

## BROOKFIELD COMMUNICATIONS, INC. v. WEST COAST ENTERTAINMENT CORP.

By Shannon N. King

New technologies require novel analysis of existing legal doctrines in order to accommodate those new technologies in a manner consistent with established principles.<sup>1</sup> The increasing accessibility of the Internet has caused new concerns in the area of trademark law and corresponding problems in the application of trademark doctrine such as the federal anti-dilution statute<sup>2</sup> and trademark infringement analysis in the context of domain names.<sup>3</sup> In *Brookfield Communications, Inc. v. West Coast Entertainment Corporation*,<sup>4</sup> the Ninth Circuit Court of Appeals declared the use of another's trademark in website metatags to be actionable infringement under the Lanham Act.<sup>5</sup> While appealing to established notions of fairness, this ruling employs an unusual confusion analysis that does not

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1. See generally Marguerite S. Dougherty, *The Lanham Act: Keeping Pace With Technology*, 7 J.L. & POL'Y 455 (1999) (positing that utilizing a physical contacts analysis of personal jurisdiction in trademark Internet controversies is not appropriate because the application is uneven and therefore defeats the purpose of a uniform national policy like the Lanham Act); Thomas A. Magnani, Note, *The Patentability of Human-Animal Chimeras*, 14 BERKELEY TECH. L.J. 443 (1999) (suggesting that existing patent laws cannot deal with the moral issues raised by the fast-changing biotechnology field and concluding that biotechnology should be regulated by Congress directly rather than via alteration of patent laws by the courts).

2. See generally *Avery Dennison Corp. v. Sumpton*, 189 F.3d 868 (9th Cir. 1999) (reversing district court's summary judgment finding as to issue of dilution under the Federal Trademark Dilution Act). Recent articles discussing dilution include: Jennifer Golinveaux, *What's in a Domain Name: Is "Cybersquatting" Dilution?*, 33 U.S.F. L. REV. 641 (1999); Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687 (1999); Edward E. Vassallo & Maryanne Dickey, *Protection in the United States for "Famous Marks": The Federal Trademark Dilution Act Revisited*, 9 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 503 (1999).

3. See generally *Intermatic Inc. v. Toeppen*, 947 F. Supp. 1227 (N.D. Ill. 1996) (finding a genuine issue of material fact as to whether use of another's trademark in a domain name created likelihood of confusion, and entering summary judgment for mark owner when finding that such use constitutes dilution). Recent domain name articles include: Carl Oppedahl, *How Is a Domain Name Like a Cow?*, 15 J. MARSHALL J. COMPUTER & INFO. L. 437 (1997); Ira S. Nathenson, *Showdown at the Domain Name Corral: Property Rights and Personal Jurisdiction Over Squatters, Poachers, and Other Parasites*, 58 U. PITT. L. REV. 911 (1997).

4. 174 F.3d 1036 (9th Cir. 1999).

5. See *id.* at 1065.

take into account the unique expectations of Internet consumers. As a result, the court finds actionable consumer confusion where there is none.

This Note discusses *Brookfield* in the context both of prior cases involving metatag use and prior cases recognizing initial interest confusion as actionable under the Lanham Act.<sup>6</sup> The Ninth Circuit is the first court to reach a confusion analysis of metatag use; other cases are instructive, however, in determining the harm, if any, caused by using another's trademark in a website metatag. This Note asserts that courts should not apply trademark law to metatag cases because the use of another's trademark in a metatag does not create consumer confusion of the type protected by trademark doctrine, and inconsistent application of trademark doctrine promotes litigation, increases business costs, and taxes judicial resources.<sup>7</sup>

## I. BACKGROUND

### A. Technical Background

#### 1. Metatags

Web page source code is written in a scripting language called hypertext markup language ("HTML"), which a computer user's web browser software reads and interprets in order to create the web pages that collectively are known as websites. Metatags are identifiers provided for in HTML and included in a web page's source code, primarily to communicate information about a site's contents. As scripting code, the metatag itself is invisible to the average unsophisticated user.<sup>8</sup> Metatags can be used to include various kinds of information in a web page, but the two types implicated in a trademark context are those utilized by some search

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6. 15 U.S.C. §§ 1051-1127 (1994).

7. For a brief discussion of the interests that trademark law must balance while fostering commercial functions, see DONALD S. CHISUM & MICHAEL A. JACOBS, UNDERSTANDING INTELLECTUAL PROPERTY LAW § 5A (1992). The four interests identified by the authors are (1) consumer interest in not being confused about the origin of goods or services; (2) trademark owner interest in preserving goodwill; (3) consumer and potential competitor interest in free competition and entering into expanding markets for goods and services; and (4) public interest in a fair and efficient legal system comprising specific and consistently applied trademark doctrines. *Id.* at 5-8.

