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Protection for Trademark Owners: The Ultimate System of Regulating Search Engine Results

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I. INTRODUCTION

In recent years, claiming a spot on the Internet to sell goods and services has become an integral part of the cost of business. Judge Guido Calabresi of the Court of Appeals for the Second Circuit noted,

> Over the last few years, the commercial side of the Internet has grown rapidly. Web pages are now used by companies to provide information about their products . . . . Moreover, many consumers and businesses now order goods and services directly from company web pages. Given that Internet sales are paperless and have lower transaction costs than other types of retail sales, the commercial potential for this technology is vast.[1]

Once a business stakes out a spot on the Internet, marketing the site becomes essential. Companies commonly submit sites to search engines in hopes of obtaining high rankings for certain keywords. Businesses fight over the top ranks of the search engines, for if such ranks can be obtained, there is money to be made. Unfortunately, sometimes businesses are so interested in obtaining high rankings that they infringe the trademarks of others.[2]

To illustrate the problem, suppose that you are in the market to purchase a new car. You are interested in the Ford Mustang and have heard that it is affordable. To find out more about the Mustang, you decide to use a search engine such as http://www.excite.com. You submit the keywords "Ford Mustang" to the search engine and the search engine returns the top ten results. The first result returned links you to the Ford Motor Company's Web site. The second result links you to Ford Motor Company's Mustang Web site. The fifth result links you to a page from Mighty Car's Web site,

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1. Sporty's Farm L.L.C. v. Sportsman's Mkt., Inc., 202 F.3d 489, 493 (2d Cir. 1999).

2. *See, e.g.*, Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036 (9th Cir. 1999) (granting a preliminary injunction where defendant used plaintiff's trademark in its Web site name and in its embedded software code).

one of Ford's competitors.

As you look at the results of your search, you notice that the description of Mighty Car's site does not mention the words "Ford" or "Mustang." Instead, it discusses an inexpensive model that the company has just released. Wondering why it came up in the rankings for the keywords "Ford Mustang," you click on the link to Mighty Car's Web site to look for the keywords. You read every word on the site, but still cannot find the keywords "Ford" or "Mustang." Finally, if savvy enough, you check pieces of code in the Web page that contain keywords relevant to the site, called metatags.[3] Once again, "Ford" and "Mustang" are absent.

If the words "Ford" and "Mustang" are not in the search engine description, visible text of the Web page, or metatags, then why does the search engine return Mighty Car's Web site as the fifth most relevant site for the keywords "Ford Mustang?" The answer is because Web designers employ many techniques to achieve high rankings in search engine results. Additionally, just because one cannot see the keywords, does not mean they are not there, or at least, were not there at one time.[4] Thus, knowing where these keywords are found can help a lawyer persuasively argue a trademark infringement or dilution case with regard to search engine results.

This article will accomplish two goals. First, it will inform lawyers of the ways search engines rank Web pages and some of the tricks site designers use to achieve high rankings. The lawyer who has such an understanding will be able to teach the courts about how site designers hide trademark violations.

The second goal of this article is to inform lawmakers that now is the time to consider whether a standardized system of regulating search engine results should be imple-

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3. "Metatags are HTML code intended to describe the contents of the web site." *Id.* at 1045.

4. For an informative and up-to-date source on the search engine industry, created and maintained by Danny Sullivan, visit internet.com's Search Engine Watch Web site, www.searchenginewatch.com (visited Jan. 31, 2002). This site offers on-line tips as well as subscription services for Seach Engine Watch newsletters. For explanatory background on "hidden" keywords, see DANNY SULLIVAN, SEARCHENGINEWATCH.COM, WHAT IS A BRIDGE OR DOORWAY PAGE?, *at* http://www.searchenginewatch.com/webmasters/bridge.html (updated June 2, 2001).

mented. If a standardized system is not implemented, market forces will determine the fate of regulation, which may lead to divergent systems and ultimately to difficulties as the search engines evolve. To assist in the determination, some alternatives will be presented, including the introduction of a standardized system of regulating search engine results. The model standardized system would require the creation of ".tm" as a new top-level domain name ("TLD") and a "Trademarks" metatag. Most importantly, the system demonstrates how a new .tm TLD could be utilized.

If adopted, the proposed model standardized system would deter a site owner from using a competitor's trademark in order to achieve high rankings in search engines for searches involving a competitor's trademark. In addition, a standardized system of regulation would require very little monitoring, and the bulk of the issues dealing with trademark infringement and dilution in search engine results would be avoided. Further, market forces could likely handle issues not addressed by the implementation of a standardized system. Finally, a new TLD and "Trademarks" metatag would create a regulatory system that balances the interests of trademark owners, their competitors, the consumer, the search engine owners, and the courts.

II. ARTICLE SUMMARY

Comprised of five sections, the first part of this article will discuss the history of the Internet, the statistics regarding its growth, as well as information regarding top-level and second-level domain names. The second section will provide a brief introduction to building and publishing a Web site, followed by an introduction to the Web site programming language HyperText Markup Language ("HTML"). The third section will explain the differences between search engines and directories and will discuss many of the tactics that Web site designers currently use to achieve high rankings for keywords. This section, coupled with the introduction to HTML, will allow a lawyer to understand the many ways that a site designer can infringe another's trademark. The fourth section will discuss trademark infringement, trademark dilution, and the fair-use defense in the context of search engines. Included will be an analysis of the two landmark cases dealing with search engine results. Finally, the article will discuss

some of the solutions that have been recently proposed towards ending the troubling issue of trademark protection in search engine results. It will then introduce a standardized system of regulation that will deter site owners from attempting to achieve high rankings for searches involving a competitor's trademark.

III. WHAT IS THE INTERNET AND WHERE DID IT COME FROM?

The Internet "is a global network of interconnected computers which allows individuals and organizations around the world to communicate and share information with one another."[5] It is the "world's largest computer network, connecting other computer networks and users."[6]

The Internet was conceived in 1966 when the director of the computer research program at the U.S. Department of Defense's Advanced Research Project Agency linked computers together so that defense research facilities could pool their resources.[7] "The Internet began in 1969 as a network of four computers located at the University of California at Los Angeles, the University of California at Santa Barbara, the University of Utah, and the Stanford Research Institute."[8] The information presented on a Web site is stored on servers and can be accessed by anyone with Internet access and a Web browser such as Netscape Navigator or Internet Explorer. "Every Web browser interprets HTML tags a little differently. Tables, forms, graphic position and alignment tags will work a little differently in each brand or version of Web browser."[9]

IV. WHAT IS A DOMAIN NAME?

Every Web page has a corresponding domain address, which is an identifier somewhat analogous to a telephone number or street address.[10]

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5. *Brookfield Communications*, 174 F.3d at 1044.

6. Ian C. Ballen, *The Nuts and Bolts of E-Commerce*, 53 CONSUMER FIN. L.Q. REP. 250, 250 (1999).

7. *See id.*

8. Leonard T. Nuara, Darren K. Rydberg & Howard P. Benard, *What Lawyers Need To Know About The Internet*, 198 NEW JERSEY LAW. 9 (Aug. 1999).

9. PATRICK J. LYNCH & SARAH HORTON, WEB STYLE GUIDE: BASIC DESIGN PRINCIPLES FOR CREATING WEB SITES 78 (1999).

10. *See* THE INTERNET CORPORATION FOR ASSIGNED NAMES AND NUMBERS (ICANN), FREQUENTLY ASKED QUESTIONS (FAQS), *at* http://www.icann.org/general/faq1.htm (page updated June 18, 2001).

> Domain names consist of second-level domain—simply a term or series of terms (e.g., [bestlecterns])—followed by a top-level domain, many of which describe the nature of the enterprise. Some examples of top-level domains include ".com" (commercial), ".edu" (educational), ".org" (non-profit and miscellaneous organizations), ".gov" (government), ".net" (networking provider), and ".mil" (military).[11]

Additionally, each country has its own top-level domain name.[12]

V.   BUILDING AND PUBLISHING A WEB SITE FOR THE INTERNET

Most Web pages on the Internet are designed using HTML. An HTML file consists of text, which is displayed to the reader of an HTML document, and tags, which tell the browser how to format that text.[13] The HTML coding is also known as the source code of a page.[14]

Although people can be intimidated by HTML upon first impression, the truth of the matter is that one does not even need to know HTML to make a Web page. Numerous programs will create the HTML for you. Microsoft Frontpage 2000 is a perfect example of such a program. The program allows the designer to make a Web page with as little effort as is required to make a document on WordPerfect or Microsoft Word. The program allows the designer to view and edit the page by manipulating the HTML directly, or by using another interface that basically works like a word processor. For example, a designer could simply type the text where they wanted it on the page and hit "enter" to create new paragraphs. To bold, italicize, underline, or center text, one would highlight the text or object and then click on the icon specifying the command. The program automates the Web

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11. Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1044 (9th Cir. 1999).

12. *See* COMPUTERUSER.COM INC., COMPUTERUSER.COM HIGH-TECH DICTIONARY (visited Jan. 31, 2002), *at* http://www.computeruser.com/resources/dictionary/domains.html (listing the top level domain name for each country).

13. CHUCK MUSCIANO, INTRODUCTION TO HTML, *at* http://members.aol.com/htmlguru/about_html.html (last visited Jan. 15, 2002).

14. "The source file for a web page is available on most computer terminals by highlighting the 'view' command and then clicking on 'source' or 'page source.'" Eli Lilly & Co. v. Natural Answers, Inc., 86 F. Supp. 2d 834, 839 (S.D. Ind. 2000).

design process.

After the page has been created, it still must be published on the Web. Publishing on the Web means that the files of the Web site are transferred to a server.[15] Commonly, such files are transferred by File Transfer Protocol ("FTP") Programs. An FTP program allows the publisher to upload all of the files of the Web page to a specific directory on the server that will host the site.[16] The most common files are the ".html" files, ".htm" files, images, and sound files.

To do this, the domain name must be directed to the server on which the files will be stored. If the domain name is not directed to the server, the Web pages will not be accessible. Thus, when a Web surfer accesses the Web site, an error message will be displayed stating that no server was found. If directed to the server, the domain name is entered into a browser, which will connect with the server and download all of the files necessary for proper viewing of the Web page.

VI. A BRIEF INTRODUCTION TO HTML

Because search engines generally rank Web sites according to the content of the HTML, an attorney must have a basic understanding of HTML to persuasively argue a trademark violation with regard to search engine rankings.[17] Like a Web site designer, a lawyer does not need to be able to write HTML. However, a lawyer must be able to understand the HTML of a Web page in order to detect the sections of the

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15. "When information is made available, it is said to be 'published' on the Web, and because of the power of the Web, it can be linked without regard to its status or physical location." Needham J. Boddie, II, Thomas C. McThenia, Jr., Fred B. Amos, II & Douglas W. Kim, *A Review of Copyright and the Internet*, 20 CAMPBELL L. REV. 193, 202 (1998).

16. "File Transfer Protocol . . . allows an Internet user to move files from one computer to another. It does not matter where the two computers are located, how they are connected, or even whether or not they use the same operating system. Files can be transferred by ftp, provided that both computers have access to the Internet and can communicate in the ftp protocol." Mark A. Kassel & Joanne Keane Kassel, *Don't Get Caught in the Net: An Intellectual Property Practitioner's Guide To Using the Internet*, 13 J. MARSHALL J. COMPUTER & INFO. L. 373, 379 (1995).

17. "Pages with the search terms appearing in the HTML title tag are often assumed to be more relevant than others to the topic." DANNY SULLIVAN, SEARCHENGINEWATCH.COM, HOW SEARCH ENGINES RANK WEB PAGES, *at* http://www.searchenginewatch.com/webmasters/rank.html (updated June 26, 2001).

code that may contain trademark violations.[18]

To provide an introduction to HTML, the following will break down the HTML presented in the Appendix. Before reading this section, it is recommended that you look at the Appendix (HTML of a simple Web page) and notice a few items. First, notice that whenever you see a tag such as <html>, there must be a tag such as </html>. The former is an opening tag (without the forward slash); the latter is a closing tag (with the forward slash). Second, notice that the tags <head> and </head> and the tags <body> and </body> contain a good deal of text in between them.

The <html> and </html> tags are the opening and closing of the Web page source code. All sections go between these tags. The first section in the <html> and </html> tags is the head of the page. These tags, <head> and </head>, contain information that is not visible to the Web surfer when viewing a Web page. On most computers, the surfer can access the source code for a Web page by highlighting the "view" command and then clicking on "source" or "page source."[19] The example of source code from the Appendix has the following head section:

<head>

<title>Lecterns-Podiums   for   very   reasonable prices!**</title>**

<meta name="description" **content**="Lecterns-Podiums for meeting rooms, schools, restaurants. Lecterns and podiums don't get better than this!">

<meta name="keywords" **content**="lecterns, podiums, Convention Centers, Restaurants, Colleges, Sound Systems, University, Meeting Rooms, Hotel, audio">

</head>[20]

The head section contains the page title and the metatags. "Metatags are HTML code intended to describe the contents of the Web site. There are different types of metatags."[21] The metatag with the meta name "description"

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18. Parts VI and IX provide a basic understanding of how to read HTML.

19. *Eli Lilly*, 86 F. Supp. 2d at 839.

20. *See infra* Appendix.

21. Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

describes the content of the site.[22] The metatag with the meta name "keywords" should, at least in theory, contain keywords reflecting the contents of the Web site.[23] Search engine "spiders," software that analyzes Web pages and adds them to an index, use keywords to categorize sites.[24]

Following the head section is the body of the page. The first paragraph in the body is as follows:

> **<p   align=**"center"**><img   src=**"Lecterns-Podiums-Logo.jpg" **alt=**"Lecterns and Podiums for prices worth bragging about. Check out our beautiful solid wood lecterns   and   podiums   now!" **width=**"530" **height=**"133"**></p>**[25]

The paragraph is one image and some alternate text. Alternate text gives the Web surfer information about the image that will be displayed, and is displayed until an image downloads.[26] Some browsers, like Internet Explorer 5.50, allow a user to view alternate text at anytime by hovering the pointer over the image. The paragraph is centered as can be seen from the opening paragraph tag. The image source (**img src**) is the name of the image. As can be seen from the name of the image, the image is the logo. The alternate text appearing after **alt=** is only visible prior to an image downloading. Once the logo downloads, the alternate text disappears. Finally, the width and height designations determine the size of the image to be displayed.

Under the first paragraph is a heading. Headings and new paragraphs are separated in a manner equivalent to hitting return on your computer. The heading is as follows:[27]

> **<h2   align=**"center"**><u>**Lecterns and Podiums of the Highest Quality.**</u></h2>**

This heading is centered, underlined, and white in color,

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22. *Id.*
23. *Id.*
24. *See* DANNY SULLIVAN, SEARCHENGINEWATCH.COM, HOW SEARCH ENGINES   WORK,   SEARCHENGINEWATCH.COM,   *at* http://www.searchenginewatch.com/webmasters/work.html (updated June 2, 2001).
25. *See infra* Appendix.
26. *See* Patrick Maroney, INTERNET *The Wrong Tool for the Right Job: Are Commercial Websites Places of Public Accommodation Under the Americans with Disabilities Act of 1990?*, 2 VAND. J. ENT. L. & PRAC. 191, 203 (2000) (noting that tagging graphics with alternate text is a common feature of HTML).
27. *See infra* Appendix.

with a size of h2. Headings come in six sizes, h1 through h6, with h1 being the largest.

The second paragraph has three images and is as follows:

<p align="center"**>;**

<img border="0" **src=**"left-lectern.jpg" **alt=**"Lecterns and Table Top Podiums for the professional speaker." **width=**"92" **height=**"152">;

<img border="0" **src=**"middle-podium.jpg" **alt=**"A picture of perfection. Our beautiful table top podiums will look good on any table top." **width=**"173" **height=**"143">;

<img border="0" **src=**"right-lectern.jpg" alt="Top quality lecterns and podiums. Want an I shaped lectern? We have them! Well priced lecterns and podiums suited for meeting rooms, convention centers, universities, churches and more!" **width=**"105" **height=**"158">;

</p>

First, notice that each image says <img border="0," yet the image in the first paragraph did not say border. This is because the second paragraph has three images in a row. The absence of a border means that the images will be right next to each other, rather than having space between them. Additionally, each image has alternate text. Further, each image also has a specified width and height.

The next tag of the source code at the Appendix is a comment tag. The comment tag is as follows:

<!— Lecterns, podiums, and sound systems supplied to convention centers and hotels. **—>**

Comment tags allow the designer to leave messages for future Web work, and can include any sort of text.[28] The Web surfer does not see them, unless the surfer accesses the source code.[29] Many designers use these tags to give themselves reminders of the work that needs to be done, ideas to look into, or simply to signify the point where they left off.[30] Some designers use comment tags for other purposes, such as adding keywords to the HTML coding.[31] The comment tag at

28. *See* LARRY ARONSON, HTML MANUAL OF STYLE 15 (1994).
29. *Id*
30. *Id.*
31. "As it turns out, some engines ignore content in comment blocks, but some other search engines may process this content." BRUCE CLAY, LLC, SEARCH ENGINE OPTIMIZATION PROMOTION TOOLS, *at*

the Appendix represents such an example.

Following the comment tag is the third paragraph. The third paragraph is some text and reads as follows:

> **<p align**="center"**>**Well priced lecterns and podiums suited for meeting rooms, convention centers, hotels, restaurants, universities and much more!**</p>**

The fourth paragraph is as follows:

> **<p   align**="center"**><a   href**="lecterns.htm"**><img alt**="Enter our site here!   Your lectern awaits you." **src**="lecterns-1.gif"   **WIDTH**="164" **HEIGHT**="62"**></p>**

The fourth paragraph is an image, but notice that it says "a href=lecterns.htm." That means that the image is linked to another Web page in the same Web site. To demonstrate, assume you are at the homepage of www.bestlecterns.com. The homepage is generally named either index.html or default.htm,[32] thus the address in the Web browser appears as http://www.bestlecterns.com/index.html. Because the image has a link directing the Web surfer to lecterns.htm, clicking on such an image will send the Web surfer to a different page in   the   same   site,   namely http://www.bestlecterns.com/lecterns.htm. Suppose the designer wanted the link to go to another Web site, such as Disney's site. The source code of the Web page would read "a href=http://www.Disney.com."

The final portion of the source code in the Appendix is merely one more paragraph of text, the closing tag of the body, and the closing tag of the Web page.[33] It is as follows:

> **<p align**="center"**>**Order a lectern or table top podium today!**</p>**

> **</body>**

> **</html>**

As has been demonstrated, HTML is not difficult, but as legal issues emerge with the new technology, trademark attorneys must have a general understanding of HTML basics. This is especially true in litigation involving search engine

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http://www.bruceclay.com/web_rank.htm (last visited Jan. 23, 2002).
    32. *See* DAVE TAYLOR, CREATING COOL WEB PAGES WITH HTML 30 (1995).
    33. *Id.* at 36.

results.

VII. WHAT ARE DIRECTORIES AND SEARCH ENGINES?

Search engines and directories create many options for the consumer. The court in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.* noted, "Sometimes, however, a web surfer will not know the domain name of the site he is looking for, whereupon he has two principal options: trying to guess the domain name or seeking the assistance of an Internet search engine."[34] Thus, without engines and directories, people would only be able to access the sites they were familiar with, or sites in which they could guess the domain name. Thus, search engines and directories are the vehicles to having many options over the Web, just as cars and airplanes are the vehicles to many options over land. Unfortunately, one must be able to drive the engines and directories to make use of the advantage, just as one must know how to drive a car.[35]

The terms search engine and directory are often used interchangeably; however, they are quite different. For example, one court stated that an example of a "search engine" is "Yahoo!."[36] It is understandable why one would think Yahoo! is the model example of a search engine because it does have mechanical search engine capabilities. However, Yahoo! is not a true search engine.[37] Yahoo! is really an example of a directory.[38] A directory is "a catalogue or index of web pages organized by subject."[39] Upon entering, the user is presented with links to general categories.[40] The user will click on the desired general category. The directory then displays a menu

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34. Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1044 (9th Cir. 1999).

35. Engines and directories are simply Web sites on the Internet in which the user must direct his browser. A browser is the software program used to display Web pages. "Browser is commonly used in the phrase point your browser, so that you can access a particular web page." Barbara Bintliff, *Why Is Web Searching So Unpredictable?*, 7 PERSPS. 84 (1999).

36. Paccar, Inc. v. Telescan Technologies, L.L.C., 115 F. Supp. 2d 772, 775 (E.D.Mich. 2000).

37. *See* SEARCHENGINEWATCH.COM, THE MAJOR SEARCH ENGINES, *at* http://searchenginewatch.com/facts/major.html (updated Jan. 22, 2002).

38. *See id.*

39. Bintliff, *supra* note 35, at 84.

40. For additional information pertaining to the organization of the Yahoo! directory, see YAHOO!, HOW TO SUGGEST YOUR SITE, *at* http://docs.yahoo.com/info/suggest/ (visited Jan. 22, 2002).

of choices pertaining to the chosen category. The user must then narrow the choices once again and repeat this process until he reaches the desired topic.

A search engine is a software program that searches its own collection of Web pages.[41] Search engines can be individual programs, which include AltaVista at http://www.altavista.com, Excite at http://www.excite.com, and Hotbot at http://www.hotbot.com. Search engines also can operate as multiple program interfaces like Dogpile at http://www.dogpile.com. The multiple program interfaces send a single query to several individual search engines at once. Although multiple program interfaces provide results from a number of different search engine catalogs, they are only good for very simple searches. They recompose the search query in the lowest common denominator of terms to access each engine simultaneously. Consequently, a user loses the benefit of a more sophisticated search equipped with Boolean operators.

Search engines operate when a user enters text descriptive of her desired target search into a search field. "When a keyword is entered, the search engine processes it through a self-created index of web sites to generate a (sometimes long) list relating to the entered keyword."[42] "No one search engine has identified and classified all the available web pages because the web is too big and its contents change too quickly."[43] Also, when a user "conduct[s] a web search, the search engine typically ranks and displays the pages it finds according to its statistical formula for determining relevancy."[44] Thus, "the list of web sites that any particular set of keywords will bring up may differ depending on the search engine used."[45]

Human involvement constitutes the key difference between directories and search engines. For instance, Yahoo! and Open Directory both are "directories" that depend on humans to compile their listings.[46] Adding sites to directories

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41. *Id.*

42. Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

43. Bintliff, *supra* note 35, at 84.

44. *Id.*

45. *Brookfield Communications*, 174 F.3d at 1044.

46. *See* DANNY SULLIVAN, SEARCHENGINEWATCH.COM, SUBMITTING TO DIRECTORIES: YAHOO, LOOKSMART & THE OPEN DIRECTORY, *at* http://searchenginewatch.com/webmasters/directories.html (updated Sept. 27, 2001).

requires a human to submit and classify the site, whereas search engines add sites to the index by way of computer tools known as spiders. Thus, directories tend to be categorized better, but contain less current information than search engines.[47] If the user wants the option of using mechanical search capabilities, most directories have this function available as well.[48]

VIII. THE PROCESS OF A SITE BEING INDEXED WITH SEARCH ENGINES VERSUS DIRECTORIES

As previously discussed, search engines and directories are different in several important respects. The key difference between them is how they add sites to their catalogs. A spider determines whether a site is indexed with a search engine. In contrast, a human determines whether a site will be indexed with a directory. Because humans enter a site into the directory, trademark violations are much less likely to occur in directories than search engines.[49] To make this clear, the following section will first explain how a site is indexed with search engines and then discuss how a site is indexed with directories.

A. *Indexing Sites with Search Engines*

Companies such as Excite, Hotbot, Lycos, and Webcrawler provide true search engines.[50] "Though most search engines today also offer small directories to interested users, their primary function is to provide a mechanical index on the web."[51]

To register a site with a search engine, the site designer

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46. *Brookfield Communications*, 174 F.3d at 1044.

47. John M. Mrsich & Meeka Jun, *Terms You Need to Know: Search Engines*, MULTIMEDIA & WEB STRATEGIST, May 1997, at 2.

48. "In the web's early days . . . a search engine either presented crawler-based results or human-powered listings. Today it is extremely common for both types of results to be presented." SULLIVAN, *supra* note 24.

49. Because a person has the chance to review a site before entering the site into the directory, it is arguable that the directory should be liable for allowing a site into the directory that has the trademark of another.

50. The key difference between search engines and directories is the involvement of humans. Search engines are mechanical, where directories depend on humans to compile their listings. SEARCHENGINEWATCH.COM, *supra* note 37.

51. F. Gregory Lastowka, Note, *Search Engines, HTML, and Trademarks: What's The Meta For?*, 86 VA. L. REV. 835, 848 (2000).

goes to the "add a link" or "submit a link" page of the search engine. For example, to submit a site to Hotbot, one would click on the "submit web site" link located at http://www.hotbot.com. This will send the submitter to a form at http://hotbot.lycos.com/addurl.asp, where he will fill in the Web page address being submitted and the return email address. Once submitted, the page will be queued for addition to the search engine's index.[52] Search engines have "massive computer databases" that "continually search and read as many web pages as they can manage."[53] Simply submitting a request for addition to the index does not mean the site will be entered into the index.[54]

The search engine indexing programs are known as "spiders," "robots," and "crawlers."[55] "Each search engine uses its own algorithm to arrange indexed materials in sequence."[56] "Search engines look for keywords in places such as domain names, actual text on the web page, and metatags."[57] "The more often a term appears in the metatags and in the text of the web page, the more likely it is that the web page will be 'hit' in a search for that keyword and the higher on the list of 'hits' the web page will appear."[58]

When a Web surfer enters a keyword phrase into a search engine, the database simply returns all indexed pages in which the keyword phrase appeared at any relevant place in the code or text of the indexed Web page.[59] In contrast to directories like Yahoo!, these mechanical search engines produce a massive number of results. For example, a query for lecterns on the directory Yahoo! retrieved seventeen matches, while a query on the search engine Hotbot received 29,100 matches.[60] For search engines, "the crucial factor therefore

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52. "Sometimes it can take a while for new pages or changes that the spider finds to be added to the index." SULLIVAN, *supra* note 24.

53. *Id.*

54. Design tools such as JavaScript and Flash may cause crawler-based search engines to miss a page. *See* Danny Sullivan, *Surplus of Search Engine Marketing Reports*, THE SEARCH ENGINE REPORT (Oct. 2, 2001) *at* http://www.searchenginewatch.com/sereport/01/10-surveys.html.

55. Lastowka, *supra* note 51, at 848.

56. Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

57. *Id.*

58. *Id.*

59. *See* SULLIVAN, *supra* note 17.

60. On January 22, 2002, a search for the word "lectern" was done on the Yahoo! directory located at www.yahoo.com and the Hotbot search engine lo-

becomes search engine ranking."[61]

How do sites come up high in the rankings on certain keywords other than by paying a fee? The keywords are placed in the HTML code that the spider for the particular engine is programmed to consider relevant.[62] Unlike directories, "human editors do not review the individual results harvested by their spiders."[63]

There are many factors that may be used by the spider to determine relevancy. First, some spiders use the number of keywords in the page as a whole.[64] Second, some look into specific tags, such as the metatags.[65] Third, some spiders are programmed to consider the content of comment tags.[66] Fourth, some search engines consider text at the top of the page, text at the bottom of the page, or in the alternate text for images.[67] Fifth, a search engine may consider keywords in the name of an image. Sixth, a spider will look at the number of sites linked to the given page. Finally, some search engines consider keywords in the domain name to be relevant.[68] Because each spider follows a different algorithm program and other factors may be controlling, different search engines will produce different results.

