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DON'T CONFUSE METATAGS WITH INITIAL INTEREST CONFUSION

Yelena Dunaevsky*

INTRODUCTION

The beginning of the new millennium brings with it a variety of technological advances and, as a result, more than a handful of legal issues. One of the most prominent technological breakthroughs is the Internet. In the last few years, courts have been faced with a barrage of Internet related legal dilemmas.¹ The focus of this Comment is whether the legal doctrine of "initial interest confusion"² should be applied in metatag³ related trademark infringement cases.⁴ Likelihood of confusion is required to prove trademark infringement.⁵ Such likelihood, however, is not easily apparent in cases involving trademark infringement through the use of metatags⁶ (parts of programming language embedded in a

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1. See Stanley U. Paylago, *Trademark Infringement, Metatags, and the Initial Interest Confusion Remedy*, 9 MEDIA L. & POL'Y 49 (2000) (listing hyperlinking, cybersquatting, and metatagging as novel problems among the intellectual property issues raised by the Internet); see also Jeffrey J. Look, *The Virtual Wild Wild West (WWW): Intellectual Property Issues in Cyberspace—Trademarks, Service Marks, Copyrights, and Domain Names*, 22 U. ARK. LITTLE ROCK L. REV. 49 (1999) (discussing conflicting legal ideologies about the Internet).

2. Initial interest confusion is a doctrine coined by the Ninth Circuit Court of Appeals in *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036, 1062 (9th Cir. 1999). For a more detailed discussion of initial interest confusion see discussion *infra* Part II.D.

3. A metatag is a special encoded term that is hidden in the code of a webpage (an electronic page on the Internet which contains various information) to provide information about the webpage. Unlike normal tags, metatags do not affect how the page is displayed. Instead, they provide information such as who created the page, how often it is updated, what the page is about, and which keywords represent the page's content. Many search engines use this information when building their indices. Webopedia definition of a metatag, at http://www.webopedia.com/TERM/m/meta_tag.html http://www.webopedia.com/TERM/M/meta_tag.html (last visited Jan. 15, 2002). For a detailed discussion of metatags, see discussion *infra* Part I.D.

4. The cases discussed in Part III of this Comment all focus on the issue of trademark infringement through the unauthorized use of trademarks in the metatags of websites. The cases also focus on the question of whether the doctrine of initial interest confusion can be used to determine whether infringement occurred.

5. See discussion *infra* Part II.C.

6. See discussion *infra* Part I.D.

webpage that Web designers use to describe their webpages).⁷ Therefore, some courts have used initial interest confusion⁸ (the transient confusion that Internet users may experience while searching for a particular product or service on the Internet) to lower the legal threshold for the required proof of confusion.⁹ This Comment argues that because it does not improve or clarify the existing process of legal inquiry in a trademark infringement litigation, the doctrine of initial interest confusion is a superfluous legal tool and may even be harmful from a public policy perspective.

Specifically, this Comment explores whether the doctrine of initial interest confusion, as used in metatag related cases, serves any useful purpose not already served by the expanded definition of actual confusion,¹⁰ which is required to prove the likelihood of confusion element¹¹ in a trademark infringement suit. This Comment concludes that the usefulness of the doctrine is greatly compromised not only by the broad definition of actual confusion,¹² but also by the limitations imposed on consumers by a strict implementation of the doctrine.¹³ Part I of this Comment provides background information on the Internet, search engines¹⁴ and metatags.

7. See *infra* note 18.

8. See discussion *infra* Part II.D.

9. See discussion *infra* Part III.A.

10. The existence of actual confusion is one of the factors courts use to determine the existence of trademark infringement. *Powder River Oil v. Powder River Petroleum*, 830 P.2d 403, 416-17 (Wyo. 1992) (holding that likelihood of confusion among suppliers as well as consumers deserves the same consideration as a relevant factor in determining infringement); see also discussion of the "Polaroid factors" *infra* Part II.C. Actual confusion is the confusion usually experienced by consumers as to the origin of a trademarked item. Actual confusion may be proven by direct testimony or established by consumer surveys, misdirected mail or misdirected telephone calls. *Powder River*, 830 P.2d at 416. See also *Paylago*, *supra* note 1, at 56 (stating that some courts have expanded the definition of actual confusion to include pre-sale, sale, post-sale and even no-sale confusion).

11. Likelihood of confusion is the core element of trademark infringement. *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036, 1053 (9th Cir. 1999). The standard used to prove likelihood of confusion is whether the similarity of the trademarks is likely to confuse consumers about the source of the products. *Id.*

12. Actual confusion may be defined as the confusion as to the source of the product or service that consumers experience in connection with their purchase of such product or service and may be proven by anecdotal or survey evidence. The evidence must provide a "substantial likelihood that the public will be confused." *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1083 (S.D. Cal. 1999).

13. See discussion *infra* Part IV.B.

14. Search engines are programs that search "documents for specified keywords and return a list of the documents where the keywords were found. Although the term "search engine" really refers to a general class of programs, the term is often used to specifically describe systems like Alta Vista and Excite that enable users to search for documents on the World Wide Web." Webopedia definition of a search

Part II offers an update on the relevant trademark law. Part III presents a brief overview of the recent court cases involving metatags and initial interest confusion. Finally, Part IV argues that a hasty expansion of the trademark law in applying the doctrine of initial interest confusion to metatag related cases may prove detrimental to both trademark law and the economy. Such expansion will likely not only promote superfluity, but would also favor the protection of trademark owners without considering the interests of consumers. This would, in turn, undermine consumers' free access to information and stifle healthy economic competition.

I. THE WORLD WIDE WEB¹⁵

A. The Internet

The Internet, or the "World Wide Web," is a worldwide network providing connections between millions of computers, thereby facilitating the communication and exchange of information.¹⁶ The Internet offers an effective medium for businesses to advertise, sell their products or supply consumers with a variety of other information made available on the World Wide Web.¹⁷ This information is located on electronic webpages¹⁸ and is becoming available to an increasing number of consumers.¹⁹ For example, over 2.8 million

engine, at http://www.webopedia.com/TERM/s/search_engine.htmlhttp://www.webopedia.com/TERM/d/domain_name.html (last visited Jan. 15, 2002). Alta Vista is located at <http://www.altavista.com><http://www.altavista.com>; Excite is located at <http://www.excite.com>.

15. The World Wide Web is a "system of Internet servers that support specially formatted documents." Webopedia definition of the World Wide Web, at http://www.webopedia.com/TERM/W/World_Wide_Web.html (last visited Jan. 15, 2002). The documents are formatted in a language called HTML (Hyper Text Markup Language) that supports links to other documents, as well as graphics, audio and video files. *Id.* This means a user can jump from one document to another simply by clicking on the links. *Id.*

16. *Bihari v. Gross*, 119 F. Supp. 2d 309, 311-12 (S.D.N.Y. 2000) (providing a brief review of the fundamentals of the Internet).

17. *See Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1091 (S.D. Cal. 1999) (supporting the view that the Internet has become a popular medium for advertising and direct consumer access to goods and services).

18. Electronic webpages are pages on the World Wide Web, that vary in content, are usually combined into websites and are accessible through almost any computer. Paylago, *supra* note 1, at 52 (discussing judicial application of trademark law to metatag infringers and advocating the use of pre-sale confusion doctrine in the metatag context).

19. *Id.* at 51-2.

websites²⁰ existed in 1999, while the current number of webpages is estimated at over one billion.²¹

B. Domain Names²²

Internet users have two basic options to locate needed information. The first option allows a web surfer²³ to access a specific site by entering the site's domain name into his web browser's²⁴ address window. Domain names are used to identify webpages on the Internet.²⁵ Every webpage has an assigned domain name that serves to distinguish it from millions of other webpages.²⁶ Essentially, a domain name serves as a street address by which different pages on the Internet can be located. A user can either type the domain name directly into the address bar on his browser immediately and bring up the desired webpage, or, if he does not remember the specific domain name, he can use a search engine.²⁷

20. Terrell W. Mills, *Metatags: Seeking to Evade User Detection and the Lanham Act*, 6 RICH. J.L. & TECH. 22, *7 (2000) (evaluating the validity of trademark infringement, false advertising and dilution claims arising from the use of trademarks in webpage metatags and concluding that trademark law is ill-equipped to address metatag misuse). A website is a location on the World Wide Web that contains a home page—the first document users see when they enter the site—and additional documents or files, which are normally stored on other webpages that link to the home page. Each site is owned and managed by an individual, company or organization. Webopedia definition of a website, at http://www.webopedia.com/TERM/W/web_site.html (last visited Jan. 10, 2002).

21. Veronica Tucci, *The Case of the Invisible Infringer: Trademarks, Metatags and Initial Interest Confusion*, 5 J. TECH L. & POL'Y 2, *8 (2000) (evaluating recent case law on trademark infringement through the use of metatags and concluding that courts readily enjoin and sometimes fine companies for using their competitor's marks in metatags).

22. Domain names are used to identify particular Webpages. Webopedia definition of a domain name, at http://www.webopedia.com/TERM/d/domain_name.html (last visited Jan. 10, 2002).

23. The term "surfing" is generally used to describe an undirected type of web browsing in which the user jumps from page to page as opposed to searching for specific information. Webopedia definition of surfing, at <http://www.webopedia.com/TERM/s/surf.html> (last visited Jan. 10, 2002).

24. A "Web browser," or simply "browser," is a software application used to locate and display webpages. The two most popular browsers are Netscape Navigator and Microsoft Internet Explorer. Webopedia definition of a web browser, at <http://www.webopedia.com/TERM/b/browser.html> (last visited Jan. 10, 2002).

25. Webopedia definition of a domain name, at <http://www.webopedia.com/TERM/d/domain-name.html>http://www.webopedia.com/TERM/d/domain_name.html (last visited Jan. 10, 2002).

26. Tucci, *supra* note 21, at *9.

27. For a more detailed discussion of search engines, see discussion *infra* Part I.C.

Domain names contain two main parts: a top level domain and a second level domain.²⁸ The top level domain indicates the type of organization that operates the webpage.²⁹ For example, businesses usually use “.com” as their top level domain; organizations use “.org”; educational institutions are designated by “.edu”; and government agencies by “.gov.”³⁰ The second level domain consists of the company’s name, its product or a term descriptive of the company’s name, product or business.³¹ “Yahoo” and “nytimes” are examples of second level domains; thus, familiar domain names include “yahoo.com” and “nytimes.com”.³²

C. Search Engines

The second strategy web surfers use to locate information involves search engines.³³ If a user does not know the exact domain name of the website he needs to access, he can enter keywords into a search engine.³⁴ The search engine will then scan millions of webpages³⁵ to retrieve the information that matches the searched keywords.³⁶ Based on the keywords provided by the consumer, the

28. Tucci, *supra* note 21, at *9.

29. *Id.*

30. Webopedia definition of a domain name, at <http://www.webopedia.com/TERM/d/domain-name.html>http://www.webopedia.com/TERM/d/domain_name.html (last visited Jan. 10, 2002).

