TRADEMARKS, METATAGS, AND INITIAL INTEREST CONFUSION: A LOOK TO THE PAST TO RE-CONCEPTUALIZE THE FUTURE

CHAD J. DOELLINGER*

INTRODUCTION

Web sites, through domain names and metatags, have created a new set of problems for trademark owners. A prominent problem is the use of one's trademarks in the metatags of a competitor's web site. The initial interest confusion doctrine has been used to combat this problem.[1] Initial interest confusion involves infringement based on confusion that creates initial customer interest, even though no transaction takes place.[2]

Several important questions have currently received little attention: How should initial interest confusion be defined? How should initial interest confusion be conceptualized? How much confusion is enough to justify a remedy? Who needs to be confused, when, and for how long? How should courts determine when initial interest confusion is sufficient to support a finding of trademark infringement? These issues have been glossed over in the current debate by both courts and scholars alike. While the two seminal opinions involving the initial interest confusion doctrine, *Brookfield Commun., Inc. v. West Coast Ent. Corp.*[3] and

* B.A., B.S., University of Iowa (1998); J.D., Yale Law School (2001). Mr. Doellinger is an associate with Pattishall, McAuliffe, Newbury, Hilliard & Geraldson, 311 S. Wacker Drive, Chicago, Illinois 60606. The author would like to thank Uli Widmaier for his assistance and insights. The views and opinions in this article are solely those of the author and do not necessarily reflect those of Pattishall, McAuliffe, Newbury, Hilliard & Geraldson.

1 *See* J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, vol. 3, § 23:6 (4th ed., West 2000).

2 *Id*.

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

Playboy Enters., Inc. v. Terri Welles, Inc.[4] have resulted in the proper outcomes, they, too, ignore these underlying issues, and thus the initial interest confusion doctrine has become muddled and nearly incoherent. Rather than cast aside the doctrine or continue traveling down the mine-filled roads illustrated by these decisions, this article provides much needed clarity fueled by the reconnection of the doctrine with its brick and mortar (or physical world) foundation.

Little scholarship has explained the doctrine in depth, so there is no unified view being refuted. Instead, an accumulation of mistakes, borne of a lack of breadth and understanding of the law, need to be corrected. The existing scholarship often takes a myopic view, focusing on the development of the doctrine over the last few years in the Internet context.[5] Here, the issues will be examined in a broader context by reviewing the past and reconnecting the initial interest confusion doctrine with its true roots in brick and mortar law.

Part I gives a brief, general overview of trademark law before focusing on the initial interest confusion doctrine. Part I continues by following the doctrine from its brick and mortar roots to the *Brookfield* decision. Part II critically examines the *Welles* decision, noting the incoherent doctrine left in its wake. Part III takes a closer look at the definition of initial interest confusion and delineates the contours of the doctrine. First, a new vocabulary is introduced. Second, the doctrine is re-conceptualized, or, more accurately, is reconnected with its brick and mortar roots. Part IV develops a likelihood of initial interest confusion test derived from the traditional likelihood of confusion test. This test provides much needed clarification and guidance for courts evaluating cases of alleged initial interest confusion. Part V explores the outer limits of the doctrine by discussing underlying ideas such as who must be confused, where the confusion must occur and how long the confusion must remain to support a finding of trademark infringement. Part VI explores additional nuances and limitations of the doctrine, including the roles of consumer sophistication and fair use.

---

[4] 78 F. Supp. 2d 1066 (S.D. Cal. 1999).

[5] *See generally e.g.* Terrell W. Mills, *Metatags: Seeking to Evade User Detection and the Lanham Act*, 6 Rich. J.L. & Tech. 22 (2000); Michael R. Sees, *Use of Another's Trademark in a Web Page Meta Tag: Why Liability Should Not Ensue under the Lanham Act for Trademark Infringement*, 5 Tex .Wes. L. Rev. 99 (1998); David Yan, *Virtual Reality: Can We Ride Trademark Law to Surf Cyberspace?*, 10 Fordham Intell. Prop. Media & Ent. L.J. 773 (2000). *Cf.* Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 Colum. J.L. & Soc. Probs. 439, 505 (2000) (even literature acknowledging the brick and mortar history of the doctrine do not use that foundation as guidance in cyberspace).

By reconnecting the initial interest confusion doctrine with its brick and mortar foundation, this article provides a new paradigm that both clarifies a confused jurisprudence and provides clear normative recommendations for the doctrine's application in the Internet context—essentially a new starting point.

I. TRADEMARK LAW AND THE INITIAL INTEREST CONFUSION DOCTRINE: FROM THE BRICK AND MORTAR WORLD INTO CYBERSPACE

A brief overview of trademark law is necessary before delving into the initial interest confusion doctrine. Trademark rights are based on use,[6] and trademark infringement is based on confusion.[7] Thus, a trademark is not a property right in the traditional sense; it only protects against other confusing uses.[8] In determining whether confusion exists, courts will turn to a multi-factored test.[9] This test and its application varies from circuit to circuit.[10] Aside from the more traditional likelihood of confusion by consumers, other types of confusion have been deemed sufficient to support a finding of infringement.[11] For example, reverse confusion involves a junior user flooding the market in such a way as to cause the senior user to lose control over her mark.[12]

Confusion that sparks initial customer interest can also be the basis for infringement.[13] This confusion is actionable even if it is quickly dissipated with no sale ever taking place.[14] This theory of confusion has come to be known as initial interest confusion.[15] Professor J. Thomas McCarthy summarizes this form of confusion by analogy:

> The analogy to trademark initial interest confusion is a job-seeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or a "typo." The misrepresentation has enabled the job-

6 *See* McCarthy, *supra* n. 1, at vol. 1, § 3:1.

7 *See id.* at vol. 1, § 2:8.

8 *See id.*

9 *See id.* at vol. 3, § 24:30.

10 *See id.* at vol. 3, §§ 24:31-24:43.

11 *See id*. at vol. 3, § 23:5.

12 *See id.* at vol. 3, § 23:10.

13 *See id.* at vol. 3, § 23:6.

14 *See id.*

15 *See id.*

> seeker to obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.[16]

The recent flurry of literature misunderstands the initial interest confusion doctrine.[17] Some have argued that initial interest confusion ought to be insufficient to support a finding of trademark infringement.[18] Others have argued that courts are stretching trademark law to its breaking point in order to function within the Internet context.[19] These objections both ignore the historical development of the Lanham Act as well as the development of the initial interest confusion doctrine in the brick and mortar world.

The history of the Lanham Act refutes such arguments:

> Prior to 1962, the Lanham Act protected against confusion, mistake, or deception on the part of "purchasers as to the source of origin of such goods or services." In 1962, Congress deleted this language…The purpose of deleting this language was to make clear that the Lanham Act prohibited more than just confusion on the part of actual purchasers.[20]

The expansion of the Lanham Act allowed for other forms of confusion, and therefore the initial interest confusion doctrine is in no way inconsistent with the statutory language.[21]

Additionally, courts acknowledged this change many years ago, having noted the doctrine as early as 1975 in *Grotrian, Helfferich, Schultz, Th. Steinweg Nachfahren v. Steinway & Sons*.[22] *Grotrian*

16 *See id.*

17 *See generally* Tami K. Lefko, *The Wild West Just Got Tamer: Appeals Court Considers Use of Trademarks in Domain Names and Metatags*, 16 Computer Law 23 (1999); Maureen A. O'Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability for Metatagging*, 33 Gonz. L. Rev. 277, 307 (1998); Yan, *supra* n. 5, at 781.

18 *See* Ira S. Nathenson, *Internet Infoglut and Invisible Ink: Spamdexing Search Engines with Meta Tags*, 12 Harv. J.L. & Tech. 43, 114 (1998).

19 *See* Mills, *supra* n. 5, at 52-53.

20 Michael J. Allen, *The Scope of Confusion Actionable under Federal Trademark Law: Who Must be Confused and When?*, 26 Wake Forest L. Rev. 321, n.9 (1991) (citing Act of October 9, 1962, Pub. L. No. 87-772, § 17, 76 Stat. 773 and S. Rep. No. 2107, 87th Cong., 2d Sess. (reprinted in 196 U.S.C.C.A.N. 2844, 2847, 2850).

21 *See id.* at 331-32 (discussing initial interest confusion in the pre-Internet era).

22 523 F.2d 1331, 186 U.S.P.Q. 436 (2d Cir. 1975); *See also Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 2 U.S.P.Q.2d 1677 (2d Cir. 1987) (finding liability for initial interest confusion).

involved two competing piano makers, Steinway & Sons ("Steinway") and Grotrian, Helfferich, Schultz, Th. Steinweg Nachfahren ("Grotrian").[23] Steinway's mark was strong and its name was famous in the United States, while Grotrian's name was virtually unknown.[24] Grotrian was attempting to market pianos in the United States under the "Grotrian-Steinweg" name.[25] Grotrian sought declaratory judgment to enable them to use the trademark, "Grotrian-Steinweg," in the United States, while Steinway counterclaimed under the Lanham Act.[26] The district court found for Steinway, basing its decision, in part, on initial interest confusion. "Misled into an *initial interest*, a potential Steinway buyer may satisfy himself that the less expensive Grotrian-Steinweg is at least as good, if not better, than a Steinway."[27] The Second Circuit agreed with the district court's holding that:

> The issue here is not the possibility that a purchaser would buy a Grotrian-Steinweg thinking it was actually a Steinway or that Grotrian has some connection with Steinway and Sons. The harm to Steinway, rather, is the likelihood that a consumer, hearing the "Grotrian-Steinweg" name and thinking it had some connection with "Steinway," would consider it on that basis. The "Grotrian-Steinweg" name therefore would attract potential customers based on the reputation built up by Steinway in this country for many years.[28]

The court recognized that neither actual nor potential confusion needed to exist at the time of purchase.[29] Thus, the theory of initial interest confusion was articulated long before the venture into cyberspace.

The initial interest confusion doctrine continues to be applied in the brick and mortar world.[30] For example, the Fifth Circuit recently

---

[23] *See Grotrian, Helfferich, Schultz, Th. Steinweg Nachfahren v. Steinway & Sons*, 523 F.2d at 1333-34, 186 U.S.P.Q at 438.

[24] *See id.* at 1342, 186 U.S.P.Q. at 445.

[25] *See id.* at 1334, 186 U.S.P.Q. at 438-39.

[26] *See id.* at 1334-35, 186 U.S.P.Q. at 439.

[27] *Grotrian, Helfferich, Schultz, Th. Steinweg Nachfahren v. Steinway & Sons*, 365 F. Supp. 707, 717, 180 U.S.P.Q. 506, 513 (S.D.N.Y. 1973) (emphasis added).

[28] *Grotrian*, 523 F.2d at 1342, 186 U.S.P.Q. at 445.

[29] *Id.*

[30] *See generally e.g. Forum Corp. of North Amercia v. Forum, Ltd.*, 903 F.2d 434, 14 U.S.P.Q.2d 1950 (7th Cir. 1990); *Mobil Oil Corp.*, 818 F.2d at 254, 2 U.S.P.Q.2d 1677 (2d Cir. 1987); *Securacomm Consulting, Inc. v. Securacom Inc.*, 984 F. Supp. 286, 45 U.S.P.Q.2d 1576 (D.N.J. 1997), *rev'd on other grounds*, 166 F.3d 182, 49 U.S.P.Q. 1444 (3d Cir. 1999); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167 (N.D.N.Y. 1995); *Blockbuster Ent. Group v. Laylco, Inc.*, 869 F. Supp. 505, 33

applied the theory to a trademark controversy in *Elvis Presley Enters., Inc. v. Capece*.[31] The plaintiffs, who were assignees and registrants of all trademarks, copyrights, and publicity rights belonging to the Elvis Presley estate, objected to the defendant's use of the service mark "Velvet Elvis" for its sixties theme nightclub.[32] The Fifth Circuit based its finding for the plaintiffs, in part, on the theory of initial interest confusion, stating "[d]espite the confusion being dissipated, this initial-interest confusion is beneficial to the Defendants because it brings patrons in the door . . . Once in the door, the confusion has succeeded because some patrons may stay, despite realizing that the bar has no relationship with Elvis Presley Enterprises, Inc., (EPE)."[33] The court noted, "[i]nitial-interest confusion gives the junior user credibility during the early stages of a transaction and can possibly bar the senior user from consideration by the consumer once the confusion is dissipated."[34] Thus, the theory of initial interest confusion originated long before the Internet and remains viable outside of cyberspace today.

While the theory of initial interest confusion is neither new nor solely applicable to cyberspace, it has received much attention in its application to metatags.[35] The notoriety of the doctrine in the metatag[36] context has led some critics to argue that market regulation should

---

U.S.P.Q.2d 1581 (E.D. Mich. 1994); *Jordache Enter., Inc. v. Levi Strauss & Co.*, 841 F. Supp. 506, 30 U.S.P.Q.2d 1721 (S.D.N.Y. 1993); *Sara Lee Corp. v. Kayser-Roth Corp.*, 1992 WL 436279 (M.D.N.C. Dec. 1, 1992); *Television Enter. Network, Inc. v. Entertainment Network, Inc.*, 630 F. Supp. 244, 229 U.S.P.Q. 47 (D.N.J. 1986); *Source Perrier, S.A. v. Waters of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617 (S.D.N.Y. 1982); *Dreyfus Fund Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 213 U.S.P.Q. 872 (S.D.N.Y. 1981); *Koppers Co. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 210 U.S.P.Q. 711 (W.D. Pa. 1981).

31 141 F.3d 188, 46 U.S.P.Q.2d 1737 (5th Cir. 1998).

32 *See id*. at 191-92, 46 U.S.P.Q.2d at 1738.

33 *Id.* at 204, 46 U.S.P.Q.2d at 1749.

34 *Id.*

35 *See e.g.* Stanley U. Paylago, *Trademark Infringement, Metatags, and the Initial Interest Confusion Remedy*, 9 Fall Media L. & Pol'y 49, 63-65 (2000); Posner, *supra* n. 5, at 505 (supporting the approach taken by the court in *Brookfield Commun., Inc.*, 174 F.2d at 1036, 50 U.S.P.Q.2d at 1545).

36 Metatags are Hyper Text Markup Language (HTML) code intended to describe a web site and are used by search engines. *See e.g., Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d at 1045, 50 U.S.P.Q. at 1550.

control cyberspace.[37] While the Internet is still a relatively new medium, courts seem clear that intellectual property law still applies:

> [s]ome of the evidence in this case strongly suggests that some companies operating in the area of the Internet may have a misconception that, because their technology is somewhat novel, they are somehow immune from the ordinary applications of laws of the United States . . . . They need to understand that the law's domain knows no such limits.[38]

Thus, a new medium is not sufficient justification to disregard the current body of intellectual property jurisprudence.

