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NOTE

CYBER PIRATES, LOOTING TRADEMARKS ON THE INTERNET: *BROOKFIELD V. WEST COAST*

INTRODUCTION

The World Wide Web (the “Web”) is a powerful tool for the dissemination of information, and is an essential medium for advertising and commerce. Companies advertising on the Web can reach millions of potential customers at a lower cost than television or print media. This inexpensive advertising medium has brought forth new and interesting ways to infringe upon others’ trademarks. Because the Internet is powerful and search engines are easy to use, companies are taking advantage of competitors’ goodwill and trademarks to lure customers to their Web sites.

Misappropriation of other’s goodwill or trademarks on the Internet should not be tolerated or condoned. Trademark owners suffer irreparable injury through this sort of infringement even though the medium is ever changing. The Internet’s ever-changing face makes it difficult for trademark holders to assert their rights. Consider the following illustration where company “A” loads its Web page with several of company “B’s” trademarks. This loading may confuse Web searching software, thus causing a consumer to reach company “A’s” Web site by mistake. Consider another illustration where company “A” chooses a domain name that is either very similar to or exactly like one of company “B’s” trade or service marks. The previous illustrations are similar to the facts of *Brookfield Communications, Inc. v. West Coast Entertainment, Co.*¹ By its holding in the *Brookfield* case, the Ninth Circuit has taken the first step to ensure that trademark

1. 174 F.3d 1036 (9th Cir. 1999).

holders have the opportunity to police their rights and receive a reasonable remedy. The *Brookfield* court enjoined West Coast Entertainment, Co. (“West Coast”) from using Brookfield Communications, Inc.’s (“Brookfield”) trademarks in its domain name and metatags because it would cause Brookfield irreparable injury.²

In *Brookfield*, the Ninth Circuit provided the first substantial appellate decision regarding the use of metatags containing another’s trademark. The decision also harmonized disputes among district court decisions by addressing the issue of trademark infringement via domain name use.³ The court reached its decision by first looking at the nature of the Internet and by second evaluating trademark jurisprudence and its application to the Internet.⁴

This note analyzes the recent Ninth Circuit Court of Appeals decision in *Brookfield v. West Coast*. Part II is a statement of the case with a summary of the facts and issues involved. Parts III and IV contain a brief history of the Internet and discuss the status of the law in the area of trademark infringement under the Lanham Act prior to and at the time *Brookfield* was decided. Part V is a report and analysis on the *Brookfield* decision. Parts VI and VII look at the future of domain name regulation and provide analysis of other courts’ rulings in the wake of *Brookfield*. Lastly, Part VIII offers a conclusory opinion that the *Brookfield* court found a reasonable solution to a problem not envisioned when trademark principles were developed and that the *Brookfield* decision provided solid authority for other circuits and practitioners to follow.

II. STATEMENT OF THE CASE: BROOKFIELD V. WEST COAST

A. *Facts and Procedural History*

Brookfield gathers and sells information about the entertainment industry.⁵ It initially offered software applications providing a searchable database featuring recent film submissions, future projects, industry credits, and professional contacts.⁶ It then expanded, by offering software “featuring a searchable database containing entertainment-industry related information”⁷ This new database was marketed under the “MovieBuff” mark.⁸

In 1996, Brookfield attempted to register the domain name, “moviebuff.com,” with Network Solutions, Inc. (“Network Solutions”).⁹ However, West Coast, a competitor, had previously acquired registration of this

2. *See id.* at 1066.

3. *See id.* at 1061 n.22.

4. *See id.* at 1061.

5. *See id.* at 1041.

6. *See id.*

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

8. *See id.*

9. *See id.* at 1042. Network Solutions was, during this conflict, the exclusive registrar of domain names ending in “.com.” *See id.*

domain name.¹⁰ So, instead of registering “moviebuff.com,” Brookfield registered “brookfieldcomm.com” and “moviebuffonline.com” in May and September 1996, respectively.¹¹ Brookfield subsequently offered its “MovieBuff” software via its “brookfieldcomm.com” and “moviebuffonline.com” Web sites.¹² In August of 1997, Brookfield applied for federal registration of its “MovieBuff” mark as a trade and service mark. In September 1998, Brookfield was granted federal trademark registration of its “MovieBuff” mark.¹³

In October 1998, West Coast announced its intention to launch a Web site entitled “moviebuff.com,” a Web site containing a searchable database similar to Brookfield’s “MovieBuff” software. West Coast claimed it chose “moviebuff.com” because the term was part of its service mark, “The Movie Buff’s Movie Store,” which West Coast registered as a federal trademark in 1991.¹⁴

Furthermore, West Coast asserted that it used the mark since 1988 to describe its retail stores, which featured video cassettes and video game cartridges.¹⁵

Upon discovery of West Coast’s plan, Brookfield delivered a cease-and-desist letter to West Coast.¹⁶ The letter claimed that West Coast’s “planned use of ‘moviebuff.com’ would violate Brookfield’s trademark rights”¹⁷ The next day, West Coast issued a press release announcing the launch of the “moviebuff.com” Web site.¹⁸ After West Coast’s announcement, Brookfield filed a complaint in the United States District Court for the Central District of California, alleging trademark infringement and unfair competition in violation of sections 32 and 43(a) of the Lanham Act.¹⁹ Brookfield then applied *ex parte* for a temporary restraining order enjoining West Coast from using “MovieBuff” in any manner.²⁰ In response, West Coast filed a brief in opposition, arguing that it was the senior user of “MovieBuff” because it first used its federally registered trademark, “The Movie Buff’s Movie Store.”²¹ West Coast claimed seniority based on the assertion that it garnered common-law rights by using the domain name of “moviebuff.com” before Brookfield offered its “MovieBuff” Internet-based searchable database.²² After hearing arguments on the motion and construing it as a motion for a preliminary injunction, the court denied the injunction because Brookfield did not establish either seniority or likelihood of

10. *See id.* West Coast registered the domain name with Network Solutions on February 6, 1996. *See id.*

11. *See id.*

12. *See id.*

13. *See Brookfield*, 174 F.3d at 1041.

14. *See id.* at 1041-42.

15. *See id.*

16. *See id.* at 1042.

17. *Id.*

18. *See id.*

19. 15 U.S.C.A. §§ 1114, 1125 (West 1998).

20. *See Brookfield*, 174 F.3d at 1043.

21. *See id.*

22. *See id.*

confusion.²³ Brookfield then filed a notice of appeal followed by a motion for an injunction pending appeal, which the district court denied.²⁴

On January 16, 1999, West Coast launched its fully operational Web site at "moviebuff.com." Several days after West Coast launched the Web site, Brookfield filed an emergency motion for preliminary injunction alleging that West Coast's Web site would cause irreparable injury to Brookfield.²⁵ The Ninth Circuit Court of Appeals granted Brookfield's motion and entered an order enjoining West Coast "from using, or facilitating the use of, in any manner, including advertising and promotion, the mark MOVIEBUFF, or any other term likely to cause confusion therewith, including @moviebuff.com or moviebuff.com."²⁶

B. Issues on Appeal

In *Brookfield*, the Ninth Circuit reviewed the district court's denial of Brookfield's request for a preliminary injunction by addressing three issues. First, the court considered whether Brookfield's use of "MovieBuff" was senior to West Coast's use of "moviebuff.com." Next, the court considered whether West Coast's use of "moviebuff.com" would confuse consumers. Finally, the court analyzed whether West Coast's use of "MovieBuff" and "moviebuff.com" in its Web site's metatags caused initial interest confusion.

The issues in *Brookfield* resemble issues in previous trademark infringement claims involving domain names. However, this case provided the opportunity for the Ninth Circuit to establish appellate court authority on the issues of domain name and metatag use. The court reviewed several district court opinions, including the leading case on the issues, *Playboy Enterprises, Inc. v. Welles*.²⁷ To understand the significance and impact of the *Brookfield* decision, a history of the Internet and previous trademark jurisprudence is necessary.

III. HISTORY OF THE INTERNET

The Internet is the result of a 1969 military project called "ARPANET," designed to provide additional backup communications in the event of war.²⁸ The Internet is comprised of a global network that links smaller computer networks.²⁹ Except for perhaps electronic mail ("e-mail"), the fastest growing part of the Internet is the Web.³⁰ The Web is composed of multimedia Web pages and

23. *See id.*

24. *See id.*

25. *See id.*

26. *Brookfield*, 174 F.3d at 1043 (stating that the injunction further enjoined West Coast from using "MovieBuff" in any metatags on its home page or in connection with the retrieval of data or information).

27. 7 F. Supp. 2d 1098 (S.D. Cal. 1998).

28. *See Reno v. ACLU*, 521 U.S. 844, 849 (1997) (describing "ARAPANET" as an acronym for the network developed by the Advanced Research Project Agency).

29. *See United States v. Microsoft*, 147 F.3d 935, 939 (D.C. Cir. 1998).

