

RECONSIDERING INITIAL INTEREST CONFUSION ON THE INTERNET

*By David M. Klein and
Daniel C. Glazer**

I. INTRODUCTION

Courts developed the theory of initial interest confusion (or “pre-sale confusion”) to address the unauthorized use of a trademark in a manner that captures consumer attention, even though no sale is ultimately completed as a result of any initial confusion. During the last few years, the initial interest confusion doctrine has become a tool frequently used to resolve Internet-related disputes.¹ Indeed, some courts have characterized initial interest confusion on the Internet as a “distinct harm, separately actionable under the Lanham Act.”²

This article considers whether the initial interest confusion doctrine is necessary in the context of the Internet. Courts typically have found actionable initial interest confusion when Internet users, seeking a trademark owner’s website, are diverted by identical or confusingly similar domain names to websites in competition with, or critical of, the trademark owner. A careful analysis of these decisions, however, leads to the conclusion that a distinct initial interest confusion theory may be unnecessary to resolve cases involving the unauthorized use of a trademark as a domain name. In fact, traditional notions of trademark infringement law and multi-factor likelihood of confusion tests may adequately address the balancing of interests required in cases where courts must define the boundaries of trademark owners’ protection against the use of their marks in the domain names of competing websites. The Federal Trademark Dilution Act (FTDA)³ and the Anticybersquatting Consumer Protection Act (ACPA)⁴

* Mr. Klein is a partner in the firm of Paul, Hastings, Janofsky & Walker LLP, New York, New York, Associate Member of the International Trademark Association. Mr. Glazer is a partner in the firm of Patterson Belknap Webb & Tyler LLP, New York, New York, Associate Member of the International Trademark Association. The views expressed by the authors herein do not necessarily reflect the views of either Paul, Hastings, Janofsky & Walker LLP or Patterson Belknap Webb & Tyler LLP.

1. See *Golden W. Fin. v. WMA Mortgage Servs.*, No. C-02-05727 (CRB), 2003 WL 1343019, at *6 (N.D. Cal. Mar. 13, 2003) (stating that initial interest confusion is a “brand of confusion particularly applicable to the Internet.”) (quoting *Playboy Enters., Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070, 1074 (C.D. Cal. 1999)).

2. *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120, 1124 n.2 (N.D. Cal. 2003).

3. 15 U.S.C. § 1125(c) (2003).

4. 15 U.S.C. § 1125(d) (2003).

provide additional protection against the unauthorized use of domain names that dilute famous marks or evidence a bad faith intent to harm trademark owners or the goodwill of their marks.

This article also reviews the development of the initial interest confusion doctrine in cases involving the unauthorized use of a trademark in the searchable code (or “metatags”) of a website. While many courts have held that such use can create actionable initial interest confusion by causing Internet search engines to list a hyperlink to the unauthorized user’s website among the results generated by an Internet user’s search engine query for the trademark, the initial interest confusion doctrine may be inapplicable in the metatag context because such unauthorized use, without more, does not appear to give rise to any of the harms that courts historically have used the doctrine to address. Unless infringing domain names or website content are used, the inclusion of a hyperlink to a website in a list of search engine results does not necessarily mislead consumers as to the source of the website they access, unintentionally divert consumers to the website against their will, or cause consumers to accord the website undue credibility. In fact, the Internet has evolved in such a manner that the Ninth Circuit recently criticized Internet search engine results as being “largely irrelevant.”⁵ Further, the conclusion that the initial interest confusion doctrine should not be applied in the metatag context is consistent with the Supreme Court’s reasoning in *Moseley v. V Secret Catalogue, Inc.*,⁶ which suggests that a finding of liability requires some identifiable harm to the consumer or the trademark owner (in the form of likelihood of confusion), or to the mark itself (if deemed to be a famous mark for purposes of the FTDA).

II. ORIGINS OF THE INITIAL INTEREST CONFUSION DOCTRINE

The test for trademark infringement typically focuses on the likelihood of confusion at the point of sale, i.e., the likelihood that a consumer will be misled by the unauthorized use of a trademark and purchase goods or services sold by someone other than the trademark owner.⁷ By contrast, initial interest confusion, although dispelled prior to the point of sale, allows a competitor to “get its

5. *Interstellar Starship Servs., Ltd. v. EPIX, Inc.*, 304 F.3d 936, 945 n.10 (9th Cir. 2002).

6. 123 S. Ct. 1115 (2003).

7. See generally, 3 J. Thomas McCarthy, *McCarthy on Trademarks and Unfair Competition*, § 23:5 at 23-17 (4th ed. 2002) (“The most common and widely recognized type of confusion that creates infringement is purchaser confusion of source which occurs at the time of purchase: point of sale confusion.”).

foot in the door” with consumers seeking to purchase goods and services sold by both the competitor and the trademark owner.⁸

The Second Circuit’s seminal decision in *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*⁹ provided the model for analyzing initial interest confusion. The Second Circuit found that the use of GROTRIAN-STEINWEG in connection with pianos infringed the STEINWAY & SONS mark, even though it was unlikely consumers would purchase a GROTRIAN-STEINWEG piano under the mistaken belief it was a STEINWAY & SONS piano.¹⁰ The actionable harm was that consumers likely would believe, at least initially, that GROTRIAN-STEINWEG was affiliated with the owner of STEINWAY & SONS and consider purchasing GROTRIAN-STEINWEG pianos on that basis.¹¹

Subsequent decisions applying the initial interest confusion doctrine have observed that initial interest confusion manifests itself in three ways: (i) the diversion of the prospective customer’s initial purchase interest; (ii) the potential effect of that diversion on the customer’s ultimate purchasing decision caused by an erroneous impression that the goods and services of the junior user of the trademark are associated with the trademark owner’s goods and services; and (iii) the initial credibility the customer may accord to the junior user’s goods and services as a result of the reputation and goodwill of the trademark owner in its mark.¹² This harm is not cured by the consumer’s investigation prior to or at the

8. See, e.g., *Syndicate Sales, Inc. v. Hampshire Paper Corp.*, 192 F.3d 633, 638 (7th Cir. 1999) (“Such ‘bait and switch,’ also known as ‘initial interest’ confusion, will affect the buying decisions of the consumers when it permits the competitor to ‘get its foot in the door’ by confusing the consumers”); see also 3 *McCarthy*, supra note 7, § 23:6 at 23-26 (comparing initial interest confusion to a jobseeker who misrepresents his educational background on his resume to obtain an interview; the misrepresentation causes competitive damage by giving the jobseeker “a clear advantage over others with the same background who honestly stated their educational achievements on their resumes.”).

9. 523 F.2d 1331 (2d Cir. 1975).

10. *Id.* at 1342.

11. *Id.*

12. *BigStar Entm’t, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 207 (S.D.N.Y. 2000) (citing *Brookfield Communications, Inc. v. West Coast Entm’t Corp.*, 174 F.3d 1036, 1063-64 (9th Cir. 1999)).

Most, but not all, judicial circuits recognize the initial interest confusion doctrine. See, e.g., *Grotrian*, 523 F.2d at 1341-42 (2d Cir. 1975); *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 294 (3d Cir. 2001); *Elvis Presley Enters. Inc. v. Capece*, 141 F.3d 188, 204 (5th Cir. 1998); *PACCAR Inc. v. TeleScan Techs., LLC*, 319 F.3d 243, 253 (6th Cir. 2003); *Syndicate Sales*, 192 F.3d at 638 (7th Cir. 1999); *Brookfield*, 174 F.3d at 1063 (9th Cir. 1999); but see *N. Light Tech., Inc. v. N. Lights Club*, 97 F. Supp. 2d 96, 113 (D. Mass. 2000) (“initial confusion . . . is not cognizable under trademark law in the First Circuit.”) (citing, inter alia, *Astra Pharm. Prods. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207 (1st Cir. 1983)), *aff’d*, 236 F.3d 57 (1st Cir. 2001), cert. denied, 533 U.S. 911 (2001).

point of sale that reveals no connection between the trademark owner and the infringer.¹³

Despite the non-traditional nature of the doctrine, courts generally have analyzed non-Internet initial interest confusion cases by utilizing the same multi-factor test used for evaluating likelihood of confusion at the point of sale.¹⁴ For example, in *Mobil Oil Corp. v. Pegasus Petroleum Corp.*,¹⁵ the court considered initial interest confusion in connection with the “actual confusion” and “sophistication of purchasers” prongs of the Second Circuit’s traditional “Polaroid” likelihood of confusion test.¹⁶ The Mobil court deemed the likelihood that the defendant “would gain crucial credibility during the initial phases of a deal” to be probative of the existence of actual confusion between the plaintiff’s and defendant’s marks.¹⁷ The fact that the defendant’s customers were sophisticated oil traders was not dispositive, because such sophistication would not prevent potential purchasers from being “misled into an initial interest” in the defendant’s business.¹⁸ Under that analysis, the likelihood of confusion test remains the same irrespective of whether the harm occurs pre-sale or at the point of sale.

13. See, e.g., *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 464 (7th Cir. 2000) (initial interest confusion is actionable “even though the consumer realizes the true identity and origin of the product before consummating a purchase.”); *McNeil-PPC, Inc. v. Guardian Drug Co., Inc.*, 984 F. Supp. 1066, 1074 (E.D. Mich. 1997) (“Even if the consumer realizes that the Arbor product is not the same as the national brand once he picks the product up off the shelf and reads the label, Defendant has already accomplished what it set out to do, which is to confuse the consumer at the point when he first reaches for the product on the shelf. It is at that point that the damage is done.”).

14. See, e.g., *Checkpoint*, 269 F.3d at 297 (the significance of initial interest confusion will vary from case to case and “courts should employ all the relevant [likelihood of confusion] factors and weigh each factor to determine whether in the totality of the circumstances marketplace confusion is likely.”). The multi-factor test for likelihood of confusion varies from circuit to circuit. The Second Circuit’s test considers: (i) the strength of the plaintiff’s mark, (ii) the similarity between the plaintiff’s and defendant’s marks, (iii) the competitive proximity of the two parties’ products in the marketplace, (iv) the likelihood that the plaintiff will “bridge the gap” and offer a product like the defendant’s, (v) actual confusion between the products among consumers, (vi) the defendant’s good faith (or lack thereof) in adopting its mark, (vii) the quality of the defendant’s product sold under the mark as compared to the plaintiff’s, and (viii) the sophistication of the relevant group of consumers. *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492, 495 (2d Cir. 1961).