8. Note that a sophisticated user can utilize one of several techniques to read the source code behind a web page, and thus can read the site's metatags. The easiest method is to use the web browser's built-in menu function for browsing source code (View|Source with Internet Explorer, View|Page Source with Netscape Navigator).

engines to index and rank websites—the “keyword” and “description” tags.<sup>9</sup>

The “keyword” metatag specifies a list of terms which search engines will then associate with the particular page or site.<sup>10</sup> It is commonplace for developers to include both generic and specific terms in “keyword” metatags in order to capture the attention of every possible interested user. The “description” metatag usually contains a summary of a page or site’s contents. Some search engines include the entire description when the site is returned as a result; other engines just use the terms in the description to index the site, in much the same manner as the “keyword” metatags are used.

## 2. *Search engines*

Search engines provide a central point from which to gather large amounts of disparate information. Typical Web-based search engines are comprised of multiple software packages, including a spider, an index, and index-searching software.<sup>11</sup> The spider is a piece of software that “travels” the World Wide Web, cataloging the full text of websites.<sup>12</sup> The spider scans documents and adds them to the index by following links.<sup>13</sup> The index is a searchable catalog of documents, containing the information collected by the spider. The index-searching software performs searches on the index contents in response to user requests.

Different search engines treat metatags differently. Typically, an engine sends out a spider, which collects metatags in addition to visible web

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9. For example, the description metatag from the home page of the website for Boalt Hall School of Law at the University of California at Berkeley reads, “(meta name=“description” content=“Boalt Hall School of Law Home Page”)”. The keyword metatag for the same page reads, “(meta name=“keywords” content=“boalt, boalt hall, school of law, boalt hall school of law, law school, university of california, berkeley, uc berkeley, ucb, uc, cal, law”)”. See Boalt Hall School of Law, *Boalt Hall School of Law Home Page* (visited Oct. 4, 1999) (<http://www.law.berkeley.edu>).

10. See Maureen A. O’Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability For Metatagging*, 33 GONZ. L. REV. 277, 281 (1997).

11. See SearchEngineWatch.com, *Search Engine Glossary*, (visited Jan. 31, 2000) (<http://searchenginewatch.com/facts/glossary.html>) (noting that although the terms “spider” and “index” may be used as synonyms for “search engine,” they are in fact separate components which comprise the search engine).

12. This Note draws a distinction between metatags (and other HTML constructs) and web page text on the basis of visibility. Therefore, a spider that collects all the information about a particular site collects both metatags (not visible in the default browser view) and web page text (visible via the browser).

13. See SearchEngineWatch.com, *Search Engine Glossary*, (visited Jan. 31, 2000) (<http://searchenginewatch.com/facts/glossary.html>).

page text. The contents of the “keyword” metatag may be used to index the site in a specific category.<sup>14</sup> Once those pages are indexed and available for user search requests, the search engine may also use a ranking algorithm in conjunction with the metatags to rank the relevance of the website to the particular user-requested search.

## **B. Trademark Law**

### *1. The purpose and function of trademark law*

United States trademark law is codified in the Lanham Act of 1946, enacted in 1947, and amended several times since, with the last major revision in 1988.<sup>15</sup> The essence of trademark law is the prevention of confusion as to the origin or sponsorship of goods or services,<sup>16</sup> and it establishes exclusive rights to use marks that distinguish one manufacturer, merchant or service provider’s goods or services from those of others.<sup>17</sup> A trademark owner may prevent others from using the same or similar marks that create a likelihood of confusion, mistake, or deception.<sup>18</sup>

Trademarks serve several commercial functions: (1) they identify the goods or services to consumers; (2) they identify the source of the goods or services and may serve as an indication of their quality; and (3) they are advertising devices, used to develop consumer association and good will toward the product being advertised.<sup>19</sup> The service of these commercial functions requires the balancing of consumer, trademark owner, and potential competitors’ interests.<sup>20</sup>

### *2. Infringement and likelihood of confusion*

Trademark infringement is the unauthorized use of a mark that so resembles another person’s valid trademark or service mark as to create a likelihood of confusion. The Lanham Act gives registrants of federally registered marks a civil right of action against any person who uses, without the registrant’s consent, a “reproduction, counterfeit, copy, or color-

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14. For instance, the Boalt Hall School of Law Home Page may be placed in the “law school” category because the term “law school” is in the keyword metatag. Note that it may also be categorized under “Berkeley,” although the law school is not technically affiliated with the City of Berkeley. Such indexing benefits the user who seeks information about schools in Berkeley and simply searches under the city name.