30. *See id.* Approximately 200 million people will use the Internet in the year 1999, as compared with 40 million in 1997. *See Reno*, 521 U.S. at 850.

computer data files written in Hyper Text Markup Language (“HTML”), containing pictures, sounds, text, advertisements, order forms and links to other Web pages.³¹

Each page on the Internet has an identifier or address called a domain name.³² A domain name is usually the combination of a person/company’s name or trademark and a “top level” domain designation such as “.com,” “.org,” or “.edu.”³³ A potential Web page owner files an application with Network Solutions listing the domain name the applicant desires. Network Solutions then inquires to see if the name is in use by any other entity.³⁴ If the name is not in use by any other entity, the applicant is granted exclusive use of the domain name. The domain name search by Network Solutions does not evaluate the applicant’s right to use of the name.³⁵ However, Network Solutions requires that the applicant represent that he, she or it has the right to use the name, that the use or registration of the domain name does not infringe upon any other entities’ rights, and that the applicant is not seeking the name for unlawful purposes.³⁶ Once all of the above requirements are met, the domain name is issued and the entity may establish a Web presence.

Domain names are valuable corporate assets because an Internet user (“surfer”) will oftentimes guess at the domain name of a certain corporation by typing in the company’s name followed by “.com.”³⁷ In *CardService International, Inc. v. McGee*,³⁸ the court implied that a domain name might be a valuable corporate asset because it facilitates communications with a broad customer base.³⁹ In the event that the surfer does not know the domain name or is unable to successfully guess it, the surfer may employ a search engine as a second step in the search.⁴⁰

Yahoo, Excite, Altavista, Webcrawler, Lycos and Infoseek are some of the search engines available on the Internet. Search engines allow a surfer to search either by query or by accessing pre-defined search categories.⁴¹ The surfer types in a search query and the search engine produces a list of possible matches, usually ranked from most to least likely.⁴² Search engines index keywords from Web site’s domain names, text, and metatags.⁴³ Mindful Web designers create pages using

31. *See id.* at 852; *see also* *Panavision Int’l, L.P. v. Toeppen*, 141 F.3d 1316, 1318 (9th Cir. 1998).

32. *See Panavision*, 141 F.3d at 1318.

33. *See id.*

34. *See Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1044 (9th Cir. 1999).

35. *See id.*

36. *See Panavision*, 141 F.3d at 1319.

37. *See Brookfield*, 174 F.3d at 1045.

38. 950 F. Supp. 737 (E.D. Va. 1997).

39. *See id.* at 741.

40. *See ACLU v. Reno*, 31 F. Supp. 2d 473, 484 (E.D. Pa. 1999).

41. *See id.*

42. *See Brookfield*, 174 F.3d at 1045 (“Each search engine uses its own algorithm to arrange indexed materials in sequence, so the list of Web sites that any particular set of keywords will bring up may differ depending on the search engine used.”).

43. *See id.*

HTML programming language and metatags as indexing tools to describe the Web page's content.⁴⁴ The creator may load the Web page with these metatags so that the search engine will find more "hits" and therefore rank the Web page higher on the search engine's result list.⁴⁵

IV. TRADEMARK LAW PRIOR TO *BROOKFIELD*

A. *Trademark Law Background*

Trademark infringement law developed from the commercial tort of unfair competition. Unfair competition is a tort that has eluded exact definition.⁴⁶ The California Court of Appeals stated: "[I]t would be impossible to draft in advance detailed plans and specifications of all acts and conduct to be prohibited, . . . since unfair or fraudulent business practices may run the gamut of human ingenuity and chicanery."⁴⁷ The concept of unfair competition developed to ensure protection from deceptive or unethical conduct in commerce.⁴⁸ Trademark law is a mere branch of the broader unfair competition or unfair trade practice area of law.⁴⁹ A fundamental difference exists between trademark infringement and unfair competition. Unfair competition considers the total physical image given by the product and its name together, while a trademark provides the exclusive right to use a word or image to distinguish a product.⁵⁰

As embodied in the Lanham Act, a trademark, is defined as "any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods."⁵¹ A mark may not be afforded trademark protection until it is used in commerce in a public manner such that an association is created between the mark and the goods sold.⁵² The Lanham Act defines "use in commerce" as "the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark."⁵³ Congress went on to provide specific examples of use in commerce, such as placement of a mark on the goods, containers or the documents associated with the goods.⁵⁴ According to Congress, a mark is used in commerce when displayed in the sale or advertising of services. The services provided must be engaged in commerce, and the person

44. *See Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104 (D. Mass. 1998) (describing the two types of metatags; the term "META" description refers to words that identify an Internet site, and the term "Meta" keywords refers to keywords that are listed by the Web page creator when creating the Web site).

45. *See id.*

46. *See J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION* § 1:8 (4th ed. 1997).

47. *People ex rel. Mosk v. National Research Co.*, 201 Cal. App. 2d 765, 772 (3rd Dist. 1962).

48. *See Mars Inc. v. Kabushiki-Kaisha Nippon Conlux*, 24 F.3d 1368, 1373 (Fed. Cir. 1994).

49. *See MCCARTHY, supra* note 47, at § 2:7.

50. *See id.*

51. 15 U.S.C.A. § 1127 (West 1998).

52. *See Armstrong Paint & Varnish Works v. Nu-Enamel Co.*, 305 U.S. 315, 334 (1938).

53. 15 U.S.C.A. § 1127.

54. *See id.*

providing the services must be engaged in commerce in connection with the services provided.⁵⁵

A party may establish prior trademark use despite not having actually sold any goods.⁵⁶ As stated by the court in *New West Co. v. NYM Co. of California*,

[A] party may acquire rights in a designation which may be superior to any rights that a subsequent user may acquire in a confusingly similar term through use thereof in advertising or promotional material connected with the publicizing and/or offering for sale of goods or services, providing that this use has been of such nature and extent as to create an association of the goods or services and the mark with the user thereof.⁵⁷

Without “use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark,” the use is insufficient to establish trademark rights.⁵⁸ Once the user has established trademark rights the user may preclude infringing use by others.

1. Likelihood of Confusion

To preclude the infringing use of a trademark, the trademark owner must prove that a likelihood of confusion exists. Unfair competition, as it relates to trademark, attempts to avoid confusion in the minds of the buying public.⁵⁹ If the goods produced by the alleged infringer are “sufficiently similar” to the goods of a competitor, infringement will be found.⁶⁰ Section 32(1) of the Lanham Act applies to federally registered marks and provides in part:

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

(a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive . . . shall be liable in a civil action by the registrant for the remedies hereinafter provided.⁶¹

Section 43(a)(1) applies to both registered and unregistered marks and provides:

Any person who, on or in connection with any goods or services, or any container

55. *See id.*

56. *See New West Co. v. NYM Co. of Cal.*, 595 F.2d 1194, 1200 (9th Cir. 1979).

57. *Id.* (holding that the totality of a parties acts must be considered in determining whether the prior use is sufficient to establish trademark rights).

58. *Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1052 (9th Cir. 1999) (quoting *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951)).

59. *See Safeway Stores, Inc. v. Safeway Properties, Inc.*, 307 F.2d 495, 497 (2nd Cir. 1962).

60. *See AMF, Inc. v. Sleekcraft Boats*, 599 F.2d at 348. In *Sleekcraft*, the court stated the following: When the goods produced by the alleged infringer compete for sales with those of the trademark owner, infringement usually will be found if the marks are sufficiently similar that confusion can be expected. When the goods are related, but not competitive, several other factors are added to the calculus. If the goods are totally unrelated, there can be no infringement because of confusion. *Id.* (citations omitted).

61. 15 U.S.C.A. § 1114(1) (West 1998).

for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which . . .

(A) is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person . . . shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.⁶²

These two sections of the Lanham Act clearly establish the likelihood of confusion standard. The plaintiff must assert that the defendant infringed on the plaintiff's registered trademarks in violation of Section 32(1) of the Lanham Act. The plaintiff must further allege the infringement causes confusion, mistake, or deception constituting false designation of origin and unfair competition in violation of Section 43(a)(1) of the Lanham Act.⁶³

Likelihood of confusion is paramount to asserting a trademark infringement claim under Section 32⁶⁴ or section 43(a) of the Lanham Act,⁶⁵ and was addressed in *AMF, Inc. v. Sleekcraft Boats*.⁶⁶ The *Sleekcraft* court held that if the goods produced by an alleged infringer compete for sales of the trademark owner and if the marks are so similar that consumer confusion can be expected, infringement is found.⁶⁷ In contrast, if the goods are totally unrelated there can be no confusion and thus no infringement.⁶⁸ If the goods are related, but not competitive, the court considers the following factors when determining whether confusion between related goods is probable: i) strength of the mark; ii) proximity of the goods; iii) similarity of the marks; iv) evidence of confusion; v) marketing channels used; vi) type of goods and the degree of care exercised by the purchaser; vii) defendant's intent in selecting the mark; and viii) likelihood of expansion in the product lines.⁶⁹

a. *Strength of the Mark*

When determining whether likelihood of confusion exists, courts first evaluate the strength of the mark. A mark is afforded the broadest protection if it

62. *Id.* § 1125.

63. *See* *Playboy Enter., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1102 (S.D. Cal. 1998).

64. The Lanham Act, also known as the Federal Trademark Act of 1946, was conceived to eliminate judicial obscurity by placing all matters relating to trademarks in one statute. *See generally* S. Res. 1333, 79th Cong. (1946). This simplifies registration, prevents misrepresentation and deception. *See id.* The Lanham Act also provides prompt and effective protection against infringement. *See id.*

65. *See* *Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1046 (9th Cir. 1999).

66. 599 F.2d 341 (9th Cir. 1979).

