

The Road Not Taken: Initial Interest Confusion, Consumer Search Costs, and the Challenge of the Internet

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Yesterday I went shopping for soy milk. I usually buy the “Silk” brand. A carton of plain Silk is light-red with white lettering. Beneath the lettering is a picture of soy milk pouring and splashing into a bowl of cereal. At the store’s soy milk display, a light-red carton with white lettering over a picture of soy milk pouring and splashing (but no cereal) caught my eye. Closer inspection revealed that it was not Silk (which was placed directly above in the store’s display), but a store brand with its own prominent trademark. I compared the ingredients (identical), bought the cheaper Silk substitute, and saved a dollar. Though the outcomes of trade dress cases are often hard to predict, the store brand’s copying of the Silk carton was likely legal.

Suppose instead that I do my grocery shopping on the Internet. Not knowing where to buy soy milk (and not knowing any brand other than Silk), I might have typed “Silk” and “soy milk” into a search engine. My result list would likely include the Silk web page.¹ But what if the store brand had a web site that incorporated the word “Silk” on its page in order to be included in my results list? Though no more confusing to me as a consumer than the mimicked trade dress, this act would give Silk a likely cause of action for “initial interest confusion.” This article critiques trademark claims based on initial interest confusion and proposes a new framework, focused on consumer search costs, for analyzing these claims.

Likelihood of confusion is the touchstone of trademark infringement. But confusion is often transitory. Although a consumer

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1. And indeed it does. In a Google search on July 19, 2004, www.silkissoy.com was at the top of the results list.

may make an initial mistake about a product's source, affiliation, or sponsorship, she might still choose to buy the product after the true facts are known. Nonetheless, some courts find trademark injury where there is initial interest confusion. They hold that the initial confusion gives an unfair "foot in the door" to infringers.²

The popularization of the Internet as a marketing tool has increased judicial interest in initial interest confusion. Courts aggressively police defendants who use plaintiff trademarks in domain names or metatags, which are hidden text on a web page designed to draw search engines to a site. Web surfers never see the trademark used as a metatag (which is invisible when reading the page), but may visit the site because it is returned by the search engine in response to a query that includes the trademark as a search term. Thus, a search for "Coca-Cola" could return the "Pepsi" web site if that site includes "Coca-Cola" in its metatags. Several circuits take the view that such inclusion infringes Coke's trademark despite the fact that no one would mistake the Pepsi site for Coca-Cola's. Nor does it matter that the cost to the consumer of any diversion is no more than an extra click of a mouse. These holdings potentially deprive consumers of an easy means to learn about web sites in the same category as their search.³

The application of initial interest confusion to the Internet has generated extensive criticism.⁴ Most critics complain that courts have failed to understand the nature of the Internet. But the problem is as much a problem of doctrine as of technology. Courts applying initial interest confusion to the Internet are fully consistent with the logic of the cases that established the doctrine.⁵ That logic, unfortunately, is vague as to why and when initial interest confusion should be enjoined. It is therefore not surprising that the resulting body of law produces questionable results. Simply put, if applying initial interest confusion to the Internet was a mistake, it was an accident waiting to happen.

The rationale for policing initial interest confusion is not immediately obvious. If there is no confused consumer at the point of sale, where is the harm? The usual answer points to the trademark owner's goodwill (the positive associations consumers have with the trademark owner's product): A junior user should not free ride on the senior user's goodwill as a means of getting his foot in the door with prospective customers.⁶

2. See *infra* Part I.B.

3. See *infra* Part II.B.

4. See *infra* notes 156-157 and accompanying text.

5. See *infra* Part II.B.3.

6. See *infra* notes 37-51 and accompanying text.

But this explanation begs the question. The law does not prohibit free riding across the board.⁷ What makes this brand of free riding wrong? Is it always wrong? Courts have not provided coherent answers to these questions.

The root of the problem is the doctrine's focus on trademark owner goodwill and not on consumer interests. Just because a mark's goodwill may attract a potential customer to further examine a product does not guarantee a sale to the trademark owner. If an initially confused consumer (who is *not* confused at the time of purchase) mistakenly looks elsewhere at first but then chooses the alternative product, notwithstanding any "bait and switch" tactics, the trademark owner's goodwill could not have been that strong. Indeed, the consumer may have been drawn to the trademark because it represented a category of product and not a particular product.⁸ If so, the "confusion" may have expanded the consumer's awareness of alternatives, thus promoting competition and enabling the purchase of a preferable product. In such cases, policing initial interest confusion potentially harms consumers by cutting them off from a source of information about the broader market.

But permitting initial interest confusion may also harm consumers. The class of initially confused consumers includes those who are specifically seeking a particular brand to the *exclusion* of others. They must expend extra effort to determine which product is which, and to find their preferred choice. For these consumers, initial interest confusion impedes the trademark's function of reducing consumer search costs. This perspective suggests that a balancing is possible: Courts should police initial interest confusion only when it produces greater harms than benefits.

Focusing on goodwill does not provide any basis for balancing. Instead, courts should consider the costs of dispelling initial confusion to determine whether initial confusion causes a trademark injury. Under this consumer-based search cost analysis, misappropriated "goodwill" is not a factor except insofar as it represents the diversion of a consumer's search "budget" from an intended recipient. Phrased another way, there *is* point-of-sale confusion of sorts, but the "product" is further exploration of a potential purchase, which is paid for with the consumer's time and opportunity costs.⁹ Consistent with this view, several courts have refused to apply initial interest confusion on the grounds that fleeting or *de minimus* initial confusion does not work a

7. See *infra* notes 42–44 and accompanying text.

8. See *infra* Part I.C.1.

9. See *infra* Part I.C.2.

trademark injury,¹⁰ although some other courts have taken a more aggressive approach.¹¹

Whatever balance the courts have struck in initial interest confusion cases has been upset by cases involving Internet domain names and metatags. When the “confusion” results in a web surfer being directed to the wrong web site, correction costs are negligible. Accordingly, one would expect judicial reluctance to apply initial interest confusion. The opposite is true. Claims of appropriated goodwill and misplaced analogies to the “real” world persuaded several circuit courts to apply a robust interpretation of initial interest confusion to cyberspace.¹² Their holdings ignore, and at times reject, any consideration of search costs. The perverse, if predictable, effect has been to invite broader claims of initial interest confusion in cases involving the brick and mortar world. Having welcomed broad claims in cyberspace, courts find reversing course difficult, especially without a clear doctrinal basis for doing so.¹³ Initial interest confusion cases involving the Internet may therefore have ramifications extending far beyond the Internet context.

This article critiques the development and application of initial interest confusion and argues for a doctrine based on consumer search costs rather than a trademark owner’s goodwill. Part I traces the origin of initial interest confusion and presents a theory, based on minimizing search costs, of when the concept should be applied. It then examines the application of initial interest confusion in light of the courts’ uncertainty as to the purpose of the doctrine. Part II describes the doctrinal difficulties caused by the uncritical adoption of initial interest confusion to cases involving the Internet. These problems can be resolved by focusing on search costs and the costs of correcting consumer confusion.

I. INITIAL INTEREST CONFUSION IN THE BRICK AND MORTAR WORLD

A. The Goals of Trademark Law and the Lanham Act

Trademark law has multiple purposes.¹⁴ Many of them can be grouped under the general goal of consumer protection, though this goal

10. See *infra* Part I.D.

11. See *infra* Part I.E.

12. See *infra* Parts II.B & II.C.

13. See *infra* Part II.E.

14. In a report on the bill that became the Lanham Act, the Senate Committee on Patents explained:

The purpose underlying any trademark statute is twofold. One is to protect the public so that it may be confident that, in purchasing a product bearing a particular trademark which it favorably knows, it will get the product which it asks for and wants to get. Secondly, where the owner of a trademark has spent energy, time and money in presenting to the public the product,

subsumes benefits to merchants as well as consumers.¹⁵ By identifying products by source or brand, trademarks lower search costs and protect consumer expectations.¹⁶ Lowering search costs benefits producers by enabling them to charge higher prices and compete on the basis of product quality.¹⁷

Trademark law also protects the goodwill symbolized by a trademark—the positive associations a customer has with a specific brand¹⁸ and the trademark holder’s investment in the identifying power of his mark.¹⁹ There is a latent tension between this goal and protecting consumer interests, because excessive protection of goodwill may endanger free competition²⁰—for example, by restricting comparative advertising.²¹

The Lanham Act prohibits use “in commerce [of] any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale . . . or advertising of any goods or services” where such use is likely “to cause confusion, or to cause mistake, or to

he is protected in his investment from its misappropriation by pirates and cheats. This is the well-established rule of law protecting both the public and the trademark owner.

S. REP. NO. 1333 (1946), *reprinted in* 1946 U.S.C.C.A.N. 1274, 1274. The committee also called trademarks

the essence of competition, because they make possible a choice between competing articles by enabling the buyer to distinguish one from the other. Trademarks encourage the maintenance of quality by securing to the producer the benefit of the good reputation which excellence creates. To protect trademarks, therefore, is to protect the public from deceit, to foster fair competition, and to secure to the business community the advantages of reputation and good will by preventing their diversion from those who have created them to those who have not.

Id. at 1275, *quoted in* Michael J. Allen, *The Scope of Confusion Actionable Under Federal Trademark Law: Who Must Be Confused and When?* 26 WAKE FOREST L. REV. 321, 324 (1991).

15. 1 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 2:33 (4th ed. 2004). The flip side of protecting consumers from confusion is “protecting the trademark owner’s right to a non-confused public.” *Id.* § 2:14 (quoting *James Burrough, Ltd. v. Sign of the Beefeater, Inc.*, 540 F.2d 266, 276 (7th Cir. 1976)).

16. 1 MCCARTHY, *supra* note 15, §§ 2:3, 2:5.

17. *Id.* §§ 2:3, 2:4; *Smith v. Chanel*, 402 F.2d 562, 566 (9th Cir. 1968) (“[Trademark] makes effective competition possible in a complex, impersonal marketplace by providing a means through which the consumer can identify products which please him and reward the producer with continued patronage. Without some such method of product identification, informed consumer choice, and hence meaningful competition in quality, could not exist.”).

18. “Good will is that which makes tomorrow’s business more than an accident. It is the reasonable expectation of future patronage based on past satisfactory dealings.” ROGERS, GOOD WILL, TRADEMARKS AND UNFAIR TRADING 13 (1914) *quoted in* 1 MCCARTHY, *supra* note 15, § 2:17.

19. “The redress that is accorded in trademark cases is based upon the party’s right to be protected in the good-will of a trade or business.” *Hanover Star Milling Co. v. Metcalf*, 240 U.S. 403, 412 (1916). *See also* *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 854 n.14 (1982); 1 MCCARTHY, *supra* note 15, § 2:30.

20. *See Smith*, 402 F.2d at 568–69.

21. *See infra* notes 43–44 and accompanying text.

deceive.”²² To prevail on a claim for trademark infringement, a plaintiff must demonstrate that the similarity of the defendant’s mark to the plaintiff’s creates a “likelihood that an appreciable number of ordinarily prudent purchasers are likely to be misled, or indeed simply confused, as to the source of the goods in question.”²³ A multifactor test, with different names in different jurisdictions, usually guides the inquiry.²⁴ For example, the test announced by Judge Friendly in *Polaroid Corp. v. Polarad Electronics Corp.*²⁵ considers: (1) the strength of the plaintiff’s mark; (2) the degree of similarity between the marks; (3) the competitive proximity of the litigants’ products; (4) any actual confusion; (5) the likelihood that the plaintiff will “bridge the gap” separating the two markets; (6) whether the defendant acted in good faith in adopting its mark; (7) the quality of the defendant’s product; and (8) purchaser sophistication.²⁶ Courts apply variations of the *Polaroid* test to claims involving both competing and non-competing goods.²⁷ The Lanham Act also protects against infringement by providing a cause of action against trade dresses that are confusingly similar to a plaintiff’s distinct packaging style or non-functional source-identifying design features that have acquired secondary meaning.²⁸

B. The Rise of Initial Interest Confusion

Likelihood of confusion typically focuses on the point of sale. But in *Grotirian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*,²⁹ the Second Circuit held that a trademark injury may exist when consumers are initially, but not ultimately, confused by the similarities between a senior and junior user’s trademark.³⁰ In other words, infringement is possible even when any confusion is dispelled before

22. 15 U.S.C. § 1114(1)(a) (1994).

23. *Mushroom Makers, Inc. v. R.G. Barry Corp.*, 580 F.2d 44, 47 (2d Cir. 1978) (per curiam).

24. See, e.g., Maureen A. O’Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability for Metatagging*, 33 GONZ. L. REV. 277, 294 (1997–1998); Jason Allen Cody, *Initial Interest Confusion: What Ever Happened to Traditional Likelihood of Confusion Analysis?* 12 FED. CIR. B.J. 643, 654 n.42 (2003) (collecting tests).

25. 287 F.2d 492 (2d Cir. 1961).

26. *Id.* at 495; see also, e.g., *Interpace Corp. v. Lapp, Inc.*, 721 F.2d 460, 463 (3d Cir. 1983); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348–49 (9th Cir. 1979).

27. See, e.g., *A & H Sportswear, Inc. v. Victoria’s Secret Stores, Inc.*, 237 F.3d 198, 207 (3d Cir. 2000) (“[W]e conclude that the factors we have developed in the noncompeting goods context are helpful tools and should be used to aid in the determination of the likelihood of confusion in other cases.”); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1043 (2d Cir. 1992).

28. See, e.g., *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205 (2000).

29. 523 F.2d 1331 (2d Cir. 1975).

30. *Id.*

purchase.³¹ *Steinway* involved competing piano manufacturers.³² In affirming the district court's conclusion that "Grotrian-Steinweg" infringed upon "Steinway," the court ruled that confusion need not exist at the time of purchase to be actionable.³³ The court characterized the problem of initial confusion as one of free riding by the junior user, *not* as a harm to the consumer.

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. The harm to Steinway in short is the likelihood that potential piano purchasers will think that there is some connection between the Grotrian-Steinweg and Steinway pianos. Such initial confusion works an injury to Steinway.³⁴

The court discussed initial interest confusion in the context of the degree of care exercised by purchasers, which is one of the *Polaroid* factors, but its holding rejected the defendant's assertion that because confusion at the time of purchase was impossible, infringement was impossible.³⁵ In other words, initial confusion sufficed as an injury that merited relief under the Lanham Act.³⁶

31. Initial interest confusion is not the only form of non-point-of-sale confusion to interest the courts. Courts have also policed post-sale confusion as potentially endangering the reputation of a trademark owner if shoddy products, which have already been purchased, are mistaken for the trademark owner's goods. *See, e.g.,* *Esercizio v. Roberts*, 944 F.2d 1235, 1244-45 (6th Cir. 1991).

32. Prior to *Steinway*, several cases addressed the possibility of harmful pre-sale confusion. *See* *Commun. Satellite Corp. v. Comcet, Inc.*, 429 F.2d 1245, 1251 (4th Cir. 1970) (finding likelihood of confusion in part because infringing mark (COMCET) sounded like mark of senior user (COMSAT) and initial confusion might result in destruction of goodwill from spoken rumor about junior user); *see also* *Blaw-Knox Co. v. Siegerist*, 300 F. Supp. 507 (E.D. Mo. 1968), *aff'd in part and mod'f'd in part*, 414 F.2d 375 (8th Cir. 1969). *See generally* Charles E. Bruzga, *Sophisticated Purchaser Defense Avoided Where Pre-Sale Confusion Is Harmful—A Brief Note*, 78 TRADEMARK REP. 659 (1988) (discussing early initial interest cases).

33. *Steinway*, 523 F.2d at 1342.

34. *Id.* (footnote and citations omitted).

35. Initial interest confusion is generally discussed in the context of a particular element of a multifactor test. *See, e.g.,* *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998) (actual confusion); *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167 (N.D.N.Y. 1995) (consumer sophistication); *Nissan Motor Co., Ltd. v. Nissan Computer Corp.*, 89 F. Supp. 2d 1154, 1162 (C.D. Cal. 2000), *aff'd*, *Nissan Motor Co. v. Nissan Computer Corp.*, No. 00-55678, 2000 WL 1875821 (9th Cir. Dec. 26, 2000) (applying initial interest confusion to proximity and actual confusion factors while identifying initial interest confusion as "[o]ne type of actionable consumer confusion"); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176 (W.D.N.Y. 2000) (applying

The Second Circuit's next discussion of initial interest confusion also focused on the prospect that a junior user might gain unearned credibility with purchasers. *Mobil Oil Corp. v. Pegasus Petroleum Corp.*³⁷ involved an infringement claim based on the similarity between the senior user's flying horse symbol and the defendant's "Pegasus" mark.

