



## The Nature and Functions of Meta-tags: Covert Infringement of Trademarks and Other Issues

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**ABSTRACT** *Meta-tags are one of the 'associational tools' considered essential to the operation of the World Wide Web. Their significance has been highlighted by recent controversies in the United States which focus on one of their important functions, i.e. as indices of websites which search engines read and rely upon in looking for the appropriate content relative to queries submitted to them. This article deals with the effect of meta-tags on the intellectual property rights of website owners. The author presents a critical survey of the American meta-tag cases and offers an Australian perspective.*

**Keywords:** meta-tags, trademarks, copyright, advertisement, search engines, damages.

### Introduction

We are living in an age where the most important commodity is information and access to it is the key to power and upward mobility. The most potent agent of social change is the Internet, which has its origins in the ARPANET, a US Department of Defense Project intended to provide uninterrupted computer communications during a major catastrophe.<sup>1</sup>

The virtual world provided by the Internet 'allows its users to obliterate, and declare obsolete, physical space and time. Business dealings can cut across the globe, in an instant, without paper, pen, or face to face contact'.<sup>2</sup> The development of the Hypertext Mark-Up Language (HTML) and the advancement of the World Wide Web's (Web) capacities in graphics and design have caused the upsurge in commercial transactions in the Internet.<sup>3</sup> The Internet is a very tolerant medium for advertising because there are practically no specifications or limitations on the form and amount of information that can be transmitted through it. Companies 'can also track the frequency and manner in which different consumers navigate through the information and thus gather data for future marketing efforts'.<sup>4</sup>

The relative ease by which one can surf the Net and obtain the information or even goods one needs, continue to be its chief lure. Controversies happen when famous or memorable marks are appropriated by entities, which have no legitimate right to use them, either in their domain names, websites or meta-tags embedded in their Web pages that search engines read.

Since meta-tags are invisible to the viewer's eyes, scepticism has been expressed over their effect on intellectual property rights. The author presents a critical survey of American cases dealing with meta-tags and examines the intellectual property issues they raise, in particular, trademark concerns. He thinks it is legally feasible to go after those

who illegitimately use the protected rights of others, be it in a word, phrase or description, based on the US cases. In anticipation of meta-tag controversies in Australia, he offers a perspective based on Australian law and jurisprudence and some recommendations that are crucial to the proper understanding of meta-tags in the scheme of cyber-commerce.

### **The Nature of Meta-tags**

Meta-tags can only be understood within the context of the HTML, the mother tongue of the Web. HTML was originally developed by Tim Berners Lee and popularized by the Mosaic browser.<sup>5</sup> Several versions of this language have been established to codify the practices of Web page authors, publishers and vendors. The latest of these is HTML 4.0 which further extends the language and provides 'mechanisms for style sheets, scripting, frames, embedding objects, improved support for right to left and mixed direction text, richer tables, and enhancements to forms, (and offers) improved accessibility for people with disabilities'.<sup>6</sup> Having just one language reduces the operational costs of content providers and avoids turning the Web into a 'proprietary world of incompatible formats, ultimately reducing the Web's commercial potential for all participants'.<sup>7</sup>

HTML has also provided the impetus for the creation of 'associational tools'<sup>8</sup> or 'tags', to make the task of information gathering an easy and fast one. These tools rely on the basic text coding technique provided by HTML which allows 'for embedding generic media objects and applications in documents and allows authors to specify a hierarchy of alternate renderings for user agents that don't support a specific rendering'.<sup>9</sup> Through these "tags", a Web browser is instructed where to implement new paragraphs, line breaks, bolded letters, and other display attributes which determine the way a document is presented to the viewer'.<sup>10</sup> These tools include hyperlinks which enable the viewer to jump from one website to another; 'framing' which 'provides a means for dividing a Website into separate windows, with optional scroll bars and borders, (e)ach window ... functions independently to display an individual Web page';<sup>11</sup> and meta-tags.

The New Oxford Dictionary of English defines the word 'meta' as 'denoting something of a higher or second order kind',<sup>12</sup> as in 'metaphysical' or 'metalanguage'. This fits quite well with the concept of a meta-tag. According to the HTML Library, meta-tags are '*used ... to embed any useful information not defined by other HTML elements*'.<sup>13</sup> The nature of these tags lies in the fact that they 'are used for control over the entire document rather than for formatting or otherwise modifying content'.<sup>14</sup> The owner of a website can determine how the site is indexed by the use of the meta-tag, depending on the search engine.<sup>15</sup>

Another general feature of the nature of meta-tags is that they are hidden from any mortal eye. They are machine readable and cannot be seen by the user unless the user views the document's source, which can be done by clicking on view/page source in Internet Explorer Version 4 or view/doc source in Navigator 3.0.<sup>16</sup> They can be considered a triumph of post-modernism simplicity due to the fact that the keywords operate as summaries of documents contained in the websites that the search engine has searched.<sup>17</sup>

### **Kinds of Meta-tags**

Meta-tags are generally of two kinds. They are HTTP-EQUIV and META tags with a NAME attribute.

### *HTTP-EQUIV Meta-tags*

These are similar to Hypertext Transfer Protocol (HTTP) headers. ‘When you click on a link for a page, the Web server receives your browser’s request via HTTP. Once the Web server has made sure that the page you’ve requested is indeed there, it generates an HTTP response. The initial data in that response is called the “HTTP header block”. The header tells the Web browser information which may be useful for displaying this particular document.’<sup>18</sup> In a similar fashion, META HTTP-EQUIV tags ‘direct the actions of Web browsers, and are used to further refine the information provided by the actual (HTTP) headers. HTTP-EQUIV tags are designed to affect the Web browser in the same manner as normal (HTTP) headers’.<sup>19</sup> An example of this is the ‘Expires’ meta-tag which ‘tells the browser the date and time when the document is considered “expired”. If a user is using Netscape Navigator, a request for the document whose time has “expired” will initiate a new network request for the document. An illegal Expires date such as “0” is interpreted by the browser as “immediately”’.<sup>20</sup> A sample format for this is `<META HTTP-EQUIV = “expires”CONTENT = “Mon, 29 February 2000 9:10:45 GMT” >`.<sup>21</sup>

