See *United States v. Microsoft*, 147 F.3d 935, 939 (D.C. Cir. 1998).
- n34 See *Brookefield Communications, Inc. v. West Coast Entertainment Corp.* 174 F.3d 1036, 1044, 50 U.S.P.Q.2d (BNA) 1545, 1549 (9th Cir. 1999).
- n35 See *ACLU*, 929 F. Supp. at 836 (finding 33).
- n36 See Kuester & Nieves, *supra* note 23, at 244.
- n37 See *id.* at 246.
- n38 See *id.*
- n39 See *id.*; see also Richard Raysman & Peter Brown, Dangerous Liaisons: The Legal Risks of Linking Web Sites, *N.Y.L.J.*, Apr. 8, 1997, at 3.
- n40 See *Reno v. ACLU*, 521 U.S. 844, 852 (1997).
- n41 See *id.*
- n42 See Kuester & Nieves, *supra* note 23, at 247.
- n43 See *id.*
- n44 See *id.*
- n45 See *id.*
- n46 See *id.*
- n47 See *Brookefield Communications, Inc. v. West Coast Entertainment Corp.* 174 F.3d 1036, 1045, 50 U.S.P.Q.2d (BNA) 1545, 1549 (9th Cir. 1999).
- n48 See Kuester & Nieves, *supra* note 23, at 247.
- n49 See *Playboy Enter., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1104 (S.D. Cal. 1998).
- n50 (visited Dec. 27, 1999) <<http://www.sony.com/>>.

n51 See *Brookfield*, 174 F.3d at 1045, 50 U.S.P.Q.2d at 1549 (citing *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104, 52 U.S.P.Q.2d (BNA) 1380, 1381 (D. Mass. 1998)).

n52 *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-164, 34 U.S.P.Q.2d (BNA) 1161, 1163 (1995) (quoting 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND

UNFAIR COMPETITION § 2.01[2], at 2-3 (3d ed. 1994)).

n53 See 15 U.S.C. § 1127 (1994).

n54 Id.

n55 Id. § 1114(1).

n56 Id. § 1127.

n57 See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1047, 50 U.S.P.Q.2d (BNA) 1545, 1551 (9th Cir. 1999).

n58 See 15 U.S.C. § 1114(1)(a) (1994).

n59 See *WCVB-TV v. Boston Athletic Ass.n.*, 926 F.2d 42, 44, 17 U.S.P.Q.2d (BNA) 1688, 1689 (1st Cir. 1991).

n60 See *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1103 (S.D. Cal. 1998); *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1290 (9th Cir. 1992).

n61 Kuester & Nieves, supra note 23, at 248 (citing 3 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 24.06[4] (3d ed. 1995 rev.)).

n62 See *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031, 10 U.S.P.Q.2d (BNA) 1961, 1965 (2d Cir. 1989) (Mead's "Lexis" mark and Toyota's "Lexus" mark are limited to the markets they service); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1047, 50 U.S.P.Q.2d (BNA) 1545, 1063 (9th Cir. 1999) (citing *Weiner King, Inc. v. Wiener King Corp.*, 615 F.2d 512, 515-16, 52122, 204 U.S.P.Q. (BNA) 820, 823-34, 828-29 (C.C.P.A. 1980) (permitting concurrent use of "Weiner King" as a mark for restaurants featuring hot dogs in New Jersey and as a mark for restaurants in North Carolina)).

n63 See *Dreamwerks Prod. Group, Inc., v. SKG Studio*, 142 F.3d 1127, 1131, 46 U.S.P.Q.2d (BNA) 1561, 1564 (9th Cir. 1998).

n64 See Kuester & Nieves, supra note 23, at 248.

n65 See *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58, 2 U.S.P.Q.2d (BNA) 1677, 1680 (2d Cir. 1987); *Brookfield*, 174 F.3d at 1062, 50 U.S.P.Q.2d at 1563-64.

n66 See *Brookfield*, 174 F.3d at 1062, 50 U.S.P.Q.2d at 1563-64.

n67 See Kuester & Nieves, supra note 23, at 248; *Mobil Oil*, 818 F.2d at 257-58, 2 U.S.P.Q.2d at 1680.

n68 See Louis K. Ebling & Karen E. Kreider, Dilution is Remedy for Internet Mark Misuse, NAT'L L.J., May 18, 1998, at C31.

n69 *Ringling Bros..Barnum & Bailey Combined Shows, Inc. v. Celozzi-Ettelson Chevrolet, Inc.*, 855 F.2d 480, 482, 8 U.S.P.Q.2d (BNA) 1072, 1074 (7th Cir. 1988); see *Panavision Int'l L.P. v. Toepfen*, 945 F. Supp. 1296, 1304, 40 U.S.P.Q.2d (BNA) 1908, 1914 (C.D. Cal. 1996).