B. *Indexing Sites with Directories*

Directories differ from search engines in one major respect. "Addition of sites to a directory, requires 'a human to

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cated at www.hotbot.com.

61. Lastowka, *supra* note 51, at 848-49.

62. When searching for keywords, the search engines "follow a set of rules, known as an algorithm. Exactly how a particular search engine's algorithm works is a closely-kept trade secret." SULLIVAN, *supra* note 17.

63. *Id.*

64. *Id.*

65. "Metatags are HTML code intended to describe the contents of the web site. There are different types of metatags." Brookfield Communications, Inc., v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

66. BRUCE   CLAY,   LLC,   ALTA   VISTA   SEARCH   ENGINE,   *at* http://www.bruceclay.com/SEInformation/altavista.htm (last visited Jan. 22, 2002).

67. "Search engines will also check to see if the search keywords appear near the top of a web page, such as in the headline or in the first few paragraphs of text. They assume that any page relevant to the topic will mention those words right from the beginning." SULLIVAN, *supra* note 17. Additionally, some search engines consider text in alternate text. *See* DANNY SULLIVAN, SEARCHENGINEWATCH.COM,   SEARCH   ENGINE   PLACEMENT   TIPS,   *at* http://searchenginewatch.com/webmasters/tips.html (updated June 26, 2001) [hereinafter SULLIVAN, PLACEMENT TIPS].

68. *See Brookfield Communications*, 174 F.3d at 1044.

submit' and 'classify the site,' whereas search engines add sites to the index by way of computer robots, also known as spiders."[69]

For example, "[e]veryday, the editors of Yahoo" receive requests and "search the web for new sites to add to their directory, reviewing each site to evaluate content and quality and to determine whether and where a new site belongs in their directory structure."[70]

To register a site with a directory such as Yahoo!, the site designer must go to the site of the directory and find a category that the designer believes best describes the site. Thus, a commercial site selling presentation furniture such as lecterns would fall into the general category of business. The designer would click on that link and then the site would present a new list of choices. The designer would be required to pick the best category of the more specific areas under the general category of business. The site designer would be required to narrow the classification until the list of categories could no longer be broken down. The designer must then submit the site and hope that the Yahoo! personnel agree that the site is worthy of being indexed by Yahoo! and the chosen category is the correct one.

Because of human intervention, it is less likely that a site designer can deceive the index and achieve high rankings for keywords that are irrelevant to the site, or keywords that would violate trademark law. In directories, a search is limited to the descriptions of a page, whereas search engines utilize many areas of a page.[71] Such differences between search engines and directories may mean that directories should be liable for trademark violations, since the human involvement in directories such as Yahoo! foreseeably creates the expectation that illegal practices will be detected.

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69. Mrsich & Jun, *supra* note 47, at 2.
70. Lastowka, *supra* note 51, at 847.
71. *See* SULLIVAN, *supra* note 24.

IX. TACTICS WEB DESIGNERS USE TO ACHIEVE HIGH RANKINGS IN SEARCH ENGINES

For Web site operators, the secret to making money from search engines is reaching the top ranks and being found by customers. An advertising promotion recently claimed that "[a] top 30 ranking in a major search engine such as Excite, Lycos or AltaVista often will generate more targeted traffic than an expensive banner advertising campaign."[72]

A ranking outside the top thirty is not likely to be helpful. For example, although a rank of 93 out of 25,100 matches seems good, in reality, a rank of 93 is not likely to be found by search engine users because most Web surfers find what they are looking for in the top thirty results. If they don't find it in the first thirty results, they are likely to start fresh with a different search engine. Thus, there are only a few good positions for the numerous competitors with regard to certain keyword searches.

To obtain the high ranks of search engine results for certain keywords, site designers will manipulate the HTML coding. Often, these schemes will be used to get high rankings for words that are relevant to the site. However, a problem is created when Web designers obtain high ranks for keyword searches by using a competitor's trademark. Regulation of this practice is the basis of this article.

In order for trademark owners to be sufficiently protected, it is essential to understand the ways that site designers can achieve high rankings for keyword searches of another's legally protected trademark. Such an understanding is invaluable in two ways. First, it allows a lawyer to competently and persuasively argue trademark violations with regard to search engine results. Second, it allows judges to understand how search engines really operate, enabling well-established precedents to be established. By use of simple examples, this section will explore the numerous tactics that designers use to beat the competition, or in some cases, steal from the competition. Although the examples will use the keywords "lecterns" and "podiums" as demonstrations, it is important to realize that a site designer instead could use keywords that are the trade names of others.

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72. Advertisement, J. Strategies, *at* http://www.search-engine-ranking.com (visited Jan. 22, 2002).

Most of the tactics that Web site designers use involve manipulation of the HTML coding, also known as source code.[73] The opening tag of the html of a Web page is <html> and the closing tag is </html>. All sections belong between these tags. The goal of the Web site designer is to insert keywords into as many areas between the two tags without violating the rules the indexing spider follows.[74] Many of the ways designers achieve this goal will be described using the source code at the Appendix.

A. *Placing Keywords in the Title Tag*

The first section inside of the HTML tags is the head section.[75] The opening tag of the head section is <head> and the closing tag is </head>.[76] The title tag is inside of the head tags.[77] Many search engine spiders are programmed to value keywords in the title tags as being relevant.[78] The title tag at the Appendix is "<title>Lecterns-Podiums for very reasonable prices!</title>."

Notice that the first word the spider will read in the title tag at the Appendix is the word "lecterns," and the second word is "podiums." Looking solely at the title tag, since the word "lecterns" comes first, it will be considered as more relevant than the word "podiums." Also, notice that the length of the title is only six words. The shorter the title tag, the more relevant the words will be when ranked by the spider since the word constitutes a higher percentage of the tag.[79]

Because many spiders are programmed to look at title tags for keywords, site designers often will repeat keywords in the title tag.[80] For example, if the keywords the site de-

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73. *See* Eli Lilly & Co. v. Natural Answers, Inc., 86 F. Supp. 2d 834, 839 (S.D. Ind. 2000) (describing the source code of a web page).

74. For example, a search engine may penalize a site which excessively repeats the same keyword in an attempt to make the site appear more relevant. *See* SULLIVAN, *supra* note 24.

75. *See* ARONSON, *supra* note 28, at 11.

76. *Id.*

77. *Id.*

78. *See* SULLIVAN, *supra* note 24.

79. "And try to keep the title and description fields as short as possible to prevent you from diluting the keyword impact." CLAY, *supra* note 31.

80. Seachenginewatch.com informs its users of the following:
   Search engines may also penalize pages or exclude them from the index, if they detect search engine spamming. An example is when a word is repeated hundreds of times on a page, to increase the frequency and propel the page higher in the listings. Search engines watch for

signer seeks to have considered relevant are "lecterns" and "podiums," the following title tag may be used: <title>Lecterns-Podiums and Lecterns-Podiums and Lecterns-Podiums, etc</title>. This would make the relevancy of "lecterns" and "podiums" very high, but may distort the search engine results if the spider were to rank this site higher than other sites that are in fact more relevant to the topic. Some spiders will not allow this practice and will constitute it as spamming even if the site really is the most relevant.[81]

It is important to note that when a Web page is viewed, the content in the title tag is usually found in the title bar at the top of the screen. Thus, the title tag may be visible to the Web surfer while viewing the Web page. Additionally, some search engines use the content of the title tag when displaying search results.[82] Thus, title tags can be a very important factor in causing two sites to be confusingly similar to the Web surfer upon first impression.

B. *The Keyword and Description Metatags*

Another trick in achieving successful engine rankings is to effectively use metatags.[83] However, "[m]eta tags are what many web designers mistakenly assume are the 'secret' to propelling their web pages to the top of the rankings."[84] But many search engines—such as AltaVista, Excite, FAST, Google, Lycos, and Nlight—don't even consider metatags in determining content relevancy.[85] Additionally, search engines "that do read meta tags may choose to weight them differently. Overall, meta tags can be part of the ranking recipe, but they are not necessarily the secret ingredient."[86]

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common spamming methods in a variety of ways, not the least by following up on complaints.
SULLIVAN, *supra* note 17.

81. CLAY, *supra* note 31.

82. "[T]he 'title' tag allows the title of the Web page to appear in the title bar of a browsing program, as well as to provide an additional source of indexing." Ira S. Nathenson, *Internet Infoglut and the Invisible Ink: Spamdexing Search Engines with Meta Tags,* 12 HARV. J.L. & TECH. 43, 62-63 (1998).

83. "Metatags are HTML code intended to describe the contents of the web site. There are different types of metatags." Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

84. SULLIVAN, *supra* note 17.

85. SEARCHENGINEWATCH.COM, SEARCH ENGINE FEATURES FOR WEBMASTERS, *at* http://searchenginewatch.com/webmasters/features.html (visited Jan. 22, 2002).

86. SULLIVAN, *supra* note 17.

Like the title tags, metatags are in the head section of the HTML coding.[87] There are two key metatags. The first is the description metatag.[88] The description metatag at the Appendix is <meta name="description" content="Lecterns-Podiums for meeting rooms, schools, restaurants. Lecterns and podiums don't get better than this!">. This tag includes the words "lecterns" and "podiums" twice. Although one could duplicate the words "lecterns" and "podiums" another fifty times in the tag, such use of the keywords will most likely get caught by the search engine spider, which will throw the page to the bottom of the results, or exclude it from the index altogether.[89]

It is important to note that the description tag is usually not hidden to the Web surfer, even though it is in the head section.[90] Many search engines use the description metatag as the description in the search engine results.[91] Thus, if one were to place trade names in the description tag, the element of confusion is more likely to exist because the trade name may not be visible on the actual Web page.

The second important metatag for achieving high rankings is the keywords metatag.[92] The site designer will include the keywords that are supposedly relevant to the site in the keyword tag. The example from the Appendix is "**<meta name**="keywords" **content**="lecterns, podiums, Convention Centers, Restaurants, Colleges, Sound Systems, University, Meeting Rooms, Hotel, audio">."

Notice that the tag only contains a few keywords and none of them are duplicated. This causes the spider to believe that the keywords are relevant. Some site designers will include the same keyword numerous times in the keyword metatag. Often, the spider will detect this and consider it

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87. "Meta tags, if any, will be included as 'head' tags." John R. Warner, *Trademark Infringement Online: Appropriate Federal Relief from the Illicit Use of Trademarked Material in Web Site Meta Tags*, 22 T. JEFFERSON L. REV. 133, 139 n.31 (2000).

88. The metatag with the meta name "description" is intended to describe the content of the site. *See* Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

89. CLAY, *supra* note 31.

90. *See* SULLIVAN, PLACEMENT TIPS, *supra* note 67.

91. *See id.*

92. The metatag with the meta name "keywords" ideally contains keywords relating to the Web site's contents. *See* Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F. 3d 1036, 1045 (9th Cir. 1999).

spamming.[93]   Additionally, all keywords are represented somewhere in the body of the Web page. However, some designers place keywords in the metatags, which cannot be found in the body of the Web page. A spider detecting such a practice will penalize the Web page lacking those keywords in its body.[94]

Lawyers should remember that many search engines do not consider keywords in metatags as relevant, and those that do may only give slight relevance to metatags.[95] Therefore, a site that appears in the top rankings for another's trade name is likely to have the competitor's trade name in some portion of the Web page besides the metatags.

C. *Keywords Placed at the Top of the Body Section*

The body is the other main section in the HTML coding of a Web page.[96] Spiders read the text in the body of a Web page to determine content relevancy,[97] thus placing keywords in the text of the Web page can be very effective. There are many ways that text can be placed in the body of the Web page to demonstrate to the spiders that the site is rich in content of a particular keyword. First, "search engines will . . . check to see if the keywords appear near the top of a Web page, such as in the headline or in the first few paragraphs of text. They assume that any page relevant to the topic will mention those words right from the beginning."[98] Further, the fact that the site designer is willing to place the keywords at the top of the page where everyone can see them indicates that the keywords are relevant to the Web page.[99]

Because the text at the top of the page may be considered very relevant, placing a logo or some other image at the top of the page is not usually done unless there are keywords in the alternate text tags.[100]

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93. CLAY, *supra* note 31.
94. *See id.*
95. "Most search engines use meta tags, but some do not because of the ease of meta tag abuse." Nathenson, *supra* note 82, at 64.
96. "HTML files commonly are broken into two sections: the head . . . and the body." TAYLOR, *supra* note 32, at 41.
97. *See* SULLIVAN, *supra* note 17.
98. *Id.*
99. *See id.*
100. *See* CLAY, *supra* note 31.

D. *Keywords in the Alternate Text Tags*

If the designer wants to place a logo at the top of the page, yet still have keywords at the top of the page, alternate text can accomplish this goal.[101] An example of such use of alternate text can be seen in the source code at the Appendix, which displays an image at the top of the page. The image coding is "**<p align**="center"**><img src**="Lecterns-Podiums-Logo.jpg" **alt**="Lecterns and Podiums for prices worth bragging about. Check out our beautiful solid wood lecterns and podiums now!" **width**="530" **height**="133"**></p>**."

Note the portion of the tag that reads "alt." That is the alternate text portion of the tag, which includes the text a user sees prior to an image loading. Because some search engines consider alternate text relevant, such tags are additional tools for site designers to boost their rankings.[102] An interesting issue with regard to alternate tags involves their use at the top of the page, which is one of the most important areas to have keywords. Since the alternate text is visible when no image is displayed, a site designer may be deterred from inappropriate keyword inclusion. However, Web designers may still use inappropriate keywords in the alternate text if a fast loading image quickly covers the text. But even quick loading images will not mask the inappropriate text when the Web page is viewed by a browser that has its image viewing capability turned off.