Brookfield Commun., Inc. v. West Coast Ent. Corp.[39] is one of the most influential cases that has applied initial interest confusion in the Internet context. Brookfield Communications, Inc. ("Brookfield") gathered and sold information about the entertainment industry.[40] Specifically, Brookfield marketed a searchable database containing entertainment industry related information under the mark "MovieBuff," a federally registered mark.[41] West Coast Entertainment Corp. (hereinafter West Coast) began marketing a database similar to "MovieBuff" at the domain name <www.moviebuff.com>.[42] In addition to using Brookfield's trademark in its domain name, West Coast also placed the trademark in the metatags of its web site.[43] Thus, the issue was whether using a competitor's trademark in the metatags of one's web site was an infringing use. As noted earlier, use of a competitor's trademark is insufficient to sustain a cause of action under the Lanham Act, because a trademark is not an absolute property right.[44] Instead, the court must determine whether a likelihood of confusion exists.[45]

The Ninth Circuit Court of Appeals engaged in a detailed discussion of the issues in deciding to apply the initial interest confusion

---

37 *See e.g.* Shannon N. King, *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 15 Berkeley Tech. L.J. 313, 326-27 (2000); F. Gregory Lastowka, *Search Engines, HTML, and Trademarks: What's the Meta for?*, 86 Va. L.Rev. 835, 838 (2000).

38 *UMG Recordings, Inc. v. MP3.Com, Inc.*, 2000 WL 1262568 at *6 (S.D.N.Y. Sept. 6, 2000) (deciding a copyright issue).

39 174 F.3d 1036, 50 U.S.P.Q.2d 1545 (9th Cir. 1999).

40 *See id.* at 1041, 50 U.S.P.Q.2d at 1547.

41 *See id.* at 1041-42, 50 U.S.P.Q.2d at 1547.

42 *See id.* at 1042, 50 U.S.P.Q.2d at 1547.

43 *See id.* at 1061, 50 U.S.P.Q.2d at 1563.

44 *See e.g.* McCarthy, *supra* n. 1, at § 2:14.

45 *See* McCarthy, *supra* n. 1, at vol. 1, § 23:1.

doctrine.[46] First, the court described the potential harm: "[e]ntering '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. . . ."[47] The court then recognized many of the arguments put forth challenging the application of the initial interest confusion doctrine to metatags.[48] The court acknowledged that confusion resulting from the search engine was less than the confusion created by including a competitor's trademark in one's domain name.[49] Moreover, the court acknowledged many scholars' concerns.[50]

> 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.[51]

In spite of the indications that confusion would be dissipated, the court found it necessary to apply the initial interest confusion doctrine,[52] holding that:

> [n]evertheless, West Coast's use of "moviebuff.com" in metatags will still 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 sizeable number of consumers who were originally looking for Brookfield's product will simply decide to utilize West Coast's offerings instead. Although . . . 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

---

46 *See Brookfield Commun., Inc.*, 174 F.3d at 1061-65, 50 U.S.P.Q.2d at 1563-66.

47 *Id.* at 1062, 50 U.S.P.Q.2d at 1563.

48 *See id*. at 1061-66, 50 U.S.P.Q.2d at 1563-66.

49 *See id.* at 1062, 50 U.S.P.Q.2d at 1563.

50 *See id*.

51 *Id.* at 1062, 50 U.S.P.Q.2d at 1563-64.

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

> "MovieBuff" to its web site, West Coast improperly benefits from the goodwill that Brookfield developed in its mark.[53]

This analysis not only explained why the concerns to applying the initial interest confusion doctrine were misguided but also presented the harm caused by such a use. While this explanation was sufficient, the court continued with a now famous (or infamous) analogy ("billboard analogy"):

> [s]uppose 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 there is Blockbuster right there.[54]

The court continued by distinguishing initial interest confusion from more traditional forms of confusion, stating that:

> [c]ustomers 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.[55]

While the billboard analogy attempted to place the world of cyberspace into the more comfortable world of brick and mortar, doing so created many more problems than it solved.

First, cyberspace is a unique context, and therefore any analogy to the brick and mortar world will be imperfect. This is not necessarily problematic in its own right, yet it has turned out to be so. The billboard analogy has the feel that it was placed in the opinion to help those not entirely comfortable with the Internet. This was unnecessary because it seems that jurists, scholars, and businesses that work within cyberspace have an adequate understanding of the Internet. Second, the billboard analogy has become a lightening rod for criticism.[56] This is troubling

---

53 *Id.*

54 *Id.* at 1064, 50 U.S.P.Q.2d at 1565.

55 *Id.*

56 *See e.g. Birahi v. Gross*, 119 F. Supp. 2d 309, 320 n. 15, 56 U.S.P.Q.2d 1489,1498 n. 15 (S.D.N.Y. 2000) (criticizing the metaphor used in *Brookfield Commun., Inc.*, 174

because the analogy did not serve as the basis for the holding. To understand initial interest confusion as applied to metatags and the *Brookfield* holding, one must turn to the court's language prior to the billboard analogy. Moreover, the *Brookfield* reasoning has been elaborated upon in subsequent decisions. In *Bigstar Ent., Inc. v. Next Big Star, Inc.,*[57] the District Court for the Southern District of New York discussed the ways in which initial interest confusion could damage a plaintiff.[58]

> The diversion of initial interest and the resulting relevant confusion under this doctrine relate to what *draws* the consumer to the *other* location in the first place. Even if the customer quickly becomes aware of the competing source's actual identity and can rectify the mistake, the damage to the first user that the courts have identified manifest in three ways: the original diversion of the prospective customers' interest; the potential consequent effect of that diversion on the customer's ultimate decision whether or not to purchase caused by an erroneous impression that two sources of a product may be associated; and the initial credibility which may be accorded by the interested buyer to the junior user's products--customer consideration that otherwise may be unwarranted and that may be built on the strength of the senior user's mark, reputation and goodwill.[59]

Nevertheless, the application of the initial interest confusion doctrine in the Internet context has been widely criticized.[60] Some have argued that *Brookfield*'s logic was flawed, because the doctrine of initial interest confusion requires a web user to actually go to the potentially infringing web site and be confused at that time.[61] Another common criticism of *Brookfield* involves the high level of sophistication of web users, or their unique expectations, both of which make the application of the initial interest confusion doctrine inappropriate.[62] Others have argued

---

F.3d at 1064, 50 U.S.P.Q.2d at 1565); Mark T. Garrett, *Recent Developments in Trademark Law*, 8 Tex. Intell. Prop. L.J. 101, 106 (1999); King, *supra* n. 37, at 325-26; Lastowka, *supra* n. 37, at 856-57. *Cf.* Posner, *supra* n. 5, at 439-44 (focusing on the billboard analogy in supporting the *Brookfield Commun., Inc.,* 174 F.3d at 1064, 50 U.S.P.Q.2d at 1565 decision).

[57] 105 F. Supp. 2d 185, 54 U.S.P.Q.2d 1685 (S.D.N.Y. 2000).

[58] *See id*. at 207, 54 U.S.P.Q.2d at 1700.

[59] *Id*.

[60] *See e.g.* Mills, *supra* n. 5, at 21-29; King, *supra* n. 36, at 325-36; Nathenson, *supra* n. 18, at 113-47; Sees, *supra* n. 5, at 112-17; Scott Shipman, *Trademark and Unfair Competition in Cyberspace: Can These Laws Deter "Baiting" Practices on Web Sites?*, 39 Santa Clara L. Rev. 245, 283 (1998) (arguing that current trademark laws need to be amended in order to encompass metatags).

[61] *See* Mills, *supra* n. 5, at 25.

[62] *See* King, *supra* n. 37, at 325-36.

that the initial interest confusion doctrine as applied to metatags is inconsistent with fundamental principles of trademark law.[63] These misconceptions will be exposed herein. *Brookfield* does an outstanding job of articulating the harm and applying the initial interest confusion doctrine, yet the court admittedly did not articulate a helpful standard that could be used for guidance in future cases. While some have praised this "flexibility,"[64] these supporters of *Brookfield* miss the mark. Without any guidance, the initial interest confusion doctrine is nothing more than an intuitive standard that judges can apply at their whim. Thus, *Brookfield* left a rapidly growing and potentially overbroad doctrine without limits. The lack of a standard will be addressed by reconnecting the doctrine with its often-overlooked brick and mortar foundation.

While initial interest confusion in the Internet context has garnered a great deal of attention, the applicability of the theory is fairly well settled law.[65] Thus, the more pressing issue to examine is the scope and contours of the doctrine, as well as attempting to derive some ordering principles for guidance. While the *Brookfield* court recognized the harm and properly applied the initial interest confusion doctrine, it admittedly left the doctrine's application far too pliable. The other seminal case in this area of jurisprudence, *Playboy Enters., Inc. v. Terri Welles Inc.*,[66] took the contrary approach in severely limiting the application of the doctrine.

II. PLAYBOY ENTERS., INC. V. TERRI WELLES, INC.: THE MISUNDERSTANDING OF THE INITIAL INTEREST CONFUSION DOCTRINE

Terri Welles ("Welles"), a self-employed model and spokesperson, began her modeling career with Playboy Enterprises, Inc. ("Playboy") in 1980.[67] She appeared on the cover of the May 1980 issue of *Playboy Magazine* and was featured as the "Playmate of the Month" in

---

63 *See id.* at 325; Mills, *supra* n. 5, at 21-29; Nathenson, *supra* n. 18, at 113-47; Sees, *supra* n. 5, at 112-17; Scott Shipman, *Trademark and Unfair Competition in Cyberspace: Can These Laws Deter "Baiting" Practices on Web Sites?*, 39 Santa Clara L. Rev. 245, 283 (1998) (arguing that current trademark laws need to be amended in order to encompass metatags).

64 *See* Posner, *supra* n. 5, at 505; Paylago, *supra* n. 35, at 63-65.

65 *See e.g. Brookfield Commun., Inc.*, 174 F.3d at 1036, 50 U.S.P.Q.2d at 1545 (9th Cir. 1999).

66 78 F. Supp 2d 1066 (S.D. Cal. 1999).

67 *See Playboy Enters., Inc. v. Terri Welles, Inc.*, 78 F. Supp. 2d 1066, 1071 (S.D. Cal. 1999).

the December 1980 issue.[68] In 1981, Welles was designated as the "Playmate of the Year," and she has continually referred to herself as a "Playmate" or "Playmate of the Year" with the knowledge of Playboy since 1980.[69] Playboy owns the federally registered trademarks for "Playboy," "Playmate," "Playmate of the Month," and "Playmate of the Year."[70] In 1997, Welles launched a web site at <www.terri.welles.com> that contained, among other things, photographs of her and others.[71] Playboy had its own web sites at <www.playboy.com> and <www.cyber.playboy.com>.[72] While Welles used "Playmate of the Year 1981" and "Playboy Playmate of the Year 1981" in the text of her web site,[73] the more relevant issue for the purposes of this article is what was not visible.

The meta code description of Welles's web site was as follows: "Playboy Playmate of the Year 1981 Terri Welles website featuring erotic nude photos, semi-nude photos, softcore and exclusive Members Club."[74] The metatag keywords included the following list of words: "terri, welles, playmate, playboy, model, models, semi-nudity, naked, breast, breasts, tit, tits, nipple, nipples, ass, butt."[75]

The District Court for the Southern District of California analyzed the use of metatags in three sections. First, the court examined the fair use defense.[76] Second, the court examined potential confusion with respect to the visible text.[77] Third, the court examined potential confusion with respect to the meta-text.[78] Before looking at the court's analysis, though, it is helpful to understand the applicable legal standards.

Welles argued that, as a matter of law, she was entitled to summary judgment because her use of the trademarks was a "fair use."[79] Fair use is a defense to liability under the Lanham Act that allows a mark to be

---

[68] *See id.*

[69] *See id.*

[70] *See id.*

[71] *See id.*

[72] *See id.*

[73] *See id.*

[74] *Id.* at 1091.

[75] *Id.*

[76] *See id.* at 1073-76.

[77] *See id.* at 1076-91.

[78] *See id.* at 1091-95.

[79] *See id.* at 1073.

used in a non-trademark, descriptive sense.[80] Three elements must be proven to establish the fair use defense: "1. Defendant's use of the term is not as a trademark or service mark; 2. Defendant uses the term 'fairly and in good faith;' and 3. Defendant uses the term '*[o]nly* to describe' its goods or services."[81] While this test appears important, its role becomes less clear when one understands how fair use is generally viewed.

A majority of the circuits, including the Ninth Circuit, hold that it is inconsistent to find both a likelihood of confusion and fair use.[82] The *Welles* court acknowledged this in noting, "a showing of likely confusion bars a defendant's reliance on the fair use defense."[83] Moreover, the court only briefly examined the fair use factors and then concluded that "the dispositive issue in deciding whether there is a genuine dispute of material fact as to Ms. Welles's non-trademark use of [the Playboy] trademarked terms in her website is the likelihood of confusion."[84] Thus, one must determine whether the defendant's use created a likelihood of confusion, irrespective of whether the use satisfied the prongs of the fair use defense.

The court then described a second kind of fair use—nominative fair use—that does not necessitate a likelihood of confusion analysis.[85]

> Notwithstanding the Ninth Circuit's clear adoption of the view that a fair use cannot simultaneously be a confusing use, it recently decided in 1991 in the case of *New Kids on the Block v. News America Publishing, Inc.* that there is a *different* type of fair use that "lies outside the strictures of trademark law" because it "does not implicate the source-identification function."[86]

According to the court, this type of fair use is invoked where the only words reasonably available to describe a particular thing are the trademarks.[87] In these limited situations, the court noted the traditional likelihood of confusion analysis gives way to a special three-pronged

---

[80] *See* 15 U.S.C. § 1115(b)(4) (1999).

[81] *Playboy Enters., Inc.*, 78 F. Supp. 2d at 1074.

[82] *See* McCarthy, *supra* n. 1, at vol. 2, § 11:47.

[83] *Playboy Enters., Inc.*, 78 F. Supp. 2d at 1074.

[84] *Id*. at 1081.

[85] *See id*. at 1075.

[86] *Id*. (citing *New Kids on the Block v. News America Publg. Inc.*, 971 F.2d 302, 308, 23 U.S.P.Q.2d 1534, 1538 (9th Cir. 1992)).

[87] *See id.*

test.[88] This nominative fair use defense insulates a commercial defendant if three requirements are met:

(1) the product or service in question must be one not readily identifiable without use of the trademark;
(2) only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and
(3) the defendant must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.[89]

If the defendant's use meets the three requirements, the presence or absence of confusion is irrelevant.

The *Welles* court found both that a likelihood of confusion was not present and the use fell within the exception of nominative fair use.[90] The court missed the mark on both findings, and in so doing, left the initial interest confusion doctrine in disarray.[91]

The court made three central arguments to support its finding for Welles (with respect to metatags). First, the court acknowledged *Brookfield* yet rejected the application of the initial interest confusion doctrine.[92] Uncontroverted evidence was presented that an appreciable number of people who used one of the plaintiff's trademarks in a search engine were, in fact, looking for the plaintiff's web sites; thus, the court acknowledged the presence of some initial interest confusion.[93] The court then attempted to demonstrate that the presence of initial interest confusion did not necessarily lead to a finding of trademark infringement.[94] It noted that *Brookfield* "held that a finding of initial interest confusion *can* be a basis for a finding of likelihood of confusion, but the presence of initial interest confusion does not necessarily support a finding of likelihood of confusion."[95] This characterization of the *Brookfield* holding is perplexing.

---

[88] *See id.*

[89] *Id*. at 1090.

[90] *See id.* at 1095-96.

[91] Contrary to the view herein, much of the literature criticizes *Brookfield Commun., Inc.* (as has been noted) and praises *Welles*. *See e.g.* Dan McCuaig, *Halve the Baby: An Obvious Solution to the Troubling Use of Trademarks as Metatags,* 18 John Marshall J. Computer & Info. L. 643, 654-70 (2000).

