

Richmond Journal of Law and Technology

Volume 6 | Issue 5

Article 3

2000

METATAGS: Seeking to Evade User Detection and the Lanham Act

Terrell W. Mills

Follow this and additional works at: <http://scholarship.richmond.edu/jolt>



Part of the [Intellectual Property Law Commons](#), and the [Internet Law Commons](#)

Recommended Citation

Terrell W. Mills, *METATAGS: Seeking to Evade User Detection and the Lanham Act*, 6 Rich. J.L. & Tech 22 (2000).
Available at: <http://scholarship.richmond.edu/jolt/vol6/iss5/3>

This Article is brought to you for free and open access by UR Scholarship Repository. It has been accepted for inclusion in Richmond Journal of Law and Technology by an authorized administrator of UR Scholarship Repository. For more information, please contact scholarshiprepository@richmond.edu.



Volume VI, Issue 5, Spring 2000

METATAGS: Seeking to Evade User Detection and the Lanham Act

Terrell W. Mills[*]

Cite As: Terrell W. Mills, *METATAGS: Seeking to Evade User Detection and the Lanham Act*, 6 RICH. J.L. & TECH. 22 (Spring 2000) <<http://www.richmond.edu/jolt/v6i5/article1.html>>. **[**]**

TABLE OF CONTENTS

I. INTRODUCTION

II. METATAGS DEFINED

A. *What Are Metatags and How Are They Used?*

B. *Why Use Metatags?*

III. TRADEMARK INFRINGEMENT

A. *Use in Commerce for Goods and Service*

B. *Likelihood of Confusion*

1. *Traditional Multi-Factored Analysis*

2. *Initial Interest Confusion*

C. *Damages*

IV. FALSE ADVERTISING

V. TRADEMARK DILUTION

A. Commercial Use

B. Dilution of the Mark

1. Blurring

2. Tarnishment

3. Other Tests

VI. CONCLUSION

I. INTRODUCTION

{1} You hop on the World Wide Web ready to do some Internet surfing. You decide to check the scores from last night's football game. You head to your favorite search engine and then pause . . . "where will the scores be" you ask yourself. You decide upon ESPN, because you know they have it all when it comes to sports. So, you type in ESPN and click on the "SEARCH" button. You eagerly await the return of the results to head out to the ESPN homepage to find out if your alma mater beat the in-state rival in the big Thanksgiving Weekend match-up. The results return, and the first result the engine returned as matching your search request is the CNN SI site, not the ESPN site. The second entry in the results appears to be a sporting goods retailer named Herman. The third seems to be the site for the Ginsu Knife Company. The fourth is some adult site selling photographs of a "different" sport.

{2} At this point, you become frustrated, consider ending this effort, and getting the local paper. But no, your allegiance to the school, and lack of a dollar fifty for the Sunday edition, cause you to continue to look for the search results' entry for the ESPN site. Finally, somewhere around entry twenty-five, you find the site you are seeking. While you are rewarded because you discover your team beat the big rival in the last five seconds by kicking a field goal, you still wonder: what happened with that search to cause ESPN to be so low on the listing of sites matching your search request?

{3} The answer to the question is metatags. While the above is a fictional account, it is useful to illustrate a very real phenomena on the Internet that is caused in part by metatags. Metatags are hidden codes on webpages that search engines use to determine what topics a webpage covers. When trademarks are placed in metatags, such as the inclusion of the ESPN trademark in the example above, the search engine sees that trademark, considers that site to be related to a search on this trademark, and returns that site in the search results. In the past two years, a number of trademark owners have become upset by the use of their mark in metatags of unrelated websites and have turned to the courts to block such use, basing their claims upon trademark law.^[1]

{4} The theories that plaintiffs have advanced include: (1) trademark infringement of registered and unregistered marks; (2) false advertising; and (3) dilution. These cases pose unique challenges for the courts because no tangible, real world counterpart to metatags exists, providing no analogy or paradigm for the court to use in analyzing the claims. This paper evaluates the validity of each of these potential claims resulting from the use of a trademark in webpage metatags, concluding that trademark law is ill-equipped to address metatag misuse.

{5} In order to understand the analysis of the legal issues, it is important to first understand what metatags are,

how they are used, and why websites utilize them. This is the focus of section two of this paper. The third section analyzes current trademark infringement laws and their potential applicability to trademark use in metatags. The fourth section looks at the claim of false advertising, and the fifth considers the dilution claim for the use of trademarks in metatags.

II. METATAGS DEFINED

A. What Are Metatags and How Are They Used?

{6}A metatag is part of the webpage programming language that is embedded on a webpage, but never seen by the end user.[2] There are multiple types of metatags, but for this discussion, the critical metatag type is the "keyword" metatag.[3] The keyword metatag allows a website creator or operator to specify terms that describe the site. A search engine then indexes these terms by the use of a "spider." [4] A "spider" crawls the "web" looking at every website and building an index.[5] The spider often gives priority to the terms in the metatags when building the index.[6] When a user executes a search with a search engine, the engine reviews the index that the spider previously generated to determine which sites match the submitted search request.[7] The search engine then returns all the sites that are found to have terms matching the request.[8]

B. Why Use Metatags?

{7}As of the beginning of 1999, the number of public websites exceeded 2.8 million,[9] with predictions of the number continuing to double or triple every six months.[10] With this type of volume, a website has a daunting task to attract users. A website, however, must attract users in order to make money. A website makes money from users through two means. The first is the opportunity to sell the user the products or services offered on the site.[11] The second is by selling advertising space on the website to third parties, the price of which depends on the volume of users that visit the site, regardless of whether the user purchases any products at the site.[12]

{8}Because of this need to attract users, website operators must market sites, as well as products or services.[13] Most users who seek information use a search engine to identify the prospective sites that contain the information they desire. Therefore, to be successful in marketing a website, an operator must design a marketing strategy that ensures that the search engine will frequently list the site in its search results. Additionally, it is not enough to be a resulting site from a search. A website needs to be ranked highly on the list of returned sites because users often fail to go beyond the top ten to twenty sites returned.[14] The marketing strategy, therefore, must focus both on making the list, and on being at the top. This leads to the use of metatags.[15]

{9}Webpage developers advocate the use of metatags because they know this is the most effective way to increase the exposure of the site.[16] This often involves the inclusion of extensive numbers of terms, variations of a term,[17] and repetitive uses of a term.[18] Realizing the power of the metatag, many website operators have elected to include terms in the metatags that have nothing to do with the site, simply in an effort to increase the number of users that visit the site.[19] This is analogous to the Ginsu Knife site in the fictional scenario at the opening of this article. This increased traffic should result in similarly increased advertising revenues.