The appeals court upheld a finding of likelihood of confusion based on the prospect that Pegasus might free ride on Mobil's reputation during initial contacts between purchasers and Pegasus.³⁸ "For example, an oil trader might listen to a cold phone call from Pegasus Petroleum—an admittedly oft used procedure in the oil trading business—when otherwise he might not, because of the possibility that Pegasus Petroleum is related to Mobil."³⁹ The court returned to this point in discussing the purchaser sophistication factor of the *Polaroid* test. Citing *Steinway*, the court stated that initial confusion is a sufficient trademark injury despite the sophistication of parties in the oil industry.⁴⁰ The fact that Pegasus

initial interest confusion to consumer sophistication factor and disclaimer defense). See also *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 294 (3d Cir. 2001) ("We join these circuits in holding that initial interest confusion is *probative* of a Lanham Act violation.") (emphasis added); *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 465 (7th Cir. 2000) (metatag use of another's trademark is probative of bad faith). Nonetheless, such confusion may be an independent basis for a finding of infringement. See, e.g., *Steinway*, 523 F.2d at 1342. When initial interest confusion is treated as an independent harm, it is not necessarily analyzed with the multifactor test. See *Brookfield Commun., Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1062 n.24 (9th Cir. 1999) ("Because we agree that the traditional eight-factor test is not well-suited for analyzing the metatags issue, we do not attempt to fit our discussion into one of the *Sleekcraft* factors.").

36. *Steinway*, 523 F.2d at 1342. In its original form, the Lanham Act applied only when the use of similar marks was "likely to cause confusion or mistake or to deceive purchasers as to the source of origin of such goods or services." Lanham Act, 15 U.S.C. §§ 1051–1127 (1946) (emphasis added). In 1962, Congress deleted the word "purchasers." S. REP. NO. 2107 (1962), reprinted in 1962 U.S.C.C.A.N. 2844, 2847. Though Congress did not specifically legislate that initial interest confusion was actionable, some courts have used the amendment to support invocation of the doctrine. See, e.g., *Checkpoint*, 269 F.3d at 295. Not all courts read the amendment as necessarily shifting the Lanham Act's focus away from the point of sale.

The legislative history states that the word "purchasers" was deleted because "the provision actually relates to potential purchasers as well as to actual purchasers." Therefore, we do not construe this deletion to suggest, much less compel, that purchaser confusion is no longer the primary focus of the inquiry. Instead, we believe that, at least in the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential "purchasers" are confused.

Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp., 954 F.2d 713, 716 (Fed. Cir. 1992) (quoting S. REP. NO. 2107 (1962), reprinted in 1962 U.S.C.C.A.N. 2844, 2847) (citation omitted).

37. 818 F.2d 254 (2d Cir. 1987).

38. *Id.* at 259.

39. *Id.*

40. *Id.* at 260.

solicited business through cold calls and the “paramount importance” of trust in the industry justified concern over initial confusion.⁴¹

C. Initial Interest Rationales

Although *Steinway* and *Mobil* tilt toward the goodwill theory of trademark protection, consumer protection is a more satisfying explanation of why courts should monitor initial interest confusion, especially when one considers the problem of search costs. Approaching initial interest confusion from the perspective of search costs also provides a clearer explanation of why and to what extent “goodwill,” loosely understood, is at stake than does the *Steinway* or *Mobil* approach.

1. The Goodwill Rationale and Its Shortcomings

Neither *Mobil* nor *Steinway* were concerned with consumer interests. Instead, as discussed above, both cases emphasize the prospect that a junior user might free ride on the senior user’s reputation. But this begs the question. The law does not enjoin free riding in general.⁴² Indeed, one could argue that comparative advertising takes similar advantage of a senior user’s reputation to gain credibility with the consumer.⁴³ This brand of free riding is permissible even when it makes use of another’s trademark because the benefits to competition outweigh judicial distaste for free riders.⁴⁴ Nor does trademark law automatically

41. *Id.* at 260. See also Bruzga, *supra* note 32, at 660 (discussing “crucial credibility” at stake in *Mobil*). The emphasis placed on trust raises the question of why a purchaser would trust Pegasus once its lack of affiliation with Mobil was revealed.

42. See, e.g., *Thomas & Betts Corp. v. Panduitt Corp.*, 65 F.3d 654, 658 (7th Cir. 1995) (“[E]ffective competition and the penumbra of the patent laws require that competitors be able to slavishly copy the design of a successful product.”); 1 MCCARTHY, *supra* note 15, § 1:2 (noting “the principle of free copying—meaning that anyone’s business ideas, inventions, writings and symbols, once disclosed to the public, are in the public domain and may be freely copied.”); *id.* § 8:19 (“[I]t must not be forgotten that there is nothing inherently unethical or illegal about copying per se. Especially in the field of trade dress, one may copy a competitor’s advertising or sales methods, packaging concepts or product shape for many reasons other than to confuse consumers.”); Wendy J. Gordon, *On Owning Information: Intellectual Property and the Restitutory Impulse*, 78 VA. L. REV. 149, 167 (1992) (“A culture could not exist if all free riding were prohibited within it.”).

43. “If you like X, you’ll love Y.”

44. See, e.g., *Smith v. Chanel*, 402 F.2d 562 (9th Cir. 1968), which allowed the marketing of a perfume as a duplicate of Chanel No. 5. The court explained that concerns about free riding on the Chanel name must yield to the public interest in free competition.

A large expenditure of money does not in itself create legally protectible rights. Appellees are not entitled to monopolize the public’s desire for the unpatented product, even though they themselves created that desire at great effort and expense. . . . By taking his ‘free ride,’ the copyist, albeit unintentionally, serves an important public interest by offering comparable goods at lower prices. On the other hand, the trademark owner, perhaps equally without design, sacrifices public to personal interests by seeking immunity from the rigors of competition.

enjoin free riding on elements of a competitor's trademark or trade dress, even when deliberately copied.⁴⁵ Typically, there is a reason beyond judicial sensibilities for enjoining free rides.⁴⁶ Simply stating that free riding occurs begins but does not end the inquiry.

Focusing on free riding responds to trademark law's concern that a defendant not deprive a trademark owner of the benefit of her investment in a mark's goodwill with the public.⁴⁷ This is indeed a common formulation of the harm caused by initial interest confusion.⁴⁸ But initial interest confusion presents an odd setting for defending a trademark holder's goodwill.

First, confusion may be dispelled at any time. It may be dispelled instantly or it may linger until the late stages of negotiation. Protecting goodwill *qua* goodwill offers no metric for distinguishing the situations. Second, the fact that customer confusion is dispelled before a purchase takes place calls into question the strength of the trademark owner's goodwill. The "goodwill" that ultimately motivates the purchase belongs to the purported infringer, not the trademark owner, because the consumer has determined that the purported infringer is the one who deserves her business.⁴⁹ Worrying about dispelled confusion as a link in the chain leading to the purchase of another's product at least raises issues of proximate causation with which *Steinway* and *Mobil* did not grapple. There is also, in the ordinary case, no depletion of the senior user's goodwill. To the extent that there is blurring or tarnishment of the mark, the senior user's claim is one for trademark dilution, not infringement.⁵⁰

Id. at 568–69.

45. *See infra* note 72.

46. For example, patents and copyrights are justified by the need to incentivize invention and other forms of creativity. *See, e.g.*, U.S. CONST. art. I, § 8, cl. 8 ("The Congress shall have Power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries."); *Sony Corp. of Am. v. Universal City Studios, Inc.*, 464 U.S. 417, 429 (1984) (declaring that the purpose of copyright is to "motivate the creative activity of authors and inventors by the provision of a special reward").

47. *See supra* note 19.

48. *See Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 294–95 (3d Cir. 2001) ("Without initial interest protection, an infringer could use an established mark to create confusion as to a product's source thereby receiving a 'free ride on the goodwill' of the established mark.").

49. The fact that the confusion is dispelled also means that the consumer does not think that the alleged infringer has some connection with the trademark owner at the time of purchase. *Cf. Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 523 F.2d 1331 (2d Cir. 1975) (describing harm to trademark owner as prospect that consumer will consider infringer based on perceived connection between the products).

50. *Steinway* was decided before the passage of the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c)(1) (2004).

Moreover, a defendant in an initial interest suit (where there is no likelihood of point-of-purchase confusion) has grounds to argue that a plaintiff's goodwill is not worth protecting. If the initial confusion is truly analogous to "bait and switch" tactics, as some courts suggest,⁵¹ one would expect consumers who realize the deception to avoid the purported infringer.⁵² If they do, no harm done (at least to the seller's goodwill); if not, basing a cause of action on plaintiff goodwill is problematic because the trademark owner does not appear to have much goodwill with the consumer at the time of purchase.

One may argue further that the trademark holder's goodwill, as representative of consumer belief in product or vendor quality, may not be implicated at all. A consumer is less likely to be put off by initial interest confusion if his initial interest was piqued by an association of the mark with a particular product *category* rather than a particular *brand*.⁵³ For example, an Internet neophyte may seek out Internet Explorer as her browser not because of any positive associations with Microsoft products, but because that is the only browser she has ever heard of and she is unaware of alternatives. If an initially confused consumer is more interested in a product category than a particular brand, one would not expect him to look elsewhere once the confusion is dispelled. In that case, protecting the senior user's investment in the goodwill of its mark is unnecessary, for the mark is functioning in a manner analogous to a generic name.⁵⁴ Generic marks, of course, do not merit trademark protection.⁵⁵ Nor may a vendor plausibly claim a reasonable expectation of the customer's patronage simply because hers is the only brand the consumer knows. To hold as much would frustrate

51. See, e.g., *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996).

52. See *supra* note 41.

53. Cf. *Saxlehner v. Wagner*, 216 U.S. 375, 380–81 (1910) (allowing use of competitor's trademark for advertising because defendants "are not trying to get the good will of the name, but the good will of the goods.").

54. Cf. *West Point Mfg. Co. v. Detroit Stamping Co.*, 222 F.2d 581, 589 (6th Cir. 1955) ("[O]ne who claims that another is guilty of unfair competition in copying his product, must show that the consuming public is primarily concerned in the producer, rather than in the product itself. . . .").

55. 2 MCCARTHY, *supra* note 15, § 12:1. By the same token, refusing to enjoin initial interest confusion does not deter trademark holders from making optimal investments in goodwill insofar as trademark holders are expected to take steps to ensure that their marks do not become generic. *Id.* § 12:26. Moreover, refusing to enjoin initial interest confusion still gives senior users an incentive to invest in the goodwill necessary to make consumers purchase from them after any initial confusion is dispelled.

the goal of free and open competition and set consumer interests against those of trademark holders.⁵⁶

The goodwill-based theory of initial interest confusion presented by *Steinway* and *Mobil* is therefore incomplete. The inattention of these and other cases to the questions raised in this section suggests that the courts may have been motivated less by the policy rationales of trademark law than by an intuitive sense that consumer confusion, in all its forms, is unfair. Lacking a precise basis for curtailing the behavior, the courts simply enforced a judgment of what constitutes fair competition. Though consistent with the tradition of the law of unfair competition, of which trademark is a part, this practice left behind a deficient doctrine.⁵⁷

This is not to say that initial interest confusion never affects a trademark owner's reasonable expectations to the value of his goodwill. But a better way to analyze the issue is to approach the problem from the consumer's perspective rather than the trademark holder's perspective. Goodwill is not so much an inappropriate consideration in these cases as it is an unnecessary one.

2. The Search Cost Rationale

In light of the consumer-protection concerns at the heart of trademark law,⁵⁸ *Steinway* and *Mobil*'s failure to consider consumer interests is curious. Neither case articulated how initial confusion harms consumers nor did either ruling consider the prospect that initial interest confusion is sometimes in the consumer's interest. The district court in *Steinway* acknowledged the possibility that initial interest confusion could make consumers aware of alternative producers, though it did so as an argument for enjoining initial interest confusion. "Misled into an initial interest, a potential Steinway buyer may satisfy himself that the *less expensive* Grotrian-Steinweg is at least as good, *if not better*, than a Steinway."⁵⁹ Whatever the harm to Steinway, buying a better, cheaper product is hardly contrary to the consumer's interest.

56. Of course this is not to say that a vendor does not deserve to benefit from her marketing investment, but only to the extent that she convinces consumers that hers is the *best* product, not that hers is the *only* product.

57. "The definition of a level of fair competition has been determined through a sifting of ethics, economic theory, the 'Protestant Ethic,' and a vague Judeo-Christian feel for what is 'fair.'" I MCCARTHY, *supra* note 15, § 1:18. Indeed, many judges have an almost palpable scorn for trademark violators. "[W]here as here it plainly appears that there is a purpose to reap where one has not sown . . . the use of the advertising or trade name or distinguishing mark of another, is in its nature, fraudulent and will be enjoined." *Aetna Cas. & Surety Co. v. Aetna Auto Fin., Inc.*, 123 F.2d 582, 584 (5th Cir. 1941).

58. See *supra* note 15 and accompanying text.

59. *Steinway*, 523 F.2d at 1341 (quoting 365 F. Supp. 707, 717 (S.D.N.Y. 1973)) (emphases added).

On the other hand, initial interest confusion is not a guided missile precisely targeting only those consumers who will decide that the alleged infringer's product is superior to that of the trademark holder's. It also affects consumers who wish to purchase the trademarked brand and must expend extra effort to find it. Their confusion, though ultimately dispelled, increases search costs even when they ultimately purchase from the trademark owner. Also, many of the diverted consumers would have preferred the initial target of their search, but settle for the infringer's product because finding the trademark holder would be too much trouble.⁶⁰ It is these increased consumer search costs that justify judicial attention to initial interest confusion. This rationale is consistent with trademark law's consumer-protection goal.

Focusing on search costs also clarifies how initial interest confusion may harm trademark holders. In making purchases, consumers effectively pay two charges: (1) the price of a good or service and (2) the costs of gathering information about the product and vendor, including the transaction costs of inspection and negotiation. Strong trademarks lower search costs and, consequently, total costs for consumers. Likewise, lowering the search cost component of consumer expenditures enables firms to command higher prices.⁶¹ Initial interest confusion increases search costs for consumers, and by doing so lowers the price that a trademark holder is able to charge.

Thinking about initial interest confusion in this manner creates a framework for explaining how the junior user may be said to have "misappropriated" something belonging to the senior user. A consumer's purchase budget has two components: search costs and purchase price. Increasing search expenditures reduces the funds that a consumer will commit to purchase (thus shifting the consumer's demand curve to the left).⁶² When a consumer visits a piano store thinking that it sells Steinways, she has elected to spend that part of her search budget on Steinway, not Grotrian-Steinweg. The longer she is confused, the greater her potential investment of search costs. Depending on how much of that budget remains after the confusion is dispelled, the consumer may not expend the added effort of seeking the original target of her search. This

60. See *infra* text accompanying note 63.

61. William Landes and Richard Posner proposed an economic model of trademarks in which $\pi = P + H(T: Y, W)$. π represents the full price of a good; P , the money price; and H , the search costs incurred by the buyer. H is reduced when T , the mark, is strong. This is affected in turn by W , representing the availability of words and symbols for use as a mark, and Y , representing other factors. William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265, 275-76 (1987). Strong marks that reduce search costs allow firms to command higher prices. *Id.* at 277-79. That is, reducing H allows P to be larger.

62. See *id.* at 288.

is so even if the senior user provides the product at a cheaper price. If the cost of finding the senior user appears to exceed the cost differential between the products, a rational consumer would not make the effort. The senior user thus suffers a lost chance of a sale. Indeed, one may take the view that a species of point-of-sale confusion has occurred. The consumer purchases a closer look at a product at the cost of her time. If a consumer chooses to “buy” a closer look at a Steinway, Steinway has a legitimate complaint if Grotrian-Steinweg is the examined product. But the extent of Steinway’s grievance depends on the value of the diversion, which in turn depends on the ease with which confusion is dispelled.