[92] *See Playboy Enters., Inc.*, 78 F. Supp. 2d at 1094.

[93] *See id*. at 1094.

[94] *See id*.

[95] *See id.*

In reading *Brookfield*, it is difficult to find support for the proposition asserted in *Welles.*[96] To the contrary, it seems that since initial interest confusion is sufficient to sustain a cause of action under the Lanham Act,[97] the presence of initial interest confusion necessarily supports a finding of likelihood of confusion. This is not to say that merely by using another's trademarks in the metatags of one's web site that initial interest confusion necessarily exists,[98] but if initial interest confusion is found to be present, then a likelihood of confusion also exists.[99] Moreover, this conclusion is entirely consistent with the initial interest confusion doctrine as developed in the brick and mortar context.[100]

The second argument introduced by the *Welles* court involved the need for several additional factors in order to make a finding of trademark infringement based upon the presence of initial interest confusion.[101] The court noted that the plaintiff failed to present evidence supporting:

(1) any initial interest confusion was "damaging and wrongful";
(2) anyone believed or was likely to believe there is a connection between [plaintiff's] and Ms. Welles's site;
(3) Ms. Welles received "opportunit[ies] for sale not otherwise available" by confusing web users; or
(4) any of Ms. Welles's actual customers were in the "appreciable number," or majority of people who when plugging in one of the Plaintiff's trademark terms into a web browser search engine, was "looking for Playboy's official site."[102]

Each factor, when taken in context of the case from which it was derived, does not appear to be an additional factor at all, but rather a further explanation of why initial interest confusion is actionable.

---

96 *Id.*

97 *See Brookfield Commun., Inc.*, 174 F.3d at 1063, 50 U.S.P.Q.2d at 1545.

98 *See* discussions within Sections III and IV describing the contours of the initial interest confusion doctrine and discussing the elements necessary for a finding of initial interest confusion.

99 *See* discussion in Section III.

100 *See e.g. Elvis Presley Enters. Inc.*, 141 F.3d at 204, 46 U.S.P.Q.2d at 1749-50; *Mobil Oil Corp.*, 818 F.2d at 260, 2 U.S.P.Q.2d at 1682; *Grotrain, Helfferich, Schultz, Th. Steinweg Nachfahren*, 523 F.2d at 1342, 186 U.S.P.Q. at 445.

101 *See Playboy Enters., Inc.*, 78 F. Supp. 2d at 1094.

102 *Id*.

For example, the first factor came from a case that never addressed a "damaging and wrongful" factor; instead, the court merely noted that this type of wrongful confusion or damaging misassociation was actionable.[103] Likewise, the second factor came from a case that did not require this additional element in order to find initial interest confusion; rather, the "factor" was the court's attempts to explain the initial interest confusion doctrine.[104] Similarly, the third factor came from a case that merely described the initial interest confusion doctrine.[105] The court did not provide any legal authority for the fourth factor, which implies the need for a transaction to have taken place (by referring to Welles's actual customers). This is contrary to the doctrine of initial interest confusion.[106] Thus, the fourth factor is oddly out of place in the analysis.

Additionally, a straightforward application of each of the three factors leads to a far different result than the one arrived at by the *Welles* court. The first factor, that the initial interest confusion is "damaging and wrongful," is met if the second and third factors are met. Thus, it is unclear what type of independent evidence (outside of the evidence to support the second and third factors) would meet this additional element.[107]

The evidence supports the second factor.[108] As was noted, both parties concurred that an "appreciable number" of people who use one of the plaintiff's trademarks in a search engine were looking for Playboy's official web site.[109] Moreover, when the defendant's web site appears on a search engine results list, the description, "Playboy Playmate of the Year 1981 Terri Welles website featuring erotic nude photos, semi-nude

---

[103] *See Koppers Co*., 517 F. Supp. at 844, 210 U.S.P.Q. at 718.

[104] *See Kompan A. S.*, 890 F. Supp. at 1180.

[105] *See Sara Lee Corp.*, 1992 WL 436279 at *24.

[106] Initial interest confusion does not require a purchase, as the doctrine involves confusion that is rectified before a purchase is made. *See e.g.* McCarthy, *supra* n. 1, at vol. 3, § 23:6.

[107] One might read this factor as requiring proof of actual confusion, yet this is entirely inconsistent with trademark law generally. Actual confusion, while probative, is never required to prove infringement. *See* McCarthy, *supra* n. 1, at vol. 3, § 23:12 and § 23:18; *Source Perrier S.A.*, 217 U.S.P.Q. at 620 (finding initial interest confusion in spite of no actual initial interest confusion in the brick and mortar context). *See M2 Software, Inc. v. Viacom, Inc.*, 119 F. Supp. 2d 1061, 1069 (C.D. Cal. 2000) (noting "[i]t is true that the absence of actual confusion is not dispositive.").

[108] *See Playboy Enters. Inc.*, 78 F. Supp. 2d at 1094.

[109] *Id*.

photos, softcore and exclusive Members Club,"[110] implies a connection between the plaintiff and the defendant.

Likewise, the evidence supports the third factor. Did the defendant's use of the plaintiff's trademarks in her metatags allow her to interest prospective customers by confusion with the plaintiff's product? The answer is a resounding "yes." Someone looking for Playboy's official web site or the type of soft-core pornography generally contained therein, who entered one of the plaintiff's trademarks into a search engine, would not be aware of the defendant's web site *but for* her use of the plaintiff's trademarks in her web site's metatags. Thus, Welles's use of the plaintiff's trademarks in her web site's metatags necessarily provided her with opportunities for sales not otherwise available. Since both the second and the third factors are met, the initial interest confusion was both damaging and wrongful—thus fulfilling the first factor. Therefore, the court's efforts to distance the initial interest confusion from a finding of trademark infringement, even if read in its most generous light, fail to support the court's ultimate finding.

A third argument the *Welles* court made was that the use of trademarks in the metatags was nominative fair use.[111] Irrespective of the court's analysis of the three nominative fair use factors, the court erred in its application of the test by misunderstanding *New Kids on the Block v. News America Publg., Inc.*[112]

As the Ninth Circuit noted, the situation in *New Kids on the Block* was atypical, as the defendant was not using the plaintiff's trademark to describe the defendant but was actually referring to the plaintiff (i.e., plaintiff's newspapers ran a telephone poll to determine the popularity of each group member).[113] Because of the unusual situation of *New Kids on the Block*, the court explicitly noted that it did not intend to change the test to be applied in traditional fair use cases by stating, "[i]f the defendant's use of the plaintiff's trademark refers to something other than the plaintiff's product, the traditional fair use inquiry will continue to govern." [114] Rather, the court introduced a new test to be used only in this new situation "[w]here the defendant uses a trademark to describe the plaintiff's product rather than its own, we hold that a commercial user is entitled to a nominative fair use defense."[115]

---

[110] *Id.* at 1091.

[111] *See id*. at 1096.

[112] 971 F.2d 302, 23 U.S.P.Q.2d 1534 (9th Cir. 1992).

[113] *See id.* at 308, 23 U.S.P.Q.2d at 1538.

[114] *Id.*

[115] *Id.*

This was not the case in *Welles*, as she was using the plaintiff's trademarks to refer to herself and not the plaintiff.[116] "[Welles] has always *referred to herself* as a 'Playmate' or 'Playmate of the Year.' "[117] Thus, the *Welles* court, by ignoring the antecedent of the nominative fair use test, erroneously applied the test to a situation the test was never intended to cover.

Based upon this extended legal analysis, the *Welles* court's attempts not to apply the initial interest confusion doctrine were in error. Moreover, viewing the case from a broader perspective further solidifies this conclusion. Based on *Brookfield* and its progeny, as well as its brick and mortar roots, initial interest confusion is a form of confusion sufficient to sustain a cause of action under the Lanham Act,[118] and it was the law in the Ninth Circuit when *Welles* was decided.[119] In reviewing the facts of *Welles*, it is apparent that this was a classic case of initial interest confusion—specifically the kind of confusion that raised the ire of the court in *Brookfield*.

Imagine the following, highly probable, scenario. A web user is searching for soft-core pornography on the Internet—specifically, a user is attempting to find images of the type and quality ordinarily associated with Playboy. The user enters the trademark "Playboy" into a search engine, and a list of possible web site matches is produced. In briefly skimming the keyword descriptions of the web sites, the user finds three sites that contain the Playboy name (i.e., the Playboy's two official web sites and Welles's web site). The user arbitrarily chooses one of the three web sites, which happens to be Welles's web site, and clicks on the hyperlink. When the web user is taken to Welles's web site, he immediately sees the profile of a seductively posed woman with her breast and nipple exposed, in addition to a disclaimer on the web site noting that the web site is not affiliated with Playboy. Even if the user takes the time to read the disclaimer (rather than focusing on the woman) and realizes that the web site is not an official Playboy web site, the user may not return to the search list. Instead, the user will likely continue viewing the site and may even become a member. In this situation, Welles would not have received this customer *but for* her use of Playboy's trademarks. Additionally, the trademarks belonged to a direct competitor. Welles is using Playboy's protected trademarks in an attempt to compete for the same customer base. This usage is the type of harm the *Brookfield* court was

---

[116] *See Playboy Enters., Inc.*, 78 F. Supp. 2d at 1071 (emphasis added).

[117] *Id*.

[118] *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1065, 50 U.S.P.Q.2d 1545, 1566 (9th Cir. 1999).

[119] *Id*.

attempting to prevent in applying the initial interest confusion doctrine to metatags. Moreover, the disclaimers on Welles's web site are of little relevance. Disclaimers on web sites have been found to be essentially useless with respect to mitigating initial interest confusion.[120] By the time the user has reached and viewed the web site, the damage has already been done.[121] Thus, the situation in *Welles* is a classic case of initial interest confusion and trademark infringement.

The opinion in *Welles*, nevertheless, has received relatively little criticism and much support.[122] What, then, was going on? Besides doctrinal criticisms, the outcome of this case was probably correct—Welles ought to have been able to use the trademarks in the way she did. Since a sound application of the law indicates a finding for the plaintiff, why are intuitions so strong for the defendant?

It appears the outcome of this case was driven by several facts, all of which were prominently highlighted in the text of the opinion (and all of which were unnecessary for the application of the initial interest confusion doctrine or the fair use tests). Since 1980, the court noted that Welles had "always referred to herself as a 'Playmate' or 'Playmate of the Year' with the knowledge of the [plaintiff]."[123] Mr. Hugh Hefner of Playboy Enterprises even admitted that he "always encouraged Playmates or Playmates of the Year to use their fame to promote themselves or make a living in connection with television . . . radio . . . [a]nd movies."[124] Moreover, Welles contended that Mr. Hefner "initially complimented her website and encouraged her use of the title 'Playmate of the Year 1981.'"[125] Thus the driving force in the opinion was the affirmative defense of acquiescence.

Acquiescence involves a trademark owner conveying through affirmative word or deed its implied consent to another to use the trademark.[126] The defendant's reliance on this consent can create an estoppel preventing the trademark owner from asserting her rights.[127] Based on

---

[120] *See e.g. Ford Motor Co. v. Ford Fin. Solutions, Inc.*, 103 F. Supp. 2d 1126, 1128 (N.D. Iowa 2000); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190, 54 U.S.P.Q.2d 1383, 1394 (W.D.N.Y. 2000).

[121] *See e.g.* McCarthy, *supra* n. 1, at vol. 3, § 23:1.

[122] *See e.g.* McCuaig, *supra* n. 91, at 654-72; Mills, *supra* n. 5, at 20 (arguing that no confusion was present in the case).

[123] *See Playboy Enters., Inc.*, 78 F. Supp. 2d at 1071.

[124] *Id.* at 1079.

[125] *Id.* at 1072.

[126] *See* McCarthy, *supra* n. 1, at vol. 5, § 31:41.

[127] *See id.*

the facts of this case, Playboy acquiesced in Welles's use of its trademarks. Not only did Playboy encourage her to use the terms, but also Mr. Hefner initially complimented Welles on her web site. The affirmative actions by Playboy ought to have resulted in a forfeiture of Playboy's cause of action.

Since the defendant raised the affirmative defense of acquiescence,[128] it is unclear why the court even needed to reach the issue of initial interest confusion. The court did acknowledge the affirmative defense of acquiescence in a prior opinion,[129] but its cursory dismissal of it in a footnote was peculiar, the court noted that "[d]efendant raises the issue of [plaintiff's] acquiescence in Ms. Welles's use of the terms Playmate, Playmate of the Month, and Playmate of the Year. . . . The court does not find it necessary to decide if this defense is applicable in this case."[130] This puzzling dismissal of a seemingly appropriate defense without explanation is difficult to understand. Thus, the problems with this case have less to do with the initial interest confusion doctrine and more to do with a peculiar judicial determination in a prior opinion. Moreover, the early rejection of the defense prevented the plaintiff from addressing the issues apparently driving the opinion.

This puzzle remains oddly unexplained: Why would a court reject a defense with no explanation, and instead base a decision on muddled legal reasoning and incoherent distinctions? One plausible explanation is judicial activism. The bench saw *Welles* as an opportunity to either undermine the theory or severely cut back its coverage. Another explanation is that the *Welles* decision was an overreaction to the overly pliable theory articulated in *Brookfield*. The court attempted to curtail some of the discretion and potentially monopolistic trademark rights that might otherwise result. Whatever the motivation, the result left the initial interest confusion doctrine in utter disarray. The remainder of the article will examine where the contours of the initial interest confusion doctrine lie by looking at the brick and motor roots.

III. INITIAL INTEREST CONFUSION—DEFINED

The first issue to resolve is what constitutes initial interest confusion. Rather than speculate how this doctrine ought to be characterized, it is helpful to reconnect the initial interest confusion doctrine with its

[128] *See Playboy Enters., Inc.*, 78 F. Supp. 2d at 1072.

[129] *See Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 47 U.S.P.Q.2d 1186 (S.D. Cal. 1998).

[130] *Id.* at 1190 n. 3.

brick and mortar roots before making any necessary modifications for the new context of cyberspace.

The Part II discussion of *Welles* necessarily implicated key distinctions that are often either overlooked or conflated in discussions of initial interest confusion. In using the term *initial interest confusion*, are we referring to the possibility of initial interest confusion, the likelihood of initial interest confusion, or actual initial interest confusion? Moreover, how do any of these terms relate to a finding of a likelihood of confusion and therefore trademark infringement?

The labels *possibility of initial interest confusion*, *likelihood of initial interest confusion*, and *actual initial interest confusion* ought to be used in a way analogous to labels describing traditional confusion (i.e., possibility of consumer confusion,[131] likelihood of consumer confusion,[132] and actual consumer confusion).[133] Not only does this make intuitive sense, but also it is precisely how the concepts were used in pre-Internet initial interest confusion cases.[134]

The first label, possibility of initial interest confusion, is analogous to a possibility of confusion and neither requires, nor precludes, a finding of trademark infringement. This example would be the situation in *Welles.* While the court concluded that some initial interest confusion was present, it then needed to determine if "enough" was present to necessitate a finding of infringement.[135] This finding is similar to concluding that there was a possibility of initial interest confusion.[136] This distinction is also evident in the brick and mortar roots of the initial interest confusion doctrine.[137] In the Internet context, a possibility of

[131] *See* McCarthy, *supra* n. 1, at vol. 3, § 23:3.