Some site designers may copy the keywords in the keyword metatag, then paste such text in the alternate text of images.[103] By placing the keywords in the metatags and in the body, the designer creates the illusion that these keywords are in fact relevant. However, "at least one search engine has added indexing logic to consider the exact duplication of substantial portions of a keyword list in this fashion as spamming, and entries will be removed within a week of their addition."[104] As spiders become more advanced, more designers copying and pasting the keywords metatag into other areas of the page such as the ALT text will be caught. However, to get around such hurdles, the site designer can simply scramble the keywords such that the spider does not recog-

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101. *See id.*
102. *See id.*
103. *See id.*
104. *Id.*

nize the text as being an exact duplication of the keywords in the metatag.[105]

E.   *Using Keywords as the Names of Images*

Another technique used by site designers is to place keywords in the names of the images. Using the example in the Appendix, "**<p align**="center">**<img src**="Lecterns-Podiums-Logo.jpg" alt="Lecterns and Podiums for prices worth bragging about. Check out our beautiful solid wood lecterns and podiums now!" width="530" height="133"></p>," the name of the image is "Lecterns-Podiums-Logo.jpg." Although naming images with keywords may be effective, currently there is no evidence to suggest that such a technique is a key determinant in search engines rankings.

F.   *Keywords in the Comment Tags*

Another way site designers can insert keywords into the body of the Web page is through comment tags. The comment tag in the Appendix is "<!— Lecterns, podiums, and sound systems supplied to convention centers and hotels. —>." Some search engines, such as AltaVista, consider keywords in comment tags when determining content relevancy.

It is important to note that comment tags are located in the body of the text, yet they are invisible to the Web surfer unless the actual source code is viewed.[106] Because comment tags are invisible like metatags, they also provide an example of less visible infringement.[107]

G.   *Keywords in the Domain Name*

Web site designers often obtain domain names that contain the keywords that the Web site will target. Some search engines value the keyword in the domain name.[108] This makes perfect sense, since many domain names reflect the name of the business, the form of the business, or a description of what the Web site sells. Because the search engine results display the domain names of the sites that are returned,

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105. *See id.*

106. "You can place comments in an HTML document . . . . Comments are completely ignored by the browser." ARONSON, *supra* note 28, at 15.

107. *See id.*

108. *See* Brookfield Communications, Inc. v. W. Coast Entm't Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

they are not hidden from the Web surfer.

H. *Keywords in Hidden Text*

Some Web site designers try to "spam search engines by repeating keywords in a tiny font or in the same color as the background color to make the text invisible to browsers."[109] However, "search engines are catching on to these and other tricks."[110] In response, a savvy designer might use an image as a background rather than a simple color. Search engines cannot read images on a Web page.[111] By using an image, the search engine spider might not be capable of determining the color of the background. In this case, a background with a blue image, for example, could have a similar shade of blue text on the page without detection by the engines. If this strategy is successful, Web designers can insert infringing language into their sites without visible detection. However, there are ways to reveal the invisible text if a designer uses this strategy. First, one can look at the HTML and view the text source. Second, one can simply highlight the entire Web page. All text that is placed on the same color background will become visible when highlighted.

I. *Keywords Located in Other Pages of the Site*

"Most search engines will index the other pages from [a] web site by following links from a page . . . submit[ted] to them."[112] This practice allows an engine to determine relevancy by looking to other pages within the same site. If the additional pages are relevant to a particular keyword as well, the site has a better chance of obtaining a high ranking with the engines. The "most descriptive, relevant pages are often inside pages rather than the home page."[113] This is important because a search engine will often display the homepage in its results rather than the internal pages of a site. Thus, one must look to the pages linked to the homepage for potentially infringing keywords.

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109. SULLIVAN, PLACEMENT TIPS, *supra* note 67.
110. *Id.*
111. *See id.*
112. *Id.*
113. *Id.*

J. *Doorway Pages - Bait and Switch Techniques*

A doorway page is a generic page that is rich in content of certain keywords or phrases.[114] They are designed primarily for search engines.[115] Doorway pages often will have a logo, a few words and a "enter" image, which will take the Web surfer to the real page that the site owner wants the surfer to visit.[116] The designer will make and submit many of these pages, differing only in the keywords or phrases placed into the HTML.[117]

A problem for designers is that doorway pages are very easy to copy.[118] Thus, a competitor of a certain keyword can view the source code of the doorway page, copy the code, then submit the doorway page as his own.[119] To avoid such a problem, some designers create certain doorway pages that work well with a specific search engine.[120] They submit a doorway page to the engine and the spider indexes the site, achieving a high ranking.[121] Next, they will replace the doorway page with the real page they want the surfer to view.[122] This practice keeps the competitors from taking the fruits of the designer's research.[123] After some time, the spider will revisit the page and the new page will not rank as high.[124] The designer will then resubmit the doorway page, achieve a high ranking, and replace the doorway page once again.

This practice of submitting and removing doorway pages creates an avenue for site designers to achieve high rankings by using another's trademark. The designer can submit the doorway page that is relevant to another's trademark and once the ranking is achieved, replace the page with one that does not even mention the trademark. This deceptive practice is difficult to detect because the trademark is not located in the HTML or domain name of any page in the site. Thus, infringement will be easier to detect if one accesses the site

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114. *See* SULLIVAN, *supra* note 4.
115. *See id.*
116. *Id.*
117. *Id.*
118. *Id.*
119. *Id.*
120. *See id.*
121. *Id.*
122. *Id.*
123. *Id.*
124. *Id.*

while the site designer is attempting to obtain the high
rankings.

X.   The Lanham Act - Trademark Infringement, Trademark Dilution, and the Fair-Use Defense Applied in the Context of Search Engine Results

The Lanham Act protects the rights of those who register
trademarks.

> The Supreme Court has articulated the fundamentals of
> Trademark law by stating that its objective is to "prevent
> others from copying a source-identifying mark, [which]
> 'reduce[s] the customer's costs of shopping and making
> purchasing decisions,' for [this process] quickly and easily
> assures a potential customer that this item—the item with
> this mark—is made by the same producer as other simi-
> larly marked items that he or she liked (or disliked) in the
> past. At the same time, the law helps assure a producer
> that it (and not an imitating competitor) will reap the fi-
> nancial, reputation-related rewards associated with a de-
> sirable product."[125]

Besides protecting consumers, trademark law is intended
to prevent one from reaping the benefits of another's good-
will.[126] Many companies invest large amounts of money into
advertising their products and services, assuring quality, and
convincing the consumer that any product with their trade-
mark can be trusted.[127] Trademark infringement law protects
those who use trademarks, and anti-dilution laws provide ex-
tra protection for those who maintain well-known trade-
marks.[128]

A federally registered trademark is "a mark that provides
the registrant with its exclusive use in commerce or in con-
nection with goods or services specified in the registration."[129]
Under the Lanham Act,

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125. Stanley U. Paylago, *Search Engine Manipulation: Creative Use of Meta-
tags or Trademark Infringement?*, 40 IDEA 451, 457 (2000) (quoting Qualitex
Co. v. Jacobson Prods. Co., 514 U.S. 159, 163-64 (1995), quoting 1 J. Thomas
McCarthy, McCarthy on Trademarks and Unfair Competition §2.01 [2],
at 2-3 (3d ed. 1994)) (alterations in original).

126. *Id.*

127. *See* David Yan, Note, *Virtual Reality: Can We Ride Trademark Law to
Surf Cyberspace?*, 10 Fordham Intell. Prop. Media & Ent. L.J. 773, 782
(1999-2000).

128. *See* 15 U.S.C. § 1127 (2000).

129. Paylago, *supra* note 125, at 457.

[t]he term "trademark" includes 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 own 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.[130]

Using the landmark cases of *Brookfield Communications, Inc. v. West Coast Video Corp.*[131] and *Playboy Enterprises, Inc. v. Terri Welles,*[132] the following will discuss trademark infringement, trademark dilution, and the fair-use defense in the context of search engine results.

A. *Trademark Infringement*

The most common course of action that a trademark holder will take to prohibit unauthorized use of its trademark in the United States is to pursue a "federal trademark infringement claim."[133] Such a claim can be made by a trademark owner against any person who, without the consent of the trademark owner, "use[s] 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 cause mistake, or to deceive."[134]

Thus, to succeed on a federal trademark infringement claim, the trademark owner must prove that "1) [he] ha[s] a valid, protectable trademark; 2) the infringer used the mark in commerce; and most importantly, 3) the infringed use creates a likelihood of customer confusion as to the source of the goods or services."[135]

In 1999, the Ninth Circuit addressed the question of whether use of another's trademark in the metatags of HTML

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130.   15 U.S.C. § 1127 (2000).

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

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

133.   Mark P. Wine et al., *Protecting Your Corporate Client's Most Valuable Intangible Asset: Its Name*, 67 DEF. COUNS. J. 285, 287 (2000).

134.   15 U.S.C. § 1114(1)(a) (2000).

135.   Paylago, *supra* note 125, at 458.

constitutes trademark infringement.[136]

1. *The Facts of* Brookfield Communications, Inc. v. West Coast Entertainment Corp.

Brookfield Communications, Inc. ("Brookfield"), a software company that maintains a "searchable database containing entertainment-industry related information," alleged that West Coast Video Entertainment Corp. ("West Coast"), "one of the nation's largest video rental chains," infringed its registered trademark "Moviebuff" by using the domain name "moviebuff.com" and including the name "in buried code or metatags on their home page."[137] Brookfield brought the action once it learned that West Coast "intended to launch a web site at 'moviebuff.com' containing, *inter alia*, a searchable entertainment database similar to 'Moviebuff.'"[138]

2. *The Findings of the Court Regarding the Use of the "Moviebuff" Trademark*

After ruling in favor of Brookfield on the domain name issue, the court stressed, "The question in the metatags context is quite different.[139] Here, we must determine whether West Coast can use 'MovieBuff' or 'moviebuff.com' in the metatags of its web site at 'westcoastvideo.com' or at any other domain address *other than* 'moviebuff.com' (which we have determined that West Coast may not use)."[140]

The key distinction between use of a trademark in a domain name versus use in metatags is that the use is visible to the consumer when used in domain names, but invisible when used in certain metatags. Therefore, confusion is likely to be significantly reduced in the context of using another's mark in metatags. Additionally, that court stated,

> [W]hen the user inputs "MovieBuff" into an Internet search engine, the list produced by the search engine is likely to include both West Coast's and Brookfield's web sites. Thus, in scanning such list, the Web user will often be able to find the particular web site he is seeking. Moreover, even if the Web user chooses the web site be-

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136. *See Brookfield Communications*, 174 F.3d at 1036.
137. *Id.* at 1041-43.
138. *Id.* at 1042.
139. *Id.* at 1062.
140. *Id.*

longing to West Coast, he will see that the domain name of
the web site he selected is "westcoastvideo.com." Since
there is no confusion resulting from the domain address,
and since West Coast's initial web page prominently dis-
plays its own name, it is difficult to say that a consumer is
likely to be confused about whose site he has reached or to
think that Brookfield somehow sponsors West Coast's web
site.[141]

Although consumer confusion is much less likely in the
context of metatags than domain names, the court held that
West Coast's use of "moviebuff.com" in metatags was unlaw-
ful.[142] To accomplish this result, the court used the initial in-
terest confusion test:

West Coast's use of "moviebuff.com" in metatags will still
result in what is known as initial interest confusion. Web
surfers looking for Brookfield's "MovieBuff" products who
are taken by a search engine to "westcoastvideo.com" will
find a database similar enough to "MovieBuff" such that a
sizeable number of consumers who were originally looking
for Brookfield's product will simply decide to utilize West
Coast's offerings instead. Although there is no source con-
fusion in the sense that consumers know they are visiting
West Coast rather than Brookfield, there is nevertheless
initial interest confusion in the sense that, by using
"moviebuff.com" or "MovieBuff" to divert people looking for
"MovieBuff" to its web site, West Coast improperly bene-
fits from the goodwill that Brookfield developed in its
mark.[143]

3. *The Court's Attempt to Analogize Trademark Use in Metatags to the Traditional Business Setting*

After finding that the "Moviebuff" trademark was in-
fringed when used in West Coast's metatags, the court then
proceeded to analogize such use to a traditional business set-
ting. The court stated,

Using another's trademark in one's metatags is much like
posting a sign with another's trademark in front of one's
store. 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"—where West

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141. *Id.*
142. *See id.*
143. *Id.*

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.

Although the court was aware that customers were not confused about the origin of the goods, it still concluded that initial interest confusion was present and that using another's trademark in metatags enables the misappropriation of another's acquired goodwill.[144]

4. *Ruling in Favor of Brookfield - A Sound Decision?*

Although the court's reasoning has been criticized, the court correctly decided to bar the use of a competitor's trademark in metatags absent fair use. The court's reasoning has generated criticism due to its reliance on the initial interest confusion standard and the analogy it applied.[145] For example, Shannon King argues that initial interest confusion was inappropriately applied because of the unique expectations of Internet consumers.[146] She states that previous "interpretations of initial interest confusion have relied upon the standard expectations of consumers in the physical world."[147] She believes that consumers expect to have some results returned that are irrelevant to the terms inputted into the search engine, thus confusion is minimal.[148] Additionally, she maintains that the court's analogy over-emphasizes the costs involved in getting off at the wrong "cyber-exit" compared with a real highway exit. "It just takes a few mouse clicks and a

144. *See id.* at 1064.
145. *See* Lastowka, *supra* note 51, at 835; *see also* Dan McCuaig, *Halve the Baby: An Obvious Solution to the Troubling Use of Trademarks as Metatags*, 18 J. MARSHALL J. COMPUTER & INFO L. 643 (1999-2000); Shannon King, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 15 BERKELEY TECH. L.J. 313 (2000).
146. King, *supra* note 145, at 325.
147. *Id.*
148. *Id.*

couple of seconds to 'go back' on the Internet."[149]

Although the criticisms may be justified, the *Brookfield* decision is still exceptional. By relying on initial interest confusion, the court found a reasonable means of supporting the finding that use of a competitor's trademark in metatags is infringement, absent fair use. This decision is important because it protects trademark owners in a new advertising medium that to date has not been properly regulated. As technology advances, the improper use of another's trademark will likely be a moot issue such that traditional legal principles will sufficiently protect trademark owners. For example, the system of regulation proposed by this article demonstrates a way of enabling search engines to provide sufficient protection to trademark owners. Therefore, despite the criticisms that the *Brookfield* decision has generated, the court must be applauded for the result achieved.