15. 818 F.2d 254, 259-60 (2d Cir. 1987).

16. *Mobil*, 818 F.2d at 259-60 (citing *Polaroid*, 287 F.2d at 495).

17. *Id.* at 259.

18. *Id.* at 260; see also *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1405 (9th Cir. 1997) (considering initial interest confusion under the sixth factor of the Ninth Circuit’s likelihood of confusion test, i.e., the factor addressing the type of goods and degree of care to be exercised by the purchasers, and suggesting that defendant’s use of plaintiff’s mark would capture “initial consumer attention” regardless of the degree of care).

III. INITIAL INTEREST CONFUSION ON THE INTERNET—DOMAIN NAME CASES

A. Commercial Websites

1. Development of the Initial Interest Confusion Doctrine

Courts have widely embraced the initial interest confusion doctrine as well-suited to addressing the unauthorized use of another's trademark as a domain name for a website promoting or offering for sale products or services.¹⁹ Typically, courts have found actionable initial interest confusion “when customers seeking a particular website are diverted by allegedly infringing domain names . . . to a competing website and then realize that the site they have accessed is not the one they were looking for.”²⁰

For example, in *Victoria's Secret Stores v. Artco Equipment Co.*,²¹ the district court found that the defendant's sale of lingerie at a website under the domain name *victoriasscrets.net* created initial interest confusion with plaintiff's VICTORIA'S SECRET mark.²² In dismissing the defendant's arguments that consumers would not actually be confused once they accessed the website, the court observed that “[t]he use of a mark which misdirects consumers to a competitor's goods constitutes infringement, even if consumers later dispel confusion on their own power or with the assistance of a disclaimer.”²³

In *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,²⁴ one of the first reported cases to expressly apply the initial interest confusion doctrine in the context of the Internet (albeit in the context of metatags rather than domain names), the Ninth Circuit observed that “applying the law in the Internet context . . . require[s] a flexible approach.”²⁵ In fact, courts appear to have heeded the Ninth Circuit's admonition and have not adopted a uniform approach to applying an initial interest confusion analysis in cases involving domain names.

Some courts have followed the approach historically taken by courts in the non-Internet context and considered initial interest confusion resulting from the unauthorized use of a trademark as a domain name within one or more of the several factors in

19. Initial interest confusion in the context of parody and criticism websites is discussed *infra* Section III(B).

20. *Caterpillar Inc. v. Telescan Techs., LLC*, No. 00-1111, 2002 WL 1301304, at *4 (C.D. Ill. Feb. 13, 2002) (quoting *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029, 1043-44 (N.D. Ill. 2001)).

21. 194 F. Supp. 2d 704 (S.D. Ohio 2002).

22. *Id.* at 728-29.

23. *Id.* at 729.

24. 174 F.3d 1036 (9th Cir. 1999).

25. *Id.* at 1054.

traditional tests for likelihood of confusion.²⁶ For example, in *Trans Union LLC v. Credit Research, Inc.*,²⁷ a case where the court found no evidence of actual confusion for purposes of its multi-factor likelihood of confusion analysis, the court instead considered the likelihood that consumers would go to the defendant's website, www.transunioncredit.com, looking for the plaintiff Trans Union LLC.²⁸

Other courts have concluded that domain name-related initial interest confusion results in a harm different from traditional infringement, for which the standard likelihood of confusion test is inappropriate or insufficient. After attempting to apply the Third Circuit's traditional test for likelihood of confusion, the district court in *Chatam International, Inc. v. Bodum, Inc.*,²⁹ determined that such analysis, "while instructive, is not itself enough" to resolve initial interest confusion cases involving domain names.³⁰ The court noted that certain of the traditional likelihood of confusion factors, such as the similarity of the plaintiff's and defendant's channels of trade, are "distorted by the modality of the Internet."³¹ Further, the court observed that the likelihood of confusion test does not attempt to resolve the resulting confusion where there are two legitimate owners of the same mark, but only one owns the corresponding domain name.³² As a result, the court concluded, "[i]nitial interest confusion, factually and legally, is the gravamen of this case and of the broader problems presented by the exclusivity of domain names."³³ The Chatam court instead focused primarily on whether the plaintiff's and defendant's goods competed in the marketplace.³⁴

Similarly, the court in *New York State Society of Certified Public Accountants v. Eric Louis Associates, Inc.*³⁵ not only held

26. See, e.g., *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029, 1043-44 (N.D. Ill. 2001) (discussing initial interest confusion within the "actual confusion" factor of likelihood of confusion test); *PACCAR Inc. v. Telescan Techs., LLC*, 319 F.3d 243, 253-54 (6th Cir. 2003) (finding initial interest confusion relevant to similarity of marketing channels and "customer care" factors).

27. 142 F. Supp. 2d at 1043-44.

28. *Id.*

29. 157 F. Supp. 2d 549 (E.D. Pa. 2001), *aff'd*, No. 01-3422, 2002 WL 1589923 (3d Cir. July 19, 2002).

30. *Id.* at 557.

31. *Id.* at 556.

32. *Id.* at 557.

33. *Id.*

34. *Id.* at 558-59. Despite the Chatam court's express statement that the Third Circuit's multi-factor likelihood of confusion test was insufficient to resolve the case, the court's initial interest confusion analysis focused on some of the key considerations of the traditional likelihood of confusion test, i.e., the similarity of the parties' goods and their competitive proximity. *Id.*

35. 79 F. Supp. 2d 331 (S.D.N.Y. 1999).

that the defendant's use of the plaintiff's trademark as its domain name created a likelihood of confusion under the Second Circuit's multi-factor Polaroid test, but also found, despite the presence of a disclaimer at the defendant's website, that the defendant's conduct "caused a likelihood of confusion because it created initial interest confusion."³⁶ The court stated that initial interest confusion warrants such distinct treatment "because it does not fit neatly within any of the eight Polaroid factors."³⁷

A third approach taken in domain name cases is to apply the traditional likelihood of confusion test in its entirety to find initial interest confusion, which is "a distinct harm, separately actionable under the Lanham Act."³⁸ The Ninth Circuit thoroughly discussed this approach in *Interstellar Starship Services, Ltd. v. EPIX, Inc.*,³⁹ concluding that while "actionable initial interest confusion on the Internet is determined, in large part, by the relatedness of the goods offered and the level of care exercised by the consumer . . . the remainder of the Sleekcraft [likelihood of confusion] factors complete the case-by-case inquiry necessary to evaluate initial interest confusion on the Internet."⁴⁰

2. The Redundancy of the Initial Interest Confusion Doctrine

(a) *Infringement*

(1) *Competing Goods and Services*

Although consumers potentially may be diverted by any unauthorized use of another's trademark as a domain name, courts typically find actionable initial interest confusion only where the goods or services available at the junior user's website are related to, or competitive with, the trademark owner's goods or services.⁴¹

36. *Id.* at 342.

37. *Id.*; see also *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000) (same); *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1120 (D. Minn. 2000) (declining to apply initial interest confusion doctrine where defendant did not stand to "materially or financially gain from said initial confusion by trading in on the value of plaintiff's mark to initially attract customers").

38. *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120, 1123 n.2 (N.D. Cal. 2003).

39. 304 F.3d 936 (9th Cir. 2002).

40. *Id.* at 945 (citing *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 296-97 (3d Cir. 2001)); *BigStar Entm't, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 207 (S.D.N.Y. 2000) (an analysis of initial interest confusion in a domain name case "rest[s] on the same Polaroid [likelihood of confusion] factors which guide[] the appraisal of other recognized forms of trademark infringement confusion").

41. See, e.g., *The Network Network v. CBS, Inc.*, 54 U.S.P.Q.2d 1150, 1170 (C.D. Cal. 2000) ("Dissimilarity of goods and services resolves the initial interest confusion question."); see also *BigStar*, 105 F. Supp. 2d at 209-10 (initial interest confusion "presumably would not arise, or would be minimized, in circumstances where the products in question are used for substantially different purposes and therefore the merchants are not in close competitive proximity"); *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001) ("[I]nitial

The mere diversion of consumers is not actionable. Rather, the trademark owner must suffer some resulting competitive harm, such as a likelihood that consumers will purchase goods from the junior user's website instead of from the trademark owner.⁴² Otherwise, all trademarks, regardless of their distinctiveness and fame, would be granted dilution-like protection against all commercial uses on the Internet.⁴³

The Ninth Circuit in *Interstellar* used APPLE as an example of the need to limit the initial interest confusion doctrine in the Internet context, observing that the doctrine likely does not allow APPLE computers to bar a hypothetical apple grower in Washington from maintaining a website under the domain name www.apple.com.⁴⁴ Not only is the apple grower using the term "apple" in a generic or descriptive sense to accurately convey the contents of its website, but it also is highly unlikely that a consumer ultimately will abandon his intended visit to the website for APPLE computers simply because he stopped along the way at an apple grower's website. As the district court observed in *The Network Network v. CBS, Inc.*, a case involving the cable television channel The Nashville Network and a computer consulting company called The Network Network, "[u]nlikely indeed is the hapless Internet searcher who, unable to find information on the schedule of upcoming NASCAR broadcasts or 'Dukes of Hazzard' reruns, decides to give up and purchase a computer network maintenance seminar instead."⁴⁵ Such diversions are an inevitable result of doing business under a common word like APPLE and not necessarily evidence of actionable confusion.⁴⁶

interest confusion is of greatest concern when products are in competition with each other . . . [w]here companies are non-competitors, initial interest confusion does not have the same consequence.") (citing *Chatam Int'l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 558 (E.D. Pa. 2001)).

42. See, e.g., *Interstellar*, 304 F.3d at 945 (actionable initial interest confusion would result if "a rogue company adopts as its domain name a protected trademark and proceeds to sell goods similar to those offered by the trademark owner, [because] it necessarily free rides on the trademark owner's goodwill").

43. See *id.* at 943 ("[A]s a matter of law, all uses of www.epix.com do not generate initial interest confusion with the EPIX mark."); but see *People for Ethical Treatment of Animals, Inc. v. Doughney*, 113 F. Supp. 2d 915, 919-20 (E.D. Va. 2000) (identically copying another's trademark as a domain name "creates a presumption of likelihood of confusion among internet users as a matter of law"), *aff'd*, 263 F.3d 359 (4th Cir. 2001).

44. *Interstellar*, 304 F.3d at 944.