31. See Tucci, *supra* note 21, at *9.

32. Yahoo is located at <http://www.yahoo.com>; New York Times is located at <http://www.nytimes.com>. The majority of Internet related trademark infringement litigation occurs in the area of domain names, but this Comment focuses solely on trademark infringement resulting from the incorrect use of metatags. See, e.g., Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 COLUM. J.L. & SOC. PROBS. 439, 457-62 (2000) (describing several cases in which the doctrine of initial interest confusion is applied to domain name trademark infringement situations). See generally Adam Silberlight, *WWW. How to Be a Master of Your Domain.Com: A Look at the Assignment of Internet Domain Names Under Federal Trademark Laws, Federal Case Law and Beyond*, 10 ALB. L.J. SCI. & TECH. 229 (2000) (providing an overview of the Internet domain name scheme and analyzing contemporary trademark law).

33. Paylago, *supra* note 1, at 52-3.

34. *Id.*

35. “Typically, a search engine works by sending out a “spider” to fetch as many documents as possible. Another program, called an “indexer,” then reads these documents and creates an index based on the words contained in each document.” Webopedia definition of a search engine, at http://www.webopedia.com/TERM/s/search_engine.htmlhttp://www.webopedia.com/TERM/d/domain_name.html (last visited Jan. 18, 2002).

36. See Tucci, *supra* note 21, at *11; Shannon N. King, *Brookfield Communications v. W. Coast Entm’t*, 15 BERKELEY TECH. L.J. 313, 315-16 (2000) (advocating against judicial application of trademark law to metatag cases and asserting that in-

search engine retrieves web addresses³⁷ that link to the pages containing closely matching information when the user clicks on the link with a mouse.³⁸

Search engines operate via two general methods: the “human-centered” method and the “mechanical” method.³⁹ Search engines like Yahoo are human-centered because their directories are compiled by people who individually evaluate every new website.⁴⁰

The mechanical method, used by search engines such as Alta Vista and Excite, provides “a mechanical index of the Web” by allowing massive databases to continuously search and read through thousands of new websites and then to index the websites according to certain specifications.⁴¹ These specifications are provided by human beings who write “web crawling” programs,⁴² but such programs do not have the flexibility of making intelligent choices.⁴³ Unlike human-centered search engines such as Yahoo, web crawling programs provide an avalanche of results, which often lack logical connection to the user’s keywords.⁴⁴ Thus, although the human-centered method is slower than the mechanical method, its organization is probably more logical and useful to the Internet surfer.⁴⁵ This is where the process of ranking results becomes important.⁴⁶

consistent application of trademark doctrine promotes litigation, increases business costs and taxes judicial resources).

37. See Posner, *supra* note 32, at 443 (arguing that traditional trademark laws apply to metatagging and that federal courts should uniformly apply the Ninth Circuit’s reasoning in *Brookfield*). See *infra* Part III.A for a discussion of the *Brookfield* case.

38. A mouse is a device that controls the movement of the cursor or pointer on a display screen. It was invented by Douglas Engelbart of Stanford Research Center in 1963 and is now used with most computers. Webopedia definition of a mouse, at <http://www.webopedia.com/TERM/m/mouse.html> (last visited on Jan. 18, 2002).

39. F. Gregory Lastowka, *Search Engines, HTML, and Trademarks: What’s the Meta For?*, 86 VA. L. REV. 835, 847-48 (2000) (examining the legal and technical issues surrounding metatag use and arguing that law and policy favor the application of traditional trademark law to deceptive description metatags, but that keyword metatag problems are better addressed through market-driven technological innovations).

40. *Id.*

41. *Id.* at 848.

42. Web crawling programs gather content information of individual webpages by reading the code of those webpages and then store the text that they find on each page in cyberspace memory. *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1092 (S.D. Cal. 1999).

43. See Lastowka, *supra* note 39, at 848-49.

44. *Id.*

45. *Id.*

46. *Id.* at 849.

Search engines use ranking systems to determine the order in which they present their results to Internet users.⁴⁷ Different engines use different factors when devising their ranking systems.⁴⁸ A common factor is the number of “times a given search term appears on a [w]eb page.”⁴⁹ The likelihood of a search engine picking out a specific webpage increases with the number of times a given search term is used in that page.⁵⁰ Search engines also differ in the “relevance factor”⁵¹ they assign to metatags.⁵² Some award great weight to “keyword metatags”;⁵³ others, like Excite, ignore them altogether.⁵⁴ In other words, search engines focus on different properties or attributes of webpages to procure the list of websites they produce for the Internet users.

If a web surfer is using a search engine which does not rely heavily on metatags,⁵⁵ he is less likely to be confused by an improper use of a metatag and thus less likely to suffer initial interest confusion.⁵⁶ Even if a search engine relies heavily on metatags,⁵⁷ the chance of encountering initial interest confusion is small because the search engine only generates a list of available websites.⁵⁸ Thus, the search engine does not force the user onto any specific site, but simply lets him choose from the list of websites that it generates.⁵⁹

Normally, a user can distinguish the source of the website based on either the short description of the website or its domain name.⁶⁰

47. *Id.*

48. *Id.* at 849-50.

49. Lastowka, *supra* note 39, at 849.

50. *Id.*

51. Search engines assign relevance factors to different aspects of websites to provide users with a list of results that are most relevant to the user's search term(s). *Id.* at 849. However, the formula for determining relevance is not uniform among different search engines. *Id.* at 849-50.

52. See discussion *infra* Part I.D.

53. Keyword metatags are used to specify the terms that are contained in the website and that are picked up by search engines during a search. See Mills, *supra* note 20, at *6; see also King, *supra* note 36, at 314-15. For a more detailed discussion of keyword metatags, see discussion *infra* Part I.D.

54. Lastowka, *supra* note 39, at 849-50.

55. See discussion *infra* Part I.D.

56. For a detailed discussion of initial interest confusion, see discussion *infra* Part II.D.

57. See discussion *infra* Part I.D.

58. Dan McCuaig, *Halve the Baby: An Obvious Solution to the Troubling Use of Trademarks as Metatags*, 18 J. MARSHALL J. COMPUTER & INFO. L. 643, 647 (2000) (suggesting a solution to the use of trademarks as metatags).

59. *Id.*

60. Posner, *supra* note 32, at 446.

Both of these distinguishing features are displayed underneath the website's link in the list produced by the search engine.⁶¹ If the user makes a mistake by clicking on an incorrect page, or is dissatisfied with the products offered by the page he first chose, he can "normally return to the list produced by the search engine by selecting the 'back' key" on his Web browser.⁶² Thus, search engines do not trap users into particular websites, but simply provide users with a number of choices.⁶³

D. Metatags

As discussed in Part I.C, some search engines match users' keywords to the metatags of Internet websites.⁶⁴ "A metatag is part of the webpage programming language that is embedded on a webpage, but never seen by the end user."⁶⁵ Web designers use metatags to describe their webpages.⁶⁶ The two types of metatags that some search engines use to index and rank websites, and which are most relevant to trademark infringement litigation because they have a greater chance of causing initial interest confusion, are the "keyword" and the "description" metatags.⁶⁷

A "keyword" metatag is used to specify the terms contained in the website.⁶⁸ If one or more of these terms is matched with the user's search request, the website containing the metatag is included in the results of the search.⁶⁹ Search engines also read "description" metatags, which allow web designers to give "a brief description of the contents of their pages in plain English."⁷⁰

There are reasons why websites strive to attract as many users as possible and why they use metatags to do so. To make money, a website must attract users.⁷¹ A website can make money in two ways.⁷² The first way is through selling the products or services

61. *Id.* at 445-46.

62. *Id.* at 446.

63. McCuaig, *supra* note 58, at 662 (mentioning that Internet surfers have freedom to select the websites they want to visit from the list generated by search engines); Mills, *supra* note 20, at *26 (same).

64. See discussion *supra* Part I.C.

65. Mills, *supra* note 20, at *6.

66. Bihari v. Gross, 119 F. Supp. 2d 309, 312 n.3. (S.D.N.Y. 2000).

67. King, *supra* note 36, at 314-15.

68. Mills, *supra* note 20, at *6; King, *supra* note 36, at 314-15.

69. Mills, *supra* note 20, at *6.

70. Lastowka, *supra* note 39, at 846.

71. Mills, *supra* note 20, at *7.

72. *Id.*

offered on the site.⁷³ The second is by selling advertising space on the website to third parties.⁷⁴ The price of the advertisements depends on the volume of users that visit the site; the price goes up with an increase in the number of visitors.⁷⁵

Webpage developers advocate the use of metatags because metatags are most effective in attracting more attention to the site.⁷⁶ To further increase exposure, many web developers include an extensive number of terms and term variations in their metatags.⁷⁷ Some even repeat the same term over and over again hoping that high frequency of the term will attract the search engine's attention.⁷⁸ Others go so far as to include popular terms that have nothing to do with the site.⁷⁹

It is common practice for web designers to include all kinds of words, names, symbols, or even trademarked terms in their metatags "to capture the attention of every possible interested user."⁸⁰ Problems arise when a business includes trademarks of its competitors in the metatags of its website.⁸¹ Some argue that such practice constitutes infringement under the trademark laws;⁸² others assert that such use can be fair.⁸³

73. *Id.*

74. *Id.*

75. *Id.*

76. Mills, *supra* note 20, at *9.

77. *Id.*

78. See Posner, *supra* note 32, at 446.

79. Mills, *supra* note 20, at *9.

80. King, *supra* note 36, at 315.

81. See, e.g., *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036, 1066 (9th Cir. 1999) (holding defendants liable for trademark infringement for the use of plaintiff's trademark in metatags of defendants' website); *SNA, Inc. v. Array*, 51 F. Supp. 2d 554, 562-63 (E.D. Penn. 1999) (same); see discussion *infra* Parts III.A and III.B.

82. See J. Thomas McCarthy, *Trademarks, Cybersquatters and Domain Names*, 10 J. ART & ENT. LAW 231, 235-6 (2000) (supporting the *Brookfield* decision by stating that initial interest confusion can be used as an element of trademark infringement in metatag situations). Several courts have already concluded that the use of another's trademark in the metatags of one's website constitutes trademark infringement. See *supra* note 81.

83. See *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1073 (S.D. Cal. 1999) (upholding the defense of fair use in a trademark infringement litigation involving defendant's use of plaintiff's trademarks in her metatags).