B.   *Trademark Dilution Through Improper Use in Metatags and Other Portions of the HTML*

In order to make a federal trademark dilution claim, the complainant has the burden of proving that 1) it owns a famous mark, rather than simply holding a registered trademark; and that 2) the infringer's mark dilutes the famous mark. 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 the other parties, or (2) likelihood of confusion, mistake or deception."[150]

Courts have defined dilution as "either the blurring of a mark's product identification or the tarnishment of the affirmative associations a mark has come to convey."[151] Dilution by blurring "is where the infringer diminishes the distinguishing and identifying power of a famous mark by misappropriating the mark."[152] Dilution by tarnishment occurs "when inferior or unwholesome goods or services are linked to a famous mark, and the linking may cause a negative asso-

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149. *Id.*
150. 15 U.S.C. § 1127 (2000).
151. Paylago, *supra* note 125, at 461 (quoting Mead Data Cent., Inc. v. Toyota Motor Sales, U.S.A., 875 F.2d 1026, 1031 (2d Cir. 1989), citing Sally Gee, Inc. v. Myra Hogan, Inc., 699 F.2d 621, 625 (2d Cir. 1983)).
152. *Id.*

ciation with the famous mark."[153] Trademark dilution,

> under 15 U.S.C. section 1125(c), therefore, aims to pre-
> serve the value of a famous mark in its representation of
> the owner's goods or services, and the ability of the mark
> to serve as a unique symbol of the source of the goods or
> services to customers, regardless of competition and cus-
> tomer confusion.[154]

When another's famous mark is placed into the metatags
and other portions of the HTML, both blurring and
tarnishment are possible dangers. "Intuitively, dilution by
tarnishment would seem to be the ideal claim if, for example,
a pornographic site used Walt Disney Co.'s trademarks in its
metatags."[155] However, "a plaintiff may have difficulty prov-
ing the negative association required for dilution by tarnish-
ment."[156] "The user never sees the metatags and knows of the
inadequacies of search engines, making it unlikely that any
association is triggered between the mark and the offending
site so as to tarnish the mark's or its owner's images."[157]

On the other hand, blurring can result because the use of
the famous mark, "within another company's metatags di-
lutes its effectiveness in promoting and marketing the
owner's own products. The unauthorized use of the mark in
meta-tags for the specific purpose of drawing the famous
mark's audience to an unsponsored site dilutes the mark's
distinctiveness and its overall effectiveness."[158]

C. *Fair Use as a Defense*

A defense to both infringement and dilution claims is
that the party fairly used the trademark or famous mark of
another.[159] The assertion "by an alleged infringer that it is
only using the contested term, mark, or designation at issue
in a non-trademark, descriptive sense has become known as

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153. *Id.*

154. *Id.*

155. Maureen O' Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability for Metatagging*, 33 GONZ. L. REV. 277, 301 (1997-1998).

156. *Id.*

157. *Id.* at 301-02.

158. Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 COLUM. J.L. & SOC. PROBS. 439, 501 (2000) (quoting Barbara Anna McCoy, *An Invisible Mark: A Meta-Tag Controversy*, 2 J. SMALL & EMERGING BUS. L. 377, 396 (1998)).

159. *See* 15 U.S.C. § 1115(b)(4)(2000). *See also* 15 U.S.C. § 1125(c)(4)(A)(2000).

the 'fair use' doctrine or defense."[160] A defendant must establish three elements to establish the defense: "1. Defendant's use of the term is not as a trademark or service mark. 2. Defendant uses the term 'fairly and in good faith.' 3. Defendant uses the term 'only to describe' its goods or services."[161]

Shortly after *Brookfield* was decided, the Southern District of California was presented with *Playboy Enterprises, Inc. v. Terri Welles, Inc.*, the second most important case addressing trademark infringement and dilution with regard to search engines.[162] Unlike *Brookfield*, the fair use defense played a major role in the decision of the court in *Playboy Enterprises*.

1.   *The Facts of* Playboy Enterprises, Inc. v. Terri Welles, Inc.

Playboy Enterprises, Inc. ("PEI"), the famous international publishing and entertainment company, "own[ed] federally registered trademarks for the terms *Playboy*, *Playmate*, *Playmate of the Month*, and *Playmate of the Year*."[163] "PEI d[id] not have a federally registered trademark in the abbreviation 'PMOY,' although PEI argued that 'PMOY' [was] worthy of trademark protection because it [was] a well-known abbreviation for the trademark *Playmate of the Year*."[164] According to PEI, "its free Website, http://www.playboy.com, has become one of the most popular sites on the Web and is used to promote its magazine, goods, and services."[165]

"Terri Welles [was] a self-employed model and spokesperson, who began her modeling career with *Playboy* magazine in 1980."[166] In December of 1980, Ms. Welles was featured as "Playmate of the Month."[167] In June of 1981, Ms. Welles received the "Playmate of the Year" award.[168] She also appeared in thirteen issues of *Playboy* magazine and eighteen of

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160. Playboy Enters., Inc. v. Terri Welles, Inc., 78 F. Supp. 2d 1066, 1073 (S.D. Cal. 1999).

161. *Id.* at 1074 (quoting 1 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION, § 11.49 at 94.1 (1999)).

162. *See id.*

163. *Id.* at 1071.

164. *Id.*

165. *Id.*

166. *Id.*

167. *Id.*

168. *Id.*

PEI's newsstand specials.[169] According to Ms. Welles, "since 1980 she always referred to herself as a 'Playmate' or 'Playmate of the Year' with the knowledge of PEI."[170]

On June 29, 1997, Ms. Welles opened a Web site at http://www.terriwelles.com, which included photographs of herself and others, as well as other features that competed with the Playboy site.[171] PEI's protected trademarks appeared in many portions of the visible portions of her site. At the top of her site's pages was an image stating, "Terri Welles— Playmate of the Year 1981."[172] Each page of her site used "PMOY '81" as a repeating watermark in the background. Additionally, there were two advertising banners placed on the pages that were available for visitors to cut and paste onto their own sites. Such banners were intended to bring additional traffic to her site. Both banners contained a seminude picture of Terri Welles and the title of her Web site.[173] One banner displayed the title as "Terri Welles Playboy Playmate of the Year '81," and the other displayed the title as "Playboy Playmate of the Year 1981 Terri Welles."[174] Both images contained Terri Welles' name in a bigger text and a different color than the phrase that included PEI's protected trademarks.[175] Finally, almost all of the pages of her site included the following disclaimer at the bottom of the page: "This site is neither endorsed, nor sponsored by, nor affiliated with Playboy Enterprises, Inc. PLAYBOY, PLAYMATE OF THE YEAR and PLAYMATE OF THE MONTH are registered trademarks of Playboy Enterprises, Inc."[176]

Additionally, PEI's protected trademarks appeared in the invisible portions of the HTML in Terri Welles' Web site.[177] The keywords metatag contained the following words: "terri, welles, playmate, playboy, model, models, semi-nudity, naked, breast, breasts, tit, tits, nipple, nipples, ass, butt."[178] The description metatag was as follows: "Playboy Playmate of the

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169. *See id.*
170. *Id.*
171. *See id.*
172. *See id.*
173. *See id.* at 1077.
174. *See id.*
175. *See id.*
176. *Id.* at 1072.
177. *See id.* at 1091.
178. *Id.*

Year 1981 Terri Welles Website featuring erotic nude photos, semi-nude photos, softcore and exclusive Members Club."[179] There was a link to "www.playboy.com."[180]   Finally, the title tag read "Terri Welles Erotica."[181]

2. *Analyzing the Content of the Welles Web Site to Determine Keyword Content Relevancy*

The only visible use of PEI's trademarks that search engines spiders would detect was the text disclaiming that the site is not associated with PEI.[182]   The disclaimer alone contains the word "Playboy" three times and the word "Playmate" twice. As for the banners, image heading at the top of the page, and repeating watermark background, search engine spiders would not have been able to read the text displayed in them. Spiders can only read the text that it sees in the actual HTML of a Web page.[183]   Text displayed in images does not show up in the HTML and thus is not considered when the spider determines content relevancy of a Web page.[184]

Next, it is necessary to look at the use of PEI's trademarks in the portions of the HTML that are not visible when viewing the Web page. Although most search engines do not consider metatags when determining content relevancy, some do.[185]   The keywords metatag contained the words "Playmate" and "Playboy" as the third and fourth keywords, respectively.[186]   Because they are listed so close to the beginning,

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179. *Id.*

180. *See id.* at 1080.

181. *See id.* at 1091.

182. Although there was a link to the Playboy site, it is unclear whether this link was an image or text. If a site displays, in text, the site "www.playboy.com" and that text links to http://www.playboy.com, then an engine spider counts the word "Playboy" twice.   But if an image is used to link to PEI's Web site, then the spider only sees the word "Playboy" in the text of the HTML code. *See supra* notes 109-11 and accompanying text. For purposes of this analysis, only the HTML that links the text or image to http://www.playboy.com will be counted.

183. "Sometimes sites present large section of copy via graphics. It looks pretty, but search engines can't read those graphics." SULLIVAN, PLACEMENT TIPS, *supra* note 67.

184. *Id.*

185. *See* SEARCHENGINEWATCH.COM, *supra* note 85 (noting that as of July 2, 2001, Inktomi analyzed content in metatags to boost rankings while AltaVista, Excite, FAST, Google and NLight did not).

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

they are more likely to be considered relevant to the site. Additionally, there are only sixteen keywords in the keywords metatag,[187] thus making them even more relevant. In the description tag, the first two words are "Playboy Playmate,"[188] thus spiders may consider them relevant. Finally, the link to http://www.playboy.com includes the word "Playboy" and may increase relevancy towards the keyword "Playboy."

This site would have a small chance, if any, of gaining a high relevancy ranking in those search engines that consider metatags. The words are in both metatags as well as in the visible text of the page. Keywords in metatags that are not also in the text of the page are usually not considered relevant.[189] With respect to those engines that do not consider metatags, the disclaimer being placed at the bottom of the page will likely hurt the chances of high rankings. Keywords at the bottom of the page are usually not as relevant as when presented at the top of the page.[190] Because the words "Playboy" and "Playmate" are very competitive keywords, it is unlikely that the site would have much success with the search engine rankings.

3. The Findings of the Court Regarding the Visible Use of PEI's Trademarks

The court focused on whether Terri Welles fairly used PEI's protected trademarks "Playboy," "Playmate," and "PMOY." To determine if the doctrine of fair use applied, the court looked at the visible use of the trademarks, then looked at the invisible use of such trademarks.[191] Although this article is mainly concerned with initial interest confusion with regard to search engine results and thus the invisible use of another's trademarks, the court's analysis of the visible use of PEI's trademarks is also included because the case demonstrates the relationship between the invisible and visible use of another's trademark.

In applying the fair use doctrine, the court first looked to see if Terri Welles used PEI's trademarks only to describe the

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187. *Id.*
188. *Id.*
189. "[E]ach keyword in your META tags must also appear within your content to avoid spamming penalties." CLAY, *supra* note 31.
190. *See* SULLIVAN, *supra* note 17.
191. *Playboy Enters.*, 78 F. Supp. 2d at 1076-91.

goods or service that she offered.[192] In making its determination, the court stated,

> [I]t is undisputed that the "Playmate" title of a Playmate model is a designation that either has, or is intended to have public recognition.
>
> ... It is equally indisputable that the title has become part of Ms. Welles' identity to the public, in much the same way as her name identifies her to others .... [G]iven that Ms. Welles is the "Playmate of the Year 1981," there is no other way that Ms. Welles can identify or describe herself and her services .... Accordingly, the court finds that the use of the terms "Playmate of the Year 1981," "Playboy Playmate of the Year 1981" and "PMOY '81" in the visible portions of Defendant Welles' Website is descriptive of Ms. Welles; it is her services and goods being described, and the public identifies her by the titles bestowed upon her by PEI.[193]

Next the court looked at whether Terri Welles used PEI's trademarks fairly and in good faith.[194] The court stated,

> [PEI] failed to identify any conduct of Ms. Welles that is sufficiently blameworthy.
>
> ... Ms. Welles provides uncontroverted evidence that she sought to take precautions to ensure that her use of PEI's trademarked terms in her Website was permitted by PEI. ... Ms. Welles ... made changes to her website consisting of: (1) adding disclaimers to the bottom of most pages of her website; (2) including a hyperlink from her website to www.playboy.com; (3) substituting the visual title of "Playboy Playmate of the Year 1981" to "Terri Welles, Playboy Playmate of the Year 1981;" (4) removing the images of three playboy covers; (5) removing any image which PEI contended was a PEI-copyrighted image. ... Finally, the unavailability of other phrases to accurately describe Ms. Welles and her business bolsters the court's finding of good faith. ... Therefore, the court finds that Ms. Welles has established sufficient evidence to show ... PEI's trademarked terms in her visible Website are used fairly and *in good faith* only to describe her goods and services.[195]

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192. *See id.* at 1078.
193. *Id.*
194. *See id.*
195. *Id.* at 1079-80 (quotation marks and citations omitted).

