Making the Demand for the “Cessation of Trademark Infringement via Metatag Use” More Convincing

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A new body of federal case law is emerging which addresses the issue of trademark infringement claims based on the use of a trademark as a metatag in the source code of a competitor’s Web site. Although courts clearly view such use as an infringing use, they have not indicated that money damages are available for this type of infringement. Accordingly, for the trademark holder confronted with trademark infringement by metatag use, a lawsuit may result in no more than an injunction ordering the removal of the metatag.

Locating Infringing Metatags

Metatags are machine understandable information for the World Wide Web that can be used by Internet search engines when trying to locate Web site pages. Metatags serve to assist search engines in classifying pages.

Web page designers embed metatags into the source code of Web pages to identify the contents of a Web site. A term used as a metatag need not be found in the text of a Web page, all that is required is that the metatags are related to the content of the Web site.

Search engines locate Web sites by scanning the text of Web pages or by scanning the Web page metatags, or by scanning both. The metatags of a Web page are especially useful when the text of the Web site is insufficient. Because all search engines have different methods to scan the content of a Web site, the results of the same search on various different search engines does not always generate the same list.

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Applying the Theory of Initial Interest
Confusion to Infringing Metatag Use

In traditional trademark infringement actions, the cause of action is premised on the theory that consumers are likely to be confused as to the source or origin of the goods or services bearing the infringing mark. Traditional trademark infringement theories, however, do not work well with metatags because Internet consumers looking for a particular trademarked good or service in a search engine will know which Web site they are visiting and therefore will generally not be confused as to the source or origin of the goods or services bearing the infringing mark. The landmark case addressing trademark infringement through metatag use is Brookfield Communications, Inc. v. West Coast Entertainment Corp in which the Ninth Circuit Court of Appeals described trademark infringement by metatag use as causing “initial interest confusion.”

The Brookfield court likened the theory of initial interest confusion to billboards along a highway. For purposes of illustration, Joe’s Burgers and Burger Haven are fierce competitors in the fast food business. On U.S. Highway 100, Joe’s Burgers is located at Exit 2 and Burger Haven is located at Exit 1. Commercially, Joe’s Burgers does much better business than Burger Haven. Thus, competitively, Burger Haven is always looking for ways to lure Joe’s Burgers customers to Burger Haven. One method Burger Haven undertook to accomplish this goal was to set up a billboard on Highway 100 that reads “Joe’s Burgers, Exit 1, 3 miles.” Thus, persons driving along Highway 100 seeking to stop at Joe’s Burgers would get off the highway at Exit 1. Once off the highway, they would see Burger Haven instead of Joe’s Burgers. Having arrived at the exit, the consumers, initially confused, may decide to stay at Exit 1 and eat at Burger Haven rather than get back on the highway and search for Joe’s Burgers. This example illustrates the theory of initial interest confusion because it demonstrates that the consumers getting off at Exit 1 are clearly not confused as to the source, origin, or sponsorship of the
products they are purchasing, they know that they are buying their burgers from Burger Haven and not Joe’s Burgers. The initial interest confusion resides in the fact that in this scenario, Burger Haven misappropriated Joe’s Burgers’ goodwill by initially drawing customers interested in Joe’s Burgers to its store by use of a deceptive billboard that resulted in confused customers who ended up shopping at Burger Haven.

Under a theory of initial interest confusion in the world of Internet commerce, Internet consumers looking for a particular trademarked good or service will enter trademarks in a search engine in order to locate the source of the goods or services. In a situation where a Web page designer has embedded the trademark by means of a metatag into the source code of a Web page, the search engine may read the metatag so that the infringer’s Web site appears in the list of sites identified by the search engine as bearing the trademark. In such a situation, the consumer who dials into the competitor’s Web site knows that the competitor is not the source of the trademarked goods or services but having come to the competitor’s Web site, may decide to remain and purchase the competitor’s goods or services rather than the goods or services legitimately associated with the trademark. This is the initial interest confusion, the luring of the consumer to the competitor’s Web site through deceptive metatag use and the consequent trading on the goodwill of the trademark.