II. TRADEMARK LAW

A. Trademarks

The Trademark Act of 1946, commonly known as the Lanham Trade-Mark Act⁸⁴ (the Act), is the foundation of federal protection for trademarks.⁸⁵ “A federally registered trademark is a mark that provides the registrant with its exclusive use in commerce or in connection with the goods or services specified in the registration.”⁸⁶ The Act defines a trademark to include

any word, name, symbol, or device, or any combination thereof—

- (1) used by a person, or
- (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.⁸⁷

In short, “[a] trademark is a ‘limited property’ right in a particular word, phrase, or symbol.”⁸⁸ Examples of commonly known trademarks include Coca-Cola, Ford and Blockbuster.⁸⁹

Trademarks are not, however, limited to words.⁹⁰ Stylized logos, artistic designs, colors, and even sounds can be registered as trademarks.⁹¹ Some examples are Nike’s “Swoosh” and the three sound combination known as the “NBC chimes.”⁹²

Trademarks do not even need to be registered to be protected.⁹³ “A person can acquire trademark rights . . . ‘simply by using a mark on or in connection with goods.’”⁹⁴ For example, if McDonald’s had not registered its golden arches, but had widely used them for some period of time in connection with its business, it

84. 15 U.S.C. §§ 1051-1127 (2000).

85. Posner, *supra* note 32, at 448.

86. Paylago, *supra* note 1, at 54.

87. 15 U.S.C. § 1127 (2000).

88. *Playboy*, 78 F. Supp. 2d at 1073 (quoting *New Kids on the Block v. News Am. Publ’g*, 971 F.2d 302, 306 (9th Cir. 1992)).

89. Tucci, *supra* note 21, at *21.

90. *Id.*

91. *Id.* at 22.

92. *Id.*

93. *See, e.g., Shade’s Landing v. James C. Williams*, 76 F. Supp. 2d 983, 987 (D. Minn. 1999) (finding that even a common law trademark qualifies for protection under the Lanham Act as long as it satisfies certain parameters).

94. Posner, *supra* note 32, at 448 (quoting WILLIAM M. BORCHARD, *A TRADEMARK IS NOT A COPYRIGHT OR A PATENT* 4 (1999)).

could successfully argue that the golden arches were its trademark. The only two basic requirements for unregistered trademarks are that their use be “actual” and “commercial.”⁹⁵

Protection of trademark rights serves two primary purposes.⁹⁶ First, it reduces the likelihood of consumer confusion by protecting the public from misleading trademark practices and by providing economic incentives for businesses to clearly identify and maintain their trademarks.⁹⁷ Second, by providing a legal barrier to the misappropriation and pirating of trademarks, trademark laws protect the time, energy and capital that trademark owners invest⁹⁸ into establishing and developing their marks.⁹⁹

95. ‘Use’ of a mark means the bona fide use of such mark made in the ordinary course of trade, and not made merely to reserve a right in a mark [i.e., “actual use”]. . . . The term ‘use in commerce’ means the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark. For purposes of this chapter, a mark shall be deemed to be in use in commerce (1) on goods when (A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and (B) the goods are sold or transported in commerce, and (2) on services when it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in more than one State or in the United States and a foreign country and the person rendering the services is engaged in commerce in connection with the services.

15 U.S.C. § 1127 (2000).

96. See *PACCAR v. Telescan Techs.*, 115 F. Supp. 2d 772, 780 (E.D. Mich. 2000) (stating that it is in the “public’s interest to protect consumers from confusion and [to] protect the right of a trademark owner to control its own product’s reputation”).

97. See, e.g., *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1074 (S.D. Cal. 1999).

98. See, e.g., *King*, *supra* note 36, at 316; see also *McCuaig*, *supra* note 58, at 647 (suggesting a solution to metatag related trademark infringement by creating a new “Trademark” metatag); *Tucci*, *supra* note 21, at *23.

99. While trademark owners can bring claims against an alleged violator for, among other things, infringement, dilution, and false advertising, this Comment focuses on federal trademark infringement only. “The term ‘dilution’ means the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other Parties, or (2) likelihood of confusion, mistake, or deception.” 15 U.S.C. § 1127 (2000). The purpose of the 1996 amendment to the Act, which allows one to bring the claim of dilution as a federal cause of action, is to extend the bounds of trademark infringement “to remedy any reduction in the public perception of a trademarked term that does not rise to the standards needed for an infringement cause of action.” *Silberlight*, *supra* note 32, at 254 (providing an overview of the Internet domain name scheme and analyzing contemporary trademark law). Section 43(a)(1)(B) of the Act protects trademark owners from false advertising. To succeed on a false advertising claim, a trademark owner does not need to prove likelihood of confusion, but he must prove (1) that defendants made false or deceptive advertise-

B. Trademark Infringement

The Act provides a detailed definition of trademark infringement. It does not permit any person, without the registrant's consent, to

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . .¹⁰⁰

Thus, to prove trademark infringement under the Act, a plaintiff must show that (1) he has a valid mark entitled to protection under the Act; (2) he owns the mark; (3) a copy of the mark was used by another; (4) such use was commercial; and (5) the use is likely to cause confusion as to the origin of the mark.¹⁰¹

This Comment will assume a plaintiff has satisfied the first, second and third requirements and focus only on the fourth and fifth requirements. The fourth requirement provides that, to sustain a cause of action for infringement, the use of a trademark must be commercial.¹⁰² Noncommercial use is not actionable under the Act.¹⁰³ However, the tests for "use in commerce"¹⁰⁴ and "in connection with goods and services,"¹⁰⁵ which courts use to determine whether the use of a trademark is commercial, are exceedingly

ments or representation to customer, (2) that those advertisements deceived a significant portion of the consuming public, and (3) that trademark owner was injured by defendant's conduct. Mills, *supra* note 20, at *34; Posner, *supra* note 32, at 449.

100. 15 U.S.C. § 1114(1) (2000).

101. See, e.g., *Bihari v. Gross*, 119 F. Supp. 2d 309, 316-17 (S.D.N.Y. 2000); *Eli Lilly v. Natural Answers*, 86 F. Supp. 2d 834, 840 (S.D. Ind.) *aff'd*, 233 F.3d 456 (7th Cir. 2000); *Paylago*, *supra* note 1, at 55 (2000); Mills, *supra* note 20, at *13 (citing J. THOMAS MCCARTHY, *MCCARTHY ON TRADEMARKS* §27.13 (3d ed. 1996)); *Tucci*, *supra* note 21, at *28.

102. See, e.g., *Bihari*, 119 F. Supp. 2d at 318.

103. *Id.*

104. 15 U.S.C. § 1127 (2000).

105. *Id.* § 1125(a)(1).

broad and are, therefore, easy to satisfy.¹⁰⁶ The connection with goods or services, for example, does not need to be a direct connection,¹⁰⁷ merely selling advertising space is sufficient to satisfy the “use in commerce” requirement.¹⁰⁸ Proving the likelihood of confusion, however, can be difficult.

C. Confusion

The fifth requirement, which involves “likelihood of confusion,” is considered to be the cornerstone of trademark infringement.¹⁰⁹ Although each of the United States circuit courts of appeals has developed its own test for determining whether likelihood of confusion is present,¹¹⁰ most of the tests use eight similar factors.¹¹¹ The Second Circuit, for example, employs an eight-factor test established by Judge Friendly in *Polaroid v. Polaroid Electronics*.¹¹² The eight factors are

1. the strength of the plaintiff’s mark;
2. the degree of similarity between the two marks;
3. the competitive proximity of the products or services;
4. the likelihood that the plaintiff will “bridge the gap” between the two markets;
5. the existence of actual confusion;
6. the defendant’s good faith in adopting its mark;
7. the quality of the defendant’s product; and
8. the sophistication of the purchasers.¹¹³

106. Mills, *supra* note 20, at *15 (explaining that almost all commercial websites will meet the requirements of these tests).

107. *Id.*

108. *Id.*

109. Nissan Motor v. Nissan Computer, 89 F. Supp. 2d 1154, 1162 (C.D. Cal. 2000); Brookfield Communications v. W. Coast Entm’t, 174 F.3d 1036, 1053 (9th Cir. 1999); Mills, *supra* note 20, at *16; Paylago, *supra* note 1, at *55; Posner, *supra* note 32, at 452.

110. PACCAR v. Telescan Techs., 115 F. Supp. 2d 772, 776 (E.D. Mich. 2000) (listing the eight factors that the Sixth Circuit uses to determine whether likelihood of confusion exists); Brookfield, 174 F.3d at 1053-54 (listing the Ninth Circuit’s eight factors); Eli Lilly v. Natural Answers, 86 F. Supp. 2d 834, 840-41 (S.D. Ind.) *aff’d*, 233 F.3d 456 (7th Cir. 2000) (listing the Seventh Circuit’s seven factors).

111. Compare, for example, the factors the Ninth Circuit used in Brookfield, 174 F.3d at 1053-54 with the factors set forth by the Sixth Circuit in PACCAR, 115 F. Supp. 2d at 776 and note the similarity among the characteristics used to evaluate the likelihood of confusion.

112. Polaroid v. Polaroid Elec., 287 F.2d 492, 498 (2d Cir. 1996).

113. N. Y. State Soc’y of Certified Pub. Accountants v. Eric Louis Assocs., 79 F. Supp. 2d 331, 340 (S.D.N.Y. 1999).

Although all eight factors pose legal hurdles, the questions raised in this Comment focus primarily on three factors: the existence of actual confusion, a defendant's good faith, and consumer sophistication.

D. Initial Interest Confusion

Several courts have held that a showing of actual confusion is not required to maintain an action for trademark infringement as long as "other factors point to a significant likelihood of actual confusion."¹¹⁴ Although actual confusion is not required for a showing of trademark infringement, a mere possibility of actual confusion is not enough.¹¹⁵ "The test for actual confusion is not whether anyone *could possibly* be confused, but whether the 'reasonably prudent consumer' is likely to be confused."¹¹⁶

The broad scope of this test explains why some courts have been flexible enough to accept the theory of "initial interest confusion."¹¹⁷ Initial interest confusion is different from confusion at the point of sale, which is the most common type of confusion in an infringement action.¹¹⁸ The point of sale confusion occurs when the consumer decides to purchase a product, but is somehow misled as to the product's origin at the time of the purchase.¹¹⁹

To the contrary, initial interest confusion occurs before the sale is made.¹²⁰ The consumer discovers his initial confusion before the sale, but instead of correcting his mistake he proceeds to purchase the product he initially mistook for the original.¹²¹ Courts agree that when a vendor intentionally diverts consumer attention from his competitor by using the competitor's trademark, or something that may be confused for the competitor's trademark, the vendor benefits unjustly from the competitor's goodwill and can be accused of trademark infringement under the Act.¹²²

114. *Eli Lilly*, 86 F. Supp. 2d at 845; see also *PACCAR*, 115 F. Supp. 2d at 778 (holding that although a showing of actual confusion constitutes strong evidence of infringement, the absence of such evidence is not dispositive).

115. *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1083.

116. *The Network Network v. CBS*, No. CV 98-1349 NM, 2000 U.S. Dist. LEXIS 4751, at *17 (C.D. Ca. Jan. 16, 2000) (quoting *Brookfield*, 174 F.3d at 1060).

117. *Brookfield*, 174 F.3d at 1061; *Nissan Motor v. Nissan Computer*, 89 F. Supp. 2d 1154, 1162-163 (C.D. Ca. 2000); *Bigstar Entm't v. Next Big Star*, 105 F. Supp. 2d 185, 207 (S.D.N.Y. 2000).