### *META-TAGS with NAME*

These tags with NAME attributes ‘are used for META types which do not correspond to normal HTTP headers ... (but) some search engine agents (worms and robots) interpret tags which contain the keyword attribute whether they are declared as “name” or “http-equiv”’.<sup>22</sup>

## **The Contents of a Meta-Tag NAME**

While these meta-tags have different functions, the most controversial are those which consist of keywords or descriptions of websites which are embedded or ‘located within a specially designated portion of the HTML code which generates the Web page’.<sup>23</sup> They are inserted in the ‘head of the HTML document between the actual `<HEAD>` tags before the `BODY` tag’.<sup>24</sup> The importance of their placement in every framed page cannot be overemphasised since they are the trigger mechanisms for ‘hits’ on a particular website. These meta-tags are used in conducting information searches via search engines like Hotbot,<sup>25</sup> Infoseek,<sup>26</sup> Altavista,<sup>27</sup> Yahoo!,<sup>28</sup> and Magellan.<sup>29</sup>

They follow either of these syntax:

- (1) `<META name = “description”content = “a description of your page” >`<sup>30</sup>

The description can be anything that relates to the Web page. Search engines which recognise this tag will ‘display the text you specify here, rather than the first few lines of text from the actual document when the document shows up in a search result. You have about 1,000 characters for your description, but not all these will be used’.<sup>31</sup>

- (2) `<META name = “keywords”content = “a,list,of,key,words” >`<sup>32</sup>

The keywords allow search engines to easily index the Web page together with a description of the website. In order not to be guilty of ‘spamdexing’, the keywords must not be repeated over and over again in sequence. Otherwise, the website would not be recognised by the search engine, ‘as most search engines have refined their spiders to ignore such spam’.<sup>33</sup>

There are website designers who include both keywords and the description on the same page to make visitors really find their site.<sup>34</sup> Some also enclose the description in comment tags, for spiders that ignore meta-tags.<sup>35</sup>

### **The Functions of Meta-tags**

The Dictionary of HTML Meta-tags lists over 40 different kinds of meta-tags currently used for different purposes.<sup>36</sup> These include 'client pulling', which helps sites update their contents periodically and allows clients to find the new location of a Web page,<sup>37</sup> and labelling and rating online content according to standards developed by the World Wide Web Consortium (W3C).<sup>38</sup> Microsoft has another proposal for a 'dynamic HTML' which will increase the purposes of meta-tags.<sup>39</sup>

### **Invisible Indices**

As of now, the most controversial function of meta-tags lies in their being the invisible indices of a website's content, which is crucial in the navigation of the Web for information. The Internet user who has no knowledge of the specific domain name of a particular entity, whose website he or she wants to access, or has an interest in an area which may be relatively unknown, or has an unclear idea of the subject he or she wants to research on, would find meta-tags particularly useful.

Meta-tags operate in this manner. The user must utilise a search engine, say Yahoo. Then he or she must type the keywords or description of the chosen subject into the search bar of Yahoo. The search engine will read the typed words and search its database for matches. 'The results returned by search engine programs are a list of hyperlinks to related Web pages ... Each search engine ... use a specific kind of software, usually called a spider or crawler, to gather the addresses of Web pages available on the Internet. These programs, in turn, index text on the Web pages, thereby enabling the search engines to associate a user's keyword query with the indexed Web pages.'<sup>40</sup> Due to the meta-tag's intrinsic connection with the search engine, it has been considered as a "pre-hyperlink" since a hyperlink is often created by a search engine in a search results phase when a user performs a search using that keyword'.<sup>41</sup>

Without meta-tags, the 'coders for a particular search engine must either read, and manually enter the Web site content (rarely done now), or use an automated (or robot) system to scan a certain amount of text (usually the first 200 characters)'.<sup>42</sup> Scanning the text characters may prove to be unsatisfactory since the 'key concepts of a document may not appear in the first 200 words'.<sup>43</sup>

The relative facility in searching for needed information using meta-tags and search engines can be illustrated in this example. In looking for the meta-tag controversy surrounding Playboy Enterprises Inc. and one of its former playmates, one can type into the search bar of Yahoo the keywords 'playmate' and 'playboy'. Yahoo will return a list that displays 24 site matches.<sup>44</sup> By clicking on the hyper-linked sites or addresses pertaining to playmates, one discovers that the site of Terri Welles,<sup>45</sup> the 1981 Playmate of the Year, has the section on 'Playboy v. Playmate' which has a sub-section 'Playboy sues Playmate'. By clicking the mouse on the sub-section, one will be led to the website<sup>46</sup> maintained by Terri Welles which has a good listing of links that contain legal articles, documents and other sites pertaining to, or relevant to the meta-tags controversy.

## **The Advertising Nexus**

The commercial viability of a website is determined by the number of 'hits' it receives. This is similar to the Nielsen ratings for television advertising. The principle that underlies all Internet advertising is this: '(t)he greater the number of hits, the greater the number of people viewing the site and the greater the value in advertising on that site'.<sup>47</sup> Advertisers often pay the creators or maintainers of such sites per hit or per click on the advertisements posted on the sites.

There are two ways by which these hits are generated. The first and more expensive way is to come to an agreement with the owner of a famous site to post or link one's site with his. The second and cost-effective way is to embed each page of one's site with meta-tags that contain keywords or descriptions which are popular to Internet users. One writer advised that 'the most popular words used for searching on the Internet are chocolate and sex. So if you want to make your Web site popular you know what words to put in as key words'.<sup>48</sup>

According to one source, statistics show that only 21% of Web pages have keyword and descriptions for meta-tags,<sup>49</sup> but with the increasing awareness and technological savvy of website owners and designers, such figure will surely rise.