15. See 15 U.S.C. §§ 1051-1127 (1994).

16. See CHISUM & JACOBS, *supra* note 7 at 5-8.

17. See *id.* at 5-7.

18. See *id.* at 5-8.

19. See *id.*

20. See *id.*

able imitation" of the mark to (a) sell, offer for sale, distribute, or advertise "any goods or services on or in connection with which such use is likely to cause confusion," or (b) reproduce the mark and apply it to "labels, signs, prints, packages, wrappers, receptacles or advertisements" intended for such sale, distribution, or advertising.<sup>21</sup> Trademark infringement remedies include injunctions, damages, infringer profits, and other relief.<sup>22</sup>

Likelihood of confusion for purposes of infringement is determined via evaluation of a fluid list of factors. The 1938 Restatement of Torts set forth four factors for determining likelihood of confusion,<sup>23</sup> and those factors have been expanded and refined by the various circuits, creating similar tests that vary as to wording and number of factors.<sup>24</sup> While some circuits treat likelihood of confusion as an issue of law and therefore freely reviewable on appeal, the Ninth Circuit has indicated that likelihood of confusion is a mixed question of law and fact and that a district court's determination of that question is reviewable on appeal under the clearly erroneous standard.<sup>25</sup>

At one time, trademark law only gave a right of action against likelihood of confusion by the purchaser as to source of goods. Today, "the test for likelihood of confusion . . . is broader, embracing confusion as to the association between the goods or sponsorship of the allegedly infringing goods."<sup>26</sup>

### 3. *Prior metatag disputes*

Some federal courts have enjoined use of a trademark in metatags when the trademark was also allegedly being infringed via an Internet do-

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21. 15 U.S.C. § 1114(1) (1999).

22. *See* 15 U.S.C. § 1116(a), 1117 (1999).

23. *See* RESTATEMENT OF TORTS § 738 (1938). The factors are:

(a) the degree of similarity between the designation and the trade-mark or trade name in

(i) appearance;

(ii) pronunciation of the words used;

(iii) verbal translation of the pictures or designs involved;

(iv) suggestion;

(b) the intent of the actor in adopting the designation;

(c) the relation in use and manner of marketing between the goods or services marketed by the actor and those marketed by the other;

(d) the degree of care likely to be exercised by purchasers.

*Id.*

24. *See infra* note 88 for the Ninth Circuit confusion factors.

25. *See* *Levi Strauss & Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1355-56 (9th Cir. 1985).

26. *Lindy Pen Co., Inc. v. Bic Pen Corp.*, 725 F.2d 1240 (9th Cir. 1984).

main name or actual website content.<sup>27</sup> While other courts have enjoined use upon a finding of wrongful intent, one court has allowed trademark use in metatags upon a finding that it constituted a fair use.<sup>28</sup> The *Brookfield* court discussed three decisions dealing with the metatag issue,<sup>29</sup> but no prior metatag case has utilized (or reached) an initial interest confusion analysis.

The first trademark complaints related to metatag use appeared in mid-1997.<sup>30</sup> *Insituform Technology, Inc. v. National Envirotech Group*<sup>31</sup> involved the use of the trademarks "Insituform" and "Insitupipe" both in metatags and in website images and text taken from plaintiff's marketing materials.<sup>32</sup> The case settled, with the defendant agreeing to remove the use of the trademarks from the metatags on its website.<sup>33</sup> *Oppedahl & Larson v. Advanced Concepts*<sup>34</sup> has been the only case thus far to revolve solely around metatag use, without also dealing with other complications such as direct code copying, allegedly infringing site content, other buried code,<sup>35</sup> or a domain name. The common law marks "Oppedahl" and "Larson," claimed by the New York intellectual property firm of Oppedahl & Larson, were used in the metatags of various sites having no connection to the practice of law.<sup>36</sup> The parties settled when the defendants agreed to a permanent injunction barring the use of the marks in their website metatags.<sup>37</sup>

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27. See *infra* note 38 and accompanying text.

28. See *infra* notes 43-50 and accompanying text.

29. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1064-65 (9th Cir. 1999).

30. See generally, Wendy R. Leibowitz, *Firm Sues For Invisible Use of Its Trademark on 'Net*, NAT'L L.J., Sept. 8, 1997, at A7 (describing the district court complaint filed by Oppedahl & Larson); Robert Baron, *Metatags Raise Serious Legal Issues*, N.Y.L.J., Sept. 14, 1998, at S4 (reporting on several early metatag controversies).

31. Civ. Action No. 97-2064, P 2 (E.D. La. filed July 1, 1997) (final consent judgment entered Aug. 26, 1997).

32. See Jeffery J. Look, *The Virtual Wild, Wild West (WWW): Intellectual Property Issues In Cyberspace—Trademarks, Service Marks, Copyrights, and Domain Names*, 22 U. ARK. LITTLE ROCK L. REV. 49, 81 (1999).

33. See Meeka Jun, *Meta Tags: The Case of the Invisible Infringer*, N.Y.L.J. Oct. 24, 1997, at 5.

34. Civ. Action No. 97-Z-1592 (D. Colo. filed July 23, 1997).

35. Buried code is technically similar to metatags in that it is invisible to the user and can possibly boost a website's search engine ranking. It usually consists of a word (the trademarked term) repeated multiple times on a page background that is the same color as the text, rendering the word invisible to users but visible to search engines.

36. See Barbara Anna McCoy, *An Invisible Mark: A Meta-tag Controversy*, 2 J. SMALL & EMERGING BUS. L. 377, 385-86 (1998).