45. *The Network Network*, 54 U.S.P.Q.3d at 1170; see also *Strick*, 162 F. Supp. 2d at 377 ("Internet surfers are inured to the false starts and excursions awaiting them and are unlikely to be dissuaded or unnerved when, after taking a stab at what they think is the most likely domain name for a particular web site guess wrong and bring up another's web page.") (citations omitted).

46. See *The Network Network*, 54 U.S.P.Q.2d at 1166 ("There is a difference between inadvertently landing on a website and being confused. Thousands of Internet users everyday take a stab at what they think is the most likely domain name for a particular

The Ninth Circuit surmised, however, that actionable initial interest confusion inevitably would result from the hypothetical apple grower's expansion of its www.apple.com website to include the sale of computers.⁴⁷ Even if consumers accessing the apple grower's website never erroneously believe that the apple grower is affiliated with APPLE computers, they may decide to buy a computer from the apple grower rather than an APPLE computer.⁴⁸ Such direct competition with APPLE computers unfairly trades on the goodwill that APPLE developed in connection with computers, while simultaneously denying Apple Computer the opportunity to sell computers under the www.apple.com domain name.⁴⁹

Although APPLE is a strong mark for computers, only one party can own and maintain a website at www.apple.com. This is one of the significant differences between the Internet and non-Internet marketplaces, i.e., different companies often sell unrelated goods under the same trademark, but only one party can own and transact business under a given domain name. The inevitable result is that consumers often will access websites other than those they initially intend to access. The question is when is such a diversion actionable. Because www.apple.com is certain to attract consumers looking for apples and computers, how can courts discern which diversions cause confusion and which do not?

As suggested by the reasoning of *Interstellar*, the common sense approach is that an apple grower should not be held liable for owning and selling apples under the domain name www.apple.com, but should be prohibited from selling computers at www.apple.com. Although Apple Computer likely would not be happy that the apple grower transacts business at www.apple.com, selling apples under a domain name incorporating the generic name for the grower's product certainly cannot be deemed to be an "unfair practice" from which infringement law is intended to

website . . . [and] it is inevitable that consumers will often guess wrong. . . . [T]he fact that aficionados of The Nashville Network may initially type 'tnn.com' into their browsers in the hope of locating Grand Ole Opry programming information does not, standing alone, demonstrate confusion."); Strick, 162 F. Supp. 2d at 377 ("[A]ny confusion that a consumer may have when reaching Defendant's web page rather than Plaintiff's site is not legally cognizable."); see also *Simon Prop. Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1047 (S.D. Ind. 2000) ("SPG does not and could not claim to have exclusive rights to the name 'Simon' on the Internet. A user who is equally confused by mySimon, by 'Simonsays,' and by other Simon sites does not show legally relevant confusion.").

47. *Interstellar*, 304 F.3d at 944.

48. *Id.*

49. *Id.* As the court explained, "[i]f a rogue company adopts as its domain name a protected trademark and proceeds to sell goods similar to those offered by the trademark owner, it necessarily free rides on the trademark owner's goodwill"). *Id.* at 945.

protect trademark owners.⁵⁰ However, hindering Apple Computer's ability to control the goodwill of its mark with respect to computers is just as clearly unfair competition. The apple grower has every right to use the term "apple," as long as he does not do so in a manner that takes unfair advantage of the computer company's goodwill in APPLE.

In most cases, many different factors must be considered to determine who may use another's trademark as a domain name. For example, even though many consumers may go to United Airlines' website www.united.com seeking information about United Van Lines, it is highly unlikely that United would prevail on an initial interest confusion theory. These two well-known companies operate disparate businesses, have coexisted for decades, and UNITED is an inherently weak mark. Even though only one of them can conduct business at www.united.com, the likely outcome of a dispute between the two parties is that ownership and use of the domain name is on a first-come, first-served basis. But an entirely different analysis could result if a hypothetical start-up competitor of United Van Lines calling itself UNITED STATES VAN LINES maintained a website at www.united.com.

(2) Traditional Likelihood of Confusion

Applying the initial interest confusion doctrine in cases between competitors is duplicative and unnecessarily complicates the analysis. The various circuits developed likelihood of confusion tests to address precisely the sort of balancing of interests needed when courts must define the boundaries of trademark owners' protectable rights in their marks as domain names. As *Interstellar* made clear, despite the unique nature of the Internet, "the different legal outcomes . . . are predicted by the *Sleekcraft* factors."⁵¹ Except in the case of famous, fanciful marks protected under dilution law, trademark owners cannot make exclusive claims to their marks across all fields of goods and services.⁵²

In fact, several courts found traditional concepts of likelihood of confusion sufficient to resolve domain name cases prior to the introduction of the initial interest confusion doctrine in the Internet context. For example, although the Ninth Circuit in *Brookfield* applied the initial interest confusion doctrine to a metatag dispute, it utilized the traditional test for likelihood of confusion to resolve the domain name issues, stating that "[w]hen

50. See *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1122 (2003) ("Infringement law protects . . . producers from unfair practices by an 'imitating competitor.'") (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)).

51. *Interstellar*, 304 F.3d at 944.

52. See discussion of the FTDA, *infra* Section III(A)(2)(b).

a firm uses a competitor's trademark in the domain name of its website, users are likely to be confused as to its source or sponsorship."⁵³ The district court in *Green Products Co. v. Independence Corn By-Products Co.*⁵⁴ resolved a similar domain name dispute between competitors using a traditional infringement analysis.⁵⁵ The court observed that a domain name is like a sign outside a store owned by the domain name owner: if the store falsely represents that the trademark owner's goods are inside, there is a likelihood of confusion as to affiliation, source or sponsorship that harms the consumer and the trademark owner.⁵⁶

Relying on the traditional likelihood of confusion test in domain name cases involving competitors is consistent with the goals of infringement law reaffirmed by the Supreme Court in *Moseley v. V Secret Catalogue, Inc.*, i.e., to "protect[] consumers from being misled by the use of infringing marks and also protect[] producers from unfair practices by an 'imitating competitor.'"⁵⁷ Even though consumers may be "misled" by the unauthorized use of a trademark as a domain name, the diversion only is actionable where the domain name is an "infringing mark." Similarly, the use of another's mark as a domain name is only "unfair" when "imitating competitors" obtain the benefits of the trademark owner's goodwill and harm the trademark's ability to designate a single source of goods and services. Resolving these issues requires the application of traditional concepts of likelihood of confusion. The introduction of the initial interest confusion doctrine in domain name cases merely diverts judicial focus from the proper analysis.

Furthermore, characterizing the harm present in domain name cases as "initial interest confusion" arguably is a misnomer. The initial interest confusion doctrine as developed in non-Internet cases makes actionable the increased possibility of additional sales being made by the infringer, and lost by the trademark owner, as a result of the infringer's misappropriation of the trademark owner's goodwill. In some respects, that additional patronage actually occurs in the Internet setting because the consumer's visit to the

53. *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999).

54. 992 F. Supp. 1070 (N.D. Iowa 1997).

55. *Id.* at 1075.

56. *Id.* at 1077-78; see also *Playboy Enters. v. Asiafocus Int'l, Inc.*, No. CIV.A.97-734-A, 1998 WL 724000, at *3 (E.D. Va. Apr. 10, 1998) (applying traditional multi-factor test to find likelihood of confusion, where defendant used variations of plaintiff's well known PLAYMATE trademark as the domain names for various websites competitive with plaintiff's men's entertainment business).

57. 123 S. Ct. at 1122 (citing *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163-64 (1995)).

website is, in and of itself, akin to a “point of sale” at which there may be a likelihood of confusion.⁵⁸

The traditional likelihood of confusion test adequately defines the trademark owner’s scope of protection with respect to the unauthorized use of its mark as a domain name by competitors. The trademark owner is entitled to the Internet traffic to the junior user’s website when the likelihood of confusion factors weigh in its favor. In such instances, consumers might not continue on to the trademark owner’s website, and the junior user will be unjustly enriched at the expense of the trademark owner. By contrast, where the likelihood of confusion factors weigh in the junior user’s favor—typically, where the goods and services are dissimilar and non-competitive—consumers are not likely to abandon their quest for the trademark owner’s website following a visit to the junior user’s website. Unless the trademark owner is entitled to protection in the absence of a likelihood of confusion (as in the case of famous marks entitled to dilution protection), or

58. For example, in *Nissan Motor Co. v. Nissan Computer Corp.*, 89 F. Supp. 2d 1154, 1164 (C.D. Cal. 2000), *aff’d*, 246 F.3d 675 (9th Cir. 2000), over 90% of the defendant’s advertising revenue from its website at *nissan.com* was due to advertisements primarily promoting automobile-related products and services competitive with those offered by the plaintiffs. The court stated that whether or not a visitor to the defendant’s website ultimately purchased an advertiser’s automotive products, the defendant derived advertising revenue as a result of the diversion of consumers’ initial interest in the plaintiffs’ NISSAN vehicles. *Id.* In this setting, “the defendant’s ‘product’ is the exploitation of customer confusion.” *Id.*; see also *Chatam Int’l, Inc. v. Bodum Inc.*, 157 F. Supp. 2d 549, 559 (E.D. Pa. 2001) (“[T]he Internet, in its presently exclusive construct, is itself a form of product.”), *aff’d*, No. 01-3422, 2002 WL 1589923 (3d Cir. July 19, 2002). The Nissan court applied a traditional multi-factor likelihood of confusion analysis and ruled that plaintiffs were likely to succeed on their trademark infringement claim. *Id.*

As the Nissan court observed, many website owners are paid by sponsors based on the number of visits to the website (or “hits”), irrespective of whether the consumer purchases the owner’s goods or services. The number of hits affects advertisers’ decisions to purchase advertising on or linked to the website because a website with greater consumer exposure typically is more attractive to advertisers. See Lisa E. Cristal, *Web Abuse*, in *Trademark Law & the Internet*, 331, 348 (Lisa E. Cristal & Neal S. Greenfield eds., 2d ed. 2001) (“Frequently visited sites can simply command higher advertising fees.”). A hit also can result in a “cookie” being placed on the consumer’s computer, which gives the owner of the website or its advertisers continuing access to the consumer and, potentially, the consumer’s personal information. Such access and information gleaned from cookies can allow website owners and their advertisers to more effectively tailor websites and advertisements to consumers’ interests and needs.