The few legal disputes that have arisen surrounding the area of meta-tags have been caused by the fact that there are no legal requirements and limitations on the content of these tags. Enterprising individuals have taken advantage of this reality to embed their meta-tags with words that consist of famous trademarks registered and owned by other entities. For example, two sites owned by travel agencies have meta-tags which are embedded with the words 'Disney', 'Mickey Mouse', and 'Magic Kingdom', although they have no connection at all with the Disney Corporation. So far, however, Disney has not brought a suit against these agencies.<sup>50</sup>

## **A Critical Survey of Meta-tag Controversies**

Currently, the most prominent jurisdiction where meta-tag disputes have reached the courtroom is the United States. A survey and critical analysis of these cases are presented here.

### **The First Meta-tags Case: Insituform Technologies, Inc. et al. v. National Enviro Tech Group, L.L.C. et al.**

The plaintiff's competitor, National Enviro Tech Group, L.L.C. had a website in which the words 'INSITUFORM' and 'INSITUPIPE' were embedded in the meta-tags. These words are registered trademarks of the plaintiff. Due to this fact, 'the databases maintained by various major search engine companies came to have an associative link between Insituform Technologies' trademarks and the defendant's website'.<sup>51</sup> Internet users who looked for the plaintiff's trademarks on search engines were given a list of links that included the defendant's websites. The plaintiff sued the defendant and moved for a preliminary injunction. The plaintiff argued that the defendant had transgressed the law of unfair competition and engaged in passing off. The defendant's conduct was seen to be 'analogous to their having altered a database maintained by the telephone company's Directory Assistance service; people calling "411" and requesting the number for "Insituform" would be given defendants' phone number instead'.<sup>52</sup>

When the parties agreed to a settlement, Judge Porteous of the US District Court of Louisiana granted a permanent injunction against the defendant using the plaintiff's

trademarks ‘in an associative and deceptive way that could result in persons who search on Internet search engines being directed by Internet search engines to the National Liner Website or to any other Internet website over which National Enviro Tech exercises control’.<sup>53</sup> The defendant was required to delete the trademarks from its meta-tags.

Although the judgement did not go into the merits of the arguments presented to the court since there was a settlement, the case is significant in two respects. One, it is the first case that reached the court which directly involved meta-tags,<sup>54</sup> and two, the judgement recognised the relevance of trademark law in this field of new technology.

### **The ‘High Profile’ Case of Oppedahl & Larson v. Advanced Concepts, et al.**

The plaintiff is a law firm that has gained a reputation in the area of intellectual property law. It has a website which provides information to the public regarding this area.<sup>55</sup> One of the firm’s partners, Carl Oppedahl, ran a search of the terms ‘Oppedahl’ and ‘Larson’ using the search engine ‘www.altavista.digital.com’. He found out that 11 URLs contained these terms and that they were located in the websites of ‘prowebsite.com’, ‘www.codeteam.com’, and ‘www.advanced concepts.com’.<sup>56</sup> The firm sued the defendants who owned these sites under the Federal and Colorado Common Laws of Unfair Competition, Federal Law of Dilution and the Colorado Law of Trademark Infringement. The chief arguments centred on the plaintiff’s allegations that the defendants’ use of its names in the meta-tag keywords of their websites without any permission nor connection with the plaintiff’s business constituted false advertising, false designation of origin, false representation and served to deprive the plaintiff of the benefit of the goodwill attached to the mark.<sup>57</sup>

Judge Weinshenk of the US District Court of Colorado issued similar orders, judgements and permanent injunctions against the defendants,<sup>58</sup> enjoining them from ever using the plaintiff’s mark on their meta-tags. There was no discussion about the plaintiff’s causes of action.

This was a well-publicised case which is important because it dealt with the issue of misleading meta-tags.<sup>59</sup> It demonstrated the value of checking search engines<sup>60</sup> for offending sites which misappropriate a mark or name that has acquired goodwill with respect to a particular business. It must also be noted that the defendants spamdexed the plaintiff’s mark by repeating the mark over and over again in the meta-tags. This is cause enough for search engines to ban the defendants’ pages.<sup>61</sup>

### **The Playboy Cases**

*Playboy Enterprises Inc. v. Calvin Designer Label et al.*

In this case, the plaintiff was able to get a permanent injunction against the defendants who used the domain names ‘playboyxxx.com’ and ‘playmatelive.com’; the names ‘Playmate Live Magazine’ and ‘Get it all here@Playboy’; and spamdexed the PLAYBOY trademark ‘in machine readable code ... so that the PLAYBOY trademark is accessible to individuals or Internet search engines which attempt to access Plaintiff under Plaintiff’s PLAYBOY registered trademark’.<sup>62</sup> Although no settlement was involved<sup>63</sup> the case demonstrated the crucial importance given by the court to protecting an established and famous trademark that is subject to dilution and infringement, be it in the form of domain names or meta-tags.

*The Monetary Value of Meta-tags: Playboy Enterprises Inc. v. Asia Focus & Internet Promotions*

Playboy Enterprises Inc. sued the defunct websites for placing 'Playboy' and 'Playmate' in their meta-tags and URLs. 'The sites were primarily designed as "clickthrough" sites, meant to capture traffic, then earn money by people clicking on banners to porn destinations.'<sup>64</sup> Playboy's chief argument is that the defendants' meta-tags dilute its trademarks. Its 'Cyber Club charges up to \$60 per year for access to original photos and real-time Playmate chats. The company's content is undoubtedly what is luring Net users to its site',<sup>65</sup> so the Virginia Federal Judge Thomas Jones assented to its claim and stated that the 'trademarks have acquired such goodwill and secondary meaning through national and international advertising and promotion that the public has come to associate the "Playmate" and "Playboy" trademarks exclusively'<sup>66</sup> with the company. Its importance lies in the fact that Playboy was awarded more than \$3 million,<sup>67</sup> which is the first ever monetary award in a case involving meta-tags. It demonstrated the pecuniary value of meta-tags and the willingness of the court to apply the law on damages where illegitimate usage of a protected trademark, through meta-tags, exists.