{10}Other operators include trademarks where they have a companion or ancillary product to that of the trademark owner.[20] This is analogous to the Herman's site in the fictional scenario. Finally, operators in direct competition with the trademark owner have included the mark in the metatags in an attempt to draw user traffic away from the competing site.[21] This corresponds to the CNNSI site in the fictional scenario.

{11} Each of these situations certainly conjures feelings of impropriety. Trademark owners whose marks have been used in this manner feel as though these types of actions are illegal. Regardless, the question remains whether such metatag "misuse" is illegal.^[22] However, not all courts follow this guiding principle.

III. TRADEMARK INFRINGEMENT

{12} The Lanham Act^[23] provides protection from trademark infringement in two sections, §§ 32(1) and 43(a)(1)(A). Section 32(1) prohibits the use in commerce of a copy of a registered mark in connection with the sale, distribution, or advertising of goods or services if such use is likely to cause confusion.^[24] Section 43(a)(1)(A) provides essentially the same protection for unregistered marks, and is commonly referred to as unfair competition.^[25] The term trademark infringement shall be used herein to refer to both infringement of registered trademarks and unfair competition.

{13} To prevail in an infringement action, the plaintiff must prove: (1) a copy of a mark was used; (2) the use was in commerce; (3) the use was in connection with goods or services; and (4) the use is likely to cause confusion.^[26] Of these, the likelihood of confusion element has raised the most discussion in relation to metatag usage.

A. Use in Commerce for Goods and Services

{14} Before turning to the discussion of likelihood of confusion, it is worth noting briefly the comments of the court in *Planned Parenthood Federation of America, Inc. v. Bucci*^[27] regarding the "use in commerce" and the "in connection with goods or services" elements in the context of an Internet trademark infringement action. The court stated that the "use in commerce" element is merely a jurisdictional prerequisite Congress must establish in order to justify the statute under the Commerce Clause and should be construed very broadly.^[28] With that in mind, the court determined that users must access the Internet via phone lines, which are part of interstate commerce, and the purpose of a webpage is to allow a world wide audience to access it.^[29] Therefore, a webpage, which encourages world wide access via phone lines, meets the requirement of "use in commerce."^[30]

{15} With regard to "in connection with goods or services," the court determined that the connection can properly be made with either the alleged infringer's goods or any goods that are advertised on the site.^[31] Therefore, merely selling advertising space is sufficient to bring a web operator under the "in connection with goods or services" element. The tests for both "use in commerce" and "in connection with goods or services" are exceedingly broad. Almost all commercial websites will meet these tests, reducing these elements to minimal importance in the analysis of trademark infringement.

B. Likelihood of Confusion

1. Traditional Multi-Factored Analysis

{16} Since most commercial websites will meet the "use in commerce" and "in connection with goods or services" elements, it appears that the trademark owner may have a chance at success under the infringement provisions of the Lanham Act. This brings us to the likelihood of confusion, considered to be the "keystone of infringement."^[32] Each of the federal circuits has adopted different multi-factored tests for determining if likelihood of confusion exists, though they all overlap.^[33] The key factors can be summarized as (1) similarity of the two marks; (2) the similarity in channels of distribution; (3) the sophistication of the buyers and the care they are likely to use; (4) the alleged infringer's intent; (5) with noncompetitive goods, whether buyers would expect the mark owner to expand into the field occupied by the alleged infringer; and (6)

evidence of actual confusion.[34]

{17}The nature of these factors points out that this type of test does not fit well with the concept of metatag misuse.[35] Consider the CNNSI case from the fictional scenario, which would appear to offer the strongest infringement possibility because the two sites are direct competitors. In that case, the ESPN trademark is included in the metatag, but does not appear on the webpage. How does that apply to the analysis of the similarity of the marks? If one were looking at the programming code, the marks would be considered identical, yet the user has never been faced with seeing two conflicting marks. Furthermore, when the user goes to the CNNSI site, it is clear to the user that is not the ESPN site and there is no mention of ESPN.

{18}The single thread upon which to tie likelihood of confusion comes down to the inclusion of a site in a listing of search results potentially containing hundreds or thousands of sites, where the list was generated from a request that included a trademark. Given the nature of search engine results, even an unsophisticated user is not likely to be confused into believing that the site is connected to ESPN simply because the site was returned from a search request on ESPN.[36] It appears that the metatag only confused the search engine.[37]

{19}In *Playboy Enterprises, Inc. v. Welles* ("Welles I"),[38] one of the few cases to address metatag trademark infringement, the defendant used the trademark both in the metatags and on the site, removing the difficulty posed by the hidden metatag use.[39] In considering the likelihood of confusion, the court enumerated the eight-factor test for the circuit, then proceeded to dismiss the test.[40] The court noted that the test was merely a guideline to be used in evaluating consumer confusion, and that this case was "not a standard trademark case and [did] not lend itself to the systematic application of the eight factors." [41] The judge, however, determined that the defendant had a fair use defense that negated the need for determining the likelihood of confusion,[42] leaving open the question of how to evaluate the likelihood of confusion relating to metatags.

{20}The *Welles I* court is correct. The multi-factor test is inapplicable in a case of metatag misuse. Therefore, if we return to a common sense approach to likelihood of confusion, it must fail. It is unlikely that a consumer will be confused to origin, sponsorship or affiliation based solely on the fact that a site was returned in a search result.[43] This misuse of a trademark "has the feel of a 'bad actor,'" [44] however, it simply does not amount to trademark infringement where the likelihood of confusion is measured under traditional multi-factored tests.