Finally, the court determined whether Terri Welles used PEI's protected trademarks in a way other than as marks. In the Ninth Circuit, "in order to constitute a nontrademark, 'fair use,' the use cannot amount to trademark infringement or unfair competition," and the dispositive issue in making such a determination "is the likelihood of confusion."[196] To determine if there was a likelihood of confusion the court applied the *Sleekcraft* test.[197]

The court found that the "totality of the Sleekcraft factors does not compel a finding of a likelihood of confusion. Plaintiff's mark is strong, the goods are related (online erotica), and the market channels converge . . . . [T]he fact that Plaintiff and Defendant Welles are in competition is not disputed."[198] Additionally, the degree of care one would expect the consumers to have was considered low.[199] On the other hand, the court held that similarity in appearance of the marks weighed heavily in favor of Terri Welles. "Ms. Welles does not use the PEI bunny logo, the PEI bunny theme, PEI trademark fonts, PEI trademark dress, or PEI trademark colors."[200] Additionally, Ms. Welles' and PEI's uses differed in meaning. Ms. Welles used the contested terms in a nontrademark manner to describe herself and not to identify PEI as the source of the goods.[201] Further, there was no evidence of actual confusion presented by PEI.[202] As for the intent of Terri Welles, the court held she had no bad intent based on the same reasons that her use of the trademarks was in good

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196. *Id.* at 1080-81.
197. *Id.* 1082-83. The *Sleekcraft* test, articulated by the Ninth Circuit in *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), includes eight factors that may be considered

> in determining likelihood of confusion: 1) the strength of the mark; 2) proximity or relatedness of the goods; 3) similarity in appearance, sound and meaning of the marks; 4) evidence of actual confusion; 5) degree to which the marketing channels converge; type of good and degree of care customers are likely to exercise in purchasing them; 7) evidence of the intention of defendant in selecting and using the infringing name; 8) likelihood that the parties will expand their product lines.

Playboy Enters., 78 F. Supp. 2d at 1074.
198. *Playboy Enters.*, 78 F. Supp. 2d at 1082.
199. *See id.*
200. *Id.*
201. *See id.* at 1082-83.
202. *See id.* at 1083. The court mentions that no empirical evidence was presented (either anecdotal or survey) to show that there is actual confusion among consumers. *Id.* This suggests that it would be useful to have surveys taken regarding such issues.

faith.

After applying the *Sleekcraft* factors, the court then applied a few additional factors. First, the fact that her site contained the trademarks at the top of the page, which was a commercial setting, didn't strengthen PEI's case, since the use was a non-trademark use.[203] Next, the court looked at stylization and lettering. The court found the use of a different font was evidence of a lack of intent to trick or mislead customers. Additionally, because the images displayed her name in a much bigger font that overlapped the trademark, the court supported a finding of non-trademark use.[204] The court then looked at the repetition of the trademarks and the commercial theme. Again the court held that Terri Welles used the trademarks fairly, for the "terms *describe* her and her goods and services, and they are *not* used to identify her goods with PEI or to identify PEI as the source."[205] The court ultimately held that Terri Welles fairly used the trademarks in the visible portions of her Web site because she had no other way of expressing her title as a Playboy Playmate.[206]

4.   *The Findings of the Court Regarding the Use of PEI's Trademarks in the Metatags*

The court proceeded to examine the use of PEI's trademarks in the metatags. The keywords metatag contained the following keywords: "terri, welles, playmate, playboy, model, models, semi-nudity, naked, breast, breasts, tit, tits, nipple, nipples, ass, butt."[207] The description metatag was as follows: "Playboy Playmate of the Year 1981 Terri Welles website featuring erotic nude photos, semi-nude photos, softcore and exclusive members club."[208]

PEI used the *Brookfield* case to argue that Terri Welles' use of the marks caused likelihood of confusion.[209] While *Brookfield* held that the presence of initial interest confusion may be actionable under the Lanham Act, it did not hold that a showing of initial interest confusion is tantamount to a finding of likelihood confusion. As such, the court disagreed

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203. *See id.* at 1085.
204. *See id.*
205. *Id.* at 1086.
206. *See id.* at 1090.
207. *Id.* at 1091.
208. *Id.*
209. *Id.* at 1092.

with PEI, finding that *Brookfield* was inapposite to Ms. Welles' case.[210] The presence of fair use and the use of trademarks in the metatags, the court explained, distinguished Ms. Welles' case from *Brookfield*.[211]

PEI's sole evidence regarding the initial interest confusion was some circumstantial evidence that many people who plug PEI's trademark terms into their Web browser search engine are probably looking for Playboy's Web site—a point that experts on either side did not dispute.[212] The court stated, "This indicates that there is at least a showing of some 'initial interest confusion.'"[213] Despite this finding, the court held that *Brookfield* in no way limited one's "right to use terms in a manner that would constitute fair use under the Lanham Act."[214]

PEI did not offer any facts to merit a consideration of other factors, derived from cases other than *Brookfield*, that might have shown a likelihood of confusion.[215] These factors included evidence of the initial interest as being "damaging or wrongful;" evidence that confusion between two products "will mistakenly lead the consumer to believe there is some confusion between two and therefore develop an interest in the [defendant's] line that it would otherwise not have"; and evidence that the "situation offer[ed] an opportunity for sale not otherwise available by enabling defendant to interest prospective customers by confusion with the plaintiff's product."[216] Without much discussion, the court concluded that PEI failed to present any facts satisfying the factors above. Among other things, PEI was unable to prove that any part of Ms. Welles' business derived from the confusion that led unaware users to her Web site, or that a majority of users typing in one of PEI's marks was searching for Playboy's official site.[217] The court was also influenced by the lack of evidence of an intent of Ms. Welles to trade-in on PEI's goodwill.[218]

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210. *Id.*
211. *Id.*
212. *Id.* at 1094.
213. *Id.*
214. *Id.*
215. *Id.*
216. *Id.*
217. *Id.* at 1094-95 (alteration in original).
218. *Id.* at 1095.

5. *The Court's Finding on the Issue of Trademark Dilution*

In deciding whether Terri Welles' use of PEI's trademarks diluted the PEI trademarks, the court made quick disposal of the issue. In concluding that Terri Welles' use of PEI's trademarks did not constitute dilution as a matter of law, the court stated that

> Ms. Welles' use of the terms "Playboy Playmate of the Year 1981," "Playmate of the Year 1981," and "PMOY '81" in her website constitute identification of herself: a nominative fair use. The use of those terms in the visible portion of her website and the terms, "Playboy Playmate of the Year 1981," "Playboy," and "Playmate," in the meta tags, allows web surfers and potential customers correctly to identify her site and locate her services. In cases where the trademarked term must be used to identify the individual or a good, infringement and dilution laws do not apply.[219]

The court continued by ruling that Terri Welles was also entitled to the "fair use" defense.[220]

6. *Problematic Implications of the Court's Decision*

Overall, the decision by the court is sound. Terri Welles earned the distinction of having appeared in many issues of Playboy Magazine and being named "Playmate of the Month," as well as "Playmate of the Year." Judge Keep correctly ruled that Terri Welles earned the rights to be addressed as such. Moreover, Terri Welles has no way of commercially exploiting her achievements if she is not entitled to use the descriptions bestowed upon her by PEI. There is no doubt that she should be entitled to use the titles on her Web page.

Notwithstanding the above, some disturbing ramifications of the decision need to be addressed. First, the decision practically places Terri Welles in the same position as PEI with regard to the rights to obtain top search engine rankings for the keywords "Playboy" and "Playmate." Terri Welles comprises only a small piece of the success of PEI; therefore, one can question the court granting Welles tremendous rights with regard to using PEI's protected trademarks for search engine rankings.

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219. *Id.* at 1096.
220. *Id.*

The court also seems to place undue emphasis on the fact that Welles' site disclaimed that the site is not affiliated with PEI.[221] While correct in its belief that such disclaimers alleviate consumer confusion, the court does not address three particularly troubling issues regarding such disclaimers. First, the court stated that there were disclaimers at the bottom of most of the pages.[222] However, the court did not pay attention to the placement of the disclaimers. Certainly the effectiveness of a disclaimer is greatly controlled by its location on the page. If the disclaimer cannot be seen without scrolling, then its effectiveness is decreased. Second, the court was not disturbed by the fact that the disclaimer was not on all of the pages of Welles' site.[223] This is important with regard to search engine rankings because sometimes a page other than the home page achieves high rankings. Thus, if one of the pages without the disclaimer were to achieve high rankings, such disclaimers may not be effective. Although it is possible that a Web surfer will see the disclaimer on another page, such a supposition places an element of chance into the equation. Finally, and most importantly, the fact that a disclaimer shows a lack of intent to confuse provides the savvy designer with a vehicle to achieve high rankings in search engines while protecting himself. Many search engines consider the text at the top of the page, as well as other portions of the page, to be highly relevant for determining actual content relevancy.[224] Thus, the addition of disclaimers can be a double-edged sword against the trademark holder because their inclusion can allow a court to infer good faith and allow the competitor to achieve high rankings.

7. *The Solution to the Troubling Disclaimer Issue*

Suppose that a site designer purchased the rights to use photographs of a former Playboy Playmate. In his Web site, he says that he has pictures of the Playmate. At the top of each page he has the following disclaimer, "This site is neither endorsed, nor sponsored by, nor affiliated with Playboy Enterprises, Inc. PLAYBOY, PLAYMATE OF THE YEAR

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221. *See id.* at 1080 (noting that Welles added "disclaimers to the bottom of most pages of her website").
222. *Id.*
223. *See id.*
224. *See* SULLIVAN, *supra* note 17.

and PLAYMATE OF THE MONTH are registered trade-
marks of Playboy Enterprises, Inc." At the bottom of his site
he has the same disclaimer typed out once again. He does not
have the word "Playboy Playmate" in his metatags or any
other portion of the HTML. Thus, the fact that he is using
the disclaimer provides the appearance that he is really not
trying to take advantage of Playboy's goodwill. However, it is
possible that he is. Because of the addition of the disclaimers,
his site is more likely to gain high relevancy rankings with
search engines for the keywords "Playboy" and "Playmate."
Thus, if the disclaimers were removed, his site would likely
have very little or no success in the search engines.

Disclaimers should be allowed, but play no part in de-
termining content relevancy with regard to search engine re-
sults. Of course, disclaimers are important to reduce the
likelihood of confusion regarding affiliation with a trademark
owner.[225] However, saying one is not affiliated with a trade-
mark owner does not mean the site is relevant for searches
using the trademark owner's marks.

A solution to this problem is to require all disclaimers to
be in the form of images.[226] If a disclaimer is placed on an im-
age, the search engine spider will not be able to read such
text.[227] This means that the text in the disclaimer will not get
credit when the search engine spider visits the Web page to
determine content relevancy.[228]

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225. "Disclaimers are a favored way of alleviating consumer confusion as a
source of sponsorship." *Playboy Enterprises*, 78 F. Supp. 2d at 1080 n.9 (quoting
Consumers Union of U.S. v. Gen. Signal Corp., 724 F.2d 1044, 1053 (2d Cir.
1983)).

226. It should be noted that the use of comparisons should not be held to the
same standard as disclaimers. Comparisons are quite useful and are often the
subject matter that the Web surfer is seeking. Truthful comparisons would not
likely run afoul of the Lanham Act since "when the mark is used in a way that
does not deceive the public [there is] no such sanctity in the word as to prevent
its being used to tell the truth. It is not taboo." Prestonettes, Inc. v. Coty, 264
U.S. 359, 368 (1924). Thus, comparisons should not be required to take the
form of images.

227. *See* SULLIVAN, PLACEMENT TIPS, *supra* note 67.

228. *See Id.*

XI. A SYSTEM OF REGULATING SEARCH ENGINE RESULTS
THAT ADEQUATELY BALANCES THE INTERESTS OF
TRADEMARK OWNERS, THEIR COMPETITORS, CONSUMERS,
THE SEARCH ENGINES, AND THE COURTS

Because of the unique qualities of the Internet, some-
times the traditional legal principles are not well suited to
provide proper regulation.[229] Protecting trademark owners
from having their goodwill used against them with regard to
search engine rankings is a perfect example. However, a sys-
tem of regulation can be implemented that would balance the
interests of the trademark owner, their competitors, the
search engines, the consumer, and the courts.

A. *A Hypothetical That Demonstrates One of the Most
Deceptive and Undetectable Uses of a Competitor's
Trademark to Achieve High Rankings in Search Engines
for Such Trademark*

Suppose you work for a hotel and are responsible for pur-
chasing recording equipment, lecterns, podiums, tables, and
other related items when needed. The hotel has a large
meeting scheduled that will require all of the meeting rooms
to be used concurrently. You notice that you need a couple
more lecterns because some of them are too beat up to use for
the meetings. You want to order them from San Diego Plas-
tics, for they were recommended to you as being the best in
the business. You get online, open your browser, and type in
the address http://www.sandiegoplastics.com, but there is no
such site. Next, you type in the address of your favorite
search engine. In the search field, you enter the keywords
"San Diego Plastics," then submit the query. The search en-
gine displays the ten most relevant results for such keywords.
The first, third and fifth results are linked to various Web
addresses in which the description states "high quality lec-
terns for half the price." The second result is linked to the
Web site of a plastic surgeon located in San Diego. The fourth

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229. See King, *supra* note 145, at 325, explaining that
traditionally trademark law has protected against consumer confusion
by barring the use of visibly infringing marks. This presents a problem
when courts adapt trademark law to protect trademarks in metatags
because these trademarks are not visible to the user. The Ninth Cir-
cuit attempted to avoid this problem by applying the theory of initial
interest confusion to metatag use, but that application is not appropri-
ate.

result is linked to a plastics manufacturer located in San Diego. Finally, the sixth result is the San Diego Plastics Web site located at http://www.san-diego-plastics.com.