67. *See id.* at 348 n.9 ("The alleged infringer's intent in adopting the mark is weighed, both as probative evidence of the likelihood of confusion and as an equitable consideration.")

68. *See id.* n.10 ("Related goods are those 'products which would be reasonably thought by the buying public to come from the same source if sold under the same mark.'") (quoting *Standard Brands, Inc. v. Smidler*, 151 F.2d 34, 37 (2d Cir. 1945)).

69. *See id.* at 348-49 n.11 ("The list is not exhaustive. Other variables come into play depending on the particular facts presented.")

is inherently distinctive, that is, if it is arbitrary or fanciful.⁷⁰ A descriptive mark is protected only if it acquires a secondary meaning.⁷¹ In between what is arbitrary and descriptive lie “suggestive marks which subtly connote something about the products.”⁷² A suggestive mark is protected even if it has not acquired a secondary meaning.⁷³

Several criteria offer guidance when determining whether a mark is descriptive or suggestive.⁷⁴ The primary criterion in determining whether a mark is suggestive or descriptive is the degree of immediacy and directness of the thought process from the mark to the product or “the imaginativeness involved in the suggestion”⁷⁵ The second criterion asks whether a grant of a limited monopoly to the trademark owner will inhibit legitimate use of the mark by competitors.⁷⁶ The third criterion asks whether the mark is actually viewed as an “indication of the product’s origin or as a self-serving description of it.”⁷⁷

b. Similarity of the marks

When goods are related there is a heightened danger that the public will mistakenly assume association between the producers of the related goods.⁷⁸ If the public is likely to associate the makers of the goods, then a lower threshold of similarity between marks is required for a finding of likelihood of confusion.⁷⁹

Similarity of marks is tested by sight, sound and meaning.⁸⁰ Each factor must be assessed separately as encountered in the market, giving more weight to similarities than differences.⁸¹ In testing the visual criterion, the *Sleekcraft* court held that when the common ending of “Craft” was added, “Slick” and “Sleek” were overall visually similar. With regard to the sound criterion, the court held that the sound of “Sleekcraft” and “Slickcraft”, while distinguishable by one syllable, was too similar.⁸² Furthermore, the Court held that the closeness of meaning of “Sleekcraft” and “Slickcraft” substantiated a claim of similarity of trademarks.⁸³

70. *See id.* at 349.

71. *See id.* n.12. (“Once secondary meaning is established, though, the protection afforded should be commensurate with the degree of consumer association proven.”) (citing *Communications Satellite Corp. v. Comcat, Inc.*, 429 F.2d 1245, 1248 (4th Cir. 1970)).

72. *Sleekcraft*, 599 F.2d at 349.

73. *See id.*

74. *See id.*

75. *Id.* (quoting RESTATEMENT OF TORTS § 721 cmt. a (1938)).

76. *See Sleekcraft*, 599 F.2d at 349.

77. *Id.*

78. *See id.* at 350.

79. *See id.* (stating that less similarity is required when the goods are complementary, that is goods that are extremely close in use and function).

80. *See id.* at 351.

81. *See id.*

82. *See Sleekcraft*, 599 F.2d at 351-52.

83. *See id.* at 352.

c. *Evidence of actual confusion and purchaser care.*

The next two factors, evidence of actual confusion and purchaser care, go hand-in-hand when assessing likelihood of confusion. Evidence of actual confusion is strong evidence that future confusion is likely.⁸⁴ However, actual confusion is difficult to prove and failure to do so is not dispositive against a trademark plaintiff.⁸⁵ In determining future confusion, a court evaluates the reasonably prudent consumer who exercises ordinary caution and the cost of the item purchased.⁸⁶ When evaluating the reasonably prudent consumer, courts look to the sophistication of the customer.⁸⁷ A buyer that has expertise in a particular field requires a higher standard, but that mere fact will not preclude a finding that confusion is likely.⁸⁸ When a mixed class of consumers is considered, courts look to the least sophisticated consumer in determining the reasonably prudent person standard.⁸⁹ In evaluating the cost of the item purchased, it is presumed that when goods are expensive, the consumer will give more deliberation and care to his purchase and, therefore, confusion will be less probable, though not impossible.⁹⁰

d. *Marketing channels used and likelihood of expansion*

Next, the *Sleekcraft* court evaluated the marketing channels used and the likelihood of expansion.⁹¹ Marketing channels that converge will increase the likelihood of confusion.⁹² This factor is met if the marketing channels are parallel, meaning if they attract the same general class of consumer through the same sales methods.⁹³ Likewise, a strong possibility that either of the parties will expand their business so that they compete directly with each other will weigh heavily toward a finding that the present use is infringing.⁹⁴

e. *Infringer's intent*

The court next looks at the alleged infringer's intent in using the mark.⁹⁵ The party claiming trademark infringement need not show that the alleged infringer intended to deceive consumers to prove intent to misappropriate.⁹⁶ However, when an alleged infringer knowingly uses a similar mark, reviewing

84. See *Official Airline Guides, Inc. v. Goss*, 6 F.3d 1385, 1393 (9th Cir. 1993).

85. See *Eclipse Assocs. Ltd. v. Data Gen. Corp.*, 894 F.2d 1114, 1118 (9th Cir. 1990).

86. See *Sleekcraft*, 599 F.2d at 353.

87. See *id.*

88. See *id.*

89. See *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 293 (3d Cir. 1991).

90. See *Sleekcraft*, 599 F.2d at 353 (holding that boat buyers do not purchase based on general impressions and therefore the trademarks are less important to a boat purchaser).

91. See *id.* at 353-54.

92. See MCCARTHY, *supra* note 47, at § 24.6.

93. See *Sleekcraft*, 599 F.2d at 353.

94. See *id.* at 354.

95. See *id.*; see also *E. & J. Gallo Winery v. Gallo Cattle Co.*, 967 F.2d 1280, 1293 (9th Cir. 1990).

96. See *Gallo*, 967 F.2d at 1293.

courts will presume that the alleged infringer can accomplish his objective to deceive the public.⁹⁷

f. Conclusion of the Sleekcraft factors.

The eight-factor test, established by the *Sleekcraft* court, is not exhaustive.⁹⁸ The listed factors cannot be rigidly applied in the Internet context. Additionally, non-listed factors may be important.⁹⁹ The Ninth Circuit repeatedly warned that the *Sleekcraft* “factors are intended to guide the court in assessing the question of likelihood of confusion.”¹⁰⁰ While the *Sleekcraft* test is important to establish likelihood of confusion, all is for naught if the party asserting infringement is not the “senior” user of the trademark.

B. Prior use and Constructive Use to Establish Seniority

To prove infringement, a plaintiff must have a valid, protectable interest in the mark questioned.¹⁰¹

It is axiomatic in trademark law that the standard test of ownership is priority of use. To acquire ownership of a trademark it is not enough to have invented the mark first or even to have registered it first; the party claiming ownership must have been the first to actually use the mark in the sale of goods or services.¹⁰²

Federal registration of a mark is *prima facie* evidence of ownership.¹⁰³ Because of this, a presumption of ownership, dating to the date of filing of the application for federal registration, is granted.¹⁰⁴ A challenger to the validity of ownership may overcome this presumption by a preponderance of the evidence.¹⁰⁵ The presumption may be rebutted in some cases by showing that the non-registrant used the mark in commerce first.¹⁰⁶

Proving that the trademark underwent changes in format and appearance as the result of business decisions may also rebut the presumption of ownership.¹⁰⁷ Changes in the form of marks may be legally attacked on two grounds: “(1) that

97. *See id.*

98. *See Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1054 (9th Cir. 1999).

99. *See id.*

100. *Dreamwerks Prod. Group, Inc. v. SKG Studio*, 142 F.3d 1127, 1129 (9th Cir. 1998) (quoting *Gallo*, 967 F.2d at 1290).

101. *See Brookfield*, 174 F.3d at 1046.

102. *Sengoku Works, Ltd. v. RMC Int'l, Ltd.*, 96 F.3d 1217, 1219 (9th Cir. 1996).

103. *See* 15 U.S.C.A. § 1057(b) (West 1998). That section provides:

A certificate of registration of a mark upon the principal register provided by this chapter shall be *prima facie* evidence of the validity of the registered mark and of the registration of the mark, of the registrant's ownership of the mark, and of the registrant's exclusive right to use the registered mark in commerce on or in connection with the goods or services specified in the certificate, subject to any conditions or limitations stated in the certificate.

Id.

104. *See id.*

105. *See Sengoku*, 96 F.3d at 1219.

106. *See id.* at 1220.

107. *See MCCARTHY*, *supra* note 47, § 17:25.

the change resulted in abandonment of rights in the old form . . . [and] (2) that the change prevents the user from tracing priority of use back to a date of first use of the old form of the mark.”¹⁰⁸ A trademark owner may be granted the same rights in a new mark, as he or she had in a previous mark, to prevent misappropriation and reduce the cost incurred in shopping and making purchase decisions, thus allowing the mark owner to tack its use of the mark.¹⁰⁹

This constructive use, or “tacking,” is allowed where the two marks are so similar that the previous mark is “the legal equivalent of the mark in question or indistinguishable therefrom”¹¹⁰ Legal equivalence is determined by “the visual or aural appearance of the marks themselves.”¹¹¹ “Legal equivalence for tacking purposes does not exist simply because the two marks a party seeks to tack are ‘confusingly similar.’”¹¹² The marks must create the same commercial impression and cannot differ materially from one another.¹¹³ Put simply, the new mark must be a derivative of the old mark, created simply to keep up with the changing market place.