Thus, the unauthorized use of a trademark owner’s domain name does not just capture “initial interest” by luring consumers to another party’s website. Rather, the consumer potentially provides the infringer with a tangible benefit that was intended for the trademark owner, even if the consumer’s confusion as to source or affiliation has dissipated before purchasing any goods and services available at the infringer’s website. The trademark owner may lose the value of the website visit to the infringer because the consumer may not bother going to the trademark owner’s website. The infringer derives this value solely by misappropriating the goodwill of the trademark owner. See *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159, 163-64 (1995) (trademark law has traditionally provided protection against the misappropriation of the financial, reputation-based rewards associated with a desirable product).

there is a showing of bad faith under the ACPA,⁵⁹ the junior user is as much entitled to the website visits as the senior trademark owner.⁶⁰

(b) FTDA

The FTDA allows the owner of a famous mark to enjoin and seek damages for another party's use of a mark that "causes dilution of the distinctive quality of the mark."⁶¹ The FTDA defines "dilution" as "the lessening of the capacity of a famous mark to identify and distinguish goods and services," regardless of the presence or absence of competition between the parties or likelihood of confusion.⁶² The legislative history of the FTDA indicates that Congress intended it to be applied in domain name cases.⁶³

Although the FTDA largely prohibits any party other than the trademark owner from conducting business under a famous mark, the nature of the Internet requires the owner of a well-known arbitrary mark like APPLE to tolerate an apple grower's sale of apples at www.apple.com.⁶⁴ By contrast, the owner of a famous fanciful mark like XEROX likely is the only party that can legitimately transact business at www.xerox.com and similar domain names.⁶⁵ The Ninth Circuit acknowledged this broad scope of protection in *Interstellar*, surmising that actionable initial interest confusion probably results from any unauthorized use of a famous fanciful mark as a domain name in connection with the sale of goods and services, because such marks describe the source of only one company's products.⁶⁶

In fact, the FTDA renders the initial interest confusion doctrine unnecessary where a famous fanciful mark is used as a domain name for a commercial website. Competition between the parties or similarity of goods and services is a prerequisite for a

59. See discussion of the ACPA, *infra* Section III(A)(2)(c).

60. See, e.g., *Interstellar Starship Servs., Ltd. v. EPIX, Inc.*, 304 F.3d 936, 945 (9th Cir. 2002) ("Like Apple Computer . . . Epix has no exclusive claim to its trademark.").

61. 15 U.S.C. § 1125(c)(1) (2003).

62. 15 U.S.C. § 1127 (2003).

63. See 141 Cong. Rec. S19312 (daily ed. Dec. 29, 1995) ("It is my hope that this antidilution statute can help stem the use of deceptive Internet addresses taken by those who are choosing marks that are associated with the products and reputations of others.") (remarks of Sen. Patrick J. Leahy (D-Vt.)). Although the FTDA has been superceded by the ACPA as the cause of action of choice for trademark owners seeking remedies against unauthorized uses of their marks as domain names, a claim under the FTDA is still appropriate where a junior user uses a famous trademark in connection with sale of goods and services on the Internet. See Neal S. Greenfield, *Trademark Dilution*, in *Trademark Law & the Internet*, *supra* note 58 at 227, 245.

64. *Interstellar*, 304 F.3d at 944; see also discussion *supra* Section III(A)(2)(a)(1).

65. *Id.* at 943-44.

66. *Id.*

finding of initial interest confusion.⁶⁷ As the court stated in *The Network Network*, “[d]issimilarity of goods and services resolves the initial interest confusion question.”⁶⁸ However, actionable dilution may be found under the FTDA regardless of the presence or absence of competition or likely confusion.⁶⁹ Thus, the FTDA is a potential cause of action when anyone but the owner of a famous fanciful mark sells goods or services under a domain name incorporating the famous mark.⁷⁰

(c) ACPA

Congress enacted the ACPA in November 1999 to address “the bad-faith and abusive registration of distinctive marks as Internet domain names with the intent to profit from the goodwill associated with such marks—a practice commonly referred to as ‘cybersquatting.’”⁷¹ One specific abuse the ACPA was intended to remedy is the misuse of domain names to intentionally divert customers to websites other than those for which they were looking, in order to gain an unfair competitive advantage by creating a likelihood of confusion.⁷² The key requirement to a finding of liability under the ACPA is that the defendant acted in bad faith, to be determined pursuant to the application of nine nonexclusive statutory factors.⁷³

67. See discussion *supra* Section III(A)(2)(a)(1).

68. *The Network Network v. CBS, Inc.*, No. CV-98-1349 NM (ANX), 2000 WL 362016, at *9 (C.D. Cal. Jan. 18, 2000).

69. 15 U.S.C. §§ 1125(c)(1), 1127 (2003); see also *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1122 (2003) (“Neither the absence of any likelihood of confusion nor the absence of competition . . . provides a defense to the statutory dilution claim.”).

70. Although the Supreme Court’s decision in *Moseley* appears to require proof of actual harm to a famous mark in order to prevail on an FTDA claim, the Court suggests that the junior user’s exact copying of the mark will be sufficient circumstantial evidence to demonstrate dilution. 123 S. Ct. at 1125. Presumably, a junior user’s transaction of business at a website under a domain name incorporating a mark identical to a famous fanciful mark (such as the *xerox.com* example discussed above) would constitute such circumstantial evidence.

71. *Sporty’s Farm LLC v. Sportsman’s Market, Inc.*, 202 F.3d 489, 495 (2d Cir. 2000) (quoting S. Rep. No. 106-140, at 4 (1999)).

72. 15 U.S.C. § 1125(d)(1)(B)(i)(V) (2003).

73. See 15 U.S.C. § 1125(d)(1)(B)(i) (2003). The nine factors to be considered are: (i) the trademark or other intellectual property rights of the person, if any, in the domain name; (ii) the extent to which the domain name consists of the legal name of the person or a name that is otherwise commonly used to identify that person; (iii) the person’s prior use, if any, of the domain name in connection with the bona fide offering of any goods or services; (iv) the person’s bona fide noncommercial or fair use of the mark in a site accessible under the domain name; (v) the person’s intent to divert consumers from the mark owner’s online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site; (vi) the person’s offer to transfer, sell, or otherwise assign the domain name to the mark owner or any third party for financial gain without having used, or having an intent to use, the domain name in the bona fide offering of any

Although courts have not required a showing of defendant's bad faith to find actionable initial interest confusion, most domain name cases resolved by means of the initial interest confusion doctrine also have found that the defendant acted in bad faith.⁷⁴ In fact, courts in some cases have found both actionable initial interest confusion and liability under the ACPA.⁷⁵ Accordingly, the ACPA likely will be sufficient to resolve many cases in which plaintiffs otherwise might consider seeking recovery for infringement under an initial interest confusion theory. This is particularly so where the plaintiff and defendant are not clearly competitors or do not sell similar goods or services, since the text of the ACPA indicates that liability is "without regard to the goods or services of the parties."⁷⁶

B. Parody and Criticism Websites

1. Development of the Initial Interest Confusion Doctrine

Courts also have used the initial interest confusion doctrine to resolve cases involving the unauthorized use of a trademark as the domain name for a website that parodies or criticizes the trademark owner. Although the use of another's trademark in a parody or as a critique generally is permitted on a website,⁷⁷ courts

goods or services, or the person's prior conduct indicating a pattern of such conduct; (vii) the person's provision of material and misleading false contact information when applying for the registration of the domain name, the person's intentional failure to maintain accurate contact information, or the person's prior conduct indicating a pattern of such conduct; (viii) the person's registration or acquisition of multiple domain names which the person knows are identical or confusingly similar to marks of others that are distinctive at the time of registration of such domain names, or dilutive of famous marks of others that are famous at the time of registration of such domain names, without regard to the goods or services of the parties; and (ix) the extent to which the mark incorporated in the person's domain name registration is or is not distinctive and famous within the meaning of the FTDA. 15 U.S.C. § 1125(d)(1)(B)(i-ix) (2003).

74. See, e.g., *New York State Soc'y of Certified Public Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d 331, 341 (S.D.N.Y. 1999) ("[T]here is ample evidence of bad faith in this case."); *Caterpillar Inc. v. Telescan Techs., LLC*, No. 00-1111, 2002 WL 1301304, at *4 (C.D. Ill. Feb. 13, 2002) (finding bad faith for purposes of granting plaintiff attorney fees under the Lanham Act); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 189 (W.D.N.Y. 2000) (discussing evidence that defendant did not act in good faith); *PACCAR Inc. v. Telescan Techs., LLC*, 319 F.3d 243, 254 (6th Cir. 2003) (finding "an intent to create the impression that the [defendant's] web sites are sponsored by or affiliated with [the plaintiff].").

75. See, e.g., *Caterpillar*, 2002 WL 1301304, at *4; *Victoria's Secret Stores v. Artco Equip. Co.*, 194 F. Supp. 2d 704, 723-24, 729 (S.D. Ohio 2002).

76. 15 U.S.C. § 1125(d)(1)(A) (2003).

77. See, e.g., *Bear Stearns Cos. v. Lavalle*, No. Civ.A. 3:00CV1900D, 2002 WL 31757771, at *5 (N.D. Tex. Dec. 3, 2002) (observing that the defendant was permitted to criticize the plaintiff on its website) (citing *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998)); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 197 (W.D.N.Y. 2000) ("Had defendant[] used a domain name other than plaintiffs' trademark . . . plaintiffs could not use the trademark laws to prevent him from criticizing The Buffalo News on his web site."); *People for Ethical Treatment of Animals v. Doughney*,

have found actionable initial interest confusion where the domain name does not convey the website's content or intent. In such instances, consumers are not likely to realize that the website is not sponsored by or affiliated with the trademark owner until they actually access the website.⁷⁸

OBH, Inc. v. Spotlight Magazine⁷⁹ demonstrates the approach many courts have taken when analyzing domain name cases involving parody websites. The defendant in OBH maintained a website under the domain name www.thebuffalonews.com that was a self-described "parody and forum for discussion" of plaintiff's newspaper, THE BUFFALO NEWS.⁸⁰ The website contained satirical and critical comments concerning THE BUFFALO NEWS, as well as hyperlinks to other news-related websites.⁸¹

In granting the plaintiff's motion for a preliminary injunction, the district court rejected the defendant's parody defense on the ground that the domain name failed to simultaneously convey the two contradictory messages required of a parody, i.e., "that it is the original, but also that it is not the original and is instead a parody."⁸² Defendant's use of the plaintiff's exact trademark as its domain name only conveyed the first message and did not indicate to consumers that defendant's website was not THE BUFFALO NEWS or affiliated with THE BUFFALO NEWS.⁸³ Only when Internet users accessed the website would they realize it was a parody, by which time the defendant already would have succeeded in diverting users from the plaintiff's website.⁸⁴ A disclaimer on the website would not alleviate the initial interest confusion, since the confusion—not the parody—enticed Internet users to go to the defendant's website.⁸⁵

263 F.3d 359, 366 (4th Cir. 2001) ("[A]n effective parody will diminish the risk of consumer confusion by conveying [only] just enough of the original design to allow the consumer to appreciate the point of the parody.") (citations omitted/alterations in original).