[132] *See id.*

[133] *See id.* at vol. 3 §§ 23:12 – 23:18.

[134] *See* Charles E. Bruzga, *Sophisticated Purchaser Defense Avoided Where Pre-Sale Confusion is Harmful—A Brief Note,* 78 Trademark Rep. 659, 660-64 (1988) (noting the difference between actionable instances of initial interest confusion and those that are not actionable, even though actual initial interest confusion may be present).

[135] *See Playboy Enters., Inc. v. Terri Welles, Inc.*, 78 F. Supp. 2d 1066, 1094 (S.D. Cal. 1999).

[136] *See Teletech Customer Care Mgt. (Cal.), Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1414, 42 U.S.P.Q.2d 1913, 1919 (C.D. Cal. 1997) (holding that the presence of some initial interest confusion was insufficient to support a finding of a likelihood of confusion).

[137] *See Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 193, 46 U.S.P.Q.2d 1737, 1739 (5th Cir. 1998) (noting, in the brick and mortar context, the difference between a possibility of confusion and the likelihood of confusion); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207, 220 U.S.P.Q. 786, 792 (1st

initial interest confusion means that a trademark is being used in the metatags of the web site of another. Without further analysis, it tells us nothing.

The second label, a likelihood of initial interest confusion, is analogous to a likelihood of confusion and necessitates a finding of trademark infringement. This example would be the situation in *Brookfield*. While the court did not have any empirical evidence of actual confusion, the likelihood of initial interest confusion was sufficient to find infringement.[138] Likewise, brick and mortar cases support this conclusion.[139]

The third label, actual initial interest confusion, is analogous to actual confusion and would be probative, but not dispositive, of finding a likelihood of initial interest confusion. In such a situation, empirical evidence exists that demonstrates consumers were actually confused.[140] As with a traditional likelihood of confusion analysis, a finding of actual initial interest confusion is unnecessary to make a finding of trademark infringement, but it is probative of determining whether a likelihood of initial interest confusion exists.[141] This result would be the situation in *Elvis Presley Enters*. The evidence demonstrated that at least one instance of actual initial interest confusion, as one of the witnesses was

---

Cir. 1983) (holding, in the brick and mortar context, that the possibility of initial interest confusion was insufficient to support a finding of a likelihood of confusion); *Television Enter. Network, Inc. v. Entertainment Network, Inc.*, 630 F. Supp. 244, 247, 229 U.S.P.Q. 47, 49 (D.N.J. 1986) (holding, in the brick and mortar context, that "[e]ven if the confusion is cured at some intermediate point before the deal is completed, the initial confusion *may* be damaging and wrongful") (emphasis added); Sees, *supra* n. 5, at 103 (discussing the difference between a possibility of confusion and a likelihood of confusion).

138 *See Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1061-67, 50 U.S.P.Q.2d 1545, 1562-67 (9th Cir. 1999).

139 *See e.g. Elvis Presley Enters., Inc.*, 141 F.3d at 193, 46 U.S.P.Q.2d at 1740 (finding a likelihood of initial interest confusion and therefore trademark infringement); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259, 2 U.S.P.Q.2d 1677, 1681 (2d Cir. 1987) (finding a likelihood of initial interest confusion and therefore trademark infringement); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachfahreu v. Steinway & Sons*, 523 F.2d 1331, 1341, 186 U.S.P.Q. 436, 444 (2d Cir. 1975) (finding a likelihood of initial interest confusion and therefore trademark infringement); *Sara Lee Corp. v. Kayser Roth Corp.*, 1992 WL 436279 at *24 (M.D.N.C. Dec. 1, 1992) (finding a likelihood of initial interest confusion and therefore trademark infringement); *Koppers Co. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 844-45, 210 U.S.P.Q. 711, 718 (W.D. Pa. 1981) (finding a likelihood of initial interest confusion and therefore granting injunctive relief).

140 *See*, McCarthy, *supra* n. 1, at vol. 3, §§ 23:12–23:13.

141 *See*, McCarthy, *supra* n. 1, at vol. 3, §§ 23:12–23:18.

initially confused, stayed and purchased a beer.[142] The court noted that this evidence was probative, but not dispositive, of the ultimate likelihood of an initial interest confusion conclusion.[143]

Thus, for the purposes of trademark infringement, the central focus ought to be a likelihood of initial interest confusion. Even mentioning that a possibility of initial interest confusion exists is undesirable. This type of discussion leads to unnecessary uncertainty, as was the situation in *Welles.* Since the court was faced with determining whether enough initial interest confusion was present, it was forced to introduce a wide array of factors that led to a muddled decision.[144] Under the standard put forth here, the *Welles* court would have found that only a possibility of initial interest confusion was present (and therefore no trademark infringement), or it would have found a likelihood of initial interest confusion (and therefore trademark infringement). (It could have also found a third possibility: the presence of actual initial interest confusion, which would have been probative, but not dispositive, of a likelihood of initial interest confusion.) Thus, a finding of a likelihood of initial interest confusion is analogous to a finding of a likelihood of confusion. Using these labels will prevent some of the confusion that resulted in the *Welles* opinion. This new standard is not only more practical and precise, but it also comports with the fundamental principle of trademark law: the prevention of consumer confusion.[145] Moreover, this standard is only new in the sense that it has yet to be articulated in the Internet context, as its roots are firmly embedded in the history of the initial interest confusion doctrine, in the brick and mortar context, as well as traditional trademark jurisprudence.

This new semantic standard begs an obvious question, though. What constitutes initial interest confusion (or more precisely, the likelihood of initial interest confusion)? Professor J. Thomas McCarthy provides an adequate definition in noting that initial interest confusion involves infringement based on confusion that creates initial customer

---

142 *See Elvis Presley Enters., Inc.*, 141 F.3d at 204 n.7, 46 U.S.P.Q.2d at 1749.

143 *Id.*; *Mobil Oil Corp.*, 818 F.2d at 259, 2 U.S.P.Q.2d at 1681 (holding, in the brick and mortar context, that actual initial interest confusion was probative but not dispositive of a finding of a likelihood of confusion); *Astra Pharm. Prods., Inc.*, 718 F.2d at 1207, 220 U.S.P.Q. at 791-92 (holding, in the brick and mortar context, that actual initial interest confusion was insufficient to support a finding of a likelihood of confusion).

144 *See Playboy Enters., Inc.*, 78 F. Supp. 2d 1066; *Teletech Customer Care Mgt. (Cal.), Inc.*, 977 F. Supp. at 1410-14, 42 U.S.P.Q.2d at 1916-19 (finding some initial interest confusion present but not enough to sustain a finding of a likelihood of confusion).

145 *See* McCarthy, *supra* n. 1, at vol. 1, § 2:8.

interest even though no transaction takes place because of the confusion.[146] In the brick and motor context, the courts embraced several other definitions. One court noted that "[w]e point out that the fact that confusion as to the source of a product or service is eventually dispelled does not eliminate the trademark infringement which has already occurred."[147] Another court noted that "securing the initial business contact by the defendant because of an assumed association between the parties is wrongful even though the mistake is later rectified."[148] Likewise,"[t]he law requires only that some form of confusion be proved likely, not that it be shown to persist and to cause lost sales."[149] Another court noted that "[t]ypes of confusion that constitute trademark infringement include where . . . potential consumers initially are attracted to the junior user's mark by virtue of its similarity to the senior user's mark, even though these consumers are not actually confused at the time of purchase."[150] Moreover, "[t]his is precisely the type of unfair trade practice [initial interest confusion] the Lanham Act was created to prevent."[151] While these definitions are adequate in articulating the doctrine in the abstract, they do little more. They merely describe a type of harm (much as the *Brookfield* court did), but they leave open important questions. How should the initial interest confusion doctrine be conceptualized and applied?

Initial interest confusion can plausibly be seen either as a factor probative of likelihood of confusion, or as a subspecies of likelihood of confusion. While these two conceptualizations overlap, and either is plausible, the initial interest confusion doctrine is best viewed as a subspecies of likelihood of confusion. Initial interest confusion is more analogous to reverse confusion (another subspecies of likelihood of confusion) than to any one of the factors probative of a likelihood of confusion (e.g., strength of mark, relatedness of goods, etc.).[152] Moreo-

---

[146] *See id.*, at vol. 3, § 23:6.

[147] *Forum Corp. of North America v. Forum, Ltd.*, 903 F.2d 434, 442 n.2, 14 U.S.P.Q.2d 1950, 1957 n.2 (7th Cir. 1990).

[148] *Koppers Co.,* 517 F. Supp. at 844, 210 U.S.P.Q. at 718.

[149] *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 1122, 213 U.S.P.Q. 872, 882 (S.D.N.Y. 1981).

[150] *Jordache Enters., Inc. v. Levi Strauss & Co.,* 841 F. Supp. 506, 514-15, 30 U.S.P.Q.2d 1721, 1726 (S.D.N.Y. 1993).

[151] *Sara Lee Corp.*, 1992 WL 436279 at *24.

[152] This conceptualization is definitional and based on my previous labels. Either conceptualization is adequate, and both would lead to comparable analyses. More specifically, if initial interest confusion were conceptualized as a factor probative of likelihood of confusion, initial interest confusion would be defined as the use of

ver, this is how the courts have treated the doctrine in its various pre-Internet applications.[153] Even though the doctrine is sometimes discussed in conjunction with a factor probative of confusion, the courts conceptualize initial interest confusion as a subspecies of confusion.[154] Regardless

another's trademark in the metatags of another's website. Then, the other factors (e.g. similarity of goods and services, strength of mark, etc.) would be used to determine whether a likelihood of confusion existed. Thus, one would be faced with the dilemma of the *Welles* court of determining how much initial interest confusion was necessary to sustain a finding of infringement (i.e. a court would be forced to attempt to "quantify" an abstract concept as part of a balancing test). Under my conceptualization, the result would likely be the same, but the application would differ slightly. Here, the use of another's trademark in the metatags of another's web site would only result in the possibility of initial interest confusion. Then, a multi-factored test would be used to determine whether a likelihood of initial interest confusion, and thus trademark infringement, existed. Under either conceptualization, the outcome would likely be the same; however, under the latter conceptualization, the analysis avoids the difficult and abstract question of "how much" initial interest confusion is enough. Moreover the historical roots of the doctrine support this intuitive comparison to other forms of confusion. *See e.g. Jordache Enters., Inc., infra* n. 153 and accompanying text. Commentators have viewed initial interest confusion in the same way. *See* Allen, *supra* n. 20, at 339-40, Posner, *supra* n. 5, at 453; Sees, *supra* n. 5, at 104-05.

[153] *See e.g. Securacomm Consulting, Inc. v. Securacom, Inc.*, 984 F. Supp. 286, 298-99, 45 U.S.P.Q.2d 1576, 1586-87 (D.N.J. 1997), *rev'd on other grounds*, 166 F.3d 182, 49 U.S.P.Q.2d 1444 (3d Cir. 1999) (conceptualizing the initial interest confusion as one of four types of actionable confusion); *Mobil Oil Corp.*, 818 F.2d at 260, 2 U.S.P.Q.2d at 1682 (describing initial interest confusion as a sufficient trademark injury rather than as a factor probative of confusion); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachfahreu*, 523 F.2d at 1342, 186 U.S.P.Q. at 445 (describing initial interest confusion as a type of harm rather than as a factor probative of confusion); *Blockbuster Ent. Group v. Laylco, Inc.*, 869 F. Supp. 505, 513, 33 U.S.P.Q.2d 1581, 1586-87 (E.D. Mich 1994) (conceptualizing initial interest confusion as a species of harm rather than a factor probative of confusion); *Jordache Enters., Inc.*, 841 F. Supp. at 514-15, 30 U.S.P.Q.2d at 1726 (classifying initial interest confusion as one of four types of actionable confusion); *Sara Lee Corp.*, 1992 WL 436279 at *24 (describing initial interest confusion as a type of harm rather than as a factor probative of confusion); *Source Perrier, S.A. v. Waters of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617, 620 (S.D.N.Y. 1982) (conceptualizing initial interest confusion as a species of confusion rather than a factor probative of it); *Dreyfus Fund, Inc.*, 525 F. Supp. at 1122, 213 U.S.P.Q. at 882-83 (conceptualizing initial interest confusion as a form of confusion rather than a factor probative of it); *Koppers Co.*, 517 F. Supp. at 844-45, 210 U.S.P.Q. at 717-18 (describing initial interest confusion as a species of likelihood of confusion rather than as a factor probative of it).

[154] *See Elvis Presley Enters., Inc.*, 141 F.3d at 204-05, 46 U.S.P.Q.2d at 1749-50 (discussing initial interest confusion in evaluating the actual confusion digit, yet conceptualizing it as a type of harm rather than a factor probative of confusion); *Kompan, A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1180 (N.D.N.Y. 1995) (discussing initial interest confusion in evaluating the consumer sophistication factor, yet conceptualizing it as a type of actionable confusion rather than a factor

of how it is conceptualized, though, it is important to note that initial interest confusion is not an alternative to a likelihood of confusion: it is merely another form of it.[155] This understanding is important in that it preserves the focus on the fundamental tenets of trademark law and helps to maintain coherence in the court's jurisprudence. Nevertheless, it is still unclear how this doctrine operates. Since initial interest confusion has been conceptualized as a subspecies of likelihood of confusion, we must determine the factors that will be considered in evaluating whether a likelihood of initial interest confusion is present.

IV. A NEW TEST

A. Traditional Likelihood of Confusion Analysis

To determine whether a defendant has infringed a plaintiff's trademark, courts apply a multi-factored likelihood of confusion test. Since we have been discussing cases within the Court of Appeals for the Ninth Circuit, we will look to the eight-factor test used there as a template for our discussion:

(1) the strength of the plaintiff's mark;
(2) relatedness of the goods;
(3) similarity of the marks;
(4) evidence of actual confusion;
(5) marketing channels;
(6) type of goods and purchaser care;
(7) intent; and
(8) likelihood of expansion.[156]

The Ninth Circuit cautioned against a rigid application of these factors, noting that the factors are not exhaustive.[157] "Other variables may come into play depending on the particular facts presented."[158] Moreover, some factors may carry more weight in particular cases or

---

probative of it); *Television Enter. Network, Inc.*, 630 F. Supp. at 247, 229 U.S.P.Q. at 49 (discussing initial interest confusion in evaluating the "price of goods" factor, yet conceptualizing it as a type of actionable harm rather than a factor probative of confusion).

[155] *See supra* n. 153 to n. 154 and accompanying text.

[156] *See AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49, 204 U.S.P.Q. 808, 814 (9th Cir. 1979). This test is representative of those used in other circuits.

[157] *See id.* 599 F.2d at 348 n. 11, 204 U.S.P.Q. at 814 n. 11.