For her part, the consumer is harmed by the prospect that the diverting product is inferior to the senior user’s product (in either cost or quality), but by a margin that is smaller than the added search costs she would have to expend to explore its purchase. Considering search costs thus values both consumer interests and a trademark owner’s goodwill.⁶³

The search cost rationale for policing initial interest confusion is consistent with Professor J. Thomas McCarthy’s explanation of initial interest confusion.⁶⁴ He justifies the doctrine by analogy to a job applicant who puffs his résumé. Though the truth may be revealed before an offer is made, the damage is done. “The misrepresentation has enabled the job-seeker to obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.”⁶⁵ But the degree of harm is contextual. The interview is coveted because the number of interview slots is finite. If the employer had an unlimited number of interviews to give (and no opportunity costs in giving them), then no competitive injury would result from the misrepresentation.

This leads to a conclusion that is ignored by *Mobil* and *Steinway*: Not all lost chances at a sale are of equal value. Their value depends on the costs of the search and the ease with which the purchaser’s confusion is dispelled.

Why should relative costs matter? They matter because, as discussed above, initial interest confusion may benefit the consumer.⁶⁶

63. Initial interest confusion therefore has both global and local effects. Raising search costs adversely affects efficient competition in cost and quality, while the individual consumer is less able to buy her preferred product.

64. 3 MCCARTHY, *supra* note 15, § 23:6.

65. *Id.*

66. Absent such benefits, the argument for aggressively policing initial interest confusion would be stronger. Trademark users have a wide variety of words, symbols, and product configurations from which to choose, enabling them to stay clear of potential infringement. The

This dynamic may be seen in the trade dress of over-the-counter drugs. A consumer buying a pain reliever initially may be looking for, say, Tylenol. At the drug display, he sees a pain reliever with packaging similar to Tylenol's, but closer inspection reveals that it is a cheaper store brand. The store brand also contains acetaminophen, which is the active ingredient of Tylenol. If the customer is satisfied that the generic brand is an adequate Tylenol substitute, his "initial confusion" allows him to save several dollars for a chemically identical product. Had he not previously known about alternative acetaminophen options, any confusion worked to his benefit by broadening his awareness of Tylenol's competitors.⁶⁷ The customer's preference, as expressed by his informed purchasing decision, was not for Tylenol, but rather for the most affordable acetaminophen product he could find. By resembling Tylenol, the store brand's trade dress signals that it is in the same category. In other words, it serves a generic function that benefits consumers.⁶⁸ Courts have recognized this possibility in trade dress cases,⁶⁹ and the same dynamic may be at play in initial interest confusion cases.⁷⁰

contrary argument would then be based on the litigation and error costs arising from broadening the set of potential infringements, raising litigation costs and the risk of penalizing marks that do not actually cause confusion.

67. Returning to Landes & Posner's model, initial interest confusion may be an element of "Y" (other factors) that lowers search costs by making consumers aware of low-cost alternatives to a trademarked product. *See supra* note 61.

68. *See supra* notes 53–55 and accompanying text. As the district court explained in *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 1068 (D.N.J. 1987), *aff'd*, 834 F.2d 368 (3d Cir. 1987):

The resemblance between two products can alert consumers to the functional or utilitarian equivalence between them, to the fact that one product may be substituted for the other in the ultimate uses for which the products are intended. The free flow of information regarding the substitutability of products is valuable to individual consumers and to society collectively, and by providing it a supplier engages in fair competition based on those aspects—for example, price—in which the products differ.

See, e.g., *Va. State Bd. of Pharmacy v. Va. Citizens Consumer Council*, 425 U.S. 748, 763–65 (1976).

69. *See id.* *See also, e.g.*, *Conopco, Inc. v. May Dept. Stores Co.*, 46 F.3d 1556, 1568 (Fed. Cir. 1994) (holding that packaging similarities that suggest product is similar to senior user's brand is insufficient to prove likelihood of confusion when junior brand is marked with a distinct logo); *id.* at 1568–70 (discussing similar cases). The caselaw is far from uniform on this point, however. *See infra* note 89.

70. Even potentially confusing names may have information content. If I am in the market for a piano and like Steinways, but cannot afford them, I might investigate a Grotrian-Steinweg as a likely similar product that may be cheaper. Or, I might have if the *Steinway* case had come out differently.

If, however, the consumer genuinely prefers Tylenol, perhaps out of concerns for quality control,⁷¹ his search costs of finding it have not been raised in any appreciable respect. He puts the generic down, sees the Tylenol in the same area of the shelf, and life goes on. In this case, gains from permitting some initial interest confusion likely outweigh the costs.⁷² Because the effect on search costs is negligible, Tylenol does not lose the ability to compete based on price, quality, or reputation.⁷³ This conclusion is reinforced by the absence of displacement of the competing product by the confusion. In contrast, Professor McCarthy's hypothetical about the inflated résumé describes a situation in which a misrepresentation effectively displaces a competitor from consideration.⁷⁴

D. Initial Interest Skepticism: "Weak" Initial Interest Confusion

If the preceding analysis is correct, one would expect courts to be sensitive to the costs of confusion when considering claims of initial interest confusion.⁷⁵ To a limited extent, they have been. In *Astra*

71. See Landes & Posner, *supra* note 61, at 275 ("That consumer will be interested not in the formula but in the manufactured product and may therefore be willing to pay a premium for greater assurance that the good will actually be manufactured to the specifications of the formula.").

72. Cf. *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033 (2d Cir. 1992) (holding trade dresses of "Tylenol PM" and "Excedrin PM" not confusingly similar despite packaging similarities and defendant's bad faith in adopting elements of plaintiff's trade dress). *But see McNeil-PPC, Inc. v. Guardian Drug Co.*, 984 F. Supp. 1066 (E.D. Mich. 1997) (enjoining generic drug maker's packaging that was similar to senior user's).

73. To return to the soy milk shopping anecdote that opened this article, when I was shopping for Silk soy milk, but purchased the store brand with a similar trade dress, there was initial interest confusion. Though I knew almost immediately that I was not looking at Silk when I saw the store brand, the carton caught my eye because I thought for an instant that I was. This "confusion" benefited me. Had the store brand not mimicked the senior user's design, I likely would not have noticed it. I would have bought the Silk and spent extra money. If, however, my heart was set on Silk, the split second diversion of attention would not have increased my search costs in any appreciable way. The Silk was on the shelf immediately above the substitute. Indeed, by having two shelves of Silk-style soy milk rather than one, the store arguably made the Silk easier to find.

74. See *supra* note 65 and accompanying text. Of course, this point can be taken to an extreme. At the moment a generic pain reliever is in a consumer's hand, Tylenol is not. But the products are side by side in a way that is not possible when a consumer visits, say, a Grotrian-Steinweg store thinking that it is a Steinway shop.

75. Though *Mobil* and *Steinway* do not discuss the search cost rationale, their results are not necessarily inconsistent with it. One could conclude, for example, that visiting a store that sells Grotrian-Steinwegs on the mistaken assumption that they are the same as Steinways raises search costs to a degree that outweighs any possible countervailing benefits. See *Steinway*, 523 F.2d at 1342. Similarly, one might argue that listening to misleading sales pitches results in higher search costs than alternative means of promoting an oil company. See *Mobil*, 818 F.2d at 259. Other forms of diversion, by contrast, may not result in sufficient costs to justify judicial intervention. See, e.g., *Mayflower Transit, Inc. v. Ann Arbor Warehouse Co., Inc.*, 892 F. Supp. 1134, 1143 (S.D. Ind. 1995) (successor's temporary use of another interstate carrier's phone number unlikely to cause confusion "because customers are likely to use great care when selecting a van line, any initial

Pharmaceutical Products, Inc. v. Beckman Instruments, Inc.,⁷⁶ for example, the First Circuit refused to give credence to evidence of confusion when the confusion was minimal and dispelled before purchase.⁷⁷ Astra Pharmaceutical sued to prevent Beckman Instruments from selling a blood analyzer with the name ASTRA (an acronym for “Automated Stat/Routine Analyzer”).⁷⁸ The record revealed some evidence of actual confusion—two purchasing directors and several lab technicians mistakenly associated Astra salesmen with the Beckman product. But there was no evidence of point-of-sale confusion.⁷⁹ The court concluded that “any confusion which may have occurred was *de minimis*, and is not sufficient to raise a genuine issue of fact relating to the likelihood of confusion issue.”⁸⁰

Though *Astra* did not address the underlying rationales for initial interest confusion, the court’s refusal to apply the concept is consistent with the search cost rationale—*de minimis* confusion is not worth worrying about. Other cases have taken a similar approach. Situations in which the initial confusion could raise search costs are enjoined, while instances of *de minimis* or easily dispelled confusion are not.⁸¹ Likewise,

confusion originating from the inaccurate Yellow Pages listing would be dispelled as the customer encountered actual representatives from individual van lines for purposes of finding the lowest bidder.”)

76. 718 F.2d 1201 (1st Cir. 1983).

77. *Id.* at 1208.

78. *Id.* at 1204.

79. *Id.* at 1207.

80. *Id.* at 1208.

81. *See, e.g., Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1231 (7th Cir. 1993) (despite creator’s statement that “MIKE” mark was to trick those glancing from across room to think shirt was NIKE, “a jury could surely conclude that any initial confusion ends with a closer look, when the observer ‘gets it’”); *Safeway Stores, Inc. v. Safeway Disc. Drugs*, 675 F.2d 1160, 1167 (11th Cir. 1982) (“Short-lived confusion or confusion of individuals casually acquainted with a business is worthy of little weight . . .”); *Mayflower Transit, Inc. v. Ann Arbor Warehouse Co., Inc.*, 892 F. Supp. 1134, 1143 (S.D. Ind. 1995); *SNA, Inc. v. Array*, 51 F. Supp. 2d 542, 550 (E.D. Pa. 1999) (mark of airplane kit builder Seawind not infringed by kit assembler Turbine Seawind when initial confusion could not cause loss of business).

Though courts have not specifically employed search cost analysis, cases finding initial interest confusion have considered consumer inconvenience. *See, e.g., Blockbuster Entm’t Group v. Layco, Inc.*, 869 F. Supp. 505, 513 n.2 (E.D. Mich. 1994) (“[B]ecause it would be inconvenient to leave one video store to find another, those customers lured to a Video Busters store may rent video cassettes from that store despite having realized that it bears no connection to Blockbuster.”). Likewise, some cases that appear to take a strong view and treat initial interest confusion as a form of misappropriation may be explained in terms of search costs. For example, *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188 (5th Cir. 1998), involved a restaurant that used the name “The Velvet Elvis.” The assignee of the intellectual property rights of the Presley estate (“EPE”) sued on infringement grounds. The Fifth Circuit’s analysis of the actual confusion prong of the multifactor likelihood-of-confusion test relied heavily on the initial confusion of patrons who entered the restaurant thinking that it might have Elvis merchandise for sale, but upon entering “had no doubt that EPE was not affiliated with it in any way.” *Id.* at 204. Despite the dispelling of any confusion,

several courts have considered the sophistication of purchasers as a reason to reject claims based on initial interest confusion.⁸² This practice makes sense in the context of the search cost analysis. Because sophisticated purchasers will be more aware of the potential for initial confusion, and better able to alleviate it, their search costs will not significantly increase.

Even courts that embrace the free-riding rationale employ reasoning that suggests that search-cost considerations factor into their analysis. In announcing that it would consider initial interest confusion as probative of whether the Lanham Act has been violated, the Third Circuit emphasized its concern that junior users not be able to “free ride on the goodwill” of senior users.⁸³ But in applying the doctrine, the court emphasized two factors: product relatedness and level of consumer care.⁸⁴ Consumer care, like consumer sophistication, affects the search costs expended by the consumer before initial confusion is dispelled. Similarly, a consumer who is diverted to an unrelated product will have his confusion dispelled fairly quickly.⁸⁵ In both situations, a finding of

the court noted that “this initial-interest confusion is beneficial to the Defendants because it brings patrons in the door; indeed, it brought at least one of EPE’s witnesses into the bar. Once in the door, the confusion has succeeded because some patrons may stay, despite realizing that the bar has no relationship with EPE.” *Id.* Though the court did not analyze the costs to consumers of this purported misdirection, it pointed out that the initial error sometimes carried direct financial costs. “This initial-interest confusion is even more significant because the Defendants’ bar sometimes charges a cover charge for entry, which allows the Defendants to benefit from initial-interest confusion before it can be dissipated by entry into the bar.” *Id.* In this, of course, the purported initial interest confusion may also be seen as actionable point-of-sale confusion.

82. *See* *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633 (7th Cir. 1999). The court rejected a claim based on initial interest confusion because of customer sophistication:

Here, however, retailers—more specifically, those retailers who actually care about the source of the baskets—are in a better position than the typical consumer either to order the correct goods, or to return the incorrect goods and receive the intended goods. *See, e.g.,* *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207 (1st Cir. 1983) (rejecting a temporary confusion claim because the purchasers were sophisticated). Indeed, an affidavit submitted by a *Syndicate Sales* witness indicates that many retailers did, upon inspection, send back the baskets that they did not want. For the limited number of retailers that care about the source of the baskets, post-sale inspection is sufficient.

Id. at 638; *see also* *Rust Env’t & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210, 1217 (7th Cir. 1997). *But see, e.g.,* *Porsche Cars N. Am., Inc. v. Manny’s Porshop, Inc.*, 972 F. Supp. 1128 (N.D. Ill. 1997) (finding that telephone calls to junior user suggested initial confusion and disputing that Porsche customers have a high standard of care).

83. *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 295 (3d Cir. 2001).

84. *See id.* at 296.

85. But, admittedly, unrelated products are unlikely to lead to the expansion of the consumer’s evoked set of product options represented by the trademark.

infringement will not lower search costs as it might if the confusion was of unsophisticated purchasers choosing among product substitutes.⁸⁶

To be sure, the court did not neglect goodwill altogether, as it found relevant the fact that the defendant did not try to trade on the plaintiff's goodwill. But the court emphasized the *de minimis* nature of the confusion that occurred.⁸⁷ Further, as argued above, goodwill is appropriately a factor in initial confusion analysis when properly understood as a factor that draws expenditures of search costs, not actual purchases.⁸⁸

Sensitivity to search costs may also explain the outcome in trade dress cases that raise similar issues as initial interest confusion cases. Many of these precedents recognize that a junior user's product may copy some aspects of the senior user's trade dress so long as any potential confusion will be dispelled by a prominently displayed distinct trademark or logo.⁸⁹

Of course, a trademark or logo is not necessarily the first thing that a potential customer will notice. It might be a similar color scheme or product design. Until other product information becomes available, confusion, however fleeting, may result. Trade dress cases that permit limited copying of product packaging necessarily accept some potential for initial interest confusion. Consistent with the search cost rationale, however, they recognize that these potentially confusing features provide informational value to consumers by signaling that the junior user's

86. *See id.* at 297 ("Where confusion has little or no meaningful effect in the marketplace, it is of little or no consequence in our analysis.").

87. *See id.* at 297–99.

88. *See supra* text accompanying note 63. These cases raise the issue of how courts should apply the search cost rationale. The purpose of this article is to argue that courts should police initial interest confusion, if at all, in order to minimize search costs, which requires consideration of the ease with which any confusion is dispelled and consideration of whether the challenged practice carries any information benefits to the consumer. Assessing the various methods that courts might use to conduct this balancing is outside the scope of the current inquiry. That said, courts could apply a variety of doctrinal tools in addition to taking economic testimony or survey evidence. For example, as argued in the text, courts should refuse to find initial interest confusion where the effects on search costs are *de minimis*. In assessing whether search costs are raised, courts might consider the degree of product displacement caused by the challenged act. *See supra* note 74 and accompanying text. Consumer sophistication may also continue to be a factor. Whatever evidentiary methodology emerges, the resulting doctrine will have something the goodwill rationale lacks: a standard for determining when judicial intervention is warranted.

89. *See, e.g.,* *Conopco, Inc. v. May Dep't Stores Co.*, 46 F.3d 1556, 1570 (Fed. Cir. 1994); *L.A. Gear, Inc. v. Thom McAn Shoe Co.*, 988 F.2d 1117, 1134 (Fed. Cir. 1993); *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1046 (2d Cir. 1992); *cf. McNeil-PPC, Inc. v. Granutec, Inc.*, 919 F. Supp. 198 (E.D.N.C. 1995) (faint mark on pill with similar design to senior user unlikely to dispel potential post-sale confusion). As the last citation indicates, there is considerable variation in this area, and the placement of a label does not necessarily resolve the matter in the defendant's favor. *See generally* 3 MCCARTHY, *supra* note 15, § 23:53.

product is in the same category as that of the senior user.⁹⁰ Indeed, the Seventh Circuit has noted that consumer expectations may make initial interest confusion unlikely in trade dress cases.⁹¹

E. Initial Interest Enthusiasm: "Strong" Initial Interest Confusion

The search cost rationale does not perfectly explain initial interest cases prior to the popularization of the Internet. Although both *Steinway* and *Mobil* were arguably consistent with the search cost rationale,⁹² neither case embraced it. Consequently, a court applying them could find actionable initial confusion whenever consumer diversion occurs, no matter how inconsequential. Several cases have adopted this "strong" form of the doctrine.