*The Fair Use of Meta-tags: Playboy Enterprises Inc. (PEI) v. Terri Welles*

Terri Welles was selected as the PEI's 1981 Playmate of the Year. She opened her own website and used, among others, the term 'Playmate of the Year' in her site's heading, the abbreviation of the term, i.e. 'PMOY' as a repeating watermark in the site's background, and the terms 'Playboy' and 'Playmate' were among the keywords embedded in the meta-tags. These terms are federally registered trademarks of the PEI, but the abbreviation 'PMOY', is not. PEI brought an action against Welles for several causes, which included trademark infringement and unfair competition both under Federal Law and under the California State law. PEI also sought a preliminary injunction against her, arguing that the defendant's use of the said terms was doing irreparable harm to it because 'websurfing consumers are likely to believe that defendant's website is authorized, sponsored or otherwise approved of by PEI, when it is not'.<sup>68</sup> The defendant countered that she fairly used the terms and the abbreviation 'PMOY' since her use is merely for identification and editorial purposes.

Judge Keep of the US District Court, Southern District of California upheld Welles' usage of the trademarks. In denying PEI's Motion for Preliminary Injunction, the court recognised the 'fair use' defence used by Welles, the essence of which 'forbids a trademark registrant to appropriate a descriptive term for his exclusive use and so prevent others from accurately describing a characteristic of their goods'.<sup>69</sup> Ms. Welles had not attempted to confuse websurfers of her site's relation to PEI. She had inserted disclaimers at the bottom of most of the Web pages, which clearly state that the site is not endorsed by PEI. Her site's font is not recognisable as a Playboy font and she did not use any of the terms for her domain name.

The court held that there was 'no infringement where defendant has used plaintiff's trademarks in good faith to index the content of her website. The meta tags are not visible to the websurfer although some search engines rely on these tags to help websurfers find certain websites. Much like the subject index of a card catalog, the meta tags give the websurfer using a search engine a clearer indication of the content of a website. The use of the term Playboy is not an infringement because it references not only her identity as a "Playboy Playmate of the Year 1981", but ... also ... the legitimate editorial uses of the term Playboy contained in the text of defendant's website. Plaintiff conceded, both in its papers and in oral argument, that defendant may properly use the

term Playboy in an editorial fashion (i.e. in reference to the Playboy Mansion). Therefore, the court finds that defendant has not infringed on plaintiff's trademarks by using them in her website meta tags'.<sup>70</sup>

### *The Welles' Counterclaim*

Terri Welles filed a Counterclaim against PEI on 4 January 1999 for defamation, interference with prospective business advantage, intentional infliction of severe emotional distress, unfair competition and declaratory relief for the legal right of Playmate titleholders, like herself, to index their websites through meta-tags which refer to their titles, that PEI claims as its trademarks.<sup>71</sup>

Both the complaint by PEI and Welles' counterclaim have not, up to the time of writing, been resolved. Judge Keep, in her decision, noted that this is not a standard trademark case which could lend itself to tests for determining 'likelihood of confusion', such as the factors recently enunciated in the Metro Pub case.<sup>72</sup> What is crucial in this case is the approbation by the court of the fair use defence to the trademark infringement, dilution and unfair competition claims of PEI. The recognition of the legitimacy of the use of a registered trademark by someone other than the registrant, through meta-tags, for indexing websites and for editorial purposes, is an excellent attempt by the court to come to terms with the realities of cyberspace, and still maintain time-honoured trademark precedents. This is shown by the rejection of the appeal lodged by PEI with the US Ninth Circuit Court of Appeals, concerning the denial of its motion for preliminary injunction against the defendant.<sup>73</sup> The denial of the appeal shows that PEI had not demonstrated 'either (1) a combination of probable success on the merits and the possibility of irreparable injury or (2) the existence of serious questions going to the merits and that the balance of hardships tips sharply in his favor'.<sup>74</sup> It is no wonder then, that PEI 'is now trying to amend its initial complaint and add new' ones.<sup>75</sup> The counterclaim is also important because it is the first action involving meta-tags, against a trademark owner for abuse of its rights.<sup>76</sup> Terri Welles had chronicled what she called PEI's campaign to wrongfully discredit her and her business when she refused to join PEI's Cyber Club and instead chose to come up with a competing website that, without wrongful intention, used PEI's trademarks. Her claim for declaratory relief over the use of meta-tags that include PEI's trademarks by her and those similarly situated, if ruled in her favour, would have significant repercussions on PEI's cyber business.

### **Protected Consumer Commentary: The Case of Bally Total Fitness Holding Corporation v. Andrew Faber**

The plaintiff is a health club that owns the federally registered trademarks 'Bally', 'Bally's Total Fitness', and 'Bally Total Fitness'. The defendant is a website designer who created a 'Bally sucks' site which utilised the name and mark of the plaintiff with the word 'sucks' printed across them. The site further states 'Bally Total Fitness Complaints! Unauthorized'.<sup>77</sup> The site also had a direct link to the defendant's 'Images of Men', which is a website that displays and sells pictures of nude males. The defendant embedded the plaintiff's marks in the meta-tags of his site. The plaintiff sued the defendant for trademark infringement, trademark dilution and unfair competition.

While District Judge Pregerson found that the plaintiff had valid protectable trademarks, which it spent over half a billion dollars to advertise, no infringement of its marks ever occurred because no likelihood of confusion could ever be created as to the source or origin of the defendant's site. No pretension of commercial connection between the



websites maintained by the parties could ever be made, since one is clearly critical of the other. Both parties are not engaged in the same trade and each of them has a distinct purpose in establishing their sites. The plaintiff's site is a commercial advertisement while the site created by the defendant is a consumer commentary. Moreover, the court held that the trademark dilution statute 'will not prohibit or threaten noncommercial expression, such as parody, satire, editorial and other forms of expression that are not a part of a commercial transaction'.<sup>78</sup> The defendant's airing of grievances against the plaintiff's services in the Internet is speech protected by the Constitution. His use of the plaintiff's marks in the meta-tags is therefore necessary for his expression to be known by users who want to be apprised of the opinions of others about the plaintiff. Finally, no tarnishment of the plaintiff's reputation could occur by the mere linking of the defendant's 'Bally sucks site', which in itself does not contain any pornographic matter, with pornographic sites. To hold otherwise would extend the scope of the dilution statute beyond its purpose and effectively restrict the flow of Internet information.