Tacking is allowed to prevent reduction in a trademark owner’s priority each time a slight alteration is made to the mark.¹¹⁴ Without this protection, the trademark owner would be discouraged from altering the mark in response to changing consumer preferences, evolving aesthetic developments or new advertising techniques.¹¹⁵ Tacking is allowed upon a showing that the two marks are so similar that consumers generally regard the marks as indistinguishable.¹¹⁶ A change of format that alters the overall commercial impression of a mark results in the mark owner losing its claimed priority of use, dating from first use of the old form of the mark.¹¹⁷

C. Trademark Infringement through the Use of Metatags

The next area of law considered by the *Brookfield* court concerns trademark infringement through the use of metatags on the Internet.¹¹⁸ The most authoritative opinion until *Brookfield* was *Playboy Enterprises, Inc. v. Welles*,¹¹⁹ in which the court attempted to synthesize a workable standard to establish the existence of infringement by use of trademarks in metatags.¹²⁰

108. *Id.*

109. *See* *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995).

110. *Data Concepts, Inc. v. Digital Consulting, Inc.*, 150 F.3d 620, 623 (6th Cir. 1998).

111. *Id.* (quoting *Van Dyne-Crotty, Inc. v. Wear-Guard Corp.*, 926 F.2d 1156, 1159 (Fed. Cir. 1991)).

112. *Id.* at 623.

113. *See* MCCARTHY, *supra* note 47, § 17:26.

114. *See* *Hess’s of Allentown, Inc. v. National Bellas Hess, Inc.*, 169 U.S.P.Q. 673, 677 (T.T.A.B. 1971).

115. *See id.* (stating that the Trademark Board, in *Hess*, allowed the owner of “Hess’s” to tack the first use of “Hess Brothers” and “Hess” onto “Hess’s”).

116. *See Data Concepts*, 150 F.3d at 623.

117. *See* MCCARTHY, *supra* note 47, at § 17:26 (citing *Owens-Illinois, Inc. v. Optimist Int’l*, 173 U.S.P.Q. 120 (T.T.A.B. 1972)).

118. *See Brookfield*, 174 F.3d at 1061.

119. 7 F. Supp. 2d 1098 (S.D. Cal. 1998).

120. *See generally id.* at 1098.

1. The Ninth Circuit Sets the Standard for Metatag Infringement: *Playboy v. Welles*.

Playboy Enterprises, Inc. (“PEI”) sought to enjoin Terri Welles (“Welles”), a former “Playmate of the Year,” from using the terms “Playmate of the Year,” “Playboy” or “Playmate” as descriptive terms to attract Web surfers to her Web page by placing the terms in her Web site metatags.¹²¹ PEI argued that Welles’ use of the trademarks would cause confusion, mistake and even deception.¹²² Welles argued that her use of the marks was merely descriptive of herself and when not used to describe Welles, they were used in an “editorial fashion.”¹²³ In ruling on PEI’s likelihood of success, the court found that PEI did indeed have a distinctive and strong mark, but the marks also represented awards bestowed upon the models in recognition of their achievements.¹²⁴ The court reasoned because PEI encourages the models to use their titles in promoting themselves as well as PEI, that surely this arrangement is profitable for both and therefore allowable.¹²⁵

In *Welles*, the court took up the task of applying trademark law to Web sites by first determining that the likelihood of confusion factors did not apply.¹²⁶ The court’s rationale was that this is not “a standard trademark case and does not lend itself to the systematic application of the eight factors.”¹²⁷ The court held that Welles used the marks as a means of describing and identifying herself and thus could assert what the court deemed the fair use defense.¹²⁸

a. *The Fair Use Defense and Editorial Use.*

Fair use of trademarks is allowed pursuant to 15 U.S.C. §§ 1115(b)(4) and 1125(c)(4). Section 1115(b)(4) provides that:

[T]he use of the name, term, or device charged to be an infringement is a use, otherwise than as a mark, of the party’s individual name in his own business, or of the individual name of anyone in privity with such party, or of a term or device which is descriptive of and used *fairly* and in *good faith* only to describe the goods or services of such party¹²⁹

Section 1125(c)(4)(A) provides that “[f]air use of a famous mark by another person in comparative commercial advertising or promotion to identify the competing goods or services of the owner of the famous mark [shall not be actionable.]”¹³⁰ This doctrine prevents the registrant of a descriptive trademark from appropriating the mark for exclusive use, thereby excluding others from

121. *See id.* at 1100.

122. *See id.* at 1101.

123. *See id.*

124. *See id.* at 1102.

125. *See Welles*, 7 F. Supp. 2d at 1102.

126. *See id.* at 1103.

127. *Id.*

128. *See id.*

129. 15 U.S.C.A. § 1115 (West 1998) (emphasis added).

130. *Id.* § 1125(c)(4).

accurately describing a characteristic of their goods.¹³¹

The court determined that Welles merely used the registered trademarks in the metatags of her Web site to describe herself and her enterprise and that such use was allowed under the fair use doctrine.¹³² “[I]t is evident that Ms. Welles minimized her references to *Playboy* on her website and has not attempted to trick consumers into believing that they are viewing a *Playboy* endorsed website.”¹³³ It is this “good faith” that made Welles’ use of PEI’s trademarks acceptable.¹³⁴ In essence, the court applied the principle of allowing use of protected trademarks in a competing product to the use of metatags, as long as the trademarks are used fairly and in good faith to describe the infringer’s products or services.¹³⁵

The *Welles* court then discussed in dictum the merits of a likelihood of confusion analysis when dealing with the use of metatags.¹³⁶ The district court determined that such analysis was not necessary in light of the fair use defense, but stated that PEI could not successfully prove likelihood of confusion.¹³⁷ The court agreed PEI’s marks are strong and used by PEI to sell adult entertainment on the Internet, but that the average Web surfer would not think that Welles’ Web site was affiliated with PEI.¹³⁸ Again, the court stated that good faith use of the trademarks weighed in favor of the defendant in such cases.¹³⁹

2. Initial Interest Confusion and the Use of Trademarks as Metatags.

The *Brookfield* court was presented with the opportunity to set the tone for an increasingly hot issue in trademark law. The court attempted to determine whether West Coast should be enjoined from using “MovieBuff” in metatags and buried code.¹⁴⁰ Brookfield asked the court to enjoin West Coast from using “MovieBuff” or “moviebuff.com” in either the metatags or domain name of their Web site.¹⁴¹ To grant a temporary order the court must find that plaintiff will be either able to prove a likelihood of success on the merits and the possibility of irreparable injury or “the existence of serious questions going to the merits and

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

132. See *id.* at 1103-04. (stating that use of the term “Playmate of the Year” was descriptive and fairly used to describe Welles, that Welles made no overt attempt to defraud surfers, and that she also included a disclaimer stating that she and her web site were not affiliated with Playboy Enterprises).

133. *Id.*

134. See *id.* at 1104. PEI actually conceded that Ms. Welles was entitled to use Playboy in an editorial context. See *id.*

135. See generally *id.*

136. See *id.*

137. See *Welles*, 7 F. Supp. 2d at 1104.

138. See *id.*

139. See *id.*

140. See *Brookfield Communication, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1061(9th Cir. 1999). The court stated in a note that Brookfield did not explain what they meant by “buried code.” See *id.* at 1061-62 n.23. The court decided to turn to a treatise on trademark law to define buried code. See *id.* Buried code, as defined by McCarthy, “is another term for the HTML code that is used by search engines but that is not visible to users.” *Id.*; see also MCCARTHY, *supra* note 47, at § 25:69 n.1.

141. See *Brookfield*, 174 F.3d at 1062.

that the balance of hardships tips sharply in his favor.”¹⁴² The court held that all of the *Sleekcraft* confusion factors, excepting purchaser care, applied with respect to West Coast’s use of “moviebuff.com” in metatags.¹⁴³

The court found that a Web surfer is not likely to be confused by West Coast’s use of “MovieBuff” and “moviebuff.com.”¹⁴⁴ The court reached this conclusion by determining that the surfer will realize immediately upon entering West Coast’s Web site that they have reached it in error because of the prominence of West Coast’s own name.¹⁴⁵ Although the Web surfer will notice the difference in the sites after entering the site, “West Coast’s use of ‘moviebuff.com’ in metatags will still result in what is known as initial interest confusion.”¹⁴⁶

a. *How does one become “initially” confused?*

Courts throughout the country have held that trademark infringement may occur in the absence of source confusion.¹⁴⁷ This type of trademark violation is the result of the consumer’s initial belief that the infringer is somehow related to the trademark owner.¹⁴⁸ One of the first cases to apply this theory was *Mobil Oil Corp. v. Pegasus Petroleum Corp.*¹⁴⁹ where the defendant used a flying horse insignia similar to Mobil’s famous emblem. Mobil argued that potential customers would be initially confused as to whether Pegasus Petroleum was affiliated with Mobil Oil. The court found that even though the confusion dissipated before a transaction was completed, Mobil had suffered an injury.¹⁵⁰ In reaching its decision, *Mobil Oil* relied on a previous case, *Grotrian, Helfferich, Schilz, Th. Steinweg Nachf v. Steinway & Sons.*¹⁵¹

In *Steinway*, the defendant, Grotrian, labeled his pianos “Grotrian-Steinweg,” perhaps hopeful that this labeling would attract potential “Steinway” piano customers.¹⁵² In finding the defendant, Grotrian, liable for infringement, the court stated:

142. *Id.* at 1046.