While trademark infringement based on initial interest confusion has a successful theoretical application, its practical application is not always so successful for two significant reasons: (1) search engines often do not pick up the offending Web page and (2) a remedy beyond removal of the offending mark is generally not available. The reason for the lack of practicality in this area of trademark infringement lies in the mechanics of Web page design, search engine capabilities, and the inapplicability of traditional cease and desist demands.

**ISP and Search Engine Contracts as Tools Against Infringing Activity**
Because metatags are included in the pages of a Web site hosted by an Internet Service Provider (ISP), their use is controlled by the contract between the user and the ISP. Similarly, because metatags are used by search engines, their use is also prescribed by search engine contracts. These contracts provide powerful tools for the trademark holder confronted with infringing metatag use to stop the infringing activity and seek appropriate damages.

ISP contracts dictate the terms under which a subscriber of the ISP may use the ISP to view or transmit information over the Internet. Most ISP contracts have “acceptable use” terms that provide that the ISP may cooperate with legal authorities and third parties to investigate any illegal use of the ISP to transmit material that intentionally or unintentionally violates any local, state, national or international law, or any rules or regulations promulgated thereunder. If the ISP concludes that a criminal or civil wrong has been perpetrated, then the ISP may suspend or terminate the subscriber’s account, and file a lawsuit against the subscriber to enjoin any future violations and to seek damages incurred as a result of the past violations.

Search engine contracts dictate the terms under which a Web page may be indexed in response to an Internet search query. Search engine contracts generally have provisions that prohibit use of the search engine for illegal uses such as copyright or trademark infringement. Upon notice of infringement, the search engine reserves the right to remove or disable access to material that is claimed to be the subject of the infringing activity. This is accomplished by banning the site from the search engine indices.

In addition, most search engine contracts also provide that the search engine is for personal use and that commercial use of the search engine is prohibited without permission. For this reason, search engines also reserve the right to ban from the search engine index any site that engages in activities known as “spamming” or “cloaking” a Web page. Spamming or cloaking of a Web site occurs when a Web page designer alters a Web page by increasing the number of metatags placed in the source code of the Web pages. The result of spamming or cloaking is that the search engine will pick up the Web site more frequently in its searches thus
increasing the ranking of the Web site and the chance that a user will view the Web site as a result of a search.xviii

A Practical Approach to Using Web Page Design Contracts

The application of contracts that govern Web page design and search engine use is best explored by way of example. In the fictional world of Internet hot dog retailers, there are two fierce competitors, Hot Dog Haven and Donny’s Dogs. “Donny’s Dogs” is a federally registered trademark and the Web site for “Donny’s Dogs” is the favored site among consumers. Aware that Donny’s Dogs is exceeding Hot Dog Haven in Internet hot dog sales, the Web master for Hot Dog Haven decides to add the term “Donny’s Dogs” to the source code of the Hot Dog Haven Web page in order to lure Internet traffic from Donny’s Dogs to Hot Dog Haven. However, when a consumer types “Donny’s Dogs” into a search engine, the Donny’s Dogs Web site is the first Web site to appear on the search engine list and Hot Dog Haven’s Web site fails to appear anywhere within the first 250 hits. The reason for this is two-fold.