118. Posner, *supra* note 32, at 453.

119. Paylago, *supra* note 1, at 56.

120. *Id.*

121. *Id.*

122. *Id.*

In the context of the Internet, “the concern is that potential consumers of one website (website 1) will be diverted and distracted to a competing website (website 2).”¹²³ The harm comes from the fact that potential consumers may believe that website 2 is associated with website 1 and will be too lazy to resume their search for website 1.¹²⁴ Alternatively, if they do not believe that there is any association between websites 1 and 2, they may still choose to remain on website 2 because its information may simply be appealing enough for them to abandon their initial search.¹²⁵ In either situation, the result is the diversion of potential consumers from their original search.¹²⁶

The doctrine of initial interest confusion has been widely used in the non-Internet context.¹²⁷ A majority of federal courts have found a showing of initial interest confusion sufficient to satisfy the confusion element of an infringement claim under the Act.¹²⁸ For example, in an oil industry case, *Mobil Oil v. Pegasus Petroleum*,¹²⁹ the Second Circuit found that the defendant’s trademark name “Pegasus” caused a likelihood of confusion with the plaintiff’s trademark, a flying horse symbol representing Pegasus, the winged horse in Greek mythology. Similarly, in a publishing industry case, *Dr. Seuss Enterprises v. Penguin Books USA*,¹³⁰ the Ninth Circuit enjoined the defendants, who published a book on the O.J. Simpson trial entitled *The Cat NOT in the Hat! A Parody by Dr. Juice*, from distributing the book, holding that the title created a strong likelihood of confusion with the plaintiff’s trademarks from the book *The Cat in the Hat*.¹³¹ Although some courts have recently extended the initial interest confusion doctrine to the Internet,¹³² others have refused to make the same leap,¹³³ partially because of

123. *Bihari v. Gross*, 119 F. Supp. 2d 309, 319 (S.D.N.Y. 2000).

124. *Id.*

125. McCuaig, *supra* note 58, at 680 (discussing possible consumer responses to encountering an alternate website).

126. *Id.*

127. Posner, *supra* note 32, at 462-63.

128. *Id.*

129. *Mobil Oil v. Pegasus Petroleum*, 818 F.2d 254 (2d Cir. 1987).

130. *Dr. Seuss Enters. v. Penguin Books USA*, 109 F.3d 1394 (9th Cir. 1997).

131. *Id.* at 1396.

132. *E.g.*, *Brookfield Communications v. W. Coast Entm’t*, 174 F.3d 1036 (9th Cir. 1999); discussion *infra* Part III.A; *see also SNA, Inc. v. Array*, 51 F. Supp. 2d 542 (E.D. Penn. 1999); discussion *infra* Part III.B.

133. *Bigstar Entm’t. v. Next Big Star*, 105 F. Supp. 2d 185, 207 (S.D.N.Y. 2000); *Bihari v. Gross*, 119 F. Supp. 2d 309, 319 n.14 (S.D.N.Y. 2000); *see also Posner, supra* note 32, at 453-54.

the existence of the "fair use defense," i.e., a defendant's good faith in adopting the mark.¹³⁴

E. The Good Faith Factor

The Act¹³⁵ allows a defendant to defeat a claim of trademark infringement if he proves that his use of another's mark was fair.¹³⁶ The Act provides an exception from liability for trademark infringement when¹³⁷

the use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party's individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used fairly and in good faith only to describe the goods or services of such party, or their geographic origin.¹³⁸

The fair use defense has been applied to the Internet¹³⁹ as well as to non-Internet related cases.¹⁴⁰ In the context of metatags, the fair use defense can be applied when another's trademark is used in metatags solely to describe the defendant or the defendant's goods or services.¹⁴¹

There are two types of fair use defenses: (1) descriptive or classic fair use and (2) nominative fair use.¹⁴² The descriptive or classic fair use defense "enables a defendant to use the plaintiff's mark to describe attributes of the defendant's [own] product."¹⁴³ For example, in *Sunmark v. Ocean Spray Cranberries*,¹⁴⁴ the Seventh Circuit allowed the defendant to use the term "sweet-tart," which was a known trademarked term, to describe its cranberry juice.¹⁴⁵

134. *E.g.*, *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066 (S.D. Cal. 1999) (holding that defendant's use of plaintiff's trademarks in metatags of defendant's website was fair because plaintiff's marks legitimately described the defendant and defendant's business); *see also Bihari*, 119 F. Supp. 2d at 321-24; discussion *infra* Part III.E.

135. 15 U.S.C. § 1115(b)(4) (2000).

136. Tucci, *supra* note 21, at *45.

137. Posner, *supra* note 32, at 467.

138. 15 U.S.C. § 1115(b)(4) (2000).

139. *See, e.g., Playboy*, 78 F. Supp. 2d at 1100 (upholding the defense of fair use in a trademark infringement litigation involving defendant's use of plaintiff's trademarks in her metatags). For a detailed discussion of this case, *see infra* Part III.C.

140. *Bihari*, 119 F. Supp. 2d at 321; Paylago, *supra* note 1, at 58-9.

141. 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION, § 25:69, at 25-150 (4th ed. 1999).

142. Posner, *supra* note 32, at 468; Tucci, *supra* note 21, at *46.

143. Tucci, *supra* note 21, at *47; *see also Bihari*, 119 F. Supp. 2d at 322.

144. *Sunmark v. Ocean Spray Cranberries*, 64 F.3d 1055, 1060 (7th Cir. 1995).

145. *Id.*

Nominative fair use enables a defendant to use the plaintiff's mark to show the relationship between the defendant's and the plaintiff's products.¹⁴⁶ However, the nominative fair use defense can succeed only if the commercial user (the defendant) satisfies the following three requirements.¹⁴⁷ First, the product in question must not be readily identifiable without the use of the trademark.¹⁴⁸ Second, the defendant must use only as much of the plaintiff's mark as is reasonably necessary to identify the defendant's product.¹⁴⁹ Finally, the user cannot engage in any conduct that would suggest affiliation with, or endorsement or sponsorship, by the trademark holder.¹⁵⁰

To benefit from the defense of fair use, a defendant must also act in good faith.¹⁵¹ "The inquiry into a defendant's good faith focuses on whether 'the defendant adopted its mark with the intention of capitalizing on plaintiff's reputation and goodwill. . . .'"¹⁵² If the defendant can show that it used the plaintiff's mark in good faith to either describe its own product or to compare its product to the plaintiff's product in an attempt at fair competition, it has a good chance of defeating the infringement claim.¹⁵³ Because it concerns a defendant's intent, the fair use defense will undoubtedly play an increasingly vital role in Internet related trademark infringement litigation, especially in the area dealing with metatags.

F. Consumer Sophistication

Courts often inquire into the level of sophistication the typical consumers of a particular product or service possess to determine whether trademark infringement has occurred.¹⁵⁴ Internet consumers usually demonstrate adequate sophistication to comfortably navigate the Internet through search engines and to determine

146. Tucci, *supra* note 21, at *48.

147. See *New Kids on the Block v. News Am. Publ'g*, 971 F.2d 302, 302-310 (9th Cir. 1992); Posner, *supra* note 32, at 468; Tucci, *supra* note 21, at *48.

148. Posner, *supra* note 32, at 468; Tucci, *supra* note 21, at *48.

149. Posner, *supra* note 32, at 468; Tucci, *supra* note 21, at *48.

150. Posner, *supra* note 32, at 468; Tucci, *supra* note 21, at *48.

151. *Bihari*, 119 F. Supp. 2d at 323.

152. *Id.* (quoting *Lang v. Ret. Living Pub.*, 949 F.2d 576, 583 (2d Cir. 1991)).

153. See, e.g., *Trans Union v. Credit Research*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001) (holding that defendants' use of plaintiffs' trademark in defendants' metatags was fair because it legitimately described defendants' business and the content of their websites). For a detailed discussion of the case, see discussion *infra* Part III.F.

154. See discussion of *Polaroid* factors *supra* Part II.C.

the origins of particular websites.¹⁵⁵ Even unsophisticated users are not likely to be confused by search engine generated lists of websites.¹⁵⁶ Thus, the question of adequate consumer sophistication is unlikely to cause major problems in trademark infringement cases dealing with metatags.

III. CASE LAW DEALING WITH METATAGS AND INITIAL INTEREST CONFUSION

Because the Internet is a relatively new phenomenon, few cases have dealt with the doctrine of initial interest confusion in the context of the Internet.¹⁵⁷ Furthermore, because most trademark infringement litigation occurs in the area of domain names,¹⁵⁸ the number of cases focusing specifically on trademark infringement resulting from unauthorized use of others' metatags is even smaller. The following six cases, however, cast some light on the most recent developments in trademark law in the area of metatags.

From the minute number of existing decisions it is difficult to predict the development of this legal field. The six decisions examined in this Comment, however, seem to put greater emphasis on the defendant's underlying intent than on the determination of whether the use of the plaintiff's trademark in the defendant's metatags is likely to cause confusion. The courts also appear to easily distinguish good faith from bad faith in metatag related situations, despite neglecting to define the differences between them, and to draw boundaries around legitimate use of trademarks in metatags. These trends raise the central question of this Comment: is the doctrine of initial interest confusion, ushered into this field of

155. King, *supra* note 36, at 325 (discussing unique expectations of Internet consumers); Posner, *supra* note 32, at 493 (noting that Internet users are aware of and have adapted to manipulative metatagging). For a more detailed discussion of consumer sophistication, see discussion *supra* Part IV.B.5.

156. Mills, *supra* note 20, at *18 (providing an example of the unlikelihood of such confusion).

157. The six cases presented in this Comment represent the current extent of judicial authority in this area.

158. Jason R. Berne, *Court Intervention But Not in a Classic Form: A Survey of Remedies in Internet Trademark Cases*, 43 ST. LOUIS L.J. 1157, 1170 (1999) (analyzing the remedies that courts have applied in cases of trademark infringement on the Internet and stating that most of the Internet trademark infringement claims have focused on the likelihood of confusion between domain names); see also discussion at *supra* Part I.B.

litigation by the notorious *Brookfield*¹⁵⁹ decision, a useful legal tool or a useless distraction?

