
Intellectual Property Section

NEWSLETTER

Published by the Oregon State Bar Intellectual Property Section

Fall 1999

Annual Meeting Notice

**Oregon State Bar
Intellectual Property Section
Annual Meeting**

**Thursday, October 7, 1999
12:00 Noon**

**Riverplace Hotel
McCall Room
1510 S.W. Harbor Way
Portland, Oregon 97201**

**Speaker: Curtis G. Rose.
Topic: Patent Prosecution
Psychology: Examining the
Examiner**

Mr. Rose is a Senior Regional Attorney for the Hewlett-Packard Company in Corvallis, Oregon, where he manages the Intellectual Property Section of the Corvallis Legal Department and supports clients engaged in the research and development of HP's notebook personal computers, high-end graphics software, and diagnostic cardiology medical devices. He is also an Adjunct Professor at the University of Oregon Law School.

Mr. Rose will examine how the policies and internal procedures of the Patent and Trademark Office generate patterns of examiner behavior, and how a practitioner's knowledge of these patterns can lead to more effective prosecution efforts.

The Agenda also includes the election of the 1999-2000 Oregon State Bar Intellectual Property Section Executive Committee.

In This Issue

Annual Meeting Notice	1
Slate of Officers	2
To Tag or Not To Tag—That Is the (Meta) Question	3
<i>Clinton Todd</i>	
1999 Intellectual Property Section Essay Contest Winners	10
Highlights of Section Activities . . .	11
New Member Application	12

1999-2000 Slate

Intellectual Property Section Executive Committee 1999-2000 Officers

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To Tag or Not To Tag – That Is the (Meta) Question

by Clinton Todd

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“Using another’s trademark in one’s metatags is much like posting a sign with another’s trademark in the front of one’s store.”¹

Introduction

The World Wide Web has become a virtual forest of services and information, and it is increasingly difficult to find desired material online using a search engine. Attempting to combat this problem, companies have employed ingenious methods of ensuring that their sites will land toward the top of a would-be searcher’s list. One such trick is to include another company’s trademarks in a site’s metatags.² This “tag” provides a “hit” whenever the trademark name is used in a search engine, even if the site has little relation to the trademark.³ The idea is to piggyback on very strong marks that are commonly used for searches.

Another strategy used by Web site operators is the use of pirated trademark names as their

own second-level domain names.⁴ The reasons are simple: some operators are attempting to confuse consumers, while others simply seek association with the mark, and still others participate in a cybersport called “cybersquatting.”⁵

In the interest of fairness, it should be noted that not all metatag and domain name use is malicious or illegal. In fact, real disputes involving legitimate claims to trademarks have put our courts and traditional trademark laws to the test. Courts have grappled with the obvious legal questions that arise in the face of these accusations. Does this activity constitute trademark infringement? Are there situations in which these actions are perfectly legitimate? The answer to each of these questions has been both “yes” and “no” as an inadequate body of law strains to keep pace with

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- 1 *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1064 (9th Cir. 1999) [hereinafter *Brookfield*]. *Brookfield* addresses the domain name infringement and metatag issues independently. Previous decisions in this area have dealt with domain names and metatags together, causing confusion among commentators as to which infringing use was the more significant factor in the decision. See Barbara Anna McCoy, *An Invisible Mark: A Meta-Tag Controversy*, J. Small & Emerging Bus. L., 2 Winter 1998 2, at 377, 384. The detail in *Brookfield* provides independent analysis and guidance in each area that was not previously attainable.
 - 2 “Meta tags are invisible codes embedded in the hypertext markup language (HTML) used to create Web sites.” Meeka Jun, *Meta Tags: The Case of the Invisible Infringer*. N.Y.L.J., Oct. 24, 1997, at 2. “Metatag,” as a very new term, is spelled with or without a space, depending on the writer’s preference. See *Brookfield*.
 - 3 See *Oppedahl & Larson v. Advanced Concepts*, Civ. No. 97-Z-1592 (D. Colo. filed July 24, 1997) (The firm argued that the defendants were using its name to capitalize on the law firm’s intellectual property reputation and enhance their business as Web site developers. Other than the metatags, the site did not mention the firm or claim to have any relationship with it.)
 - 4 “Pirating” is defined as the practice of “obtaining SLD registrations within the .com TLD of a well-known company name or brand.” Sally M. Abel, *Trademark Issues in Cyberspace: The Brave New Frontier* (visited May 2, 1999), Fenwick & West, LLP <http://www.fenwick.com/pub/trademark_issues_in_cyberspace.htm>.
 - 5 Cybersquatters are “pirates” intent on selling registered domain names to the company that associates with the mark.

technological advances. However, a federal court has recently addressed these questions and provided guidelines, but even though the landscape is clearer than before, the answers to the above questions may actually remain the same.