37. See *id.*

Courts have been quickest to enjoin metatag use when viewed in conjunction with other allegedly infringing uses such as a domain name or site content. Playboy Enterprises, in particular, has been vigilant about filing such suits in an effort to disassociate itself from websites that use the Playboy marks in their metatags but feature hard-core pornography.<sup>38</sup> In *Playboy Enterprises, Inc. v. Calvin Designer Label*,<sup>39</sup> Playboy asserted federal trademark infringement based on defendant's use of domain names and buried code utilizing Playboy's trademarks "playboy" and "play-girl."<sup>40</sup> The court issued a preliminary injunction ordering cessation of use of the buried code as well as of the domain names.<sup>41</sup> In *Playboy Enterprises, Inc. v. AsiaFocus International*,<sup>42</sup> upon a finding of actual consumer confusion caused by deceptive tactics to lure consumers to a website, a federal court ordered AsiaFocus to pay \$3,000,000 in damages.<sup>43</sup>

Courts have also focused on wrongful or malicious intent when enjoining trademark use in metatags.<sup>44</sup> The *AsiaFocus* court found evidence of deceptive tactics.<sup>45</sup> In *Niton Corporation v. Radiation Monitoring Devices*,<sup>46</sup> the district court considered a Niton employee's affidavit asserting that the defendant's website metatag descriptions were copied verbatim from Niton's website to their own.<sup>47</sup> It determined that Niton was likely to succeed on an unfair competition theory, and entered a preliminary injunction against the misleading use of the metatags based on the likelihood of harm to Niton.<sup>48</sup> Evidence of wrongful intent simplifies a court's decision regarding infringement because trademarks logically protect against source confusion, so a party deliberately attempting to create such confusion makes itself vulnerable to a cause of action.

Yet another case involving Playboy but allowing trademark use in metatags revolved around a former Playboy Bunny and Playmate of the

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38. See, e.g., *Playboy Enters., Inc. v. Calvin Designer Label*, Civ. Action No. C-97-3204 CAL, at P38, 44, 49 (N.D. Cal. filed Sept. 8, 1997); *Playboy Enters., Inc. v. Welles*, 7 F. Supp 2d. 1098 (S.D. Cal.), *aff'd*, 162 F.3d. 1169 (9th Cir. 1998) (unpublished); *Playboy Enters., Inc. v. AsiaFocus Int'l, Inc.*, 1998 WL 724000 (E.D. Va. 1998).

39. 985 F. Supp. 1220 (N.D. Cal. 1997).

40. See *id.* at 1221.

41. See *id.* at 1221-22.

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

43. See *id.* at \*1.

44. See *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102, 104 (D. Mass. 1998); *AsiaFocus*, 1998 WL 724000 at \*3 (E.D. Va. 1998).

45. See *AsiaFocus*, 1998 WL 724000 at \*3.

46. 27 F. Supp. 2d 102 (D. Mass. 1998).

47. See *id.* at 104.

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

Year's use of the "playboy" and "playmate" trademarks in her website's content and metatags. In *Playboy Enterprises v. Welles*,<sup>49</sup> the court found that Terri Welles used the trademarks to promote herself, not to confuse the user, and that the use of the marks was descriptive in nature, and so constituted fair use.<sup>50</sup> The recognition of the fair use defense in the meta-tag context illustrates a desire to fold the issue into trademark law.

#### 4. *Initial interest confusion*

Several courts have discussed an initial interest confusion theory, albeit using different descriptors.<sup>51</sup> Universally, use of the theories has depended upon a definition that required the consumer to assume an association between the alleged infringer and the source of the goods, thus defining confusion by identifying the harm inflicted.

In one of the first cases developing the initial interest confusion theory, the court in *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*<sup>52</sup> stated that while the prospective buyer of an expensive piano is often a musical expert, he or she may be misled into considering the purchase of a Grotrian-Steinweg piano because the prospective buyer initially is under the mistaken impression that the maker of the Grotrian-Steinweg is somehow affiliated with the maker of the famous Steinway pianos.<sup>53</sup> The harm to Steinway occurred when a potential customer, thinking there was a connection, was attracted by the Grotrian-Steinweg name to consider that brand of piano, even though later investigation revealed that there was no connection with the makers of the Steinway.<sup>54</sup>

The *Mobil Oil Corp. v. Pegasus Petroleum Corp.*<sup>55</sup> court relied upon the *Steinway* decision to hold that potential oil purchasers would be initially confused because they would assume an association between Pegasus Petroleum and Mobil.<sup>56</sup> The court held that the initial confusion cre-

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49. *Playboy Enters. v. Welles*, 7 F. Supp. 2d 1098 (S.D. Cal. 1998).

50. *See id.* at 1104.

51. *See* *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996) ("[T]he Lanham Act forbids a competitor from luring potential customers away from a producer by initially passing off its goods as those of the producer's. . . . This 'bait and switch' of producers [is] also known as 'initial interest' confusion. . . ."). Other terms used to describe the theory include initial confusion, consumer confusion, and pre-sale confusion. This Note utilizes "initial interest confusion" in accordance with the court's usage in *Brookfield*.