78. See, e.g., Doughney, 263 F.3d at 366-67 ("[A]n internet user would not realize that they were not on an official PETA web site until after they had used PETA's mark to access the web page www.peta.org.") (quoting *People for Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d 915, 921 (E.D. Va. 2000)).

79. 86 F. Supp. 2d 176.

80. *Id.* at 182.

81. *Id.* at 182-83.

82. *Id.* at 191 (quoting *Hormel Foods Corp. v. Jim Henson Prods., Inc.*, 73 F.3d 497, 503 (2d Cir. 1996)).

83. *Id.*

84. *Id.*; see also Doughney, 263 F.3d at 366 ("To the extent that an alleged parody conveys only the first message, it is not only a poor parody but also vulnerable under the trademark law, since the customer will be confused.") (citations omitted); *Morrison & Foerster LLP v. Wick*, 94 F. Supp. 2d 1125, 1134-35 (D. Colo. 2000) ("[T]he names of [defendant's] web sites produce confusion. Only by reading through the content of the sites could the user discover that the domain names are an attempt at parody.").

85. *Id.* at 190; see also *PACCAR Inc. v. TeleScan Techs., LLC*, 319 F.3d 243, 253 (6th Cir. 2003) ("A disclaimer disavowing affiliation with the trademark owner read by a

The OBH court also rejected the defendant's First Amendment defense.⁸⁶ Although the defendant had the right to use THE BUFFALO NEWS on its website to parody the plaintiff's newspaper, the defendant was not permitted to use a domain name that suggested the defendant's website was affiliated with the plaintiff's newspaper.⁸⁷ The court held that the use of another's mark as a domain name, without more, suggests that it is for the purpose of source identification, rather than to convey a constitutionally protected satirical or critical message.⁸⁸ In such instances, "trademark law generally prevails over the First Amendment."⁸⁹

Finally, the OBH court disagreed with the defendant's contention that the domain name www.thebuffalonews.com was not infringing because, as a parody, it was not used "in commerce" nor "in connection with the distribution or advertising of goods and services" for the purpose of finding trademark infringement under the Lanham Act.⁹⁰ Regardless of whether goods and services are offered for sale on a website, "the national, and even international, nature of the Internet" makes the use of another's trademark as a domain name a "use in commerce."⁹¹ Further, the court found that defendant did use its domain name in connection with the distribution or advertising of goods and services because the

consumer after reaching the web site comes too late."); *SNA, Inc. v. Array*, 51 F. Supp. 2d 542, 553 (E.D. Pa. 1999) ("[T]he relevant confusion that the domain name causes is drawing the web user to the site in the first place, and the disclaimer cannot fix that."); *aff'd sub nom., Silva v. Karlsen*, 259 F.3d 717 (3d Cir. 2001); but see *Taubman Co. v. Webfeats*, 319 F.3d 770, 777 (6th Cir. 2003) (where defendant used plaintiff's mark as the domain name for a non-competitive, uncritical website, the "website and its disclaimer actually serve to redirect lost customers to [plaintiff's] site that might otherwise be lost").

86. *Id.* at 197.

87. *Id.*

88. *Id.* at 197-98; *Morrison & Foerster*, 94 F. Supp. 2d at 1135 ("Mr. Wick's use of Morrison & Foerster's mark as the domain name for his web sites is more analogous to source identification than to a communicative message."); see also *OBH*, 86 F. Supp. 2d at 198 n.13 (citing the domain name ballysucks.com as an example of an instance "where a domain name uses a trademark [i.e., BALLY] in such a way that it is part of a communicative message") (citing *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1167 (C.D. Cal. 1998)); *Taubman*, 319 F.3d at 777 (defendant was permitted to use the critical domain name taubmansucks.com because "the First Amendment protects critical commentary when there is no confusion as to source, even when it involves the criticism of a business").

89. *Id.* at 198 (citations omitted); see also *Morrison & Foerster*, 94 F. Supp. 2d at 1135 (rejecting defendant's First Amendment defense on the grounds that "[f]ree speech rights do not extend to labeling or advertising products in a manner that conflicts with the trademark rights of others").

90. *OBH*, 86 F. Supp. 2d at 185-86 (citations omitted).

91. *Id.* at 186 (citing *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 WL 133313, at *3 (S.D.N.Y. Mar. 24, 1997), *aff'd*, 152 F.3d 920 (2d Cir. 1998)).

domain name made it more difficult for Internet users to locate plaintiff's website and obtain plaintiff's services.⁹²

Similarly, courts have held that a party using another's trademark as the domain name for a website critical of the trademark's owner must make the nature of the website clear from the domain name.⁹³ Using a domain name that is "deceptive, confusingly similar, or identical" to a trademark owned by the party being criticized creates initial interest confusion by unfairly exploiting the fact that consumers will go to the website expecting it to be affiliated with or sponsored by the trademark owner.⁹⁴ While the First Amendment permits public criticism on a website, that website's domain name cannot appropriate the criticized party's goodwill in its trademark unless accompanied by words or phrases that are "unmistakably critical."⁹⁵

2. The Redundancy of the Initial Interest Confusion Doctrine

The ACPA is a more appropriate cause of action than initial interest confusion in domain name cases involving parody or criticism websites. The ACPA's multi-factor test of bad faith best addresses the unique nature of the confusion present in parody and criticism domain name cases, i.e., that the trademark owner's

92. *Id.*; *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 365 (4th Cir. 2001) (same). The OBH court also concluded that the hyperlinks on defendants' website to other websites selling goods and services competitive with plaintiff's business rendered the defendants' use of the plaintiff's trademark "in commerce" and "in connection with the sale of goods and services." OBH, 86 F. Supp. 2d at 186; but see *Taubman*, 319 F.3d at 775 ("As long as [defendant] has no commercial links on either of his websites . . . we find no 'use in connection with the advertising' of goods and services to enjoin, and the Lanham Act cannot be properly invoked.").

93. See, e.g., *The Bear Stearns Cos. v. Lavalle*, No. Civ.A. 3:00CV1900D, 2002 WL 31757771, at *5 (N.D. Tex. Dec. 3, 2002) (permitting defendant's use of plaintiffs' mark in domain names only where critical nature of website is clear, such as *bearstearnscriminals.com*); *Bally Total Fitness Holding Corp. v. Faber*, 29 F. Supp. 2d 1161, 1167 (C.D. Cal. 1998) (permitting defendant's use of *ballysucks.com*).

94. *Bear Stearns*, 2002 WL 31757771, at *5 (citing *Morrison & Foerster*, 94 F. Supp. 2d at 1131); see also *SNA, Inc. v. Array*, 51 F. Supp. 2d 542, 552-53 (E.D. Pa. 1999) (finding "initial confusion . . . [because] Internet users expect that a site with a domain name that is a trademark is somehow related to the owner of the trademark," even if the "highly critical and mean-spirited" content of defendant's website dispels any suggestion of affiliation with plaintiff), *aff'd sub nom.*, *Silva v. Karlsen*, 259 F.3d 717 (3d Cir. 2001).

95. *Bear Stearns*, 2002 WL 31757771, at *6; see also *Nissan Motor Co. v. Nissan Computer Corp.*, 231 F. Supp. 2d 977, 980 (C.D. Cal. 2002) (stating, in a case decided under the FTDA, that "[t]he goodwill that Nissan Motor has built up in the 'Nissan' mark ensures a steady stream of visitors expecting to find Nissan Motor at *nissan.com* and *nissan.net*. Critical commentary at *nissan.com* and *nissan.net* would exploit this goodwill in order to injure Nissan Motor."); but see *Northland Ins. Cos. v. Blaylock*, 115 F. Supp. 2d 1108, 1119-21 (D. Minn. 2000) (finding no likelihood of initial interest confusion where defendant maintained website at *northlandinsurance.com* that was critical of plaintiff *Northland Insurance*).

mark is being used in a deceptive manner to divert consumers and disparage the trademark.⁹⁶ The key ACPA factor in such cases is the fifth factor, which addresses the defendant's intent to mislead or confuse consumers into accessing a website that could tarnish the goodwill represented by the trademark owner's mark.⁹⁷ In decisions before and after the enactment of the ACPA, courts typically have found an intent to mislead consumers when the domain name owner uses a trademark owner's mark, without more, as a domain name to divert consumers to a parody or criticism website.⁹⁸ Such use of the mark exceeds the boundaries of First Amendment protection and unfairly deceives consumers into accessing a website harmful to the trademark owner's goodwill.

A parody or criticism website established under a domain name identical or substantially similar to another's trademark is akin to a storefront sign bearing the store owner's trademark that masks the presence of protesters inside complaining about the store's owner. Customers unwittingly enter the store intending to

96. See 4 McCarthy, *supra* note 7, § 25:78 at 25-276-77 (observing that the fifth "bad-faith" factor under the ACPA "is intended to capture those cybersquatters who incorporate another's trademark or service mark into their domain name for the purpose of diverting web users by confusing them into thinking that the bogus web site is one sponsored by the owner of the trademark or service mark").

97. See 15 U.S.C. § 1125(d)(1)(B)(i)(V) (2003) (stating that a court may consider "the person's intent to divert consumers from the mark owner's online location to a site accessible under the domain name that could harm the goodwill represented by the mark, either for commercial gain or with the intent to tarnish or disparage the mark, by creating a likelihood of confusion as to the source, sponsorship, affiliation, or endorsement of the site"); see also 4 McCarthy, *supra* note 7, at 25-277-78 ("This factor embodies the traditional rule of trademark law that when there is proof that the junior user has done something to intentionally divert or confuse customers, the courts will use this, either via a presumption or as relevant evidence, that defendant was successful and that a likelihood of confusion exists."); H.R. Rep. No. 106-412 at 12 (1999) ("Under this provision, a court may give appropriate weight to evidence that a domain name registrant intended to confuse or deceive the public in this manner when making a determination of bad faith intent.").