This comment focuses on the analysis in the *Brookfield* decision concerning trademark use in metatags, discusses the implications of the decision, and provides workable parameters for Web operators concerning the use of metatags. The comment does not further address the domain name portion of the *Brookfield* decision because it concerns a distinctly separate analysis.⁶ Also, in the interest of brevity and focus, many previous metatag cases are not scrutinized as the cases are sufficiently discussed in many journal comments and Web sites; furthermore, *Brookfield* is the first Federal appellate decision specifically dealing with metatag use, employing an entirely different breed of confusion analysis not mentioned in previous metatag cases.⁷

Brookfield Communications, Inc. V. West Coast Entertainment Corp.

On April 22, 1999, in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, the Ninth Circuit of the United States Court of Appeals updated trademark law concerning the World Wide Web, at least as far as domain names and metatags are concerned. The court treats the Web with a precision and understanding that few courts have thus far achieved and at the

same time manages to apply well-settled legal principles to the questions faced. No doubt *Brookfield* will be regarded as a seminal case for some time because no federal court of appeals has extensively addressed the metatag issue until now and much of the domain name case law has been in question.⁸ *Brookfield* provides guidelines for metatag use constituting neither infringement nor unfair competition. However, the question remains whether the decision will provide new uses for enterprising individuals or increased rights and protection to Trademark holders.

Initial-Interest Confusion

The facts of the case are simple: West Coast is using Brookfield's registered trademark, "MovieBuff," in its metatags. The court admits that "[s]ince there is no confusion resulting from the domain address, and since West Coast's initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast's web site."⁹ While judicial declarations of this type usually signify the demise of a trademark infringement claim, the court finds for the plaintiff using a sheltered corner of confusion analysis known as "initial interest confusion."¹⁰ Initial-interest confusion occurs prior to the point of sale when a consumer is attracted by an infringing mark and is "misled into an 'initial interest' in the infringer's product."¹¹ The confusion constitutes infringement even if the consumer takes steps to further investigate the infringing company and realizes his initial mistake.¹² Furthermore, the subsequent eradication of

6 See *Brookfield* 1036-1061.

7 See *infra* notes 1, 8, 10.

8 For a synopsis of prior metatag case history, see generally *A Webmaster's Guide to Search Engines*, Metatag Lawsuits (visited May 3, 1999) <<http://searchenginewatch.com/resources/metasuits.html>>. See also McCoy, *supra* note 1, at 384-87.

9 *Brookfield*, at 1062 (The court disallowed West Coast the use of the "moviebuff.com" domain name in a portion of the decision.).

initial-interest confusion does not erase the infringement or the effects therefrom.¹³

Initial-Interest In The Metatag Context

In the metatag context, the concept of initial-interest confusion is best illustrated by the following example. A consumer types Company X's name into a search engine, and through the use of a metatag containing Company X's trademark, competing Company Y's Web site, containing similar services to that of X, is listed. The curious and possibly confused consumer chooses Company Y from the list produced by the search engine. Upon arrival at Y's Web site, the consumer is offered services so much like X's that he simply decides to utilize Y's Web site instead. "Even consumers who prefer [X] may find it not worth the trouble to continue searching for [X] since . . . [Y] [is] right there."¹⁴ Although the consumer is not confused as to the source of the information because he is aware of the service he has chosen, Company Y improperly benefits from the goodwill that Company X has garnered in its mark. Even if no actual sale is completed by Y, the court concludes that this use of Company X's trademark "to capture initial consumer attention . . . may be

still an infringement."¹⁵ The confusion may be fleeting or immediately displaced, but the initial confusion is sufficient to constitute infringement. After being "[l]ured into an infringer's store by a confusing mark, consumers may stay to do business as a convenience, even though they realize their mistake."¹⁶ Thus, "the diversion of consumers' initial interest is a form of confusion against which the Lanham Act protects."¹⁷

Upon restatement of the initial-interest confusion theory and its application in terms of the World Wide Web, the *Brookfield* court maintains that West Coast has improperly benefited from the goodwill associated with *Brookfield's* "MovieBuff" mark by employing it in its metatags. As a result, the court concludes "that the Lanham Act bars West Coast from including in its metatags any term confusingly similar with *Brookfield's* mark."¹⁸ Specifically, West Coast is prevented from using "MovieBuff" in its metatags notwithstanding application of the fair use defense. As expected, West Coast argued that its employment of the "MovieBuff" mark constituted fair use under the Lanham Act.