In *Foxworthy v. Custom Tees, Inc.*,⁹³ comedian Jeff Foxworthy sued a T-shirt manufacturer for selling shirts that displayed phrases akin to his "you might be a redneck" jokes. The court granted a preliminary injunction in Foxworthy's favor on both copyright and trademark grounds. In analyzing the actual confusion prong of the circuit's multifactor likelihood-of-confusion test, the court emphasized potential initial interest confusion. A witness testified that he saw the purportedly infringing shirts, but was nearly certain that they were not Foxworthy's.⁹⁴ No matter. "[I]n the present case, [the witness] immediately *associated* the jokes with the plaintiff, and was fairly convinced that the shirts were not 'the real McCoy' for other reasons. Thus, in one respect, *the mere fact that [his] suspicions were aroused* because of the association indicates confusion on a legally cognizable level."⁹⁵

The court appeared primarily concerned with the defendant's apparent free riding on its shirts' resemblance to Foxworthy products.⁹⁶ But the court's equation of all forms of confusion, no matter how easily dispelled, is noteworthy. "The important thing is that, whether the consumer discerns the truth or gives it no thought whatsoever, the fact that some mental process *must* be performed in order to understand the association indicates not only an unfair competitive advantage but the

90. See *Am. Home Prods. Corp. v. Barr Labs., Inc.*, 656 F. Supp. 1058, 1068 (D.N.J. 1987), *aff'd*, 834 F.2d 368 (3d Cir. 1987) ("The resemblance between two products can alert consumers to the functional or utilitarian equivalence between them. . . . The free flow of information regarding the substitutability of products is valuable to individual consumers and to society collectively. . .").

91. See *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 383 (7th Cir. 1996) (rejecting initial interest confusion claim because "where product configurations are at issue, consumers are generally more likely to think that a competitor has entered the market with a similar product").

92. See *supra* note 75.

93. 879 F. Supp. 1200 (N.D. Ga. 1995).

94. *Id.* at 1215.

95. *Id.* (second emphasis added).

96. See *id.*

actual embodiment of confusion.”⁹⁷ Under goodwill analysis, forcing “mental process[es]” upon consumers suffices for a trademark injury.⁹⁸

Other cases have taken the extreme view that mere evocation of another party’s mark or trade dress may constitute infringement.⁹⁹

F. Conclusion

Notwithstanding the unconvincing rationale proffered by the courts for enjoining initial interest confusion, cases applying the doctrine are often, but not always, explainable by weighing the increased search costs from the confusion against the potential consumer benefits of increased product information. This rough balance, however, remained unarticulated. As a result, courts had little doctrinal basis for choosing between broad or restrictive applications of the doctrine. This ambiguity left judges ill-prepared to apply initial interest confusion to the large number of claims based on trademark usage on the Internet. Advocates of strong initial interest confusion proved able to turn this doctrinal uncertainty to their advantage.

II. INITIAL INTEREST CONFUSION IN CYBERSPACE

By now it is something of a cliché to observe that the Internet raises controversy about how legal doctrines designed for the “real” world should apply to cyberspace. Initial interest confusion is one of several examples. Claims based on purported initial interest confusion are increasingly popular as plaintiffs attempt to police the use of their trademarks on the Internet. Unfortunately, many of the resulting decisions have lost the rough balancing of search costs against consumer benefits that partially mediated the application of initial interest confusion to the brick and mortar world. Though many commentators

97. *Id.* at 1216.

98. *Id.* In a similar vein, see *McNeil-PPC, Inc. v. Guardian Drug Co., Inc.*, 984 F. Supp. 1066, 1074 (E.D. Mich. 1997) (“Even if the consumer realizes that the [generic drug] is not the same as the national brand once he picks the product up off the shelf and reads the label, Defendant has already accomplished what it set out to do, which is confuse the consumer at the point when he first reaches for the product on the shelf. It is at this point that the damage is done.”).

99. Prior to its broad application of initial interest confusion to the Internet, discussed *infra*, the Ninth Circuit listed potential initial confusion as a factor in finding trademark infringement and identified the harm as the “capture [of] initial consumer attention.” *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997). The court provided no analysis of how much attention was required nor why such capture was actionable; it simply cited *Mobil. Id.* See also, e.g., *Philip Morris Inc. v. Star Tobacco Corp.*, 879 F. Supp. 379, 385 (S.D.N.Y. 1995) (granting preliminary injunction against “GUNSMOKE” cigarettes brought by manufacturer of “MARLBORO” and noting plaintiff’s argument that new entrant “achieves an unfair advantage by means of a trade dress playing off consumers’ consciousness, *albeit perhaps subliminal*, of the MARLBORO trade dress”) (emphasis added).

correctly take these opinions to task for not understanding the nature of the Internet, the problem is fundamentally doctrinal. Having never articulated a cogent basis for the initial interest doctrine, courts left plenty of precedential space for an overly aggressive application to the Internet.

A. Initial Interest Confusion on the Internet

1. Purported Sources of Initial Confusion

To date, two forms of purported initial confusion have dominated judicial discussion of the doctrine as applied to the Internet: metatags and domain names.¹⁰⁰ Metatags are HTML¹⁰¹ code that describe a web site's contents. Description metatags describe the web site while keyword metatags are words that relate to the contents of the web site.¹⁰² These tags are invisible to web surfers, but are readable by search engines. Thus, a web surfer who types "Golden Retriever" into a search engine will receive a list of web sites that the engine's search algorithm deems responsive to the search. In addition to selecting pages based on their readable content, the search algorithm may also consider metatags.¹⁰³ If it does, then a web site can place itself on the list by using the term "Golden Retriever" in its metatags.¹⁰⁴

Web site owners use metatags in order to draw attention to their pages. Ideally this practice helps index the millions of pages on the Internet. One would hope that the tag "Golden Retriever" would be used by sites that have something to do with Golden Retrievers. But some site owners place common search terms into their metatags even though their sites have little, if anything, to do with the tag, a practice known as "spamdexing."¹⁰⁵ For example, several hours after Princess Diana's

100. Litigation is increasingly common for other practices. See *infra* notes 194-199 and accompanying text.

101. Hypertext Markup Language, the code in which web sites are programmed to allow web browsers to present them graphically.

102. For a good overview of metatag use and Internet searching in general, see F. Gregory Lastowka, Note, *Search Engines, HTML, and Trademarks: What's the Meta For?* 86 VA. L. REV. 835, 843-54 (2000).

103. *Id.* at 850. Many do not. See F. Gregory Lastowka, *Search Engines Under Siege: Do Paid Placement Listings Infringe Trademarks?* 14 INTELLECTUAL PROP. & TECH. L. J. Issue 7, at 2 (2002) (stating that many search engines claim not to recognize metatags).

104. Some search engines also sell placements or advertisements based on a search. Thus, a breeder of Golden Retrievers could purchase an ad that would be displayed whenever someone types "Golden Retriever" into a search engine. See *Playboy Enters., Inc. v. Netscape Commun. Corp.*, 55 F. Supp. 2d 1070 (C.D. Cal. 1999), *rev'd*, 354 F.3d 1020 (9th Cir. 2004).

105. See Ira S. Nathenson, *Internet Infoglut and Invisible Ink: Spamdexing Search Engines with Meta Tags*, 12 HARV. J.L. & TECH. 43, 46 (1998).

death, many web sites used “Princess Diana” as a metatag hoping to lure visitors who were looking for information about her.¹⁰⁶

Trademarks are sometimes used as metatags. Web site owners may incorporate the name of a competitor’s mark into the site’s metatags in the hope of drawing web surfers who are in the market for the same product or service sold by both the trademark owner and the junior user. Such use has generated infringement claims based on initial interest confusion.¹⁰⁷

The second major battleground over Internet initial interest confusion is over the domain names that identify web sites. Trademark owners have litigated against the practice of junior users who use the owners’ trademarks, or similar marks, as domain names.¹⁰⁸ This practice is said to cause initial interest confusion because the web surfer thinks he will reach the trademark owner’s site when he types the trademark into his web browser as a domain name.¹⁰⁹

2. Is the Internet Different?

The Internet is not the first electronic communications medium to raise issues of initial interest confusion.¹¹⁰ Courts have addressed initial interest confusion concerning phone numbers, which serve a similar function to domain names. *Mayflower Transit, Inc. v. Ann Arbor Warehouse Co.*¹¹¹ involved a dispute between two interstate carriers. The plaintiff, Mayflower, employed an Ann Arbor booking agent who sold the use of its phone numbers to another local booking agent, Phoenix, who worked for a different carrier, Red Ball. For a time after the sale, Ann Arbor customers seeking a Mayflower agent reached a Red Ball agent when they dialed the “Mayflower” number listed in the Yellow Pages.¹¹² Mayflower brought Lanham Act claims based on the resulting potential confusion. Note that the confusion at issue is directly analogous to that in a domain name case. A potential customer initiates an electronic contact with the expectation she will reach one company, but in fact reaches another company.

The district court ruled, however, that the resulting initial confusion was too easily dispelled to sustain a Lanham Act claim.

106. Lastowka, *supra* note 102, at 853. Most of these sites were pornographic. *Id.*

107. *See infra* Part II.B.1.

108. *See infra* Part II.B.2.

109. *See id.*

110. *But see* O’Rourke, *supra* note 24, at 309 (arguing that “[metatagging] has no obvious ‘hard copy’ counterpart, thereby making it difficult to assess from conventional legal doctrines”).

111. 892 F. Supp. 1134 (S.D. Ind. 1995).

112. *Id.* at 1137.

There can be no denying, however, the existence of several factors that lessen the likelihood that the public would confuse the two companies. For example, both Phoenix and its interstate carrier, Red Ball, have completely different names and service marks than Mayflower. Indeed, Phoenix's affiliation with Red Ball appears prominently on Phoenix's invoices, service order forms and trucks. That affiliation also appears in Phoenix's current advertising, in the Yellow Pages and otherwise, and on the large free-standing sign designating Phoenix's location. Moreover, testimony given at the hearing revealed that consumers often have three or four carriers submit estimates on the expected cost of a move. Thus, because customers are likely to use great care when selecting a van line, any initial confusion originating from the inaccurate Yellow Pages listing would be dispelled as the customer encountered actual representatives from individual van lines for purposes of finding the lowest bidder.¹¹³

If anything, the search costs implicated by *Mayflower* are higher than those present in an Internet case. The initially confused customer—who was diverted from her intended target—would lack any confusion-dispelling visual information until she had actually seen one of the movers' vehicles. In contrast, a misdirected web surfer will have more immediate clarifying information in front of him upon arriving at the "wrong" web site. Indeed, the *Mayflower* court found relevant that the defendant had confusion-resolving information available to misdirected callers.¹¹⁴ As with *Mayflower*, one would expect most initial interest cases involving the Internet to be sensitive to the ease with which confusion is dispelled. Not so.

B. Brookfield Communications v. West Coast Entertainment Corp.

The application of the initial interest confusion doctrine to Internet cases has primarily focused on the goodwill rationale. *Brookfield Communications v. West Coast Entertainment Corp.*¹¹⁵ is the leading case on initial interest confusion and the Internet.¹¹⁶ The case involved a

113. *Id.* at 1143.

114. *See id.* (noting that Phoenix employees made their affiliation clear and that customers who mentioned Mayflower were given the company's national or Michigan phone number). *Cf.* *Holiday Inns, Inc. v. 800 Reservation, Inc.*, 86 F.3d 619 (6th Cir. 1996) (rejecting claim that defendant's use of 1-800-H[zero]oliday violated Lanham Act in light of plaintiff's rights to 1-800-HOLIDAY when defendant did not cause confusion).

115. 174 F.3d 1036 (9th Cir. 1999).

116. Prior to *Brookfield*, several district courts in the Ninth Circuit had considered the use of trademarks as domain names or in machine readable code. *See, e.g.*, *Playboy Enters. v. Calvin Designer Label*, 985 F. Supp. 1220 (N.D. Cal. 1997); *see also, e.g.*, *Green Prods. Co. v. Independence Corn By-Products Co.*, 992 F. Supp. 1070 (N.D. Iowa 1997); *Jeffrey Kuester & Peter*

trademark dispute between a seller of entertainment industry information (Brookfield) and a chain of video stores (West Coast). The parties disputed the right to use the trademark "MovieBuff" both as a domain name and in web site metatags. Brookfield used "MovieBuff" as a mark for a searchable database containing entertainment-related information.¹¹⁷ West Coast claimed the right to use the term online based on its service mark "The Movie Buff's Movie Store."¹¹⁸ West Coast also had a searchable database available on its web site.¹¹⁹

The Ninth Circuit concluded that Brookfield had rights to the name, and ruled that West Coast's use of the domain name "moviebuff.com" created a likelihood of confusion under the court's multifactor test.¹²⁰ The court then turned to initial interest confusion in its analysis of West Coast's use of marks similar to "MovieBuff" in its HTML code.

1. Goodwill and Search Costs Revisited

The court acknowledged that for web pages that did not use "movie buff" as part of the domain name, no actual confusion was possible.¹²¹ The court still found the use of metatags actionable due to the supposed initial interest confusion of web surfers who use search engines.

Web surfers looking for Brookfield's "MovieBuff" products who are taken by a search engine to "westcoastvideo.com" will find a database similar enough to "MovieBuff" such that a sizeable number of consumers who were originally looking for Brookfield's product will simply decide to utilize West Coast's offerings instead. Although there is no source confusion in the sense that consumers know they are patronizing West Coast rather than Brookfield, there is nevertheless initial interest confusion in the sense that, by using "moviebuff.com" or "MovieBuff" to divert people looking for "MovieBuff" to its web site, West Coast improperly benefits from the goodwill that Brookfield developed in its mark.¹²²

Nieves, *Hyperlinks, Frames and Meta-Tags: An Intellectual Property Analysis*, 38 IDEA: J.L. & TECH. 243, 275-76 (1998) (discussing early metatag litigation); Nathenson, *supra* note 105, at 67-71 (same).

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

118. *Id.* at 1042.

119. *Id.* at 1056.

120. *Id.* at 1061.

121. *Id.* at 1062 ("Since there is no confusion resulting from the domain address, and since West Coast's initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast's web site.")

122. *Id.* The court also invoked goodwill in determining that West Coast's use of "moviebuff" in a domain name would create a likelihood of confusion. *Id.* at 1057.

The court's invocation of goodwill raises the question at the heart of initial interest confusion since *Steinway*—why prohibit benefiting from Brookfield's goodwill in this manner? The court relied largely on moral judgment. Diversion of web surfers is "improper[.]"¹²³ Beyond intuition, the court employed analogy rather than analysis, comparing metatags to billboards:

Using another's trademark in one's metatags is much like posting a sign with another's trademark in front of one's store. Suppose West Coast's competitor (let's call it "Blockbuster") puts up a billboard on a highway reading—"West Coast Video: 2 miles ahead at Exit 7"—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there. Even consumers who prefer West Coast may find it not worth the trouble to continue searching for West Coast since there is a Blockbuster right there. Customers are not confused in the narrow sense: They are fully aware that they are purchasing from Blockbuster and they have no reason to believe that Blockbuster is related to, or in any way sponsored by, West Coast. Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that Blockbuster would be misappropriating West Coast's acquired goodwill.¹²⁴

The billboard analogy captures the potential harm of initial interest confusion, but overlooks why that harm did not exist in *Brookfield*. The harm in the billboard hypothetical can be understood in terms of the search cost rationale for initial interest confusion.¹²⁵ The billboard affects the customer looking for West Coast in two ways that are relevant from a trademark perspective.¹²⁶ First, "consumers who prefer West Coast may

123. Cf. O'Rourke, *supra* note 24, at 295 (discussing common intuitions that metatagging is wrongful conduct).

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

125. See *supra* Part I.C.2.

126. This is not to say that other legal perspectives—fraud and false advertising in particular—could not apply to the situation. Perhaps some of the judicial distaste for initial interest confusion defendants is based on a sense that their conduct is akin to fraud or false advertising. But to whatever extent initial interest confusion evokes or resembles fraud or false advertising, it is neither.