The court's recognition of protected expression via the Internet and the extension of such protection to the tools which make the expression accessible to others, are the crucial factors which make this case an important precedent for future controversies.

### **The Copyright Connection: The Case of Niton Corp. v. Radiation Monitoring Devices Inc.**

The plaintiff is in the business of manufacturing and selling x-ray fluorescence (XRF) instruments and software designed to detect the presence or absence of lead in paint. The defendant is also engaged in the manufacture of such instruments. The plaintiff filed a case against the defendant for false and misleading statements in the latter's advertising. In the course of the case, an employee of the plaintiff who was in charge of maintaining its website discovered, using the Netscape's View Source command, that the descriptions embedded in the meta-tags of the defendant's website were identical to the meta-tag descriptions used by the plaintiff. In fact, certain keywords, such as 'radon', which were relevant to the plaintiff's products but not to those of the defendant's, were also used in the latter's meta-tags. The result was that the defendant's website got more 'hits' than the plaintiff's. Due to this incident, the plaintiff filed an action for a preliminary injunction against the defendant. The US District Court of Massachusetts, through Judge Keeton, granted the relief prayed for with the proviso that the defendant could apply to the court for a modification of the order upon showing of good cause that an alternative relief would be more appropriate. The good judge stated that the plaintiff had shown likelihood of success in establishing its cause of action against the defendant and thus irreparable harm to it was presumed.

There was no discussion on the trademark issue regarding the meta-tag. This is probably due to the fact that as the court noted, '(t)his is a classic illustration of a new kind of litigation for which nothing in past experience comes even close to preparing trial judges and the advocates appearing before them. But the case must be decided, and quickly, unless mediation within or outside court sponsorship produces an even quicker solution'.<sup>79</sup>

This case brought another aspect into the controversy. Since the exact meta-tag keywords of the plaintiff were copied by the defendant in its own meta-tags to generate 'hits', might there be copyright infringement as well, apart from the trademark issue? This point was not raised in the case argued before the judge. This may signal some connection between these two branches of intellectual property, that not only judges but

all concerned with the protection of intellectual property rights should explore and investigate.

### **Contempt in Meta-tag Controversy: *Nettis Environmental Ltd v. IWI Inc.***

The plaintiff corporation 'provides engineering, sales and service in connection with in-plant ventilation problems'<sup>80</sup> while the defendant is a competitor of the plaintiff in the same business. The defendant used in its meta-tags the terms 'Nettis Environmental', 'Nettis', and 'DR Nettis' and managed to register its website containing such 'offending' terms with 380 search engines and websites. The plaintiff sought a preliminary injunction (PI) against the defendant to enjoin it from using, or remove the terms, from its meta-tags and site. The injunction was granted but the defendant failed to comply with the court order. The defendant relied on the advice of its computer consultant who stated that there was no need to de-register its website after he removed the offending terms. The consultant utterly relied on the search engines' automatic updating process. As it turned out, more than a month after the PI was granted, the plaintiff ascertained that at least six search engines still retrieved the defendant's website in response to queries for 'nettis' or 'nettis environmental'. The defendant only removed its website from the Internet when it was served with a Motion for Contempt.

The court held that the defendant did not meet the objective standard 'which asks whether the alleged contemnor has failed to take all reasonable steps within (its) power to comply with the court's order'.<sup>81</sup> The court recognised that removing the offending terms so that the connection between the parties could be severed, can be a daunting task because of the 'recent explosion of internet users, and the concomitant rise in search engines and websites', but such would not exonerate the defendant from contempt liability. Its sole reliance on the erroneous advice of its consultant was not sufficient. A reasonable person under the same circumstances would not only check if the search engines were updated but would also 'undo' the site's registration with the search engines. The court's ruling is clearly instructive as to the extent of the action that a defendant should take to avoid any liability for contempt in similar future cases.

### **The Case of Initial Interest Confusion: *Brookfield Communications Inc. v. West Coast Entertainment Corp.***<sup>82</sup>

The plaintiff is engaged in creating computer software and services for professionals in the entertainment industry as well as selling to the public software featuring a database that contains entertainment-industry related information which it markets under the mark 'MovieBuff'. It registered the mark to designate both its goods and services under the Principal Register in 1998. It tried to register the mark as its domain name (moviebuff.com) with Network Solutions Inc. (NSI) but it was informed that the defendant had already registered it first. So the plaintiff registered instead the domain names 'brookfieldcomm.com', 'moviebuffonline.com', and 'inhollywood.com'. It also began using its websites to sell its software. The defendant, a video rental store chain, had a federal registered trademark 'The Movie Buff's Movie Store', since 1991 but had used the same mark as early as 1986 in advertisements, promotions and letterhead in connection with retail services featuring videocassettes and video game cartridges. When the plaintiff learned of the defendant's plan to launch a website at 'moviebuff.com', which would contain a searchable entertainment database similar to its 'MovieBuff' software, the plaintiff sent a letter to the defendant warning the latter of a civil suit. When the defendant paid no heed, the plaintiff filed an action for trademark infringe-

ment under the Lanham Act and unfair competition against the defendant in the US District Court for the Central District of California and sought a temporary restraining order (TRO) against the defendant to enjoin the latter from using, among others, the mark 'MOVIEBUFF' ... in buried code or metatags on their home page or web pages ...<sup>83</sup> The TRO was denied by the district court upon its finding that the defendant was the senior user of the mark and that no likelihood of confusion was established. The plaintiff appealed this denial to the Ninth Circuit Court.