10 *Brookfield*, at 1062 n.24 (The court, agreeing with the decision in *Welles (Playboy Enters. v. Welles*, 7 F. Supp. 2d 1098, 1104 (S.D. Cal. 1998)), declines to apply the traditional Sleekcraft factors for likelihood of confusion because the eight-factor test is not suited for the analysis in the metatag context. Rather, the court discusses confusion within the parameters of the purchaser-care analysis.)

11 Richard L. Kirkpatrick, *Likelihood of Confusion in Trademark Law* § 1.7, at 1-30 (1998).

12 *Brookfield*, at 1063-64. The court offers several cases with similar conclusions. See *Television Enter. Network, Inc. v. Entertainment Network, Inc.*, 630 F. Supp. 244, 247 (D.N.J. 1986) ("Even if the confusion is cured at some intermediate point before the deal is completed, the initial confusion may be damaging and wrongful."); see also *Forum Corp. of N. A. v. Forum, Ltd.* 903 F.2d 434, 442 n.2 (7th Cir. 1990) ("We point out that the fact that confusion as to the source of a product or service is eventually dispelled does not eliminate the trademark infringement which has already occurred.")

13 *Brookfield*, at 1063-64.

14 *Id.* at 1064.

15 *Id.* at 1062 (quoting *Dr. Seuss Enterprises v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (citing *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254, 257-58 (2d Cir. 1987))).

16 Kirkpatrick, *supra* note 11, at 1-31.

17 *Brookfield*, at 1063.

18 *Id.* at 1065.

Fair Use Allowed In *Brookfield*

Not surprisingly, the court does not prohibit West Coast from using “MovieBuff” in a manner that legally constitutes fair use under the Lanham Act.¹⁹ Typically, fair use consists of a truthful identification of the competitor’s goods using the competitor’s mark for either descriptive or comparative purposes. The court ensures application of the rule on the Internet, stating that “[t]his fair use doctrine applies in cyberspace as it does in the real world.”²⁰

Agreeing with the *Welles* court, the *Brookfield* panel allows the use of descriptive terms in metatags to fairly describe the content of the Web page. But, if the descriptive terms are another’s trademark, the terms must have been used in good faith. In *Playboy Enterprises v. Welles*, Ms. Welles uses the “Playboy” mark in her Web site’s metatags and on the site itself, although sparingly. The court allows Ms. Welles to use the “Playboy” and “Playmate of the Year” marks in her metatags because she is simply describing herself and the title that she received from Playboy.²¹ “It is clear that defendant is selling Terri Welles and only Terri Welles on the website. There is no overt attempt to confuse the websurfer. . . .”²² This is not true in the present case. West Coast lacks the reasonable-description fair-use claim to which Ms. Welles is entitled since no association exists between the two entities. West Coast did not formerly use the “MovieBuff” mark legally, nor was West Coast

ever entitled to “MovieBuff.” Finally, “MovieBuff” is not descriptive of the West Coast site. Unlike Ms. Welles, West Coast cannot claim that the mark is a good-faith description of its site or business.

In *Brookfield*, the court allows the use of “Movie Buff” (with a space) in West Coast’s metatags because it is a descriptive term used routinely to describe a motion-picture enthusiast, whereas “MovieBuff” is not a word and not commonly used to describe the same type of consumer. Semantics, yes, but important nonetheless. “[T]hat difference is pivotal.”²³

The court also encourages West Coast to use the “MovieBuff” mark in comparative advertising legitimately describing *Brookfield*’s products. Comparative fair use constitutes neither trademark infringement nor unfair competition. “However, such comparative advertising will not be permitted if it is likely to confuse buyers as to exactly what they are getting.”²⁴ While allowing West Coast to use “MovieBuff” in comparative advertising that constitutes fair use, the panel again restates its prohibition of luring consumers to West Coast’s Web site through the use of infringing metatags.