52. 523 F.2d 1331 (2d Cir. 1975).

53. *See id.* at 1342.

54. *See id.*

55. 818 F.2d 254 (2d Cir. 1987).

56. *See id.* at 260.

ated a sufficient trademark injury, regardless of the fact that the potential customers would learn that Pegasus and Mobil were unrelated well in advance of any sale.<sup>57</sup> The identified harm to Mobil was that an oil trader might listen to a cold call from Pegasus based on an assumed association with Mobil and later enter into a contract with Pegasus, although no longer confused about the relationship between the companies.

The *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*<sup>58</sup> court relied upon the *Mobil Oil* decision to find that the use of the familiar Cat in the Hat marks or a confusingly similar title (e.g., "The Cat NOT in the Hat!") to capture initial consumer attention may still be trademark infringement, even though no sale is finally completed as a result of the confusion.<sup>59</sup> The harm to Dr. Seuss caused by the sale of a book with a confusingly similar title and appearance was not clearly laid out in the decision.

### C. Brookfield Communications, Inc. v. West Coast Entertainment Corp.

#### 1. Procedural history

Brookfield Communications ("Brookfield") creates and markets software containing entertainment industry-related information.<sup>60</sup> Initially, Brookfield only offered software that organized and presented industry information (film submissions, future projects, etc.) to film studios, production companies, actors, and other professionals in the film industry,<sup>61</sup> but in December 1993, Brookfield expanded its target audience to the greater consumer market when it developed and marketed a searchable database containing movie credits, film release schedules, and lists of actors and producers.<sup>62</sup> This "MovieBuff" software is sold at major retail stores throughout the country.<sup>63</sup> Additionally, Brookfield offers online access to the MovieBuff database at <inhollywood.com> and sells the MovieBuff software at <brookfieldcomm.com> and <moviebuffonline.com>.<sup>64</sup>

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57. *See id.* at 259.

58. *Dr. Seuss Enters. L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

59. *Id.* at 1405.

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

61. *See id.* at 1041.

62. *See id.*

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

64. *See id.* at 1042.

West Coast Entertainment Corporation ("West Coast") is one of the country's largest video rental store chains. It registered the domain name <moviebuff.com> with Network Solutions on February 6, 1996.<sup>65</sup> West Coast has had a federally registered service mark, "The Movie Buff's Movie Store," since 1991.<sup>66</sup> West Coast also claimed to have used the phrase "Movie Buff" to promote goods and services in its video stores in Massachusetts.<sup>67</sup>

Upon learning in October 1998 that West Coast planned to launch a website at <moviebuff.com> consisting of, among other things, a searchable entertainment database similar to the MovieBuff software, Brookfield sent West Coast a cease-and-desist letter alleging that such use of the MovieBuff mark would infringe Brookfield's trademark rights.<sup>68</sup> One day after receiving the letter, West Coast issued a press release detailing its plans for the site.<sup>69</sup> Brookfield then filed suit in federal district court alleging trademark infringement and unfair competition and applied for a temporary restraining order ("TRO") enjoining West Coast from using the term MovieBuff in domain names or metatags.<sup>70</sup>

In opposition to the TRO request, West Coast argued that it was the senior user of the MovieBuff mark because it had used its federally registered service mark in commerce since 1986.<sup>71</sup> Alternatively, West Coast argued for seniority based on its common law rights in the domain name, secured prior to Brookfield's offering of the database on the Internet.<sup>72</sup> West Coast also argued that there was no likelihood of confusion.<sup>73</sup>

The district court construed the TRO request as a motion for a preliminary injunction and denied the motion, stating that West Coast was the senior user of the mark and that Brookfield had failed to show a likelihood of confusion.<sup>74</sup> West Coast therefore launched its website in January 1999. Brookfield, fearing that the operation of the site would cause irreparable injury, applied for and received an emergency motion for injunction pending appeal.<sup>75</sup>

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65. *See id.*

66. *See id.*

67. *See id.*

68. *See id.*

69. *See id.*

70. *See id.* at 1043.

71. *See id.*

72. *See id.*

73. *See id.*

74. *See id.*

75. *See id.*

## 2. *The Ninth Circuit decision*

The Ninth Circuit reversed, determining that Brookfield was the senior user of the MovieBuff mark. In doing so, it rejected West Coast's arguments that it should be allowed to tack its prior use of "The Movie Buff's Movie Store" to its use of <moviebuff.com>. The court noted that the standard for tacking is extremely strict; marks must create the same commercial impression and not differ materially from one another or alter the character of the tacking mark.<sup>76</sup> Accordingly, the court found that "The Movie Buff's Movie Store" and <moviebuff.com> are very different in terms of, among other things, the number of words in the phrase.<sup>77</sup> West Coast also failed to show that consumers view the marks as identical.<sup>78</sup>