Because you are curious as to why the other sites about lecterns are coming up before the San Diego Plastics site, you visit the three sites. After entering each of the three sites, you notice they all have a few things in common. First, they all contain identical content and their only difference is that they are linked to a different domain name address. Second, you notice that they do not contain the keywords "San Diego Plastics" anywhere in the content of the pages. Finally, you cannot find the keywords "San Diego Plastics" in the meta-tags, title tag, comment tags, or any other portion of the HTML coding.

If the keywords "San Diego Plastics" do not appear in any portion of the HTML of the three Web sites, then how did they get ranked above the San Diego Plastics Web site? One possibility is that they used the bait and switch method of obtaining high search engine rankings discussed above.[230] Because the bait and switch method is difficult to detect, it may be the most deceptive known practice of obtaining high search engine rankings. Thus, it is important to consider such a practice when making a determination of which system of regulation is appropriate. A system of regulation that minimizes the dangers involved with the bait and switch method may best suit the needs of trademark holders.

B. An Analysis of Some of the Solutions Proposed in the Most Recent Law Review Articles

The following presents solutions proposed in three of the most recent law review articles regarding trademark protection in search engine results.

1. Search Engines, HTML, and Trademarks: What's the Meta For?

F. Gregory Lastowka takes the position that competitor use of trademarks in metatags should be allowed.[231] Although there are probably some people who would agree with him, such a position completely ignores the tremendous value of

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230. *See supra* Part IX.J.
231. Lastowka, *supra* note 51.

goodwill. In developing his position, Lastowka uses Adidas and Nike as an example. Suppose that Adidas includes the trade name Nike in its metatags such that a search for Nike also returned the Adidas Web site.[232] Lastowka states, "While this may at first seem unethical, closer examination argues that this practice neither harms the public, nor demonstrates bad intent on the part of Adidas."[233]

In support of his position, Lastowka provides four reasons. First,

> in terms of the public harm, there is little likelihood of confusion (or at least little likelihood of any *additional* confusion) created by the mere fact that a product produced by someone other than Nike, Inc. shows up in a search for Nike . . . the addition of the Adidas site to the Nike bin is probably more helpful to the user who is searching for sneakers than are most other sites listed . . . . A person who would use a search engine to look for Nike sneakers may appreciate the opportunity to comparison shop.[234]

Although it seems clear that Lastowka is correct in stating that there is little likelihood of confusion, it is not so clear that consumers are going to be pleased to be presented with a group of Nike's competitors when searching for Nike. For example, when someone types in "Nike shoes," he is likely to be looking for sites with Nike shoes, namely a page within the Nike site or an authorized vendor of Nike shoes. In other words, he is using the search engine analogously to the white pages. If someone were interested in having many choices, he would use the search engine like he uses the yellow pages and perform a general search for "athletic shoes." Additionally, if competitors were allowed to use the trade name of another, there would be no guarantee that Nike would even come up in the top ten results of the search engines.

Second, Lastowka states, "[T]here is no pagejacking or counterfeiting concern, because the Adidas site can be easily identified by its product label (title and description tags) as being affiliated with Adidas and not Nike."[235] Although he is correct, this does nothing more than support his argument

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232. *See id.* at 876.
233. *Id.* at 876.
234. *Id.* at 876-77.
235. *Id.* at 877.

that there is little likelihood of confusion.

Third, Lastowka states that "First Amendment consid-
erations support the policy of allowing sites to use competitor
meta tags since these sites merely request that search en-
gines index them under certain terms. Search engines are
free to ignore this request or give it slight value."[236]

A reply to Lastowka is that First Amendment freedom is
not absolute; trademark law itself is a restriction of free
speech. "Free speech rights do not extend to labeling or other
advertising products in a manner that conflicts with trade-
mark rights of others."[237] Additionally, the use of "another's
trademark is entitled to protection only when the mark is
part of a communicative message, not when it is used merely
to identify the source of a product."[238] Since most metatags,
particularly the keywords metatag, are only intended to be
read by the search engines and are invisible to web users, it is
clear that their purpose is not communicative. Thus banning
unfair trademark use in metatags does not restrict free
speech. Such a ban merely strikes a balance between First
Amendment freedoms and trademark principles.[239]

Finally, Lastowka states that

> allowing competitor use of meta tags merely attempts to
> recreate some of the spatial realities of the marketplace.
> In real space, consumers are often introduced to compet-
> ing goods when searching for a particular brand due to the
> fact that stores typically place competing goods in spatial
> proximity. Competitor meta tag use simply fosters compe-
> tition through providing consumers with more choices.[240]

Again, Lastowka does not give thought to the yel-
low/white pages analogy, which is probably the best analogy
for search engines and directories. Simply because brick and
mortar stores present similar products next to each other
does not mean that this model should be used regarding
product searches on the Internet. This model ignores the
ability of search engines to provide precise searches. In cy-
berspace, a consumer often searches for a particular product.
Thrusting a brick and mortar analogy on this endeavor frus-

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236. *Id.*
237. OBH v. Spotlight Magazine, 86 F. Supp. 2d 176, 198 (W.D.N.Y. 2000).
238. *Id.* at 197.
239. A fair use like accurate product comparison would not be banned. *See
supra* note 226 and accompanying text.
240. Lastowka, *supra* note 51, at 877.

trates the promise of the Internet. Why would one want to sift through competing brands when he knows what he wants? Further, when one shops at K-Mart, it is highly unlikely that the store will be in the same shopping center as all of its competitors. He wants to go to K-Mart, so he drives there. However, if he wants to shop at K-Mart on the Internet and types "K-Mart" into a search engine, competitors' sites will come up if they are allowed to use the trademarked name "K-Mart" in the metatags of their sites. Although Lastowka is correct in stating that there is a small likelihood of confusion, absence of such confusion does not mean that trademark owners should risk having the goodwill of their trademark tarnished through infringement in the context of search engine results. Therefore, the option of regulating should be considered a viable option when not doing so completely fails to account for the value of goodwill.

2.   Brookfield Communications, Inc. v. West Coast Entertainment Corp.

Shannon N. King takes a similar position to that of Lastowka. She believes that

> Unauthorized use of trademarks in metatags may seem wrong, but it should not be actionable under the Lanham Act. A better solution exists—allowing market forces to pressure search engines to change searching and ranking algorithms. Market theory suggests that search engine providers would be wise to exclude metatags from being included in ranking algorithms in order to provide the most relevant hits to the consumer.[241]

Although King in essence agrees with Lastowka, her view does not completely ignore the value of goodwill. Instead, she believes that the burden of regulating search engine results should be placed solely on the search engines.[242] In support of her view, she states "[o]f the big eight search engine providers—Yahoo!, Excite, WebCrawler (owned by Excite), Info-Seek, Lycos, HotBot (owned by Lycos), and AltaVista—only InfoSeek and Lycos (and therefore HotBot) allow metatags to boost ranking."[243] Further, she states Yahoo "does not employ spiders to catalog information and thus does not use metatag

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241. King, *supra* note 145, at 327.
242. *See id.*
243. *Id.*

information."[244]   Finally, she states "self-regulation by the Internet community is plausible, possible, and preferable to judicial solutions given both the speed at which potentially infringing technology changes and the notable lack of speed at which an overloaded federal judiciary is able to hear and decide cases."[245]

While King makes several astute observations, it may not be wise to place all of the responsibility on the search engines. In support of her position, King argues that, due to importance of metatags, some of the major search engines have stopped using metatags and others have "switched in response to coders embedding multiple instances of keywords."[246] It is clear that the quest for more accurate results and making customers happy has led many search engines to take such actions. However, it is not so clear that the search engines did so as a response to combat trademark violations specifically, nor does King cite any evidence that would support such a proposition. The more likely reason that search engines are making such changes is simply accuracy of results in general, which incidentally includes trademarks.

To demonstrate, suppose that one performed a search for the keyword "lecterns" in hopes of obtaining a lectern manufacturer. Instead of getting the top ten most relevant Web sites for lecterns, two of the top ten sites may be completely irrelevant other than the fact that they include the word "lecterns" in their metatags. The problem is that it is easy to add irrelevant words to metatags, particularly the keywords metatag, since the user does not see them. Thus, adding many irrelevant words to the "keywords" metatag results in no harm. Rather, it may bring a customer who was looking for something else to their site.

Although the absence of metatags may enhance the accuracy of search results, trademark violations are still easy to commit. The site designer will simply place the competitor's trademarks in the area that the search engine does check. Further, the bait and switch method is still just as easy as before to employ. Eliminating metatags may provide some trademark protection in that it may force violations to become more visible. However, more steps than simply eliminating

244. *Id.* at 328.
245. *Id.* at 329.
246. *Id.* at 327.

metatags must be taken to sufficiently protect owners.

Moreover, although search engines are interested in making their engines more accurate, they may not have enough pressure on them or incentive to make the necessary changes with regard to trademark violations. The infringer, rather than the search engine, employs the deceptive practices to steal a competitor's trademark. Hence, the trademark owner pursues a claim against the infringer, and not the search engine. Additionally. it is important to realize that there are more than one thousand search engines to which companies submit their Web sites, making it difficult to ensure that many of the search engines will take the necessary steps to prevent trademark violations.

3. *A Partial Solution to the Troubling Use of Trademarks as Metatags*

Dan McCuaig proposes a very interesting solution to the problem of competitor use of trademarks in metatags. He believes that the "utilization of a 'Trademarks' metatag to complement the established 'Keywords' metatag would allow the source-identification purpose of trademarks as metatags to be separated from their functional descriptive purpose."[247]

For example, suppose a Web surfer used the search term "Playboy" to find the official site and another Web surfer used the same term to find images of nude women.

> Adding a "Trademarks" metatag to complement the "Keywords" metatag would allow both sets of web surfers to find their intended sites. For example, after entering "Playboy" into her favorite search engine, the surfer would then have the option of checking the search engine's "Trademarks Only" box before submitting her query request, and thus being fairly certain that [her] results list would contain only links to PEI's official site(s), or leaving the box unchecked and thus availing herself to a much larger results list that would contain non-PEI sites that wished to be considered by surfers who searched for "Playboy" not as a trademark, but as a descriptor.
>
> As a means for encouraging compliance with this new standard, either Congress could create a cause of action for any company whose trademarked terms are used as "Trademarks" metatags in sites whose owners do not also

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hold rights in those terms, or courts could evaluate the ac-
tions of alleged trademark misusers in light of whether
the appropriated terms were listed as "Keywords" meta-
tags or "Trademarks" metatags, with a much harsher test
presented to defendants who listed others' trademarked
terms in their "Trademarks" section.[248]

Additionally, McCuaig states that the trademark owner
would be the only one who could use the trademark tag, thus
the trademark owner would not be permitted to license the
use of its trademark.[249] Finally, he proposes that "[t]he plac-
ing of a term in the 'Trademarks' metatags section of the web
site would present dispositive evidence that that the site
owner meant to use the term *as a trademark*."[250]

McCuaig's proposed solution provides some innovative
suggestions. However, it still requires regulation. One must
detect the unfair use of the "Trademarks" metatag; thus, the
system requires constant regulation. Additionally, the solu-
tion remains susceptible to the bait and switch technique.
For example, suppose the trademarks of another are used in
the "Trademarks" metatag. Once the search engine indexes
the page, the trademark can be removed from the "Trade-
marks" metatag and detection would be all but impossible.
Further, the fact that there are so many different top-level
domain names makes the system very difficult to regulate.

C. *Defining the Ultimate System of Regulation - Balancing*
    the Interests of the Trademark Owners, Their
    Competitors, the Search Engines, the Consumer, and the
    Courts

This section will discuss three systems of regulating
search engine results that could be used to provide trademark
owners with sufficient protection in search engine results.
First, it will involve a discussion regarding the benefits of
adding a new top-level domain name exclusively for trade-
marks. Second, it will discuss the addition of a "Trademarks"
metatag. Finally, the section will discuss how the combina-
tion of a new top-level domain name and a "Trademarks"
metatag create a superior system of regulation.

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248. *Id.* at 683 (footnote omitted).
249. *Id.* at 685.
250. *Id.* at 686.

1. *The Benefits of a New Top-Level Domain Name for*
    Trademark Owners

The time for a new TLD has come. A standardized sys-
tem of regulating trademarks in search engine results could
prove to be necessary, and a new TLD can help a great deal.
As new TLDs are created, the difficulties for search engines
increase. For example, the search engines must account for
trademarks in numerous TLDs such as .com, .org, .net, .tv,
.cc, .ws, as well as many others. Search engines would have a
difficult task in developing a system of regulation that could
protect the goodwill of trademark owners. However, if a new
TLD such as .tm were issued, the difficulties for the search
engines to develop such a system would be sufficiently mini-
mized.

Suppose there was a standardized way to guarantee that
when a Web surfer performs a search in a search engine us-
ing a trademark as the search term, the trademark owner's
Web site was the first result returned. Would this be enough
trademark protection such that it would be acceptable for a
competitor of the trademark holder to be the second result
listed? The addition of a .tm TLD in itself could provide such
protection. It would work by providing all trademark owners
with the rights to the .tm for such trademark.