n70 See Clark W. Lackert, Famous Trademarks and the Internet: A Global Perspective, J. INTERNET L., Oct. 1997, at 1, 2.

n71 15 U.S.C. § 1127 (1994).

n72 See *id.* § 1125(c)(1); Kuester & Nieves, *supra* note 23, at 251.

n73 15 U.S.C. § 1125(c)(1) (1994 & Supp. IV 1998).

n74 See Kuester & Nieves, *supra* note 23, at 251.

n75 *Mead Data Central, Inc. v. Toyota Motor Sales, U.S.A., Inc.*, 875 F.2d 1026, 1031, 10 U.S.P.Q.2d (BNA) 1961, 1965 (2d Cir. 1989) (citing *Sally Gee, Inc. v. Myra Hogan, Inc.*, 699 F.2d 621, 625, 217 U.S.P.Q. (BNA) 658, 662 (2d Cir. 1983)).

n76 See *Deere & Co. v. MTD Prods., Inc.*, 41 F.3d 39, 43, 32 U.S.P.Q.2d 1936, 1939 (2d Cir. 1994).

n77 See *Hasbro, Inc. v. Internet Entertainment Group, Ltd.*, No. C96-130WD, 1996 WL 84858, at *2 (W.D. Wash. Feb. 22, 1996).

n78 See *Playboy Enters., Inc. v. AsiaFocus Int'l, Inc.*, No. Civ.A.97-734-A, 1998 WL 724000, at *8 (E.D. Va. Apr. 10, 1998).

n79 See *Dr. Seuss Enters., L.P. v. Penguin Book USA, Inc.*, 924 F. Supp. 1559, 1573 (S.D. Cal. 1996); Kuester & Nieves, *supra* note 23, at 251.

n80 174 F.3d 1036, 50 U.S.P.Q.2d (BNA) 1545 (9th Cir. 1999).

n81 See 15 U.S.C. § 1115(b)(4) (1994)); *Id.* § 1125(c)(4)(A) (1994 & Supp. IV 1998)).

n82 *New Kids on the Block v. News Am. Publ.g., Inc.*, 971 F.2d 302, 306, 23 U.S.P.Q.2d (BNA) 1534, 1537 (9th Cir. 1992) (quoting *Soweco, Inc. v. Shell Oil Co.*, 617 F.2d 1178, 1185, 207 U.S.P.Q. (BNA) 278, 285 (5th Cir. 1980)).

n83 15 U.S.C. § 1115(b)(4) (1994).

n84 See *id.* § 1125(c)(4)(A); *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1105 (S.D. Cal 1998).

n85 See *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1065, 50 U.S.P.Q.2d (BNA) 1545, 1566 (9th Cir. 1999).

n86 7 F. Supp. 2d 1098 (S.D. Cal 1998).

n87 See *Radio Channel Networks, Inc. v. Broadcast.com, Inc.*, No. 98 Civ.4799 (RPP), 1999 WL 124455, at *6 (S.D.N.Y. Mar. 8, 1999).

n88 See *Welles*, 7 F. Supp. 2d at 1103.

n89 See *Radio Channel*, 1999 WL 124455, at *6.

n90 See *Welles*, 7 F. Supp. 2d at 1103.

n91 See *id.*

n92 See Danny Sullivan, Search Engine Watch, (visited Aug. 27, 1999) <www.searchenginewatch.com/resources/metasuits.html> (Sullivan maintains a web site that tracks most of the metatag cases.).

n93 Civ. Act. No. 97-2064 (E.D. La. Aug. 26, 1997) available at <www.cll.com/case1.htm> (visited Aug. 30, 1999).

n94 See *Kuester & Nieves*, supra note 23, at 275.

n95 See *id.*

n96 See *id.*

n97 *No. Civ.A.97-Z-1592*, 1998 U.S. Dist. Lexis 18359 (D. Col. Feb. 6, 1998).

n98 See Jeff Peline, Keywords said to violate trademark, CNET News.com, Aug. 27, 1997 (visited Aug. 30, 1999) <www.news.com/News/Items/0,4,13799,00.html>; see also, David Loundy, Hidden Code Sparks High-Profile Lawsuit, Chicago Daily Law Bulletin, Sep. 11, 1997 (visited Aug. 30, 1999) <www.loundy.com/CDLB/MetaTags.html>.

n99 See generally *Oppedahl & Larson*, 1998 U.S. Dist. Lexis 18359.

n100 27 F. Supp. 2d 102 (D. Mass. 1998).

n101 See *id.* at 104-5.

n102 See *id.* at 104.