Comparative Advertising

Comparative advertising is encouraged to some extent by case law and the Federal Trade Commission.²⁵ The Ninth Circuit was clear on

19 *Id.* at 1065.

20 *Id.* at 1065.

21 *Id.* at 1066.

22 The court also notes that “Ms. Welles earned the title of ‘Playboy Playmate of the Year’ in 1981 and has used that title ever since, without objection from [Playboy].” 7 F. Supp. 2d at 1098, 1103 (Welles’ use of the trademark “is descriptive of and used fairly and in good faith only to describe [herself].” 15 U.S.C. § 1115(b)(4).” *Welles*, 7 F. Supp. 2d, at 1104.

23 *Brookfield*, at 1066.

24 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition* § 25:52, at 25-85 (4th ed. 1999). The Federal Trade Commission also encourages nonconfusing comparative advertising using the competitor’s mark. *See id.* n.1.1: “16 C.F.R. § 14.15(b)-(c) (‘Commission policy in the area of comparative advertising encourages the name of, or reference to competitors, but requires clarity, and, if necessary, disclosure, to avoid deception of the consumer.’).”

the point in 1968: “in the absence of misrepresentation or confusion as to source or sponsorship a seller in promoting his own goods may use the trademark of another to identify the latter’s goods.”²⁶ Notice that this type of fair use is permitted only in the absence of confusion. In subsequent rulings on comparative advertising, courts revisited and restated the rule with similar language. If the defendants “have taken a ‘free ride’ on plaintiff’s name without causing confusion or deception, then they have taken that to which they were legally entitled.”²⁷ Again, under this theory the opposite conclusion must also hold true: comparative advertising that is confusing or deceptive will constitute infringement. Under the Ninth Circuit’s own analysis, confusion and comparative advertising cannot exist together.

Using Marks In Metatags To Refer To Comparative Advertising: Fair Use?

Commentators argue that *Brookfield* opens a loophole regarding the use of metatags to refer to a competitor’s goods or services.²⁸ “For example, if a Web site in its visual textual portion compared its goods or services to a competitor’s, the Web site operator could include in its meta tag the competitor’s trademark as a ‘fair use.’”²⁹ In support of this position, the Welles court, cited in *Brookfield*, ruled that the use of trademark names in metatags is permissible when that use constitutes “a good faith attempt to index the content of [the] web site.”³⁰ Under this analysis, West Coast could use “MovieBuff” in its metatags as long as the Web site contained a product comparison, such as, “Why pay for MovieBuff when you can get the same thing here for FREE?”³¹ If this is the true reading of *Brookfield*, the allowance of good-faith

indexing under *Welles* includes references to comparative advertisements.

But this cannot be the correct reading of *Brookfield*, because if true, the exception would swallow the rule. Allowing the use of “MovieBuff” in metatags to refer solely to comparative advertising should be prohibited under *Brookfield* for a variety of reasons. This metatag use runs contrary to the likelihood-of-confusion analysis, it can be distinguished from a good-faith effort to index the Web site, and it does not comply with the statutory and judicial requirements of the fair use defense in comparative advertising. The essence of initial-interest confusion is “the diversion of [the] consumer’s *initial* [emphasis added]”³² attention, and using another’s mark in metatags will often produce this result. A product comparison in the actual Web site would not erase consumer confusion because in the court’s own example and definition, the confusion is “initial.” And even in cases in which the confusion is eradicated, the infringement is not erased.³³ Thus, the confusion occurs prior to the consumer’s arrival at the infringing Web site, and the fact that the consumer may use the Web site or read the comparison advertisement is not dispositive because it occurs after the initial confusion and therefore after the infringement.

Similar logic requires that initial-interest confusion overrule the fair-use defense in comparative advertising. As previously stated, confusion and comparative advertising cannot exist together without infringement.³⁴ The World Wide Web is simply not big enough for the two of them. A one-sentence comparative advertisement does not suddenly change a deceptive metatag into a good-faith effort to describe the contents of the Web site. If this were the case, Web operators could include

25 16 C.F.R. § 14.15(c) (“Comparative advertising encourages product improvement and innovation, and can lead to lower prices in the marketplace.”).