The Court, through Judge O' Scanlain, upheld the appeal. In resolving it, the court relied on established trademark precedents. It found the plaintiff as the prior user of the mark 'MovieBuff' which is quite distinct and cannot be considered part of or 'tacked' with the defendant's mark 'The Movie Buff's Movie Store', that was registered earlier. The defence of constructive use or 'tacking' is only recognised when 'the marks ... create the same, continuing commercial impression, and the later mark should not be materially different from or alter the character of the mark attempted to be tacked'.<sup>84</sup> The purpose of 'tacking' is to give the trademark owner the same rights in the new mark as he has in the old, to protect source identifying trademarks from appropriation by competitors and further the trademark law's objective of reducing costs that customers incur in shopping and making purchasing decisions.<sup>85</sup>

The next and more crucial issue is the likelihood of public confusion over the source or sponsorship of the defendant's website. Here, the court held that three factors are important in determining the issue in the Internet context. These are: (1) virtual identity of marks; (2) relatedness of the parties' goods; and (3) the simultaneous use of the Web as the marketing channel.<sup>86</sup>

In the first factor, the court considered the similarity of appearance, sound and meaning of the plaintiff's trademark 'MovieBuff', with 'moviebuff.com', the defendant's domain name. It did not compare the plaintiff's domain name 'moviebuffonline' with that of the defendant's because 'the Lanham Act requires that the allegedly infringing mark be compared with the claimant's trademark'.<sup>87</sup> Properly framed, 'MovieBuff' and 'moviebuff.com' are quite similar. The capitalisation of two letters and the addition of '.com' were held by the court to be inconsequential. The '.com' is irrelevant since it is a generic top-level domain name. The defendant's second-level domain name 'moviebuff' is essentially identical to 'MovieBuff'.

In determining the relation between the goods and services produced and proffered by the plaintiff and by the defendant, 'each company's prime directive is not relevant'.<sup>88</sup> The court found that both companies offer products and services relating to the entertainment industry and not only are they competitors, the competitive proximity of their products is actually quite high because both offer searchable databases which the public can access in the Internet.

The fact that both companies utilise the Web as a marketing and advertising tool is another factor that exacerbates public confusion. People who surf the Net for information on 'MovieBuff' may confuse it with the searchable database available at 'moviebuff.com' and simply assume that they have reached the plaintiff's website. Others may also believe that the defendant licensed 'MovieBuff' from the plaintiff or that the plaintiff sponsored the defendant's website or that both companies are related. But whatever the case is, it cannot be denied that the use of the second-level domain name by the defendant is a misappropriation of the goodwill in the mark established by the plaintiff.

As to the specific issue regarding meta-tags, the court held that by embedding the term 'moviebuff' into its meta-tags which are read by search engines, the defendant is still responsible for what the court has termed 'initial interest confusion', which is actionable

under the Lanham Act. It has been settled that the use of another's trademark in any 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'.<sup>89</sup> The diversion of consumer attention offers an opportunity for the defendant to make a sale or to interest somebody with its products or services, which would not have occurred if there was no attempt to associate the plaintiff's mark with the defendant's. The court made this analogy:

Using another's trademark in one's metatags is much like posting a sign with another's trademark in front of one's store. 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 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 Blockbuster would be misappropriating West Coast's acquired goodwill.<sup>90</sup>

The use by the defendant of appropriate descriptive terms in its meta-tags is by no means restricted by the court. However, such use must not infringe the plaintiff's trademark. 'MovieBuff' is not a descriptive word in the English language. When it is employed, the term is used to refer to the plaintiff's goods and services, but the court pointed out that 'Movie Buff' is a proper descriptive term which denotes a 'motion picture enthusiast'. This, the defendant can use in its meta-tags. Moreover, the defendant can still use the term 'MovieBuff' to refer to the plaintiff's product, in the context of say, comparative advertising. This is in line with the fair use of a trademark that the Terri Welles case has so pointedly made.

This decision has been hailed as showing a 'sophisticated understanding of the workings of the Internet',<sup>91</sup> and made 'clear that things that look and feel like unfair competition are unfair competition ... (without going) overboard because it recognized perfectly legitimate uses of trademarks'.<sup>92</sup>

Judging by the surveyed decisions on meta-tags, this is truly the first case where the complex issues surrounding trademark usage in meta-tags have been dealt with in a cogent and comprehensive manner. The fair-use strategy, which was recognised in the Terri Welles case as a valid defence against an action for trademark infringement, was affirmed here, thereby lending strength to the position of innocent users of registered trademarks.

The most important factor in this case, however, is the court's extension of the concept of 'initial interest confusion' which was heretofore used only in commercial 'real-time' transactions, to Internet activities, and with good reason. Consumers who surf the Net and have no opportunity to physically inspect the products they buy, often have to rely on the reliability of the trademark of the company selling those products. The trademark, be it in a domain name or embedded in a meta-tag, is the sole assurance of the customer that he is getting exactly what he paid for. In the virtual world, such assurance may be the only determinant of a company's survival.

## **An Australian Perspective**

In anticipation of future cases involving meta-tags in Australia, it is useful to examine the pertinent legal remedies that the owner of a trademark can pursue against the illegitimate users of such marks in meta-tags. The US cases are particularly instructive in this examination.

### *Copyright Infringement*

There has been a body of jurisprudence, particularly in the United Kingdom, which has denied copyright protection to the use of a word. In one case, the court emphatically stated that '(a)part from the law as to trade marks, no one can claim monopoly rights in the use of a word or a name'.<sup>93</sup> This is also true even if the word is invented.<sup>94</sup> The court gives paramount importance to an original literary work which is construed to be a written work that originates from an author<sup>95</sup> and affords to the viewer or reader information and instruction or literary enjoyment.<sup>96</sup> But there is reason to argue that a word or a short phrase can be given copyright protection if it succeeds in having a meaning in itself, and not just be meaningful via the juxtaposition of other words, or by being applied in a limited and particular context. Such appears to be the sole criterion for such a word or phrase to be copyrightable as enunciated by Mr Justice Graham in the *Exxon* case.<sup>97</sup>

Copyright protection can be feasibly pursued if the keywords and descriptions embedded in the meta-tags of a website owner which apparently possess some original, literary value but were actually the same or lifted from the embedded words in the meta-tags of another website. This is the situation which arose in the previously discussed *Niton* case. It must be emphasised that copyright exists to protect the form or manner of expression of ideas. This is the thrust of the 1968 Australian Copyright Act, as amended. Thus, the substantial or actual copying of the whole descriptions and keywords embedded in meta-tags which could amount to an original literary expression of the website owner, constitute copyright infringement in the most basic sense.