A. *Brookfield Communications v. West Coast Entertainment*¹⁶⁰

In *Brookfield*, the Ninth Circuit was the first court to specifically address the issue of metatags in a trademark infringement suit.¹⁶¹ In this case, the plaintiff was in the business of gathering and selling information about the entertainment industry.¹⁶² The plaintiff's business later expanded onto the Internet in the form of a searchable database¹⁶³ which was marketed under the "MovieBuff" mark.¹⁶⁴ However, when the plaintiff attempted to register the World Wide Web domain name "moviebuff.com," it was informed that the same domain name had already been registered by the defendant.¹⁶⁵ The plaintiff then registered different domain names to sell its "MovieBuff" computer software and to "offer [its] Internet-based searchable software database [also] marketed under the 'MovieBuff' mark."¹⁶⁶ The plaintiff then successfully sought to register the "MovieBuff" mark with the Patent and Trademark Office.¹⁶⁷

The following year, the plaintiff learned that the defendant, "one of the nation's largest video rental store chains with over 500 stores," intended to launch its own website at "moviebuff.com," which would contain a searchable database similar to Brookfield's.¹⁶⁸ The plaintiff subsequently filed a lawsuit charging the defendant with trademark infringement in violation of 15 U.S.C. § 1114(1).¹⁶⁹

After discussing all the usual elements of a trademark infringement claim, the court focused on the issue of metatags.¹⁷⁰ To explain an Internet user's confusion resulting from search engine

159. *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036 (9th Cir. 1999); See also *infra* notes 159-177.

160. *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036 (9th Cir. 1999).

161. Paylago, *supra* note 1, at 62.

162. *Brookfield*, 174 F.3d at 1041.

163. A searchable database consists of a collection of information organized in such a way that a computer program is able to search for the desired data. Webopedia definition of a database, at <http://webopedia.com/TERM/d/database.html> (last visited Jan. 9, 2002).

164. *Brookfield*, 174 F.3d at 1041.

165. *Id.* at 1042.

166. *Id.*

167. *Id.*

168. *Id.*

169. *Brookfield*, 174 F.3d at 1043.

170. *Id.* at 1064.

results, the court used its famous, but extensively criticized,¹⁷¹ analogy¹⁷² of a highway billboard sign.¹⁷³ Because the court concluded that likelihood of confusion was imminent in its billboard scenario, the court held that likelihood of confusion would occur in a similar situation involving metatags.¹⁷⁴

West Coast, the defendant, had used the trademark "MovieBuff" in the metatags of its website to attract consumers to its website.¹⁷⁵ The court found that "West Coast [could] legitimately use an appropriate descriptive term in its metatags," but concluded that "MovieBuff" was not such a term.¹⁷⁶ The court determined that West Coast's use of the term "MovieBuff" in the metatags of its website was designed solely for the purpose of attracting consumers and was, therefore, "not fair use."¹⁷⁷ The court enjoined the defendant from using the term as long as the term was used to refer to the plaintiff's products.¹⁷⁸

B. SNA, Inc. v. Array¹⁷⁹

This case was decided by the Federal District Court of the Eastern District of Pennsylvania approximately one month after the Ninth Circuit decided the *Brookfield* case.¹⁸⁰ The plaintiffs were manufacturers of do-it-yourself kits for an amphibious aircraft

171. This analogy has been extensively criticized as a distortion of "how Internet search engines function." See King, *supra* note 36, at 325-26; McCuaig, *supra* note 58, at 654.

172. The court's famous analogy is as follows:

Suppose West Coast's competitor (let's call it 'Blockbuster') puts up a billboard on a highway reading - 'West Coast Video: 2 miles ahead at Exit 7' - when 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 a Blockbuster right there. Customers are not confused in the narrow sense: they are fully aware that they are purchasing from Blockbuster and they have no reason to believe that Blockbuster is related to, or in any way sponsored by, West Coast.

Brookfield, 174 F.3d at 1064. E.g., *Bihari v. Gross*, 119 F. Supp. 2d 309, 319-20 (S.D.N.Y. 2000) (mentioning the billboard analogy); McCuaig, *supra* note 58, at 661 (same); Paylago, *supra* note 1, at 64 (same).

173. *Brookfield*, 174 F.3d at 1064.

174. *Id.* at 1066.

175. *Id.*

176. *Id.*

177. *Id.*

178. *Brookfield*, 174 F.3d at 1066.

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

180. *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036 (9th Cir. 1999).

called the Seawind.¹⁸¹ The defendants sold and installed turbine engines for the Seawinds and assembled the do-it-yourself kits for purchasers.¹⁸² The defendants operated two websites, both of which had previously made references to the plaintiffs.¹⁸³ The plaintiffs sued defendants, alleging, inter alia, that the defendants used the word “Seawind” in the metatags of their websites in violation of the Act.¹⁸⁴

Based on the lower court’s finding that the plaintiffs had a common law trademark in the word “Seawind,” the district court concluded that the defendants intentionally used this mark in the metatags of their websites to “lure [I]nternet users to their site.”¹⁸⁵ The court based its decision on “repetitious usage [of the term in defendants’ metatags] and the evidence of defendants’ general intent to harm plaintiffs.”¹⁸⁶ The court found that such actions were made in “bad faith to confuse internet users” and enjoined the defendants’ metatagging.¹⁸⁷

C. *Playboy Enterprises v. Terri Welles*¹⁸⁸

In this California case, the plaintiff, an international publishing and entertainment company, published the widely popular *Playboy* magazine along with numerous specialty magazines, such as *Playboy’s Playmate Review*, *Playboy’s Playmates of the Year* and *Playboy’s Calendar Playmates*.¹⁸⁹ The plaintiff had two websites, “playboy.com,” on which it promoted its magazine, goods and services, and “cyber.playboy.com,” which was devoted to promoting the plaintiff’s models.¹⁹⁰ The plaintiff also owned registered trademarks for the terms “Playboy,” “Playmate,” “Playmate of the Month” and “Playmate of the Year.”¹⁹¹

The defendant was a self-employed model who had modeled for *Playboy* magazine in 1980 and was featured as “Playmate of the Month” and then “Playmate of the Year.”¹⁹² She had subsequently

181. *SNA, Inc.*, 51 F. Supp. 2d at 558.

182. *Id.*

183. *Id.*

184. *SNA, Inc.*, 51 F. Supp. 2d at 561-62.

185. *Id.* at 562.

186. *Id.* at 563.

187. *Id.*

188. *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066 (S.D. Ca. 1999).

189. *Id.* at 1071.

190. *Id.*

191. *Id.*

192. *Id.*

appeared in thirteen issues of *Playboy* magazine and eighteen of its newsstand specials.¹⁹³

In June of 1997, the defendant opened a website, *terriwelles.com*, which included, among other things, photographs of herself and others, and the heading, "Terri Welles—Playmate of the Year 1981."¹⁹⁴ Eleven of the fifteen free webpages of the website included a disclaimer stating that it was not affiliated with the plaintiff and that the plaintiff held registered trademarks to the terms "Playboy," "Playmate of the Month" and "Playmate of the Year."¹⁹⁵ However, the defendant used the terms "Playboy" and "Playmate" in the metatags of her website.¹⁹⁶ The defendant sought permission from the plaintiff for the use of the registered marks before she launched her website.¹⁹⁷ Plaintiff at first granted the permission, but later asked the defendant to remove the "Playmate of the Year" title from her home page.¹⁹⁸ The defendant's refusal to do so was followed by a lawsuit alleging, among other things, trademark infringement pursuant to 15 U.S.C. § 1114(1).¹⁹⁹

The district court first emphasized the limits of trademark protection.²⁰⁰ It declared specifically that "the 'policies of free competition and free use of language dictate that trademark law cannot forbid the commercial use of terms in their descriptive sense.'"²⁰¹ The court then pointed out that the Act contains a fair use defense, and laid out three elements needed to establish the defense: (1) the use of the term not in its trademark capacity, (2) the requirement that the use be in good faith and (3) the requirement that the description of a defendant's goods or services be the only purpose of such use.²⁰²

The court found that the plaintiff's reliance on the *Brookfield* decision was "misplaced."²⁰³ The court distinguished *Brookfield* on the basis that the use of metatags in *Brookfield* was not, as in this case, descriptive.²⁰⁴ The court pointed out that for "a finding

193. *Playboy*, 78 F. Supp. 2d at 1071.

194. *Id.*

195. *Playboy*, 78 F. Supp. 2d at 1072.

196. *Id.*

197. *Id.*

198. *Id.*

199. 15 U.S.C. § 1114(1) (2000); *Playboy*, 78 F. Supp. 2d at 1070.

200. *Playboy*, 78 F. Supp. 2d at 1073.

201. *Id.* (quoting 1 J. MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION §11.45, at 82 (1999)).

202. *Id.* at 1073-74.

203. *Id.* at 1092.

204. *Playboy*, 78 F. Supp. 2d at 1093.

of likelihood of confusion,” “a finding of initial interest confusion” was not required, but was only optional.²⁰⁵ Thus, a finding of initial interest confusion is not a decisive element in a case if fair use can be established.²⁰⁶

The court held that the terms used in the defendant’s metatags, although clearly plaintiff’s property, were used fairly to describe the products and services offered on the defendant’s website.²⁰⁷ The inclusion of such terms into defendant’s metatags was a “logical way [to allow search engines] to find her site on the web.”²⁰⁸ Finally, the court found “no evidence of intent by [the defendant] to trade upon the goodwill of Plaintiff’s marks by falsely implying sponsorship by or affiliation with” the plaintiff, and granted the defendant’s motion for summary judgment.²⁰⁹

D. New York State Society of Certified Public Accountants v. Eric Louis Associates²¹⁰

In this case, the plaintiff was a non-for-profit corporation organized under the laws of New York in 1897. The corporation’s total membership was 30,000 accountants.²¹¹ The plaintiff had been using the common-law “service mark,”²¹² “NYSSCPA,” since 1984.²¹³ “Service marks are essentially trademarks used in the sale of services, instead of goods[,]” and are thus governed by the same standards as trademarks.²¹⁴ The plaintiff fastidiously protected its mark and permitted its use only through revenue generating agreements.²¹⁵ In 1994, the plaintiff registered the domain name “nyss-

205. *Id.* at 1094.

206. *Id.*

207. *Id.* at 1095.

208. *Playboy*, 78 F. Supp. 2d at 1095.

209. *Id.* at 1095-096.

210. *N. Y. State Soc’y of Certified Pub. Accountants v. Eric Louis Assocs.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999).

211. *Id.* at 338.

212. Service marks also fall within the protection of the Act and are defined by the Act as “any word, name, symbol, or device, or any combination thereof (1) used by a person, or (2) which a person has a bona fide intention to use in commerce and applies to register on the principal register established by this chapter, to identify and distinguish the services of one person, including a unique service, from the services of others and to indicate the source of the services, even if that source is unknown. Titles, character names, and other distinctive features of radio or television programs may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.” 15 U.S.C. § 1127 (2000).

213. *NYSSCPA*, 79 F. Supp. 2d at 338.

214. *Bihari*, 119 F. Supp. 2d at 317 n.11.