First, as a result of a widespread Internet advertising campaign, the number of Web pages rich in text with the term “Donny’s Dogs” is very high. Second, the Hot Dog Haven Web master embedded only one instance of the “Donny’s Dogs” trademark as a metatag into the Hot Dog Haven Web page. If the Web master had spammed the Web page full of the “Donny’s Dogs” trademark, it is likely that Hot Dog Haven would have appeared in the search engine index despite the high percentage of Web sites rich in text for the term “Donny’s Dogs.” The Web master’s restraint was the result of the common knowledge among Web masters that spamming is a prohibited activity that can result in the termination of a Web site. This particular Web master’s knowledge, however, did not extend to the legal theories of trademark infringement through metatag use.
A savvy businessman, Donny realizes that the widespread fair use of his trademark throughout the World Wide Web prevents Hot Dog Haven from effectively trading on Donny’s Dogs’ Internet traffic by means of a single metatag. Nevertheless, Donny objects to Hot Dog Haven’s infringing use his “Donny’s Dogs” trademark and wants it to stop. Thus, Donny hires a lawyer, I.P. Maven, to stop Hot Dog Haven’s infringing use of the “Donny’s Dog” trademark and to seek damages for the infringing use. After a brief meeting with Donny, Ms. Maven composes a cease and desist letter to be sent to Hot Dog Haven.

Traditionally, cease and desist letters demand an immediate halt of all infringing use of a trademark and an accounting of all profits derived from such infringing use. In the context of trademark infringement on the Internet, demands for profits six months before and after the appearance of the metatag are not uncommon. Such demands usually result in no more than a removal of the metatag from the source code and an apology. To date, there are no trademark infringement judicial decisions based solely on one instance of infringing metatag use. Current published opinions that have decided in favor of the plaintiff for trademark infringement by metatag use have all included other forms of trademark infringement as well, such as infringing trademark use in a domain name. There are, however, two cases that provide some guidance on the issue of infringement by metatag use alone, they are *Niton Corp. v. Radiation Monitoring Devices, Inc.* and *Roberts-Gordon, LLC v. Superior Radiant Products, Ltd.*

In *Niton Corp. v. Radiation Monitoring Devices, Inc.*, the district court for the District of Massachusetts granted the plaintiff a preliminary injunction based upon the defendant’s misleading use of the plaintiff’s Internet Web site in the source code of the defendant’s Web page. There, the defendant copied the source code from the plaintiff’s Web site and placed it whole as a metatag into the source code of the defendant’s Web page. The preliminary injunction thus prohibited the defendant from using the content of the plaintiff’s Web site as a means of attracting Internet consumers to the defendant’s Web site.
In *Roberts-Gordon, LLC v. Superior Radiant Products, Ltd.*, the issue was whether the district court in the Western District of New York had personal jurisdiction over defendant Superior Radiant for trademark infringement committed outside the State of New York. The court held that it did have personal jurisdiction over Superior Radiant because Superior Radiant’s Web site contained information directed to potential customers throughout North America, including New York where Roberts-Gordon had its principal place of business. In so holding, the court noted that the source code for Superior Radiant’s Web page had Roberts-Gordon’s trademarks embedded as metatags.

Prior to filing suit, Roberts-Gordon sent Superior Radiant a cease and desist letter demanding that the offending mark be removed from the metatag of Superior Radiant’s Web page and also demanding an accounting and an award of Superior Radiant’s profits. In reply, Superior Radiant informed Roberts-Gordon that the offending metatags had been removed but that it was unable to attribute any sales to its Web site advertising.

Having studied the *Niton Corp.* and *Roberts-Gordon* decisions, Ms. Maven decides that the traditional cease and desist letter will not benefit her client, and thus opts to draft a different type of cease and desist letter based upon the contract Hot Dog Haven entered into with its ISP and the contracts that all of the available search engines have posted for consumer use. Thus, she first investigates which ISP Hot Dog Haven uses to host its Web site by visiting the Network Solutions® WhoIs database, which provides all of the information for Hot Dog Haven’s Web site address (also called a Uniform Resource Locator or URL). Having identified the ISP Hot Dog Haven uses to host its Web site, Ms. Maven then visits the ISP Web site and prints out a copy of their user contract. As suspected, the contract prohibits all infringing activities and reserves the right to terminate membership and shut down offending Web sites.

Next, Ms. Maven visits the Web sites of numerous search engines and finds that they all prohibit infringement of intellectual property rights, as well as spamming or cloaking, and that all of the search engine contracts have provisions whereby the search engines reserve the right to
remove the offending Web pages from their indices. Noting that the one instance of the infringing use of the “Donny’s Dogs” trademark cannot constitute spamming, Ms. Maven determines that the one instance could still be considered cloaking.