143. *See id.* at 1062.

144. *See id.* (“[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.”).

145. *See id.*

146. *Id.*

147. *See Brookfield*, 174 F.3d at 1062 ; *see also* *Dr. Suess Enter., L.P., v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254 (2d Cir. 1987); *Pebble Beach Co. v. Tour 18 I, Ltd.*, 942 F. Supp. 1513 (S.D. Tex. 1996); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707 (S.D.N.Y. 1973) (holding that a trademark violation can result from the initial confusion even if the customer discovers that the defendant is not related to the trademark owner).

148. *See Steinway*, 365 F. Supp. at 717 (holding that a there was a likelihood of confusion, because the harm to Steinway results from the customer’s perception that the less expensive competing piano is connected to Steinway).

149. 818 F.2d 254 (2d Cir. 1987).

150. *See generally id.* at 260.

151. 523 F.2d 1331, 1341-42 (2d Cir. 1975).

152. *See id.*

The issue here is not the possibility that a purchaser would buy a Grotrian-Steinweg thinking it was actually a Steinway or that Grotrian had some connection with Steinway and Sons. The harm to Steinway, rather, is the likelihood that a consumer, hearing the "Grotrian-Steinweg" name and thinking it had some connection with "Steinway", would consider it on that basis. The "Grotrian-Steinweg" name therefore would attract potential customers based on the reputation built up by Steinway in this country for many years.¹⁵³

It is this initial attraction that actually causes the harm to the senior user because the consumer may, in certain instances, decide to purchase from the junior user because of convenience.¹⁵⁴

The *Brookfield* court indicated that the application of initial interest confusion produced conflicting results in many different jurisdictions.¹⁵⁵ In the First Circuit and the Central District of California, it was held that only confusion affecting the ultimate buying decision is actionable, and that "brief confusion" is not cognizable under trademark law.¹⁵⁶ Fortunately, the majority of courts presented with this issue have ruled inapposite to these courts and found that initial interest confusion is actionable.¹⁵⁷ The Seventh Circuit, in *Forum Corp. of North America v. Forum, Ltd.*, stated, "the fact that confusion as to the source of a product or service is eventually dispelled does not eliminate the trademark infringement which has already occurred."¹⁵⁸ Courts have repeatedly punished the deceptive practice of baiting customers with familiar trademarks and not the good faith use of trademarks, in comparative or editorial fashions.¹⁵⁹

The *Brookfield* court proposed a hypothetical situation in which Blockbuster¹⁶⁰ allegedly baited customers by placing a billboard which read "West Coast Video: 2 miles ahead at Exit 7."¹⁶¹ In the hypothetical, Blockbuster was situated at Exit 7, and West Coast Video was situated at Exit 8.¹⁶² The court found trademark infringement in this case because Blockbuster attracted customers' initial interest by falsifying a sign.¹⁶³ In the hypothetical, the court said that Blockbuster misappropriated West Coast's good will, even though the customers

153. *Id.* at 1342.

154. *See generally* *Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1062 (9th Cir. 1999).

155. *See generally id.* at 1062-64.

156. *See* *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1206-08 (1st Cir. 1983); *Teletech Customer Care Mgmt. (Cal.), Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1414 (C.D. Cal. 1997).

157. *See generally* *Securacomm Consulting, Inc. v. Securacom Inc.*, 984 F. Supp. 286 (D.N.J. 1997); *Blockbuster Entertainment Group v. Laylco, Inc.*, 869 F. Supp. 505 (E.D. Mich. 1994); *Forum Corp. of N. Am. v. Forum, Ltd.*, 903 F.2d 434 (7th Cir. 1990).

158. *Forum*, 903 F.2d at 442 n.2 (*quoting Mobil Oil Corp.*, 818 F.2d at 254).

159. *See* *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376 (7th Cir. 1996); *see also* MCCARTHY, *supra* note 48, at § 23:6.

160. Blockbuster was strictly used as an example by the court. *See* *Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1064 (9th Cir. 1999).

161. *See id.*

164. *See id.*

163. *See* *Blockbuster Entertainment Group v. Laylco, Inc.*, 869 F. Supp. 505 (E.D. Mich. 1994); *see also* *Brookfield*, 174 F.3d at 1064.

undoubtedly would no longer be confused upon realizing the absence of a West Coast Video store.¹⁶⁴ Injury occurs when the customer who prefers West Coast Video decides to rent from Blockbuster instead of endeavoring to find the West Coast Video store.¹⁶⁵ “Using another’s trademark in one’s metatags is much like posting a sign with another’s trademark in front of one’s store.”¹⁶⁶ How will this apply to the use of trademarks in metatags?

D. *The Playboy Problem: Application of Initial Interest Confusion to Metatags.*

1. Playboy Enterprises, Inc. v. Calvin

The law of trademark use in metatags is still in its infancy. Few courts have dealt with the issue, and of those who have, with the exception of the *Welles* court, most have ruled that infringement does result.¹⁶⁷ The first PEI case to address this issue was *Playboy Enterprises, Inc. v. Calvin Designer Label*.¹⁶⁸ The court granted PEI’s motion for preliminary injunction based on Calvin’s use of “Playboy” and “Playmate” in its domain name and in its Web page.¹⁶⁹ The court granted the injunction because PEI established that Calvin had used PEI’s trademarks in such a way that misled consumers.¹⁷⁰ Calvin made repeated use of PEI’s trademark by “loading” it on its Web page so that search engines attempting to access PEI’s Web site would find Calvin’s instead.¹⁷¹ The court enjoined Calvin from using Playboy’s marks in any manner and ordered the cancellation of Calvin’s infringing domain names and machine-readable code.¹⁷²

2. Playboy Enterprises v. Asiafocus

In the second Playboy case, *Playboy Enterprises, Inc. v. Asiafocus International, Inc.*,¹⁷³ the defendant, Asiafocus, allegedly created and maintained several Web sites containing adult photographs.¹⁷⁴ PEI alleged that Asiafocus intentionally misled customers into believing that Asiafocus was affiliated with PEI by using “Playboy” and “Playmate” in its HTML code.¹⁷⁵ The trademarks

164. See *Brookfield*, 174 F.3d at 1064.

165. See *id.*

166. *Id.*

167. See generally *Playboy Enter., Inc. v. Asiafocus Int’l, Inc.*, No. Civ. A. 97-734-A, 1998 WL 724000 (E.D. Va. Apr. 10, 1998); *Playboy Enter., Inc. v. Calvin Designer Label*, 985 F. Supp. 1220 (N.D. Cal. 1997); *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102 (D. Mass. 1998); but see *Playboy Enter., Inc. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998) (holding that no infringement occurred as a result of defendant’s fair use of “Playmate,” “Playboy” or “Playmate of the Year”).

168. 985 F. Supp. at 1220.

169. See *id.* at 1221.

170. See *id.* at 1220.

171. See *id.* at 1221.

172. See *id.* at 1221-22 (stating that the domain names used by defendant were “*www.Playboyxxx.com*” and “*www.playmatelive.com*”).

173. No. CIV.A. 97-734-A, 1998 WL 724000 (E.D. Va. Apr. 10, 1998).

174. See *id.* at *2.

175. See *id.* at *3, *6-*7. Use of PEI’s trademarks in HTML code results in “hitting” the defendant’s web site when the surfer uses a search engine to find PEI’s adult web sites. See *id.*

were placed in the HTML code so consumers searching for PEI would find Asiafocus. The Court cited section 32(1)(a) of the Lanham Act to protect PEI's federally registered trademarks. That section provides in part:

Any person who shall, without the consent of the registrant . . . use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive¹⁷⁶

PEI was burdened with proving that Asiafocus's use of its trademarks would cause confusion among consumers.¹⁷⁷ Consumer confusion resulted because the services offered by PEI and Asiafocus were so similar that, upon reaching Asiafocus's Web site, the consuming public would believe that Asiafocus was affiliated with PEI.¹⁷⁸ "Through . . . [Asiafocus's] willful deception, consumers have been misled into believing the [A]sian-playmates Web site is connected with, or somehow sponsored by, PEI."¹⁷⁹ In *Asiafocus*, the court hinted that an application of the initial interest confusion doctrine to the infringing use of metatags might be appropriate.¹⁸⁰

3. Niton v. RMD: the infringing use of metatags.

*Niton Corp. v. Radiation Monitoring Devices, Inc.*¹⁸¹ is arguably the best example of willful metatag infringement resulting in initial interest confusion. In *Niton*, defendant Radiation Monitoring Devices ("RMD") allegedly copied several of the keywords used in plaintiff Niton's Web page.¹⁸² A Niton employee ran several searches on the Web by entering "Niton Corporation" in various search engines.¹⁸³ The results were touted as links to the Niton Corporation Web Page, but were linked to RMD's Web site.¹⁸⁴ The Web page creator discovered, by using Netscape's "view source" option,¹⁸⁵ that RMD had copied Niton's metatags verbatim.¹⁸⁶ The court held that consumers would initially believe that RMD is affiliated with Niton because of the deceptive use of Niton's trademarks.¹⁸⁷ Although the deceptive practice by RMD would be abated upon reaching RMD's site, the customer may be led there by the misappropriation of Niton's good will, which entitled Niton to a preliminary injunction against RMD.¹⁸⁸

176. For the language of the statute, see *supra* note 63 and accompanying text.

177. *See id.*

178. *See Asiafocus*, 1998 WL 724000, at *6.

