



1-1-2005

# Deregulating Relevancy in Internet Trademark Law

Eric Goldman

*Santa Clara University School of Law*, [egoldman@gmail.com](mailto:egoldman@gmail.com)

Follow this and additional works at: <http://digitalcommons.law.scu.edu/facpubs>



Part of the [Internet Law Commons](#)

---

## Automated Citation

Eric Goldman, *Deregulating Relevancy in Internet Trademark Law*, 54 EMORY L. J. 507 (2005),  
Available at: <http://digitalcommons.law.scu.edu/facpubs/68>

This Article is brought to you for free and open access by the Faculty Scholarship at Santa Clara Law Digital Commons. It has been accepted for inclusion in Faculty Publications by an authorized administrator of Santa Clara Law Digital Commons. For more information, please contact [sculawlibrarian@gmail.com](mailto:sculawlibrarian@gmail.com).

# DEREGULATING RELEVANCY IN INTERNET TRADEMARK LAW

*Eric Goldman\**

I. A BRIEF PRIMER ON INTERNET SEARCH .....	511
II. INTERNET SEARCH FROM THE SEARCHER'S PERSPECTIVE .....	513
A. <i>The Complex Process of Internet Search</i> .....	513
1. <i>Stage 1: Objective Formulation</i> .....	515
2. <i>Stage 2: Search Provider Selection</i> .....	515
3. <i>Stage 3: Keyword Selection</i> .....	515
4. <i>Stage 4: Search</i> .....	516
5. <i>Stage 5: Results Evaluation</i> .....	516
6. <i>Stage 6: Decision</i> .....	519
7. <i>Stage 7: Investigation</i> .....	520
8. <i>Stage 8: Objective Satisfaction</i> .....	521
B. <i>Trying To Infer Searcher Objectives from Keyword Selection</i> ...	521
1. <i>"Objective Opaqueness"</i> .....	521
2. <i>Internet Searches Differ from Physical Space Searches</i> .....	526
III. INTERNET SEARCH FROM THE PUBLISHER'S PERSPECTIVE .....	529
IV. INTERNET SEARCH FROM THE SEARCH PROVIDER'S PERSPECTIVE ....	532
A. <i>Search Providers Are Editors, Not Passive Intermediaries</i> .....	532
1. <i>Aggregation</i> .....	533
2. <i>Sorting</i> .....	534
3. <i>Filtering Content</i> .....	537
4. <i>Reinterpreting Searcher Keywords</i> .....	538
5. <i>Editing Publisher Content</i> .....	539
6. <i>Reinterpreting Publisher Keywords</i> .....	541

\* Eric Goldman (eric.goldman@marquette.edu), Assistant Professor, Marquette University Law School, Milwaukee, WI. My personal home page is located at [http://eric\\_goldman.tripod.com](http://eric_goldman.tripod.com). I thank the participants at the Third Annual Intellectual Property Scholars Conference at Boalt Hall, the Institute of Legal Studies at the University of Wisconsin Law School, and the American Bar Association Annual Meeting, and Ann Bartow, Michael Carroll, Chad Doellinger, Ben Edelman, Roberta Rosenthal Kwall, Greg Lastowka, Mark Lemley, Martin Schwimmer, Scott Shipman, and Amanda Spink, for their helpful comments. I also thank Ted Potter, Paul Krause, Henry Abromson, and Deborah Spanic for their research assistance.

In the interest of full disclosure, I assisted the Electronic Frontier Foundation on a pro bono basis in its amicus curiae brief on behalf of WhenU.com in WhenU.com's appeal of *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003), to the Second Circuit Court of Appeals. See [http://www.eff.org/IP/TM/20040218\\_WhenU\\_Amicus.pdf](http://www.eff.org/IP/TM/20040218_WhenU_Amicus.pdf).

7. <i>Advanced Technologies</i> .....	541
8. <i>Summary on Passivity</i> .....	542
B. <i>Keyword Convergence</i> .....	542
1. <i>Domain Names</i> .....	543
2. <i>Link Navigation</i> .....	549
3. <i>Software Agents</i> .....	550
4. <i>Implications of Keyword Convergence</i> .....	551
V. <i>THE DEVOLUTION OF INTERNET TRADEMARK LAW</i> .....	552
A. <i>A Brief Primer on Trademark Law</i> .....	552
B. <i>The Breakdown of the MFLOCC Test and Goodwill</i> <i>Misappropriation</i> .....	553
1. <i>Referential Uses</i> .....	554
2. <i>Associative Uses</i> .....	556
3. <i>Misappropriative Uses</i> .....	558
C. <i>Initial Interest Confusion</i> .....	559
1. <i>The Development of the Doctrine</i> .....	559
2. <i>The Failings of the Doctrine</i> .....	565
3. <i>Deconstructing Brookfield</i> .....	570
4. <i>Consequences of a Bad Doctrine</i> .....	573
VI. <i>DEVELOPING AN INTEGRATED LAW OF KEYWORDS</i> .....	575
A. <i>Move Infringement Analysis Back in Time</i> .....	575
1. <i>Searchers Benefit from Filtering Content</i> .....	576
2. <i>At Early Search Stages, There Is Less Reason To Believe</i> <i>that Trademark Owners Suffer Any Harm</i> .....	581
3. <i>Summary on the Timing of Infringement Analysis</i> .....	584
B. <i>Modernize the MFLOCC Test</i> .....	584
1. <i>Add a "Relevancy" Factor to the MFLOCC Test</i> .....	584
2. <i>Consider the Search Stage</i> .....	585
3. <i>Consider Minority Definitions</i> .....	586
4. <i>Require Plaintiffs to Provide More Rigorous Evidence</i> <i>of Confusion or Harm</i> .....	587
C. <i>Immunize Search Providers</i> .....	588
1. <i>Why Search Providers Need a Safe Harbor</i> .....	588
2. <i>Implementing a Safe Harbor</i> .....	593
CONCLUSION .....	595

## DEREGULATING RELEVANCY IN INTERNET TRADEMARK LAW

Jane, a 10th grader, is writing a report on ancient Greek religious figures for her classical history class. She enters the word “Nike” into the Google search engine in an attempt to find source material for her report. However, she only finds product information regarding footwear and clothing from Nike, Inc., because Google has removed other content due to liability concerns. Out of frustration, Jane abandons her Internet search and turns to the next most convenient free resource, her school library. Unbeknownst to Jane, her school library’s acquisition director is personally interested in Roman mythology but finds Greek mythology boring. As a result, Jane only finds a few books briefly discussing her subject.

John is a rock climbing enthusiast with a penchant for the latest gear. He has heard rumors about the new Reebok “Hilltopper 483,” an advanced technology shoe for rock climbing intended to directly compete with the just-released Nike “Swooshtown 96” model. He would like to educate himself about each model to decide if he wants to purchase the newest, hottest rock climbing footwear. He searches for “Reebok Hilltopper 483” in Yahoo Search but this only leads him to the official website of Reebok, Ltd. and its authorized distributors. These sites have some information about Reebok shoes but no neutral or comparative information. Frustrated by his inability to find the information he wants, John decides not to buy new shoes from either Reebok or Nike.

These two scenarios illustrate how trademark law could jeopardize the Internet’s potential as an information resource and a catalyst for competition. Emerging trademark law doctrines have allowed trademark owners to excise socially beneficial content and to take unprecedented control over their channels of distribution. Without limits, trademark law has the capacity to counterproductively destroy the Internet’s utility for everyone.

It does not have to be this way. Trademark law’s assault on the Internet is predicated on a series of factual myths and doctrinal errors. The clichéd story assumes that predatory marketers steal customers’ attention away from trademark owners using surreptitiously dishonest means.<sup>1</sup> Under this story, it

<sup>1</sup> See, e.g., Scott Shipman, Comment, *Trademark and Unfair Competition in Cyberspace: Can These Laws Deter “Baiting” Practices on Web Sites?*, 39 SANTA CLARA L. REV. 245, 246–47 (1998).

is argued that trademark law needs to protect trademark owners and searchers by ensuring that Internet searchers see only content approved by the trademark owner.

This cliché, and its supporting academic commentary, have developed from intuition based assumptions about searcher behavior that contradict the empirical data about how searchers actually search. This Article corrects those mistakes by basing its analysis on what information scientists know about Internet search behavior.

By examining how people search for information on the Internet, it becomes clear that Internet search providers compete fiercely with each other to help Internet searchers find the content they want. To do so, search providers must discern searchers' true objectives from opaque and poorly-chosen search keywords delivered without any surrounding context. This requires search providers to choose what content to present to searchers, putting publishers trying to reach those searchers at the mercy of the search engine.

Using the facts presented by the Article, it becomes possible to develop an Internet trademark policy from the ground up. To increase the odds of efficient and successful searches, searchers should be able to pick the search terms they want, and search providers should be able to use those search terms to deliver the most helpful content to searchers. Thus, trademark law must step aside when searchers receive relevant content they may want.

In short, the introductory vignettes above may realistically preview the current direction of Internet search. However, with a more rigorous understanding of both trademark law and Internet search, there is an opportunity to preserve the Internet as a medium that helps searchers find what they seek.

Part I of the Article provides a brief overview of the Internet search process. Parts II–IV consider Internet search from three perspectives. Part II considers Internet search from the searcher's perspective, concluding that one cannot infer searchers' objectives from the keywords they choose. Part III considers Internet search from the web publisher's perspective. Part IV considers Internet search from the search provider's perspective, explaining that search providers, not web publishers, decide what searchers see. Part IV also explains that all Internet technologies are converging to use keywords to

match searchers with content. Thus, historical distinctions between the domain name system, directories, and search engines are collapsing.

Part V summarizes trademark law and then provides a theoretical framework to distinguish beneficial and misappropriative uses of trademarks. The framework helps explain why trademark law doctrines like “initial interest confusion” are misguided. Part VI offers three concrete solutions: (1) courts should consider the search process stage where searchers see a trademark being used; (2) the law should modernize the test used to determine consumer confusion, most conspicuously by considering content relevancy in any infringement analysis; and (3) search providers should have both common law and statutory safe harbors. The Article concludes with a brief consideration of how keyword-based search benefits society.

## I. A BRIEF PRIMER ON INTERNET SEARCH

Internet searchers have two primary means of conducting a keyword search using keywords to express their interests: search engines and domain names.<sup>2</sup>

Search engines allow a searcher to enter a keyword<sup>3</sup> into a search box and make a query against a database of content. The search engine may be a stand-alone database, like Google, or a functionality supporting some other business objective, such as the search function at Staples’s office supply website. Major ecommerce websites like eBay and Amazon incorporate a broad variety of third-party content into their search databases and depend heavily on users conducting keyword searches, so they share a lot of common issues with stand-alone search engines like Google.

Stand-alone search engines build their databases in a variety of ways. Commonly, a search engine uses automated robots<sup>4</sup> to canvass the Internet for content, which then make copies of pages they find and add those copies to the database.<sup>5</sup> Alternatively, or in addition, some search engines allow publishers to affirmatively upload content to the search engine which may be

<sup>2</sup> These methods are converging into a single keyword-based search approach, a topic explored in Part IV.B *infra*.

<sup>3</sup> For convenience, this Article refers to “keyword” in the singular. Keywords, however, can be composed of multiword phrases, and this Article covers those phrases as well.

<sup>4</sup> Search engine robots may also be called scripts, crawlers, or spiders.

<sup>5</sup> See THOMAS A. POWELL, WEB DESIGN: THE COMPLETE REFERENCE 277–79 (2nd ed. 2002), available at <http://www.webdesignref.com/chapters/09/ch9-01.htm>.

incorporated, either automatically or after manual review, directly into the index.<sup>6</sup> Databases can also be built manually.<sup>7</sup>

The domain name system ("DNS") enables searchers to obtain content in at least three ways. First, the searcher can guess that a word, when used as a domain name, will lead to relevant content. Second, the searcher may already know a desired domain name and can type it into the web browser address bar directly. Third, if a searcher has already visited the web page, the searcher can use bookmarks or the browser's history to return to the page.

While search engines and the DNS represent the principal techniques for engaging in keyword searches, there are other methods of presenting "search-like" content. For example, as an alternative to affirmatively entering a keyword into a search box, searchers can navigate their way to content through directories of editorially-organized links. Links can be graphics, pictures or text, and the links can be laconic ("More") or very detailed ("Click Here to Learn More About the Canon PowerShot S400 Digital Camera"). Often, websites organize links into "taxonomies" that group related items into hierarchies.<sup>8</sup> This Article refers to the process of navigating through a directory of links as "link navigation." Unlike the other two search methods, the directory organizer (instead of the searcher) selects the applicable keywords that lead to more content. Part IV.B.2 revisits link navigation.

<sup>6</sup> Feeds can contain the entire dataset incorporated into the index or a partial dataset that also instructs the search engine how to obtain the remaining data automatically (such as through a robot that collects information from a publisher's website in accordance with the instructions contained in the feed). See Google, *Froogle Beta Information for Merchants*, at <http://google.com/froogle/merchants.html> (last visited Apr. 1, 2005).

<sup>7</sup> Many associate manually built databases with Yahoo! and, to a lesser extent, LookSmart. However, today Yahoo!, LookSmart, and other directories primarily rely upon publishers to submit feeds which are manually evaluated (usually for a fee) before being added to the database. However, "pure" directories still exist, the most prominent of which is the Open Directory Project ("ODP"). See Open Directory Project, at <http://dmoz.org/> (last visited Apr. 1, 2005).

<sup>8</sup> Consider this hypothetical four level taxonomy that a searcher might use to find more information on the Canon PowerShot S400 digital camera. The home page contains a text link called "Digital Cameras" (Level 1 of the taxonomy). On the subsequent page (Level 2), the searcher sees a list of digital camera manufacturers, including a text link called "Canon." On the subsequent page (Level 3), the searcher sees a list of digital camera brands manufactured by Canon, including a text link called "PowerShot." On the final page (Level 4), the searcher sees a list of different models of PowerShot-brand digital cameras, including the "S400."

## II. INTERNET SEARCH FROM THE SEARCHER'S PERSPECTIVE

This Article takes complementary looks at the Internet search process from three different perspectives: the searcher, the publisher, and the search provider. This Part evaluates Internet search from the perspective of a searcher looking for information.

### A. *The Complex Process of Internet Search*

Search processes are complex and defy simplistic analysis. Some searches are very simple and directed; other searches are open-ended and meandering.<sup>9</sup> Thus, any attempt to describe a universal search process is inherently misleading.

Nevertheless, Internet searches share sufficient commonalities to develop a methodology that applies to many such searches. Specifically, all successful Internet keyword-driven searches go through the following eight distinct stages:<sup>10</sup>

- Stage 1: Objective Formulation
- Stage 2: Search Provider Selection
- Stage 3: Keyword Selection
- Stage 4: Search
- Stage 5: Results Evaluation
- Stage 6: Decision
- Stage 7: Investigation
- Stage 8: Objective Satisfaction

<sup>9</sup> LOUIS ROSENFELD & PETER MORVILLE, INFORMATION ARCHITECTURE FOR THE WORLD WIDE WEB § 6.2 (1998), available at [http://www.monkeytools.com/oreilly/webdesign/infoarch/ch06\\_02.htm](http://www.monkeytools.com/oreilly/webdesign/infoarch/ch06_02.htm) (distinguishing different types of search behavior, such as known-item searching, existence searching, exploratory searching and comprehensive searching and research).