Although the more likely cause of action for the false billboard would seem to be for false advertising, this action appears problematic in the metatag context because it is hard to discern what the false statement is. Use of a trademark in one's metatags may "say" any number of things. If the web site for Pepsi includes "Coca-Cola" in its metatags, its "statement" is much more likely "we are a cola like Coca-Cola" than the clearly incorrect "we are Coca-Cola." Julie A. Rajzer, Comment, *Misunderstanding the Internet: How Courts Are Overprotecting Trademarks Used in Metatags*, 2001 L. REV. MICH. ST. U. DET. C.L. 427, 462 ("[C]ourts should have no reason to preclude Pepsi

find it not worth the trouble to continue searching for West Coast.”¹²⁷ In other words, as a result of the initial confusion, the consumer’s search costs have increased. Anyone truly looking for West Coast—including those who are well aware of Blockbuster—must expend additional costs to find it. These consumers are thus harmed by the billboard stratagem. Some of them will find that the total “cost” of renting from West Coast (search costs plus the actual price) would exceed their budget for a movie rental. As a result, they will rent from Blockbuster even though that is not their preference. Indeed, if search costs are sufficiently high, Blockbuster could charge higher prices than West Coast and still sell to consumers for whom the price differential is not worth the expense of locating the cheaper store.¹²⁸

One must remember, however, that the effects of initial interest confusion are not uniformly negative. The second effect of the false billboard is to expose consumers to an alternative product choice. Suppose, hypothetically (and counterfactually), that Blockbuster were an upstart brand. Suppose further that it offers a wider selection at cheaper prices than West Coast.¹²⁹ The initially confused consumers may well be grateful for such confusion. At the very least, they have become aware of the availability of a video store alternative at the hypothetical highway exit.

What about goodwill? The harm to West Coast in the hypothetical is not that a consumer may conclude that Blockbuster is just as good or better than West Coast. That is competition. The harm is that the consumer, though choosing to spend her search budget on West Coast, is tricked into making a search expenditure on Blockbuster’s behalf. That is misappropriation. Simply calling the problem one of misappropriated goodwill confuses more than it clarifies. Using the term broadly overlooks both the potential benefits of confusion and the situations in which analogous free riding on goodwill is *not* forbidden by trademark law.¹³⁰

Indeed, *Brookfield* acknowledged that West Coast could have used the movie buff trade name for comparative advertising of its own

from putting ‘Coke’ in its metatags. Consumers who type ‘Coke’ into a search engine may want to see all similar products.”). See also *infra* note 148.

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

128. To illustrate, suppose that Blockbuster rents videos for \$4.00 each and West Coast charges \$3.75. A consumer may prefer West Coast for that reason, but, because of Blockbuster’s deception, could decide that looking for West Coast is not worth saving a quarter.

129. I do not know how Blockbuster compares to West Coast in reality.

130. See *supra* notes 42–45, 66–74 and accompanying text.

service.¹³¹ But that fair use would also have drawn the attention of web surfers who typed “movie buff” into search engines and could have resulted in the same “harm” to Brookfield as would the use of metatags. The “free ride” would still have occurred.¹³² To say that such free rides may nonetheless be fair uses suggests that balancing must be employed, but the goodwill perspective of *Brookfield* provides no guideposts for the inquiry. The court should not have used absolute terms to describe a contextual matter.¹³³

When determining whether the goodwill appropriation caused by metatags should be enjoined, the proper question is whether the costs of confusion outweigh the benefits. In some cases, like the billboard hypothetical, the costs of confusion likely outweigh any benefits. In others, particularly when there is no displacement of a competing product, like generic drugs that draw attention because their packaging resembles better-known brands,¹³⁴ the benefits of “confusion” probably outweigh the costs.

Using trademarks in metatags is more like similarly packaged pain relievers that share a store display than deceptive billboards. First, the search costs imposed upon consumers are low. As the *Brookfield* court acknowledged, confusion among web sites is unlikely.¹³⁵ Any web surfer is likely to know “immediately”¹³⁶ whether he or she has reached a

131. *Brookfield*, 174 F.3d at 1066 (“For example, its web page might well include an advertisement banner such as ‘Why pay for MovieBuff when you can get the same thing here for FREE?’”); see also *Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 814 n.2 (7th Cir. 2002) (“It is not the case that trademarks can *never* appear in metatags, but that they may only do so where a legitimate use of the trademark is being made.”).

132. *Cf. Smith v. Chanel*, 402 F.2d 562, 568–69 (9th Cir. 1968) (“By taking his ‘free ride,’ the copyist, albeit unintentionally, serves an important public interest by offering comparable goods at lower prices. On the other hand, the trademark owner, perhaps equally without design, sacrifices public to personal interests by seeking immunity from the rigors of competition.”).

133. Some courts applying *Brookfield* have found fair use of trademarks in metatags or site text. See, e.g., *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120, 1125–27 (N.D. Cal. 2003) (holding competitor’s use of trademarked tax service’s name to be nominative fair use); *Trans Union L.L.C. v. Credit Research, Inc.*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001) (metatag use is fair when allegedly infringing site is affiliated with trademark owner and offers products derived from trademark owner’s database).

Complaints about free riding in search engines may ring hollow to some, for free riding is hardly uncommon on the Internet. See O’Rourke, *supra* note 24, at 303; see generally LAWRENCE LESSIG, *THE FUTURE OF IDEAS: THE FATE OF THE COMMONS IN A CONNECTED WORLD* (2001) (arguing that the Internet represents an information commons endangered by excessive efforts to control intellectual property).

134. See *supra* note 73.

135. *Brookfield*, 174 F.3d at 1062 (“Since there is no confusion resulting from the domain address, and since West Coast’s initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast’s web site.”).

136. *Id.* at 1057.

desired page.¹³⁷ The search costs of leaving one page and returning to a search engine-generated list requires only a point and a click, not physical relocation.¹³⁸ Moreover, search engines typically display results as a list that includes excerpts of the page in question, minimizing the possibility of errant clicks.¹³⁹ In other words, reaching the “wrong” page is often the product of consumer choice. Extralegal means of preventing confusion also exist, for search engines are in competition with one another to ensure that they produce results that are likely to be useful to web surfers.¹⁴⁰ Last, the “free riding,” if any, by the junior user does not result in any displacement of the senior user’s product. Like the generic drug displayed next to the brand name, the senior user’s web site will still be listed by the search engine if it contains the relevant search terms. Merely appearing on the same computer-generated list should not cause actionable confusion.¹⁴¹ Further, the marginal increase in search costs caused by the trademark use of metatags should be weighed against the

137. “The presence and prominence of markings tending to dispel confusion as to the origin, sponsorship or approval of the goods in question is highly relevant to an inquiry concerning the similarity of the two trade dresses.” *Bristol-Myers Squibb Co. v. McNeil-P.P.C., Inc.*, 973 F.2d 1033, 1046 (2d Cir. 1992). This should be true in metatag cases.

138. In *Bihari v. Gross*, 119 F. Supp. 2d 309 (S.D.N.Y. 2000), Judge Scheindlin noted the implausibility of *Brookfield*’s metaphor:

Use of the highway billboard metaphor is not the best analogy to a metatag on the Internet. The harm caused by a misleading billboard on the highway is difficult to correct. In contrast, on the information superhighway, resuming one’s search for the correct web site is relatively simple. With one click of the mouse and a few seconds delay, a viewer can return to the search engine’s results and resume searching for the original web site.

Id. at 320 n.15. Professor McCarthy takes issue with this point, stating that this is merely a difference of degree, not kind. 4 MCCARTHY, *supra* note 15, § 25:69; *see also* Lisa M. Sharrock, *Realigning the Initial Interest Confusion Doctrine with the Lanham Act*, 25 WHITTIER L. REV. 53, 76 (2003) (arguing diversion costs on the Internet may affect purchasers). But for purposes of search cost analysis, differences in degree matter greatly.

Curiously, the *Brookfield* court and others have treated the low costs of error as a reason to give trademark concerns on the Internet *greater* attention rather than less. In considering whether West Coast’s use of “moviebuff” as a domain name created a likelihood of confusion, the Ninth Circuit reasoned that the ease with which web surfers navigate demonstrates that their standard of care is low, increasing the likelihood of confusion. *Brookfield*, 174 F.3d at 1057; *Goto.com, Inc. v. Walt Disney Co.*, 202 F.3d 1199, 1209 (9th Cir. 2000) (“Navigating among web sites involves practically no effort whatsoever . . .”). But it is precisely because Internet navigation is so low cost that web surfers need not exercise care in visiting a site. If they hit the wrong one, the expenditures of correction are minimal. For the view that these costs may matter, *see Sharrock, supra*.

139. As does Google, currently the most popular search engine.

140. *See* 4 MCCARTHY, *supra* note 15, § 25:69 (noting rise of Google based on the effectiveness of its search algorithm).

141. *Compare Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225, 1229 (7th Cir. 1993) (“That a person cannot tell the difference between the two from across the room matters little. We are dealing here with customer confusion *when choosing to purchase, or not purchase, the items*, not public confusion at viewing them from afar.”) (emphasis added).

existing clutter that already fills search engine results from other uses of a mark.¹⁴²

On the flip side, metatag use of trademarks may provide value to search engine users by providing them with a low-cost list of web sites that are related to the subject of their search. Though *Brookfield* did not raise the issue, courts and commentators alike recognize that few people expect search engines to automatically connect a trademark to the web site of its owner.¹⁴³ Search engine users may type trademarks into search engines *because* doing so will result in hits other than that of the trademark holder because web searches are a tool for finding related items as well as specific ones.¹⁴⁴ By using the trademark of a competitor in a metatag, a web site is essentially telling search engines that it is in the same category as the senior user.¹⁴⁵ Provided that any confusion is

142. For example, a Google search for “Pepsi” on July 19, 2004, produced approximately 1,790,000 hits. Because Google does not recognize metatags, 4 MCCARTHY, *supra* note 15, § 25:69, they played no role in creating this clutter. A case from the Southern District of New York recently recognized that searching for a trademark on a search engine may produce thousands of hits that have nothing to do with purportedly infringing acts. *Strange Music, Inc. v. Strange Music, Inc.*, No. 04 Civ. 02915(PKC), 2004 WL 1488414, at *9 (S.D.N.Y. July 1, 2004).

143. *See, e.g.*, *Chatam Int’l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 559 (E.D. Pa. 2001); O’Rourke, *supra* note 24, at 294; Terrell W. Mills, *METATAGS: Seeking to Evade User Detection and the Lanham Act*, 6 RICH. J.L. & TECH. 22, 26 (2000).

144. *See* Nathenson, *supra* note 105, at 79–81. Nathenson explains that Internet searches lie on a spectrum of targeted searches to conceptual inquiries. Conceptual inquiries fall into two categories: categorical and relational. A categorical search looks for information within a term’s category, as searching “movies” would produce information about “Casablanca” or “Citizen Kane.” A relational search “seeks output that is inferred from the query term,” so “one might use ‘Princess Diana’ to search about information about royalty in general.” *Id.* at 80–81. Nathenson notes that “[a]s one moves along the continuum from targeted to conceptual, one’s expectations of high precision or recall becomes less reasonable.” *Id.* at 81. Thus, if one is looking for a pain reliever, but only knows the name “Tylenol,” she may type that term into a search engine even though she is not specifically looking for the Tylenol site. *See* Stephen W. Feingold, *Trademarks: Means to Avoid Confusion, or Property Rights. Two Pending Cases Outline Dilemma*, 222 N.Y. L.J. no. 17, at S2, col. 3 (1999) (“[O]ne highly ethical and respected advertising executive specializing in the Internet . . . believes that someone entering HONDA in a search engine is just as likely looking for information about Japanese cars as for information specifically about Honda.”). One commentator disagrees that consumers should be able to use trademarks as shortcuts, making the curious claim that “consumer education” will enable such consumers to get information with other methods. Chad J. Doellinger, *Trademarks, Metatags, and Initial Interest Confusion: A Look to the Past to Reconceptualize the Future*, 41 IDEA: J.L. & TECH. 173, 210 (2001); *see also* Note, *Confusion in Cyberspace: Defending and Recalibrating the Initial Interest Confusion Doctrine*, 117 HARV. L. REV. 2387, 2406 (2004). This overlooks the fact that trademarks are information-rich terms. Returning again to the soy milk anecdote, many soy milks are, well, terrible. If I like Silk and am looking for a soy milk that mimics its flavor, but at a lower price, “Silk” is a helpful search term in a way that “soy milk” alone is not.

145. *See* Lastowka, *supra* note 102, at 861 (describing the role of metatags in keyword searches); *cf.* *Playboy Enters., Inc. v. Netscape Commun. Corp.*, 55 F. Supp. 2d 1070 (C.D. Cal. 1999). *Playboy* involved a search engine accepting payment to allow certain advertisements to appear when a web user used “playboy” or “playmate” as search terms. In rejecting the claim that

quickly dispelled, the metatag use is a potential avenue to give consumers information.¹⁴⁶ Treating such use as unfair competition makes unwarranted assumptions. *Brookfield* does not explain why a metatag necessarily means “I am the trademark” and not “I am like the trademark.”¹⁴⁷ When metatags are used in the latter sense, the balance

this arrangement infringed on Playboy’s trademark, the district court distinguished *Brookfield* in part by arguing that a different analogy applied:

Here, the analogy is quite unlike that of a devious placement of a road sign bearing false information. This case presents a scenario more akin to a driver pulling off the freeway in response to a sign that reads “Fast Food Burgers” to find a well-known fast food burger restaurant, next to which stands a billboard that reads: “Better Burgers: 1 Block Further.” The driver, previously enticed by the prospect of a burger from the well-known restaurant, now decides she wants to explore other burger options. Assuming that the same entity owns the land on which both the burger restaurant and the competitor’s billboard stand, should that entity be liable to the burger restaurant for diverting the driver? That is the rule [plaintiff] contends the Court should adopt.

Id. at 1075. The effectiveness of this distinction is questionable. Using metatags to allow a web page to be listed in search engine results alongside the page of a trademark owner, at issue in *Brookfield*, is analogous to the *Netscape* situation as well. The only difference is that one situation involved payment to the search engine while the other did not. The court did not explain why payment saves the practice from being “devious.”

Unfortunately, the Ninth Circuit was also not persuaded and reversed the district court. *Playboy Enters., Inc. v. Netscape Commun. Corp.*, 354 F.3d 1020 (9th Cir. 2004). Applying *Brookfield*, the court found a triable issue of fact as to whether users might click on the ads thinking they were related to the plaintiff’s marks. “Even if they realize ‘immediately upon accessing’ the competitor’s site that they have reached a site ‘wholly unrelated to’ PEI’s, the damage has been done.” *Id.* at 1025 (quoting *Brookfield Commun. v. W. Coast Entm’t*, 174 F.3d 1036, 1057 (9th Cir.)).

The court noted, however, that under Playboy’s theory, banner advertisements that were clear about their source would not give rise to confusion. *Id.* at n.16; *see also id.* at 1030 (“We are also not addressing a situation in which advertisers or defendants overtly compare PEI’s products to a competitor’s—saying, for example, ‘if you are interested in Playboy, you may also be interested in the following message from [a different named company].’”) (brackets in original). In a concurrence that criticized *Brookfield*’s reasoning for not treating metatagging the way analogous behavior in the brick and mortar world would be treated, Judge Berzon pointed out that under *Brookfield*’s logic, the alternative suggested by the court might not preclude a conclusion that initial interest confusion exists. *Id.* at 1034 (Berzon, J., concurring).

146. Professor McCarthy has worried that permitting metatag use of trademarks would lead to the insertion of irrelevant trademarks in metatags, thus harming Internet navigation. *See* 4 MCCARTHY, *supra* note 15, § 25:69. But the above analysis does not treat “spamdexing” as an act that benefits the public. *See generally* Nathenson, *supra* note 105. Initial interest confusion is likely to be applied when the products in question are in relative proximity. *See infra* notes 175-177 and accompanying text. The metatag use that is the subject of the current inquiry concerns *related* web sites, not, for example, an attempt to draw search engine attention to a pornographic site by using the trademark “Coca-Cola.” This latter problem has drawn recent congressional attention. *See* 18 U.S.C. § 2252B (2004) (criminalizing the use of misleading domain names to deceive a person into viewing obscenity or a minor into viewing material harmful to minors).