179. *Id.* at *3 (E.D. Va. Apr. 10, 1998).

180. *See id.* at *8.

181. 27 F. Supp. 2d 102 (D. Mass. 1998).

182. *See id.* at 104.

183. *See id.*

184. *See id.*

185. *See id.* (stating that the "view source" feature allows a surfer to view the current HTML code providing the structure for the Web page).

186. *See id.*

187. *See Niton*, 27 F. Supp. 2d at 105.

188. *See id.* at 104-05.

E. Establishing Trademark Infringement when Marks are used as Metatags.

Courts throughout the nation have established a continuum. At one end is *Welles*, which permits the fair use of other's marks in metatags, and at the other end is *Niton*, holding that a preliminary injunction is appropriate when the alleged infringer intended to willfully deceive consumers.¹⁸⁹

V. THE *BROOKFIELD* COURT'S DECISION AND ANALYSIS.

To establish a claim for trademark infringement through the use of metatags, a plaintiff must establish a likelihood of confusion among Web surfers.¹⁹⁰ Showing that consumers are initially confused by the improper use of a trademark may itself prove likelihood of confusion.¹⁹¹ Confusion results because "[I]nitial-interest confusion gives the junior user credibility during the early stages of a transaction and can possibly bar the senior user from consideration by the consumer once the confusion is dissipated."¹⁹² This confusion gives rise to an infringement even though no actual sale is finally completed as a result of the confusion.¹⁹³

A. *West Coast's Domain Name Infringement*

1. Brookfield must establish seniority of use.

Brookfield began using "MovieBuff" in commerce before West Coast began using "moviebuff.com." Therefore, Brookfield was the senior user of the "MovieBuff" mark.¹⁹⁴ West Coast asserted that it was the senior user of "MovieBuff" because of its previous use of "The Movie Buff's Movie Store."¹⁹⁵ The court dismissed West Coast's senior user claim as simply irrelevant because "The Movie Buff's Movie Store" and "MovieBuff" are not similar enough to be tacked.¹⁹⁶ West Coast actually conceded that actual confusion between "MovieBuff" and "The Movie Buff's Movie Store" would not result, and the court agreed.¹⁹⁷ Therefore, West Coast was not allowed to tack previous use of its federally registered trademark to its use of "moviebuff.com," and Brookfield was deemed the senior user of "MovieBuff."¹⁹⁸ The court then discussed priority as to the one discrete issue of use on the Internet.

West Coast registered "moviebuff.com" in February 1996, and Brookfield

189. See *supra* note 165 and accompanying text.

190. See *Playboy Enter., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1103 (S.D. Cal. 1998).

191. See *Dr. Suess Enter., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997).

192. *Elvis Presley Enter., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998).

193. See *Securacomm Consulting, Inc. v. Securacom, Inc.*, 984 F. Supp. 286, 298 (D.N.J. 1997).

194. See *Brookfield Communications, Inc. v. West Coast Entertainment Co.*, 174 F.3d 1036, 1049 (9th Cir. 1999).

195. See *id.*

196. See *id.* (stating that failure in proving actual confusion is not dispositive against a trademark plaintiff, because of the inherent difficulties in gathering evidence to prove such confusion); see also *supra* notes 108-19 and accompanying text.

197. See *Brookfield*, 174 F.3d at 1049-50.

198. See *id.*

began using “MovieBuff” on its Internet based products in August of 1997.¹⁹⁹ However, neither West Coast’s mere registration of a domain name nor use of “MovieBuff” in internal electronic mail constituted “use in commerce” as defined by the Lanham Act. “The Lanham Act grants trademark protection only to marks that are used to identify and to distinguish goods or services in commerce – which typically occurs when a mark is used in conjunction with the actual sale of goods or services.”²⁰⁰ Congress recently clarified the “use in commerce” requirement by amending the Lanham Act so that trademark rights are conveyed only by “the bona fide use of a mark in the ordinary course of trade, and not made merely to reserve a right in a mark.”²⁰¹ Section 45(1) of the Lanham Act provides in part:

For purposes of this chapter, a mark shall be deemed to be in use in commerce . . . on goods when . . .

(A) it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or . . . on documents associated with the goods or their sale, and

(B) the goods are sold or transported in commerce²⁰²

The court held West Coast’s registration of the mark was not sufficient to constitute “use in commerce.”²⁰³ Therefore, West Coast’s first use date of “moviebuff.com” for purposes of the Lanham Act was neither the date of registration with Network Solutions nor when it first used “moviebuff.com” in e-mail, but was the date of public release, November 11, 1998.²⁰⁴ Brookfield was the senior user because the date of public release by West Coast was preceded by Brookfield’s first use of “MovieBuff.” The court reversed the district court’s ruling and held that Brookfield established a likelihood of success on its senior use claim.²⁰⁵

2. Brookfield must establish a likelihood of confusion.

Establishing seniority of use is merely the first element in proving trademark infringement. Brookfield also bore the burden of proving that the public was likely to become confused as a result of West Coast’s use in commerce of “moviebuff.com.”²⁰⁶ Because the case was at the preliminary injunction stage, Brookfield had to establish that it could show likelihood of confusion.²⁰⁷ The court

199. *See id.* at 1051.

200. *Id.*

201. Lanham Act § 45, 15 U.S.C.A. § 1127 (West 1998).

202. *Id.*

203. *See Brookfield*, 174 F.3d at 1052.

204. *See id.* at 1053. West Coast made a half-hearted attempt to assert that their date of first use was established by using the mark in e-mail correspondence. *See id.* The court dismissed this argument on the grounds that West Coast’s use did not constitute “use in a way sufficiently public to identify or distinguish the marked goods in an appropriate segment of the public mind as those of the adopter of the mark.” *Id.* at 1052 (quoting *New England Duplicating Co. v. Mendes*, 190 F.2d 415, 418 (1st Cir. 1951)).

205. *See Brookfield*, 174 F.3d at 1053.

206. *See Lanham Act* § 43, 15 U.S.C.A. § 1125(a)(1).

207. *See Brookfield*, 174 F.3d at 1053 n.15; *see also Sardi’s Restaurant Corp. v. Sardie*, 755 F.2d 719,

applied the eight-factor test to the facts and determined that Brookfield had established a likelihood of confusion.²⁰⁸

a. *The Sleekcraft factors*

First, the court looked to the similarity of the marks. The district court held that Brookfield's domain name "moviebuffonline.com" and West Coast's "moviebuff.com" were not similar enough to warrant a finding of confusion.²⁰⁹ The Ninth Circuit reversed stating "[c]omparison of domain names . . . is irrelevant as a matter of law, since the Lanham Act requires that the allegedly infringing mark be compared with the claimant's *trademark*, which here is 'MovieBuff,' not 'moviebuffonline.com.'"²¹⁰ The court determined that "MovieBuff" and "moviebuff.com" are identical in terms of sight, sound, and meaning, and that the similarity factor weighed heavily in Brookfield's favor.²¹¹

Upon finding that the marks were similar, the court moved to an analysis of the relatedness of the products and services offered and the overlap in marketing and advertising.²¹² The focus of this analysis was on the likelihood that a Web surfer, accessing West Coast's site, would think that they were somehow affiliated with Brookfield.²¹³ The court held that consumer confusion in many forms was likely because both Brookfield and West Coast offered searchable databases containing movie industry related information, and used the same channels of advertising and marketing.²¹⁴ This factor was not conclusive of likelihood of confusion, but tipped the scale further in Brookfield's favor.

Next, the court had to determine the relative strength of "MovieBuff." Brookfield's mark, "MovieBuff," fell into the category of a suggestive mark. A suggestive mark may gain strength by a showing of significant advertising expenditures or widespread recognition in the marketplace.²¹⁵ Brookfield could not establish widespread recognition of its mark. Yet, Brookfield used the mark for over five years, registered the mark at both the federal and state level, and expended \$100,000 in advertising costs. The court held that these expenditures of effort and money sured up the mark and produced a suggestive mark warranting trademark protection.²¹⁶ The court further mused that the strength of mark is of diminished importance in this situation because of the identity of the two marks.²¹⁷

723 (9th Cir. 1985).

208. See *supra* text accompanying notes 70-102; see also *Brookfield*, 174 F.3d at 1053, 1061.

209. See *Brookfield*, 174 F.3d at 1055.

210. *Id.* (citation omitted).

211. See *id.* The court dismissed the significance of ".com" because many companies use their corporate name or trademark followed by "dot com." See *id.*

212. See *id.*

213. See *id.* at 1056.

214. See *id.* at 1057.

215. See *Nutri/System, Inc. v. Con-Stan Indus., Inc.* 809 F.2d 601, 605 (9th Cir. 1987); see also *Streetwise Maps, Inc. v. Vandam, Inc.*, 159 F.3d 739, 743-44 (2d Cir. 1998).