The court also rejected West Coast's alternative argument, that it had used <moviebuff.com> in commerce before Brookfield began offering the MovieBuff searchable database on the Internet.<sup>79</sup> The court found that West Coast's registration of the domain name in February 1996 did not constitute a use in commerce for the purpose of acquiring trademark protection.<sup>80</sup> As Brookfield first used MovieBuff on its Internet-based products in August 1997 and West Coast did not actually use the domain name in any commercial sense until November 1998, the Court determined that Brookfield was still the senior user of the mark.<sup>81</sup>

According to the court, Brookfield had shown a likelihood of confusion regarding the use of the MovieBuff mark in the domain name, utilizing a "pliant" and nonexhaustive list of factors.<sup>82</sup> It concluded that <moviebuff.com> is essentially identical to "MovieBuff", especially since Internet users regularly tack ".com" onto the end of familiar trademarks to find the corresponding website.<sup>83</sup> The court held that the two companies' products were sufficiently related so as to cause confusion in the minds of consumers, and that both companies' use of the Internet as a marketing tool furthered the likelihood of such confusion.<sup>84</sup>

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76. *See id.* at 1048.

77. *See id.* at 1049.

78. *See id.*

79. *See id.* at 1053.

80. *See id.* at 1052-54. The Brookfield decision is among the first to require that a domain name actually be used in commerce (as opposed to merely registered) in order to accrue trademark rights. This aspect of the decision is interesting in its own right, but outside the scope of this Note.

81. *See id.* at 1053

82. *Id.* at 1053-54.

83. *See id.* at 1055.

84. *See id.* at 1055-56.

The court then analyzed the strength of Brookfield's mark, finding it to fall "within the weak side of the . . . spectrum" but to be not so "flabby" as to mandate a finding of no likelihood of confusion.<sup>85</sup> With regard to intent, the court found that the intent factor should favor the plaintiff where the alleged infringer adopts the mark with knowledge that it is the trademark of another.<sup>86</sup> There was, however, no evidence that West Coast registered the domain name with the principal intent of causing consumer confusion.<sup>87</sup>

Finally, the court analyzed the important metatag issue: would West Coast's use of "moviebuff" in the HTML metatags on any of its sites create confusion on the part of the consumer? The court declined to utilize traditional confusion factors<sup>88</sup> when evaluating Brookfield's metatag confusion claim; instead, it focused on the potential initial interest confusion created by West Coast's use of the MovieBuff mark in website metatags.<sup>89</sup> It held that because a search engine might list West Coast's sites as hits on a search for "moviebuff", the consumer would suffer from initial interest confusion.<sup>90</sup> Although there would be no confusion over which company offered the product, West Coast would benefit from the goodwill previously established by Brookfield's use of MovieBuff. The court held this was enough to make such metatag use actionable under the Lanham Act.<sup>91</sup>

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85. *Id.* at 1058.

86. *See id.* at 1059.

87. *See id.*

88. The Ninth Circuit test used to analyze the likelihood of confusion, commonly called the "Sleekcraft Factors" and articulated in *AMF Incorporated v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979), includes the following eight flexible factors: (1) strength of the mark; (2) proximity of the goods; (3) similarity of the marks; (4) evidence of actual confusion; (5) marketing channels used; (6) type of goods and the degree of care likely to be exercised by the purchaser; (7) defendant's intent in selecting the mark; and (8) likelihood of expansion of the product lines. *Id.* at 348-349. The *Sleekcraft* court noted that the list is not exhaustive. *Id.*

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

90. *See id.* at 1062.

91. *See id.* at 1064-65. West Coast was not prohibited from using "MovieBuff" to describe Brookfield's product, as this would be a fair use. *See id.* at 1066. Use of the descriptive term "Movie Buff" was also permitted, as it is regularly used in the English language to describe a movie fan. *See id.* The court noted that a space between the terms "movie" and "buff" made all the difference between the generally descriptive term ("Movie Buff") and the term that is Brookfield's mark ("MovieBuff"). *See id.*

## II. DISCUSSION

Traditionally, trademark law has protected against consumer confusion by barring the use of visibly infringing marks.<sup>92</sup> This presents a problem when courts adapt trademark law to protect trademarks in metatags because these trademarks are not visible to the user. The Ninth Circuit attempted to avoid this problem by applying the theory of initial interest confusion to metatag use, but that application is not appropriate.

### A. Initial Interest Confusion is Not Appropriately Applied Because Internet Consumers Have Unique Expectations

Previous interpretations of initial interest confusion have relied upon the standard expectations of consumers in the physical world. Internet consumers expect to receive information differently from a search engine than typical consumers expect to receive from traditional advertising, and Internet users seek that information in different ways. The *Brookfield* court analogized unauthorized trademark use in metatags to posting a sign containing another's trademark in front of one's store.<sup>93</sup> It introduced a hypothetical situation in which West Coast's competitor, Blockbuster, put up a highway billboard reading, "West Coast Video: 2 miles ahead at exit 7," when West Coast is really located at exit 8 but Blockbuster is at exit 7.<sup>94</sup> The court posited that customers looking for West Coast's store will pull off at exit 7.<sup>95</sup> Unable to find West Coast but seeing the Blockbuster store, they might simply rent at Blockbuster instead.<sup>96</sup> Consumers would not be confused in the sense that they know the source of the goods and do not assume any relationship, but Blockbuster is nonetheless misappropriating West Coast's goodwill.<sup>97</sup>

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. A search engine returns a multitude of possibly relevant websites and a

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92. See *Coca-Cola Bottling Co. v. Coca-Cola Co.*, 269 F. 796, 806 (D. Del. 1920) ("[A] trademark is merely one of the *visible* mediums by which the good will is identified, bought and sold, and known to the public.") (emphasis added). *But see* 1 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 7:105 (4th ed. 1999) (discussing the relatively recent trademark registrations for marks consisting of a fragrance applied to a good, commonly known as fragrance marks).