2. Initial Interest Confusion

{21}The only circuit court that has addressed the issue of metatag misuse is the Court of Appeals for the Ninth Circuit in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*[45] *Brookfield* was a preliminary injunction case where a video store used the mark MOVIEBUFF in the metatags of its website and as its domain name.[46] The owner of the mark MOVIEBUFF is a software company that provides a database of movie statistics.[47] The court conducted the multi-factor test for the domain name use and held that mark owner had demonstrated that it was likely to prevail on its claim of trademark infringement.[48]

{22}Then, turning to the metatag use, as had the *Welles I* court,[49] the *Brookfield* court enumerated the eight-factor test for the circuit.[50] However, rather than follow *Welles I* and dismiss the test as inapplicable in this context, the *Brookfield* court specifically stated that the test was not meant to be an exhaustive list of factors and that the court must be cautious of applying such a test too rigidly to Internet cases.[51] Furthermore, the court concluded its consideration of the multi-factored test, stating that the "emerging technologies require a flexible approach." [52]

{23}With the foundation laid to depart from the traditional multi-factored analysis, the court announced its new standard for metatag cases - initial interest confusion.[53] Initial interest confusion is consumer

confusion that exists for only a short period of time and that results in the consumer being attracted to the person or company misusing the trademark of another. This confusion is quickly dispelled once the consumer reaches the location and has clear evidence that it is not related to the trademark owner. Thus, the confusion at issue is the confusion that caused the consumer to go to the trademark misuser's location, not the traditional confusion to source of goods or services.[\[54\]](#)

{24}The court analogized the metatag misuse scenario to highway billboards. For example, Store Y places a highway sign that advertises that Store X is at Exit 7, when Store X is actually at Exit 8 and Store Y is at Exit 7. The consumer, in search of Store X, exits at Exit 7, but does not find Store X and instead finds Store Y. The consumer, realizing that Store Y is similar to Store X, and knowing that the two stores are not related, elects to shop Store Y, rather than continue to search for Store X. Therefore, this issue is no longer one of confusion; rather, the issue becomes Store Y misappropriating the goodwill of Store X.[\[55\]](#) Based on this logic, the court held that the inclusion of the mark in the metatags constituted trademark infringement.[\[56\]](#)

{25}While on the surface, initial interest confusions appears to provide courts with a legitimate avenue to find infringement in metatag cases, the logic of this approach breaks down under greater scrutiny. First, this logic depends upon the web user actually going to the site misusing the trademark in the metatags. Secondly, the user needs to be confused at the time he goes to that site. In a pure metatag misuse situation, consisting of a situation where there is no visible use of the mark, neither is likely to be true.

{26}Users are accustomed to receiving search results that have volumes of unrelated and often irrelevant sites. Because of this, users sift through the listing to find the site they actually desire. If the site misusing the trademark in the metatags has made no visible reference to the mark, the user will skim past that result and never go to the misuser's site. When put into the context of the highway analogy given by the *Brookfield* court, the trademark misuser may have succeeded in obtaining rights to put up a billboard by using someone else's mark, but the billboard itself correctly identifies the advertising party. If the highway traveler is not interested in the actual advertising party, he simply continues down the highway. The traveler has not been deceived into believing that the location he seeks is at that exit. The only initial confusion was on the part of the person granting the rights to put up the billboards. In the alternative, when viewed in the web context, only the search engine was confused, not the user. This analysis changes if coupled with visible misuse of the mark, as presented in *Brookfield*. With a visible misuse of the mark, the user does have reason to pause upon that particular result in the listing and to possibly go to that site.

{27}Secondly, if the user knows that the site is not related to the searched-for mark and still elects to visit the site, this is not done based on initial interest confusion. The user reviewed the description presented by the search engine that contained no reference to the trademark and knew that it was an unrelated site. Choosing to visit the site at that stage is not done based on confusion. Therefore, there is no initial interest confusion in a pure metatag scenario, as opposed to metatag misuse coupled with visible misuse.[\[57\]](#)

{28}Given the lack of confusion that results from a pure metatag case, the *Brookfield* result appears to be driven not by the illegality of the metatag trademark use, but rather by the visible trademark infringement coupled with the metatag trademark use. The court indicates that the result would be the same regardless of the visible use.[\[58\]](#) Translating this approach to pure metatag trademark use, the courts are abdicating their responsibility to assess the legality of the trademark use and are being driven by a general sense of right and wrong.

{29}Although the *Brookfield* analysis and invocation of initial interest confusion is flawed, it is the current law of the Ninth Circuit. One district court in the Ninth Circuit has already been faced with a metatag case under the *Brookfield* law, *Playboy Enterprises, Inc. v. Terri Welles, Inc.* ("*Welles II*").[\[59\]](#) The *Welles II* opinion has highlighted the malleability of the initial interest confusion test.

{30} In *Welles II*, the court first noted that a finding of initial interest confusion alone does not mandate a finding of infringement.^[60] Then, the court distinguished the cases cited by *Brookfield* as having other findings indicating wrongful conduct on the part of the infringing party and suggesting that such other conduct may be necessary to find infringement based on initial interest confusion.^[61] In preparation for finding no initial interest confusion, the *Welles II* court then cites the *Brookfield* language mandating flexibility in applying trademark infringement test to emerging technology.^[62] With this interpretation of the *Brookfield* opinion, the *Welles II* court found that Playboy has failed to show any wrongful conduct, and therefore, there was no basis for an infringement claim.^[63] The *Welles II* court then stated that Welles has a fair use defense, showing that fair use is a valid defense to both initial interest confusion and traditional confusion to the source of goods and services.^[64]

{31} The door opened by *Brookfield* for finding infringement based upon initial interest confusion has been knocked off its hinges by *Welles II*. *Welles II* shows that the courts can manipulate the initial interest confusion test to suit their morality, and that it does not provide a test that can be used to provide judicial consistency in application of the Lanham Act.

C. Damages

{32} Metatags play a greater role in trademark infringement, where the site uses visual depictions of the trademark in addition to the metatag because metatag use clearly points to willful conduct, providing for a greater award of damages under Section 35 of the Lanham Act.^[65] In *Playboy Enterprises, Inc. v. AsiaFocus International, Inc.*,^[66] AsiaFocus used the Playboy and Playmate marks on its site, in its domain name, e-mail address, and metatags.^[67] Additionally, the court had evidence of actual confusion.^[68] The court held that AsiaFocus had infringed on the Playboy trademarks.^[69] When considering damages, the *AsiaFocus* court awarded damages based upon section 35(c)(2), which provides that willful use of a counterfeit mark entitles the owner to damages of up to \$1,000,000 per mark per category of goods sold.^[70] The court noted at several points in the discussion that the conduct of AsiaFocus was willful, which was illustrated by the "purposeful tactic of embedding the trademarks . . . in the hidden computer source code."^[71] The court found the use to be sufficiently broad and blatant to justify the award of the full statutory amount, \$1,000,000.^[72]

{33} Based solely upon the misuse of a trademark in a hidden metatag, it appears that a trademark owner should not succeed in establishing a likelihood of confusion. However, if coupled with traditional, visible misuse of the trademark, a court may seize upon the feeling of a "bad actor," and open the doors to large statutory damages.