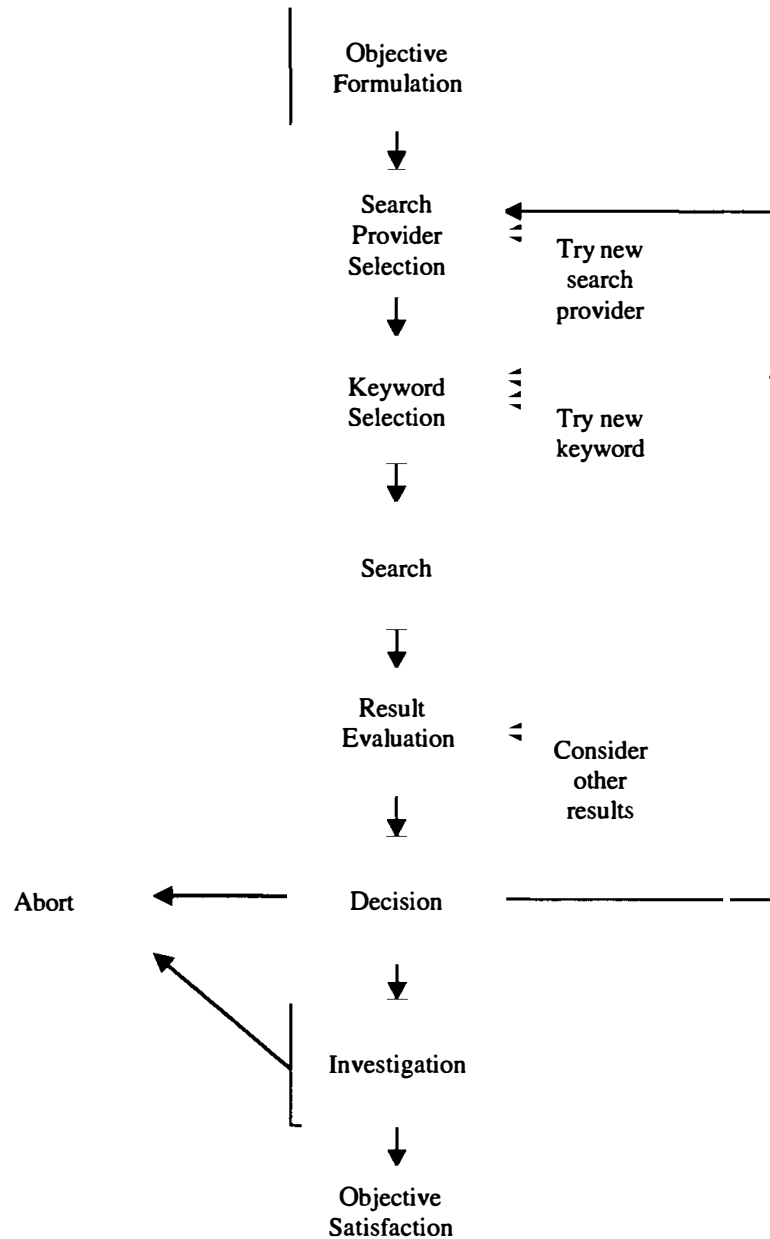
<sup>10</sup> Cf. POWELL, *supra* note 5, at 276–77 (describing a four-stage search process, consisting of query formulation, search, results review, and decision what to do).

When a searcher uses a software agent, this process may vary some because the searcher prospectively delegates authority to the software agent to monitor behavior and interject content when the agent deems appropriate. In these situations, the searcher is implicitly selecting a search provider at Stage 2 prior to having an objective from Stage 1.



This process is depicted graphically as:

Figure 1



To better understand the search process, this subsection describes each stage in more detail. While this discussion treats each stage as distinct and

separate, a searcher may move from stage to stage very quickly, making the search process appear seamless and integrated.

### *1. Stage 1: Objective Formulation*

A searcher initiates a search by formulating a search objective.<sup>11</sup> Objectives may range from transacting goods or services, to obtaining information to make a nontransaction decision (e.g., checking the weather to decide if an umbrella is necessary before departing), to obtaining information for general educational purposes (e.g., trying to remember the first name of Kramer from the *Seinfeld* TV show).

### *2. Stage 2: Search Provider Selection*

Once a search objective is formed, the searcher decides which search provider to use for the search. This involves two separate but related inquiries: (1) which search tool is most likely to yield the desired results (i.e., search engine, DNS, or link navigation), and (2) which particular vendor is the best choice for that search tool.<sup>12</sup>

### *3. Stage 3: Keyword Selection*

Having formulated a search objective and selected a search provider, the searcher picks a keyword that the searcher believes will elicit relevant information. Before one can make any inferences about searchers' objectives based on the keyword they use, it is important to understand how they choose terms.

Unfortunately, searchers do a poor job selecting keywords. Searchers with domain expertise on a topic generally do a better job selecting keywords,<sup>13</sup> but because searchers routinely have low domain expertise, searchers routinely

<sup>11</sup> Although this Article contemplates that searchers pursue only a single search objective during a search, some searchers "multitask," i.e., pursue multiple search objectives simultaneously. See Amanda Spink et al., *Multitasking on Web Search Engines* (draft on file with author).

<sup>12</sup> See RAHUL TELANG ET AL., *AN EMPIRICAL ANALYSIS OF INTERNET SEARCH ENGINE CHOICE* (Darden School of Business Working Paper No. 03-05, Sept. 2001) (discussing the factors searchers use to choose search providers).

<sup>13</sup> See Giorgio Brajnik et al., *Strategic Help in User Interfaces for Information Retrieval*, 53 J. AM. SOC'Y INFO. SCI. & TECH. 343, 344 (2002) (summarizing the literature showing that novice searchers use simple and low efficacy techniques); Barbara M. Wildermuth, *The Effects of Domain Knowledge on Search Tactic Formulation*, 55 J. AM. SOC'Y INFO. SCI. & TECH. 246 (2004) (showing how researchers improved their search process when they had better domain knowledge).

choose keywords poorly. Specifically, most searchers use no more than two keywords in a keyword search,<sup>14</sup> and searchers almost never use advanced search methodologies like Boolean logic<sup>15</sup> or advanced searching functionality offered by search providers.<sup>16</sup>

#### 4. *Stage 4: Search*

With all of the preliminary decisions resolved, the searcher next conducts the search and receives the search results. If the searcher uses a search engine, the searcher may receive multiple search results. If the searcher uses the DNS, the searcher is, in effect, taken directly to the search result.

#### 5. *Stage 5: Results Evaluation*

Regardless of the search method used, the searcher evaluates the content provided in response to the search. This stage is crucial for both the searcher and any legal judgments regarding the searcher's objectives.

The amount of information presented to a searcher following a search varies with the search provider. Search engines almost always display some amount of content previewing each website in the search results list. This Article refers to the previewing of content as "filtering content."

For example, Google frequently provides a substantial amount of information for searchers to evaluate before they decide which search results to explore further. Search results in Google may display some or all of the following filtering content:<sup>17</sup> a web page title, an excerpt of the page, a

<sup>14</sup> See iProspect.com, Inc., *iProspect Natural SEO Keyword Length Study* (Nov. 2004), at [http://www.iprospect.com/premiumPDFs/keyword\\_length\\_study.pdf](http://www.iprospect.com/premiumPDFs/keyword_length_study.pdf) (88% of search engine referrals are based on only one or two keywords); see also Declan Butler, *Souped-Up Search Engines*, NATURE, May 11, 2000, at 112, 115 (citing an NEC Research Institute study showing that up to 70% of searchers use only a single keyword as a search term); Bernard J. Jansen et al., *Real Life Information Retrieval: A Study of User Queries on the Web*, 32 SIGIR FORUM 5, 15 (1998) (average keyword length was 2.35 words; one-third of searches used one keyword and 80% used three keywords or fewer); Jakob Nielsen, *Search: Visible and Simple*, at <http://www.useit.com/alertbox/20010513.html> (May 13, 2001) (average keyword length was 2.0 words).

<sup>15</sup> Nielsen, *supra* note 14 ("Most users cannot use advanced search or Boolean query syntax."); Jansen, *supra* note 14, at 15 (only one in eighteen searchers used any Boolean functions).

<sup>16</sup> Press Release, Vividence, Inc., Google Wins Users' Hearts, But Not Their Ad Clicks (May 25, 2004), at <http://www.vividence.com/public/company/news+and+events/press+releases/2004-05-25+ce+rankings+search.htm> ("Although a majority of users expressed interest in advanced search options when asked, less than 3% actually used advanced search techniques in any given search task . . .").

<sup>17</sup> Google, *How To Interpret Your Search Results*, at <http://www.google.com/help/interpret.html> (last visited Apr. 1, 2005).

summary description of the website, the category into which the website has been taxonomized in Google's directory, the web page's format (e.g., HTML, PDF, or Microsoft Word),<sup>18</sup> a Uniform Resource Locator ("URL") for the web page, the web page's file size, and the date Google last indexed the page. Unfortunately for searchers, filtering content is sometimes inaccurate. Some web publishers use techniques such as cloaking<sup>19</sup> and pagejacking<sup>20</sup> to present inaccurate filtering content.

In contrast, a searcher using the DNS does not see filtering content. Instead, the searcher gets a single search result (the web page associated with that domain name) and is immediately taken there.

This Article does not distinguish ads from other forms of filtering content. Like other filtering content, ads can inform searchers what to expect if they investigate further.<sup>21</sup> While controversy has brewed over the blurring of editorial search results and paid search results,<sup>22</sup> searchers often find the relevance of paid search results equal to or better than editorial search results.<sup>23</sup>

<sup>18</sup> Google, *Google Web Search Features*, at <http://www.google.com/help/features.html#pdf> (last visited Apr. 1, 2005).

<sup>19</sup> Although definitions vary, cloaking generally occurs when the publisher presents a different page to search engine robots than is presented to searchers who select the search result. See Danny Sullivan, *Ending the Debate Over Cloaking*, at [http://searchenginewatch.com/sereport/print.php/34721\\_2165231](http://searchenginewatch.com/sereport/print.php/34721_2165231) (Feb. 4, 2003). Although cloaking is not inherently bad (good-looking or ergonomic web pages may be "cloaked" because they are not readable by search engine robots or will not be favorably indexed), search engines often penalize publishers who are caught doing it. *Id.*

<sup>20</sup> Pagejacking occurs when a web publisher copies the third party content and incorporates that content into the publisher's web page in a way that results in search engines displaying filtering content for the copier identical to the filtering content displayed for the copied site. Whatis.com, *Pagejacking*, at [http://whatis.techtarget.com/definition/0,,sid9\\_gci213799,00.html](http://whatis.techtarget.com/definition/0,,sid9_gci213799,00.html) (last visited Apr. 1, 2005). See *Niton Corp. v. Radiation Monitoring Devices, Inc.*, 27 F. Supp. 2d 102 (D. Mass. 1998); Press Release, Federal Trade Commission, *FTC Halts Internet Highjacking Scam* (Sept. 22, 1999), available at <http://www.ftc.gov/opa/1999/09/atariz.htm> (discussing how a pornographer used cloaked pagejacked pages (including the Harvard Law Review) to induce users to visit pornography and then mousetrapped them). See generally F. Gregory Lastowka, Note, *Search Engines, HTML, and Trademarks: What's the Meta For?*, 86 VA. L. REV. 835, 862-65 (2000) (defining and discussing the terms).

<sup>21</sup> See F. Gregory Lastowka, *Search Engines Under Siege: Do Paid Placement Listings Infringe Trademarks?*, 14 INTEL. PROP. & TECH. L.J. 1, 6 (2002).

<sup>22</sup> Search engines receive some criticism for blurring the line between ads and editorially generated search results, including "paid inclusion" programs and ambiguously-labeled zones on search results pages. See Letter from Heather Hipsley, Acting Associate Director, Division of Advertising Practices, Federal Trade Commission to Mr. Gary Ruskin, Executive Director, Commercial Alert (June 27, 2002), available at <http://www.ftc.gov/os/closings/staff/commercialalertletter.htm>.

<sup>23</sup> See iProspect, *Search Engine User Attitudes*, at <http://www.iprospect.com/premiumPDFs/iProspectSurveyComplete.pdf> (Apr.-May 2004) (survey showing that users of several search engines found paid search advertisements more useful than algorithmically-generated search results); Leslie Marable, *False Oracles: Consumer Reaction to Learning the Truth About How Search Engines Work*, 21 (June 30, 2003), at

Ultimately, searchers care only about the relevancy of the information they see, and artificial divisions between “ads” and “content” mask important similarities in the searcher’s relevancy determination process.

When evaluating search results, the searcher judges the relevancy of the results to his or her search objective. Assessing relevancy is a complex cognitive process not completely understood by information scientists. Part of the problem is definitional: Information scientists do not have a single well-accepted definition of relevancy.<sup>24</sup> There is general agreement that relevancy consists of multiple factors, of which “topicality” (i.e., being on topic) is an essential one. However, information scientists do not agree on the number or nomenclature of other factors.<sup>25</sup>

No matter what definition is used, the fact that searchers make multifactored assessments of relevancy has two important consequences. First, two searchers with the same search objective may grade the relevancy of content differently because individual judgments will depend on idiosyncratic weightings of the factors. Second, relevancy is not a “binary” determination but will exhibit shades of gray,<sup>26</sup> as even the best search results may satisfy most, but not all, of a searcher’s criteria.

Information scientists believe that relevancy judgments occur in two stages: predictive and evaluative.<sup>27</sup> Stage 5 (results evaluation) is the predictive stage, which generally involves sorting search results based principally on topicality. Stage 7 (investigation) is the evaluative stage where the searcher evaluates a

<http://www.consumerwebwatch.org/news/searchengines/ContextReport.pdf> (in ethnographic study, twelve of seventeen participants found paid search listings helpful in ecommerce searches); Stefanie Olsen, *Software Tool Smothers Sponsored Search*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5107846.html?tag=st\\_util\\_print](http://news.com.com/2102-1032_3-5107846.html?tag=st_util_print) (Nov. 14, 2003) (citing a survey showing that 24% found sponsored search results more useful than algorithmically-generated search results and 51% found them just as useful).

<sup>24</sup> See Kelly L. Maglaughlin & Diana H. Sonnenwald, *User Perspectives on Relevance Criteria: A Comparison Among Relevant, Partially Relevant, and Not-Relevant Judgments*, 53 J. AM. SOC’Y INFO. SCI. & TECH. 327, 328–31 (2002) (stating that “there is not a consensus regarding the definition of relevance”). See generally Stefano Mizzaro, *Relevance: The Whole Story*, 48 J. AM. SOC’Y INFO. SCI. & TECH. 810 (1997) (summarizing several decades of information science research about “relevance”).

<sup>25</sup> See Rong Tang & Paul Solomon, *Use of Relevance Criteria Across Stages of Document Evaluation: On the Complementarity of Experimental and Naturalistic Studies*, 52 J. AM. SOC’Y INFO. SCI. & TECH. 676, 677–79 (2001) (summarizing the literature). Some example factors include goodness, accuracy, currency, usefulness, and importance. See Soo Y. Rieh, *Judgment of Information Quality and Cognitive Authority in the Web*, 53 J. AM. SOC’Y INFO. SCI. & TECH. 145, 152 (2002).

<sup>26</sup> See Amanda Spink & Howard Greisdorf, *Regions and Levels: Measuring and Mapping Users’ Relevance Judgments*, 52 J. AM. SOC’Y INFO. SCI. & TECH. 161 (2001).

<sup>27</sup> See Rieh, *supra* note 25, at 150.

particular search result for “quality” (i.e., the other considerations that collectively define relevancy).

In the predictive stage, searchers sort through heterogeneous search results to find relevant matches.<sup>28</sup> Sorting is not inherently detrimental to searchers. Because no search provider delivers only perfectly relevant results every time, searchers expect that they will have to sort search results.<sup>29</sup> Furthermore, sorting educates the searcher. Scanning search results for topicality gives the searcher some feedback about the searcher’s choice of keywords and search providers. For example, the searcher may realize that the chosen keywords are imprecise, capable of multiple meanings, or inferior to some other keyword.<sup>30</sup> Depending on the quantity and quality of filtering content, the searcher may also immediately fulfill the search objective just by scanning the search results (without having to do further investigation).