215. *NYSSCPA*, 79 F. Supp. 2d at 338.

cpa.org.”²¹⁶ In 1997, the plaintiff began operating a website, which contained information about the organization.²¹⁷

The defendant was a small firm, that specialized in accounting and other financial matters in the tri-state area of New York, New Jersey and Connecticut.²¹⁸ In 1998 and 1999, it registered three domain names, one of which was “nysscpa.com,” and began operating identical websites at the three Internet addresses.²¹⁹ The Internet address “nysscpa.com” contained a disclaimer stating that the defendant was not affiliated with the plaintiff, but, along with the other two websites, contained the term “NYSSCPA” in its metatags.²²⁰ The plaintiff brought a lawsuit in part based on trademark and service mark infringement.²²¹

Because the defendant intentionally copied plaintiff’s mark, the court presumed, as a matter of law, that the likelihood of confusion requirement was satisfied.²²² The court confirmed this presumption when it analyzed the eight *Polaroid* factors²²³ to determine whether a likelihood of confusion exists.²²⁴ The court rejected the defendant’s argument that, by including a disclaimer in its website, it successfully eliminated the likelihood of confusion.²²⁵ The court followed the reasoning in *Brookfield*²²⁶ and held that, even with the disclaimer, the domain name “nysscpa.com” and the “NYSSCPA” metatag “cause[d] a likelihood of confusion because [they] created initial interest confusion.”²²⁷

E. *Bihari v. Gross*²²⁸

In this New York Southern District case, the plaintiffs were interior designers who had been practicing under the name of “Bihari Interiors” around the country and abroad since 1984.²²⁹ Their name was well known, “particularly in the New York City high-end

216. *Id.*

217. *Id.*

218. *NYSSCPA*, 79 F. Supp. 2d at 339.

219. *Id.*

220. *Id.*

221. *Id.* at 333.

222. *Id.* at 340.

223. *Polaroid v. Polaroid Elecs.*, 287 F.2d 492 (2d Cir. 1996); see discussion of the eight *Polaroid* factors at *supra* Part II.C.

224. *NYSSCPA*, 79 F. Supp. 2d at 341-42.

225. *Id.* at 342.

226. *Brookfield Communications v. W. Coast Entm’t*, 174 F.3d 1036 (9th Cir. 1999).

227. *NYSSCPA*, 79 F. Supp. 2d at 342.

228. *Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000).

229. *Id.* at 312.

residential interior design market.”²³⁰ The plaintiffs did not engage in paid advertising to promote their business, but relied primarily on referrals from former clients and other designers.²³¹

The defendant was a former client of the plaintiffs who did not think highly of his former decorators.²³² In 1999, the defendant registered the domain names “bihari.com” and “bihariinteriors.com” and placed disparaging statements about the plaintiffs on the websites.²³³ Plaintiffs sought to preliminarily enjoin defendant from using the above-mentioned domain names at which time the defendant relinquished both of them.²³⁴ However, in March 2000, the defendant registered two more websites, “designscam.com” and “manhattaninteriordesign.com,” both of which contained the same content as the previous two websites and used the term “Bihari Interiors” in their metatags.²³⁵ The description metatags gave a brief overview of the site, which also referred to the plaintiffs by name.²³⁶

The plaintiffs argued that inclusion of the term “Bihari Interiors” in the metatags of the defendant’s websites was likely to cause confusion.²³⁷ The court rejected this argument because “no reasonable viewer would believe that the disparaging comments regarding Bihari’s business ethics . . . are endorsed by Bihari.”²³⁸

The plaintiffs’ argument for the likelihood of initial interest confusion was also unsuccessful.²³⁹ First, the court was skeptical in applying the theory to an Internet related case.²⁴⁰ Second, the court reluctantly and cautiously²⁴¹ discussed the *Brookfield* billboard analogy²⁴² and concluded that this case was missing one vital element, “a competing website.”²⁴³ The court concluded that any initial confusion resulting from defendant’s websites was not long enough to satisfy the likelihood of confusion requirement.²⁴⁴

230. *Id.*

231. *Id.*

232. *Id.*

233. *Bihari*, 119 F. Supp. 2d at 312.

234. *Id.* at 313.

235. *Id.*

236. *Id.*

237. *Bihari*, 119 F. Supp. 2d at 318.

238. *Id.* at 319.

239. *Id.*

240. *Id.*

241. *Bihari*, 119 F. Supp. 2d at 319-20 n.15 (stating that the use of the highway billboard metaphor is not the best analogy to a metatag on the Internet).

242. *See supra* note 172.

243. *Bihari*, 119 F. Supp. 2d at 320.

244. *Id.*

Finally, the court focused on the fair use doctrine.²⁴⁵ The court held the defendant had not used the term “Bihari Interiors” in its metatags “as a mark, but rather, [only in a descriptive sense] to fairly identify the content of his websites.”²⁴⁶ Furthermore, the defendant’s inclusion of a disclaimer in his website indicated a good faith use of the plaintiffs’ mark.²⁴⁷ The court concluded the defendant acted in good faith because his purpose in using the mark was not to capitalize on the plaintiffs’ reputation or goodwill or any confusion that may have resulted, but simply to criticize the plaintiff.²⁴⁸

The court also addressed the public policy aspect of the issue by declaring that “[a] broad rule prohibiting use of ‘Bihari Interiors’ in the metatags of websites not sponsored by Bihari would effectively foreclose all discourse and comment about Bihari Interiors, including fair comment.”²⁴⁹ The court cautioned against “overextending the reach of the Lanham Act and intruding on First Amendment values.”²⁵⁰

F. *Trans Union v. Credit Research*²⁵¹

In this Northern District of Illinois case, plaintiffs accused defendants of misusing plaintiffs’ trademarks in the metatags of defendants’ website.²⁵² The plaintiffs moved to preliminarily enjoin defendants from the alleged misuse,²⁵³ but the court denied the motion on the basis that defendants’ use of plaintiffs’ mark constituted legitimate and fair descriptive use.²⁵⁴

Plaintiffs were one of the three major credit-reporting agencies in the country who entered into a service agreement with defendants, a local credit bureau.²⁵⁵ The service agreement created a contractual relationship between the parties but did not refer to their intellectual property rights.²⁵⁶ Plaintiffs owned a federally registered trade name “Trans Union” and a stylized “TU” logo.²⁵⁷ Be-

245. *Id.* at 321-22.

246. *Id.* at 322.

247. *Id.* at 324.

248. *Id.* at 323.

249. *Id.*

250. *Id.*

251. *Trans Union v. Credit Research*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001).

252. *Id.* at 1034.

253. *Id.*

254. *Id.* at 1040.

255. *Id.* at 1035.

256. *Id.* at 1036.

257. *Trans Union*, 142 F. Supp. 2d at 1035.

cause of their close business association with plaintiffs, defendants started using plaintiff's trade name and logo.²⁵⁸ Plaintiffs did not authorize such use and found it objectionable.²⁵⁹ Plaintiffs brought a lawsuit to enjoin defendants from using the marks on the metatags of defendants' website.²⁶⁰

Plaintiffs argued that the defendant's metatags were likely to create "the false impression that Trans Union endorses or otherwise is affiliated with defendants' website."²⁶¹ Defendants responded that they had a legitimate right to use the plaintiffs' mark because it was an essential part of their contractual relationship.²⁶² The court followed the fair use defense reasoning in *Brookfield*, *Bihari* and *Playboy*, and concluded that "there [was] nothing inaccurate about including Trans Union's trade name in a metatag, since the metatag simply describe[d] defendants and the content of their website."²⁶³

IV. DISCUSSION: RECENT LEGAL TRENDS LEAN AGAINST THE DOCTRINE

A. Recent Legal Trends

Very few cases have considered the improper use of trademarks in metatags; therefore, it is difficult to guess in what direction this body of law will develop. Based on the cases discussed in Part III of this Comment, it appears the courts have begun to increasingly consider the evidence of a defendant's fair and good faith use of a plaintiff's marks. The courts also began to focus their attention on a defendant's intent and most situations have held that where no culpable intent was present, defendant's use of plaintiff's marks was not illegal.²⁶⁴

One well-supported conclusion of the *Brookfield* court was that a good faith use of a descriptive term in metatags is allowable.²⁶⁵ Although the *Brookfield* court was the first court to apply the doc-

258. *Id.* at 1036.

259. *Id.*

260. *Id.* at 1037.

261. *Trans Union*, 142 F. Supp. 2d at 1038.

262. *Id.*

263. *Id.* at 1040.

264. *See* discussion *supra* Parts III.C and III.E.

265. *See* *Trans Union v. Credit Research*, 142 F. Supp. 2d 1029, 1040 (N.D. Ill. 2001); *see* discussion *supra* Part III.F; *see also* *Bihari v. Gross*, 119 F. Supp. 2d at 323-24; discussion *supra* Part III.E; *see also* *Brookfield Communications v. W. Coast Entm't*, 174 F.3d at 1065; discussion *supra* Part III.A.

trine of initial interest confusion to metatags,²⁶⁶ most of the court's conclusions, aside from its emphasis on the importance of good faith use of descriptive terms in metatags, are questionable and have been extensively debated.²⁶⁷ The court's incomplete understanding of the function of search engines resulted in the court harshly limiting the use of legitimate descriptive terms in metatags.²⁶⁸ For example, the court found use of the "Moviebuff" trademark illegitimate because the term, not being an English word, was not descriptive.²⁶⁹

Although the court correctly focused on the defendant's intent, it erroneously concluded that no fair use could exist if the defendant's sole purpose is to attract consumers to his website.²⁷⁰ This conclusion begs the query, what other purpose can a business owner have in setting up a website, if not to attract consumers? Unfair use does not result from the general business purpose of attracting consumers, but from the deviant purpose of stealing consumers from the competition by intentionally confusing them.²⁷¹

The *SNA* case, which was decided only a few months after *Brookfield*, is a good illustration of such deviant intent.²⁷² The *SNA* defendants had intentionally lured Internet users onto their website by repeatedly using the plaintiff's trademark in their metatags.²⁷³ The *SNA* court was justified in holding that no fair use could possibly have existed in the case because it found that defendants had intended to harm the plaintiffs.²⁷⁴

Similarly, the *NYSSCPA* court further defined limitations on the fair use defense when it held that defendant's disclaimers of association with the plaintiff did not constitute fair use because they were

266. King, *supra* note 36, at 314; Paylago, *supra* note 1, at 62.

267. See, e.g., King, *supra* note 36, at 325-26 (disagreeing with *Brookfield*'s application of the doctrine of initial interest confusion to the Internet); McCuiag, *supra* note 58, at 658-64 (discussing the misconceptions of the *Brookfield* court's analysis of the metatag issue); Mills, *supra* note 20, at *26-29 (discussing the *Brookfield* analogy and concluding that the *Brookfield* court's reasoning that initial interest confusion may be caused by improper use of metatags is "flawed"). But see Posner, *supra* note 32, at 445-46 (relying on *Brookfield*'s analysis of the metatag issue).

268. See Mills, *supra* note 20, at *26-29.

269. *Brookfield*, 174 F.3d at 1066; see discussion *supra* Part III.A.

270. *Brookfield*, 174 F.3d at 1066; see discussion *supra* Part III.A.

271. See, e.g., *SNA, Inc.*, 51 F. Supp. 2d at 562-63; see discussion *supra* Part III.B where the court enjoined defendant's metatagging because defendants had intentionally confused internet users.

272. *SNA, Inc.*, 51 F. Supp. 2d at 562-63; see discussion *supra* Part III.B.