n103 985 F. Supp. 1220, 44 U.S.P.Q.2d (BNA) 1156 (N.D. Cal. 1997).

n104 *Id.* at 1221, 44 U.S.P.Q.2d at 1157.

n105 See Link Law on the Internet: A Panel Discussion, 38 IDEA 197, 209 (1998); Martin J. Elgison & James M. Jordan III, Trademark Cases Arise from Meta- Tags, Frames: Disputes Involve Search-Engine Indexes, Web Sites Within Web Sites, as well as Hyperlinking, NAT'L L.J., Oct. 20, 1997, at C6.

n106 See *Calvin Designer Label*, 985 F. Supp. at 1221, 44 U.S.P.Q.2d at 1157; *Kuester & Nieves*, supra note 23, at 274-75.

n107 *No. Civ.A.97-734-A*, 1998 WL 724000 (E.D. Va. Apr. 10, 1998).

n108 See *id.* at *2-3, 7.

n109 See *id.* at *9.

n110 *Id.* at *8.

n111 See 15 U.S.C. § 1115(b)(4) (1994).

n112 7 F. Supp. 2d 1098 (S.D. Cal. 1998).

n113 See *id.* at 1100.

n114 *Id.*

n115 See *id.* at 1101.

n116 See *id.* at 1104.

n117 See *Playboy Enters., Inc. v. Welles*, 162 F.3d 1169 (9th Cir. 1998).

n118 See *Welles*, 7 F. Supp. 2d at 1104-5.

n119 See *id.* at 1105.

n120 See *id.*

n121 *Id.* at 1104.

n122 See *id.*

n123 174 F.3d 1036, 50 U.S.P.Q.2d (BNA) 1545 (9th Cir. 1999).

n124 See *id.* at 1041-42, 50 U.S.P.Q.2d at 1546-47.

n125 See *id.* at 1062, 50 U.S.P.Q.2d at 1563-64.

n126 *Id.*

n127 *Id.*

n128 985 F. Supp. 1220, 44 U.S.P.Q.2d (BNA) 1156 (N.D. Cal. 1997).

n129 *Brookfield*, 174 F.3d at 1065, 50 U.S.P.Q.2d at 1565-66.

n130 See *id.* at 1062, 50 U.S.P.Q.2d at 1563-64.

n131 See *id.*

n132 *Id.*, 50 U.S.P.Q.2d at 1564.

n133 See *id.* (citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58, 2 U.S.P.Q.2d (BNA) 1677, 1680 (2d Cir. 1987); *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405, 42 U.S.P.Q.2d (BNA) 1184, 1193 (9th Cir. 1997)).

n134 Kuester & Nieves, *supra* note 23.

n135 See *Brookfield*, 174 F.3d at 1062 n.24, 50 U.S.P.Q.2d 1563-64 n.24.

n136 See *id.* at 1062.

n137 See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 170, 34 U.S.P.Q.2d (BNA) 1161, 1165 (1995); *Dreamwerks Prod. Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1131, 46 U.S.P.Q.2d (BNA) 1561, 1564 (9th Cir. 1998) (In assessing the similarity of the marks, courts examine the marks in terms of sight, sound and meaning.).

n138 See ALBERT & LAFF, WHITESEL & SARET, LTD., *supra* note 8, at 186; Jun, *supra* note 6, at 5.

n139 818 F.2d 254, 257-58 (2d Cir. 1987).

n140 *Brookfield*, 174 F.3d at 1063, 50 U.S.P.Q.2d at 1564 (citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58 (2d Cir. 1987)).

n141 See *id.* at 1047, 50 U.S.P.Q.2d at 1551.

n142 See *id.* at 1062, 50 U.S.P.Q.2d at 1563-64.

n143 *No. Civ.A.97-734-A*, 1998 WL 724000 (E.D. Va. Apr. 10, 1998).

n144 *Brookfield*, 174 F.3d at 1064, 50 U.S.P.Q.2d at 1565.

n145 See id.

n146 See id.

n147 See id.

n148 Id. (citing *Blockbuster Entertainment Group v. Laylco, Inc.*, 869 F. Supp. 505, 513, 33 U.S.P.Q.2d (BNA) 1581, 1586-87 (E.D. Mich. 1994)); see Richard Raysman & Peter Brown, Law Developments, Ninth Circuit Says Use of Meta-tags Causes 'Initial Interest' Confusion, (visited Nov. 15, 1999).

<<http://www.brownraysman.com/recdev/metatagsconfusion.html>>.

n149 See Elizabeth Gardner, Trademark Battles Simmer Behind Sites, Aug. 25, 1997 (visited Sep. 22, 1999) <<http://www.internetworld.com/print/1997/08/25/news/19970825battles.html>>.

n150 See id.