#### 6. *Stage 6: Decision*

Based on the searcher’s predictive judgment about the search results, the searcher decides what to do next. The searcher can continue on the same search path by further investigating one or more search results. This process is described more in Stage 7. Alternatively, the searcher may decide that a new search approach is needed, in which case the searcher may submit a new keyword to the same search provider (returning to Stage 3)<sup>31</sup> or try the same keyword at a different search provider (in which case the search returns to Stage 2).<sup>32</sup> Finally, the searcher may choose to abort the search.

<sup>28</sup> For a discussion of the different techniques used by different searcher segments, see Gord Hotchkiss, *Inside the Searcher’s Mind: It’s a Jungle in Here!*, at <http://searchenginewatch.com/searchday/article.php/3357841> (May 26, 2004).

<sup>29</sup> See Martin P. Courtois & Michael W. Berry, *Results Ranking in Web Search Engines*, available at <http://www.onlinemag.net/OL1999/courtois5.html> (May 1999). See generally Gregory Shea, Note, *Trademarks and Keyword Banner Advertising*, 75 S. CAL. L. REV. 529 (2002) (arguing that searchers do not expect to get only relevant results).

<sup>30</sup> See Nina Elkin-Koren, *Let the Crawlers Crawl: On Virtual Gatekeepers and the Right To Exclude Indexing*, 26 DAYTON L. REV. 179, 185–86 (2001) (“Search results do not simply locate materials. They construct meaning. They affect the organization and meaning of information. They structure categories in response to users’ queries, and thereby have the capacity of creating categories for grasping the world.”).

<sup>31</sup> This happens relatively infrequently. See Jansen et al., *supra* note 14, at 15 (observing that two-thirds of searchers did only one query at a search engine; only one in seven did more than two queries).

<sup>32</sup> See Danny Sullivan, *NPD Search and Portal Site Study*, at [http://searchenginewatch.com/sereport/print.php/34721\\_2162791](http://searchenginewatch.com/sereport/print.php/34721_2162791) (July 6, 2000) (noting that approximately 20% of searchers who have a failed search try a different search engine); Press Release, Vividence, Inc., *supra* note 16 (up to 47% of searchers will try another search engine when their search expectations are not met).

### 7. *Stage 7: Investigation*

In this stage, which the information scientists define as the evaluative stage, the searcher more carefully investigates the search results he or she has received. By choosing to invest that time, the searcher is indicating that the search results he or she has received appear to have some relevancy to the searcher's objective—at least topically, if nothing else.

Although described as a single stage, this stage is composed of a potentially infinite number of incremental decisions by the searcher.<sup>33</sup> As the searcher gains more information, such as by visiting another web page, the searcher makes another small calculation: Did I get what I expected?<sup>34</sup> Am I still on the right search? Will additional investigation of this website lead me to my objectives?<sup>35</sup> The more times a searcher answers "yes" to these questions, the more likely that the web publisher is succeeding in satisfying the searcher's objectives.<sup>36</sup>

Conversely, if the searcher concludes that the web publisher is not helping to achieve his or her objectives, the searcher may return to the search results page (Stage 6) and consider selecting a different result to investigate, reinitiate the search (with new keywords at Stage 3 or in a new search provider at Stage 2), or abort the search. As a practical matter, the searching process is often iterative. Evaluating and investigating search results causes searchers to refine their thinking and become more precise in their objectives.<sup>37</sup> This process, sometimes called "associative learning," means that a searcher, conducting a normal and productive search, may reach Stage 7 multiple times in a search sequence.

In all cases—even when the searcher has been "tricked" into viewing a website through unscrupulous practices—a searcher's costs to change an Internet search is trivial. The searcher need only hit the back button, type a

<sup>33</sup> See Marcia J. Bates, *The Design of Browsing and Berrypicking Techniques for the Online Search Interface*, 13 ONLINE REV. 407 (1989).

<sup>34</sup> Rieh, *supra* note 25, at 150 (stating that the evaluative judgment determines if the predictive judgment was correct).

<sup>35</sup> See Jakob Nielsen, *Deceivably Strong Information Scent Costs Sales*, at <http://www.useit.com/alertbox/20040802.html> (Aug. 2, 2004).

<sup>36</sup> Rieh, *supra* note 25, at 156.

<sup>37</sup> See ROSENFELD & MORVILLE, *supra* note 9, § 6.2.3; Rieh, *supra* note 25, at 150; Heather Lloyd-Martin, *Delving Deep Inside the Searcher's Mind*, at <http://searchenginewatch.com/searchday/article.php/3406911> (Sept. 14, 2004) (citing a statistic that 70% of searchers begin with a generic keyword and refine the term after getting the search results).

new web address into the address bar, or select a new bookmark. Any of these steps requires just a moment or two of the searcher's time. The costs to switch a web search compare very favorably to other offline searches, such as using the Yellow Pages (which require extra time to dial, reach a live person and get questions answered) or driving around town looking for a particular item (where, if a store does not have what the searcher wants, the searcher must get back into the car and drive to the next vendor).<sup>38</sup>

#### 8. *Stage 8: Objective Satisfaction*

In some cases, the searcher satisfies his or her objectives by transacting with a vendor or by fulfilling the searcher's information needs.

#### B. *Trying To Infer Searcher Objectives from Keyword Selection*

##### 1. *"Objective Opaqueness"*

Simply put, one cannot make any legally-supportable inferences about searcher objectives based on the keywords used. As already discussed, searchers do a poor job selecting keywords that represent their objectives, but this is not the core stumbling block. Instead, even if searchers picked keywords with more precision, we *still* could not infer their search objectives. This Article refers to our inability to infer searchers' objectives from their keywords as "objective opaqueness."

Objective opaqueness should not really be controversial. Words are capable of many meanings, so we always need some method to determine which meaning the searcher intends. A searcher might communicate his or her intent through very specific keywords: "I am looking to purchase a new in-the-box Canon PowerShot S400 digital camera that is not a gray-market good." In some cases, the search context will give some clues, such as a keyword search for "Canon PowerShot S400" in a search database provided by an ecommerce website that only sells digital cameras. In other cases, one can make inferences about searchers' objectives based on their behavior in response to the information presented to them: If a searcher explores the publisher's website more, chances are the searcher found the website useful; if

<sup>38</sup> Cf. G. Gervaise Davis, III & Eric B. Boustani, *Initial Interest Confusion and the Internet: A Confusion of Trademark Law Principles*, 5 J. INTERNET L. 1 (Jan. 2002) (discussing the transaction costs incurred by a retail store shopper lured by false advertising).



a searcher abandons the publisher's website, the searcher probably did not find the website useful.

In the vast majority of situations, when the searchers pick short keywords and use them in a search environment that provides no contextual clues—such as when a searcher enters a keyword into a stand-alone search engine like Google or the DNS—it is effectively impossible for anyone to accurately infer the searcher's objectives. An example illustrates the phenomenon.

Consider a searcher seeking information about the Canon PowerShot S400 digital camera. The searcher might choose keywords such as "Canon" or "PowerShot" or "S400," or the searcher could combine terms to create keywords such as "PowerShot S400" or even "Canon PowerShot S400 digital camera." Assume that a searcher chooses the last. Even with a comparatively lengthy (five words) and precise keyword, it is still unclear, merely from the chosen keyword, which of the following possible objectives the searcher has:

- *Prepurchase Information.* The searcher may want more information to facilitate a purchasing decision, such as product specifications, marketing collateral, product reviews (positive or negative), or information about product warnings or recalls. The searcher may also want comparative information, such as comparative advertising or editorial reviews comparing multiple products.
- *Purchase Information.* The searcher may have already decided to purchase the camera but needs pricing and availability information. Often, the searcher will want to know about all vendors, including third-party distributors and manufacturers who sell the product directly.<sup>39</sup> Some searchers may want or be willing to obtain the product in used condition from retailers or previous customers.
- *Postpurchase Information.* The searcher may have already purchased the camera and may be looking for postpurchase assistance, including customer support or repair or servicing information, from either the manufacturer or a third-party vendor. The searcher could also want ancillary goods or services such as training courses or after-market accessories that are compatible with the camera (camera bags, lenses, straps, tripods, etc.).

<sup>39</sup> Although the camera example makes it appropriate to discuss "manufacturers" and "products," the discussion applies equally to services and service providers.

- *Community Information.* The searcher may be looking for other camera owners to share information or form enthusiast groups or fan clubs.

The challenge of inferring search objectives is compounded because searchers rarely use such precise search terms as “Canon PowerShot S400 digital camera” even when they have a very specific search objective in mind. With less specific keywords, the range of possible search objectives expands even further.

Assume that the searcher merely used the keyword “Canon” in the search. The searcher could be looking for any product bearing the “Canon” brand, and any such product may have any of the objectives discussed above. This expands the number of possible objectives exponentially, as each of the thousands of Canon products creates dozens of additional possible search objectives. In addition, a searcher may manifest any of the following objectives through the use of the keyword “Canon”:

- *Employment Related Information.* The searcher may be looking for employment opportunities with Canon, Inc., trying to find or organize unions associated with Canon, Inc., or trying to communicate with a Canon employee.
- *Investor or Financial Information.* The searcher may be looking to buy or sell stock in Canon, Inc., or for information about Canon’s financial performance such as reporting documents required by the Securities and Exchange Commission.
- *Supplier Information.* The searcher may be trying to establish a vendor relationship with Canon, Inc., or find out who Canon’s vendors are.
- *News About Canon.* The searcher may be looking for information about Canon in the news. A Canon product may be involved in a newsworthy event, and the searcher may want to know more about it. For example, Canon sponsors the Canon Camera Museum,<sup>40</sup> so a searcher might want to know about a new exhibit running at the museum.

<sup>40</sup> Canon Camera Museum, at <http://www.canon.com/camera-museum/index.html> (last visited Apr. 1, 2005).

All of the foregoing search objectives have some relation to Canon, Inc., but other legitimate searches could have nothing to do with Canon, Inc., including the following:<sup>41</sup>

- *Trademark Uses by Third Parties.* The searcher may be looking for other parties that use the term “Canon” in their trademarks, including Chateau Canon la Gaffeliere,<sup>42</sup> Canon Law Institute,<sup>43</sup> Canongate Golf Clubs,<sup>44</sup> Canons Regular of Daylesford Abbey,<sup>45</sup> and Canon Communications LLC (a specialty publisher). Although this discussion is specific to Canon, words often have multiple legitimate trademark owners.
- *Dictionary Uses.* The searcher may be looking for information related to dictionary uses of the word “canon.” “Canon,” among other things, means a rule or law (especially in religious contexts) and a singing style.<sup>46</sup> Cañon also means “canyon” in Spanish.<sup>47</sup>
- *Place Names.* The searcher may be looking for information related to United States towns named Canon, such as Canon, Georgia,<sup>48</sup> Cañon City, Colorado,<sup>49</sup> or Canon Rivers in Washington or Minnesota.
- *Typographical Errors.* Some searchers may make a typographical error, intending to type a different term such as “cannon.”

In addition, “proxy usage” can further expand the range of possible searcher objectives. In some situations, searchers use trademarks as a “proxy” for a class of goods, of which the trademarked item is just one member of the class.<sup>50</sup> Proxy usage can be particularly common when all of the goods in the

<sup>41</sup> While some of these specific searches would be less likely to occur if the trademark were truly fanciful and unique, all of the other possible objectives apply to fanciful and nonfanciful terms equally.

<sup>42</sup> U.S. Trademark No. 2,898,806 (issued Nov. 2, 2004).

<sup>43</sup> U.S. Trademark No. 2,682,057 (issued Jan. 28, 2003).

<sup>44</sup> U.S. Trademark No. 2,549,929 (issued Mar. 19, 2002).

<sup>45</sup> U.S. Trademark No. 2,198,586 (issued Oct. 20, 1998).

<sup>46</sup> Dictionary.com, *canon*, at <http://dictionary.reference.com/search?q=canon> (last visited Jan. 18, 2005).

<sup>47</sup> *Id.*

<sup>48</sup> See City-Data.com, *Canon, Georgia*, at <http://www.city-data.com/city/Canon-Georgia.html> (last visited Apr. 1, 2005).

<sup>49</sup> See Cañon City Chamber of Commerce, at <http://www.canoncitychamber.com/> (last visited Apr. 1, 2005).

<sup>50</sup> Stephen W. Feingold, *Trademarks: Means To Avoid Confusion, or Property Rights? Two Pending Cases Outline Dilemma*, N.Y. L.J., July 26, 1999, at S2 (“For example, one highly ethical and respected advertising executive specializing in the Internet, speaking off the record, believes that someone entering

class are fungible and marketers differentiate their products principally through branding.

For example, consider a consumer who wants to purchase a pseudoephedrine-based decongestant. The consumer may not even know that the products contain pseudoephedrine but, based on heavy brand advertising, the consumer may recall the Pfizer brand “Sudafed.”<sup>51</sup> The consumer could choose the keywords “pseudoephedrine” or “decongestant,” but some consumers might choose the keyword “Sudafed” as an easier-to-remember synonym for those keywords. When searchers use “Sudafed” as a proxy, a consumer’s decision to search for “Sudafed” does not mean that the consumer intends to buy the Pfizer-branded version of pseudoephedrine.

In the case of “Canon,” some consumers might use the term as a starting point for a search for cameras, copiers, or printers. The searcher’s thought process might go something like this:

I’m interested in a digital camera but I don’t know the digital camera brands. I could do a search on the keyword “digital camera” but that might be too generic because it could include all types of cameras, from junk cameras to professional-grade cameras. I just want a good digital camera. I know that a coworker just bought a Canon PowerShot and that person has similar tastes to me. So I’ll start with the keyword “Canon PowerShot” as my initial search term to learn about that camera and, I hope, competitive cameras of the same grade.

Unquestionably, Internet trademark law would be easier if searchers did a better job selecting their keywords. Over time, education efforts may improve the keyword selection process.<sup>52</sup> In the interim, searchers’ keyword selection processes should be considered as they are, not as one might wish they would be<sup>53</sup>—and for now, keyword selection is done poorly.

HONDA in a search engine is just as likely looking for information about Japanese cars as for information specifically about Honda.”).

<sup>51</sup> See Pfizer, *Allergy Cold Cough Sinus*, at <http://www.allergy-cold.com/#Sudafed> (last visited Apr. 1, 2005).

<sup>52</sup> See generally Nielsen, *supra* note 14 (suggesting that at some point better search techniques will need to be taught in schools).

<sup>53</sup> Some courts and commentators presumptuously want searchers to change their search methodologies. See *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467, 509 (S.D.N.Y. 2003) (distinguishing between a searcher’s choice to search for a generic term like “contact lenses,” which indicates that the searcher is “clearly looking for general information,” and “1800contacts.com,” which inferentially indicates something else); Chad J. Doellinger, *Trademarks, Metatags, and Initial Interest Confusion: A Look to the Past To Reconceptualize*

## 2. *Internet Searches Differ from Physical Space Searches*

Although in many respects the Internet does not materially differ from the physical world, Internet searches differ from physical space searches in at least two principal ways.

First, Internet searchers can completely control the keyword selection process. Contrast this with mass media—such as newspapers, magazines, television, radio, and billboards—where searchers receive content unassociated with any keyword. In those circumstances, publishers and advertisers embed keywords into their content hoping that viewers will recognize the keywords and be interested in pursuing more information. In other words, mass media bombards viewers with keywords with the hope that enough viewers will find the messages relevant. Alternatively, if a viewer has selected a keyword for a search, the viewer really has very little way to receive customized information back from the mass media publisher in response to the keyword.

Even when the publisher provides an index of its content, the searcher has little control over the search. For example, consider the index in a Yellow Pages telephone book. If a searcher has a search keyword that matches the editorially selected keywords in the index, the searcher can have a successful search. However, the number of keywords supported by the index is necessarily limited and may not match the words a searcher would choose.<sup>54</sup> Thus, searchers may need to redefine their keywords to match those selected by the Yellow Pages publisher, and searchers with esoteric search terms may fail to obtain any relevant information.