### *Passing Off*

The common law action of passing-off, as it has evolved in its current state, requires the concurrence of these elements which Lord Diplock succinctly stated in the '*Advocaat*' case: '(1) a misrepresentation (2) made by a trader in the course of trade, (3) to prospective customers of his or ultimate consumers of goods or services supplied by him, (4) which is calculated to injure the business or goodwill of another trader (in the sense that this is a reasonably foreseeable consequence) and (5) which causes actual damage to a business or goodwill of the trader by whom the action is brought or (in a *quia timet* action) will probably do so'.<sup>98</sup>

The requirement of actuality or probability of damage is clearly illustrated by the *Cadbury Schweppes Pty Ltd v. The Pub Squash Co. Ltd* case.<sup>99</sup> Here, the plaintiff bottled a lemon squash drink in cans which it called 'Solo' and advertised to appeal to masculine and rugged individuals as well as to evoke nostalgia by advertizing to the 'great old squash like the pubs used to make' in the drink's slogan. The cans were coloured predominantly in yellow, with tinges of green and had a medallion-type label. 'Solo' was a success. The defendant came up with a lemon squash drink of its own which it termed 'Pub Squash'. The drink was also bottled in yellow-green cans with a medallion-like label and was advertised using themes of nostalgia and masculine activities. The Privy Council

accepted the factual findings of Mr Justice Powell, who concluded that there was no passing off. He stated that:

There is no doubt that if the two cans (or two bottles) are placed side by side, it can readily be seen that they are different. This, however, is not necessarily enough, for one must take into account the nature of the market-place and the habits of ordinary purchasers ... As I have pointed out earlier, it is not uncommon, albeit that it is not the universal practice, both in supermarkets, and in mixed businesses ... which have self-selection display refrigerators for products such as 'Solo' and 'Pub Squash' to be displayed alongside ... (or) in close proximity to each other. Further, as I have pointed out, the purchase of a soft drink is often a casual transaction ... when accepting, as I do, that by reason of the nature of the market-place and of the habits of purchasers, mistakes are likely to, and do, in fact, occur, the evidence would seem to demonstrate that in most, although not all, cases in which there has initially been a wrong selection by a customer, or the wrong product has been offered by the shopkeeper, the error has been recognised before the purchase has been completed. This being so, it seems to me that the defendant has sufficiently differentiated its product from that of the plaintiffs' ... It follows, in the light of all that I have written, that, in my view, the plaintiffs have failed to make out a case of passing off.<sup>100</sup>

This kind of reasoning does not recognise the potential damage that occurs when the consumer is initially confused about his choice. Granted that many errors in decision were rectified prior to the completion of the sale, what about those instances when the contrary occurred, e.g. when the consumer is either lazy or ashamed to change the product or is in a hurry to go somewhere such that the mistake was not noticed until it was too late. Consumer mistakes in choosing products are a daily occurrence in the physical world; more so in cyber-commerce, when the consumer is not presented with the actual tangible product itself. For this reason, I think it is prudent for Australian courts to consider the doctrine of 'initial interest confusion' enunciated in the Brookfield case which was discussed above.

The use of keywords or descriptions embedded in meta-tags, which appropriate or utilise the trademark or trade designation of another, effectively diverts consumer interest from the products and services of the rightful owner of the mark, offered in the Internet. As has been shown in the Niton case, the owners of the website which copied the meta-tag keywords of the competitor got more 'hits' than their rival. Even if the interest was just 'initial' and even if the Internet consumer realised that the site he chose was not the right one and no sale transaction took place, damage was already caused since a 'hit' was taken away from the rightful owner of the website that should have been accessed, were it not for the wrongful use of the meta-tag keywords that the search engines rely upon in directing Internet consumers to the sites they want.

### *Trademarks Infringement*

In contrast with copyright law, trademarks law lends itself easily as a shield to protect a word or phrase that has come to mean and distinguish the particular goods or services proffered by a trader. A trademark is defined under the 1995 Australian Trademarks Act as a 'sign used, or intended to be used, to distinguish goods or services dealt with or provided in the course of trade by a person from goods or services so dealt with or provided by any other person'.<sup>101</sup> Although trademarks have served different functions like a warranty of quality and protection of goodwill, it is the origin or source function

which has been 'given legal protection under trademark law proper'.<sup>102</sup> As recently held in one case, '(t)he same "badge of origin" notion is plainly to be seen in the definition of "trademark" in s 17 of the 1995 Act'.<sup>103</sup>

In the present context, when a word or phrases which constitute protected trademarks are embedded in the meta-tags of a website, the owner of which has no relation or connection with the owner of the trademarks, the latter would have a valid cause of action for infringement against the site owner. The Internet user who types in the trademark word or phrase in the search query of the search engine may not see the meta-tag, but reasonably expects that the sites to which he or she will be directed to correspond or are related to the site of the trademark owner. Even if the site owner does not use the trademarks in the offending website itself, there is a great possibility that the user may be confused as to the origin or source of the site that he or she has accessed. The highway billboard analogy made by the Brookfield court is quite appropriate, especially if the products or services offered by the site owner are similar or the same as those of the trademark owner.

### *Violation of Trade Practices Act*

The most pertinent provisions contained in this Act relative to meta-tag controversies are the prohibitions against engaging in conduct that is misleading or is likely to mislead or deceive by corporations or entities involved in trade and commerce (s 52.1), the false representations of these entities that they enjoy sponsorship, approval or affiliation with other entities (s 53,d), or that their goods or services have sponsorship or approval, which they do not actually have (s 53,c).