26 *Smith v. Chanel, Inc.*, 402 F.2d 562, 569, 159 U.S.P.Q. 388 (9th Cir. 1968). See *infra* note 24.

27 *Sykes Laboratory, Inc. v. Kalvin*, 610 F. Supp. 849, 855 (C.D. Cal. 1985).

28 Carl S. Kaplan, *Court Lays Down the Law on Labels for Web Sites*, Cyber L. J., N. Y. Times, (visited Apr. 30, 1999) <<http://www.nytimes.com/library/tech/99/04/cyber/cyberlaw/30law.html>>. See also e-mail; the following is an e-mail conversation I had with Carl S. Kaplan:
Date: 5/2/99, 9:15:47 PM

Mr. Kaplan, I am a law student in Oregon who reads your column every Friday. I was excited to see the Brookfield summary because I am preparing a research project on the case for my Cyberspace law class. In your article I found what I thought to be a misstatement of the metatag holding, and I wanted to let you know and see what you thought about it.

The article states that as long as web operators include a product comparison on the actual web site, they may use the competitor's trademark in their metatag as fair use. I don't believe this can be the correct reading of Brookfield, because if true, the exception would swallow the rule. First, allowing the use of the mark as a meta tag runs contrary to the likelihood of confusion analysis. A product comparison in the actual web site would not erase consumer confusion because in the courts own example and definition, the confusion is "initial." Thus, the occurrence is prior to the consumer's arrival at the infringing web site, and the fact that the consumer may use the web site or read a comparison add is not dispositive because it occurs after the initial confusion and therefore after the infringement.

The court also stated that West Coast could use descriptive terms in its metatags, but not "MovieBuff" because it "is not such a descriptive term." As you note in your article, the court states that West Coast can use "Movie Buff" (with a space) since it is a descriptive term meaning "motion picture enthusiast." "It cannot, however, omit the space" in its metatags. In addition, the court explains that "MovieBuff" "can be legitimately used to describe Brookfield's product," but West Coast uses "MovieBuff" "to attract people to its web site in the case of the metatags). That is not fair use."

Finally, if this were the correct reading of the case, its application would lead to an illogical conclusion. Any Web operator would be free to use desirable trademarks in their metatags as long as they included a one sentence product comparison in the actual web site. I don't believe the panel could have intended such an easy escape route for West Coast or any other web site operator.

Thank you in advance for considering this e-mail. I would appreciate any feedback you have on the subject.

Sincerely, Clinton Todd.

Hi Clinton: Thanks for your note, and please call me Carl.

Well, I think I got it right, but you're correct that the court was not crystal clear on the point. Evidence for my side: see the court's discussion of metatag fair use, beginning with paragraph 31. There the court makes the general point that comparative advertising is fair use. Since the court is discussing fair use in connection with metatags, I think the case is strong that the court meant to green light use of another's trademarks in comparative advertising on visible text, and also use of those same trademarks in accurate metatags. Thus, "Contrary to West Coast's contentions, we are not in any way restricting West Coast's right to use terms in a manner which would constitute fair use under the Lanham Act. . . It is well established that the Lanham Act does not prevent one from using a competitor's mark truthfully to identify the competitor's goods. . . or in comparative advertising (citing New Kids on the Block). This fair use doctrine applies in cyberspace as it does in the real world."

And a few paragraphs later, the court explicitly states that West Coast could use a trademark of a competitor in its text as fair use. The implication is strong, I think, that the same trademark can go into a metatag — that's the Terri Welles case, really, which the court said was on point. Thus, "Moreover, West Coast is not absolutely barred from using the term 'MovieBuff.' As we explained above, that term can be legitimately used to describe Brookfield's product. For example, its web page might well include an advertisement banner such as "Why pay more for MovieBuff when you can get the same thing here for FREE?" which clearly employs "MovieBuff" to refer to Brookfield's products." For you to be right, Clinton, then the court would have to approve West Coast's use of 'MovieBuff' in its visible text as a comparative ad but not its metatag. But, again, the Welles court came to the opposite conclusion (i.e., she could use "playboy" in her text, and she could use the same word in her metatag, which accurately indexed the contents of her site). NB: the 9th Circuit affirmed the Preliminary Injunction in Welles.