*the Future*, 41 IDEA 173, 210 (2001) (“A consumer looking for optimal information regarding a wide variety of running shoes should enter ‘running shoes’ rather than ‘Nike.’”); Ira S. Nathenson, *Internet Infoglut and Invisible Ink: Spamdexing Search Engines with Meta Tags*, 12 HARV. J.L. & TECH. 43, 91–92 (1998); Note, *Confusion in Cyberspace: Defending and Recalibrating the Initial Interest Confusion Doctrine*, 117 HARV. L. REV. 2387, 2404 & n.91, 2407 (2004) (generally discussing consumers’ selection of keywords, and specifically arguing that consumers should pick “car rental” or “travel services” instead of “Hertz” or “Expedia” because the generic terms “will typically suffice to communicate the desired information to a user expressly interested in these services generally”); cf. Paul R. Hagen, *Must Search Stink?*, Forrester Research (June 2001), at 5 (quoting a manufacturing company assessing its search engine: “Most of the complaints we get are due to the way the users search—they use the *wrong* keywords.”) (emphasis added). While better keyword selection sounds great in theory, it is backwards to force consumers to pick alternative keywords instead of crafting a law that addresses consumer confusion based on the keywords searchers organically choose themselves.

<sup>54</sup> See Warren Thorngate, *The Economy of Attention and the Development of Psychology*, 31 CAN. PSYCHOL. 262, 267 (1990) (an ad hoc study showed that descriptive keywords selected by knowledgeable readers matched the article’s published keywords only 11% of the time).

In contrast, Internet searchers can affirmatively sort and receive content that responds to their keyword, rather than passively waiting for it to appear in mass media.<sup>55</sup> Internet searchers are not constrained to the keyword choices made by an intermediary publisher. When search providers index every word they find, a keyword search can succeed even if a publisher does not use the keyword in any organizational scheme.

The second way Internet keyword-driven searches differ from offline keyword-driven searches is that Internet searches can lack any “context” to make inferences about the searcher’s objectives. In offline searches, significant inferences are often possible regarding the objectives from the context when the searcher initiates a keyword-driven search. In online searches, a searcher may merely express his or her objectives using just text in a “generic” search environment. Text communication inherently limits the quantity of information a searcher can communicate. As Albert Mehrabian’s famous study indicates, 55% of a person’s communication is manifested through nonverbal means (such as posture, gestures, and facial expressions), 38% is manifested through tone of voice, and only 7% is manifested through the words themselves.<sup>56</sup> In offline searches, a searcher can use the full range of communicative elements. If the searcher telephones a merchant, the merchant can hear the tone of voice. Online, the searcher “speaks” only through text, often only a few words. It should not be surprising that, when a search is stripped down to the words itself, communicative elements are lost in the process.

Physical space searches often have a context that facilitates inferences about a searcher’s intent based on a single keyword. The following example illustrates the differences between an Internet search and an offline search. Recall the searcher using the keyword “Sudafed.” If the searcher says to a grocery store clerk “Sudafed?,” one might infer from the grocery store context that the searcher intends to purchase a decongestant.<sup>57</sup> If the searcher says to her doctor “Sudafed?,” one might infer that the searcher wants more

<sup>55</sup> See Rieh, *supra* note 25, at 146 (questioning prior research on relevance for failing to distinguish between active and passive searchers); see also Bryce J. Maynard, Note, *The Initial Interest Confusion Doctrine and Trademark Infringement on the Internet*, 57 WASH. & LEE L. REV. 1303 (2000).

<sup>56</sup> See Albert Mehrabian, *Communication Without Words*, PSYCHOL. TODAY, Sept. 1968, at 53.

<sup>57</sup> We might further infer that such a keyword search is not primarily targeting the acquisition of more information about Sudafed because, depending on the store, grocery stores often do not provide much product information beyond product packaging, meaning that such information searches will have low utility.

information about Sudafed or decongestants generally.<sup>58</sup> Meanwhile, if the searcher says to her automobile mechanic “Sudafed?,” this appears to be an ambiguous nonsequitur.

In contrast, in most Internet searches, the search environment provides no information about the searcher. Consider all of the things a search provider like Google *might not know* about an Internet searcher. Google may not know where the searcher is physically located. Google may not know the searcher’s physical status, such as if he or she is congested or teary-eyed. Google may not know what the searcher was doing immediately prior to the search—was the searcher playing computer games, telecommuting, or researching hay fever?

Therefore, it is possible for a search provider to know only one piece of information about the searcher: the chosen keyword. In the offline Sudafed examples, the grocery store clerk, the doctor and the mechanic each know where the searcher is located, what his or her physical condition is, and what the searcher was doing immediately prior to initiating the search.

Furthermore, even if the clerk, the doctor, or the mechanic cannot figure out the searcher’s objectives from the searcher’s keyword plus the associated context, the person can simply ask the searcher for more information. Thus, when a searcher says to her auto mechanic “Sudafed?,” the auto mechanic can request more information before attempting to respond to the inquiry. In contrast, many Internet search contexts do not have this iterative quality. At Google, a searcher puts the word “Sudafed” into the search box and gets results. Google does not ask searchers to clarify their search<sup>59</sup> or to provide more information about the search objectives. Thus, Google—and any fact-finder evaluating Google’s results must make inferences from a decontextualized keyword that has not been iteratively clarified.

<sup>58</sup> We might further infer that the searcher is not planning to immediately acquire Sudafed from the doctor directly, because doctors rarely vend over-the-counter pharmaceuticals to their patients.

<sup>59</sup> The only current exception is that if Google thinks the searcher made a typographical error, it may prompt the searcher by asking “did you mean [corrected word].” Google, *Google Web Search Features*, at <http://www.google.com/help/features.html#spell> (last visited Apr. 1, 2005). See *infra* note 103.

### III. INTERNET SEARCH FROM THE PUBLISHER'S PERSPECTIVE

This Part looks at the Internet search process from the second of the three perspectives. While the previous Part looked at Internet search from the searcher's perspective, this section looks at Internet search from the perspective of a publisher trying to present content to searchers.

As the previous section indicated, on the Internet, searchers choose the search terms that manifest their search objectives. As a result, publishers trying to reach searchers need to (1) anticipate what terms express search objectives<sup>60</sup> and (2) find ways to get search providers to associate the publisher's content with the keywords searchers use.

Publishers can communicate words intended to reach searchers through "data" and "metadata." In this context, "data" refers to content visibly presented when web visitors arrive at a web page, such as the web page's text. Sometimes this is defined as "on the page" content.<sup>61</sup> "Metadata" refers to content about the web page that describes or summarizes the page,<sup>62</sup> such as the page title, the page URL or domain name, and "metatags."

"Metatags" are HTML commands that allow web publishers to provide automated instructions to search engine robots.<sup>63</sup> Two types of metatags,

<sup>60</sup> Jill Whalen, *Even Small Businesses Can Gain Valuable Search Traffic*, at [http://www.searchengineguide.com/whalen/2005/0113\\_jwl.html](http://www.searchengineguide.com/whalen/2005/0113_jwl.html) (Jan. 13, 2005); see Google, *Optimization Tips*, at <https://adwords.google.com/select/tips.html> (last visited Apr. 1, 2005); see also Daina J. Schemo, *In Online Auctions, Misspelling in Ads Often Spells Cash*, N.Y. TIMES, Jan. 28, 2004, at A1 (discussing the financial impact to eBay auction sellers of making typographical errors in their auction listings, meaning that searchers using the correct spelling do not find them).

This process of assessing the keywords consumers use is sometimes called "keyword research." See Bryan Eisenberg, *Keyword Research: Optimization for Conversion*, at <http://www.clickz.com/experts/design/traffic/print.php/3086411> (Oct. 3, 2003).

<sup>61</sup> In contrast, attributes outside the publisher's control (such as anchor text and inbound links) are referred to as "off the page" factors. Danny Sullivan, *How Search Engines Rank Web Pages*, at [http://searchenginewatch.com/webmasters/print.php/34751\\_2167961](http://searchenginewatch.com/webmasters/print.php/34751_2167961) (July 31, 2003).

<sup>62</sup> Technically, "metadata" is usually defined as "data about other data." See Tim Oren, *Metadata: Promises and Perils*, Due Diligence, at <http://www.pacificavc.com/blog/2003/08/21.html> (Aug. 21, 2003); see also *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029, 1045 (C.D. Cal. 2003), *aff'd*, 380 F.3d 1154 (9th Cir. 2004) (discussing metadata in the context of MP3 files), *cert. granted*, 125 S. Ct. 686 (2004).

<sup>63</sup> See Danny Sullivan, *How To Use HTML Meta Tags*, at [http://searchenginewatch.com/webmasters/print.php/34751\\_2167931](http://searchenginewatch.com/webmasters/print.php/34751_2167931) (Dec. 5, 2002). Although metatags (other than the title) do not appear in "on the page" content, any web visitor can see a web page's metatags by using the "View Source" option in his or her web browser, and the description metatag may appear in the filtering content at search engines.



“keyword metatags” and “description metatags,” deserve special attention. Keyword metatags allow the publisher to designate certain keywords that summarize or classify a web page’s contents without those references appearing in the “on the page” content.<sup>64</sup> Description metatags allow the publisher to provide a short summary of the website’s contents that does not appear in the “on the page” content,<sup>65</sup> although in some cases search engines will display the description metatag’s content as part of the filtering content for that page.

Keyword metatags and description metatags are not the only metatag types; there are hundreds of metatags with a variety of purposes.<sup>66</sup> Each metatag type’s “validity” depends on the degree to which it is recognized and adopted by web browser software programs and search providers. Some metatag types have been incorporated into widely recognized standards such as the specifications for HTML. Many other metatag types are recognized by only one or two search providers or web browsers, so few publishers use those metatags.

The Internet creates a virtually unprecedented information environment because both data and metadata can be fully searchable by search providers, meaning that every word a publisher includes in its website can act as marketing for the publisher. In other words, publishers who incorporate a keyword into their website may be displayed, through the intermediation of search providers, in the search results for that term, which may lead searchers to investigate the website.

This attention from searchers can translate into money, either directly through revenue models that pay based on the number of visitors (such as banner advertisements which pay per impression) or indirectly because some web visitors may choose to transact with the web publisher or those the web publisher promotes.<sup>67</sup> With money at stake, not surprisingly, some publishers

<sup>64</sup> Brookfield Communications, Inc. v. W. Coast Entm’t Corp., 174 F.3d 1036, 1045 (9th Cir. 1999).

<sup>65</sup> *Id.*

<sup>66</sup> See A Dictionary of HTML META Tags, at <http://vancouver-webpages.com/META/metatags.detail.html> (Apr. 4, 2003).

<sup>67</sup> In the mid- and late-1990s, many advertisers paid for each ad impression delivered to a website visitor. Thus, a website that attracted searchers would increase its inventory of ad impressions and make more money, even if searchers were misled about the website’s relevance to their search. See Maureen A. O’Rourke, *Defining the Limits of Free-Riding in Cyberspace: Trademark Liability for Metatagging*, 33 GONZ. L. REV. 277, 284, 302–03 (1998); William Romanos, *Internet Accuracy Wars: How Trademarks Used in Deceptive Metatagging Should Be Dealt with To Increase Economic Efficiency*, 7 U. BALT. INTELL. PROP. L.J. 79, 80 (1998). Because these practices did not create real economic value, advertisers have largely moved away from

will use data or metadata to try to attract more searchers from search providers.<sup>68</sup> Not only is this fact inevitable, but in many cases it constitutes a socially efficient process. Publishers will try to get search providers to associate their website with the keywords being used by desired searchers. If publishers pick the right keywords, and search providers make the right matches, social search costs decrease and society benefits generally.

Unfortunately, not every publisher uses keywords in a manner that increases social utility. Some publishers deliberately select (and in some cases, excessively repeat) keywords that have no relevance to the content they are publishing.<sup>69</sup> In other cases, publishers may place keywords in strategic locations on the web page hoping that search providers will overweight that placement, giving the publisher more attention than it deserves. However, in other cases, publishers' keyword selection and placement decisions may look funny but still may be legitimate; for example, this Article repeatedly uses the term "Canon PowerShot S400 digital camera" and search providers will index the Article on that term—even though this Article has zero or low relevance to searchers using that keyword.

More generally, it is not possible to conclude that a publisher's keyword use is objectionable without understanding the searcher's objectives. Searchers may use the same keyword for a variety of different meanings. In some cases, publishers legitimately select keywords that relate to their content, but that particular use of the keyword will be relevant to only a minority of searchers, meaning that the majority of searchers would deem the keyword usage irrelevant. Squelching the publisher's use of the keyword in this context

paying solely based on the number of ad impressions, instead preferring to pay based on a website's performance in generating qualified leads or actual sales. See J. William Gurley, *The Persistent Rise of Performance-Based Advertising*, CNET News.com, July 10, 2000, at [http://news.com/2102-1071\\_3-281334.html?tag=st.util.print](http://news.com/2102-1071_3-281334.html?tag=st.util.print). As a result, the ability to obtain greater advertising revenues merely by tricking users to visit a website has declined substantially (except, perhaps, in narrow ad sectors like pornography).

<sup>68</sup> See Michael Totty & Mylene Mangalindan, *Cat and Mouse: As Google Becomes Web's Gatekeeper, Sites Fight to Get In*, WALL ST. J., Feb. 26, 2003, at A1.

<sup>69</sup> These practices are variously called keyword stuffing (or word stuffing or cyberstuffing), keyword loading, spamdexing, keyword repetition and search engine spamming. See Webopedia, *Keyword Stuffing*, at [http://www.webopedia.com/TERM/K/keyword\\_stuffing.html](http://www.webopedia.com/TERM/K/keyword_stuffing.html) (last visited Apr. 1, 2005). See generally J.K. Harris & Co. v. Kassel, 2002 WL 1303124 (N.D. Cal. Mar. 22, 2002), *vacated by* 253 F. Supp. 2d 1120 (N.D. Cal. 2003) (discussing the various efforts the defendant, a critic of plaintiff, took to manipulate search results placement); Alan Perkins, *The Classification of Search Engine Spam*, at <http://www.seoconsultants.com/articles/1000/search-engine-spam.htm> (last visited Jan. 28, 2005).

Many search engines prohibit keyword stuffing and penalize violators with sanctions as severe as being excluded from the index. See Webopedia *supra*.

may destroy the publisher's ability to find and communicate with nonmajority searchers.

#### IV. INTERNET SEARCH FROM THE SEARCH PROVIDER'S PERSPECTIVE

This Part represents the third of three different perspectives on Internet search and looks at Internet search from the search provider's perspective.

##### A. *Search Providers Are Editors, Not Passive Intermediaries*

Compared with other types of search providers, search engines often portray themselves as passive intermediaries for web publishers' content and ads.<sup>70</sup> Adherents to this view see search engines as defenseless against the abusive tactics of web publishers seeking to "confuse" the search engines.<sup>71</sup>

There are some kernels of truth to this position. Search engines often automatically collect data, so publishers may be able to cause the robot to capture both good and "unwanted" content. Further, many web publishers aggressively try to "game" search engines in an effort to get as much searcher attention as possible. Indeed, an entire industry of "search engine optimizers" has emerged to help web publishers maximize their positioning under search engines' various rules.<sup>72</sup>

However, it is 100% wrong to treat search engines as passive agents for publisher content. Search engines are media companies, not neutral providers of information.<sup>73</sup> Thus, search engines often view their search database as a

<sup>70</sup> See David Becker, *Google Caught in Anti-Semitism Flap*, CNET News.com, at [http://news.com.com/2102-1038\\_3-5186012.html?tag=st.util.print](http://news.com.com/2102-1038_3-5186012.html?tag=st.util.print) (Apr. 7, 2004) (quoting Google spokesperson David Krane as saying "Google's search results are solely determined by computer algorithms that essentially reflect the popular opinion of the Web . . . . Our search results are not manipulated by hand. We're not able to make any manual changes to the results."); Google, *Trademark Complaint Procedure*, at [http://www.google.com/tm\\_complaint.html](http://www.google.com/tm_complaint.html) (last visited Apr. 1, 2005) ("As a provider of space for advertisements, please note that Google is not in a position to arbitrate trademark disputes between the advertisers and trademark owners.") (emphasis added).