216. See *Brookfield*, 174 F.3d at 1058.

217. See *id.* at 1059 ("Whether a mark is weak or not is of little importance where the conflicting mark is identical and the goods are closely related") (citing MCCARTHY, *supra* note 47, at § 11:76).

The court next turned to the intent of West Coast in adopting the mark.

The intent factor will favor the plaintiff where the alleged infringer, in this case West Coast, adopts another's mark with knowledge that it was another's mark.²¹⁸ The court considered a previous ruling that in "the Internet context . . . courts have appropriately recognized that the intentional registration of a domain name knowing that the second-level domain is another company's valuable trademark weighs in favor of likelihood of confusion."²¹⁹ The court found this factor to be inconclusive because there was no evidence that West Coast intended to confuse consumers at the time it registered "moviebuff.com."²²⁰

The court briefly examined the final three factors, evidence of actual confusion, likelihood of expansion in product lines, and purchaser care, and stated that they were not determinative of trademark infringement.²²¹ Brookfield filed suit before West Coast actually began using "moviebuff.com"; thus, there was no evidence of actual confusion. West Coast and Brookfield already competed to a significant extent so the likelihood of expansion in product lines was irrelevant, because neither would enter more directly into each other's principal market.²²²

Although not determinative, the court nonetheless engaged in a discussion of purchaser care.²²³ The court was faced with the possibility of three different consumer standards: i) the entertainment professional, which will exercise a higher degree of care; ii) the movie devotees, who will exercise substantially less care; and iii) the casual movie watcher.²²⁴ In analyzing this factor, the court applied the standard that was equal to the least sophisticated consumer, the casual movie watcher.²²⁵ According to the court, the reasonably prudent casual movie watcher exercises very little care when searching the Internet for Brookfield's product.²²⁶ The court stated it need not analyze this factor further, "because the purchaser confusion factor, even considered in the light most favorable to West Coast, is not sufficient to overcome the likelihood of confusion strongly established by the other factors . . . [the court] analyzed."²²⁷

3. The Court rules for Brookfield.

The Ninth Circuit Court of Appeals reversed the district court's denial of a preliminary injunction and held that Brookfield had established a likelihood of

218. See *Brookfield*, 174 F.3d at 1059.

219. *Id.* at 1058. This standard was established in a case where the infringer purchased a domain name and then preceded to attempt a sale of the name to the rightful trademark holder. Courts have held, without fail, that such conduct infringes against the rightful trademark holders' rights. See *Panavision Int'l v. Toepfen*, 141 F.3d 1316 (9th Cir. 1998); see also *Intermatic, Inc. v. Toepfen*, 947 F. Supp. 1227 (N.D. Ill. 1996).

220. See *Brookfield*, 174 F.3d at 1059.

221. See *id.* at 1060.

222. See *id.*

223. See *id.*

224. See *id.*

225. See *Ford Motor Co. v. Summit Motor Prods., Inc.*, 930 F.2d 277, 283 (3d Cir. 1991).

226. See *Brookfield*, 174 F.3d at 1060.

227. *Id.* at 1061.

success on its Lanham Act claims.²²⁸ The court stated that Brookfield successfully established seniority of use and likelihood of confusion.²²⁹ Therefore, West Coast was enjoined from using “moviebuff.com” in commerce.²³⁰

B. West Coast’s use of Brookfield’s Trademarks in HTML.

When analyzing the use of “MovieBuff,” the court gave the following analogy: “Using another’s trademark in one’s metatags is much like posting a sign with another’s trademark in front of one’s store.”²³¹ After determining that West Coast could not use “moviebuff.com” as a domain name to peddle its entertainment database,²³² the court engaged in an analysis of West Coast’s alleged infringing use of Brookfield’s marks, “MovieBuff” and “moviebuff.com,” in the metatags of its Web site.²³³ The Court determined that the *Sleekcraft* factors concerning likelihood of confusion applied to the metatag analysis as well.²³⁴ The court was faced with determining if West Coast’s use of “MovieBuff” or “moviebuff.com” in the metatags of its Web site at “westcoastvideo.com” or at any other domain name constituted trademark infringement.²³⁵

1. Initial Interest Confusion

West Coast’s use of “moviebuff.com” resulted in initial interest confusion, because consumers searching for Brookfield’s products found a similar database at “westcoastvideo.com.”²³⁶ “The fact that there is only initial interest confusion does not alter the fact that [the infringer] would be misappropriating . . . acquired goodwill.”²³⁷ A consumer confronted with the prospect of leaving West Coast’s Web site and continuing their search for Brookfield’s products may opt to remain with West Coast, thereby causing injury to Brookfield.²³⁸

The court held, like in *Niton*, that West Coast’s use of “MovieBuff” was intended to divert people from finding Brookfield’s Web site.²³⁹ In so holding, the court stated, “[T]he Lanham Act bars West Coast from using, in its metatags any term confusingly similar with Brookfield’s mark.”²⁴⁰ West Coast infringed through actively creating the initial interest confusion by placing Brookfield’s trademark in

228. *See id.*

229. *See id.*

230. *See id.* at 1066-67.

231. *Id.* at 1064.

232. *See Brookfield*, 174 F.3d at 1064.

233. *See id.* at 1062.

234. *See id.*

235. *See id.* West Coast’s use of the domain name “moviebuff.com” was found to infringe Brookfield’s “MovieBuff” mark. *See id.* Therefore, all the court needed to determine was if West Coast could use the marks in other Web sites. *See id.*

236. *See id.*

237. *Id.* at 1064.

238. *See Brookfield*, 174 F.3d at 1064.

239. *See id.* at 1065.

240. *Id.*

its metatags.²⁴¹ However, the court did not limit West Coast from using the marks in a manner constituting fair use under the Lanham Act.²⁴² West Coast, unlike Terri Welles, did not use Brookfield's marks as descriptive terms.²⁴³ Welles used PEI's marks to describe herself as a former "Playboy Playmate" and placed several disclaimers stating that her site was not affiliated with PEI in any way.²⁴⁴ "MovieBuff" is not a descriptive term, and West Coast did not attempt to either minimize its use of the mark or place disclaimers on its Web page.²⁴⁵ The court distinguished *Brookfield* from *Welles* by holding that fair use of another's trademarks is allowed, but West Coast's intentional misleading use of Brookfield's trademarks was a danger to consumers.²⁴⁶ West Coast did not use Brookfield's trademarks as a means of describing themselves or of distinguishing themselves from Brookfield,²⁴⁷ but instead, it used the trademarks to attract people to its own Web site to the detriment of Brookfield.

VI. PROPOSED DOMAIN NAME REGULATION

Network Solutions, for the last six years, has been the exclusive registrar of ".com," ".net," and ".org" domain names.²⁴⁸ Recently, more registrars were added, including America Online, CORE, France Telecom/Oleane, Melbourne IT and register.com.²⁴⁹ Multiple registrars, in the absence of a review process, may lead to further confusion and domain name infringement.²⁵⁰ The World Intellectual Property Organization ("WIPO") issued recommendations designed to alleviate some domain name disputes.²⁵¹ ICANN²⁵² broadly endorsed the WIPO recommendations and indicated that it intended to formally adopt the WIPO recommendations.²⁵³ Pursuant to ICANN guidelines, each registrar must have policies and procedures to resolve domain disputes; until such time, each registrar shall have authority to resolve disputes under their own guidelines.²⁵⁴

WIPO made two basic proposals for handling domain name disputes.²⁵⁵ The organization's recommendations include "a framework for handling abusive

241. See *id.* (refuting West Coast's argument that they acted passively by merely taking advantage of a confusing situation); accord *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619, 622 (6th Cir. 1996).

242. See *Brookfield*, 174 F.3d at 1065.

243. See *id.* at 1066.

244. See *Playboy v. Welles*, 7 F. Supp. 2d 1098, 1100 (S.D. Cal. 1998).

245. See *Brookfield*, 174 F.3d at 1066.

246. See *id.*

247. See *id.*

248. See *supra* note 9 and accompanying text.

249. See LISA D. DAME, *ICANN Adopts WIPO Recommendations on Domain Names*, THE INTELL. PROP. STRATEGIST, June 1999, at 1.

250. See *id.*

251. See *id.* at 8.

252. ICANN is a non-profit corporation that oversees the Internet's core technical management functions. See *id.*

253. See *id.*

254. See *id.*

255. See DAME, *supra* note 251, at 8.

domain name registrations and . . . that there be special treatment given to owners of famous or well-known marks.”²⁵⁶ These recommendations seem to fall in line with prevailing Ninth Circuit case law.²⁵⁷

The WIPO recommendations define “abusive domain name registration” as meeting the following requirements:

- (i) the domain name is identical or misleadingly similar to a trade or service mark in which the complainant has rights; and (ii) the holder of the domain name has no rights or legitimate interests in respect of domain name; and (iii) the domain name has been registered and is used in bad faith.²⁵⁸

Under WIPO’s proposal, a three-member panel would administer the resolution procedure and issue remedies.²⁵⁹ The three-member panel would be limited to “(i) cancellation or transfer of the domain name and (ii) imposition of procedural costs in the losing party, not including attorney fees.”²⁶⁰ Importantly, the parties retain the right to challenge the ruling in a court of law.²⁶¹

WIPO further recommends that owners of famous and well-known marks should be allowed to apply for their marks to be excluded from generic top-level domains.²⁶² The three-member panel would evaluate the following seven factors in determining an application for exclusion: i) the degree of recognition of the mark in the relevant public sector; ii) the duration, extent and geographical area of use; iii) the duration, extent and geographical area of any promotion of the mark; iv) the duration and geographical area of any registrations to the extent they reflect use or recognition of the mark; v) successful enforcement of rights in the mark; vi) the value of the mark; and vii) evidence of unauthorized third parties’ attempts to register the mark as a domain name.²⁶³ The process does not exclude third parties as they have the right to refute the application.²⁶⁴

ICANN’s path is still unclear, but it will put a process in place that will fundamentally differ from the approach utilized by Network Solutions.²⁶⁵ Any policy or procedure that can harmonize the process and decrease the amount of domain name disputes should be welcomed and widely adopted.