[158] *Id.* at n.11.

particular types of cases. For example, the Ninth Circuit has held that in a reverse confusion case three factors are most important (i.e., strength of mark, similarity of marks, and relatedness of goods).[159] Likewise, the Ninth Circuit has held that in a traditional likelihood of confusion analysis in the Internet context, three factors are most important (i.e., similarity of the marks, relatedness of the goods, and marketing channels).[160] Thus, the court has continually emphasized that the multi-factored test is only to be used as a guide to determine whether a likelihood of confusion exists: "[T]he foregoing list does not purport to be exhaustive, and non-listed variables may often be quite important."[161] Nevertheless, the standard for trademark infringement is a likelihood of confusion, and this test is used to determine whether a likelihood of confusion is present: "Claims of trademark infringement and reverse confusion rely on the same test—likelihood of confusion."[162]

Since this test is used to determine whether trademark infringement has occurred and confusion (in its various forms) is present, it is the natural place to start in formulating the test for the initial interest confusion doctrine. Moreover, this starting point is supported by the numerous applications of the initial interest confusion doctrine in the brick and mortar context, as those cases attempted to apply the traditional likelihood of confusion test.[163]

The *Brookfield* court warned of the dangers of taking law from the brick and mortar world and rigidly applying it to the Internet: "We

---

159 *See Dreamwerks Prod. Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1130, 46 U.S.P.Q.2d 1561, 1564 (9th Cir. 1998).

160 *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1054, 50 U.S.P.Q.2d 1545, 1557 (9th Cir. 1999).

161 *Id.*

162 *M2 Software, Inc. v. Viacom, Inc.*, 119 F. Supp. 2d 1061, 1067 (C.D. Cal. 2000) (citation omitted).

163 *See e.g. Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259, 2 U.S.P.Q.2d 1677, 1681 (2d Cir. 1987) (applying the traditional likelihood of confusion test); *Grotrian, Helferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1342, 186 U.S.P.Q. 436, 444 (2d Cir. 1975) (applying the traditional likelihood of confusion test); *Blockbuster Ent. Group v. Laylco, Inc.*, 869 F. Supp. 505, 513, 33 U.S.P.Q.2d 1581, 1586-87 (E.D. Mich. 1994) (applying the traditional likelihood of confusion test); *Sara Lee Corp. v. Kayser-Roth Corp.*, 1992 WL 436279 at *24 (M.D.N.C. 1992) (applying the traditional likelihood of confusion test); *Source Perrier, S.A. v. Waters of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617, 620 (S.D.N.Y. 1982) (applying the traditional likelihood of confusion test); *Dreyfus Fund, Inc. v. Royal Bank of Canada*, 525 F. Supp. 1108, 1122, 213 U.S.P.Q. 872, 882-83 (S.D.N.Y. 1981) (applying the traditional likelihood of confusion test); *Koppers Co., v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 844-45, 210 U.S.P.Q. 711, 717-18 (W.D. Pa. 1981) (applying the traditional likelihood of confusion test).

must be acutely aware of excessive rigidity when applying the law in the Internet context; emerging technologies require a flexible approach."[164] Nevertheless, we must likewise be cautious in the other extreme: applying too flexible an approach and creating limitless trademark rights or judicial discretion in the Internet context. The initial interest confusion doctrine can be easily hypothesized with little or no evidence—much more so than a traditional likelihood of confusion claim. Thus, the doctrine can quickly become overbroad with a foundation of pure speculation by trademark holders unless the likelihood of confusion factors are carefully met.[165] Therefore, the doctrine needs to find a middle ground between requiring actual initial interest confusion (an exceedingly high standard that could rarely be met)[166] and the purely speculative possible initial interest confusion (a standard that could be met merely by the use of the plaintiff's trademarks in the defendant's metatags). Examples of this dichotomy can be seen in the *Welles*[167] and *Brookfield*[168] decisions. While the reasoning in the *Welles* court was refuted and rejected at length in this article, *Brookfield* is by no means the solution. *Brookfield*, however, properly identified the harm and the need for the initial interest confusion doctrine in the Internet context.[169] Both supporters and critics alike acknowledge the great flexibility and lack of a standard articulated in *Brookfield*.[170] Without a standard, the doctrine can quickly become overbroad and trademark holders can be granted monopolistic property rights in cyberspace. Nevertheless, this problem is not unique to the Internet context, as courts in the brick and mortar context likewise

---

164 *Brookfield Commun., Inc.*, 174 F.3d at 1054, 50 U.S.P.Q.2d at 1557.

165 *See* Mills, *supra* n. 5, at 31 (noting that "Welles II [78 F. Supp. 2d 1066] shows that the courts can manipulate the initial interest confusion test [articulated in *Brookfield*] to suit their morality, and that it does not provide a test that can be used to provide judicial consistency in application of the Lanham Act").

166 Essentially, the determination would come down to the state of mind of a consumer when she clicked on a hyperlink. This point is discussed in detail later in Section V.

167 The *Welles* court put forth an exceedingly high standard that would have extremely difficult for the plaintiff to meet. *See Playboy Enters., Inc. v. Terri Welles, Inc.*, 78 F. Supp. 2d 1066 (S.D. Cal. 1999).

168 The *Brookfield* court noted that since "the traditional eight-factor test is not well-suited for analyzing the metatags issue, we do not attempt to fit our discussion into one of the *Sleekcraft* factors." 174 F.3d at 1062, n.24, 50 U.S.P.Q.2d at 1564. Rather than propose an alternative test, the court merely described a kind of harm and concluded that the defendant's actions caused the harm. *See id.* at 1061-66.

169 *Brookfield Commun., Inc.*, 174 F.3d at 1062, 50 U.S.P.Q.2d at 1564.

170 *See* Mills, *supra* n. 5, at 31; Paylago, *supra* n. 35, at 62-65; Posner, *supra* n. 5, at 505; Yan, *supra* n. 5, at 822-24.

struggled in attempting to apply the initial interest confusion doctrine without a formal standard.[171]

In briefly reviewing the eight factors, several factors are necessarily met in a case of possible initial interest confusion involving metatags (i.e., use of another's trademarks in the metatags of one's web site). For example, the marks are identical and the marketing channels are the same. Also, the defendant is likely acting in bad faith.[172] Moreover, the sixth factor, purchaser care, would be moot as initial interest confusion involves confusion before a purchase takes place.[173] Likewise, under the theory articulated in this article, the fourth factor, evidence of actual confusion, ought to be given relatively little weight. Evidence of actual initial interest confusion would be probative, but not dispositive, on the issue.[174] Similarly, a lack of evidence of actual initial interest

---

171 *See Television Enter. Network, Inc. v. Entertainment Network, Inc.*, 630 F. Supp. 244, 247, 229 U.S.P.Q. 47, 49 (D.N.J. 1986) (holding that "[e]ven if the confusion is cured at some intermediate point before the deal is completed, the initial confusion *may* be damaging and wrongful") (emphasis added). While the court acknowledged that initial confusion could lead to a finding of trademark infringement, it did not articulate a test or standard used to determine how much initial confusion was sufficient to support such a finding. *See id.* Bruzga, *supra* n. 134.

172 "In the case of metatags, however, where the person viewing a web site may not even see the metatags, it is difficult to see how the use could be fair, except in some unusual situations." *Eli Lilly and Co. v. Natural Answers, Inc.*, 86 F. Supp. 2d 834, 846 (S.D. Ind. 2000).

173 Some might argue that a consumer looking for more expensive goods would exercise more caution and would be less susceptible to initial interest confusion, yet this contention is flawed for two reasons. First, the initial interest confusion doctrine has been applied to situation involving expensive goods and this defense has been explicitly rejected. *See Grotrian, Helfferich, Schulz, Th. Steinweg Nachfahreu*, 523 F.2d at 1341, 186 U.S.P.Q. at 444; *Mobil Oil Corp.*, 818 F.2d at 260, 2 U.S.P.Q. at 1682 (rejecting the sophisticated consumer defense and applying the initial interest confusion doctrine in the brick and mortar context); *Kompan, A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1180 (N.D.N.Y. 1995) (rejecting the sophisticated consumer defense and applying the initial interest confusion doctrine in the brick and mortar context). Nevertheless, the initial interest confusion doctrine has also been applied to situations involving inexpensive products and unsophisticated purchasers as well. *See Source Perrier, S.A.*, 217 U.S.P.Q. at 620 (applying the initial interest confusion doctrine in the brick and mortar context to inexpensive goods (i.e., mineral water)). Second, the ease of moving from web site to web site on the Internet undermines the argument that consumers exercise a great deal of care before clicking on any given link. *See GoTo.com Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1209, 53 U.S.P.Q.2d 1652, 1659 (9th Cir. 2000).

174 *See Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, n.7, 46 U.S.P.Q.2d 1737, 1749 (5th Cir. 1998) (noting, in the brick and mortar context, that a single incident of actual initial interest confusion was probative but not dispositive on the issue).

confusion is neither dispositive nor controlling.[175] The strength of the mark ought to be considered, but only insofar as is necessary to determine whether the plaintiff has a protectable interest.[176] As is the case in a traditional trademark analysis, a very strong mark ought to be given broader protection.[177] Nevertheless, a weaker mark ought not preclude a finding of a likelihood of initial interest confusion.

It is important to note that several of these factors (i.e., similarity of the marks, marketing channels, intent, and presumably strength of the mark) cut in favor of the plaintiff. Thus, the defendant's actions (i.e., using the plaintiff's trademarks in the metatags of its web site) create a presumption in favor of the plaintiff.[178]

In the sections to follow, the dispositive factors in determining whether a likelihood of initial interest confusion is present will be articulated.[179] These factors will delineate the limits of the initial interest confusion doctrine, and the suggested approach will attempt to provide a middle ground where a legitimate harm can be remedied without the doctrine becoming overbroad.[180]

---

[175] *See Source Perrier, S.A.*, 217 U.S.P.Q. at 620 (finding initial interest confusion in spite of no actual initial interest confusion in the brick and mortar context). This is consistent with current case law in a traditional likelihood of confusion analysis: "It is true that the absence of actual confusion is not dispositive." *M2 Software, Inc.*, 119 F. Supp. 2d at 1069 (citation omitted).

[176] As a practical matter, it is quite unlikely that marks that are not strong or famous would be used in this manner, as an unknown mark would infrequently be used as a term in a search engine; thus, using such a mark would not increase the visibility of the web site.

[177] *See* McCarthy, *supra* n. 1, at vol. 2, § 11:73.

[178] This presumption is no different than using our label of a possibility of initial interest confusion. This presumption is "rebuttable" if the remaining, "important," factors are not met by the plaintiff; however, if the remaining factors seem to support the plaintiff, even modestly, a finding of a likelihood of initial interest confusion is justified.

[179] While these factors were developed based upon Ninth Circuit law, the factors are not meant to be exclusive to the Ninth Circuit. Tests employed by the various circuits overlap, and the test herein is not inconsistent with the traditional likelihood of confusion tests applied in the other circuits.

[180] A commentator noted this problem in the brick and mortar context, and extrapolated from the then current case law two factors for determining whether initial interest confusion ought to result in a finding of trademark infringement: competitiveness of the goods and marketing channels. *See* Bruzga, *supra* n. 134.

1. Competitive Proximity Requirement[181]

The first factor the courts ought to examine is the competitive proximity of the goods or services.[182] As is the case with a traditional trademark infringement analysis, a trademark owner cannot prevent all others from using the trademark in all situations. This restriction ought to hold equally true in the initial interest confusion analysis. If two web sites offer noncompeting and unrelated goods or services, the junior user would likely be allowed to use the senior user's trademarks in the metatags of the junior user's web site without a finding of a likelihood of initial interest confusion. This application is analogous to the standard in a traditional likelihood of confusion analysis.[183]

Likewise, if two web sites offer competing goods or services, the junior user's use of a senior user's trademarks in metatags may result in a finding of a likelihood of initial interest confusion.[184] Finally, if two web sites offer noncompeting but related goods or services, the junior user's use of a senior user's trademarks in metatags can, under the articulated theory, result in a finding of a likelihood of initial interest confusion. The basis for such a standard results from the analogous modern rule regarding a traditional likelihood of confusion analysis:

> The modern rule expands trademark rights to prevent use on related, but noncompetitive goods; and gives the trademark owner protection against use of its mark on any product or service which would rea-

---

[181] This requirement merges two, potentially overlapping *Sleekcraft* (*See AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49, 204 U.S.P.Q. 808, 814 (9th Cir. 1979)) factors: relatedness of goods and likelihood of expansion.

[182] This is consistent with current case law: "Dissimilarity of goods and services resolves the initial interest confusion question. . . . [R]elatedness of products is an important component in the analysis, even if the products need not be closely related." *The Network Network v. CBS, Inc.*, 2000 WL 362016 at *9 (C.D. Cal. Jan. 18, 2000). *See also* Bruzga, *supra* n. 134 (noting, in the brick and mortar context, that one factor used to determine whether initial interest confusion ought to lead to a finding of trademark infringement is the competitive proximity of the two goods); John R. Warner, *Trademark Infringement Online: Appropriate Federal Relief from the Illicit Use of Trademarked Material in Web Site Meta Tags*, 22 Thomas Jefferson L. Rev. 133, 172 (2000) (noting, in a descriptive inquiry, the importance of competition in initial interest confusion cases).

[183] *See e.g. Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 104 F. Supp. 2d 427 (D.N.J. 2000).

[184] This situation is similar to that in *Brookfield Communications*. While such a use can result in a finding of initial interest confusion, it does not necessarily do so, as the mere use of a competitor's trademarks in the metatags of one's web site is not dispositive on the issue of confusion. The discussion that follows will address how to determine when a likelihood of initial interest confusion occurs.

> sonably be thought by the buying public to come from the same source, or thought to be affiliated with, connected with, or sponsored by, the trademark owner: "…thus, when speaking of a '*likelihood of confusion*,' this denotes any type of confusion, including: confusion of source; confusion of affiliation; confusion of connection; or confusion of sponsorship."[185]

This evaluation necessarily includes the determination of whether the plaintiff is likely to expand into the defendant's market. The following hypothetical is useful in demonstrating this concept.

Imagine a company, Y, that manufacturers and sells motor oil under the trademark "Y." It recently launched a web site that provides company information and allows for users to purchase motor oil on-line. Imagine a junior second company, Z, that manufacturers and sells goods under the trademark "Y-Z." It also recently launched a web site that provides company information and allows users to purchase goods on-line. Company Z has placed "Y" in the metatags of its web site. If Company Z sells motor oil, the two products would be in direct competition and a finding of a likelihood of initial interest confusion would be possible (i.e., possible initial interest confusion). If Company Z sells computer software then the two products would be noncompetitive and unrelated. This would preclude a finding of a likelihood of initial interest confusion. If Company Z sells parts for automobile engines, the two products would not be directly competing, but they likely would be sufficiently related. Therefore, a finding of a likelihood of initial interest confusion would be possible (i.e., possible initial interest confusion). While this determination is highly fact specific, the potential complexity is not a problem unique to the initial interest confusion doctrine. A similar evaluation takes place in every traditional likelihood of confusion analysis; thus, this area of jurisprudence is already well developed.[186]

In applying this first step of the analysis, one must remember the only conclusion that can be reached is whether a finding of a likelihood of initial interest confusion is possible or not (i.e., a necessary but not sufficient condition).[187] If the goods or services offered at the two web

---

[185] *Charles Schwab & Co. v. Hibernia Bank*, 665 F. Supp. 800, 804, 3 U.S.P.Q.2d 1561, 1563-64 (N.D. Cal. 1987) (quoting McCarthy) (citation omitted).

[186] *See* McCarthy, *supra* n. 1, at vol. 4, § 24.