<sup>71</sup> See J. Thomas McCarthy, *Trademarks, Cybersquatters and Domain Names*, 10 J. ART. & ENT. L. 231, 234 (2000); Nathenson, *supra* note 53, at 118.

<sup>72</sup> See, e.g., Heather Lloyd-Martin, *Secrets of Successful Search Engine Optimization*, at [http://searchenginewatch.com/searchday/print.php/34711\\_2175081](http://searchenginewatch.com/searchday/print.php/34711_2175081) (Mar. 6, 2003) (describing how Search Engine Optimizations ("SEOs") can help publishers).

<sup>73</sup> Cf. *Search King, Inc. v. Google Tech., Inc.*, 2003 WL 21464568 (W.D. Okla. May 27, 2003) (characterizing the ranking of a publisher via the relevancy algorithm as an "opinion").

proprietary asset<sup>74</sup> that they tightly control to provide a quality user experience and, not coincidentally, maximize profits.

To debunk any remaining myths about search engine passivity, it is helpful to consider the ways that search engines control their searchers' experiences:

### 1. Aggregation

Search engines try to build comprehensive databases,<sup>75</sup> but no search engine incorporates every page on the Internet into their database.<sup>76</sup> Instead, search engines make editorial choices about which websites to include in their database. Search engines may remove websites based on a publisher's overzealous efforts to game the search engine's system<sup>77</sup> or due to liability concerns.<sup>78</sup> In other cases, search engines may choose not to index certain websites based on the costs and benefits of catering to esoteric interests.<sup>79</sup>

<sup>74</sup> Cf. *eBay, Inc. v. Bidder's Edge, Inc.*, 100 F. Supp. 2d 1058 (N.D. Cal. 2000) (discussing eBay's attempts to keep its database of third party auction listings proprietary).

<sup>75</sup> See Danny Sullivan, *Search Engine Size Wars V Erupts*, at <http://blog.searchenginewatch.com/blog/041111-084221> (Nov. 11, 2004). Database comprehensiveness benefits searchers because it increases the odds that searchers with esoteric search objectives will have a successful search.

<sup>76</sup> The "Deep Web" refers to content available online that is not indexed by search engines. This content may be inaccessible to search robots because the content is presented on dynamically generated pages, which the robots cannot access. See Michael K. Bergman, *The Deep Web: Surfacing Hidden Value*, 7 J. ELECTRONIC PUBLISHING, Aug. 2001, available at [http://www.press.umich.edu/jep/07\\_01/bergman.html](http://www.press.umich.edu/jep/07_01/bergman.html). However, content may also be excluded because publishers instruct search robots to bypass them, which can be done by placing a robot exclusion header into a robots.txt file. Other reasons content may not appear in search engines is that a search engine simply cannot handle the volume of data, the content cannot be found by search engines because no one links to it, the content is new and the search engines have not indexed it yet, or because (as discussed later) the search engines choose not to include it. Note also that even if a search engine indexes a page, it may not index the entire page if the page is a large file. See Sullivan, *supra* note 75.

<sup>77</sup> See *Search King*, 2003 WL 21464568, at \*3; Stefanie Olsen, *Search Engines Delete Adware Company*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5212479.html?tag=st.util.print](http://news.com.com/2102-1024_3-5212479.html?tag=st.util.print) (May 13, 2004) (Google and Yahoo kicked WhenU.com out of their databases for allegedly engaging in cloaking).

<sup>78</sup> See Letter from Ava Paquette, attorney at Moxon & Kobrin and counsel for the Church of Scientology, to Google, Inc. (Mar. 8, 2002), available at <http://www.chillingeffects.org/dmca512/notice.cgi?NoticeID=232> (demanding that Google remove content from its database that was indexed from a website critical of the Church of Scientology based on both copyright and trademark grounds). Google honored this request. Declan McCullagh, *Google Yanks Anti-Church Sites*, at <http://www.wired.com/news/print/0,1294,51233,00.html> (Mar. 21, 2002).

<sup>79</sup> Lucas D. Introna & Helen Nissenbaum, *Shaping the Web: Why the Politics of Search Engines Matters*, INFO. SOC'Y, July -Sept. 2000, at 169; see also Elkin-Koren, *supra* note 30, at 188.

## 2. *Sorting*

Search engines determine the order of search results using a proprietary methodology called a “relevancy algorithm.” Algorithms can be based on a wide variety of factors,<sup>80</sup> and they do not need to be sophisticated. For example, search engines could order results alphabetically or by date of publication.<sup>81</sup> However, most search engines use complex formulas in an attempt to get the most relevant results to the top of the search results list.

For example, Google’s algorithm purportedly considers 100 different factors,<sup>82</sup> including words in the page title, words on the page (including their proximity to each other), words contained in the hypertext links established by third parties to that page (called “anchor text”), and the page’s “PageRank,” a complex and data-intensive calculation that considers the number and quality of hypertext links pointing to the web page.<sup>83</sup>

Search engines can also use cash as a “relevancy algorithm” by sorting search results based on how much the publisher is willing to pay for placement. This sorting method has received a lot of criticism, often on the basis that it is unfair for publishers to purchase competitor trademarks,<sup>84</sup> that search engines should not profit from the sale of trademarks, or that consumers do not understand that search engines are using cash as a relevancy algorithm. Whether or not these critiques are fair, sorting search results on the basis of publishers’ willingness to pay can work well because it forces publishers to carefully assess the value of being associated with a particular keyword. If a publisher overestimates the relevancy of a keyword association to searchers, the publisher overpays for searchers who are not interested in the publisher. Thus, rank-ordering publishers based on their willingness to pay implicitly introduces market forces into the publishers’ attempts to characterize their relevancy to searchers.

<sup>80</sup> See generally RICARDO BAEZA-YATES & BERTHIER RIBEIRO-NETO, *MODERN INFORMATION RETRIEVAL* (1999).

<sup>81</sup> See Greg R. Notess, *On the Net: Rising Relevance in Search Engines*, available at <http://www.onlinemag.net/OL1999/net5.html> (May 1999). For example, Nexis search results are, as a default, organized by date. Google News gives users the option to sort search results by date.

<sup>82</sup> Chris Ridings & Mike Shishigin, *PageRank Uncovered* 35 (Sept. 2002), at <http://www.texaswebdevelopers.com/docs/pagerank.pdf>.

<sup>83</sup> *Id.* at 8.

<sup>84</sup> See G. Peter Albert, Jr. & Rita A. Abbati, *Metatags, Keywords, and Links: Recent Developments Addressing Trademark Threats in Cyberspace*, 40 *SAN DIEGO L. REV.* 341, 358–59 (2003) (describing the practice as “predatory”).

Regardless of which relevancy algorithms search engines use, their importance to the Internet search process cannot be overstated. As a practical matter, relevancy algorithms determine the results that searchers see and investigate. Searchers do not generally look at search results beyond the first page or two,<sup>85</sup> which is a result consistent with bounded rationality.<sup>86</sup> Thus, web publishers who fail to get into the zone of visibility will not reach searchers.<sup>87</sup> In turn, degraded exposure can materially impact a publisher's business and profits.<sup>88</sup> Because searchers invariably judge the search provider's performance based on the relevancy of the top results, a search engine's decisions about what factors to include and exclude in a relevancy algorithm, and how to weigh each factor, are not made lightly.<sup>89</sup>

<sup>85</sup> See Jansen et al., *supra* note 14 (over three-fourths of searchers looked at only one or two pages); Marable, *supra* note 23, at 13 (88% of search results links selected in ethnographic study were from the first page of search results). See generally Nico Brooks, *The Atlas Rank Report: How Search Engine Rank Impacts Traffic*, Atlas Institute Digital Marketing Insights, available at <http://www.atlasdmt.com/media/pdfs/insights/RankReport.pdf> (June 2004) (the first ranked search result should see ten times the quantity of clicks as the tenth ranked search result); iProspect, *supra* note 23 (discussing users' unwillingness to look at more than two search results pages).

<sup>86</sup> See Herbert A. Simon, *A Behavioral Model of Rational Choice*, 69 Q.J. ECON. 99 (1955).

<sup>87</sup> Some have expressed concerns that searchers who receive too many search results will abort their search in frustration. See *Teletech Customer Care Mgmt., Inc. v. Tele-Tech Co.*, 977 F. Supp. 1407, 1410 (C.D. Cal. 1997); Doellinger, *supra* note 53, at 211 ("If every shoe and athletic apparel company were allowed to include the 'Nike' trademark in the metatags of their web sites, it would make it much more difficult for someone actually searching for the Nike web site. Moreover, if every web site for every major shoe company contained the trademarks of every other major shoe company in the metatags of their web sites, the ability of a web user to find any given web site would be greatly reduced."); Gerard N. Magliocca, *One and Inseparable: Dilution and Infringement in Trademark Law*, 85 MINN. L. REV. 949, 1028-32 (2001).

This thinking is erroneous because of bounded rationality. If searchers focus only on the top search results, the quantity of "inferior" search results they ignore is irrelevant. However, if the top search results are not relevant, the searcher may abort the search out of frustration because the searcher will not sift through a larger dataset to find the desired information. See Marable, *supra* note 23.

<sup>88</sup> See Totty & Mangalindan, *supra* note 68 (discussing how a clothing retailer's sales dropped 80% after its search results placement had been degraded in Google's index); Adam L. Penenberg, *Googling the Bottom Line*, at <http://www.wired.com/news/print/0,1294,66485,00.html> (Feb. 3, 2005) (quantifying the traffic and revenue gains from improved positioning on results lists).

<sup>89</sup> See *Search King, Inc. v. Google Tech., Inc.*, 2003 WL 21464568 (W.D. Okla. May 27, 2003) (discussing the subjective nature of deciding what factors to include or exclude and how much weight to give each); see also Stefanie Olsen, *Ask Jeeves Denounces Paid Inclusion*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5168805.html?tag=st.util.print](http://news.com.com/2102-1024_3-5168805.html?tag=st.util.print) (Mar. 2, 2004) ("After much testing of paid inclusion, [Ask Jeeves] found that it can negatively sway search results—producing more commercial and irrelevant lists of Web sites" which led Ask Jeeves to end its paid inclusion program); Stefanie Olsen, *MSN To Shake Up Search Ads*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5176197.html?tag=st.util.print](http://news.com.com/2102-1024_3-5176197.html?tag=st.util.print) (Mar. 19, 2004) (discussing how MSN decided to make changes to its search engine based on testing of consumer responses).

Amazon.com signaled the importance of algorithms when it hired a "Chief Algorithms Officer" reporting to the Chief Information Officer. See Margaret Kane, *Amazon Hires Algorithm Guru*, CNET News.com, at [http://news.com.com/2102-1017\\_3-965068.html?tag=st\\_util\\_print](http://news.com.com/2102-1017_3-965068.html?tag=st_util_print) (Nov. 8, 2002).

Because the relevancy algorithm can affect how much money they earn, web publishers want to learn the algorithm<sup>90</sup> and optimize their content for maximum exposure. In practice, this creates an arms race between search engines and web publishers.<sup>91</sup> Search engines start the cycle by making a change to their relevancy algorithm. In response, some web publishers (especially those guided by search engine optimizers) do everything they can to benefit from the change, and some web publishers succeed in getting premium exposure for content the search engine does not want to be so highly ranked. The search engine responds with a new change, and the cycle starts over. The process virtually mandates that search engines constantly change their relevancy algorithms.<sup>92</sup>

In the end, though, search engines decide how to order search results, not publishers. Publishers are at the mercy of search engine changes, meaning that a publisher can be the top-ranked search result one day and out of the index on the next day—even if the publisher does not change its website at all. The volatility of results can be attributed to relevancy algorithm changes by the search engines,<sup>93</sup> but it can also be due to changes made by third parties in anchor text or in the number of links third parties make to the publisher's website.

Some commentators have claimed that manipulative web publisher practices threaten the viability of search engines.<sup>94</sup> In fact, the exact opposite is true. First, search engines expect these practices. Second, abusive publisher

<sup>90</sup> To make it harder for publishers to game the algorithm (and to slow down competitors), search engines zealously keep their algorithms secret. See *Search King Inc. v. Google Tech., Inc.*, No. CIV-02-1457-M, at 3 n.2 (W.D. Okla. Jan. 13, 2003) (“Google’s mathematical algorithm is a trade secret, and it has been characterized by the company as ‘one of Google’s most valuable assets.’”); Stefanie Olsen, *Project Searches for Open-Source Niche*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5064913.html?tag=st\\_util\\_print](http://news.com.com/2102-1032_3-5064913.html?tag=st_util_print) (Aug. 18, 2003).

<sup>91</sup> See Totty & Mangalindan, *supra* note 68 (discussing the “arms race[] between big search engines” and search engine optimizers); Notess, *supra* note 81 (“It becomes a never-ending cycle.”); Romanos, *supra* note 67, at 94 (noting that an arms race produces social costs but also may spur innovation). See generally O’Rourke, *supra* note 67, at 286 (discussing search engine antigaming practices).

<sup>92</sup> See Stefanie Olsen, *Google Co-Founder: No Rush for IPO*, CNET News.com, at [http://news.com.com/2102-1025\\_3\\_5066227.html?tag=st\\_util\\_print](http://news.com.com/2102-1025_3_5066227.html?tag=st_util_print) (Aug. 20, 2003) (citing Google cofounder Sergey Brin as saying that Google “tests half a dozen new algorithms a month and implements some subset of those”); Ridings & Shishigin, *supra* note 82, at 35.

<sup>93</sup> These changes could be the product of general algorithmic changes or targeted at specific publishers or practices. See *Search King*, No. CIV-02-1457-M at 4 (“Google knowingly and intentionally decreased the PageRanks assigned to both SearchKing and PRAN.”).

<sup>94</sup> See McCarthy, *supra* note 71, at 236 (keyword stuffing in metatags “tends to destroy the usefulness of a search engine”).

practices may endanger search engines with easily gamed algorithms, but search engines with robust algorithms can withstand these tests. Gaming efforts give search engines an additional basis for competitive differentiation—the search engine that does a better job avoiding or mitigating these efforts will produce more relevant results and be rewarded in the marketplace accordingly. Web publisher games do not jeopardize search engines; instead, they are a vital component of a dynamic and constantly improving search engine industry.

Some courts and commentators have suggested that a publisher's liability for trademark infringement based on using a third party trademark might depend on if the publisher succeeds in being ranked higher than a trademark owner in search results.<sup>95</sup> However, any such suggestion seems illogical given the practical logistics of search result placement:<sup>96</sup> Search engines and third parties affect placement regardless of what the publisher does, placement can change daily or even more frequently, and placement can vary significantly between different search engines.<sup>97</sup>

### 3. *Filtering Content*

Search engines also make editorially significant judgments about the presentation of filtering content (if any).<sup>98</sup> Filtering content can educate and influence the searcher, affecting the searcher's interest in pursuing a search result and setting the searcher's expectations for the web publisher's content. As part of managing the "user interface," search engines decide how much filtering content searchers see and in what order and prominence.

<sup>95</sup> See *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 804 (9th Cir. 2002) (indicating that it might have changed its ruling if Welles had successfully shown up higher than Playboy in the search engines); *J.K. Harris & Co. v. Kassel*, 2002 WL 1303124 (N.D. Cal. Mar. 22, 2002) (finding infringement based on the defendants' efforts to move up in the search results), *vacated by* 253 F. Supp. 2d 1120 (N.D. Cal. 2003); see also Doellinger, *supra* note 53, at 205–09 (proposing a complicated system of liability based on the relative placement of the trademark owner's search results and an interloper's search results). But see *Search King, Inc. v. Google Tech., Inc.*, 2003 WL 21464568, at \*4 (W.D. Okla. May 27, 2003) (rejecting relative placement as the basis of search engine liability).