VII. JURISPRUDENCE IN THE WAKE OF *BROOKFIELD*.

In a recent holding the Central District of California distinguished *Brookfield* by ruling that the infringing use of “MovieBuff” in *Brookfield* was not similar to the alleged infringing use of PEI’s marks in *Playboy Enterprises, Inc. v.*

256. *Id.*

257. *See Brookfield Communications, Inc. v. West Coast Entertainment Co.*, , 174 F.3d 1036, 1066 (9th Cir. 1999).

258. *DAME*, *supra* note 249, at 8.

259. *See id.*

260. *Id.*

261. *See id.*

262. *See id.*

263. *See id.* at 8-9.

264. *See DAME*, *supra* note 251, at 9.

265. *See id.*

*Netscape Communication, Inc.*²⁶⁶ The court opined that *Brookfield* turned upon the status of the word as a word in its own right.²⁶⁷ The court reasoned that PEI's marks, "Playboy" and "Playmate," as trademarks, are akin to words in the English language, and a trademark holder may not remove a word from the English language.²⁶⁸ Defendant, Netscape Communications, Inc. ("Netscape"), used "playboy" and "playmate" as keywords, triggering certain banner ads to appear on a search engine result page in the event a Web surfer uses the words as search terms.²⁶⁹ PEI asserted that this caused initial interest confusion and resulted in dilution of PEI's trademarks.²⁷⁰ The court found this particular use of PEI's trademarks to be a fair use under the Lanham Act because "[a] trademark holder may not prevent the use of words necessary to communicate ideas."²⁷¹ "Playboy" and "Playmate" are words of common usage in the English language and, as such, should not be afforded protection.²⁷²

The court applied the following three-factor test to determine fair use: "(a) the product must be one not readily identifiable without the use of the trademark . . . ;(b) only so much of the mark may be used as is reasonably necessary; and (c) the user must do nothing in conjunction with the mark to suggest sponsorship or endorsement."²⁷³ In this case, the first factor did not apply because the words "playboy" and "playmate" were used as words of the English language and not as trademarks.²⁷⁴ Netscape won the final two factors because it made only necessary use of the words and did not suggest sponsorship or endorsement.²⁷⁵ In other words, Netscape did not make use of PEI's bunny mark or suggest that they were sponsored or affiliated with PEI.

In distinguishing *Brookfield*, the court stated that West Coast made use of a word not in the English language by using "MovieBuff" in its metatags.²⁷⁶ The Ninth Circuit held that West Coast could make use of the phrase "Movie Buff" because the two words separated by a single space did not infringe upon Brookfield's trademark rights.²⁷⁷ Because "playboy" and "playmate" are words of common usage in the English language and "MovieBuff" is not, Netscape's use of PEI's marks is distinguishable from West Coast's use of Brookfield's trademarks. Therefore, PEI was not granted a preliminary injunction.²⁷⁸

266. 55 F. Supp. 2d 1070, 1074 (C.D. Cal. 1999).

267. *See id.*

268. *See id.* Removing from the English language means that the holder effectively obtained a monopoly on a word that is in common usage. This is not the purpose of trademark law. *See id.* at 1080.

269. *See id.* at 1072.

270. *See id.*

271. *Id.* at 1086 (citing *New Kids on the Block v. News America Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)).

272. *See Netscape*, 55 F. Supp. 2d at 1086.

273. *Id.*

274. *See id.*

275. *See id.* at 1087.

276. *See id.*

277. *See id.*

278. *See Netscape*, 55 F. Supp. 2d at 1087.

The United States District Court for the Central District of California has further limited the holding of *Brookfield* in *The Network Network v. CBS, Inc.* (hereinafter “*Network*”).²⁷⁹ The Network Network brought suit against CBS asserting that its use of “tnn.com” did not infringe CBS’s rights.²⁸⁰ The court held that plaintiff’s use of the domain name, “tnn.com,” created a duty in CBS to know that it was potentially losing rights in its trademark.²⁸¹ “The length of time of concurrent usage of ‘tnn’ before . . . [CBS] complained indicates that Network’s activity did not seriously dilute the value of . . . [CBS’s] trademark.”²⁸² The court did not apply the eight-factor *Sleekcraft* test because “the Sleekcraft test applies only to related goods. . . .”²⁸³ The court expressly stated that using the same medium of advertising, namely the Internet, does not render the services related.²⁸⁴

The *Network* court extended the initial interest confusion from metatags to domain name similarities, but distinguished *Brookfield* on three premises.²⁸⁵ First, unlike *Brookfield*, the court stated that the party asserting priority to “TNN” had actually used the mark it registered as a domain name for over ten years.²⁸⁶ Second, unlike *Brookfield*, there is no substantial overlap of the products offered by the parties.²⁸⁷ Lastly, both companies use the Internet as marketing channels, but unlike *Brookfield*, the consuming public did not associate the similar goods and services with both companies.²⁸⁸ The court concluded that likelihood of confusion was so remote that The Network Network must prevail on its declaratory judgment action.²⁸⁹ “Unlikely indeed is the hapless Internet searcher who, unable to find information on the schedule of upcoming NASCAR broadcasts or ‘Dukes of Hazzard’ reruns, decides to give up and purchase a computer network maintenance seminar instead.”²⁹⁰

Decisions in the wake of *Brookfield* have distinguished yet strengthened the initial interest confusion analysis set forth in the Court’s analysis. The *Netscape* court turned its analysis upon the fact that the marks used by PEI were words of common usage in the English language.²⁹¹ In *Network*, the court’s analysis turned upon the legal determination that The Nashville Network and a vendor of computer networks, The Network Network, were not sufficiently related to foster the level of confusion necessary to facilitate a cause of action under the Lanham

279. 2000 WL 362016 (C.D. Cal).

280. *See id.* at *4.

281. *See id.*

282. *Id.*

283. *Id.* at *5.

284. *See id.* at *5.

285. *See The Network Network v. CBS, Inc.*, 2000 WL 362016, at *8.

286. *See id.*

287. *See id.*

288. *See id.* CBS uses the mark “TNN” as an identifier of its affiliate network, The Nashville Network.

289. *See id.*

290. *Id.*

291. *See Netscape*, 55 F. Supp. 2d at 1087.

Act.²⁹²

VIII. CONCLUSION

In this country, people seek to protect their trademarks by obtaining trademark rights at state and/or federal levels. The federal government has provided a vehicle for exclusive use in the Lanham Act. This grant of exclusive use seeks to prevent others from misappropriating the goodwill established by substantial investments of effort and money. The courts are faced with providing trademark owners a remedy in spite of the ever-changing nature of the Internet. The Internet provides a medium, which allows the real-time dissemination of information to vast numbers of individuals. Because the Internet is never static, competitors may infringe upon another's trademarks and disappear into cyberspace with ease and speed.

The Ninth Circuit's review of these issues will hopefully provide guidance to those not yet faced with the issues of domain name and metatag infringement. The Ninth Circuit has provided a well-reasoned decision by applying well-established principles of trademark law to a relatively new medium. Based on the Ninth Circuit's analysis, other circuits should rule that use of another's trademark as a domain name constitutes infringement, in light of the *Sleekcraft* factors, and that use of another's trademarks in metatags, a tactic used to deceive consumers, is likely to cause confusion. The Ninth Circuit carved out an exception for the use in metatags by allowing fair use to describe or compare one's goods or services.

The Ninth Circuit's later decision in *Netscape* sought to distinguish *Brookfield*, but drew a distinction relying on weak rationale. The court stated that a space between the words "Movie" and "Buff" made a substantial difference when evaluating confusion. West Cost was not precluded from using "Movie Buff" but was precluded from using "MovieBuff." This distinction is very technical and does not serve the purpose of trademark law. The average consumer is not likely to notice a single space between two words when initially considering a purchase. The court relied on the initial interest confusion doctrine to find a likelihood of success in *Brookfield*, but twisted their analysis with the single space distinction.

The forthcoming domain name regulations should provide a more expedient remedy for trademark owners. Until such time, those seeking to establish a Web presence should take heed of the Ninth Circuit's rulings. Practitioners should also take stock of the Ninth Circuit's rulings on metatag infringement. As more individuals become Web savvy, concealing trademarks in one's metatags will become more difficult and the practitioner should cite *Brookfield* to advise against any such practice.

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292. See *The Network Network*, 2000 WL 362016, at *9.