[187] As a purely logical matter, this factor would not likely be necessary. Market forces would create incentives that would presumably prevent a company from inserting the trademarks of a noncompetitor or producer of unrelated goods in the metatags of its web site. Nevertheless, such a factor is employed to prevent trademarks from taking on the characteristics of a monopolistic property right. Thus, the factor ensures that the initial interest confusion doctrine remains consistent with traditional trademark jurisprudence and does not become overbroad.

sites in question are either directly competitive or noncompetitive but related, a finding of a likelihood of initial interest confusion (thus trademark infringement) is possible. To determine if a trademark infringement has occurred, the analysis must continue.

2. Relative Placement on Search Engine Results List[188]

Once it is determined that the products or services offered at two web sites are sufficiently related to cause confusion (or, more specifically, a likelihood of initial interest confusion), the pivotal inquiry involves the appearance of the web sites on a search engine results list.[189] The classic situation of a likelihood of initial interest confusion, as discussed in *Brookfield*, involves a user entering the plaintiff's trademark into a search engine and the defendant's web site appearing on the list. "[I]nitial interest confusion may result when a user conducts a search using a trademark term and the results of the search include web sites not sponsored by the holder of the trademark search term, but rather of competitors."[190] As noted, this *may* result in a likelihood of initial interest confusion. (Using the labels previously established, this is a possibility of initial interest confusion.) When using a search engine, hundreds or even thousands of web sites are listed. Not every one of these web sites would be liable for trademark infringement. This issue has been addressed with some cases suggesting the possibility that the large number of search results might negate or diminish the possibility of initial interest confusion.[191] While the competitive proximity requirement will

[188] This is arguably analogous to the second factor mentioned by Bruzga in his inquiry into the brick and mortar initial interest confusion doctrine (i.e., both marketing channels and search engine results list dictate how the company is viewed by the consumer). *See* Bruzga, *supra* n. 134.

[189] This factor, and the analysis to follow, assumes that top places on a search engine results list are more coveted than lower places or places on additional pages. This assumption is supported by the literature. *See e.g.* Shipman, *supra* n. 63, at 276.

[190] *Playboy Enters., Inc. v. Netscape Commun. Corp.*, 55 F. Supp. 2d 1070, 1074, 52 U.S.P.Q.2d 1162, 1165 (C.D. Cal. 1999) (*citing Brookfield Commun., Inc.*, 174 F.3d at 1062-64).

[191] *See Bigstar Ent., Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 210, 54 U.S.P.Q.2d 1685, 1703 (S.D.N.Y. 2000) (noting that "where there is evidence of use by third parties of other 'bigstar' web addresses, the likelihood of confusion attributed to initial interest diversion by any one of the users of the mark becomes more speculative and difficult to substantiate, except by strong evidentiary demonstration. In that event, a search engine inquiry originally seeking plaintiff's 'bigstar.com' address would produce the sites of the various domains containing

probably eliminate many of the web sites from consideration, the interesting issue that needs to be examined next is when such an occurrence results in a likelihood of initial interest confusion (and therefore trademark infringement) and when it does not.

This issue has received little attention from either the courts or the commentators. Criteria will be proposed for making such a determination, attempting to keep in mind the underlying objectives of trademark law and public policy. In developing this issue, several possible cases will be examined. Even if my normative conclusions are not agreeable, the structure of this analysis ought to be a helpful way to conceptualize the issues. To place each situation in context, the *Welles* situation will be used as a template for the analysis. In all of the cases, the user enters one of the plaintiff's trademarks into a search engine.[192]

a) Type I

The first, and easiest case, involves a situation where the search engine produces a list that contains the defendant's web site and not the plaintiff's web site. Imagine that a user entered "Playboy" into a search engine. Playboy's official web site did not appear anywhere on the results list, while Welles's web site did appear on the list. Since the two sites are competing for the same customers, the customers would likely be drawn to the defendant's web site. This diversion would therefore constitute a likelihood of initial interest confusion and thus trademark infringement.

b) Type II

A second possible case is where both the plaintiff's and the defendant's web sites appear on the search engine results list; however, the

---

other 'bigstar.com' addresses as well, to any one of which the prospective purchaser theoretically could be diverted, and not just to defendant's site."). *See Simon Property Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1044 (S.D. Ind. 2000) (noting that "the user will confront a host of search results with a wide variety of types of sites . . . Any Internet user is familiar with the confusion one confronts with such a welter of search results, but that confusion is the uncertainty about where to go next, not necessarily the confusion that is relevant for the purposes of trademark law.").

[192] For sake of clarity, reference will be made to the trademark owner as the plaintiff and the competitor who uses the trademark owner's trademarks in the competitor's metatags as the defendant. The use of these terms is not intended to carry any normative weight. Moreover, the assumption is made that the plaintiff and the defendant are direct competitors.

defendant's web site appears above the fold and the plaintiff's web site appears below the fold.[193] In this case, Welles's web site is immediately visible to the user, while Playboy's official web site can only be seen if the user scrolls down the list or clicks on a link to go to an additional page of results. The situation here strongly parallels Type I. The plaintiff's web site is not immediately visible, so it seems likely that users would be drawn to the defendant's web site rather than the plaintiff's web site. This situation would therefore result in a finding of a likelihood of initial interest confusion and thus trademark infringement.

c) Type III

A third possible case is where both the plaintiff's and the defendant's web sites appear on the search engine results list above the fold; however, the defendant's web site appears before the plaintiff's web site on the list. In this case, Welles's web site might be listed second on the list, while Playboy's official web site would be fifth on the list. While the plaintiff's web site is now immediately visible, the defendant's web site would still likely draw potential customers away, as it appears before the plaintiff's web site. This situation would therefore result in a finding of a likelihood of initial interest confusion and thus trademark infringement.

d) Type IV

A fourth possible case is the mirror image of Type III. Here, both the plaintiff's and the defendant's web sites appear on the search engine results list above the fold; however, the plaintiff's web site appears before the defendant's web site on the list. In this case, Playboy's official web site might be second, while Welles's web site would be fifth. This situation still represents a harm that trademark law is meant to prevent, and thus a finding of trademark infringement is compelled. Since both web sites appear on the screen together, the ordering is not overly significant. A web user can, and likely would, briefly skim the list that appears on the computer screen. The presence of the defendant's web site could likely draw at least some customers away from the plaintiff's web site. These customers would go to the plaintiff's web site *but for* the defendant's presence on the search engine results list. This situation

---

[193] For the purposes of this discussion, a web site's position on a search engine results list will be described as below the fold if the user must either scroll down the screen to see it or access another page of the search engine results list.

would therefore result in a finding of a likelihood of initial interest confusion and thus trademark infringement.

e) Type V/Type VI

The next two possibilities only need to be briefly mentioned. The fifth case would be where the plaintiff's web site appears before the defendant's web site and is above the fold, while the defendant's web site appears below the fold. The sixth case would be where the plaintiff's web site appears on the search engine results list and the defendant's does not. Neither of these cases would constitute a likelihood of initial interest confusion, and no trademark infringement would be found.

In applying the initial interest confusion doctrine, one must keep in mind the underlying principle of trademark law—preventing consumer confusion. The defendant has not committed trademark infringement merely by placing the plaintiff's trademark in the metatags of the defendant's web site; rather, a search engine must read those metatags and generate a search engine results list that contains the defendant's web site in a manner described above (i.e., Types I–IV). Without confusion, there is no trademark infringement. Welles did not harm Playboy by using the term in her web site's metatags. The harm only occurs when search engines produce various results lists that included Welles's web site. If, for example, Welles had poorly configured her metatags and her web site did not appear on any search engine results list when the plaintiff's trademarks were entered in a search engine, neither a likelihood of initial interest confusion nor trademark infringement would have occurred.[194]

f) Type VII

A final possibility is actually a derivative of the previous possibilities. What happens if both the plaintiff's and the defendant's web sites

---

[194] An interesting and related point involves the wide variety of search engines. Clearly, the sheer number of search engines makes it extremely unlikely that any search term would produce consistent categorical results (i.e., same relative placement) across numerous search engines. This leads to two possibilities. The first would be to allow a finding of initial interest confusion when the requisite relative placement was present on any search engine. An alternative might be to use this as an additional factor in the analysis balancing the number of potentially infringing placements with the popularity of the given search engine. Thus, an infringing placement generated by a highly popular search engine would be highly probative of a finding of a likelihood of initial interest confusion, while an infringing placement generated by a relatively unknown search engine would be less likely to lead to a finding of a likelihood of initial interest confusion.

appear below the fold? The analysis does not change depending on whether the web user must scroll down the screen or go to an additional page of search results. Once one of the web sites (either the plaintiff's or the defendant's) is visible on the screen, the situation necessarily would fit into one of the previous six types of results.[195]

B. Policy Considerations

While the conceptual framework and analysis regarding the various scenarios involving the initial interest confusion doctrine are consistent with the current state of the law, the brick and mortar foundation of the doctrine, and the underlying principles of trademark law, some will undoubtedly object to what might be characterized as a strong reading of the initial interest confusion doctrine.

One of the criticisms of applying the initial interest confusion doctrine to metatags is that it hinders the dissemination of useful information to consumers.[196] Imagine a consumer looking for a pair of running shoes. She enters the term "Nike" into the search engine. As she reviews the search engine results list, she notices web sites for Nike, Bob's Brand-X Shoes,[197] Reebok, New Balance, Adidas, and Converse. According to the initial interest confusion doctrine as developed herein, those web sites would be liable for trademark infringement.[198] Critics of the application of the initial interest confusion doctrine would argue that the appearance of those web sites on the search engine results list is a positive externality.[199] It allows the consumer to receive additional information and make a more informed purchasing decision.[200] This, as the argument goes, allows for a better overall experience as the consumer would be better informed.

Two central problems are evident in this reasoning. The first involves the choice of the search term. The argument conflates two

[195] Even if the plaintiff's web site immediately follows the defendant's web site below the fold, this could nonetheless be a Type II situation rather than a Type III situation, because it is plausible that the web user would stop scrolling down the screen when he "found" the defendant's web site.

[196] *See e.g.* Lastowska, *supra* n. 37 at 877.

[197] To clarify, Bob's Brand-X shoes are an unknown brand of shoes and not a discount retailer who carries several brands of shoes.

[198] This assumes the other companies included the trademark "Nike" in their metatags.

[199] *See* Thomas F. Presson & James R. Barney, *Trademarks and Metatags: Infringement or Fair Use?* 26 AIPLA Q.J.147, 176-177 (1998).

[200] *See* King, *supra* n. 37, at 326.

distinct types of consumers (or web searchers). A consumer looking for optimal information regarding a wide variety of running shoes should enter "running shoes" rather than "Nike." A search engine results list for "running shoes" would likely be similar to the hypothetical list described above. A consumer who enters "Nike" is looking for Nike running shoes and products. A relatively unsophisticated web user seemingly could grasp such a distinction, and thus the curtailment of information does not seem as problematic. This distinction has been referred to in the literature as concept searching[201] or categorical searching versus targeted searching.[202] A web user could easily receive the "desired" information by performing a search at a more general level. Some argue that consumers ought to be able to use a famous trademark as a shortcut.[203] This argument would be more persuasive if alternative methods of receiving the same information were not easily accessible.[204] With a minimal amount of consumer education, no consumers would be deprived of information.[205]

One might question what is wrong with the user searching for Nike being presented with a variety of options as the hypothetical search engine results list indicates.[206] If the consumer was actually looking for Nike running shoes, she would ignore the other web sites and make her selection. If the consumer was not specifically looking for Nike running shoes but entered the search term because the Nike name is well known, the additional web sites would provide the consumer with useful information. If the consumer was actually looking for Nike running shoes but nevertheless decided to examine other shoes after seeing the search engine results list, the consumer is benefited because of the additional information and is not confused but rather curious.

---

[201] *See* Stephen W. Feingold, *Trademarks: Means To Avoid Confusion, Or Property Rights? Two Pending Cases Outline Dilemma*, 222 N.Y.L.J. S2, S11 (July 26, 1999).

[202] *See* Nathenson, *supra* n. 18, at 139–41.

[203] *See* Thomas F. Presson & James R. Barney, *Trademarks as Metatags: Infringement or Fair Use?* 26 AIPLA Q.J. 147, 177 (1998).

[204] Some might attempt to point to examples where categorical searching is difficult, so using trademarks as a short cut is the only plausible alternative. For example, someone searching for acetaminophen might not recall the name and instead use the famous trademark TYLENOL. Other manufacturers of acetaminophen would therefore be at a competitive disadvantage and the consumers would be unable to engage in comparative shopping without such a shortcut method of searching. While this argument might be initially persuasive, a concept search of "pain reliever" would be a more than adequate replacement, and one not beyond the vocabulary of most web users.

[205] *Cf*. Nathenson, *supra* n. 18, at 78–81 (advocating better searching techniques for the public).

[206] *See id.*

The problem is that other shoe manufacturers are taking advantage of Nike's goodwill and benefiting from it. Regardless of which of the three categories of consumers one falls within, Nike is potentially losing customers because of the use of its trademarks by its competitors. Put another way, those other web sites and their products would not even be considered by the consumers *but for* their use of Nike's trademark. This type of harm associated with initial interest confusion has been actionable in the brick and mortar context: "That situation offers an opportunity for sale *not otherwise available* by enabling defendant to interest prospective customers by confusion with the plaintiff's product."[207] This is a recognizable harm to Nike. Some might argue that the benefit to the public (of increased information) outweighs this harm, but the detriment to the public is entirely avoidable. As was noted, entering "running shoes" in the search engine would produce the "desired" result and give the consumer the additional information. The doctrine of initial interest confusion merely prevents the presentation of unwanted information to consumers. This prevention is a minimal harm that does not outweigh the harm to Nike in allowing it. Moreover, allowing the use of Nike's trademarks in competitors' metatags could prevent the user from obtaining the information she desires. If every shoe and athletic apparel company were allowed to include the "Nike" trademark in the metatags of their web sites, it would make it much more difficult for someone actually searching for the Nike web site. Moreover, if every web site for every major shoe company contained the trademarks of every other major shoe company in the metatags of their web sites, the ability of a web user to find any given web site would be greatly reduced. In these situations, the additional information provided to the consumer would be a harm rather than a benefit.[208]

This discourse leads to a corollary argument against a strong application of the initial interest confusion doctrine. As was alluded to, the side-by-side comparison-shopping that the use of "Nike" in competitors' metatags would produce mirrors the shopping experience in the brick and

---

207 *Sara Lee Corp. v. Kayser-Roth Corp.*, 1992 WL 436279 at *24 (M.D.N.C. Dec. 1, 1992) (emphasis added).