147. This shortcoming was anticipated by Thomas F. Presson & James R. Barney, *Trademarks as Metatags: Infringement or Fair Use?*, 26 AIPLA Q.J. 147 (1998). Addressing the road sign metaphor, which had been raised in pre-*Brookfield* cases, they wrote:

While technically correct, this analogy is not inclusive of all the possible legitimate uses that a bed and breakfast owner could make of a trademark metatag. For instance, why is it

between harms and benefits tilts against policing metatag use of trademarks as actionable initial interest confusion.¹⁴⁸

2. What About Domain Names?

In light of the ease with which potential confusion from metatag use is dispelled, and the potential benefits to consumers, the Ninth Circuit erred in deeming actionable the metatag use in *Brookfield*. The case for policing domain name use because of initial interest confusion appears stronger.¹⁴⁹ Though the costs of diversion remain low, several factors suggest that the harms of diversion will outweigh the benefits. First, consumers who type a trademark as a domain name are more likely to be seeking the mark's owner than a company in the same line of business as the mark holder.¹⁵⁰ Second, the diversion has a greater

necessarily true that the insertion of the term "SHERATON®" in the bed and breakfast owner's web site is equivalent to saying, "this way to the Sheraton?" It could also be interpreted to mean: (1) "if you are interested in the SHERATON®, we have cheaper rates;" or (2) "our bed and breakfast is located just minutes from the SHERATON®;" or (3) "if the SHERATON® is full, try us;" or (4) "three out of four travelers prefer us to the SHERATON®." Likewise, the bed and breakfast owner could simply erect his billboard right next to SHERATON®'s billboard (zoning laws permitting) so that drivers would be forced to look at both signs at the same time. All of these would be considered legitimate forms of comparative advertising and as such are encouraged under FTC policy.

Id. at 173–74 (footnotes omitted).

148. In its analysis of whether use of "moviebuff" as a domain name was likely to confuse, *Brookfield* acknowledged that the diversion caused by use of the mark could benefit consumers. *Brookfield*, 174 F.3d at 1057 ("A consumer who was originally looking for Brookfield's products or services may be perfectly content with West Coast's database (*especially when it is offered free of charge*); but he reached West Coast's site because of its use of Brookfield's mark as its second-level domain name, which is a misappropriation of Brookfield's goodwill by West Coast.") (emphasis added). If the databases are of equal quality, the purported confusion would benefit the consumer in the court's hypothetical.

Indeed, by broadening the consumer's choice of web sites, the purported confusion may enhance competition and give web sites an incentive to invest in making their site preferable to consumers as a specific destination—for example, by creating a user-friendly interface—such that consumers will seek it out *to the exclusion* of competitors. Aggressively policing initial interest confusion, by contrast, discourages such investment by allowing trademark owners to reap the benefits of visitors for whom the mark functions as a generic. See *supra* notes 54–56 and accompanying text. *Contra Confusion in Cyberspace*, *supra* note 144 at 2404. Again, trademark holders are expected to ensure that their marks do *not* become generic. 2 MCCARTHY, *supra* note 15, § 12:26.

149. *Brookfield* found that there was a likelihood of confusion between West Coast's using "moviebuff.com" and Brookfield's "MovieBuff" trademark. The court did not resort to initial interest confusion in this analysis.

150. Courts have assumed that Internet users expect that a web site with a domain name that is a trademark will be connected to the trademark's owner. See, e.g., *SNA, Inc. v. Array*, 51 F. Supp. 2d 542, 552 (E.D. Pa. 1999); 4 MCCARTHY, *supra* note 15, § 25:73 ("[T]hrough habit and convention, Internet users have come to expect that to reach the web site of a company they should be able to type in the name of the company or its major trademark . . .").

displacement effect.¹⁵¹ Domain names are rivalrous; metatags are not. A web surfer who cannot access a sought-after web site by typing the trademark as a domain name has lost that avenue for reaching his desired site.¹⁵² In contrast, a search engine user who hits the wrong site can return to her result list or refine her search. So there appears to be a basis—though by no means ironclad¹⁵³—for concluding that the aggregate costs of “misabeled” web sites justify granting a property right to trademark holders in the use of their marks as domain names.

It is worth noting that courts need not have the final say on these disputes. Congress has enacted legislation designed to give trademark holders the ability to use their marks as domain names, even when another party has beaten them to online registration.¹⁵⁴ Given Congress’s willingness to act, some judicial modesty with respect to novel initial interest confusion claims may be in order.

3. A Problem of Technology or Doctrine?

By refusing to balance the harms and benefits to consumers of metatag use, the Ninth Circuit opened the door to wider application of the “strong view” of initial interest confusion.¹⁵⁵ For the most part, commentators have treated *Brookfield’s* shortcomings as a failure by the

151. See *supra* note 74 and accompanying text.

152. *Brookfield* made this point in considering whether “moviebuff.com” would also be an infringing use of the “MovieBuff” trademark. “Consumers may wrongly assume that the “MovieBuff” database they were searching for is no longer offered, having been replaced by West Coast’s entertainment database, and thus simply use the services at West Coast’s web site.” *Brookfield*, 174 F.3d at 1057. This analysis only applies to a use like “pepsi.com.” There is no similar displacement with a site devoted to comparative advertising named “cokeisbetterthanpepsi.com” or a site dedicated to criticism called “pepsisucks.com.”

153. Many uses of a trademark as a domain name may provide information of value to web surfers. For example, consumers typing a trademark as a domain name may be directed to a site established to criticize the trademark holder. *SNA*, 51 F. Supp. 2d at 552–53. The web site may also be a seller of the trademark holder’s products, products derived from the trademark holder, or otherwise affiliated with the trademark holder. Nonetheless, courts have used initial interest confusion to quash these uses of trademarks. See, e.g., *Paccar Inc. v. Telescan Tech., L.L.C.*, 319 F.3d 243 (6th Cir. 2003) (suit by truck manufacturer against used truck locator service); *Trans Union L.L.C. v. Credit Research, Inc.*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001) (affiliated company that sold derivative products); *SNA, supra*, (criticism), *Bear Stearns Cos. v. Lavalle*, 2002 WL 31757771, No. Civ. A. 3:00CV1900D (Dec. 3, 2002) (criticism, but permitting domain names that are themselves critical); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d at 191 (“[E]ven if the user will easily recognize, upon reaching defendants’ web site, that it is only a parody, the use of plaintiffs’ mark as the site’s domain name . . . creates initial interest confusion . . .”). But see *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108 (D. Minn. 2000).

154. The Anticybersquatting Consumer Protection Act creates liability for those who, with a “bad faith intent to profit” from another’s trademark, use a domain name that is identical or confusingly similar to a famous trademark. 15 U.S.C. § 1125(d).

155. See *supra* Part I.E.

court to understand the Internet's nature.¹⁵⁶ They also criticize the court for using the wrong metaphor to describe search engines and metatag use, preferring discount bins and store shelves to highway billboards.¹⁵⁷ Though correct as far as it goes, an analysis of *Brookfield* on this basis overlooks the more fundamental problem: Nothing in the doctrine of initial interest confusion precluded the court from ruling as it did. In creating the doctrine of initial interest confusion, *Steinway*, *Mobil*, and other precedents emphasized consumer diversion; they did not calibrate the degree of diversion necessary.¹⁵⁸ Nor did these courts cast the initial

156. See, e.g., Dan McCuaig, *Halve the Baby: An Obvious Solution to the Troubling Use of Trademarks as Metatags*, 18 J. MARSHALL J. COMPUTER & INFO. L. 643, 662 (2000) (arguing that *Brookfield* "rest[s] on a fundamental misunderstanding of the way in which Internet search engines operate"); Shannon N. King, Note, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 15 BERKELEY TECH. L.J. 313, 313-14 (2000) ("[T]his ruling employs an unusual confusion analysis that does not take into account the unique expectations of Internet consumers."); Lastowka, *supra* note 102, at 857-59 (criticizing *Brookfield's* billboard metaphor); Tom Monagan, Note, *Can an Invisible Word Create Confusion? The Need for Clarity in the Law of Trademark Infringement Through Internet Metatags*, 62 OHIO ST. L.J. 973, 998 (2001) (arguing that metatags cannot create visual associations); Rajzer, *supra* note 126, at 456 ("[The billboard metaphor] fails to address the ease of movement from one web site to another . . ."); Jonathan A. Weininger, Note, *Trademark Metatagging: Lanham Act Liability or Pareto Optimality*, 23 WHITTIER L. REV. 469, 497 (2001) (criticizing billboard metaphor); Bryce J. Maynard, Note, *The Initial Interest Confusion Doctrine and Trademark Infringement on the Internet*, 57 WASH. & LEE L. REV. 1303, 1338 (2000) ("[M]anipulative metatagging is not the same as ordering Coke and receiving Pepsi instead; it is more akin to ordering Coke and having a waiter ask 'Is Pepsi okay?' The potential consumer is faced with a number of alternate choices and must make a reasonable, informed decision.") (footnote omitted); Mills, *supra* note 143, at 27-29 (discussing the absence of visible trademark use). *But see*, e.g., 4 MCCARTHY, *supra* note 15, § 25:69 (praising *Brookfield*); Doellinger, *supra* note 144, at 173-74 (agreeing with *Brookfield's* outcome); *id.* at 216 (arguing that "improper use of goodwill occurs by placing the trademark in one's metatags, and thus the diversion and harm occurs merely by having the web site appear on the search engine results list"). Several commentators suggested that initial interest confusion was not the proper framework for analysis before the *Brookfield* ruling. See, e.g., Presson & Barney, *supra* note 147, at 173-74 (discussing flaw of highway analogy); O'Rourke, *supra* note 24, at 304; Nathenson, *supra* note 105, at 115-18; Michael R. Sees, *Use of Another's Trademark in a Web Page Meta Tag: Why Liability Should Not Ensure Under the Lanham Act for Trademark Infringement*, 5 TEX. WESLEYAN L. REV. 99, 117-18 (1998) (noting that metatag inclusion may be an avenue for comparative advertising, which aids consumers).

157. See, e.g., McCuaig, *supra* note 156, at 662-63 (likening situation in *Brookfield* to a store in which West Coast and *Brookfield's* products are stacked next to each other); Presson & Barney, *supra* note 147, at 166 (likening metatag use to a store that displays Tylenol next to generic brand); King, *supra* note 156, at 325 ("The court's analogy over-emphasizes the costs involved in getting off at the wrong 'cyber-exit' compared with a real highway exit. It takes just a few mouse clicks and a couple of seconds to 'go back' on the Internet."); Lastowka, *supra* note 102, at 859-62 (likening search engines to a thrift store with large bins, and metatags as requests to be placed in one or another bin); see also Mark T. Garrett, *Recent Developments in Trademark Law*, 8 TEX. INTELL. PROP. L.J. 101, 106 (1999) (arguing that a better analogy "is the placement of one's billboard beside a competitor's billboard, or the placement of one's business near a competitor's business. In these cases, as in the case of competing hits on a hit list, a consumer is presented with two equally accessible options").

158. Though several criticisms of *Brookfield* take it to task for failing to consider potential information benefits to consumers of the use of trademarks in metatags, see, e.g., Maynard, *supra*

interest confusion doctrine in terms of consumer protection. The emphasis was always on the trademark owner's goodwill.¹⁵⁹ Though many courts stayed their hand in situations where the confusion was likely negligible,¹⁶⁰ others found initial interest confusion simply because consumers had to engage in "mental processes," long before the Internet became an issue.¹⁶¹

The broad view taken by the Ninth Circuit (which neglected consumer search costs), though arguably a break from majority practice and inconsistent with several specific applications, was not a break in initial interest confusion doctrine. Simply put, *Brookfield* was a precedential accident waiting to happen—a point made clear by the court's reliance on previous initial interest confusion cases.¹⁶²

C. *Brookfield's Aftermath:*

"Strong" Initial Interest Confusion on the Internet

Brookfield ushered in a trend of Internet cases that failed to consider search costs in upholding claims based on initial interest confusion.¹⁶³ Whatever rough balancing that had characterized the doctrine's application in the brick and mortar world was lost.

1. Inviting Strong Claims

Brookfield contained several invitations to strong initial interest confusion claims. First and foremost, the case relied on the goodwill theory of initial interest confusion.¹⁶⁴ Bolstered by the misleading analogy of metatags to highway billboards, the doctrine as applied had no limiting mechanism designed to consider consumer interests.¹⁶⁵ Second, in its discussion of whether the moviebuff.com domain name was infringing, the court viewed the ease of navigating the Internet as

note 156, at 1338; Garrett, *supra* note 157, at 106, these critiques do not address the initial interest confusion doctrine more generally.

159. The application of goodwill protections on the Internet has led critics to question the wisdom of protecting goodwill at all. See Presson & Barney, *supra* note 147, at 174 ("[T]he 'spirit' of trademark protection is not to protect the investment that trademark owners may choose to make in extensive and costly advertising, but rather, to protect consumers against the nuisance of confusing and misleading marks.").

160. See *supra* Part I.D.

161. See *supra* Part I.E.

162. *Brookfield*, 174 F.3d at 1062 ("Recently in *Dr. Seuss*, we explicitly recognized that the use of another's trademark in a manner calculated 'to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion, may be still an infringement.' *Dr. Seuss*, 109 F.3d at 1405 (citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58 (2d Cir.1987)).").

163. See *infra* Part II.C.2.

164. See *supra* Part II.B.

165. See *id.*

raising the likelihood of consumer confusion, and neglected to consider that web surfers would take into account the strong likelihood of mis-hits when web surfing.¹⁶⁶ This erroneous view is likely to be compounded in the future as more Internet neophytes become acquainted with the “false starts and excursions awaiting [Internet users] in this evolving medium.”¹⁶⁷ Moreover, to the extent that a web site employing a trademark in its metatags becomes a site that “looks like” another, *Brookfield’s* failure to consider consumer expectations clashes with several trade dress cases that consider initial interest confusion.¹⁶⁸

Third, *Brookfield* removed initial interest analysis from the multifactor *Polaroid*-style likelihood-of-confusion test. Although courts have recognized that initial interest confusion might be a stand-alone trademark injury, they generally consider such confusion as part of the multifactor test.¹⁶⁹ Because other factors may cut against a finding of likelihood of confusion, treating initial interest confusion independently of the multifactor test improves the prospects of any given claim.¹⁷⁰

Brookfield elevated *de minimis* confusion to a recognized cause of action. Subsequent Ninth Circuit cases sought to temper some of *Brookfield’s* implications, but without alleviating the root of the problem: the case’s reliance on a subjective, and ultimately standardless goodwill analysis. In *Playboy Enterprises, Inc. v. Welles*,¹⁷¹ the court picked up *Brookfield’s* suggestion that metatag use of a trademark may nevertheless be permissible. Playboy sought to prevent a former Playmate of the Year from identifying herself as such on her Internet web site. The court held that Welles, the defendant, could include the terms “playboy” and “playmate” in her metatags as a nominative use of

166. See *supra* note 138.

167. *Chatam Int’l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 559 (E.D. Pa. 2001).

168. See, e.g., *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 383 (7th Cir. 1996) (rejecting initial interest confusion claim because “where product configurations are at issue, consumers are generally more likely to think that a competitor has entered the market with a similar product”).

169. See *supra* note 35.

170. *Brookfield Commun. v. W. Coast Entm’t*, 174 F.3d 1036, 1062 n.24 (9th Cir. 1999) (“Because we agree that the traditional eight-factor test is not well-suited for analyzing the metatags issue, we do not attempt to fit our discussion into one of the *Sleekcraft* factors.”). The Ninth Circuit later clarified that it did not exclude multifactor analysis from all discussion of Internet initial interest confusion. *Interstellar Starship Services, Ltd. v. Epix, Inc.*, 304 F.3d 936, 945 (9th Cir. 2002) (“Of course, the remainder of the *Sleekcraft* factors complete the case-by-case inquiry necessary to evaluate initial interest confusion on the Internet.”). See also *Playboy Enters. v. Netscape Commun. Corp.*, 354 F.3d 1020, 1026 (9th Cir. 2004); cf. *Cody*, *supra* note 24 (criticizing application of initial interest confusion to the Internet when the traditional likelihood-of-confusion test would produce better results).