273. *SNA, Inc.*, 51 F. Supp. 2d at 562.

274. *Id.* at 563.

counteracted by the defendant's bad faith intent to capitalize on the plaintiff's goodwill.²⁷⁵

To the contrary, the *Playboy* court correctly found the defendant not to have deviant intent.²⁷⁶ The *Playboy* court was thus justified in finding fair use.²⁷⁷ There, the defendant did not only legitimately use the plaintiff's trademark as a descriptive term of herself and her products,²⁷⁸ but she also showed good faith when she included disclaimers to distinguish her website from the plaintiff's and when she acted with plaintiff's permission to launch her website.²⁷⁹

Similarly, in *Bihari*, when faced with the issue of the use of trademarks in metatags, the New York Southern District court focused on the defendant's intent rather than on the likelihood of confusion.²⁸⁰ The *Bihari* court found that the inclusion of a disclaimer along with the defendant's legitimate use of the term for descriptive purposes and lack of desire to capitalize on the plaintiff's reputation, constituted legitimate use of the mark.²⁸¹

Lastly, in the most recent case, *Trans Union v. Credit Research*, the Northern District of Illinois court also found no evidence of defendant having used the plaintiff's mark in bad faith. The court did not even bother to make a determination of whether the defendant's use of the plaintiff's mark in the defendant's metatags could have caused either actual or initial interest confusion.²⁸² Instead, the court concluded that defendant's use of plaintiff's trademark to describe defendant's business was fair due to defendant's close business association with the plaintiff.²⁸³

It appears from the above analysis that courts that have addressed trademark infringement cases involving metatags have focused more attention on a defendant's intent than whether the use in question was likely to cause confusion. The courts also appear to have thus far had no difficulties in distinguishing good faith from bad faith in metatag related situations and in drawing the boundaries around the legitimate use of trademarks in metatags. It is

275. N.Y. State Soc'y of Certified Pub. Accountants v. Eric Louis Assocs., 79 F. Supp. 2d at 348; see discussion *supra* Part III.D.

276. *Playboy Enters. v. Terri Welles*, 78 F. Supp. 2d 1066, 1080. See discussion *supra* Part III.C.

277. *Playboy*, 78 F. Supp. 2d at 1095.

278. *Id.* at 1078-79.

279. *Id.* at 1072.

280. *Bihari v. Gross*, 119 F. Supp. 2d at 322-24; see discussion *supra* Part III.E.

281. *Bihari*, 119 F. Supp. 2d at 322-24.

282. *Trans Union v. Credit Research*, 142 F. Supp. 2d 1029, 1039-40 (N.D. Ill. 2001); see discussion *supra* Part III.F.

283. *Trans Union*, 142 F. Supp. 2d at 1039-40 (2001); see discussion *supra* Part III.F.

likely, that if courts continue to focus on a defendant's intent, and to use the fair use defense to decide metatag related trademark infringement cases, courts may no longer consider the doctrine of initial interest confusion a useful legal tool in such decision making.

B. The Doctrine of Initial Interest Confusion Should Not Be Applied to Metatags

The doctrine of initial interest confusion, as it stands presently, is unnecessary in trademark infringement cases involving metatags for primarily three reasons. First, the standards for proving likelihood of confusion in trademark infringement cases are already very relaxed,²⁸⁴ resulting in successful infringement claims even without a showing of actual confusion.²⁸⁵ Second, a defendant's inability to succeed with the fair use defense serves as a good safeguard against intentional infringers.²⁸⁶ And third, the common remedy of trademark infringement, which enjoins a defendant's use of infringing metatags, may itself intrude upon a defendant's First Amendment right to freedom of speech.²⁸⁷

1. Relaxed Standards for Proving Likelihood of Confusion

Already relaxed legal standards for showing the existence of likelihood of confusion in trademark infringement cases advocate against the introduction of a new category of confusion. As discussed in Parts II.B and II.C, to prove trademark infringement, a plaintiff must show a likelihood of confusion.²⁸⁸ The best way to achieve this is to show actual confusion.²⁸⁹ Actual confusion, however, is often very difficult, if not impossible, to prove.²⁹⁰ Courts, realizing the difficulties involved in proving actual confusion, often allow plaintiffs to forego the showing of actual confusion altogether and instead focus on the other seven Polaroid (or Polaroid-like) factors of the case to determine whether the likelihood of confusion exists.²⁹¹ The standards for proving the likelihood of

284. See discussion *supra* Parts II.D and IV.B.

285. See discussion *supra* Introduction and Part I.D.

286. See discussion *supra* Parts II.E, IV.A and Part IV.B.

287. See discussion *supra* Part III.E.

288. See discussion *supra* Parts II.B and II.C.

289. See discussion *supra* Introduction.

290. See discussion *supra* Part II.D.

291. *Polaroid v. Polaroid Elecs.*, 287 F.2d 492 (2d Cir. 1961); See discussion *supra* Part II.C.

confusion are already very relaxed,²⁹² allowing for a finding of pre-sale, sale, post-sale and even no-sale confusion based on the circumstances of each case.²⁹³ Etching out a new category of confusion, such as initial interest confusion, serves no purpose when courts in several districts have already stretched the standards for satisfying a showing of likelihood of confusion to include any probable type of confusion.²⁹⁴

The opposing argument, in support of courts using initial interest confusion, rests on the idea that expansion of trademark law into new fields can be beneficial.²⁹⁵ There is in fact merit to stretching legal limits to reach equitable results or to comply with public policy considerations. In this spirit, trademark law was recently expanded to, for example, include such new federally recognized causes of action as "dilution."²⁹⁶ Under the Federal Trademark Dilution Act the owner of a famous mark is entitled to an injunction if another's commercial use of the mark dilutes the distinctive quality of the famous mark.²⁹⁷ Dilution theory is based on the concept that "the more widely a symbol is used, the less effective it will be for any one user."²⁹⁸ One may argue that because the law has expanded in the direction of dilution, it should also expand to include initial interest confusion.

Although expansion of law to meet public policy and equity goals may be beneficial, if such expansion is carried out without proper evaluation of new technological or societal developments, it

292. *Powder River Oil v. Powder River Petroleum*, 830 P.2d 403, 416-17 (Wyo. 1992) (holding that a showing of likelihood of confusion is not limited to customers but can even apply to suppliers).

293. *Paylago*, *supra* note 1, at 55-6.

294. See discussion *supra* Parts II.C and II.D.

295. *Mills*, *supra* note 20, at *52 (stating that although courts are sometimes willing to stretch statutory language to reduce unfairness, this strategy is more likely to be beneficial in cases of trademark dilution than in cases involving trademark infringement).

296. See *supra* note 99 for the definition of dilution. "Bringing a claim on federal trademark dilution grounds is a relatively new concept. It was not until 1996 in which it was federally authorized by statute for one to sue on these grounds." Kenneth L. Port, *The Congressional Expansion of American Trademark Law: A Civil Law System in the Making*, 35 WAKE FOREST L. REV. 827, 829 (2000) (discussing the social, economic and legal foundations of American trademark law and concluding that American trademark law is becoming harmonized with civil law systems); Silberlight, *supra* note 32, at 254.

297. 15 U.S.C. § 1127 (2000); see discussion *supra* Part II.A; see also Silberlight, *supra* note 32, at 254.

298. Ralph S. Brown, Jr., *Advertising and the Public Interest: Legal Protection of Trade Symbols*, 57 YALE L.J. 1165, 1191 (1948) (raising the question of whether legal protection of trade symbols furthers private, as well as public, goals).

can just as easily become a hindrance to the legal process. Courts must proceed with caution when expanding the application of traditional legal concepts to such relatively unexplored legal fields as the Internet. The expansion of the standard for confusion as used in trademark infringement litigation to metatags may prove beneficial only if it serves a practical purpose. If such expansion becomes too convoluted or its purpose too obscure, its application should be reconsidered.

The *Brookfield* court began the trend of applying the initial interest confusion doctrine to metatags.²⁹⁹ The court, however, was not fully informed of the Internet's intricacies.³⁰⁰ Thus, relying on the *Brookfield* decision can lead only to difficulties as more cases involving metatags reach the courts. Because this Comment focuses on trademark infringement, rather than dilution, it does not explore whether the expansion of trademark law to include federal causes of action for dilution has been beneficial. Thus far, however, such expansion has been witnessed only in very limited situations.³⁰¹ The majority of the dilution claims addressed since the amendment to the Act have involved domain name disputes only.³⁰² It would be wise to take a similarly cautious approach to trademark infringement law by not expanding it to the Internet before acquiring a more solid understanding of how the Internet functions in our society.

2. *Failure of the Fair Use Defense Is a Good Safeguard*

The use of the initial interest confusion doctrine in metatag related cases is unnecessary because the statutory fair use defense already serves as an effective safeguard against intentional infringers. When courts are faced with the dilemma of metatag related trademark infringement litigation, they should, as some courts have already,³⁰³ focus not on whether the use of a trademark in

299. *Brookfield Communications v. W. Coast Entm't*, 174 F.3d 1036 (9th Cir. 1999). For a more detailed discussion of the case, see discussion *supra* Parts III.E and IV.

300. For a more detailed discussion of the case, see discussion *supra* Parts III.E and IV.

301. See *supra* note 99 (discussing the expansion of trademark law by the Federal Trademark Dilution Act).

302. For a detailed discussion of dilution, see Oscar S. Cisneros, *Bally Total Fitness Holding Corp. v. Faber*, 15 BERKELEY TECH. L.J. 229, 232-36 (2000) (offering a thorough explanation of trademark dilution and current related law).

303. See *Trans Union v. Credit Research*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001); see discussion *supra* Part III.F; see also *Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000); see also discussion *supra* Part III.E; see also *New York State Soc'y of Certified Pub. Accountants v. Eric Louis Assoc.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999); see also

metatags can possibly cause confusion, but rather on whether such use was perpetrated with a bad faith intent to capitalize on the plaintiff's goodwill. In situations where bad faith intent is shown, failure of the fair use defense³⁰⁴ serves as an additional safeguard even when a court finds the likelihood of confusion improbable.³⁰⁵ In a trademark infringement case, an innocent defendant will likely not miss the opportunity to establish fair use by showing it lacked any intent to confuse or to benefit economically from possible confusion. If a plaintiff cannot prove likelihood of confusion, but can prove the defendant had a bad faith intent to confuse, a court will likely still enjoin the defendant from further use of the mark. Therefore, if the purpose of initial interest confusion is to provide an extra barrier against trademark infringers in cases where confusion is hard to prove, a defendant's failure to meet the requirements of the fair use defense will achieve the same result, rendering the initial interest confusion doctrine superfluous.