IV. FALSE ADVERTISING

{34} Section 43(a)(1)(B) provides protection from false advertising to trademark owners.^[73] To succeed on a false advertising claim, the trademark owner must prove "at least the following three elements: (1) [d]efendants made false or deceptive advertisements or representation to customers; (2) those advertisements deceived a significant portion of the consuming public; and (3) [the trademark owner was] injured by [d]efendants' conduct."^[74] As this test illustrates, the trademark owner does not have to establish a likelihood of confusion, the element that weighs against a successful infringement claim. To date, no court has discussed the false advertising claim in relation to a metatag misuse.^[75]

{35} While the removal of the requirement of proving likelihood of confusion seemingly benefits the trademark owner, such glory is short lived. The trademark owner must now show that a significant portion of the consuming public was actually deceived by the use of the metatags. Given the same reasons that point to a failure to establish likelihood of confusion in an infringement action, it seems even more remote that a

trademark owner could show actual deception.[76] Furthermore, the form of the metatag fails to conform to the expectation of a commercial advertisement or promotion because it is never seen by the user.[77] For these reasons, a claim of false advertising will be rendered ineffective.

V. TRADEMARK DILUTION

{36}Prior to January 1996, when the Federal Trademark Dilution Act of 1995 ("the Act") [78] was signed into law by the President, the federal trademark law had no protection for trademarks based upon dilution.[79] The dilution provision provides the trademark owner another cause of action that is not dependent upon the likelihood of confusion.[80] Further, this action attempts to preserve the distinctiveness of the owner's trademark, as opposed to the other trademark laws, which have a dual purpose of protecting an owner's goodwill in the mark and protecting the public from confusion, deception, and mistake.[81] From this general view, it appears that dilution may provide an even stronger basis for attacking metatag trademark misuse than a traditional infringement action.

{37}Section 43(c) of the Lanham Act creates a right of action for a trademark owner when the owner's famous mark has been diluted by the use of the mark by a separate party.[82] In order to prevail in a claim of dilution, the plaintiff must prove that:

- (1) the mark is famous; (2) the defendant is making a commercial use of the mark in commerce;
- (3) the defendant's use began after the mark became famous; and (4) the defendant's use of the mark dilutes the quality of the mark by diminishing the capacity of the mark to identify and distinguish goods and services.[83]

{38}Of these elements, those that pose the greatest challenge for application to metatags are commercial use [84] and dilution. If the mark had no fame or notoriety, the webpage operator would not be including the mark in the metatags because such use would not attract more users to the site. For the same reasoning, it is given that the use of the mark as a metatag post-dates the mark reaching famous status. That is not to say that in a lawsuit such defenses would not be raised. Such arguments, however, would not be credible when used in the context of a metatag for a site that makes no explicit mention of the trademark.

A. Commercial Use

{39}The Act characterizes use in commerce for goods as the placement of the mark "on the goods or their containers or the displays associated therewith . . . or if [such placement is] impracticable, then on documents associated with the goods or their sale, and the goods are sold or transported in commerce. . . ." [85] The Act similarly classifies use in commerce for services to occur "when [the mark] is used or displayed in the sale or advertising of services and the services are rendered in commerce. . . ." [86] Pursuant to these definitions, the trademark must be displayed on or in connection with the goods or services being sold.

{40}With this definition in mind, consider the website that only provides information to users, but has embedded in its metatags a famous trademark to attract traffic to its site. It does not mention or use the mark in the visible display of the site. Does this amount to commercial use? Because it is never displayed to the user, it is hard to fit this situation under the Act's characterization of use in commerce. The web operator is not using the mark in any visible manner.

{41}The courts have not had the opportunity to consider this exact question. But, in *Panavision International, L.P. v. Toeppen*, [87] the court was faced with a similar challenge to the commercial use standard under the Lanham Act's dilution provisions. In *Panavision*, Toeppen was a cybersquatter [88] who had registered the domain name Panavision.com. [89] The webpage simply displayed pictures of Pana,

Illinois.^[90] Panavision, upon discovering that Toeppen had registered the name, sent him a cease and desist letter. Toeppen then attempted to sell the name to Panavision International for \$13,000.^[91]

{42} Toeppen challenged the district court's finding that he was using the mark in commerce.^[92] He argued that "a user who types in Panavision.com, but who sees no reference to the plaintiff Panavision on [his] webpage, is not likely to conclude the webpage is related in any way to the plaintiff, Panavision."^[93] The court, rejecting Toeppen's argument, stated that it did "not matter that he did not attach the marks to a product."^[94] He was seeking to trade on the value of the mark by attempting to sell the domain name to Panavision, and that met the commercial use requirement.^[95]

{43} It appears that the court was motivated to find a commercial use here because of the bad intentions of Toeppen, though those intentions in no way met the requirements of the Act.^[96] Likewise, in a metatag case where there is no visual display of the mark, it is likely that the court will be inclined to find a commercial use when the trademark use was inspired by bad intentions. Given that the two main reasons for using such marks are commercial in origin, to sell products and to sell advertising space, such use will clearly fit within the exceedingly broad parameters set by the *Panavision* court for commercial use on the Internet -- to trade on the value of the mark.^[97]

B. Dilution of the Mark

{44} The Act defines dilution as "the lessening of the capacity of a famous mark to identify and distinguish goods or services, regardless of the presence or absence of (1) competition between the owner of the famous mark and other parties; or (2) likelihood of confusion, mistake, or deception."^[98] This definition has been described as providing "little help in determining what the 'lessening' of distinctiveness means. . . ."^[99] With the limited guidance provided by the statute, it has been suggested that metatag analysis may be conducted based upon either the dilution by blurring test or the dilution by tarnishment test, both imported into federal law from state dilution laws.^[100]

1. Blurring

{45} Blurring results from other uses of the mark that do not create confusion, but that somehow "diminish the ability of the mark to trigger an immediate association between the mark and its owner."^[101] In the metatag context, this type of disassociation is hard to establish. The user will not see the famous mark in the listing of the search results, nor on the webpage, should the user visit the page. While the user may wonder why this site has been included in the list, this does not lead to disassociation in the context presented by metatag misuse. As one court has noted, a search based upon a trademark can generate 800 to 1,000 matches.^[102] This suggests that users are all too familiar with the discrepancy between the sites the user was targeting and the results of a search, and that users accept many irrelevant results.^[103] With this type of user experience and expectation, the mere inclusion of the site on the list of search results does not generate blurring of the trademark.