171. 279 F.3d 796 (9th Cir. 2002).

the trademarks.¹⁷² In its holding, the court noted its concern that restricting nominative uses in metatags might “hinder[]the free flow of information on the internet, something which is certainly not a goal of trademark law.”¹⁷³ But this statement does not explain why the information available from the former Playmate’s web site is more valuable to consumers than would be information about products similar to Playboy’s from a competitor’s site (one who, unlike Welles, lacked a past link to the company). Ensuring the free flow of information would dictate similar treatment in each situation, especially since each presents the same potential for diversion. Further, the court persisted in its view that there is something inappropriate about metatag use. Welles’s use of metatags was permissible in part because Playboy’s web site still appeared first in search engine results. That is, Welles could seek to appear on a search engine result with Playboy, but she could not be too successful at doing so.¹⁷⁴

The Ninth Circuit also pulled back from suggesting that any similarity among web site domain names constituted initial interest confusion. *Interstellar Starship Services, Ltd. v. Epix, Inc.*¹⁷⁵ held that the question whether domain names that incorporated trademarks caused initial interest confusion depended on the similarity of the products (thus permitting use of www.apple.com by an apple grower who did not sell computers) and the notoriety of the mark (thus prohibiting an apple grower from drawing hits by using www.DRSEUSS.com).¹⁷⁶ Although these distinctions can be defended based on search costs, the court’s analysis focused on the goodwill rationale.¹⁷⁷

172. *Id.* at 803. The three-factor test for permissive nominative use employed by the court requires that (1) the mark be used only when there is no adequate descriptive substitute; (2) the defendant use no more of the mark than necessary; and (3) the defendant do nothing to suggest sponsorship or endorsement of the mark holder. *Id.* at 801.

173. *Id.* at 804.

174. *Id.* (“We note that our decision might differ if the metatags listed the trademarked term so repeatedly that Welles’ site would regularly appear above [Playboy’s] in searches for one of the trademarked terms.”).

175. 304 F.3d 936 (9th Cir. 2002).

176. *Id.* at 943–44. *See also* Nissan Motor Co. v. Nissan Computer Corp., Nos. 02-57148, 03-55236, 03-55017, 03-55144, 2004 WL 1753289, at *13 (9th Cir. August 6, 2004) (“Nissan Computer’s use of nissan.com to sell non-automobile-related goods does not infringe because Nissan is a last name, a month in the Hebrew and Arabic calendars, a name used by many companies, and ‘the goods offered by these two companies differ significantly.’ However, Nissan Computer traded on the goodwill of Nissan Motor by offering links to automobile-related websites.”) (quoting *Interstellar*, 304 F.3d at 944).

177. *Interstellar*, 304 F.3d at 945 (“If a *rogue* company adopts as its domain name a protected trademark and proceeds to sell goods similar to those offered by the trademark owner, it necessarily free rides on the trademark owner’s goodwill, and that rogue company benefits from increasing initial interest confusion as consumers exercise lower levels of care in making their purchasing decisions.”) (emphases added).

2. Picking Up the Baton

Prior to *Brookfield*, initial interest cases rarely found that fleeting confusion mattered,¹⁷⁸ but such examples are increasingly common. Several courts followed *Brookfield*'s lead by prohibiting the metatag use of trademarks.¹⁷⁹ The resulting opinions ignored the ease with which confusion could be dispelled, focusing instead on the purported misappropriation of goodwill.¹⁸⁰

Many courts also employed initial interest confusion to give trademark owners effective property rights to use their marks as domain names, notwithstanding the prior registration of the domain by a third party.¹⁸¹ For example, in *OBH, Inc. v. Spotlight Magazine, Inc.*,¹⁸² a district court considered a parody site of the Buffalo News with the domain name "thebuffalonews.com." In rejecting defendants' disclaimer

Although the court's concern with product similarity echoes a similar concern in the pre-Internet initial interest cases, *see supra* text accompanying note 84, it is misplaced in the Internet context. In the brick and mortar world, product likeness is significant because the difference in products is what easily dispels any consumer illusions. On the Internet, it is the obvious differences in web pages, competing or not, that does so. If a competing product has a web page that is confusingly similar to a trademark holder's, then the proper cause of action is for infringement based on likelihood of point-of-sale confusion, not its initial interest cousin.

Nonetheless, numerous cases have applied the proximate product test to address initial interest claims. *See Network Network v. CBS, Inc.*, 2000 WL 362016, 54 U.S.P.Q. 1150 (C.D. Cal. Jan. 18, 2000), at *9 ("A trademark violation based on initial interest confusion involves the junior user capitalizing on the senior user's goodwill. The senior user's customers, at least tangentially in the market for the junior user's services, accidentally access the infringing site while in search of information on the senior user's products. Thus, relatedness of products is an important component in the analysis, even if the products need not be closely related. . . . Unlikely indeed is the hapless Internet searcher who, unable to find information on the schedule of upcoming NASCAR broadcasts of "Dukes of Hazzard" reruns, decides to give up and purchase a computer network maintenance seminar instead."). *See also Chatam Int'l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549 (E.D. Pa. 2001) (rejecting initial interest claim because of product differences); *Northland Ins. Co. v. Blaylock*, 115 F. Supp. 2d 1108, 1121 (D. Minn. 2000) (initial interest confusion not reflective of likelihood of confusion when use of trademark as domain name was not commercial); *Bigstar Entm't, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 211 (S.D.N.Y. 2000) (no Internet initial interest confusion when non-competitors, non-identical web sites, weak marks, differing products, third-party use of similar trade names, no intentional use of plaintiff marks in metatags, and no evidence of defendant bad faith). Not all courts have required competition to find initial interest confusion. *See, e.g., N.Y. State Soc'y of Certified Public Accountants v. Eric Louis Assocs.*, 79 F. Supp. 2d 331 (S.D.N.Y. 1999).

178. *See supra* Part I.E.

179. *See, e.g., Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 812–13 (7th Cir. 2002) (following *Brookfield*); *Bayer Corp. v. Custom School Frames, L.L.C.*, 259 F. Supp. 2d 503, 509 (E.D. La. 2003) (same); *Soc'y of Certified Public Accountants*, 79 F. Supp. 2d at 342 ("When [visitors] arrive instead at Defendant's web site, they cannot help being confused—even if only momentarily.").

180. *Promatek*, 300 F.3d at 812–13 ("What is important is not the duration of the confusion, it is the misappropriation of [plaintiff's] goodwill. [Defendant] cannot unring the bell.").

181. *See, e.g., cases cited in note 153; Paccar Inc. v. Telescan Tech.*, L.L.C., 319 F.3d 243 (6th Cir. 2003).

182. 86 F. Supp. 2d 176 (W.D.N.Y. 2000).

defense, the court explained that “the problem with this argument is that it ignores the initial interest confusion caused by defendants’ use of the plaintiffs’ mark. Internet users entering ‘thebuffalonews.com’ domain name *are expecting to arrive at The Buffalo News’ web site*. When they arrive instead at defendants’ web site *they cannot help being confused—even if only momentarily.*”¹⁸³ Though the court purported to make a finding of fact that Internet users will guess at domain names, the only citation for its conclusion was to *Brookfield*.¹⁸⁴ The court concluded that the labeling causes the expenditure of “time and energy” for those who access the defendants’ site, but did not balance the “momentar[y]” confusion against other consumer interests.¹⁸⁵ The court also discarded consideration of consumer sophistication as a means of sorting between valid and invalid initial interest confusion claims. Instead, it followed *Brookfield*’s lead and downplayed this factor’s significance.¹⁸⁶

In many cases, courts applying strong initial interest confusion to the Internet have found actionable infringement where no such infringement was found in the “real world.”¹⁸⁷ This has produced doctrinal tension in some circuits between Internet initial interest confusion cases and prior case law involving parties operating in the

183. *Id.* at 190 (emphases added).

184. *Id.* at 180 (citing *Brookfield Commun. v. W. Coast Entm’t*, 174 F.3d 1036, 1045 (9th Cir. 1999)). This is not to say that such expectations do not exist or that no evidence can be adduced for them. See *Nissan Motor Co. v. Nissan Computer Corp.*, 89 F. Supp. 2d 1154, 1164 (C.D. Cal. 2000), *aff’d*, *Nissan Motor Co. v. Nissan Computer Corp.*, No. 00-55678, 2000 WL 1875821 (9th Cir. Dec. 26, 2000) (citing survey evidence that ninety-two percent of consumers would expect to find information about cars at *nissan.com* or *nissan.net* web sites). Some courts have demanded evidence of actual initial interest confusion on the Internet. See *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 465 (7th Cir. 2000).

185. *Spotlight Magazine*, 86 F. Supp. 2d at 190 (quoting *Planned Parenthood Fed’n of Am., Inc. v. Bucci*, No. 97 Civ. 0629, 1997 WL 133313, at *12 (S.D.N.Y. Mar. 24, 1997).

186. *Id.* at 195.

187. For example, in *SNA, Inc. v. Array*, 51 F. Supp. 2d 542 (E.D. Pa. 1999), the district court granted a preliminary injunction in favor of an airplane kit manufacturer (Seawind) against a newsletter company that used the name “seawind.net” to post its “Seawind Builders Newsletter.” The court ruled that the web site name would cause initial confusion, but denied the motion against the use of “seawind” in the newsletter, which was also published on paper. *Id.* at 551–53. Though the content of the media were largely the same, the court treated them differently. One could try to justify this result under the search cost rationale by the fact that the Internet creates a new low-cost avenue for information about a product. To summon information about Seawind, one need only type that name into a web browser. For this to work, the trademark domain name must be set aside for the trademark owner, who is the party most likely to have the incentive to create information at the web site attached to its mark. Allowing a third party to take the name eliminates the opportunity to lower search costs if third parties are deemed less likely as a class to provide useful information about the subject of the domain name. This argument would not similarly apply to metatags, for search engine results lists can present multiple options.

brick and mortar context.¹⁸⁸ Similarly, the doctrine has been applied to Internet controversies outside the domain name and metatag context.¹⁸⁹ Courts have also considered initial confusion as a more robust part of the multifactor test when applying it to the Internet.¹⁹⁰

D. Holdouts: “Weak” Initial Interest Confusion on the Internet

Not all courts have followed *Brookfield*'s lead. Some judges considering Internet-based claims of initial interest confusion have issued opinions suggesting that the nature of the confusion caused by using trademarks in domain names or metatags does not warrant a suit under the Lanham Act, but these cases have not involved competing products.¹⁹¹

188. *Compare* *Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 812–13 (7th Cir. 2002) (metatag case in which “[w]hat is important is not the duration of the confusion, it is the misappropriation of [plaintiff’s] goodwill”), *with* *Nike, Inc. v. “Just Did It” Enters.*, 6 F.3d 1225 (7th Cir. 1993) (despite creator’s statement that “MIKE” mark was to trick those glancing from across room to think shirt was “NIKE,” “a jury could surely conclude that any initial confusion ends with a closer look, when the observer ‘gets it’”).

189. *See infra* notes 197–199 and accompanying text.

190. In *Trans Union L.L.C. v. Credit Research, Inc.*, 142 F. Supp. 2d 1029 (N.D. Ill. 2001), a district court considered an infringement claim based on the defendant’s use of the plaintiff’s trademark or logo in its domain name and metatags. Although there was no evidence that anyone accessed defendant’s web site thinking they would reach the plaintiff’s, the court still weighed the actual confusion factor in plaintiff’s favor based on the prospect of Internet-based initial interest confusion. *Id.* at 1044 (“But with regard to the logo and the transunioncredit domain name, the risk of initial interest confusion tips this element of the test in favor of Trans Union.”) (emphasis added). *See also, e.g.*, *Pa. Bus. Bank v. Biz Bank Corp.*, No. 01-2529, 2004 WL 1799657, at *10-11 (E.D. Pa. Aug. 6, 2004) (weighing actual confusion factor in plaintiff’s favor despite lack of evidence based on expected initial interest confusion due to domain name similarity to plaintiff’s mark).

191. *See, e.g.*, *Hasbro, Inc. v. Clue Computing, Inc.*, 232 F.3d 1, 2 (1st Cir. 2000) (holding computer company’s clue.com web site does not cause initial interest confusion with board game Clue and noting “in a case involving such disparate products and services as this, the court’s refusal to enter the ‘initial interest confusion’ thicket is well taken given the unlikelihood of ‘legally significant’ confusion”). *See also* *Strange Music, Inc. v. Strange Music, Inc.*, No. 04 Civ. 02915(PKC), 2004 WL 1488414, at *9 (S.D.N.Y. July 1, 2004) (declining to find that goods were proximate because of purported initial interest confusion stemming from search engine results and noting low correction costs); *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001) (initial interest confusion not cognizable between non-competing sites); *Bihari v. Gross*, 119 F. Supp. 2d 309, 320–23 (S.D.N.Y. 2000) (trademark use in metatags fair and use on site critical of trademark owner would “provide users with information about [plaintiff]”); *Teletech Customer Care Mgmt. Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1414 (C.D. Cal. 1997) (pre-*Brookfield* case stating that “brief” initial confusion of browsers typing trademark name as domain name is “not cognizable under the trademark laws”). Again, these cases did not involve proximate products in competition. One district court indicated a willingness to permit a goods reseller to incorporate the trademark of the source of the goods in its metatags, but granted a temporary restraining order against such use based on its view that the reseller’s site was misleading. *Bernina of Am., Inc. v. All Brands Sewing Machines & Sergers*, 57 U.S.P.Q. 2d 1883 (N.D. Ill. 2001) (“If AllBrands’ web site was not confusing to customers, then an injunction of AllBrands’ use of the Bernina and Bernette trademarks in its metatags would be improper because such use merely directs customers to the location where

At least one court has suggested that the policy questions raised by initial interest confusion on the Internet are better left to Congress than to judges.¹⁹² There is no reason why not. As discussed above, Congress has already intervened in the area of domain names.¹⁹³

E. Consequences

Though some fear that initial interest confusion precedents may stymie the Internet's development,¹⁹⁴ the heavens are unlikely to fall if Pepsi must use a metatag that says "Pepsi is better than Coke" rather than a tag that simply says "Coke." Indeed, the market may moot the metatag issue, as search engines seek to defeat spamdexing by ignoring metatags.¹⁹⁵ As for use of trademarks as domain names, Congress has largely resolved the debate over whether trademark owners should have dibs on their use by passing the Anticybersquatting Consumer Protection Act.¹⁹⁶

Though the disputes that generated *Brookfield* and its progeny are of fading importance, initial interest confusion remains highly relevant to the Internet. Other online practices are coming under legal attack. The initial interest cases have spurred litigation over the search engine practice of selling banner advertisements to be displayed in response to trademark-based searches.¹⁹⁷ The Ninth Circuit has already approved such litigation under *Brookfield's* logic.¹⁹⁸ If successful, these suits could stifle development of search engine technology by impeding access to advertising revenue.

Similarly, litigation is underway challenging the propriety of Internet "pop-up" ads that are keyed to visits to a competitor's web site. These challenges have produced mixed results to date.¹⁹⁹

Initial interest confusion cases involving the Internet are also important because of their effects beyond the online context. By carrying a flawed doctrine to its extreme, these precedents threaten to reach

they may purchase genuine branded goods from a reseller that does not hold itself out to be anything but an independent retailer unaffiliated with Bernina.").

192. See *Chatam Int'l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 559 (E.D. Pa. 2001).

193. See *supra* note 154.

194. See, e.g., Maynard, *supra* note 156, at 1343–44.

195. 4 MCCARTHY, *supra* note 15, § 25:69 (noting that by 2003, seventy-five percent of Internet searches used Google, which does not use metatags); Lastowka, *supra* note 103.

196. See *supra* note 154.

197. See Lastowka, *supra* note 103; G. Rita A. Abbati, *Metatags, Keywords, and Links: Recent Developments Addressing Trademark Threats in Cyberspace*, 40 SAN DIEGO L. REV. 341, 358–60 (2003).

198. See *Playboy Enters. v. Netscape Commun. Corp.*, 354 F.3d 1020 (9th Cir. 2004).

199. *Compare Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734 (E.D. Mich. 2003), with *1-800 Contacts, Inc. v. WhenU.com, Inc.*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

beyond metatags and back into the “real” world to complicate what were once easy cases. More broadly, the expansion of initial interest confusion may be viewed as a symptom of a larger trend: efforts by intellectual property holders to control any evocation of their protected marks.