To establish a breach under s 52 of the Act, it is sufficient that 'as a result of a misrepresentation, the consumer is misled into thinking, contrary to the fact, that there is some connection between the two businesses'.<sup>104</sup> This section, due to its extensive application 'has subsumed much of the areas of law covered by passing off and misrepresentation, both of the contractual and tortious variety, and has impinged on almost every form of commercial activity, from the sale of a business to advertising'.<sup>105</sup> It may very well provide a very potent cause of action against the wrongful use or appropriation of keywords or phrases embedded in meta-tags, which may constitute protected trademarks or protection by copyright. Internet users who are led to the wrong sites by search engines which rely on meta-tags that contain these keywords or phrases, may be deceived into thinking that the sites are related to the company or trader that they are looking for.

But I think that not all usage of protected words or phrases is actionable. The law and jurisprudence allow comparative advertising, which is fair and reasonable and based on true and accurate facts.<sup>106</sup> So a website owner who is a rival of another may validly embed the latter's trademarks in the meta-tags for his site and even place therein, his competitor's trademarks for the purpose of comparing the values and virtues of his goods or services against those manufactured by his rival. The courts would also allow the use of clear, unambiguous and prominent disclaimers<sup>107</sup> which prevent the pertinent conduct from being construed as deceptive or misleading. Website owners can avail of this device to protect themselves from claims of trademark infringement or violation of the Trade Practices Act.

The editorial usage of protected trademarks, as happened in the Welles case, could be permitted since a fair statement is one that conveys *solely the factual truth and nothing else*. It has been held that '(b)efore a statement can be said to be misleading or deceptive or falsely to represent a fact, it must convey a meaning inconsistent with the truth. A

statement which conveys no meaning but the truth cannot mislead or deceive or falsely represent; although a statement which is literally true may nevertheless convey another meaning which is untrue, and be proscribed accordingly'.<sup>108</sup>

Website commentaries and criticisms, such as what transpired in the Bally case, can be accommodated under current Australian jurisprudence. For example, in the recent Tobacco Institute case, the public interviews given by the defendant regarding the Full Court of the Federal Court's decision on 'passive smoking' were not considered to be done in trade or commerce, even if the statements he made were intended to reduce the business of the Tobacco Institute, because the defendant made those statements as executive director of the Action on Smoking and Health Ltd, a public company which is engaged in public affairs and information campaigns that try to educate the citizenry about the implications of tobacco usage. The court, through Mr Justice Bryson, held that '(d)enigratory material from a rival trader and denigratory material from a person wholly outside the relevant industry appear to me to stand in entirely different situations for the relation between such conduct and trade or commerce'.<sup>109</sup> Dissatisfied consumers or persons who create 'grievance' sites containing the protected marks of commercial traders and embedded in the meta-tags, can invoke this precedent to protect the expression of their opinions, so long as they are not competitors of such traders and the creation of such sites does not constitute 'conduct which is itself an aspect or element of transactions which, of their nature, bear a trading or commercial character'.<sup>110</sup>

## Conclusion

One writer has argued that 'the idea that keywords alone can create a false belief of connection, and can thus open up a claim for trademark dilution or unfair competition is arguable. The claim that it is misleading may be hard to sustain given that the casual surfer never even sees the offending words'.<sup>111</sup> This case survey has shown that it is possible and feasible to prove trademark infringement in meta-tags even if the Internet user does not see the embedded words. One need not be an assiduous Web master like Carl Oppedahl or a conscientious site maintainer like Niton's employee to protect the embedded trademarks. One only has to know the relatively simple technique for revealing the hidden words and take it from there.

It is the common perception that technological development outpaces the law and judicial interpretation. More often than not, the courts have tried to apply ancient doctrines to cover contemporary situations. While this may be the path of least resistance, it may, at least in the context of the US controversies, particularly the Welles and Brookfield cases, lead to the path of sagacious assistance. By no means have these cases settled the trademark issues surrounding meta-tags since the rulings mentioned are not on the main actions themselves. The Order issued in the Welles case is the denial of PEI's Motion for Preliminary Injunction against Welles and the decision in the Brookfield case is a resolution of the appeal lodged by the plaintiff against the District Court's denial of its application for a temporary restraining order. Nonetheless, the principles enunciated by the American courts provide instructive and persuasive guidelines for future decisions on meta-tags, not only in the United States but for other jurisdictions as well, including Australia.

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103. *Top Heavy Pty Ltd v Killin* (1996) 34 IPR 282 at 286.
104. *Chase Manhattan Overseas Corp & Or v Chase Corp Ltd & Anor* (1986) 70 ALR 303 at 320.
105. V. Nagarajan & D. Meltz, *Butterworths Questions and Answers: Trade Practices Law*, Butterworths, Australia, 1999, p. 103.
106. See *Makita (Australia) Pty Ltd v Black & Decker (Australasia) Pty Ltd* (1990) ATPR 41–030 at 51,467; *State Government Insurance Commission v JM Insurance Pty Ltd* (1984) ATPR 40–465 at 45,359; and *Stuart Alexander & Co (Interstate) Pty Ltd v Blenders Pty Ltd* (1981) 37 ALR 161.
107. See *Sony Music Australia Ltd v Tansing* (1993) ATPR 41–279 at 41,742 and *INXS v South Sea Bubble* (1986) ATPR 40–667 at 47,369.
108. *World Series Cricket Pty Ltd v Parish* (1977) 16 ALR 181 at 201 citing *US v 95 Barrels etc of Vinegar* 265 US 438 at 442.
109. *Tobacco Institute of Australia v Woodward* (1993) 32 NSWLR 559 at 572.
110. *Fasold v Roberts* (1997) 70 FCR 489 at 528.
111. T. Jackson, 'The case of the invisible ink', *Financial Times*, 22 September 1997, see <<http://econ.law.harvard.edu/property/metatags/meta6.html>> last visited 27 October 1999.