For example, Playboy Enterprises, Inc. ("PEI"), would
have the rights to http://www.playboy.tm,
http://www.playboy-playmates.tm, http://www.pei.tm,
http://www.playmate-of-the-year.tm, http://www.playmate-of-
the-month.tm. The relevance of having the rights to the .tm,
would be that whenever a search is performed in the search
engines for a trademark, the .tm would be the first result re-
turned. To illustrate, if someone typed in the words "Playboy
Playmates" into the search field, the search engine would first
look through its .tm pages for a match.[251] Because Playboy
Playmate is a match with one of Playboy's trademarks, the
site located at http://www.playboy-playmates.tm would be the
first result presented by the search engine. Suppose someone
typed the trademark "Playmate of the Month" into the search
field. The search engine would look through the .tm pages. It

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251. The domain names would be the same as keywords such that all indi-
vidual words would be spaced with a dash. For example: http://www.playboy-
playmate.tm would include the keywords playboy and playmate;
www.playboyplaymate.tm would be one keyword.

would find the address www.playmate-of-the-month.tm and present the site as the number one result. Next, suppose that the search terms were "Playboy Playmates and nude women." The search engine would search for the .tm that matched the terms and once it didn't find an exact match, the results would be listed without the preference for any .tm pages. Finally, suppose the search term was a generic term such as "lecterns." The search engine could search for the .tm that matched the term and if it didn't find an exact match, the results would again be listed without the preference for any .tm pages. Thus, one would not be able to establish a monopoly over a generic term.[252]

The benefit is that the .tm TLD allows trademark owners to receive top priority when a Web surfer searches for their trademark. No other site could achieve a higher ranking when the trademark is used as a search term. Moreover, it would require no effort to guarantee that the trademark holder's site is the number one result for he is the only one with the .tm for that trademark. Also, the bait and switch technique of achieving high rankings would never allow the baiter to achieve the top result. Although the addition of the .tm TLD could allow for standardized prioritization with regards to the top result, it is important to consider whether that is enough protection. The answer to this question is determined by how the search engine is defined. For example, if it is defined as being analogous to a store, then a guarantee of obtaining the top result will be enough, especially in light of the fact that the trademark owner could also submit its other sites to the search engines. Thus, if it is sufficient to have a system of regulation that enables the trademark holder to always achieve the top spot when its trademark is used as a search term, then implementing a new .tm TLD would end the matter. Finally, it is important to realize that a .tm TLD could also be implemented simply to provide the search engines with a great tool that enables them to develop their own system of regulating search engine results. It would be very easy to design a system of regulation based on keywords in a domain name if engines could search through a single list of only trademarks.

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252. Note that if the .com domain name were used, generic terms could be used as trademarks. The reason is that generic terms have been distributed and are currently being used.

2. *The Benefits of a "Trademarks" Metatag*

Another option would be to require the addition of a "Trademarks" metatag as proposed by Dan McQuaig.[253] The addition of the "Trademarks" metatag would allow a trademark owner to list all of his trademarks in the "Trademarks" metatag. Additionally, the search engine would contain a box that when checked by the Web surfer indicates to the search engine spider that the Web surfer is interested in all of a particular trademark owner's marks.

To illustrate, suppose that a Web surfer is interested in seeing nude playmates, and types in "Playboy Playmates." He is not interested in all of the PEI Web sites. Instead he only wants to see Playboy Playmates, whether from a site sponsored by PEI, or a site sponsored by someone else such as Terri Welles. He would not check the search engine's trademark box, consequently the PEI trademarks would not dominate the search engine results. If he wanted all of PEI's sites listed at the top of the search results, he would simply check the box.

Although the "Trademarks" metatag, as proposed by Dan McQuaig, is a useful idea, it alone cannot sufficiently protect trademark owners' rights. First, anyone could still use the "Trademarks" metatag in hopes of not getting caught. Including another's trademark in the "Trademarks" metatag could lead to a cause of action, and such use would be dispositive evidence that the site owner meant to use the term as a trademark. Courts would likely have to spend valuable time in enforcing the rights of trademark owners. Second, the "Trademarks" metatag does not protect trademark holders from the deceptive bait and switch technique. One could use the "Trademarks" metatag to achieve high rankings and then remove the "Trademarks" metatag once the site achieves high rankings for such trademark. Although imperfect, the "Trademarks" metatag does provide options. In fact, when combined with a .tm TLD, a very impressive system of self-regulation can be achieved.

3. *The Ultimate System of Regulation*

The ultimate system of regulating search engine results would accomplish a number of important goals. First, it

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253. McCuaig, *supra* note 145, at 682.

would deter the use of a competitor's trademark to achieve high rankings for such trademark. Second, it would require very little monitoring. Finally, it would balance the interests of trademark owners, their competitors, the consumer, the search engines, and the courts. The following will carefully explain how the implementation of a .tm TLD coupled with a "Trademarks" metatag creates a system of regulation that could accomplish such goals.

Assume that a new TLD, .tm, as well as a new metatag called the "Trademarks" metatag were both implemented. Additionally, assume that the search engines placed a box next to the search field that when checked, told the search engine spider that the user wants a listing of the trademark owner's sites.

All trademark owners would be given the right to use the .tm for any of their trademarks; however, they would not be able to assign the rights to use them. For example, Playboy Enterprises, Inc. ("PEI"), would have the rights to www.playboy.tm, www.playboy-playmates.tm, www.pei.tm, www.playmate-of-the-year.tm,   www.playmate-of-the-month.tm. Additionally, because PEI is a trademark owner, PEI would have the right to use a "Trademarks" metatag. For example, PEI could place the following "Trademarks" metatag on their .tm Web sites:

> **<meta**   **name**="Trademarks"   **con-tent**="PEI,Playboy,Playmates,   Playboy   Play-mates,Playmate of the Year,Playmate of the Month,etc.">

Search engines would only recognize the "Trademarks" metatag when the metatag was placed on a .tm site. So, if Playboy included the "Trademarks" metatag on the pages within their site at http://www.playboy.com, the search engine spider would not even see the "Trademarks" metatag. The spider would see the metatag only on those pages within their .tm sites. This is a very important part of the system of regulation, for without this aspect, a trademark owner could place a competitor's trademark in their "Trademarks" metatag and achieve high rankings for searches using his competitor's trademark.

So how would it work? If all of a trademark owner's marks were placed into the "Trademarks" metatag, then a search for one of the trademarks would return all of the trademarks in the "Trademarks" metatag when the box is

checked.[254]   The search engine would only have to look
through the .tm TLD for matches rather than having to look
for matches in the many other TLD's such as .com, .tv, .net,
.org, .ws or .biz. Additionally, the regulation would require
the site owner to actually own the trademark. When the box
is checked, and a site owner does not own the trademark, the
site will not come up in the results for a search using such
trademark.

The best part of this system of regulation is that it actu-
ally deters the inclusion of another's trademark in the
"Trademarks" metatag. When someone types in a search and
checks the box, the search engine spider will first look to see
if there is a match with the trademark that was used as a
search term. When the spider locates the trademark, it will
read the "trademarks" metatag on the site that matched the
query. The results that the spider would display would be all
of the .tm sites that are listed in the "Trademarks" metatag.
The key is that the spider does not simply look for any .tm
site that contains the search term in their "Trademarks"
metatag. It only looks at the "Trademarks" metatag of the
.tm site that matched the query. Thus, inclusion of a com-
petitor's trademark will do no good, for the spider will never
even see it when the competitor's trademark is used as a
search term.

How does this deter inclusion? Suppose that Penthouse
Magazine owned six trademarks having rights to six different
.tm sites. If Penthouse put its six protected trademarks in
the "Trademarks" metatag of each of its .tm sites, then a
search for any of its trademarks when the box is checked
would result in all six of its .tm pages being displayed. Sup-
pose that Penthouse wanted to try to grab some of PEI's cus-
tomers and so it included the word "Playboy" in their

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254. An alternative to the box that indicates the desire for only sites from the
trademark owner would limit the "Trademarks" metatag to include only three of
a trademark owner's trademarks. Instead of giving the option for trademark
owners to dominate the results, it would allow the trademark owner to have the
first three or four results whenever a search is conducted that matched one of
their trademarks. For example, suppose that someone typed in "PEI." The
search engine would see that there is a trademark that matches, thus the spider
would read the "Trademarks" metatag at www.pei.tm. Included in the results
would be up to three additional .tm sites owned by PEI. This would allow PEI
to pick from its numerous trademarks and group three or four together that are
similar and would attract the same audience. It also provides the competitors
with the chance to obtain all the results after the top four.

"Trademarks" metatag. As previously shown, the search engine, in a search for "Playboy," would not even see the inclusion of Playboy in Penthouse's "Trademarks" metatag, since the only "Trademarks" metatag that the search engine will look at is the one located at www.playboy.tm. However, the fact that Penthouse included the term "Playboy" in its "Trademarks" metatag will bring up the site www.playboy.tm whenever one of Penthouse's trademarks is used as a search term. This occurs because the search engine spider will display all .tm sites listed in the "Trademarks" metatag of the .tm site that matched the query. To reiterate, if the Web surfer searched for "Penthouse" and checked the box, the search engine spider would look for "Penthouse" in its .tm directory and once it found www.penthouse.tm, it would read the "Trademarks" metatag located at www.penthouse.tm. The spider would not look at the "Trademarks" metatag of any other site. Thus, the inclusion of "Playboy" in Penthouse's "Trademarks" metatag would also list www.playboy.tm in the search results for a query using the search term "Penthouse."

Under this system a trademark owner who improperly includes another's trademark in their "Trademarks" metatag does not receive any benefits from such deception. Rather, the violator will be penalized. Inclusion of a competitor's trademark in a "Trademarks" metatag will only help the competitor, for now the competitor's site is displayed whenever the violator's trademarks are used as search terms.

As previously mentioned, if both the "Trademarks" metatag and the new .tm TLD were implemented, it would allow a system of regulation to exist that balances the interests of trademark owners, their competitors, the consumer, the search engines, and the courts. The interests of trademark owners are served, for the system would not allow a competitor to reap the benefits of the goodwill associated with such trademark. The interests of the trademark owner's competitors are served because the Web surfer would be given the option of checking the box to indicate that he wants the trademark owner's sites. The competitor would be permitted to fairly use the trademarks of another by way of comparisons or other fair uses. The interests of the consumers are served because they will have the choice of checking or not checking the box. Thus, they will obtain the results that they are in-

terested in and the likelihood of confusion all but disappears. The interests of the search engines are also served for they are provided with a .tm TLD that enables them to easily regulate searches for trademarks. Additionally, search engines will be more user-friendly and accurate from the consumer's point of view. Finally, the interest of the courts is served because the standardized system of regulation actually self-regulates such that the inclusion of another's trademark in the "Trademarks" metatag only penalizes the violator. Thus, the need for court action will be minimal.

XII. CONCLUSION

Goodwill is one of the most valuable business assets. Thus, it is essential that the proper steps be taken to protect trademark owners from having their goodwill unfairly used in the context of search engine rankings. The recent court decisions agree with such a conclusion; however, the search engines are only in the beginning stages of creating a system of regulating search engine results such that trademark owners are sufficiently protected. Because there is currently no standardized system of regulating the more than one thousand search engines in existence, a great amount of monitoring is required to detect infringing uses of a competitor's trademark. Thus, there is potential for a large amount of litigation, or in the alternative, insufficient protection for trademark owners. Additionally, as the number of sites on the Internet continues to increase, the problem could worsen, since many new businesses will have nothing to lose and everything to gain by using a competitor's trademark in the HTML tags of their Web pages.

Market forces may play a role in prohibiting the use of a competitor's trademark to achieve high rankings for such trademark. However, before market forces are given complete control to deal with the matter, it is recommended that lawmakers consider the available alternatives. In considering the alternatives, it is very important to understand the standardized system of regulation introduced in this article, namely the implementation of a new .tm TLD name and a "Trademarks" metatag.

The benefits of implementing a .tm TLD and a "Trademarks" metatag are numerous. First, their implementation would allow the existence of a system of regulation that actu-

ally deters the use of a competitor's trademark. Second, it would create a system of regulation that requires very little monitoring and the bulk of issues dealing with trademark infringement and dilution could be avoided. Further, those issues that are not avoided by the their implementation, could likely be handled by market forces. Finally, implementation of the "Trademarks" metatag and the .tm TLD would allow a system of regulation to exist that balances the interests of trademark owners, their competitors, the consumer, the search engines, and the courts.

APPENDIX

\<html\>
\<head\>
\<title\>Lecterns-Podiums for very reasonable prices!**\</title\>**
\<meta name="description" **content**="Lecterns-Podiums for meeting rooms, schools, restaurants. Lecterns and podiums don't get better than this!"\>
\<meta name="keywords" **content**="lecterns, podiums, Convention Centers, Restaurants, Colleges, Sound Systems, University, Meeting Rooms, Hotel, audio"\>
\</head\>

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\<p align="center"\>**\<img src**="Lecterns-Podiums-Logo.jpg" **alt**="Lecterns and Podiums for prices worth bragging about. Check out our beautiful solid wood lecterns and podiums now!" **width**="530" **height**="133"\>**\</p\>**

\<h2 align="center"\>**\<u\>\Lecterns and Podiums of the Highest Quality.**\</font\>\</u\>\</h2\>**

\<p align="center"\>
\<img border="0" **src**="left-lectern.jpg" **alt**="Lecterns and Table Top Podiums for the professional speaker." **width**="92" **height**="152"\>;
\<img border="0" **src**="middle-podium.jpg" **alt**="A picture of perfection. Our beautiful table top podiums will look good on any table top." **width**="173" **height**="143"\>;
\<img border="0" **src**="right-lectern.jpg" **alt**="Top quality lecterns and podiums. Well priced lecterns and podiums

suited for meeting rooms, convention center, universities, churches and more!" **width="105" height="158">**
</p>

<!— Lecterns, podiums, and sound systems supplied to convention centers and hotels. **—>**

<p align="center">**Well priced lecterns and podiums suited for meeting rooms, convention centers, hotels, restaurants, universities and much more!**</p>**

<p align="center">****<img alt=**"Enter our site here! Your lectern awaits you." **src=**"lecterns-1.gif" **WIDTH=**"164" **HEIGHT=**"62">**</p>**

<p align="center">**Order a lectern or table top podium today!**</p>**
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