93. See *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999).

94. See *id.*

95. See *id.*

96. See *id.*

97. See *id.*

user can get to any site listed merely by clicking on a hypertext link. Therefore, a more accurate highway analogy would be: Blockbuster and West Coast are located off the same highway exit and a third party interested in encouraging consumers to rent videos erects a billboard listing video stores at that exit. Blockbuster reminds the third party that it rents videos just like West Coast does, and the third party puts the names of both stores on the billboard. A video tape consumer driving by the billboard will see both West Coast and Blockbuster listed and will be able to access either one with ease. If the consumer originally looked at the sign expecting to locate West Coast, the presence of Blockbuster's name on the sign will not frustrate that purpose and the consumer is free to patronize West Coast. If the consumer looked at the sign expecting to locate a video store *like* West Coast, or even just any video store, then she is presented with information that satisfies her request as well.

Search engine users may enter a search request using a trademark in the hopes of finding sites representing products similar to the product represented by the mark in addition to the site belonging to the owner of the mark.<sup>98</sup> In that event, prohibiting the use of trademarks in metatags frustrates a source of information retrieval anticipated and utilized by Internet consumers. In this respect, prohibiting metatag use of trademarks does nothing to further consumer protection against source confusion while frustrating consumer choice. Further, the use of alternate marks in metatags serves the valuable function of promoting competition. It provides the consumer choice, much like a supermarket, where consumers often seek categories by using famous marks instead of generic terms.

## **B. The Case for Self-Regulation of Search Engines**

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

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98. See Stephen W. Feingold, *Trademarks: Means to Avoid Confusion, or Property Rights. Two Pending Cases Outline Dilemma*, 222 N.Y.L.J. 17 (1999). Feingold uses the phrase "concept searching" to describe use of a specific trademark to search out information about a product's general category of goods, including competing products. "[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." *Id.* Note that concept searching is different than genericide in that the consumer does not use the term Honda to describe all Japanese cars, but instead uses the term as a starting point for gathering related information.

rithms in order to provide the most relevant hits to the consumer.<sup>99</sup> Search engine providers desire a maximal user base. Therefore, they should return relevant and helpful results to attract that user base. If consumers do not want to get results that include competing websites, search engine providers will accommodate that consumer preference by changing the technology used. Many examples of such self-regulation already exist in the metatag context.

In fact, the most commonly used search engines have altered indexing schemes so as to not rely upon metatags and therefore not to encourage improper use of metatags.<sup>100</sup> Of the big eight search engine providers<sup>101</sup>—Yahoo!, Excite, WebCrawler (owned by Excite), InfoSeek, Lycos, HotBot (owned by Lycos), and AltaVista—only InfoSeek and Lycos (and therefore HotBot) allow metatags to boost ranking. Other providers switched in response to coders embedding multiple instances of keywords. In an effort to maintain their value, search engine providers fight manipulative meta-tagging regularly. In addition to refining their ranking algorithms, search engine providers continually attempt to improve their software in other ways to provide more accurate results. Steps range from ignoring metatags altogether to sanctioning pages that use manipulative metatags, including removing them from the index.<sup>102</sup>

Excite Search has the largest index among the top searching websites.<sup>103</sup> The Excite spider<sup>104</sup> does not index keyword metatags because the “information is not always reliable. It may or may not accurately reflect the content of the site.”<sup>105</sup> Excite explains the decision not to rank based on metatags by stating, “[w]e believe our decision protects our users from unreliable information and ensures that Web publishers, if they choose, can have an active role in the representation of their content and services

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99. See Craig K. Weaver, *Signposts to Oblivion? Meta-tags Signal the Judiciary to Stop Commercial Internet Regulation and Yield to the Electronic Marketplace*, 22 SEATTLE U. L. REV. 667, 683 (1998).

100. See SearchEngineWatch.com, *Search Engine Features for Webmasters*, (visited Jan. 31, 2000) (<<http://searchenginewatch.com/webmasters/features.html>>).

101. See Scott Clark and David Fiedler, *Priming the Search Engines*, WebDeveloper.com (visited Oct. 7, 1999) (<[http://www.webdeveloper.com/manage\\_search\\_engine\\_tips\\_part.html](http://www.webdeveloper.com/manage_search_engine_tips_part.html)>). Ninety-five percent of Web surfers use just these eight engines.