<sup>96</sup> Cf. Doellinger, *supra* note 53, at 208 n.194 (raising but sidestepping the issue).

<sup>97</sup> See Jakob Nielsen, *Diversity Is Power for Specialized Sites*, at <http://www.useit.com/alertbox/20030616.html> (June 16, 2003) (showing that search engines had little overlap in search results for specialized topic searches).

Of course this proposal also simply cannot work for words that have multiple trademark owners. More generally, searchers want the most relevant results, and there could be situations where a third party site is considered more relevant than the trademark owner's site.

<sup>98</sup> Cf. *Kelly v. Arriba Soft Corp.*, 280 F.3d 934, 947 (9th Cir. 2002) (discussing how the visual search engine Ditto.com was more than a passive agent in the way it delivered its visual search results).



#### 4. *Reinterpreting Searcher Keywords*

In their goal to satisfy searcher objectives, search engines invariably put words into searchers' mouths. They do so in at least two different ways. First, to better anticipate searchers' objectives, the search engines reinterpret the searcher's keyword to mean something the searcher did not say.

"Concept searching" is an example of this phenomenon. Using concept searching, a search engine associates a searcher's keyword with related words or concepts, such as synonyms. For example, a search engine might automatically interpret the keyword "GPS" to include "Global Positioning System," and then automatically execute a search on both the keywords "GPS" and "Global Positioning System." Search engines can also use concept searching to place keywords in taxonomies and to execute a search for both the specific and general levels within the taxonomy. For example, a concept search on the keyword "Canon PowerShot S400" might automatically include search results generated from the keyword "digital camera."<sup>99</sup> In such situations, search engines must editorially determine what taxonomical associations to make.

Concept searching can also be used on a much more mechanical level. Search engines can automatically detect and correct typographical errors—a search on "recieve" can be interpreted as a search on "receive"—or automatically truncate the keyword to a "word stem" and look for all words containing that word stem.<sup>100</sup>

A variation of concept searching is called "phrase recognition." With phrase recognition, the search engine automatically detects a multiword keyword as a phrase and limits its search to the phrase (as opposed to finding results containing the words individually).<sup>101</sup>

Second, search engines provide suggested keywords to searchers. For example, Yahoo Search and Snap (a new search engine) provide alternative

<sup>99</sup> See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1023 (9th Cir. 2004) (search engine bundled keywords for sale, requiring advertisers to buy the package even if certain keywords were not wanted).

<sup>100</sup> The process of searching for all words containing a word stem is sometimes called "truncation." See Signpost, *Use Search Tips: Truncate Words*, at <http://www.marquette.edu/library/thesignpost/truncation.html> (last visited Apr. 1, 2005). Other analogous processes include searching the plural form of a singular word (or vice-versa), or different forms of word tenses (such as including "written" in any search for "write").

<sup>101</sup> See Notess, *supra* note 81.

search keywords at the top of search results pages,<sup>102</sup> and Google is testing a product called “Google Suggest” that automatically scans the search box and displays possible search keywords.<sup>103</sup>

### 5. *Editing Publisher Content*

In addition to putting words in searchers’ mouths, search engines put words into web publishers’ mouths. Specifically, search engines associate metadata with publisher content, in many cases without the publisher knowing or being able to control this association. These associations can cause the web publisher to be displayed as a search result for keywords that the web publisher did not use at all.

For example, some search engines include anchor text, the third party words used to establish links, in the data associated with the linked web page. Web publishers cannot control the words third parties use to link to their websites, creating the potential that a web publisher will show up in search results for words it never used. This exploit has become so well known that it has a name: “Google bombing.” Google bombing occurs when third parties link to a web publisher using carefully chosen anchor text, which causes the publisher to appear as a top Google search result for keywords in the anchor text.<sup>104</sup> Victims of Google bombing include AOL and Microsoft, both listed in search results for the keyword “go to Hell;”<sup>105</sup> Disney, which has been listed in search results for pornographic keywords;<sup>106</sup> George W. Bush’s website, listed in search results for “miserable failure;”<sup>107</sup> and the first publicized victim of

<sup>102</sup> See Stefanie Olsen, *MSN Launches Revamped Search Engine*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5254083.html?tag=st.util.print](http://news.com.com/2102-1032_3-5254083.html?tag=st.util.print) (June 30, 2004) (giving the example of how a search for the word “Apple” will cause Yahoo Search to prompt searchers to try “Apple Computer” as their keyword); Stefanie Olsen, *New Snap Site Thinks Outside the Search Box*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5397793.html?tag=st.util.print](http://news.com.com/2102-1032_3-5397793.html?tag=st.util.print) (Oct. 5, 2004).

<sup>103</sup> See Google Suggest, at <http://www.google.com/webhp?complete=1&hl=en> (last visited Apr. 1, 2005).

<sup>104</sup> See BBC News, *Google Hit by Link Bombers*, at <http://news.bbc.co.uk/1/hi/sci/tech/1868395.stm> (Mar. 13, 2002); Danny Sullivan, *Google’s (and Inktomi’s) Miserable Failure*, at <http://www.searchenginewatch.com/sereport/article.php/3296101> (Jan. 6, 2004). See generally John Hiler, *Google Time Bomb*, at <http://www.microcontentnews.com/articles/googlebombs.htm> (Mar. 3, 2002) (analyzing the phenomenon in some detail and subcategorizing the phenomenon into humor bombs, ego bombs, money bombs, and justice bombs).

<sup>105</sup> See Linda Rosencrance, *Google Search Leads to Gates of “Hell”*, at <http://www.computerworld.com/printthis/2002/0,4814,74566,00.html> (Sept. 25, 2002).

<sup>106</sup> See CNN.com, *Google Blips: Search Not Always Right*, at <http://www.electricsheep.us/story/EpFFuEEypVzCrzbNag.shtml> (Sept. 30, 2002) (abridged version).

<sup>107</sup> See Tom McNichol, *Your Message Here*, N.Y. TIMES, Jan. 22, 2004, at G1 (noting that Yahoo, HotBot, and MSN also were affected by the bombing).

Google Bombing, programmer Andy Pressman, whose “friend” caused Pressman’s website to be listed as the top search result for “talentless hack.”<sup>108</sup>

A different example of Google putting words into publishers’ mouths occurs with Google’s “description” line of filtering content. Traditionally, publishers used description metatags with the hope that search engines would display them as filtering content. However, in some circumstances, Google will automatically generate its own description using “snippets” from the web page, or it will use descriptions authored by members of the Open Directory Project.<sup>109</sup>

Compared to their approaches to algorithmically generated search results, search engines exercise even more editorial control over advertising they run, taking down (or leaving up) advertising capriciously.<sup>110</sup>

## 6. *Reinterpreting Publisher Keywords*

Many search engines sell keyword-specific advertisements to publishers. For example, Canon may pay Google to display an ad for the Canon PowerShot S400 every time a searcher searches on the keyword “digital camera.” However, search engines may interpret the advertiser-selected keywords to include other keywords that the search engine believes are

<sup>108</sup> See *id.*

<sup>109</sup> See Google, *My Site’s Listing Is Incorrect*, at <http://www.google.com/webmasters/3.html> (last visited Apr. 1, 2005).

For example, an ODP volunteer editor wrote the following description for my personal website at [http://eric\\_goldman.tripod.com](http://eric_goldman.tripod.com): “The author’s speeches, articles, perspectives on cyberspace law and internet law, the reasons for his name change, and favorite vegetarian restaurants.” See <http://search.dmoz.org/cgi-bin/search?search=eric+goldman> (last visited Jan. 28, 2005). On February 22, 2004, this exact language was associated with my personal site in Google (although the language truncates after “for”). See <http://www.google.com/search?hl=en&ie=UTF-8&oe=UTF-8&q=%22eric+goldman%22> (last visited Apr. 1, 2005). I did not write that language, and the description does not appear anywhere on my personal website.

Google’s composition of “snippets” has prompted at least one lawsuit because a Certified Public Accountant believed that the search results language falsely represented that he had been disciplined for certain violations. See Seth Fineberg, *Calif. CPA Sues Google Over “Misleading” Search Results*, ACCT. TODAY, Apr. 19, 2004, at 5.

<sup>110</sup> See Verne Kopytoff, *Google’s Ad Rules Complex, Controversial*, S.F. CHRON., Aug. 9, 2004, at F1, F5 (quoting Google’s vice president of global online sales and operations as saying “our [ad] policies will always involve an element of discretion and we reserve the right to reject or approve any ads”); *Google Guys*, PLAYBOY, Sept. 2004, 55, 56–57 (quoting Google founder Sergey Brin as saying “we don’t accept ads for hard liquor, but we accept ads for wine. It’s just a personal preference . . . . We don’t try to put our sense of ethics into the search results, but we do when it comes to advertising.”). For an example of Google’s arbitrariness, see, e.g., MSNBC, *Google Bans Environmental Group’s Ads*, Feb. 13, 2004, at <http://www.msnbc.msn.com/id/4263590/> (reporting that Google dropped a protest ad against Royal Caribbean Cruises because it does not accept ads with “language that advocates against Royal Caribbean”).

conceptually related, much like the search engines reinterpret searcher keywords in concept searching. For example, Google may cause Canon's ad to be displayed in response to a search on "nikon digital camera," a process that Google calls "broad matching."<sup>111</sup> Canon may not even realize that competitive trademarks are included in the broad matched set. In the future, search providers will go further and automatically tell publishers what keywords they should use for advertising.<sup>112</sup>

### 7. *Advanced Technologies*

Search engines are constantly looking for new ways to service searcher needs. In the long-term, searching may be redefined by collaborative filtering or artificial intelligence,<sup>113</sup> the use of personal data or past behavior to provide a context for a keyword search,<sup>114</sup> and more customized sorting based on geography or using individualized relevancy algorithms.<sup>115</sup> In many cases, these advanced technologies will require the search engine to play an even more active editorial role in sorting and presenting search results. In the shorter-run, search engines will attempt to solve searcher needs through techniques like merchandising search results (telling searchers "If you like X, you will really like Y") and presenting more variations of filtering content.<sup>116</sup>

<sup>111</sup> See Google, *Expanded Broad Keyword Matching*, at [https://adwords.google.com/select/expanded\\_matching.html](https://adwords.google.com/select/expanded_matching.html) (last visited Apr. 1, 2005). Netscape and Excite used a variation of the practice, requiring advertisers to purchase a "bundle" of keywords that would trigger the ads. See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1023 (9th Cir. 2004).

<sup>112</sup> See Stefanie Olsen, *Google Preps New Tool To Juice Revenue*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5208492.html?tag=st\\_util\\_print](http://news.com.com/2102-1024_3-5208492.html?tag=st_util_print) (May 10, 2004); Pamela Parker, *Google Widens Test to Froogle Merchants*, at <http://www.clickz.com/news/print.php/3428811> (Oct. 29, 2004) (discussing Google "ad automator" tool that automatically scans merchant product feeds to recommend keywords that the merchant should purchase). But see *Société des Hôtels Meridien v. S.A.R.L. Google France*, NRG 04/3772 (T.G.I. Nanterre, Dec. 16, 2004), available at [http://www.juriscom.net/documents/tgin\\_anterre20041216.pdf](http://www.juriscom.net/documents/tgin_anterre20041216.pdf) (criticizing Google for suggesting third party trademarks to advertisers to purchase as keywords).

<sup>113</sup> See Lisa Guernsey, *Making Intelligence a Bit Less Artificial*, N.Y. TIMES, May 1, 2003, at G1; Steven Levy, *All Eyes on Google*, NEWSWEEK, Mar. 29, 2004, at 48, 58.

<sup>114</sup> See Stefanie Olsen, *Searching for the Personal Touch*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5061873.html?tag=st\\_util\\_print](http://news.com.com/2102-1024_3-5061873.html?tag=st_util_print) (Aug. 11, 2003); Levy, *supra* note 113, at 55–56 (discussing Microsoft's research project called "Implicit Query," software that will figure out what searchers should be asking for without having to interrupt their tasks to initiate a search); Steve Silberman, *The Quest for Meaning*, WIRED, Feb. 2000, at 173 (discussing the use of Bayesian filters to determine user interests based on past activities). Google's Gmail offering may be an early example of this.

<sup>115</sup> See Stefanie Olsen, *Search Upstarts Storm Google's Gates*, CNET News.com, at [http://news.com.com/2102-1038\\_3-5172198.html?tag=st\\_util\\_print](http://news.com.com/2102-1038_3-5172198.html?tag=st_util_print) (Mar. 11, 2004); Levy, *supra* note 113, at 58.

<sup>116</sup> See, e.g., Google WebQuotes, at <http://labs.google.com/cgi-bin/webquotes> (last visited Apr. 1, 2005).

### 8. *Summary on Passivity*

Because search engines so liberally redeploy content to accomplish their objectives, a third party (like a plaintiff or a judge) cannot make any assumptions about why content is presented by a search engine. A searcher who searches for the keyword “canon” might see a Nikon search result because the search engine reinterpreted the searcher’s keyword, the search engine reinterpreted Nikon’s content or a third party linked to Nikon’s website with the word “canon” in the anchor text. At the same time, Nikon could try its hardest to be indexed on the word “canon” but still completely fail to do so based on search engine policies. One should abandon any legal presumptions about why a search result or an ad appears to a searcher. This inquiry is resolvable only by reference to the facts; and the facts change constantly.

### B. *Keyword Convergence*

Until now, this Article has primarily focused on search engines, particularly those that generate their databases using automated means. However, the historical distinctions between search engines and other Internet search providers have collapsed. Now, virtually all the major ways that searchers can obtain Internet content have converged on using keywords as the trigger for content. The keyword phenomenon is not limited to text; keywords have become fundamental to searching for all types of media, including photos,<sup>117</sup> musical recordings,<sup>118</sup> and pornography.<sup>119</sup> Keywords have emerged as the new “lingua franca” for every aspect of how the Internet can be used as a commercial or information resource.

<sup>117</sup> E.g., Google Image Search, at <http://www.google.com/imghp?hl=en&tab=wi&q=google%20image%20search> (last visited Apr. 1, 2005); Ditto.com, at <http://www.ditto.com/> (last visited Apr. 1, 2005); see Kelly v. Arriba Soft Corp., 336 F.3d 811, 815–16 (9th Cir. 2003) (discussing the operation of the Ditto.com website and Ditto.com’s liability for copyright infringement).

<sup>118</sup> Searchers looking for music files through peer-to-peer file sharing services search by artist name and song title. See, e.g., *In re Aimster Copyright Litig.*, 334 F.3d 643, 646 (7th Cir. 2003); *A&M Records, Inc. v. Napster, Inc.*, 239 F.3d 1004, 1012 (9th Cir. 2001); *Metro-Goldwyn-Mayer Studios, Inc. v. Grokster, Ltd.*, 259 F. Supp. 2d 1029, 1032 (C.D. Cal. 2003).

<sup>119</sup> Parental control software (sometimes pejoratively called “censorware”) may use keywords to block access to pornography and other objectionable content. See *Reno v. Am. Civil Liberties Union*, 521 U.S. 844, 855 (1997). Not surprisingly, overreliance on keywords to control access to pornography can block legitimate publications. Classic examples include the words “breast,” which is an essential word to obtaining information about breast cancer, and “couples,” a word that can be used in sexual content, which caused the blocking of an official White House website page containing the word. See CNET News.com, *SurfWatch To Give Users More Control*, at <http://news.com.com/2102-1023-211137.html> (May 2, 1996).

Nevertheless, keyword-based search engines are routinely distinguished from other types of content searching mechanisms, such as the use of domain names.<sup>120</sup> This subsection argues that these alternative methods of accessing content have merged into other forms of keyword searches, so the law should not treat them differently.