208 Some might argue that this "harm" is de minimis, as most people searching for the Nike web site would first attempt to access <www.nike.com> rather than using a search engine. Clearly, computer users are becoming more savvy and educated with respect to domain name use; nevertheless, some companies' web sites are not as easy to locate and thus a search engine would be used (e.g., a person searching for Vermont Teddy Bears might turn to a search engine when <www.vermontteddybears.com> was unsuccessful. (The web site is found at <www.vermontteddybear.com>.))

mortar world.[209] This argument contains the same flaw just exposed. The only time a consumer receives a side-by-side comparison-shopping experience in the brick and mortar world is if she goes to a "Running Shoe Store." If she enters a "Nike Store," she will only be presented with Nike running shoes. While a consumer would be presented with additional (and potentially useful) information if the Nike Store was forced to carry Bob's Brand-X shoes, Reebok shoes, New Balance shoes, Adidas shoes, and Converse shoes, we do not require Nike to do this, nor do we require that Nike permit these competitors to set up displays in its store. Thus, the side-by-side comparison-shopping experience can take place in cyberspace if that is what the consumer requests (i.e., if she enters a categorical term in the search engine). Likewise, in the brick and mortar world, we do not force companies to provide this type of side-by-side comparison-shopping experience (i.e., we allow them to have corporate stores and exclude competitors from these stores). Moreover, when the side-by-side shopping experience in the brick and mortar world caused confusion, it was barred.[210] Thus, the doctrine of initial interest confusion does not hinder the dissemination of relevant information to the consuming public and does mirror the shopping experience in the brick and mortar world.

V. CONFUSION—WHEN AND WHERE?

A. The Initial Interest Confusion Doctrine and the Search Engine Results List

The discussion to this point has been conflating an important distinction with respect to the initial interest confusion doctrine, and this distinction was alluded to in a recent opinion. The District Court for the Southern District of Indiana noted that the brief descriptions of the retrieved web sites that many search engines include in their results lists potentially dissipate initial interest confusion:

> [T]he user will confront a host of search results with a wide variety of types of sites. Moreover, the results are not limited to a mere list of URL addresses. The results will also include some additional descriptive information about the responsive sites. That information will

[209] *See* Presson & Barney, *supra* n. 203, at 165-67.

[210] *See Sara Lee Corp.*, 1992 WL 436279 at **5–25 (holding that the defendant's use of the plaintiff's trade dress and placement in adjoining displays was actionable under the doctrine of initial interest confusion).

> help the user determine which ones are most promising for the purpose of the search. Any Internet user is familiar with the confusion one confronts with such a welter of search results, but that confusion is the uncertainty about where to go next, not necessarily the confusion that is relevant for the purposes of trademark law.[211]

Can the likelihood of initial interest confusion be eliminated if examining the search engine results list dissipates the confusion?

The brief descriptions are not necessarily helpful in eliminating confusion. As has been noted, the description accompanying Welles's Uniform Resource Locator ("URL") address was as follows: "Playboy Playmate of the Year 1981 Terri Welles website featuring erotic nude photos, semi-nude photos, soft-core and exclusive Members Club."[212] In this situation, the potential confusion of a web user would be exacerbated by the description. The description in Welles's web site explicitly referred to the plaintiff's trademark. Thus, the presence of the brief description, in some situations, would not alleviate the initial interest confusion. Moreover, an explicit disclaimer can further exacerbate confusion, as search engines will recognize the trademark that is being disclaimed, possibly resulting in higher placement on the search engine results list.[213]

The running shoe hypothetical illustrates an important distinction with respect to the relative strength of each party's trademark. In the *Welles* situation, the trademark holder had a well-known mark (i.e., Playboy), while the potential infringer was relatively unknown (i.e., Welles). This distinction is highlighted in the running shoe hypothetical. Recall, when the trademark "Nike" was entered into a search engine, the web sites for the following companies were listed: Bob's Brand-X, Reebok, New Balance, Adidas, and Converse. The situation with Bob's Brand-X Shoes is much the same as the *Welles* situation. Imagine the following brief description accompanying the URL: "Bob's Brand-X Shoes sells high quality running shoes at low prices; you won't find lower priced running shoes anywhere." Even though the description does not mention Nike, this seems to be a classic case of initial interest confusion. Since the consumer entered "Nike" in the search engine and Bob's Brand-X web site appeared on the results list, web users likely would assume that Bob's Brand-X web site sells Nike shoes. Irrespective of whether the user visits

---

211 *Simon Prop. Group L.P. v. MySimon, Inc.*, 104 F. Supp. 2d 1033, 1044 (S.D. Ind. 2000).

212 *Playboy Enters., Inc. v. Terri Welles, Inc*., 78 F. Supp. 2d 1066,1091 (S.D. Cal. 1999).

213 *See* Shipman, *supra* n. 63, at 275–76 (noting that the trademark being disclaimed can be picked up by search engines and thus can lead to higher confusion on the search engine results lists, by causing a higher placement).

the web site, confusion would not likely be dissipated by viewing the search engine results list. People visiting this web site would learn that only Brand-X shoes were sold there and not Nike shoes. At this point, though, it is too late: the harm has already occurred. Thus, when the trademark holder's mark is well known (e.g., Nike or Playboy) and the competitor's mark is not (e.g., Bob's Brand-X or Welles), the use of the trademark by the competitor in its metatags leads to initial interest confusion. Moreover, the brief description that accompanies the URL addresses could exacerbate the likelihood of initial interest confusion in these cases.

The logical next question involves the interaction of two well-known brands. This is where "Nike" is entered into the search engine and web sites for Reebok, New Balance, Adidas, and Converse appear. Irrespective of the brief descriptions that accompany the URL, the consumer would probably realize (even before visiting the web sites) that those web sites do not sell Nike running shoes. Thus, the confusion would be dissipated when the consumer views the search engine results list. This takes us to the heart of the initial interest confusion doctrine: at what level must the confusion occur to result in a finding of trademark infringement? Specifically, does the fact that the consumer realizes you cannot buy Nike running shoes at the web site *www.reebok.com* by viewing the search engine results list preclude the application of the initial interest confusion doctrine? If so, the initial interest confusion doctrine as applied to metatags could all but be eliminated by including a disclaimer in the brief description that accompanies the URL in a search engine results list.[214] For example, Welles could have avoided all liability (even under the analysis herein) by adding the following disclaimer to her description: "This site is not affiliated with, sponsored by, or endorsed by Playboy." Bob's Discount could do the same: "This site is not affiliated with, sponsored by, or endorsed by Nike nor does it sell any Nike products." Competitors with trademarks of similar power (i.e., Nike and Reebok) could also freely use each other's trademarks in the metatags of their respective web sites.[215]

Can the doctrine of initial interest confusion apply even when the likelihood of confusion is dissipated at the level of the search engine results page? For both legal and policy reasons, the answer is "yes."[216]

[214] *See* Presson & Barney, *supra* n. 203, at 177 (alluding to the idea of disclaimers at the search engine result level in suggesting possible color coding to alert web users of "official" web sites).

[215] *See e.g.* Shipman, *supra* n. 63, at 258 (noting that disclaimers are generally viewed with skepticism and not effective).

[216] This position has been consistently rejected in academic literature. *See e.g.* Mills, *supra* n. 5, at **25–27; McCuaig, *supra* n. 91, at 679–80; O'Rourke, *supra* n. 17, at

In reviewing the language of the *Brookfield* court, it seems clear that the court intended the doctrine to be applied even if the likelihood of confusion was dissipated after viewing the search engine results list.[217] The court noted that by scanning the search engine results list and noting the URL, most web users would be able to determine which web site belonged to the plaintiff and which belonged to the defendant: "Thus, in scanning such a list, the Web user will often be able to find the particular web site he is seeking."[218] Nevertheless, the court went on to conclude that the defendant's use of the plaintiff's metatags "will still result in what is known as initial interest confusion."[219] (Applying our newly created labels, this would be a likelihood of initial interest confusion.) Remember, the harm was not that people were mistakenly patronizing the defendant's web site but rather that the defendant was improperly using the plaintiff's goodwill to *potentially* divert people away from the plaintiff's web site.[220] Thus, a close reading of *Brookfield* supports my position.

Some might point to other language in *Brookfield*: "[w]eb surfers . . . who are taken by a search engine to [defendant's URL] will find a database similar enough to [plaintiff's] such that a sizeable number of consumers who were originally looking for [plaintiff's] product will simply decide to utilize [defendant's] offerings instead."[221] One might argue that the web user must mistakenly access the defendant's web site. This is not the case, though, particularly if the language is placed in context. First, the court neither stated nor implied that the web user was confused as to which web site she had entered. Rather, this language followed the court's explanation that web users would likely be able to distinguish the plaintiff's web site from the defendant's web site by briefly

294. *But cf*. Katherine E. Gasparek, *Applying the Fair Use Defense in Traditional Trademark Infringement and Dilution Cases to Internet Meta Tagging or Linking Cases*, 7 Geo. Mason L. Rev. 787 (1999) (noting that initial interest confusion does not necessarily require a customer to be actually deceived upon arriving at the web site); Marcelo Halpern, *Meta-Tags: Effective Marketing or Unfair Competition?* 2 Cyberspace Law 2 (October 1997) (noting that initial interest confusion does not necessarily require a customer to be actually deceived upon arriving at the web site).

[217] Relying on *Brookfield* in identifying the harm is not inconsistent with the rest of the analysis. This article's criticisms of *Brookfield* deal only with its overly flexible approach and lack of an adequate test. The *Brookfield* court did an excellent job of articulating the harm it was attempting to remedy.

[218] *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1062, 50 U.S.P.Q.2d 1545, 1564 (9th Cir. 1999).

[219] *Id.*

[220] *See id.*

[221] *Id.*

examining the search engine results list.[222] The language was an attempt by the court to distinguish source confusion from initial interest confusion, noting that the latter involves an improper use of one's goodwill to divert consumers away from the web site.[223] This improper use of the goodwill occurs by placing the trademark in one's metatags, and thus the diversion and harm occurs merely by having the web site appear on the search engine results list.

B. Opposing Viewpoints

Subsequent decisions seem to support the view that initial interest confusion can only occur if the consumer mistakenly accesses the defendant's web site. For example, the District Court for the Central District of California, in interpreting *Brookfield*, noted that "[t]he Ninth Circuit reasoned that the user may be diverted to an un-sponsored site, and only realize that she has been diverted *upon arriving* at the competitor's site."[224] This language by no means resolves the issue. First, it follows a passage that supports the view that a likelihood of initial interest confusion can occur at the level of a search engine results list: "Generally speaking, initial interest confusion may result when a user conducts a search using a trademark term and the results of the search include web sites not sponsored by the holder of the trademark search term, but rather of competitors."[225]

Second, nothing in the early language precludes a finding of a likelihood of initial interest confusion at the level of a search engine results list. The court described one application of the doctrine—an application that is clearly accepted—but does not hold that its scenario is the only one in which the initial interest confusion doctrine can apply. This, combined with the unambiguous language in *Brookfield*, supports the view herein that the application of the initial interest confusion doctrine to situations where the confusion is potentially eliminated at the level of the search engine results list is not prohibited (at the very least) but rather supported. This reading of *Brookfield* is consistent with the doctrine as developed in the brick and mortar context. For example, one court noted that "[t]he absence of misdirected phone calls . . . are other

[222] *See id.*

[223] *See id.*

[224] *Playboy Enters., Inc. v. Netscape Commun. Corp.*, 55 F. Supp. 2d 1070, 1074, 52 U.S.P.Q.2d 1162, 1165 (C.D. Cal. 1999) (emphasis added).

[225] *Id*. (relying on *Brookfield*, 174 F.3d at 1062–64, 50 U.S.P.Q.2d at 1563–66).

matters [in an initial interest confusion inquiry]."[226] Not only was the lack of misdirected telephone calls (arguably analogous to accessing a web site from a search engine results list) not required but they also were not even probative in the inquiry.[227] The actionable harm was completed before any misdirected telephone calls could have been made.[228] Likewise, another court noted that, in an initial interest confusion inquiry, it is irrelevant that confusion is quickly dissipated.[229] Thus, the strong reading of the initial interest confusion doctrine is consistent with both the text of *Brookfield* and the historical development of the doctrine in the brick and mortar world.

Since legal precedent supports the strong reading (or at the very least, does not preclude it), do any significant policy reasons exist to the contrary? The central policy reason for not applying the initial interest confusion doctrine when the confusion dissipates upon viewing the search engine results list involves the dissemination of useful information to the consumers. This argument was already rejected in the context of the shoe shopping hypothetical. The benefits of the additional information are minimal and are outweighed by the potential harm to the trademark holder, particularly because the information is available to the consumer if a categorical search is performed.[230]

Another reason for rejecting the view that a likelihood of initial interest confusion can only occur if the consumer mistakenly accesses the defendant's web site involves prudential considerations. Interpreting the initial interest confusion doctrine in this manner would cause the resolution of any dispute to come down to the state of mind of the consumers at the time they clicked on the hyperlink. This subjective mental state would be difficult for any court to determine accurately. It is likely that this distinction regarding where the confusion is dissipated has received relatively little attention because of an assumption implicit in the operation of the Internet and search engines. Courts seem to embrace the assumption that the presence of the defendant's web site on a search engine results list indicates that at least some web users will access the web site. The court in *Brookfield* did not require proof of actual web users who accessed the defendant's site; rather, it reasoned that

---

226 *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 259, 2 U.S.P.Q.2d 1677, 1681 (2d Cir. 1987).

227 *See id.*

228 *See id.*

229 *See Blockbuster Ent. Group v. Laylco, Inc.*, 869 F. Supp. 505, 513, 33 U.S.P.Q.2d 1581, 1587 (E.D. Mich. 1994).

230 *Cf.* Feingold, *supra* n. 201, S11; Nathenson, *supra* n. 18, at 139-41.

it was likely to occur.[231] To reject this assumption, and thus require proof of actual consumers entering the plaintiff's trademark in a search engine and then proceeding to the defendant's web site while under the impression that the web site was somehow related to or affiliated with the plaintiff's web site, would create an insurmountable burden.[232] This requirement would essentially eliminate the doctrine of initial interest confusion, a doctrine that addresses a recognizable harm. Moreover, a finding of initial interest confusion in the brick and mortar context does not require proof of actual initial interest confusion as "reliable evidence of actual instances of confusion is practically almost impossible to secure, particularly at the retail level."[233] Thus, the prudential reasons are further supported by the brick and mortar history of the doctrine.

My reading is consistent with the famous billboard analogy contained in *Brookfield*.[234] Recall the analogy: the customer's confusion was dissipated before entering the competing video store.[235] Nevertheless, a likelihood of initial interest confusion still occurred. Additionally, this interpretation is consistent with Professor McCarthy's analogy. Recall that Professor McCarthy analogized initial interest confusion to a job seeker:

> The analogy to trademark initial interest confusion is a job-seeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or a 'typo.' The misrepresentation has enabled the job-seeker to obtain a coveted interview, a clear advantage over others

---

[231] *See Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1062, 50 U.S.P.Q.2d 1545, 1564 (9th Cir. 1999). *See also Blockbuster*, 869 F. Supp. at 513, 33 U.S.P.Q.2d at 1587 (holding that "some unwitting customers might enter a Video Busters store thinking it is somehow connected to Blockbuster" and thus not requiring proof of actual confused individuals mistakenly entering the store but assuming it).

[232] *See* Allen, *supra* n. 20, at 344 (noting, in the brick and mortar context, that requiring actual confusion in the initial interest confusion doctrine is an unrealistic obstacle).

[233] *Source Perrier, S.A. v. Water of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617, 620 (S.D.N.Y. 1982) (citation omitted). *See also* Allen, *supra* n. 20, at 344 (noting, in the brick and mortar context, that the harm to the plaintiff ought to be assumed in applying initial interest confusion (much the way it typically is in the traditional likelihood of confusion analysis) since it is too difficult to find proof of actual harm).