2. Tarnishment

{46} Dilution by tarnishment occurs when the "trademark is linked to products of shoddy quality, or is portrayed in an unwholesome or unsavory context likely to evoke unflattering beliefs about the owner of its products."^[104] The metatag scenario providing the opportunity for such a claim exists when a pornographic site has used a famous mark, such as the fourth site returned in the fictional scenario in the introduction of this article.

{47} In the context of the fictional scenario, it seems clear that ESPN has been tarnished by the adult site

including the mark among the metatags for the site. Merely being linked, however, is not sufficient to establish dilution under the tarnishment test. ESPN would also have to establish that the adult site's use "evoked unflattering beliefs" about ESPN, which would be difficult to prove.^[105] As discussed above with blurring, the site does not use the mark, and users have become accustomed to many irrelevant sites being included in search results.^[106]

3. Other Tests

{48} While it seems improbable that a challenge to metatags can survive under either the blurring or tarnishment tests, the courts are not restricted to these approaches. As noted above, these state law doctrines have been imported to the federal law because of lack of guidance on how to determine when dilution occurs. Given that the Internet is a unique, independent entity, and that there is no real-world equivalent to metatags, it seems likely that the courts will fashion a new test for this medium. The Ninth Circuit has started to blaze this trail in *Panavision*.

{49} The *Panavision* court explicitly rejected the use of blurring or tarnishing for determining if a domain name registration diluted the value of a trademark.^[107] Citing the district court opinion, the court notes that dilution has occurred when the use "diminishe[s] the capacity of the Panavision marks to identify and distinguish Panavision's goods and services on the Internet."^[108] Furthermore, the court states that requiring the user to wade through hundreds of websites in search of the trademark owner's site dilutes the value of the trademark.^[109]

{50} Applying this dilution approach to the metatag situation, a strong argument can be made that the mark has been diluted. For every site that uses the trademark in the metatag, the number of sites returned from a search is increased. Therefore, the user must wade through a higher number of sites, increasing the likelihood that the user will become frustrated and quit the search before finding the site of the trademark owner.

{51} While this approach holds more promise for establishing liability, the realities of the situation logically oppose such a result. The Internet user community has become accustomed to the inadequacies of the search engine and search results numbering in the thousands. Yes, wading through the site listing is quite frustrating, but it is hard to convert that frustration into a lessening of the capacity of a mark to distinguish goods or services, especially when the mark is never visually depicted in reference to the diluting user. Regardless of the factual realities, courts may be willing to stretch the statutory language by fashioning a new test that exceeds the bounds of the literal language because the misuse of metatags simply seems unfair. What this situation really begs for is a market solution, such as the yellow pages of the Internet, rather than a "judicial stretching" of the law.^[110]

VI. CONCLUSION

{52} It should be difficult for a trademark owner to establish a cause of action under the Lanham Act because of the following requirements: (1) the lack of any visual connection between the trademark and the webpage misusing the trademark; and (2) the common user experience of receiving many irrelevant sites from search requests. The situation of pure metatag misuse fails to meet the statutory requirements for infringement, false advertising, or dilution. The inclusion of another's trademarks in a webpage's metatag, however, reeks of impropriety, which may be enough to provoke the commercial morality of the courts, as shown by the *Brookfield* opinion. So provoked, courts may continue to stretch the trademark laws to encompass such actions.

{53} This "judicial stretching" should more likely occur under a claim of dilution, rather than under infringement because dilution is more concerned with protecting the owner's value in the trademark; whereas,

infringement focuses more on the protection of the public. While dilution appears the more likely candidate for stretching, the courts have not shown a desire to do this thus far. Rather, the courts seem to prefer stretching trademark infringement law to the point of breaking. Neither approach to expanding the trademark laws to encompass metatag misuse, however, stands on solid statutory ground.

ENDNOTES

[*] Mr. Mills is an associate at Mezzullo & McCandlish, P.C. in Richmond, Virginia, where he focuses his practice on Corporate and Intellectual Property Law. He graduated with honors from Georgia Institute of Technology in 1988, where he earned a B.I.E. For the eight years prior to attending the University of Richmond School of Law, Mr. Mills worked as a management consultant, specializing in the design, development and implementation of custom software systems. He earned his J.D. in 1999, *magna cum laude* from the University of Richmond. During law school, Mr. Mills was a member of the McNeill Law Society and the *University of Richmond Law Review*. The author would like to thank Professor Deborah Tussey for her guidance and his family, Benjie, Morgan, and Grace Mills for their patience.

[**] **NOTE:** All endnote citations in this article follow the conventions appropriate to the edition of THE BLUEBOOK: A UNIFORM SYSTEM OF CITATION that was in effect at the time of publication. When citing to this article, please use the format required by the Seventeenth Edition of THE BLUEBOOK, provided below for your convenience.

Terrell W. Mills, *METATAGS: Seeking to Evade User Detection and the Lanham Act*, 6 RICH. J.L. & TECH. 22 (Spring 2000), at <http://www.richmond.edu/jolt/v6i5/article1.html>.