### 1. Domain Names

The most obvious example of keyword convergence is the DNS, which is just a stylized type of search engine.<sup>121</sup> Just like search engines, the DNS works by having a searcher submit a keyword (the domain name) to the DNS and receiving content in return—i.e., the web page located at the Internet Protocol (“IP”) address associated with the domain name. The DNS differs from stereotypical search engines in that it only returns one search result (the web page)<sup>122</sup> and does not provide any filtering content before the searcher receives the result. However, these are details that go to the implementation of the search functionality; Google replicates this implementation with its “I’m Feeling Lucky” feature.<sup>123</sup>

Although the DNS has a different technical architecture and origin than search engines, the DNS has always functioned as a search tool. In the 1990s, it was not uncommon for searchers to guess domain names as a way to obtain relevant content.<sup>124</sup> Often, a searcher’s guess would take one of two forms. The searcher might select a trademark, add the suffix “.com,” and assume that the DNS would retrieve the trademark owner’s website (for example, assuming that kodak.com was associated with the Eastman Kodak Company).<sup>125</sup> Or, the

<sup>120</sup> See, e.g., Nathenson, *supra* note 53, at 87–88 (discussing the differences between domain name disputes and efforts to game search engines).

<sup>121</sup> See Expert Report of Milton Mueller, *Taubman Co. v. Webfeats*, Nos. 01-2648/01-2725 (E.D. Mich. 2002), available at <http://www.taubmansucks.com/Act108b.html> [hereinafter Mueller Report]. Domain names also can be used for email addresses, raising issues beyond this Article’s scope.

<sup>122</sup> See *Kremen v. Cohen*, 337 F.3d 1024, 1030 (9th Cir. 2003).

<sup>123</sup> See Google, *Google Web Search Features*, at <http://www.google.com/help/features.html> (last visited Apr. 1, 2005).

<sup>124</sup> Mueller Report, *supra* note 121.

<sup>125</sup> This proposition has a venerable tradition in case law precedent, starting with one of the earliest Internet cases. See *MTV Networks v. Curry*, 867 F. Supp. 202, 204 (S.D.N.Y. 1994). Appellate cases also endorse this proposition. See, e.g., *Interactive Prods. Corp. v. A2Z Mobile Office Solutions, Inc.*, 326 F.3d 687, 691 (6th Cir. 2003); *PACCAR, Inc. v. TeleScan Techs., L.L.C.*, 319 F.3d 243, 250 (6th Cir. 2003); *Sporty’s Farm L.L.C. v. Sportsman’s Mkt., Inc.*, 202 F.3d 489, 493 (2d Cir. 2000) (“The most common method of locating an unknown domain name is simply to type in the company name or logo with the suffix .com”); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1044–45 (9th Cir. 1999) (“Oftentimes, an Internet user will begin by hazarding a guess at the domain name, especially if there is an

searcher might select some generic noun or verb, add the suffix “.com,” and assume that the associated website would provide content relevant to the noun or verb (for example, assuming that pets.com would contain information related to pets). In either case, the searcher used a keyword (“Kodak” or “pets”) in the DNS system in an effort to get relevant content.

However, the DNS was never intended to be a search tool,<sup>126</sup> and it underperforms as a search tool for several reasons.<sup>127</sup> First, top level domains (“TLDs”) like .com have a “relevancy algorithm” based on the first party to register the domain name, which is a very weak proxy for relevancy. Second, searchers do not get any filtering content to make predictive determinations and do not get the convenience of a summary list of search results.<sup>128</sup> Third, because keywords are capable of multiple meanings, the “one website per domain name” architecture produces relevancy on a consistent basis only when most searchers share a single definition of the keyword (such as in the case of a well-known fanciful trademark). Finally, searchers can incur unpleasant consequences, such as mousetrapping<sup>129</sup> or unwanted pornography, if the

obvious domain name to try. Web users often assume, as a rule of thumb, that the domain name of a particular company will be the company name followed by .com.”); *Panavision Int’l L.P. v. Toeppen*, 141 F.3d 1316, 1327 (9th Cir. 1998).

*But see* Mueller Report, *supra* note 121 (calling the assumption a temporary phenomenon from 1994 to 1997 and saying “[n]o systematic empirical evidence quantifying the validity of [these] proposition[s] is available”). Some cases question these searcher expectations and practices. *See, e.g.,* *Interstellar Starship Servs. v. Epix, Inc.*, 304 F.3d 936, 944–45 (9th Cir. 2002); *Strick Corp. v. Strickland*, 162 F. Supp. 2d 372, 377 (E.D. Pa. 2001); *Chatam Int’l, Inc. v. Bodum, Inc.*, 157 F. Supp. 2d 549, 559 n.17 (E.D. Pa. 2001); *Mach. Head v. Dewey Global Holdings, Inc.*, 2001 U.S. Dist. LEXIS 22759, \*28 (N.D. Cal. 2001); *The Network Network v. CBS*, 2000 U.S. Dist. LEXIS 4751, at \*16 (C.D. Cal. Jan. 16, 2000).

<sup>126</sup> Ben Edelman, *DNS as a Search Engine: A Quantitative Evaluation*, at <http://cyber.law.harvard.edu/people/edelman/DNS-as-search/> (July 1, 2002); Mueller Report, *supra* note 121.

<sup>127</sup> *See generally* Edelman, *supra* note 126 (comparing the relevance of results generated through domain name guessing, search engines, and the RealNames keyword system).

<sup>128</sup> *See* Rieh, *supra* note 25, at 159 (discussing the importance of filtering content to the search process). One could say that the domain name acts as filtering content, but unless a searcher has other information about the domain name, it provides little reliable insight into what to expect when a searcher gets there.

<sup>129</sup> Mousetrapping occurs when a web publisher effectively prevents the searcher from leaving by disabling the “back” button or by opening new pop-up windows faster than the searcher can close them. Webopedia.com, *Mousetrapping*, at <http://www.webopedia.com/TERM/M/mousetrapping.html> (last visited Apr. 1, 2005); *see* *FTC v. Zuccarini*, 2002 WL 1378421, at \*1 (E.D. Pa. Apr. 9, 2001) (treating mousetrapping as an unfair trade practice). *See generally* Eun S. Bae, Comment, *Pop-Up Advertising Online: Slaying the Hydra*, 29 RUTGERS COMPUTER & TECH. L.J. 139 (2003) (discussing various harms associated with mousetrapping). Software is increasingly killing pop-up ads automatically, which may minimize (at least for a while) some of mousetrapping’s perniciousness. *See* Stefanie Olsen, *Internet Explorer To Stomp Pop-Ups*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5105139.html?tag=st\\_util\\_print](http://news.com.com/2102-1032_3-5105139.html?tag=st_util_print) (Nov. 10, 2003). *But see* Stefanie Olsen, *Revenge of the Pop-Ups*, CNET News.com, at [HeinOnline -- 54 Emory L.J. 544 2005](http://news.com.com/2102-1024_3-</a></p></div><div data-bbox=)

searcher makes a typing error<sup>130</sup> or encounters a domain name that has expired and been re-registered by an unexpected third party.<sup>131</sup>

Various attempts have been made to improve the DNS's integrity as a search database. For example, new TLDs in the recent years have abandoned the "first to register" relevancy algorithm, giving priority to trademark owners.<sup>132</sup> However, these new TLDs have been used comparatively infrequently.<sup>133</sup>

5408453.html?tag=st.util.print (Oct. 14, 2004) (discussing how websites are finding ways around the pop-up ad blockers).

<sup>130</sup> Domain name registrants who register typographical error versions of popular domain names are called "typosquatters." See *Shields v. Zuccarini*, 254 F.3d 476, 483 (3d Cir. 2001); see also *Elecs. Boutique Holdings Corp. v. Zuccarini*, 2001 WL 83388, at \*1 (E.D. Pa. Jan. 25, 2001), *aff'd without comment*, 33 Fed. Appx. 647 (3d Cir. 2002); *Educ. Tours, Inc. v. Hemisphere Travel, Inc.*, 2004 WL 887417, at \*2 (N.D. Ill. Apr. 26, 2004). See generally Dara B. Gilwit, Note, *The Latest Cybersquatting Trend: Typosquatters, Their Changing Tactics, and How To Prevent Public Deception and Trademark Infringement*, 11 WASH U. J.L. & POL'Y 267 (2003); Benjamin Edelman, Large-Scale Registration of Domains with Typographical Errors, at <http://cyber.law.harvard.edu/people/edelman/typo-domains/> (Sept. 3, 2003).

Congress criminalized some types of typosquatting in the Truth in Domain Names Act, H.R. 939, 108th Cong. (2003) (to be codified at 18 U.S.C. § 2252B). The law criminalizes using a misleading domain name with the intent to cause minors to view sexually explicit pictures. Notorious typosquatter Zuccarini was sentenced to thirty months in prison for typosquatting on domain names that might appeal to kids and redirecting those domain names to advertisements for hard core pornography. See Press Release, U.S. Department of Justice, "Cyberscammer" Sentenced to 30 Months for Using Deceptive Internet Names To Mislead Minors to X-Rated Sites (Feb. 26, 2004), available at <http://www.cybercrime.gov/zuccariniSent.htm>.

<sup>131</sup> This phenomenon is referred to as "porn napping" when pornographers re-register the domain name. See Mike Wendland, *Expired Domains Present Opportunity for Net Porn*, DETROIT FREE PRESS, at [http://www.freep.com/money/tech/mwendl6\\_20020516.htm](http://www.freep.com/money/tech/mwendl6_20020516.htm) (May 16, 2002). In one incident, a link from Senator Orrin Hatch's website was porn napped, leading some to wonder if Senator Hatch endorsed pornography. See Robert Gehrke, *Hatch Removes Mistaken Link to Porn Site*, at <http://www.sunherald.com/mld/sunherald/6136653.htm> (June 20, 2003).

<sup>132</sup> More recently, new TLDs such as .info, and .us, and the .kids.us domain, have modified the first to register approach, using techniques like segmented registration periods where only registrants possessing a registered trademark in the domain name can register during the initial period. See Afiliastats, *The Sunrise Period*, at <http://www.afiliastats.info/register/schedule/sunrise> period (July 26, 2001).

<sup>133</sup> See Caslon Analytics, *Profile: Domains and the DNS*, at <http://www.caslon.com.au/domainsprofile1.htm> (Oct. 2003); see also Ben Edelman, *Registrations in Open ccTLDs*, at <http://cyber.law.harvard.edu/people/Edelman/open-ccTlds/> (July 22, 2002) ("more than 80% [of .cc, .tv, and .ws domains] lead only to placeholders or to no web content at all," a substantially higher percentage than in .com, .net, and .org); Ben Edelman, *Survey of Usage of the .US TLD*, at <http://cyber.law.harvard.edu/people/edelman/dotus/> (Sept. 20, 2002) (less than 15% of .us domains provide web content); Francis Hwang, *Do Domain Names Matter?*, at [http://fhwang.net/writing/do\\_domain\\_names\\_matter.html](http://fhwang.net/writing/do_domain_names_matter.html) (July 25, 2003) (citing how most prominent museums have avoided using the .museum TLD, preferring to use the .org TLD); Jonathan Zittrain & Benjamin Edelman, *Survey of Usage of the .BIZ TLD*, at <http://cyber.law.harvard.edu/tlds/001/> (June 25, 2002) ("74% of currently registered .BIZ domains provide no web content or provide only error messages or placeholders.").



Also, some domain names resolve to a “gateway page” (also referred to as a “shared page” or “intermediate page”)<sup>134</sup> for the sole purpose of allowing multiple trademark owners or licensees to “share” the domain name through links on the page to their respective sites.<sup>135</sup>

Finally, as a DNS alternative, RealNames deployed a keyword system where a searcher could type a keyword into their software and receive a list of websites that paid to be associated with that keyword.<sup>136</sup> RealNames ultimately failed,<sup>137</sup> perhaps due to searcher migration away from domain names or perhaps because RealNames delivered less relevant results than search engines did.<sup>138</sup>

None of the efforts to improve DNS quality have rehabilitated the DNS as a useful search tool. Instead, the DNS’s shortcomings have led to two interesting developments in the keyword convergence process. First, domain name registries increasingly treat domain names as triggers for search results just like search engines do.<sup>139</sup> In May 2003, searchers arriving at unregistered domain names in the .biz and .us TLDs, operated by NeuStar, received paid search results instead of a typical error page.<sup>140</sup> NeuStar’s trial program only lasted for a few days, but the concept re-emerged in September 2003 when VeriSign launched its “Site Finder” program, which presented search results instead of a “page not found” message for the .com and .net TLDs.<sup>141</sup> Besieged by a firestorm of opposition, VeriSign suspended the program after two weeks in October 2003.<sup>142</sup>

<sup>134</sup> Prominent examples include [scrabble.com](http://scrabble.com), [playtex.com](http://playtex.com), and [disc.com](http://disc.com). See David H. Bernstein et al., *Trademark and Unfair Competition Issues*, PLI G0-00D2, n.45 (July 2000).

<sup>135</sup> See Puneet Singh, *Gateway Pages: A Solution to the Domain Name Conflict?*, 91 TRADEMARK REP. 1226 (2001).

<sup>136</sup> See Danny Sullivan, *Goodbye Domain Names, Hello RealNames?*, at [http://www.searchenginewatch.com/sereport/print.php/34721\\_2162611](http://www.searchenginewatch.com/sereport/print.php/34721_2162611) (May 3, 2000).

<sup>137</sup> See David McGuire, *RealNames Going Out of Business, Shutting Down Keywords*, WASH. POST, May 11, 2002, at <http://www.washingtonpost.com/ac2/wp-dyn?pagename=article&node=&contentId=A4680-2002May11&notFound=true>.

<sup>138</sup> See Edelman, *supra* note 126.

<sup>139</sup> See Nick Wingfield, *Internet Companies See Value in Misaddressed Web Traffic*, WALL ST. J., Sept 5, 2003, at B1 (discussing how AOL, MSN, and others deliver search results instead of error messages).

<sup>140</sup> See *id.*

<sup>141</sup> See VeriSign, Inc., *VeriSign’s Site Finder Implementation*, at <http://www.verisign.com/resources/gd/sitefinder/implementation.pdf> (Aug. 27, 2003).

<sup>142</sup> Press Release, VeriSign, Inc., *VeriSign Site Finder Service Update* (Sept. 23, 2003), available at [http://www.verisign.com/corporate/news/2003/pr\\_20031003.html](http://www.verisign.com/corporate/news/2003/pr_20031003.html). The opposition included three lawsuits against VeriSign by GoDaddy, Popular Enterprises, and class-action lawyer Ira Rothken.

These successive efforts by NeuStar and VeriSign strongly indicate that domain names are converging with other keyword-based search methods. With these programs, the registries try to present content that a searcher will find more useful than a page saying “your search failed—tough luck.”<sup>143</sup> In other words, the registries are delivering search results in response to searchers’ keywords. While the NeuStar and VeriSign programs may be on hiatus, other TLDs deliver keyword-triggered ads for unregistered domains,<sup>144</sup> and it seems inevitable that more TLDs will do so because searchers have a better experience and registries make some easy money.<sup>145</sup>

A second principal example of domain name convergence can be seen from searcher keyword choices at search engines. Consider the following list of top keywords searched at various meta-search engines<sup>146</sup> in Summer 2002:<sup>147</sup>

<sup>143</sup> See Elizabeth Olson, *Profits in Missed Exits on Information Highway*, N.Y. TIMES, Sept. 15, 2003, at C4 (quoting a VeriSign executive as saying “A year ago, we were asking our users what was difficult for them . . . [a]nd what we came up with was the frustration of not being able to find what they wanted” and noting that AOL removed its basic error message because it was confusing consumers).

<sup>144</sup> Other TLDs and ccTLDs that present search results for unregistered domains include .cc, .museum, .nu, .ph, .tm, and .ws. Declan McCullagh, *VeriSign Redirects Error Pages*, CNET News.com, at [http://news.com.com/2102-1032\\_3-5077530.html?tag=st\\_util\\_print](http://news.com.com/2102-1032_3-5077530.html?tag=st_util_print) (Sept. 16, 2003).