98. See, e.g., *Planned Parenthood Fed'n of Am., Inc. v. Bucci*, No. 97 Civ. 0629 (KMW), 1997 WL 133313, at *9 (S.D.N.Y. Mar. 24, 1997) (evidence indicated that "defendant chose his domain name and homepage with full knowledge and intent that some Internet users seeking to find plaintiff's homepage would instead encounter his"), *aff'd*, 152 F.3d 920 (2d Cir. 1998); *Jews for Jesus v. Brodsky*, 993 F. Supp. 282, 304 (D.N.J. 1998) ("[T]he actions by the Defendant were willful and undertaken in bad faith, with full knowledge of and the intent to cause confusion."), *aff'd*, 159 F.3d 1351 (3d Cir. 1998); *OBH*, 86 F. Supp. 2d at 189 (finding evidence of bad faith where defendants adopted domain name "with full knowledge and intent that some Internet users seeking to find plaintiffs' web site would instead be tricked into encountering [defendants'] web site"); *People for Ethical Treatment of Animals v. Doughney*, 113 F. Supp. 2d at 920 (finding likelihood of confusion and bad faith for purposes of ACPA where defendant "clearly intended to confuse, mislead and divert internet users into accessing his web site which contained information antithetical and therefore harmful to the goodwill represented by the [plaintiff's mark]"); *Morrison & Foerster*, 94 F. Supp. 2d at 1132 (finding violation of ACPA where defendant's use of plaintiff's mark as a domain name for a parody website "demonstrates his intent to divert customers from [plaintiff's] online location"); *Caterpillar Inc. v. Telescan Techs., LLC*, No. 00-1111, 2002 WL 1301304, at *4 (C.D. Ill. Feb. 13, 2002) (finding actionable initial interest confusion and bad faith for purposes of ACPA liability).

purchase the store owner's goods, only to be confronted by criticism of the store owner's business practices. Because the customers already have accessed the website, i.e., are inside the store, they are a captive audience deprived, at least initially, of their free choice to decide whether to patronize the store or listen to protesters criticizing the store's owner. Although the First Amendment permits such criticism, it also allows the store's owner to maintain control over the shopping environment he establishes for his customers and prevent protesters from expressing themselves on his private property.

By contrast, domain names conveying critical messages, such as www.ballysucks.com or www.bearstearnscriminals.com, are like protesters expressing their views on public property outside the store.⁹⁹ In such instances, customers can choose of their own free will whether to remain outside and listen to the protesters or go inside the store and shop. Although the store's owner must respect the protesters' rights to express themselves, he retains control over the shopping environment provided in his store for his customers.

Despite the consumer's deception and the trademark owner's loss of control over its goodwill, the nature of the harm resulting from domain names for parody and criticisms websites is outside the scope of protection historically provided by the initial interest confusion doctrine. Although the unauthorized use of the trademark owner's mark as a domain name diverts consumer attention, the diversion is intended to convey a message regarding the trademark owner, rather than to compete with him in the marketplace.¹⁰⁰ The multi-factor likelihood of confusion test also is not entirely appropriate in this context to analyze the potential harm to the trademark owner. For example, there is no similarity of goods and services, because only the trademark owner's goods and services are at issue.

Of course, many websites critical of the trademark owner also compete with the trademark owner, either by offering for sale the website owner's goods or services or by providing hyperlinks to websites maintained by the trademark owner's competitors.¹⁰¹ It is not necessary to apply the initial interest confusion doctrine in such instances, although some courts have done so.¹⁰² If the

99. See Taubman, 319 F.3d at 778 ("The rooftops of our past have evolved into the [I]nternet domain names of our present. We find that the domain name [taubmansucks.com] is a type of public expression, no different in scope than a billboard or a pulpit.").

100. See *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001) ("[I]nitial interest confusion is of greatest concern when products are in competition with each other . . . [w]here companies are non-competitors, initial interest confusion does not have the same consequence.") (citing *Chatam Int'l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 558 (E.D. Pa. 2001)).

101. See, e.g., *OBH*, 86 F. Supp. 2d at 186; *People for Ethical Treatment of Animals v. Doughney*, 263 F.3d at 366.

102. See, e.g., *OBH*, 86 F. Supp. 2d at 190-91.

domain name makes clear on its face that the website is not affiliated with or sponsored by the rightful trademark owner (such as in the case of domain names for critical websites like *ballysucks.com*), there is no likelihood of confusion or actionable harm to the goodwill of the trademark owner.¹⁰³ As demonstrated above, in the event harm results from the unauthorized use of a trademark as the domain name for a website offering competing goods and services, such harm can be adequately addressed using the traditional likelihood of confusion analysis, the FTDA and/or the ACPA.¹⁰⁴

IV. INITIAL INTEREST CONFUSION ON THE INTERNET—METATAG CASES

A. Development of the Initial Interest Confusion Doctrine

The other primary line of cases recognizing initial interest confusion on the Internet has developed from the unauthorized use of a trademark in website metatags.¹⁰⁵ Such use of a trademark can cause Internet search engines to list a hyperlink to the unauthorized user's website among the results generated by a consumer's search engine query for the trademark. Even though the consumer knows which website will be accessed before leaving the search engine results page, courts have found actionable initial interest confusion because the consumer ultimately may choose to patronize the unauthorized user's website instead of the trademark owner's site.¹⁰⁶ The junior user would not have had its site listed among the search engine results or gained the opportunity to obtain the consumer's business, but for the use of the trademark in its metatags.¹⁰⁷

103. Taubman, 319 F.3d at 778 (“[Defendant] has a First Amendment right to express his opinion about [plaintiff] Taubman [in his domain name “taubmansucks.com], and as long as his speech is not commercially misleading, the Lanham Act cannot be summoned to prevent it.”).

104. See discussion *supra* Section III(A)(2).

105. Metatags are a part of HTML (hyper text mark up language), the code in which web pages are written. Website designers use metatags to describe and catalogue the contents of their websites. Although typically invisible to Internet users, Internet search engines can use metatags to find and rank websites that are potentially responsive to an Internet user's search query. See generally, Lisa E. Cristal, *Web Abuse, in Trademark Law & the Internet*, *supra* note 58, at 331, 347-48; see also *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1104 (S.D. Cal. 1998) (“Much like the subject index of a card catalog, the metatags give the websurfer using a search engine a clearer indication of the content of a website.”).

106. See, e.g., *Brookfield Communications, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1062 (9th Cir. 1999).

107. See, e.g., *Playboy Enters., Inc. v. Welles*, 78 F. Supp. 2d 1066, 1094 (S.D. Cal. 1999) (citations omitted) (stating that initial interest confusion is “a confusion of consumer attention” that may result when defendant's use of plaintiff's trademark in its metatags causes a search engine to list defendant's website among the results to a search query for

In the seminal *Brookfield*¹⁰⁸ decision applying initial interest confusion in the metatag context, the defendant used the plaintiff's MOVIEBUFF mark in the metatags for defendant's www.westcoastvideo.com website.¹⁰⁹ The court acknowledged the absence of traditional confusion because the defendant did not use MOVIEBUFF as its domain name or in the text of its website.¹¹⁰ Consumers going to www.westcoastvideo.com would know they were patronizing the defendant's website and would have no reason to presume any affiliation with the plaintiff.¹¹¹

Nonetheless, the Ninth Circuit found that defendant's use of MOVIEBUFF created actionable initial interest confusion "in the sense that, by using 'moviebuff.com' or 'MovieBuff' [in its metatags] to divert people looking for 'MovieBuff' to its web site, West Coast improperly benefits from the goodwill that Brookfield developed in its mark."¹¹² To illustrate the nature of the harm, the Brookfield court formulated its now-famous "billboard" analogy:

plaintiff's trademark), *aff'd in part*, 279 F.3d 796 (9th Cir. 2002); *Playboy Enters., Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070, 1083 (C.D. Cal. 1999) ("Internet users may experience 'initial interest confusion' when the results of their search include web sites not sponsored by the trademark holder.").

108. 174 F.3d 1036 (9th Cir. 1999).

109. *Id.* at 1061.

110. *Id.* at 1062 ("Since there is no confusion resulting from the domain address, and since West Coast's initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or think that Brookfield somehow sponsors West Coast's web site."). In fact, the Brookfield court explicitly rejected the applicability of the traditional likelihood of confusion test, stating that "the traditional eight-factor test is not well-suited for analyzing the metatags issue." *Id.* at 1062 n.24; see also *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120, 1124 (N.D. Cal. 2003) ("[Metatags are] not visible to consumers and, therefore, [are] not likely to cause consumer confusion.") (citing *Brookfield*, 174 F.3d at 1062).

Courts have also rejected the applicability of the ACPA to the metatag context. See *Bihari v. Gross*, 119 F. Supp. 2d 309, 316 (S.D.N.Y. 2000) (stating that "the plain meaning of the [ACPA] and its legislative history make [the] conclusion apparent" that the ACPA does not apply to metatags).

Although a few reported decisions have found that the use of another party's famous mark in metatags can give rise to liability under the FTDA, the defendants in these cases also used the famous mark as a domain name and in the text of the defendant's website. See, e.g., *Playboy Enters. v. Asiafocus Int'l, Inc.*, No. CIV.A. 97-734-A, 1998 WL 724000, at *8 (E.D. Va. Apr. 10, 1998) ("[E]mbedding the trademarks PLAYMATE and PLAYBOY in the hidden computer source code . . . epitomizes the 'blurring' of PEI's trademarks."). It is uncertain, particularly in light of the Supreme Court's ruling in *Moseley* that an FTDA claim requires a showing of actual harm (i.e., more than just a mere mental association with the plaintiff's mark), whether a court would find a defendant liable under the FTDA for using a famous mark solely in the metatags of a website. It is difficult to see how a consumer could even make such a mental association in the metatag context, since the consumer never perceives the defendant's use of the plaintiff's mark.

111. *Brookfield*, 174 F.3d at 1062.