[234] While this article previously noted the inherent problems of relying on such analogies to the brick and mortar context, demonstrating that the reading of *Brookfield* suggested herein is not inconsistent with what the court envisioned is necessary, since the court was lucid in the type of harm it was attempting to prevent.

[235] *See Brookfield*, 174 F.3d at 1064, 33 U.S.P.Q.2d at1565.

> with the same background who honestly stated their educational achievements on their resumes.[236]

This analogy further supports my view that a likelihood of initial interest confusion can occur even where confusion is dissipated before traveling to the web site. The misrepresented educational background on the resume is analogous to the use of the plaintiff's trademark in the defendant's metatags. Examining the analogy in this context is instructive: The misrepresentation (use of the metatag) has enabled the jobseeker (defendant) to obtain a coveted interview (coveted place on the search engine results list), a clear advantage over others with the same background who honestly stated their educational achievements (not including the plaintiff's trademark) on their resumes (in their metatags). Even if the jobseeker (defendant), at the interview (search engine results list), explains that the inflated resume claim (plaintiff's trademark in the defendant's metatags) is a mistake or a "typo" (in a disclaimer), the harm is not alleviated and a likelihood of initial interest confusion has occurred.

Some might question this application of the initial interest confusion doctrine as inconsistent with the fundamental principle of trademark law: preventing consumer confusion. They might argue that this reading of the initial interest confusion doctrine is granting a strong property right in a trademark and is not focusing on the consumer's confusion—since confusion is so quickly eliminated or never even present. This is an inaccurate understanding of the doctrine as presented. The mere appearance of a defendant's web site on a search engine results list necessarily indicates consumer confusion at a certain level. Specifically, the use of the trademark in the metatags confused the consumer via the search engine. Such a proposition is not without support. In the brick and mortar context, courts have recognized that confusion can occur at "subliminal levels."[237] Thus, an actionable harm can be present based on confusion the consumer is not even consciously aware of at the time. This situation is strongly analogous to confusion at the level of search engines. In searching for web sites, the search engine acts as an extension of the web user, and thus the user is confused.[238] Essentially, the search engine does what the web user would do but for the sheer enormity of the

---

[236] *See* McCarthy, *supra* n. 1 at vol. 3, § 23:6.

[237] *Koppers Co., Inc. v. Krupp-Koppers GmbH*, 517 F. Supp. 836, 844, 210 U.S.P.Q. 711, 718 (W.D. Pa. 1981).

[238] *See* Halpern, *supra* n. 216 (noting that deceiving the search engine is deceiving the consumer); Shipman, *supra* n. 63 at 271–74 (noting that, while technically the search engine is confused, initial interest confusion still ought to be applied to remedy this indirect confusion on the consumer). *But see* Sees, *supra* n. 5 at 115–17 (noting that trademark law ought not apply to confusion of search engines).

Internet. Imagine only seventy-five web sites existed, and a consumer was looking for Nike running shoes. Further imagine that each web site's URL was at the bottom of an index card, a brief description was in the middle of the index card, and a few key words were at the top of the card. A consumer would rapidly flip through the cards "pulling" all of those that contained "Nike" in the key words. (This pile of cards would be equivalent to the search engine results list). Assume that twelve cards were set aside because they contained "Nike" in the key words. Now, think back to the hypothetical. If Reebok had included "Nike" as a search term, the Reebok web site would now have a place in this group. Even though the consumer would quickly realize the mistake once she read the brief description or the URL address, she was still confused by the misuse of the key word (or metatags). Thus, *but for* Reebok's use of Nike's trademarks, it never would have made it to the short list.[239] By including Nike's trademark in its key words, Reebok not only confused the consumer but also increased the chance that a Nike customer might shop at the Reebok web site (either because some users might not pay attention to the brief descriptions or the URLs, some users might mistakenly click on the link, or some users might decide to look at the Reebok web site after the confusion was dissipated). Therefore, the use of a competitor's trademarks in one's metatags does confuse the consumer, even if viewing the brief descriptions, URL addresses, or even explicit disclaimers eliminates that confusion.[240]

A final policy reason for accepting the proffered interpretation of the initial interest confusion doctrine is the desire not to reward bad faith actors. Put another way, do competitors have any good faith reason to include another's trademark in their metatags? We have already rejected the notion that it is done to increase information to consumers. Thus, the only reason a competitor would include the trademarks of another in the metatags of its web site would be to attempt to divert some of the trademark holder's potential customers. Essen-

239 *Cf. Sara Lee Corp. v. Kayser-Roth Corp.*, 1992 WL 436279 at *24 (M.D.N.C. Dec. 1, 1992) (noting, in the brick and mortar context, 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" (emphasis added)).

240 As search engines become more sophisticated and complex, this analogy likely becomes more tenuous. For example, a sophisticated search engine might automatically add the phrases "running shoes" and "athletic apparel" when a user enters "Nike." This type of search engine would certainly complicate the analysis. While the effect would remain the same, the competitor's would have no role in the "confusion." It is unclear whether the search engine provider could be liable in such a situation. In any event, this idea is beyond the scope of this article. Nevertheless, it is worth noting as one must keep an eye on developing technology to see how new innovations affect the current state of the law.

tially, the competitor is attempting to capitalize on the goodwill of another's trademark, and this practice is couched in the justificatory terms of "access to information." Aside from the reasons previously noted, it seems problematic to reward someone acting in bad faith. Thus, both legal and policy considerations provide support for the position that the initial interest confusion doctrine ought to be applied even if the likelihood of confusion is dissipated when a web user views the search engine results list.

VI. ADDITIONAL CONSIDERATIONS

A. Consumer Sophistication

Much of the scholarly criticism of the application of initial interest confusion to metatags revolves around the high sophistication of Internet users.[241] A repeated refrain is that the applicability of the initial interest confusion doctrine requires a low level of consumer sophistication.[242] This is clearly not the case and flies in the face of the brick and mortar roots of the doctrine.[243] In the brick and mortar context, the initial interest confusion doctrine has been applied in cases where a high level of consumer sophistication was recognized by the courts.[244] As was noted, "[I]t is the subliminal confusion . . . between the corporate entities and the products that can transcend the competence of even the most sophisticated consumer."[245]

241 *See e.g.* Garrett, *supra* n. 56, at 106; King, *supra* n. 37 at 325–326.

242 *See id.*

243 *See* Bruzga, *supra* n. 134, at 661–62.

244 *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331, 1341, 186 U.S.P.Q. 436, 444 (2d Cir. 1975). *See also Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 260, 2 U.S.P.Q.2d 1677, 1682 (2d Cir. 1987) (rejecting the sophisticated consumer defense and applying the initial interest confusion doctrine in the brick and mortar context); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167,1180 (N.D.N.Y. 1995) (rejecting the sophisticated consumer defense and applying the initial interest confusion doctrine in the brick and mortar context). Nevertheless, the initial interest confusion doctrine has also been applied to situations involving inexpensive products and unsophisticated purchasers. *See Source Perrier, S.A. v. Water of Saratoga Springs, Inc.*, 217 U.S.P.Q. 617, 620 (S.D.N.Y. 1982) (applying the initial interest confusion doctrine in the brick and mortar context to inexpensive goods (i.e., mineral water)).

245 *Grotrian*, , 523 F.2d at1341, 186 U.S.P.Q. at 444.

Moreover, the level of sophistication of Internet users is not as high as some might argue. As the Ninth Circuit has recently noted, "[a]lthough the use of computers may once have been the exclusive domain of an elite intelligentsia, even modern-day Luddites are now capable of navigating cyberspace."[246] It is well-settled law in the area of trademarks that the average consumer is the measuring stick.[247] The Ninth Circuit noted that the proliferation of the Internet has made it widely accessible, and thus the average Internet user is not likely a highly sophisticated actor.[248]

Additionally, these assumptions regarding the high sophistication of the average Internet user overlook an important distinction made by the Ninth Circuit. As was noted in *Brookfield*, "[i]n the Internet context, in particular, entering a web site takes little effort—usually one click from a linked site or a search engine list; thus, Web surfers are more likely to be confused as to the ownership of a web site than traditional patrons of a brick-and-mortar store would be of a store's ownership."[249] This distinction was subsequently expanded upon in noting the problem with assuming that high sophistication of Internet users (even if true) could mitigate confusion and prevent the application of the initial interest confusion doctrine:

> Furthermore, the question in this analysis is not how sophisticated web surfers are but, rather, how high the cost is of choosing one service—that is, one web site—over another on the Web. We agree with our previous conclusion that this cost is negligible: it is simply a single click of a mouse.[250]

The court rejected the argument that web users exercise a great deal of care before clicking on hyperlinks.[251] Thus, the sophistication of Internet users not only does not preclude the application of the initial interest confusion doctrine but it also makes the application of the stronger version advocated herein more necessary.

B. Fair Use

[246] *GoTo.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1208-10, 53 U.S.P.Q. 2d 1652, 1658–59 (9th Cir. 2000).

[247] *See* McCarthy, *supra* n. 1, at vol. 3, § 23:93-94.

[248] *See GoTo.com*, 202 F.3d at 1209-10, 53 U.S.P.Q. 2d at 1659.

[249] *Brookfield Commun., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1057, 50 U.S.P.Q.2d 1545, 1559–60 (9th Cir. 1999).

[250] *GoTo.com*, 202 F.3d at 1209-10, 53 U.S.P.Q. 2d at 1659.

[251] *See id.*

Although I am arguing for a strong version of the initial interest confusion doctrine, fair use is not precluded. *Brookfield* explicitly recognized this proposition.[252] Contrary to the opinion in *Welles*, though, a narrow fair use defense with respect to metatags should be advocated.[253] This position has been noted in a recent judicial opinion: "In the case of metatags, however, where the person viewing a web site may not even see the metatags, it is difficult to see how the use could be fair, except in some unusual situations."[254] Embracing the fair use position of the majority of the circuits,[255] a finding of fair use ought to be inconsistent with a finding of confusion, and more specifically, initial interest confusion. Thus, a finding of initial interest confusion would bar a finding of fair use.

Since the application of fair use in the *Welles* case is wholly inappropriate, what type of situation would constitute fair use? Consistent with the language of the Lanham Act, fair use would be the use of another's trademark in a non-trademark sense.[256] Imagine an on-line fruit wholesaler. Such a business could legitimately include the term "apple" in its metatags referring to the fruits it sells. The computer company ought not be able to prevent such a use of the its trademark "Apple." While this situation would also fail the competitive proximity requirement, this would be a clear case of a fair use.[257]

Similarly, a limited nominative fair use defense would still be viable in the Internet context. The same on-line fruit wholesaler could use the trademark "Chiquita" in its metatags to refer to the types of bananas it sells over the objection of Chiquita Brands, Inc. Likewise, in a variation of the running shoe example, Tom's Sporting Goods web site could use the trademark "Nike" in its metatags to describe the shoes it actually sells. These are both cases of nominative fair use where the

---

252 *See Brookfield*, 174 F.3d at 1065, 50 U.S.P.Q.2d at1566.

253 Some academic literature advocates for a broad and flexible fair use defense in the Internet context. *See* Gasparek, *supra* n. 216. Other literature has taken the position contrary to mine by suggesting a regime that allows most trademarks to be used in the metatags of a competitor's web site. *See* Lastowka, *supra* n. 37. *Cf.* Presson & Barney, *supra* n. 203, at 149 (arguing against a per se rule banning the use of competitor's metatags and instead advocating a very broad fair use that would encompass most uses).

254 *Eli Lilly and Co. v. Natural Answers, Inc*., 86 F. Supp. 2d 834, 846 (S.D. Ind. 2000).

255 *See* McCarthy, *supra* n. 1, at vol. 2, § 11:47.

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

257 The hypothetical is not undermined because the fair use defense and the absence of confusion are both present. In fact, "the two defenses of fair use and lack of a likelihood of confusion will blend together [in many cases]." McCarthy, *supra* n. 1, at vol. 3, § 11:47.

defendant would be using the plaintiff's trademark to describe the plaintiff's product (as required by *New Kids on the Block*).[258] Thus, nominative fair use is not precluded by this strong version of initial interest confusion; rather, such a finding must be reserved for those situations that are both sufficiently similar to the unique situation described in *New Kids on the Block* and meet the requirements articulated therein.[259]

Nevertheless, eliminating the comparative advertising exception in the Internet context in all but a few cases is advocated. Since metatags are invisible or hidden text, no true comparative advertising could take place in them. Rather, comparative advertising could be a creative way for competitors to subvert the doctrine of initial interest confusion and attempt to capitalize on a competitor's goodwill and divert its customer base. Imagine the running shoe hypothetical. Instead of merely placing Nike in the metatags of their sites, Bob's Brand-X Shoes, Reebok, New Balance, Adidas, and Converse could all place the phrase "Nike competitor" or "we are better than Nike" in their metatags. Doing so would likely result in a problem similar to the one discussed in the hypothetical with the various companies being part of a search engine results list. Allowing an end run around the initial interest confusion doctrine in this manner would be contrary to both the legal and policy concerns noted herein.

Further, imagine a situation where the use of a competitor's trademark in metatags would legitimately fall within the comparative advertising exception. For example, Pepsi might dedicate a web site to its well-known "Pepsi Challenge" taste test against Coca-Cola. If this happened, Pepsi ought to be able to use "Pepsi and Coke taste test" in its metatags, since this would be a fair and accurate description of the web site content and not an attempt to confuse consumers or divert them from Coke's web site in the sense found objectionable by the initial interest confusion doctrine. Thus, the comparative advertising exception ought only to be applied in situations where web site content justifies the application.[260] This narrow application of both fair use and comparative advertising is consistent with both the current legal standards and policy considerations discussed herein.

---

[258] *New Kids on the Block v. News Am. Publg. Inc.*, 971 F.2d 302, 308, 23 U.S.P.Q. 1534, 1538 (9th Cir. 1991).

[259] *See id*.

[260] This situation could easily fall within the nominative fair use defense making the application of the comparative advertising exception moot.

CONCLUSION

While the contours of the initial interest confusion doctrine are still relatively unsettled, it is clear that the initial interest confusion doctrine as applied to metatags and in the Internet context is well-settled law. Throughout this analysis, an attempt has been made to articulate where the edges of the doctrine currently extend. In so doing, three categories were created: possible initial interest confusion, likelihood of initial interest confusion, and actual initial interest confusion. These new labels will provide much needed clarity in discussions and analyses of the initial interest confusion doctrine. While seemingly minor semantic distinctions, the careful attention to such minor distinctions can prevent the muddled reasoning displayed by the *Welles* court. Additionally, this article re-conceptualized the doctrine and made normative suggestions for its application to metatags, driven by the brick and mortar history of the doctrine as well as policy considerations. These suggestions led to a likelihood of initial interest confusion test that mirrors the traditional likelihood of confusion test, something sorely missed in *Brookfield*. While the initial interest confusion doctrine as advocated herein might be deemed radical by some accounts, it fits entirely within current case law, doctrinal history, and policy considerations. As many of the issues touched upon have received little judicial or academic attention, it remains to be seen how the doctrine will take shape in the coming years. While the normative suggestions put forth in this article might not be agreeable to all, the analytical framework utilized still can be of use as others begin to take notice of these issues, and this paradigm will hopefully lead to better and more precise discussions and provide some much needed clarity in a quickly expanding area of jurisprudence.