29 Kaplan, *supra* note 26.

any mark in their metatags with a single-sentence caveat in the textual portion of the Web site despite the initial-interest confusion ruling and the nondeceptive requirements of comparative advertising. The court could not have intended this result given the good-faith requirement cited in *Brookfield* and *Welles*.³⁵

Furthermore, the court also stated in no uncertain terms that West Coast could use descriptive terms in its metatags, but not “MovieBuff” because it “is not such a descriptive term.”³⁶ The court even goes so far as to say that West Coast can use “Movie Buff” (with a space) since it is a descriptive term meaning “motion picture enthusiast.”³⁷ “It cannot, however, omit the space”³⁸ in its metatags. *Brookfield* does allow the use of trademarks in metatags in situations similar to the Welles case, but not under a *Brookfield* fact pattern. Even though *Welles* is on point, it is distinguishable from *Brookfield* because West Coast lacks a legitimate relationship with *Brookfield*. In contrast, Ms. Welles appeared in the *Playboy* publication on numerous occasions and was named “Playmate of the Year” in 1981. The court is clear: “MovieBuff” “can be legitimately used to describe *Brookfield*’s product,” but West Coast uses “MovieBuff” “to attract people to its web site in the case of the metatags [sic]. That is not fair use.”³⁹

At the same time, Ms. Welles should be allowed to refer to herself as a “Playmate” in her Web site and metatags. If she is prevented from doing so “she will be forced to describe herself absurdly as ‘a model who previously posed nude in a monthly national magazine connected to a rabbit.’”⁴⁰ West Coast does not fall victim to this apparent illogic because it lacks a legitimate history or compelling reason to connect its goods to *Brookfield*’s other than fair comparative advertising that is not misleading or confusing.

Advice For Web Operators Using Metatags

So what’s a Web site programmer to do now that the best metatags have some level of protection? *Brookfield* seems to have dealt a blow to the use of misleading metatags, but it leaves the door open to some legitimate uses that will no doubt be utilized. Webmasters should be able to avoid litigation by following a few simple guidelines. First, another’s trademark should not be utilized in a metatag unless it is a descriptive word. Well known, descriptive trademarks are uncommon, but under *Brookfield*, it is the easiest way to avoid litigation. Words located in the dictionary are the best bet.⁴¹ Second, the *Welles* court listed a number of determining factors while finding in Ms. Welles’ favor. Follow this example: Ms. Welles “does not use *Playboy* or *Playmate* in her domain name, she does not use the classic

30 *Brookfield*, at 1066.

31 *Brookfield*, at 1066

32 *Brookfield*, at 1063.

33 *See infra* note 12.

34 *See infra* notes 24, 26.

35 *See infra*, note 30.

36 *Brookfield*, at 1066.

37 *Id.*

38 *Id.*

39 *Id.*

40 Carl S. Kaplan, *Case Against Playboy Model Could Set Precedent*, (visited Apr. 30, 1999) Cyber L. J., N. Y. Times, (quoting Michael J. Plonsker, lawyer representing Terri Welles).

41 *Brookfield*, at 1066. (“The term ‘MovieBuff’ is not in the dictionary. . . . Nor has that term been used in any published federal or state court opinion.”).

Playboy bunny logo, she inserted disclaimers which clearly state that the website is not endorsed by [Playboy],⁴² and the font is distinguishable from Playboy's. These factors seemed to impress the court with evidence of good faith, and subsequent decisions may follow similar analysis. Third, indexing a Web site with metatags is allowable and encouraged, but the good-faith and nondeception requirements discussed earlier cannot be ignored. This can be accomplished by indexing a larger portion of the Web site's content and by increasing the content of the Web site itself. Finally, some commentators believe that *Brookfield* allows the use of trademarks in metatags to refer to comparative advertising in most situations, even if deceptive. Ironically, the Internet community might even eventually benefit from this behavior. Inevitably, someone will test the rule, and a subsequent interpretation of *Brookfield* may add some clarity to the subject.