[1]. See *Brookfield Comm., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1041 (9th Cir. 1999) (seeking a preliminary injunction against use of terms confusingly similar to trademark); *Playboy Enterprises, Inc. v. Terri Welles, Inc.*, 78 F. Supp. 2d 1066, 1070 (S.E. Cal. 1999) (granting summary judgment to metatag user based on "fair use" defense); *Playboy Enterprises., Inc. v. Welles*, 7 F. Supp.2d 1098, 1099-1100 (S.D. Cal. 1998) (denying preliminary injunction to force metatag user to cease such use based on "fair use" defense), *aff'd* 162 F.3d 1169 (9th Cir. 1998); *Playboy Enterprises., Inc. v. Calvin Designer Label*, 985 F. Supp. 1218, 1219 (N.D. Cal. 1997) (finding that plaintiff would be likely to succeed on the merits in proving trademark infringement); *Oppedahl & Larson v. Advanced Concepts*, No. 97-Z-1592, 1997 U.S. Dist. LEXIS 18359 (D. Colo. Feb. 6, 1998) (granting parties' Joint Motion for Final Judgment permanently enjoining the defendant from using plaintiff's trademark without authorization, and thus settling the case without trial); *Playboy Enterprises., Inc. v. AsiaFocus Int'l, Inc.*, No. 97-734-A1998 U.S. Dist. LEXIS 10359, at *1 (E.D. Va. Feb. 2, 1998) (finding defendants created a false association); *Insituform Technologies, Inc. v. National Envirotech Group LLC*, No. 97-2064 (E.D. La. Aug. 26, 1997) (settled without trial). A discussion of the case can be found at Cowan, Liebowitz & Latman, P.C., *CL&L Successfully Stops a Competitor's New Form of Website Unfair Competition* (visited Mar. 15, 2000) <<http://www.cll.com/keyword.htm>>. Access to pleadings and related material to most of these cases can be found at John Marshall Law School, *Meta-tagging and "Spamdexing"* (visited Mar. 14, 2000) <<http://www.jmls.edu/cyber/index/metatags.html>>.

[2]. See Excite, *Understanding Meta Tags* (visited Mar. 14, 2000) <http://www.excite.com/info/getting_listed/meta_tags/> (explaining what metatags are and Excite's policy regarding use of metatags with their search engine); see generally, Search Engine Watch, *How to Use HTML Meta Tags* (visited Mar. 14, 2000) <<http://searchenginewatch.com/webmasters/meta.html>> (outlining the

benefits of metatags).

[3]. See Maureen A. O'Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability of Metatagging*, 33 *Gonz. L. Rev.* 277, 281 (1997-98) (noting the existence of description metatags in addition to keyword metatags); SUNY Brockport, *Using Meta Tags on Your Web Page* (visited Mar. 14, 2000) <<http://cc.brockport.edu/~campus22/meta.html>> (describing metatags as "keywords that will be used in addition to the text of the page"). *Id.*

[4]. A spider is an Internet search device that use metatags to identify matching sites to search requests. Alta Vista, WebCrawler, HotBot, and Lycos are common search engines that use the metatags. See David Loundy, *Hidden Code Sparks High-Profile Lawsuit* (visited Mar. 14, 2000) <http://www.loundy.com./CDLB/Meta_Tags.html>.

[5]. See *id.*; see also SUNY Brockport, *supra* note 3 (describing how search engines scan webpages searching for keywords).

[6]. See Alta Vista, *META Tags: Controlling How Your Web Page Is Indexed by AltaVista* (visited Mar. 15, 2000) <<http://www.altavista.com/cgi-bin/query?pg=addurl>> (explaining how AltaVista uses metatags to index websites). But see Excite, *supra* note 2 (describing Excite's belief that metatag information is not reliable and asserting Excite's policy to index sites based upon the actual content of the text displayed when the sites are viewed by the end user).

[7]. See Jeffrey R. Kuester & Peter A. Neives, *Hyperlinks, Frames and Meta-Tags: An Intellectual Property Analysis*, 38 *IDEA* 243, 247 (1998) (describing how spiders function).

[8]. See O'Rourke, *supra* note 3, at 283 (describing metatags and the metatag indexing process).

[9]. See Jason Zien, *Internet Industry* (visited Mar. 15, 2000) <<http://internet.about.com/industry/internet/library/weekly/1999/99071399a.htm>> (discussing a recent study in *Nature* estimating the number of webpages and websites and the estimating methodology); see also Kuester & Neives, *supra* note 7, at 245 (stating that as of August, 1997, the number of websites tallied is 1,269,800).

[10]. See O'Rourke, *supra* note 3, at 278 (citing *Using the Internet for Tax Preparation*, *Acctg. Today*, Aug. 11, 1997).

[11]. See *id.* at 284 (identifying attracting visitors as the first step in website sales).

[12]. See *id.* at 282, 284; see also Mark Sableman, *Business Liabilities on the Internet*, 16 *Comm. Law* 3 (1998) (reporting that "[b]anner advertising is a significant source of revenue for some commercial webpages, and many banner advertising contracts are written so that costs are related to the number of 'hits' on a page."). *Id.*

[13]. See O'Rourke, *supra* note 3, at 278.

[14]. See *id.* at 284 (citing Guy Alvarez & Peter Curran, *The Secrets of Marketing a Law Firm's Website*, N.Y. L. J., July 21, 1997, at S7); see also *How We Do It* (visited Feb. 24, 2000) <<http://www.getontop.com/how.html>> (offering services to customers that are directed at improving the rank of the website on search engine results).

[15]. See Loundy, *supra* note 4 (discussing *Oppedahl & Larson v. Advanced Concepts*, No. 97-Z-1592, 1997 U.S. Dist. LEXIS18359); O'Rourke, *supra* note 3, at 285 (citing Tim Jackson, *The Case of the Invisible Ink*,

Financial times, Sept. 22, 1997, at 17).

[16]. See O'Rourke, *supra* note 3, at 282, 282 n.17.

[17]. See Walter A. Effross, *The Legal Architecture of Virtual Stores: World Wide Websites and the Uniform Commercial Code*, 34 SAN DIEGO L. REV. 1263, 1319 (1997) (advising that using variations of keywords is a way to maximize their usefulness).

[18]. See Ian C. Ballon, *Linking, Framing and Other Hot Topics in Internet Law and Litigation*, 520 Prac. L. Inst. 167, 247 (1998) (citing *Oppedahl & Larson v. Advanced Concepts*, No. 97-Z-1592, 1997 U.S. Dist. LEXIS 18359).

[19]. See O'Rourke, *supra* note 3, at 285-86 (discussing pornographic sites that have included the term "Mir" or "Princess Diana" to attract visitors because the operators believed these to be commonly searched terms).