102. See O'Rourke, *supra* note 10 at 305-306 (1997).

103. See Excite.com, *Press Release—Excite Search Announces 250 Million Indexed Web Pages the Largest Among Top Ranking Portals*, (visited Jan. 31, 2000) (<[http://corp.excite.com/News/pr\\_000202\\_01.html](http://corp.excite.com/News/pr_000202_01.html)>).

104. See *supra* (I.A.2) for a definition of search engine spiders.

105. Excite.com, *Excite Info—Understand Meta Tags*, (visited Nov. 6, 1999) (<[www.excite.com/Info/listing8.html](http://www.excite.com/Info/listing8.html)>).

to the online consumer.”<sup>106</sup> This pledge illustrates the fact that search engines, in order to remain competitive, must take into account the interests of both users and publishers. AltaVista indexes all description and keyword metatags, but metatags play only a small part in determining site ranking in search results.<sup>107</sup> HotBot (owned by Lycos) is one of the few search engines that still uses metatags to rank a site’s relevancy when returned as a search result.<sup>108</sup> Even though HotBot still employs ranking by metatag content, it is the policy of HotBot to manually downgrade a site’s ranking when improper use is detected.<sup>109</sup> Yahoo!, which is responsible for almost half of all Internet traffic generated by search engines,<sup>110</sup> does not employ spiders to catalog information and thus does not use metatag information to index or rank sites.<sup>111</sup>

Given the commercial interests at stake, proliferation of Internet-based legislation before Congress,<sup>112</sup> and increasing judicial intervention,<sup>113</sup> it is

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106. *Id.*

107. See AltaVista.com, *AltaVista—Help—FAQ*, (visited Nov. 11, 1999) (<<http://doc.altavista.com/help/search/faq.shtml>> (“AltaVista uses a ranking algorithm to determine the order in which matching documents are returned on the results page. Each document gets a grade based on how many of the search terms it contains, where the words are located in the document, and how close they are to each other. Intentionally and unnecessarily repeating a word on a Web page is known as spamming and has a negative effect on a site’s ranking. AltaVista uses special software to detect spamming and the offending site is prevented from appearing in the index.”).

108. See Sofer.com, *Search Engines: Submission Tips, Help and Use*, (visited Feb. 2, 2000) (<<http://www.sofer.com/research/engines.html#HotBot>>).

109. See HotBot.com, *HotBot—Help—Add URL & Webmaster’s FAQ*, (visited Nov. 11, 1999) (<<http://hotbot.lycos.com/help/addurl/#2>>) (“We’re aware that some people create pages to maliciously ‘spoo’ search engines. Spoofing a search engine makes search engines return pages that are irrelevant to the search, or pages that rank higher than their content warrants. Common spoofing techniques include the repetition of words, the inserting of meta tags unrelated to the document’s content, or the use of words that cannot be read due to their small size or color. If HotBot detects search-engine spoofing, it will significantly downgrade a page’s ranking.”).

110. See Internet.com, *Yahoo Generates Most Search Traffic*, (visited Feb. 2, 2000) (<[http://cyberatlas.internet.com/big\\_picture/traffic\\_patterns/article/0,1323,5931\\_152101,00.html](http://cyberatlas.internet.com/big_picture/traffic_patterns/article/0,1323,5931_152101,00.html)>).

111. See Yahoo.com, *Yahoo! Frequently Asked Questions*, (visited Nov. 11, 1999) (<<http://docs.yahoo.com/info/faq/faq.html#gather>>) (“Most sites in Yahoo! are suggested by users. Sites are placed in categories by Yahoo! Surfers, who visit and evaluate all suggestions and decide where they best belong. This is done to ensure that Yahoo! is organized in the best possible way, making the directory easy to use, intuitive, helpful, and fair to everyone.”).

112. See, e.g., H.R. 2326, 105th Cong. (1997) (Children’s Online Privacy Protection Act of 1998); H.R. 2441, 104th Cong. (1995) (Copyright Protection Act of 1995).

naive to advocate a regulation-free Internet. But the regulation, while inevitable, does not have to be judicial—self-regulation by the Internet community is plausible, possible, and preferable to judicial solutions given both the speed at which potentially infringing technology changes and the notable lack of speed at which an overloaded federal judiciary is able to hear and decide cases.

### III. CONCLUSION

Brookfield establishes a cause of action under trademark doctrine for the unauthorized use of another's trademark in one's website metatags, at least in the Ninth Circuit. The result may be an influx of complaints asserting trademark infringement into the courts, tying up judicial resources and increasing business and litigation expenses. A remedy for the perceived wrong would be better pursued through the market system, by increasing pressure on search engine creators to innovate new searching and ranking algorithms in order to bypass the use of metatags in generating search results altogether.

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113. *See, e.g.*, *Reno v. ACLU*, 521 U.S. 844 (1997); *Religious Tech. Ctr. V. Netcom On-Line Comm'n Serv.*, 907 F.Supp. 1361 (N.D. Cal. 1995).



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