Armed with this information, Ms. Maven drafts a cease and desist letter which lists the infringing activity as trademark infringement based upon metatag use and cloaking. The letter demands that the infringing trademark be immediately removed and that Hot Dog Haven pay Donny a specified sum for each day of the infringement. To ensure compliance, the letter threatens to (1) report the infringing activity to Hot Dog Haven’s ISP with a request that Hot Dog Haven’s subscription agreement with the ISP be permanently terminated; (2) report the infringing activity to all known search engines with a request that Hot Dog Haven’s URL be permanently banned; and (3) to institute legal action for trademark infringement (Roberts-Gordon) and misleading use of a metatag (Niton), if the trademark is not removed from the source code of the Hot Dog Haven Web site and if an agreement as to damages is not made within a specified time period.

An Alternative Approach to Using Web Page Design Contracts

The approach taken by Ms. Maven is just one example of how to use ISP and search engine contracts to stop infringing metatag use. As an alternative approach, Ms. Maven could have opted to contact the ISP and search engines and inform them of the infringing use before contacting Hot Dog Haven. Such an approach may be desirable in a situation with repeated metatag infringement or where the metatag infringement rises to the level of spamming or extensive cloaking.

Conclusion
The cease and desist letter proposed here gives the trademark holder a new weapon to stop trademark infringement by metatag use. As can be seen in the sample cease and desist letter put together by Ms. Maven, the strength of the demand lies in the threat to the infringer, posed by power of the ISP and the search engines contracts, to remove the infringer’s Web site from Internet commerce upon notice by the trademark holder of infringing use of its trademarks in a metatag. Moreover, under this type of threat, the trademark holder has a vehicle by which to demand money damages for past infringement.

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iii Metatags can be viewed from any Web page by going to the Menu Bar on the top of a Web page and pulling down the View menu and clicking on “Source.” The resulting text is the source code for the Web page written in hypertext mark-up language (HTML). Within the source code, metatags can be seen in strings such as meta name="description" content="words which describe the contents of the Web page" or meta name="keywords" content="words which a search engine would pick up to classify the Web site."


vi Sullivan, supra n.4.


ix Brookfield Communications, Inc. v. West Coast Entertainment Corp., 174 F.2d 1036, 1962 (9th Cir. 1999).

x See id. at 1063.

xi Id. at 1062.
See e.g., Earthlink\textsuperscript{TM} Internet Service Agreement, Section 5, Monitoring the Services, available at http://www.earthlink.net/about/policies/dial/index.html visited on July 20, 2001; Earthlink\textsuperscript{TM} Acceptable Use Policy, Section 1, Introduction, and Section 2(a), Violations of Earthlink\textsuperscript{TM} Acceptable Use Policy – Illegal Use, available at http://www.earthlink.net/about/policies/use visited on July 20, 2001.

See e.g., Earthlink\textsuperscript{TM} Acceptable Use Policy, supra n. 9, Section 3, Reporting Violations Of Earthlink’s AUP.


Id.

See e.g., Google\textsuperscript{TM} Terms of Service for Your Personal Use, p. 1, Personal Use Only, supra at p. 1, Personal Use Only.


Sullivan, supra n.4 at 2; GOOGLE\textsuperscript{TM} FAQ, supra n.7 at 4.

See e.g., Brookfield, 174 F.3d 1036 ("MovieBuff" trademark used in URL (Uniform Resource Locator) as well as metatag HTML sourcecode); see also, Playboy Enterprises, Inc. v. AsiaFocus International, Inc., 1229 WL 742000 (E.D. Va. 1998) (Playboy trademarks use in domain name as well as metatags).


Niton, 27 F. Supp.2d at 104.

Id.

Roberts-Gordon, 85 F. Supp.2d at 207.

Id. at 216.

Id. at 207.

Id.

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