Final Thoughts

Trademark law is alive and well on the World Wide Web, at least in the metatag context. The *Brookfield* court protects trademarks from deceptive use in metatags. The *Brookfield* panel did not intend, as some may argue, to label a deceptive reference to comparative advertising in metatags as fair use. If allowable, the effect would contradict the court's analysis based on initial-interest confusion, good-faith description, and fair use in comparative advertising. At the same time, *Brookfield* does not mean the end of metatag use on the Internet. Legal guidelines for metatag use have been outlined by the

1999 Intellectual Property Section Essay Contest Winners

- First prize of \$500 was awarded to Clinton Todd (Northwestern School of Law of Lewis & Clark College) for his essay entitled "To Tag or Not to Tag - That Is the (Meta) Question,"
- Second prize of \$300 was awarded to Nicole Bernadette Markey (University of Oregon) for her essay entitled "Did Negativland Get a Raw Deal?: Music Sampling Under Copyright Law,"
- Third prize of \$200 was awarded to Ryan S. Hilbert (Santa Clara University) for his essay entitled "Peculiar Procedure or Practitioners' Panacea: An Analysis of the Community Trademark System."

Brookfield and *Welles* courts and many avenues for allowable use remain.

On another note, while the *Brookfield* decision is timely now, it risks losing its teeth in the face of technology. Search engines already work in a myriad of ways, and some disregard metatags altogether.⁴³ If technology makes search engines more accurate and less dependent on metatags and text-based searching, which it most certainly will, the *Brookfield* decision will be just another ripple in the wake of ever-adapting cyberspace law. If so, another decision will take its place and provide for even more discussion.

⁴² *Welles*, 7 F. Supp. 2d. at 1104.

⁴³ "Some search engines such as Excite and Lycos generate their own descriptions of web sites while other search engines such as Alta Vista and Infoseek use an HTML tag known as the description meta tag." Scott Shipman, *Trademark and Unfair Competition in Cyberspace: Can These Laws Deter "Baiting" Practices on Web Sites?*, 39 Santa Clara L. Rev. 245, 252 (1998).

Highlights of the Oregon State Bar Intellectual Property Section Activities

- The Oregon State Bar Intellectual Property Section Annual Meeting will be held at the Riverplace Hotel on October 7, 1999. Curtis Rose from Hewlett-Packard will speak on the topic "Patent Prosecution Psychology: Examining the Examiner."
- The Intellectual Property Section sponsored an Intellectual Property Essay Contest with the goals of encouraging scholarship and generating content for the Intellectual Property Section newsletter and web site.
- From the submissions received, a first prize of \$500 was awarded to Clinton Todd (Northwestern School of Law of Lewis & Clark College) for his essay entitled "To Tag or Not to Tag - That Is the (Meta) Question," a second prize of \$300 was awarded to Nicole Bernadette Markey (University of Oregon) for her essay entitled "Did Negativland Get a Raw Deal?: Music Sampling Under Copyright Law," and a third prize of \$200 was awarded to Ryan S. Hilbert (Santa Clara University) for his essay entitled "Peculiar Procedure or Practitioners' Panacea: An Analysis of the Community Trademark System."
- Members of the Intellectual Property Section served as judges for three moot court practice rounds for the Lewis and Clark and the University of Oregon law schools preparation for the Giles S. Rich Moot Court Competition in San Francisco. The Executive Committee arranged for one practice round to be held in Judge Henry Kantor's courtroom in the Multnomah County Courthouse.
- The section provided the Lewis and Clark and the University of Oregon moot court teams with a \$500 scholarship to help with travel expenses.
- The 1999 Intellectual Property Section newsletter was prepared and distributed to section members and included the First Place entry from the Intellectual Property Section Essay Contest.
- The Intellectual Property Section provided a \$1,000 sponsorship to the Northwestern School of Law of Lewis and Clark College Second Annual Conference on Intellectual Property in the Global Market Place.
- Intellectual Property Section Chair Bennet Langlotz attended the 1999 Oregon State Bar Convention as a voting member of the House of Delegates in the ex-officio category, generally monitoring matters with a focus on the interests of intellectual property law practitioners.
- The Intellectual Property Section Executive Committee voted that henceforth it shall be a responsibility of the Chair to attend the Oregon State Bar Convention, and that the section shall reimburse the Chair's expenses for his attendance.
- The Intellectual Property Section discussed improvements to the Section's page on the Oregon State Bar's Web site, including adding content such as job openings at local patent firms and IP-related openings at other firms/businesses, the winning essay in the writing contest sponsored by the Section, an entry form and other information for the next contest, and an online version of the Section's newsletter. The Section is considering bids from two local Web site designers and Internet Service Providers and plans to place the improved Web site at its own domain name and link it into the frames at the Bar's Web site.

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