112. *Id.*; see *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808, 812-13 (7th Cir. 2002) ("What is important is not the duration of the confusion, it is the misappropriation of Promatek's goodwill. Equitrac cannot unring the bell."); *J.K. Harris*, 253 F. Supp. 2d at 1124

Using another's trademark in one's metatags is much like posting a sign with another's trademark in front of one's store. Suppose West Coast's competitor (let's call it "Blockbuster") puts up a billboard on a highway reading—"West Coast Video: 2 miles ahead at Exit 7"—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there. Even consumers who prefer West Coast may find it not worth the trouble to continue searching for West Coast since there is a Blockbuster right there. Customers are not confused in the narrow sense: they are fully aware that they are purchasing from Blockbuster and they have no reason to believe that Blockbuster is related to, or in any way sponsored by, West Coast. Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that Blockbuster would be misappropriating West Coast's acquired goodwill.¹¹³

Not all unauthorized uses of trademarks in metatags have been found to constitute initial interest confusion. Where the junior user of a trademark has a good faith reason for using the mark in its metatags to index the legitimate content of its website, courts typically have deemed such use to be a permissible fair use.¹¹⁴ To evaluate the applicability of a fair use defense, courts have utilized tests for both "descriptive" fair use¹¹⁵ and "nominative" fair use.¹¹⁶

Examples of instances in which courts have deemed the defendant's use of plaintiff's trademark in its metatags to be a fair use include where the defendant uses the plaintiff's mark in a

("[T]he alleged use of Plaintiff's trademark in the HTML code . . . allows Defendants initially to divert Plaintiff's potential consumers to its web site.").

113. Brookfield, 174 F.3d at 1064.

114. *Playboy Enters., Inc. v. Welles*, 7 F. Supp. 2d 1098, 1104 (S.D. Cal. 1998); *Trans Union LLC v. Credit Research, Inc.*, 142 F. Supp. 2d 1029, 1039 (N.D. Ill. 2001) (citing cases); see also *Brookfield*, 174 F.3d at 1065 ("[W]e 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.").

115. See, e.g., *Bihari*, 119 F. Supp. 2d at 321-22 (stating that the "central considerations" in a determination of whether defendant's use of plaintiff's trademark in metatags is a "descriptive" fair use are "whether the defendant has used the mark (1) in its descriptive sense, and (2) in good faith.").

116. See, e.g., *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 801 (9th Cir. 2002) (stating that the unauthorized use of a trademark in metatags is a permissible "nominative" fair use if (i) the product or service is not readily identifiable without using the trademark; (ii) only so much of the trademark is used as is reasonably necessary to identify the product or service; and (iii) the junior user does nothing that would suggest sponsorship or endorsement by the trademark owner).

descriptive sense;¹¹⁷ the defendant's website is critical of plaintiff's business activities;¹¹⁸ the defendant distributes the plaintiff's products or has a similar legitimate business relationship with or connection to the plaintiff and its products;¹¹⁹ and defendant's fame or notoriety stems from its affiliation with the plaintiff.¹²⁰ However, even where the defendant has a legitimate reason for using the plaintiff's trademark, courts have not extended the fair use defense to so-called "cyberstuffing," i.e., the excessive use of a trademark in a website's metatags in an effort to obtain more prominent placement on a search engine result page.¹²¹

B. Resolving Metatag Cases Without the Initial Interest Confusion Doctrine

1. Practical Considerations

The changing nature of the Internet may have rendered the initial interest confusion doctrine in the metatag context a cause of action without a harm. According to the Ninth Circuit's decision in *Interstellar Starship Services Ltd. v. Epix, Inc.*,¹²² search engine results now are "largely irrelevant" to an initial interest confusion analysis.¹²³ Until recently, the Ninth Circuit noted in dicta, "each search engine used its own algorithm, based on the domain name, website text, and the metatags, to arrange the results in a proprietary sequence."¹²⁴ Today, however, companies can pay search engines for "primary placement" among the results to

117. *Brookfield*, 174 F.3d at 1066 ("The proper term for the "motion picture enthusiast" is "Movie Buff," which West Coast certainly *can* use [in its metatags]. It cannot, however, omit the space.") (emphasis in original).

118. *Bihari*, 119 F. Supp. 2d at 322; see also *Welles*, 279 F.3d at 804 ("[S]omeone searching for critiques of Playboy on the internet would have a difficult time if internet sites could not list the object of their critique in their metatags.").

119. *Trans Union*, 142 F. Supp. 2d at 1040; see also *Promatek*, 300 F.3d at 814 ("The problem here is not that Equitrac, which repairs Promatek products, used Promatek's trademark in its metatag, but that it used that trademark in a way calculated to deceive consumers into thinking that Equitrac was Promatek.").

120. *Welles*, 7 F. Supp. 2d at 1104 ("[D]efendant's use of the term Playmate of the Year 1981 is descriptive of and used fairly and in good faith only to describe herself.") (citations omitted).

121. See, e.g., *SNA, Inc. v. Array*, 51 F. Supp. 2d 554, 564 (E.D. Pa. 1999) (stating that when defendants repeated plaintiffs' mark numerous times in the metatags of defendants' website, "the court cannot find that this use is a . . . good faith effort simply to index the content of the website"), *aff'd sub nom.*, *Silva v. Karlsen*, 259 F.3d 717 (3d Cir. 2001); see also *Trans Union*, 142 F. Supp. 2d at 1040 n.8 ("Significantly, only one 'trans union' metatag is embedded in the website, indicating that defendants have not engaged in 'cyberstuffing.'").

122. 304 F.3d 936 (9th Cir. 2002).

123. *Id.* at 945 n.10.

124. *Id.*

search engine queries for certain words.¹²⁵ Accordingly, the Ninth Circuit concluded, “our initial interest confusion analysis does not depend on a given business’s payment or lack thereof to the various search engines.”¹²⁶

As the *Interstellar* court suggests, the results of search engine queries do not necessarily reflect the use of the searched trademark in the metatags of the listed websites. By simply paying a fee, websites that do not even use the searched trademark in metatags, as a domain name, or on the website itself can appear more prominently in search engine results than websites using the searched trademark. Yet it is difficult to argue that there should be a trademark-related cause of action against the owners of such websites because they do not use the trademark in question. Trademark infringement law protects against consumer confusion,¹²⁷ whether search engine manipulation should be permitted is an issue of public policy.¹²⁸

Further, most search engines do not follow a straight calculus listing websites according to the frequency of the appearance of the search term in their metatags,¹²⁹ especially because search engines have become more savvy to the strategies employed by website owners to manipulate search engine results.¹³⁰ The search software and ranking methodologies used to generate query

125. *Id.*

126. *Id.*

127. See, e.g., *Moseley v. V Secret Catalogue, Inc.*, 123 S. Ct. 1115, 1122 (2003) (stating that unfair competition law prohibits uses of trademarks “that are likely to cause confusion about the source of a product or service”).

128. In fact, the Federal Trade Commission (FTC) recently recommended in a letter to seven search engine companies that “any paid ranking search results [should be] distinguished from non-paid results with clear and conspicuous disclosures.” Attachment to Letter of Federal Trade Commission to Gary Ruskin, Executive Director, Commercial Alert (June 27, 2002), available at <http://www.ftc.gov/os/closings/staff/commercialalertattatch.htm>. This letter was in response to a formal complaint filed with the FTC by the consumer group Commercial Alert, which claimed that the failure to disclose that “ads are ads” in search engine results “may mislead search engine users to believe that search results are based on relevancy alone, not marketing ploys.” *Id.* Nonetheless, it is not clear that such mistaken beliefs among Internet users constitute confusion as to sponsorship or affiliation for the purposes of trademark law.

129. See Lisa E. Cristal, *Web Abuse*, in *Trademark Law & the Internet*, supra note 58, at 331, 348 (“Not all search engines take metatags into account equally and some, such as Excite, do not index them at all.”); 4 McCarthy, supra note 7, § 25:69 at 25-155 n.4 (“Most search engines use a complex algorithm that reviews the number of times a word appears, weighing various factors such as the place within the web site where a word appears.”).

130. See Eric Goldman, “Deregulating Relevancy: Consumer Confusion and the Internet” 17 (draft manuscript dated July 7, 2003 accessed at http://www.law.berkeley.edu/institutes/bclt/ipsc/papers/IPSC_2003_Goldman.pdf) (“Publishers have far less control over their placement—both ranking and the words used to index them—than they want, and search engines do not blindly let publishers solely determine what content gets provided to searchers.”)

responses differ among search engines,¹³¹ and the same query run on different search engines likely will generate entirely different lists of results.¹³² One search engine may heavily weight domain names in its website rankings, while another may afford more significance to web page content. It has become increasingly difficult to use metatags to manipulate search engine results; by the end of 2002, only one major search engine gave metatags extra significance.¹³³

Finally, the typical consumer is vastly more experienced in using the Internet than at the time of the Brookfield decision. Brookfield's "billboard" analogy suggests that an Internet user who does not know the address of his desired website might never find it if forced to sift through hyperlinks responsive to a search engine query.¹³⁴ By contrast, today's average Internet user is accustomed to "surfing" among hyperlinks and websites in a manner not at all analogous to getting on and off an actual highway.¹³⁵ The harm caused by a misleading highway billboard is relatively significant, typically costing at least a few minutes of a driver's time and effort. On the so-called "information superhighway," a consumer can resume his search for a desired website with "one click of the mouse and a few seconds delay."¹³⁶

2. Doctrinal Considerations

Application of initial interest confusion in the metatag context extends the doctrine beyond its intended boundaries. As discussed above, courts developed the initial interest confusion doctrine to address three harms: (i) the initial diversion of the prospective customer's interest; (ii) the potential effect of that diversion on the customer's ultimate purchasing decision; and (iii) the initial credibility that may be accorded by the customer to the junior user's goods and services.¹³⁷ In fact, these harms never materialize when another party's trademark is used solely in a website's metatags.

First, any original diversion of the consumer's interest is made of the consumer's own free will. A search engine does not take the

131. *Simon Prop. Group L.P. v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1042 (S.D. Ind. 2000) ("Numerous search engines are available on the Internet. They employ a variety of criteria for selecting, categorizing, and displaying search results.").

132. *Id.* ("Using common terms . . . in different search engines produces a range of different results.").

133. *Goldman*, *supra* note 130, at 19-20.

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

135. See, e.g., *Bihari v. Gross*, 119 F. Supp. 2d 309, 320 n.15 (S.D.N.Y. 2000) ("Use of the highway billboard metaphor is not the best analogy to a metatag on the Internet.").