[20]. See Wendy R. Leibowitz, *Firms Sues for Invisible Use of Its Trademark on 'Net: Partner Protests Use of His Law Firm's Name in 'MetaTags,' or Website Codes* (visited Mar. 15, 2000) <<http://cyber.law.harvard.edu/metaschool/fisher/linking/meta/meta8.html>> (discussing the *Oppedahl & Larson* case where a webpage developer included the *Oppedahl & Larson* firm name repetitively in its metatags because the firm is a high profile player in the web's legal market); see also Loundy, *supra* note 4 (discussing *Oppedahl* case).

[21]. See *Playboy Enterprises, Inc. v. AsiaFocus Int'l, Inc.*, 1998 U.S. Dist. LEXIS 10359, *8 (E.D. Va. Feb. 2, 1998) (finding willful infringement and awarding a default judgment of \$300,000).

[22]. See *Intermatic Inc. v. Toepfen*, 947 F. Supp. 1227, 1233-34 (E.D. Ill. 1996) (stating "[r]egardless of one's view as to the morality of such conduct, the legal issue is whether such conduct is illegal."). *Id.*

[23]. 15 U.S.C. §§ 1051-127 (1994 & Supp. IV 1998).

[24]. Section 32(1) provides in full: 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; or

(b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is likely to cause confusion, or to cause mistake, or to deceive, shall be liable in a civil action by the registrant for the remedies hereinafter provided. Under subsection (b) hereof, the registrant shall not be entitled to recover profits or damages unless the act have been committed with knowledge that such imitation is intended to be used to cause confusion, or to cause mistake, or to deceive.

As used in this paragraph, the term "any person" includes any State, any instrumentality of a State, and any officer or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

15 U.S.C. § 1114(1) (1994 & Supp. IV. 1998).

[25]. See *Tonowanda Street Corp. v. Fay's Drug Co.*, 842 F.2d 643, 646-47 (2d Cir. 1988) (stating that Section 43(a) may be used to assert infringement of an unregistered trademark). Trademark infringement for unregistered marks under Section 43(a) is commonly referred to as unfair competition. See *Brookfield Comm., Inc. v. West Coast Ent. Corp.*, 174 F.3d 1036, 1047 n.8 (9th Cir. 1999).

Section 43(a)(1) provides in full:

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

(B) in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities, 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.

15 U.S.C. § 1125(a)(1) (1994).

[26]. See J. Thomas McCarthy, *McCarthy on Trademarks* § 27.13 (3d ed. 1996).

[27]. 1997 U.S. Dist. Lexis 3338, 42 U.S.P.Q.2d 1430 (S.D.N.Y. 1997).

[28]. See *id.* at *1, 10-11, 42 U.S.P.Q.2d at 1434.

[29]. See *id.*

[30]. See *id.* But cf. *infra* Section V A (discussing the "commercial use in commerce" requirement in a dilution claim.).

[31]. See *Planned Parenthood*, at *10-13.

[32]. McCarthy, *supra* note 26, § 23:1.

[33]. *Id.*

[34]. See *id.*

[35]. See Loundy, *supra* note 4 (stating that a metatag "suit is not an easy fit with the law").

[36]. See Tim Jackson, *The Case of the Invisible Ink*, *Fin. Times*, Sept. 22, 1997, at 17 (noting that users have few illusions about the relevancy of the majority of the sites provide in a search result listing).

[37]. See O'Rourke, *supra* note 3, at 294.

[38]. 7 F. Supp.2d 1098 (S.D. Cal. 1998).

[39]. *See id.* at 1100 (describing defendant's disclaimer).

[40]. *See id.* at 1103.

[41]. *Id.*

[42]. *See id.* at 1104. The court determined that the defendant's use of the trademarks on the site was justified, and that the inclusion of the term in the metatags was justified, both because the trademark was descriptive of the defendant and because she had fairly used the trademark in an editorial fashion. *See id.* This suggests that a site that wishes to include their competitor's trademark can do so and avoid potential infringement by making some legitimate use of the other's mark, such as comparative advertising, and thereby justify the use of the trademark in the metatag.

[43]. *See O'Rourke, supra* note 3, at 295 (stating that "[g]iven the relative novelty of commercial exploitation of the Internet as well as consumer use of that medium, it is appropriate to seek evidence of actual confusion before finding a violation of the Lanham Act. That evidence may, in fact, be quite hard to come by.") *Id.*

[44]. Loundy, *supra* note 4.

[45]. 174 F.3d 1036 (9th Cir. 1999).

[46]. *See id.* at 1043. The amount of actual use of the mark in the domain name and metatags was limited because of the success of the mark owner in obtaining an injunction from continued use of the website during the litigation. *See id.* at 1043-44.

[47]. *See id.* at 1041 (including movie credits, box office receipts, films in development, film release schedules, entertainment news, and listings of executives, agents, actors, and directors).

[48]. *See id.* at 1061 (concluding that "West Coast's use of 'moviebuff.com' violates the Lanham Act"). *Id.*

[49]. *See supra* notes 38-42 and accompanying text.

[50]. *See Brookfield Comm.*, 174 F.3d at 1053-54.

[51]. *See id.* at 1054.

[52]. *Id.*

[53]. *Id.* at 1062.

[54]. *See id.* at 1062-64.

[55]. *See id.* at 1064.

[56]. *See id.* at 1066.

[57]. In *Nitron Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp.2d 102 (D. Mass. 1998), one case that appears to address a pure metatag misuse fact pattern, the district court granted a preliminary injunction. *See id.* at 104-05. In granting the injunction, the court, after reciting the plaintiff's evidence of metatag misuse, stated that it found "a likelihood of success of plaintiff in establishing before the finder of fact, at trial, the credibility of [the witness'] findings recited here." *Id.* at 104. This rather curious statement does not seem to indicate that a finding of trademark infringement will be found, nor does the case ever refer to trademark

misuse claims of any type.

However, minus such language or clear intent, the *Brookfield* court chose to construe the *Nitron* case as standing for trademark infringement based upon initial interest confusion. *See Brookfield*, 174 F.3d at 1065. Unlike the *Brookfield* court, the author finds no basis for interpreting the holding of the *Nitron* case as applying to trademark infringement, and have not included it in the analysis of court opinions on metatag trademark infringement.

[58]. *See Brookfield*, 174 F.3d at 1065 (approving of and summarizing the *Nitron* case that involved only metatag trademark use without any visible reference to the trademark). *But see, supra* note 56 (stating that the *Nitron* case is not a clear trademark infringement case, and the *Brookfield* court may have twisted the *Nitron* opinion to support the *Brookfield* court's conclusion on initial interest confusion).