3. *Enjoining Defendants From Using Other's Marks Stifles Their Freedom of Speech*

If, on the other hand, the purpose of initial interest confusion is to broaden the already expanded boundaries of the trademark infringement requirements,³⁰⁶ then the use of the doctrine may put the First Amendment right to freedom of speech, the fundamental purpose of the Internet as a supplier of information, and the principle of business competition at risk. Courts usually resolve trademark infringement through the use of metatags cases by enjoining a defendant from using metatags in its website.³⁰⁷ This, in a way, stifles a web designer's freedom of expression. Initial interest confusion may, therefore, result in the infringement of the First Amendment rights of millions of website owners. At least one court has already cautioned against such overextension of the Act,³⁰⁸ and this warning should not be lightly dismissed.

discussion *supra* Part III.D; *see also* *Playboy Enters. v. Terri Welles*, 78 F. Supp.2d 1066 (S.D. Ca. 1999); *see also* discussion *supra* Part III.C; *see also* *SNA, Inc. v. Array*, 51 F. Supp. 2d 554 (E.D. Pa. 1999); *see also* discussion *supra* Part III.B.

304. *See* discussion *supra* Part II.E.

305. *Id.*

306. *See* discussion *supra* Part II.C.

307. *See* discussion *supra* Part III.

308. *Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000). For a more detailed discussion of the case, *see* discussion *supra* Parts III.E and IV.

4. *What About Trademark Owners' Rights?*

The protection of trademark owners' rights must also be considered. The purpose of trademark law, after all, is not only to facilitate consumers in identifying the sources of the products they buy, but also to protect the time and expense trademark owners invest in developing trademarks.³⁰⁹ One argument in support of the protection of trademark rights relies on the recognition of trademarks as property, which rests on economic principles.³¹⁰ The economic principles are simple: if one is permitted to retain a monopoly in a term or a concept, he will derive some economic benefit from such monopoly regardless of how limited that monopoly is.³¹¹ The legal concept of equivocating trademarks to property, however, is not as straightforward.³¹²

Trademarks are symbols derived from society and made popular by being introduced into our culture as communication devices.³¹³ They not only "identify source or origin for one particular manufacturer, they also have iconic value for the society itself."³¹⁴ If trademarks are thus derived from the public and play a vital role in society, trademark owners should be prohibited from declaring monopolies on the use of such icons.³¹⁵

The originator must understand that the mark or symbol or image is no longer entirely its own, and that in some sense it also belongs to all those other minds who have received and integrated it. This does not imply a total loss of control, however, only that the public's right to make use of the word or image must be considered in the balance as we decide what rights the owner is entitled to assert.³¹⁶

309. See discussion *supra* Part II.A.

310. William Romanos, *Internet Accuracy Wars: How Trademarks Used in Deceptive Metatagging should be Dealt with to Increase Economic Efficiency*, 7 U. BALT. INTELL. PROP. J. 79, 86-91 (1998) (discussing property aspects of the use of trademarks in metatags and addressing the question of whether a property right should be recognized in metatag situations).

311. *Id.*

312. Look, *supra* note 1, at 50 (pointing out that there are conflicting opinions on whether property rights should be protected on the Internet).

313. Alex Kozinski, *Trademarks Unplugged*, 68 N.Y.U. L. REV. 960, 972-73 (1993) (arguing that trademarks no longer merely serve to identify sources, but have now become part of the product itself); Port, *supra* note 296, at 894.

314. Port, *supra* note 296, at 894.

315. Kozinski, *supra* note 313, at 975.

316. *Id.*

Thus, the use of famous marks to describe the contents of a website may prove irreplaceable.³¹⁷

Even if trademark owners gain exclusive property rights when they register and use their marks, it is questionable whether such economic rights should outweigh the First Amendment rights of website owners.³¹⁸ Courts must consider whether an overzealous protection of trademark owners' rights would in fact be beneficial to the trademark owners themselves. Trademark owners may benefit from having the freedom to use their competitors' trademarks in the metatags of their own sites.

It should not be left up to the courts and obscure doctrines, such as initial interest confusion, to impose strict limitations on the Internet industry. The legislature can devise better-informed, uniform, federally imposed rules. These rules will undoubtedly serve as a better regulator of trademark use on the Internet than intermittent court decisions that typically concentrate only on very narrow fact patterns that happen to reach a court's docket. Waiting for the courts to carve out the appropriate legal boundaries risks further confusing the issue.

5. *Internet Consumers Are Too Savvy to Be Confused by Metatags*

The insignificant consumer confusion that the doctrine of initial interest confusion seeks to eradicate may in fact be beneficial for consumers. When competitors use each others' metatags they not only supply consumers with a wider array of information on competing or related products, but they also promote competition among similar businesses.³¹⁹ Furthermore, expectations of Internet consumers differ from expectations of consumers in the physical world.³²⁰ Shopping on the Internet involves significantly different tactics than shopping in the real world.³²¹

Most Internet users are familiar with the intricacies of the Internet shopping process, including the function of search engines. They know that when they type in their keywords, a number of

317. *Id.* at 974 (providing examples of how such marks as Xerox, Kleenex, Band-Aid and Escalator "are particularly apt to fill in gaps in our language").

318. See discussion *supra* Parts III.E and IV.B.

319. King, *supra* note 36, at 326.

320. King, *supra* note 36, at 325 (discussing unique expectations of Internet consumers); Posner, *supra* note 32, at 493 (noting that Internet users are aware of and have adapted to manipulative metatagging).

321. King, *supra* note 36, at 325; Posner, *supra* note 32, at 493.

possibly unrelated or competing links will be generated.³²² In fact, some consumers, relying on a search engine's ability to provide a variety of options, depend on the search engine to do their comparison-shopping or to gather information on competing but related products.³²³ The courts cannot conclude definitively that the use of another's trademarks in metatags of a website causes initial interest confusion without first determining what the consumer's intent was when entering that particular trademark name into a search engine. For example, a consumer might have been using a famous mark as a product category identifier³²⁴ to find cheaper substitutes, with no intention of ever buying the famous name brand product. It would be quite unfair to both consumers and lesser-known vendors "to limit consumer choice in selecting goods on the Internet to only well-known products."³²⁵ Such limitation would preclude lesser-known vendors from being exposed to potential purchasers who may actually be seeking the lesser-known vendor's goods.³²⁶

6. *Initial Interest Confusion May Not Even Exist in Situations Where Metatags Are Used Legitimately*

Still another query is whether initial interest confusion exists at all in a legitimately used metatag situation. Consider the following scenario. A user inputs a keyword into his search engine. The engine comes up with a number of links to different websites and provides descriptions of the sites underneath each link. Even if the user does not look at the domain name to determine who owns a particular website,³²⁷ he scans the description of the website before clicking on the link. If the description contains no reference to the famous trademark, or if it simply compares the famous trademarked product to another product, the user will know the site is unrelated to the mark, and, therefore, there can be no initial interest confusion.³²⁸

If, however, there is a reference to the mark, but the reference is designed to confuse, the user may indeed click on the link.³²⁹ After

322. King, *supra* note 36, at 325; Posner, *supra* 32, at 493.

323. King, *supra* note 36, at 326.

324. *Id.*

325. McCuaig, *supra* note 58, at 681.

326. *Id.*

327. Romanos, *supra* note 310, 92 (stating that consumers are likely to authenticate the owner of a website by looking at the domain names before clicking on the link); Posner, *supra* note 32, 483 (same).

328. Mills, *supra* note 20, at *27.

329. See discussion *supra* Part II.C.

momentary confusion, however, the user will likely realize his mistake and simply click the “back” button of his browser to return to his original search.³³⁰ Thus, the user’s initial confusion can be easily rectified by just one click of the “back” button.

One counter-argument may be that, when the user clicks on the “back” button, he is returned to an endless list of websites and, as a result, remains confused.³³¹ A consumer’s confusion may be further exacerbated when sly website owners try to outsmart the search engines by including repetitious or unrelated trademarked terms in their metatags, thereby increasing the size of the list the search engine has generated.³³² Nevertheless, the modern consumer will likely know to correct this problem by either narrowing his keywords to generate a smaller list of hits, or by paying more attention to the domain names.

Moreover, if the user decides to stay on the site of the product he was not originally searching for, and the trademark owner then seeks to enjoin the site’s use of the owner’s mark, lack of good faith and fair use can likely be easily proven by showing that the description of the site contained no source identifying distinction, or that the metatags were intentionally doctored with repetitious use of the owner’s mark.³³³ The trademark owner can also likely show that its trademark was used in the metatags of a site completely unrelated to the owner’s site and the sole purpose of its use was to capitalize on the trademark owner’s goodwill. In either case, courts will most likely find lack of good faith in the use of the marks and enjoin the defendants from using the marks in their metatags.

7. *Initial Interest Confusion Loses Out in the Cost-Benefit Analysis*

Finally, the last question to ask is whether initial interest confusion makes sense from a cost-benefit standpoint.³³⁴ As discussed in Part III, the most common solution to trademark infringement situations is for courts to enjoin the infringing website owners from using another’s trademarks in the metatags of their sites.³³⁵ Another proposed solution is to alter the setup of millions of websites

330. *Id.*

331. McCuaig, *supra* note 58, at 662 (discussing Internet search strategies).

332. Posner, *supra* note 32, at 446 (discussing methods some web designers use to confuse search engines).

333. *See id.*

334. Kozinski, *supra* note 218, at 969.

335. *See* discussion *supra* Parts III.B & III.D.

by dividing metatags into two sections: one that contains all non-trademark related metatags and another that contains all the trademarked terms.³³⁶ Theoretically, this alternative will provide courts with a clear idea of website owner's intent and make it easier to filter out the infringers.³³⁷

Neither of the two solutions is satisfactory. The first solution, enjoining the infringing website owners from using another's trademarks in their metatags, involves considerable court costs for both sides and, as discussed in Part IV,³³⁸ possible First Amendment violations, reduction of information provided to consumers, and the stifling of business competition both on and off the Internet. The second solution, imposing obligatory alterations of metatags on website owners, will likely result in a loss of millions of dollars, time and effort necessary to devise new federal regulations and then alter the code of millions of websites to comply with those regulations. Is the discomfort of a momentary confusion that is easily rectified by a couple of clicks of a mouse worth the cost of altering the codes of millions of websites and reducing the amount of information the Internet currently provides to consumers?

CONCLUSION

The rapid advent of the Internet has brought countless benefits for consumers, businesses and the economy. However, to achieve smooth integration of this new, but enormously popular, technology into society, we must be careful not to bootstrap the legal questions it raises into traditional legal models. The issue of metatag related trademark violations is one particular area where the traditional concept of initial interest confusion simply does not produce a good fit. Some courts have hastily extended this theory onto the Internet without first fully understanding how metatags function, or what expectations Internet consumers have. This hastiness not only risks the creation of confusion and discord in legal circles, but may potentially cause a massive financial dent in the economy; and it may also impose unnecessary, if not illegal, limitations on the way the Internet functions. This Comment strongly encourages everyone, and especially the courts that are currently, or will be, faced with this issue in the near future, to, as the old saying goes, look before they leap.

336. See McCuaig, *supra* note 58, at 681-88.

337. *Id.*

338. See discussion *supra* Part IV.A.