136. *Id.*

137. *BigStar Entm't, Inc. v. Next Big Star, Inc.*, 105 F. Supp. 2d 185, 207 (S.D.N.Y. 2000) (citing *Brookfield*, 174 F.3d at 1063-64).

consumer directly to websites potentially responsive to a query for a given trademark. Rather, it generates a list of hyperlinks to websites for the consumer to consider, as well as some additional information describing the websites and their content.¹³⁸ The consumer may choose to go to the trademark owner's website, or to a competitor's website. However, the consumer is not likely to go to a competitor's website believing it to be the trademark owner's website, unless the competitor has created confusion by using the trademark owner's mark as its domain name or in its visible website content.¹³⁹ Contrary to the Brookfield "billboard" analogy, the "driver" need not get off the "highway" to know that the two entities are unrelated. Any "diversion" of the consumer's interest does not necessarily result from the consumer being misled; rather, it results from the consumer's informed choice in selecting from a group of hyperlinks to websites.¹⁴⁰

Second, the unauthorized use of a trademark in a website's metatags does not, in and of itself, create an impression of affiliation. Consumers typically do not even know when a website uses another's trademark in its metatags because metatags are hidden from view. Further, the simultaneous listing of hyperlinks to multiple websites on a search engine results page, without more, does not necessarily signal to consumers that the websites are related.¹⁴¹ The Brookfield court acknowledged this, noting that in the context of search engine query results, when no confusion results from the domain name or website content, "it is difficult to say that a consumer is likely to be confused about whose site he has reached or think that [the trademark owner] somehow sponsors [the junior user's] site."¹⁴² Although metatags allow

138. See Simon, 104 F. Supp. 2d at 1044 (observing that search engine results "will also include some additional descriptive information about the responsive sites. That information will help the user determine which ones are most promising for the purpose of the search.").

139. See *Bernina of Am., Inc. v. Fashion Fabrics Int'l, Inc.*, 57 U.S.P.Q. 2d 1881, 1883 (N.D. Ill. 2001) ("If [defendant's] website was not confusing to customers, then an injunction of [defendant's] use of [plaintiff's] trademarks in its metatags would be improper because such use merely directs customers to a location where they may purchase genuine branded goods from a reseller that does not hold itself out to be anything but an independent retailer unaffiliated with [plaintiff]."). As discussed supra Section III(A), the use of domain names or website content that create confusion is actionable under infringement law, the FTDA or the ACPA.

140. See Simon, 104 F. Supp. 2d at 1042-43 ("[C]onsumer[s] viewing search results will see much more than the domain names as the responses. One can reasonably expect that additional information will influence the consumer's choice of sites.").

141. See *id.* at 1044, 1047 ("Any Internet user is familiar with the confusion one confronts with . . . a welter of search results, but that confusion is the uncertainty about where to go next, not necessarily the confusion that is relevant for purposes of trademark law . . . SPG must show there is something different about mySimon that makes it *more* confusing than a level of perhaps inevitable confusion based solely on the name.") (emphasis in original).

142. Brookfield, 174 F.3d at 1062.

consumers to consider listed websites in close proximity, there is no more representation made to the consumer of affiliation or sponsorship than in the context of a telephone book's yellow pages.

Finally, the reasonable consumer does not accord initial credibility to a website simply because it is listed among the search engine results in a query for the trademark owner's mark. As discussed above, different search engines use different search methodologies, such that any given query will return a mixed bag of listings—some relevant and some irrelevant. Companies also can purchase favorable placement in search engine results. As a result, Internet users have become more discerning and have modified their expectations of search engines. Today's Internet surfer/consumer does not necessarily assume that every result in response to a search engine query is even relevant, much less sponsored by the owner of the searched trademark.¹⁴³

While the Brookfield "billboard" analogy may be useful in the non-Internet context,¹⁴⁴ choosing among search engine results for a trademark used in the metatags of various websites is better analogized to standing outside a store and finding that its competitors occupy the nearby stores. Assuming each competing store does business under its own unique trademark, the consumer can make an informed choice as to which store to patronize *before entering*. Although the presence of multiple stores creates stiff competition, the consumer can fairly consider each store on its own relative merits. The consumer is not deceived at any point during the decision-making process, and has no reason to believe that any of the stores are affiliated. At most, the consumer may form a mental association among the stores because they sell similar goods in the same geographical area. But courts consistently have held that a finding of likely confusion requires more than a showing that the junior user's mark merely "calls to mind" the trademark owner's mark.¹⁴⁵ Further, as the Supreme Court stated in *Moseley v. V Secret Catalogue, Inc.*,¹⁴⁶ a mere mental association is insufficient for a finding of dilution.¹⁴⁷

143. See, e.g., *Bihari v. Gross*, 119 F. Supp. 2d 309, 320 n.16 (S.D.N.Y. 2000) (when defendant's websites listed on search engine result page did not use plaintiff's mark as a domain name or in website content that created confusion, "[n]o reasonable person would believe that any of these . . . websites were sponsored or endorsed by [plaintiff]")

144. In fact, the Brookfield court based its analogy on the facts of *Blockbuster Entertainment Group, Division of Viacom v. Laylco, Inc.*, 869 F. Supp. 505, 513 (E.D. Mich. 1994), which found trademark infringement where defendant, a video rental store, attracted customers' initial interest by using a sign confusingly similar to its competitor's, even though confusion would end prior to the point of sale. *Brookfield*, 174 F.3d at 1064.

145. See generally 3 *McCarthy*, supra note 7, § 23:9 (citing cases).

146. 123 S. Ct. 1115 (2003).

147. *Id.* at 1124 ("[T]he mere fact that consumers mentally associate the junior user's mark with a famous mark is not sufficient to establish actionable dilution.").

As demonstrated by the store analogy, the unauthorized use of a trademark in a website's metatags is not likely to cause actionable harm. Consumers are not misled as to whose website they access, are not unintentionally diverted to the website against their will, and have no reason to accord the website undue credibility. In fact, consumers arguably benefit from a wider variety of choices in their purchasing decisions when multiple websites are listed in the results of a search engine query. The trademark owner faces increased competition, but it is competition based on the relative merits of its website in comparison with those of other websites. Trademark law provides relief only from competition that is unfair.¹⁴⁸

One of the fundamental principles of trademark law is that trademarks are not property rights in gross and do not receive absolute protection from copying.¹⁴⁹ As the Supreme Court reaffirmed in *Moseley*, there can be no finding of liability in the absence of the harms intended to be addressed by infringement and dilution laws. The district court in *Moseley* found that the defendant's use of VICTOR'S LITTLE SECRET did not infringe the plaintiff's VICTORIA'S SECRET mark.¹⁵⁰ Because there was no likelihood of confusion, use of the defendant's mark necessarily created little risk of potential harm to consumers and did not constitute an unfair practice by an "imitating competitor."¹⁵¹ Further, despite the fame of the VICTORIA'S SECRET trademark, the Supreme Court ruled that there could not be actionable dilution in the absence of evidence that the goodwill of VICTORIA'S SECRET would be harmed by defendant's use of VICTOR'S LITTLE SECRET.¹⁵² Thus, despite some similarity between the defendant's and plaintiff's marks, there could be no liability without evidence of harm to consumers, the plaintiff or the

148. See, e.g., *id.* at 1122 ("Traditional trademark infringement law is a part of the broader law of unfair competition."); see also *Playboy Enters., Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070, 1081 n.5 (C.D. Cal. 1999) (observing that courts "have generally confined legal protection to the trademark's source identification function for reasons grounded in the public policy favoring a free, competitive economy"); Jonathan A. Weininger, *Trademark Metatagging: Lanham Act Liability or Pareto Optimality?* 23 *Whittier L. Rev.* 469, 499 (Winter 2001) (concluding that "in the absence of consumer perception of a tangible allegedly infringing mark, application of the initial interest confusion theory to the use of trademarks in metatags overly protects the rights of trademark holders to the detriment of competition").

149. *Netscape*, 55 F. Supp. 2d at 1080-81 ("A trademark is not an omnibus property right or a monopoly on the use of the words in the trademark.") (citing *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 306 (9th Cir. 1992)).

150. *Moseley*, 123 S. Ct. at 1120 (citing *V Secret Catalogue, Inc. v. Moseley*, No. 3:98CV-395-S, 2000 WL 370525 (W.D. Ky. Feb. 9, 2000)).

151. *Id.* at 1122 ("Infringement law protects consumers from being misled by the use of infringing marks and also protects producers from unfair practices by an 'imitating competitor.'") (citing *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163-64 (1995)).

152. *Id.* at 1124-25.

goodwill of the plaintiff's mark. Absent such harm, any benefit gained by the defendant as a result of consumers' mental association of VICTOR'S LITTLE SECRET with VICTORIA'S SECRET did not give rise to a cognizable cause of action under trademark law.¹⁵³

The reasoning of *Moseley* is fully applicable to cases involving the unauthorized use of a trademark in metatags. There is no likelihood of confusion because the listing of several distinct websites in a search engine result does not mislead consumers. While the trademark owner is subject to increased competition, each website competes on its own merits and not from a base of confusion. There also is no harm to the goodwill of the trademark owner's mark because the consumer never sees the trademark used in metatags. Thus, any benefit that the metatag user receives from having a hyperlink to its website included in the same set of search results as the trademark owner does not harm the consumer, the trademark owner, or the goodwill in the trademark. Consistent with the principles set forth in *Moseley*, such mere association between the unauthorized metatag user and the trademark owner should not result in liability.

V. CONCLUSION

As the Internet has evolved, courts often have developed creative and novel approaches to address Internet-related legal issues. Nonetheless, the use of the initial interest confusion doctrine is unnecessary to resolve the cases in which courts have applied the doctrine.

The nature of the Internet mandates that only one party can own a given domain name. Yet trademark owners do not have a monopoly over the use of their marks, and there are limits to the protection that trademark owners have against the use of their marks as the domain names of competing websites. To define the boundaries of protection, courts must consider, on a case-by-case basis, each dispute between a trademark owner and an unauthorized user of that trademark as a domain name. The balancing of interests required in these cases is best achieved using principles of traditional trademark infringement law, the FTDA and the ACPA.

Further, Internet users have become sufficiently sophisticated that a search engine's listing of multiple hyperlinks in response to a search engine query should not, by itself, create actionable confusion. The mere uncertainty that Internet users may have when deciding among several different hyperlinks listed in

153. *Id.* at 1125 (declining to find actionable dilution where army officer seeing advertisement for defendant's store made a "mental association" with plaintiff's famous mark, but did not form any different impression of plaintiff's store or mark).

response to a search engine query is not the confusion that is relevant for purposes of trademark law. A finding of liability requires some identifiable harm to the consumer or trademark owner or to the mark itself (if it is a famous mark for purposes of the FTDA). Accordingly, unless a responsive hyperlink or its related website content creates likely confusion as to affiliation, source or sponsorship, diverts consumers to a website they did not intend to patronize, or dilutes a famous trademark, the proper balancing of the goals of trademark law suggests that the unauthorized use of trademarks in metatags should not be prohibited.