[59]. 78 F. Supp.2d 1066 (S.D. Cal. Dec. 1, 1999) [hereinafter *Welles II*]. This is a summary judgment motion opinion that is part of the ongoing litigation mentioned above in the discussion of the traditional multi-factored likelihood of confusion tests. *See supra* Section III(B)(1).

[60]. *See Welles II*, 78 F. Supp.2d at 1092.

[61]. *See id.* at 1092-93.

[62]. *See id.* at 1095.

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

[64]. *See id.*

[65]. 15 U.S.C. § 1117 (1994 & Supp. IV 1998).

[66]. 1998 U.S. Dist. LEXIS 10359 (E.D. Va. Feb. 2, 1998).

[67]. *See id.* at *7-8.

[68]. *See id.* at *9.

[69]. *See id.* at *18-19.

[70]. *See id.* at *22.

[71]. *Id.* at *21; *see also id.* at *8, *23 (describing defendant's willful conduct).

[72]. *See id.* at *23.

[73]. *See* 15 U.S.C. § 1125(a)(1)(B) (1994).

[74]. *Brown v. Armstrong*, 957 F. Supp. 1293, 1301 (D. Mass. 1997) (citing, among others, *William H. Morris Co. v. Group W, Inc.*, 66 F.3d 255, 257 (9th Cir. 1995)).

[75]. A few commentators have considered the possibility. *See* Kuester & Neives, *supra* note 7, at 250-51; Loundy, *supra* note 4, at 6; O'Rourke, *supra* note 3, at 296-99.

[76]. *See supra* Section III discussing the barriers to proving likelihood of confusion.

[77]. See *Brown*, 957 F. Supp. at 1302. The *Brown* court itemized a four-part test for determining if a statement was an "advertisement or promotion," consisting of: "(1) commercial speech; (2) by a defendant who is in commercial competition with plaintiff; (3) for purposes of influencing consumers to buy defendant's goods; . . . [and,] (4) disseminated sufficiently to the relevant purchasing public." *Id.* (alteration in the original). The court concluded that an alleged false statement that was contained on a video cassette and never seen by the purchaser until after the product was purchased, failed to meet the requirements of "an advertisement or promotion." *Id.*; see also O'Rourke, *supra* note 3, at 297.

[78]. Pub. L. 104-98, § 3(a), Jan. 16, 1996, 109 Stat. 985 (1996) (codified as amended at 15 U.S.C. § 1125 (Supp. IV 1998)).

[79]. See Jerome Gilson, *Trademark Protection and Practice* § 5.12[1][a] (1998).

[80]. See 15 U.S.C. § 1127 (Supp. IV 1998) (providing that dilution may exist "regardless of the presence or absence of . . . [a] likelihood of confusion, mistake, or deception"). *Id.*

[81]. See Gilson, *supra* note 79 at § 5.12[1][a].

[82]. In pertinent part, the statute provides: The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. 15 U.S.C. § 1125(c) (Supp. IV 1998).

[83]. *Panavision Int'l, L.P. v. Toeppen*, 141 F.3d 1316, 1324 (9th Cir. 1998).

[84]. The judicial opinions construing "commercial use in commerce" requirement under Section 43(c) have not been willing to give that phrase the breadth granted by the *Planned Parenthood* court interpreting the "use in commerce" requirement under Sections 32(1) and 43(a). See *supra* notes 30-32 and accompanying text (emphasis added).

[85]. 15 U.S.C. § 1127 (1994).

[86]. *Id.*

[87]. 141 F.3d 1316 (9th Cir. 1998).

[88]. A cybersquatter is a person who seeks to make a profit by reserving domain names based upon well known trademarks and company names, and then attempts to sell these domain names to the company who owns the trademark. See *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227, 1233 (N.D. Ill. 1996).

[89]. See *Panavision*, 141 F.3d at 1319.

[90]. See *id.*

[91]. See *id.* at 1319.

[92]. See *id.* at 1324.

[93]. *Id.* at 1325.

[94]. *Id.*

[95]. *See id.*

[96]. This harkens back to the concept of commercial morality, where courts find that the principles of old fashion honesty are controlling. *See* Gilson, *supra* note 79, at § 103[8][f]. As one famous quote puts it: "[i]f another poaches upon the commercial regulation of the symbol he has created, the owner can obtain legal redress." *Mishawaka Rubber & Woolen Mfg. Co. v. S.S. Kresge Co.*, 316 U.S. 203, 205 (1942).

[97]. *See* O'Rourke, *supra* note 3, at 291 n.65.

[98]. 15 U.S.C. § 1127 (Supp. IV 1998).

[99]. Gilson, *supra* note 79, at § 5.12[1][e][v][A].

[100]. *See id.*; Kuester & Neives, *supra* note 7, at 251.

[101]. O'Rourke, *supra* note 3, at 300; *see also* Panavision, 141 F.3d at 1326 n.7 (stating that "[b]lurring occurs when a defendant uses a plaintiff's trademark to identify the defendant's goods or services, creating a possibility that the mark will lose its ability to serve as a unique identifier of the plaintiff's product[s]"). *Id.*

[102]. *See* Panavision, 141 F.3d at 1327 (citing *Teletech Customer Care Management, Inc. v. Tele-Tech Co., Inc.*, 977 F. Supp. 1407, 1410 (C.D. Cal. 1997)).

[103]. *See* O'Rourke, *supra* note 3, at 294.

[104]. Gilson, *supra* note 79, § 5.12[1][e][v].

[105]. *See id.*; *see also* O'Rourke, *supra* note 3, at 301-02 (characterizing the requirement as requiring a showing of negative association resulting from the linking of the mark to the unsavory site).

[106]. *See* O'Rourke, *supra* note 3, at 301-02.

[107]. *See* Panavision, 141 F.3d at 1326.

[108]. *Id.* (internal quotation omitted).

[109]. *See id.*

[110]. Alta Vista has introduced a new search service termed Real Names. This appears to map a company's name to any URL, thereby removing the need to register your trademark as your domain name. However this is a proprietary directory that requires that you pay in order to be included in the listing. *See* RealNames, *About RealNames* (visited Feb. 24, 2000) <http://customer.realnames.com/Virtual.asp?page=Eng_Corporate_Background>.

Related Browsing