1. *Brookfield’s* Brick and Mortar Legacy

Brookfield and its progeny did not revolutionize the initial interest confusion doctrine. For the most part, these cases applied the same standardless goodwill reasoning that had characterized the doctrine from its inception.²⁰⁰ What these cases provided was not new doctrine, but rather new examples of the doctrine’s strong form. The consequence may be more ambitious initial interest claims outside the Internet context. Having opened the door to initial interest claims that do not implicate consumer interests in one medium, courts have difficulty rejecting analogous claims in another.

Shell Trademark Management v. Canadian American Oil Co. presents an example of the *reductio ad absurdum* of an initial interest claim.²⁰¹ Defendant Canadian, a Shell franchisee, advertised and sold Shell gasoline at its gas station. Canadian also sold its own cheaper brand, called Touchless. Unsurprisingly, Canadian advertised both products and displayed a Touchless sign beneath a more prominent Shell sign. Relying on *Brookfield*, Shell sued, claiming initial interest confusion.²⁰² There was no similarity between the two gasoline brand names, and Canadian actually sold both products at its station. Anyone pulling to a pump selling Touchless gas had only to move a few feet to a Shell pump, if Shell gas was what he actually wanted.²⁰³

Little separates Canadian from a store that sells and advertises both Coke and Pepsi. Nonetheless, the court had difficulty explaining why *Brookfield* did not apply. Though consumers had no trouble moving to a Shell pump if they had been diverted to the Touchless brand, the court had to concede that “that minor inconvenience is somewhat like the Internet cases of diversion to the wrong web site, which may be only one click away from the intended destination.”²⁰⁴ Indeed, driving a car from one pump to another is likely more inconvenient than navigating web sites.²⁰⁵

200. See, e.g., *Brookfield Commun. v. W. Coast Entm’t*, 174 F.3d 1036, 1062 (9th Cir. 1999); *Promatek Indus. v. Equitrac Corp.*, 300 F.3d 808, 812–13 (7th Cir. 2002).

201. No. 02-01365 EDL, 2002 WL 32104586 (N.D. Cal. May 21, 2002).

202. *Id.* at *4.

203. *Id.*

204. *Id.*

205. Depending on one’s connection speed.

The court struggled to distinguish *Brookfield*. First, the court suggested that because Canadian sold both brands of gasoline, it was more like a web site that offered both a trademark owner's and a competitor's products.²⁰⁶ Of course, this is equally true of the results page generated by a search engine that produces both a trademark owner's site and the site of a third party that used the trademark in metatags. Second, the court mused that diversion could be a two-way street, that perhaps customers would sometimes be diverted to Shell pumps despite wanting Touchless gas.²⁰⁷ But a similar argument could have been made in *Brookfield*. One could claim that some consumers entering a trademark into a search engine were really performing a categorical search and did not want to see the site of the trademark owner.²⁰⁸ Third, the court noted that the initial interest cases cited by *Brookfield* concerned the use of similar marks.²⁰⁹ Shell claimed, however, that Canadian drew Touchless customers with the *Shell* mark.²¹⁰

The court ultimately conceded that these distinctions were not dispositive. It concluded that Shell had

raised a serious issue as to whether Defendant is in effect improperly trading on Shell's goodwill through the use of Shell's prominently displayed sign and trade dress in close proximity to Touchless gas . . . by confusing consumers about whether Touchless gas is affiliated with Shell, at least initially To do so is to run afoul of the two basic goals of trademark protection, especially the goal of protecting the seller's investment in goodwill.²¹¹

Shell nicely illustrates the dilemma facing courts that follow *Brookfield*. Although *Brookfield*'s reasoning was not novel, it applied initial interest confusion analysis to facts in which the confusion was so minor as to be negligible. Once that line was crossed, rejecting the same analysis outside the Internet context became that much more difficult.²¹²

206. *Shell*, 2002 WL 32104586, at *4.

207. *Id.*

208. *See supra* note 144.

209. *Shell*, 2002 WL 32104586, at *4.

210. *Id.*

211. *Id.* at *6. Shell also brought dilution claims, which the court also found serious. *Id.* *Shell* arose on the plaintiff's motion for a preliminary injunction. The court concluded that the balance of hardships did not justify Shell's requested remedy of an injunction against all sales of the Touchless brand. *Id.* at *7. The court was willing to issue an injunction of a lesser scope, but Shell rejected this option. *Id.* at *8.

212. Even the competing analogies to metatags as billboards could be characterized as causing initial interest confusion. *See, e.g.,* Lastowka, *supra* note 102, at 859–62 (likening search engines to a thrift store with large bins and metatags as requests to be placed in one or another bin). *See supra* note 157 and accompanying text.

By contrast, if the courts had applied the search cost rationale to initial interest confusion, no cause of action would have been possible in either *Brookfield* or *Shell*.²¹³

The same problem appears in trade dress cases. As argued above, claims of trade dress infringement are often analogous to those of initial interest confusion. Both situations involve potentially confusing similarities between products that are ultimately distinguishable by consumers. Similarly, both contexts bring the interests of producers and consumers into potential tension.²¹⁴ Courts often resolve these cases in the defendant's favor with reasoning that is consistent with the search cost rationale for initial interest confusion.²¹⁵

Such cases stand in sharp contrast to initial interest cases that reject the use of disclaimers to ameliorate any initial confusion.²¹⁶ Prior to *Brookfield*, some trade dress cases had already been influenced by initial interest precedents.²¹⁷ And post-*Brookfield* trade dress cases have referred to *Brookfield's* facts to apply a strong form of initial interest confusion to the brick and mortar world.²¹⁸ This development runs

213. Compare *Playboy Enters. v. Netscape Commun. Corp.*, 354 F.3d 1020, 1035 (9th Cir. 2004) (Berzon, J., concurring) (criticizing *Brookfield's* logic for being akin to finding infringement when one brand displays its wares near another's).

214. In the trade dress context, the risk exists that an attractive product design may not be freely copied because a court deems it to be a protected trade dress. See, e.g., *Esercizio v. Roberts*, 944 F.2d 1235, 1248 (6th Cir. 1991) (Kennedy, J., dissenting) (“[T]he majority opinion . . . protects the source of the goods, Ferrari, against plaintiff’s copying of its design even if the replication is accompanied by adequate labeling so as to prevent consumer confusion.”).

215. See *supra* notes 69-72 and 89-91 and accompanying text.

216. See *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000).

217. See, e.g., *Kompan A.S. v. Park Structures, Inc.*, 890 F. Supp. 1167, 1180 (N.D.N.Y. 1995). See also *Sara Lee Corp. v. Am. Leather Prods.*, No. 97 C 4158, 1998 WL 433764, at *17 (N.D. Ill. July 29, 1998) (noting infringing trade dress would likely cause initial interest confusion among consumers).

218. In *Adidas-Salomon AG v. Target Corp.*, 228 F. Supp. 2d 1192 (D. Or. 2002), a magistrate judge concluded that an athletic shoe’s four-stripe design could potentially infringe on Adidas’s three-stripe trade dress notwithstanding the fact that the junior user’s product was labeled with its own distinct trademark. The judge concluded that initial interest confusion was possible by citing *Brookfield's* discussion of Internet diversion.

In the same way, a consumer encountering defendants’ shoes at Target may be initially drawn to them because they appear to be adidas shoes from a distance. The shoes sit side-by-side in open boxes that are angled so that the customer primarily sees only the shoes, not the word “B.U.M.” on the tongue or the shoebox. This method of display may trade on adidas’ Three Stripe Mark to capture the initial attention of the consumer, which may constitute trademark infringement.

Id. at 1212 (citation omitted); see also *Gibson Guitar Corp. v. Paul Reed Smith Guitars, L.P.*, 311 F. Supp. 2d 690, 723–24 (M.D. Tenn. 2004) (finding infringement in guitar design in part because of initial interest confusion and citing *Brookfield*).

counter to the Supreme Court's recent signal that courts may be too welcoming of trade dress claims.²¹⁹

2. Initial Interest Confusion, Dilution, and the Right to Evoke

The development of initial interest confusion raises interesting parallels with the doctrine of trademark dilution. Both doctrines police the ability of a junior user to bring to mind the senior user's mark in a manner that does not cause confusion at the point of sale. And both doctrines have been employed in an increasingly aggressive manner by the courts. The United States Supreme Court, however, recently indicated that courts have gone too far with respect to dilution.²²⁰ Its opinion should give pause to courts that are enthusiastic about initial interest claims.

The Federal Trademark Dilution Act ("FTDA") provides a cause of action when a junior user's use of a trademark or name "causes dilution of the distinctive quality" of the senior user's mark.²²¹ Dilution and initial interest confusion are analogous in two respects. First, both doctrines protect trademark holders in situations in which traditional point-of-sale likelihood-of-confusion analysis is unlikely to give them a cause of action. Second, both doctrines rely on a more subtle understanding of the consumer mind than is implicated in a traditional point-of-sale confusion case. Rather than assessing whether consumers are likely to be confused when making a purchase, dilution is concerned with the associations consumers may make between two products employing similar marks. Likewise, initial interest confusion looks to consumer associations by expanding the universe of actionable confusion to include confusion that is dispelled before any purchase. As has been seen, this confusion may involve simply calling to mind the trademark owner's product.²²²

The lower courts had varied on the degree of association required to make a dilution case. In *Moseley v. V Secret Catalogue, Inc.*,²²³ the Supreme Court set the bar higher than had been the trend in some courts by holding that the FTDA requires proof of actual (as opposed to likely) dilution of the senior user's mark.

In the opinion on review, the Sixth Circuit concluded that though no one would expect a connection between an adult novelty store named

219. See *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000) (holding that product design is not inherently distinctive and may be protected as unregistered trade dress only if it acquires secondary meaning).

220. See *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418, 432 (2003).

221. 15 U.S.C. § 1125(c)(1).

222. See, e.g., *Foxworthy v. Custom Tees, Inc.*, 879 F. Supp. 1200 (N.D. Ga. 1995).

223. 537 U.S. at 432.

“Victor’s Little Secret” and “Victoria’s Secret” products, “consumers who hear the name “Victor’s Little Secret” are likely automatically to think of the more famous store and link it to the [novelty shop].”²²⁴ Again, this “automatic link” echoes the association that forms the basis of strong initial interest confusion.²²⁵

The Supreme Court, however, rejected this broad approach:

[A]t least where the marks at issue are not identical, the mere fact that consumers mentally associate the junior user’s mark with a famous mark is not sufficient to establish actionable dilution [S]uch mental association will not necessarily reduce the capacity of the famous mark to identify the goods of its owner.²²⁶

The Court noted that evocation is not dilution.²²⁷ In the initial interest context, however, some courts treat evocation as infringement.²²⁸ Recent developments in intellectual property law have been characterized as a sustained effort by intellectual property owners to obtain an “exclusive right to evoke” the protected subject.²²⁹ Trademark law has generally resisted this trend.²³⁰ But just as a low evidentiary standard for dilution would have represented a break in this tradition, so does the strong form of the initial interest confusion doctrine.

The Supreme Court’s holding in *Moseley* may be understood as reinforcing the traditional understanding that trademark does not confer an exclusive right to evoke and as striking a blow against the creeping expansion of trademark rights.²³¹ The expansive application of initial interest confusion presents the same evocation issue at play in cases involving broad application of the dilution doctrine. What then to make

224. *Id.* at 426–27 (quoting *V Secret Catalogue, Inc. v. Moseley*, 259 F.3d 464, 477 (6th Cir. 2001)).

225. *See supra* Part I.E.

226. *Moseley*, 537 U.S. at 432.

227. *Id.* (“[E]ven though Utah drivers may be reminded of the circus when they see a license plate referring to the ‘greatest snow on earth,’ it by no means follows that they will associate ‘the greatest show on earth’ with skiing or snow sports, or associate it less strongly or exclusively with the circus.”) (discussing *Ringling Bros.-Barnum & Bailey Combined Shows, Inc. v. Utah Div. of Travel Dev.*, 170 F.3d 449 (4th Cir. 1999)).

228. *See, e.g.*, *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257 (2d Cir. 1987).

229. *See* Stacey L. Dogan, *An Exclusive Right to Evoke*, 44 B.C. L. REV. 291 (2003); *cf.* Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999) (criticizing trend of treating trademarks as property).

230. *See* Dogan, *supra* note 229, at 309; *In re Ferrero*, 479 F.2d 1395, 1397 (C.C.P.A. 1973) (“The fact that one mark may bring another mark to mind does not in itself establish likelihood of confusion as to source.”); 3 MCCARTHY, *supra* note 15, § 23:9 (“‘Confusion’ means more than that the junior user’s mark merely ‘calls to mind’ the senior user’s mark”).

231. *See* Dogan, *supra* note 229, at 316. In a similar vein, *see* *Wal-Mart Stores, Inc. v. Samara Bros., Inc.*, 529 U.S. 205, 216 (2000) (holding that product design is not inherently distinctive and may be protected as unregistered trade dress only if it acquires secondary meaning).

of the holding that mere “mental processes” represent actionable confusion?²³² What then to make of holdings that the momentary (and perhaps hypothetical) confusion caused by metatags is actionable? Just as the Supreme Court called for actual evidence of dilution, the search cost rationale demands that initial interest confusion impose significant costs before permitting initial interest confusion’s application. If plaintiffs cannot meet this standard, their claims deserve to fall by the wayside.²³³

III. CONCLUSION

Considerable ink has been spilled on the question whether legal disputes involving the Internet require new rules, modified rules, or the same rules that govern the brick and mortar world.²³⁴ The translation process is often controversial. Sometimes judges who purport to apply existing doctrine to the Internet do so in a manner that arguably twists old doctrines into unrecognizable shapes.²³⁵

The initial interest confusion doctrine was overdue for some twisting. Its focus on the goodwill of trademark holders to the exclusion of consumer interests invited claims that set the interests of consumers against those of trademark holders. This article has argued that the better approach would be a doctrine that focuses on search costs. Such a doctrine would protect consumers while still placing a value on the purported misappropriation of a trademark holder’s goodwill.²³⁶

By staying their hand when the purported initial confusion was *de minimis*, many courts ameliorated the tension at the heart of initial interest confusion.²³⁷ But the popularization of the Internet as a marketing tool brought an increasing number of initial interest claims in its wake. The proliferation of claims involving *de minimis* initial confusion, particularly in the metatag context, gave the courts an opportunity to reexamine the doctrine. To do otherwise and mechanically apply goodwill analysis threatened to stifle a source of low-cost

232. See *supra* notes 94–99 and accompanying text.

233. The push to expand initial interest confusion may also be seen as part of a larger drive by trademark holders to obtain full property rights in their symbols. See, e.g., Jessica Litman, *Breakfast with Batman: The Public Interest in the Advertising Age*, 108 YALE L.J. 1717 (1999).

234. See, e.g., Tim Wu, *When Code Isn’t Law*, 89 VA. L. REV. 679, 681 nn.4–6 (2003).

235. See, e.g., *Intel Corp. v. Hamidi*, 71 P.3d 296 (2003) (reversing intermediate court’s decision that e-mails sent to Intel’s employees that were critical of the company constituted a trespass to chattels of the company’s e-mail system though system was not damaged or commandeered); see generally Dan L. Burke, *The Trouble with Trespass*, 4 J. SMALL & EMERGING BUS. L. 27 (2000) (discussing revisions to trespass law necessary if one is to apply it to Internet e-mail).

236. See *supra* Part I.C.

237. See *supra* Part I.D.

information for consumers and harm the free and open competition that trademark law is intended to protect. For the most part, unfortunately, courts did otherwise.²³⁸ The consequences threaten to produce increasingly unbalanced applications of an already flawed doctrine.²³⁹

It is a mistake to see this as a problem of technology, though many courts were certainly guilty of a facile understanding of how the Internet functions.²⁴⁰ In the end, however, the Internet did not create the doctrinal problem. Rather, cases involving the Internet made stark the problems at the core of pre-existing initial interest confusion law.

The difficulty is not wholly intractable. To a large extent, devices like fair use may temper the impact of initial interest confusion in cyberspace. Alternatively, a mix of legislative and technological fixes may help.²⁴¹ But these options would still leave a flawed doctrine largely intact. One hopes instead that courts will see that the imperfect results that come from applying initial interest confusion to Internet disputes are a symptom of a larger doctrinal problem. Perhaps this understanding will lead to recognition of the road not taken at initial interest confusion's birth and to the creation of a doctrine that harmonizes the interests of consumers and trademark holders.

238. See *supra* Parts II.B & II.C.

239. See *supra* Part II.E.

240. See *supra* notes 156–157.

241. See McCuaig, *supra* note 156.