<sup>145</sup> Cf. Stefanie Olsen, *Craving for ‘Clicks’ Bogs Down Search*, CNET News.com, at [http://news.com.com/2102-1038\\_3-5088552.html?tag=st\\_util\\_print](http://news.com.com/2102-1038_3-5088552.html?tag=st_util_print) (Oct. 8, 2003) (discussing the myriad ways, legitimate and not, that search providers try to generate new search sessions).

<sup>146</sup> A meta-search engine compiles search results from multiple search engines, allowing a searcher to search these disparate search engines with a single search query. Wendy Boswell, *Meta Search Engine*, ABOUT.COM, at [http://websearch.about.com/od/m/g/meta\\_search\\_eng.htm](http://websearch.about.com/od/m/g/meta_search_eng.htm) (last visited Apr. 1, 2005).

<sup>147</sup> Wordtracker.com, *Search Engine Guide: Wordtracker: Top 500 Keyword Report*, at [http://www.searchengineguide.com/wt/2002/0729\\_wt1.html](http://www.searchengineguide.com/wt/2002/0729_wt1.html) (July 29, 2002). Although the phenomenon has abated somewhat, in November 2004 the top 20 searched keywords still include Google (#1), eBay (#2), Yahoo (#3), Mapquest (#7), Yahoo.com (#8), and Hotmail (#15). See Wordtracker.com, *Top 500 Keywords of the Week*, at [http://www.searchengineguide.com/wt/2004/1117\\_wt1.html](http://www.searchengineguide.com/wt/2004/1117_wt1.html) (Nov. 17, 2004).

Table 1: Top Keywords Searched at Meta-Search Engines

Rank	Keyword
#1	Google
#3	Yahoo
#7	eBay
#8	Hotmail
#9	Hotmail.com
#13	Yahoo.com
#15	www.hotmail.com
#18	Mapquest
#20	www.yahoo.com

In all of these cases, if the searcher was looking for the website, they could have merely put the search term into the address bar instead of going to a meta-search engine.<sup>148</sup> Especially striking are the keywords “www.hotmail.com” and “www.yahoo.com,” where searchers had all of the information they needed to find the website merely by entering the keyword into the address bar. However, searchers—enough to rank these keywords in the top twenty of all searched keywords—chose to initiate their search at a search engine instead of typing the keyword into their address bar, even though the latter would have been more efficient.

This search behavior may portend the eventual death of domain names. Some searchers, frustrated with the DNS’s low relevancy or adverse consequences, like typosquatting, porn-napping, and mouse-trapping, may have become trained to start *every* search at a search engine instead of entering domain names into the address bar.<sup>149</sup> For some searchers, search engines have supplanted the DNS’s core search function of delivering known websites. In turn, top search engine placements have eclipsed domain names as the premier Internet locations.<sup>150</sup>

<sup>148</sup> See *Nissan Motor Co. v. Nissan Computer Corp.*, 204 F.R.D. 460, 468 (C.D. Cal. 2001) (characterizing a search for nissan.com in a search engine as “pointless”).

<sup>149</sup> A universal search methodology eliminates the transaction cost of time spent making choices about each search.

<sup>150</sup> See Dan Gillmor, ‘Google Effect’ Reduces Need for Many Domains, SILICONVALLEY.COM, at [http://www.bayarea.com/mld/siliconvalley/business/columnists/dan\\_gillmor/2531424.htm?template=contentModules/printstory.jsp](http://www.bayarea.com/mld/siliconvalley/business/columnists/dan_gillmor/2531424.htm?template=contentModules/printstory.jsp) (Jan. 12, 2002) (describing how the author let domain name registrations lapse because search engine placement had become more important than the domain names); Tamara Loomis, *Domain Name Disputes Decline as Internet Matures*, at <http://www.nylawyer.com/news/03/02/020603c.html> (Feb. 6, 2003).

## 2. *Link Navigation*

Although keyword convergence has been especially pronounced in the domain name arena, it is also occurring with respect to link navigation. Specifically, searchers navigating around websites implicitly trigger keyword searches whether the searcher knows it or not.

Historically, web publishers organized taxonomies manually, meaning that an editor would manually determine the organization of links. Increasingly, however, publishers use links in a taxonomical structure to trigger searches in the publisher's database.<sup>151</sup> For example, if a taxonomy has a navigation link called "digital cameras," that link could cause the display of information resources that the web publisher manually assembled, or the link could trigger a search for the keyword "digital camera" in the publisher's searchable database.<sup>152</sup> Either approach leads to the same outcome: The publisher presents putatively relevant content about "digital cameras" to the searcher. Meanwhile, by dynamically generating a search results page, the publisher can take advantage of constantly changing data in the database without having to manually maintain each page.

Link navigation triggers keyword searches in a second way: through search engine programs that "distribute" search results and paid advertising. Google's "AdSense" program is a flagship example of these distribution programs.<sup>153</sup> Web publishers that participate in the AdSense program place Google-supplied HTML code on their web pages. When a visitor accesses one of those pages, the HTML code asks Google's servers to supply ads to the visitor in

(citing a trademark attorney who said domain name registrations were becoming less important due to search engines). See generally Carl Bialik, *Lawyers Bid Up Value of Web-Search Ads*, WALL ST. J., Apr. 8, 2004, at B1 (discussing how lawyers pay \$90 or more per click on advertisements triggered by the keyword "mesothelioma attorney").

Not surprisingly, the changes in searcher behavior has adversely affected the value of domain names. See Joanna Glasner, *Looking for the Beef (.com)*, at <http://www.wired.com/news/print/0,1294,58763,00.html> (May 12, 2003). This change has correspondingly reduced the number of fights over them. See Loomis, *supra* (citing statistics that Uniform Domain Name Dispute Resolution Policy ("UDRP") proceedings dropped 50% in two years). See generally Milton Mueller, *Success by Default: A New Profile of Domain Name Trademark Disputes Under ICANN's UDRP*, at <http://dcc.syr.edu/markle/markle-report-final.pdf> (June 24, 2002).

<sup>151</sup> See Hagen, *supra* note 53, at 16.

<sup>152</sup> In light of concept searching, a taxonomy-initiated search could, in fact, use different or additional words to "digital camera" without the searcher even knowing or realizing it.

<sup>153</sup> See Google, *Google AdSense Overview*, at <https://www.google.com/adsense/overview> (last visited Apr. 1, 2005). See generally Stefanie Olsen, *All the Search That's Fit to Print?*, CNET News.com, at <http://news.com.com/2102-1023-984252.html> (Feb. 12, 2003) (discussing a range of news publishers who display paid search listings from Google or Overture).

conjunction with the web page. Google's proprietary algorithms evaluate the publisher's page to automatically assess what keywords best characterize that page. Google then serves keyword-triggered ads to the web visitor. By dynamically assessing the page's contents and selecting ads based on that assessment, AdSense increases the likelihood that an ad will be relevant to the page's content—and thus to the searcher as well. From a technical standpoint, the net effect is that visitors receive these keyword-triggered ads as they navigate around the Internet, irrespective of whether they intended to conduct dynamic searches.

Google's AdSense program, and the many other competitive keyword-triggered ad programs,<sup>154</sup> have revitalized an Internet advertising industry that virtually collapsed in the early 2000s.<sup>155</sup> Their phenomenal success is attributable to a simple fact: Contextually relevant keyword-triggered ads do a better job of meeting searcher objectives than other ways of delivering ads to consumers. Based on this fact, advertisers and publishers will continue to favor keyword-triggered ads.

### 3. *Software Agents*

Software agents are software tools that present content based on a searcher's perceived interests. Although these software agents are sometimes pejoratively maligned as "adware," software agents can deliver more than just paid advertisements.

Often, the software agents will make judgments about a searcher's possible interests based on the searcher's online conduct.<sup>156</sup> Like AdSense, software agents contextually determine keywords to trigger search content. For example, adware vendor WhenU.com<sup>157</sup> treats the searcher's input of a domain name into the address bar as a search and, in response, delivers advertising

<sup>154</sup> See Danny Sullivan, *Overture's Content Match Takes on Google's Contextual Ads*, at [http://www.searchenginewatch.com/searchday/print.php/34711\\_2230221](http://www.searchenginewatch.com/searchday/print.php/34711_2230221) (July 2, 2003) (comparing Overture's Content Match program with Google's AdSense program).

<sup>155</sup> See Jim Hu, *Online Ad Sales Hit New High*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5158188.html?tag=st.util.print](http://news.com.com/2102-1024_3-5158188.html?tag=st.util.print) (Feb. 12, 2004) ("Much of this growth has come from commercial search . . .").

<sup>156</sup> See David Bank, *What's That Sneaking into Your Computer?*, WALL ST. J., Apr. 26, 2004, at R1 (discussing the various factors considered by software agents).

<sup>157</sup> WhenU.com is one of an emerging class of "adware" vendors. Adware is software that resides on a user's computer and causes ads to be displayed to the user. See Adware.info, *Quick Reference on Adware and Spyware Software*, at <http://www.adware.info/> (last visited Apr. 1, 2005).

content that WhenU.com thinks is responsive to that keyword.<sup>158</sup> As with the other methods of Internet search, the designated keyword becomes the link between the searcher's objectives and putatively relevant content.

Although software agents often operate passively (in the sense that searchers do not affirmatively choose them in Stage 2), software agents still respond to keywords affirmatively selected by the searcher, making them indistinguishable from other intermediaries delivering keyword-triggered content.

#### *4. Implications of Keyword Convergence*

Historically, legal doctrines have treated Internet search methods as legally distinct "silos."<sup>159</sup> However, technology, business practices, and searcher behavior have effectively mooted the distinctions between domain names, search engines, directories, and other search approaches. Instead, virtually all Internet searches are now keyword-driven, as that methodology (combined with skillful content presentation by search providers and publishers) does a superior job helping searchers accomplish their objectives. This insight should change the way one thinks about policymaking regarding Internet search. Integrated laws that reflect the converged keyword-driven search environment are essential.

<sup>158</sup> For example, WhenU.com uses the phrase "1800contacts.com" as a keyword to trigger competitive ads. *See* 1-800 Contacts, Inc. v. WhenU.com, 309 F. Supp. 2d 467, 489 (S.D.N.Y. 2003).

<sup>159</sup> For example, legislators have passed a number of laws treating domain names as a special class of keywords. *See, e.g.*, Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113, 113 Stat. 1501 (1999); Truth in Domain Names Act, H.R. 939, 108th Cong. (2003) (codified at 18 U.S.C. § 2252B) (prohibiting the use of misleading domain names that lead children to pornography); Dot Kids Implementation and Efficiency Act of 2002, Pub. L. No. 107-317, 116 Stat. 2767 (2002) (creating and implementing a kid-safe Internet zone at .kids.us); CAL. BUS. & PROF. CODE §§ 17525-28 (West 1997) (prohibiting the bad faith registration, use or trafficking of another person's name as a domain name).

However, Congress may be realizing the convergence between keywords and other forms of keywords. *See* Children's Online Safety Act of 2004, H.R. 4305, 108th Cong. (2004) (proposing to extend 18 U.S.C. § 2252B to apply to domain names and metatags equally).

## V. THE DEVOLUTION OF INTERNET TRADEMARK LAW

### A. *A Brief Primer on Trademark Law*

Federal trademark law<sup>160</sup> applies to Internet conduct in three principal ways: trademark infringement,<sup>161</sup> trademark dilution,<sup>162</sup> and anti-cybersquatting.<sup>163</sup> While all three laws have important implications for Internet search, this Article focuses on trademark infringement.

Trademark infringement prohibits trademark use in a manner that “is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person.”<sup>164</sup> This prohibition serves dual purposes: protecting consumers from confusion when making purchasing decisions and protecting producers’ investments in quality that creates consumer goodwill towards them.<sup>165</sup> In addition, by reducing confusion and sharpening the communicative effects of words, trademarks can help lower consumer search costs,<sup>166</sup> an outcome that benefits searchers, trademark owners seeking to be found, and society in general.

The common law has developed a multifactor test to determine the likelihood that, when two parties use the same or a similar trademark,<sup>167</sup> consumers will be confused about the source of their respective goods and services. This Article refers to the multifactor likelihood of consumer confusion test as the “MFLOCC” test. Each federal circuit has developed its

<sup>160</sup> This Article concentrates on federal law. Many state laws track federal trademark laws closely enough that this Article’s analysis applies equally to them.

<sup>161</sup> 15 U.S.C. § 1125(a) (2000).

<sup>162</sup> Trademark dilution protects owners of famous trademarks from junior uses that reduce the trademark’s capacity to act as source identifiers. *Id.* § 1125(c).

<sup>163</sup> Anticybersquatting protects trademark owners from bad faith registrations of confusingly similar or dilutive domain names. *Id.* § 1125(d).

<sup>164</sup> *Id.* § 1125(a)(1)(A).

<sup>165</sup> See *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 163–64 (1995).

<sup>166</sup> Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777 (2004); William M. Landes & Richard A. Posner, *Trademark Law: An Economic Perspective*, 30 J.L. & ECON. 265 (1987).

<sup>167</sup> The Lanham Act defines a trademark as “any word, name, symbol, or device, or any combination thereof . . . used by a person . . . to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods, even if that source is unknown.” 15 U.S.C. § 1127.

own set of factors to consider under the MFLOCC test, although the factors are similar across the circuits. Frequently referenced versions of the MFLOCC test include the Ninth Circuit's *Sleekcraft* test<sup>168</sup> and the Second Circuit's *Polaroid* test.<sup>169</sup> Professor McCarthy provides a summary version of an MFLOCC test using the following factors:

- The degree of resemblance between the conflicting designations;
- The similarity of the marketing methods and channels of distribution;
- The characteristics of the prospective purchasers and the degree of care they exercise;
- The degree of distinctiveness of the senior user's mark;
- Where the goods or services are not competitive, the likelihood that prospective buyers would expect the senior user to expand into the field of the junior user;
- Where the goods or services are sold in different territories, the extent to which the senior user's designation is known in the junior user's territory;
- The intent of the junior user; and
- Evidence of actual confusion.<sup>170</sup>

#### *B. The Breakdown of the MFLOCC Test and Goodwill Misappropriation*

The MFLOCC test has not fared well in the Internet era. The MFLOCC test is a workhorse, expected to apply with equal vigor across multiple media and contexts ranging from product packaging to corporate names, from television advertisements to decorated blimps. Not surprisingly, a one-size-fits-all test will have some frayed edges.

Internet search has exposed two of those edges. First, Internet cases have accelerated a nascent judicial trend to use legal heuristics to bypass the MFLOCC test. Second, Internet cases have exposed trademark law's inability to sharply distinguish between the different ways words can be used.

<sup>168</sup> See *AMF, Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).

<sup>169</sup> See *Polaroid Corp. v. Polarad Elecs. Corp.*, 287 F.2d 492 (2d Cir. 1961).

<sup>170</sup> 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 24:29 (4th ed. 2003).



The “goodwill misappropriation” doctrine illustrates both deficiencies. Some courts use goodwill misappropriation as an alternative to the MFLOCC test in finding infringement.<sup>171</sup> Other courts use goodwill misappropriation as an analytical tool to evaluate one or more of the MFLOCC factors, but goodwill misappropriation replaces any concrete demonstration of plaintiff harm.<sup>172</sup> In both cases, goodwill misappropriation is a conclusion rather than an analytical tool; if a junior user can be said to have misappropriated the senior user’s goodwill, then the junior user has infringed.

The misuse of the goodwill misappropriation doctrine is partially definitional, as there is no uniformly accepted definition of goodwill misappropriation. McCarthy describes goodwill in at least five different ways: “the lure of the place,” “the lure to return,” “buyer momentum,” “the legal and economic recognition of buying habits,” and the “expectancy of continued patronage.”<sup>173</sup> With so many definitions, the goodwill misappropriation doctrine provides courts with flexibility to reach any desired conclusion. As a result, goodwill misappropriation analysis adds little to an infringement analysis.

Considering how trademarks can be used as communicative tools in Internet searching provides a better understanding of goodwill misappropriation and distinguish it from other forms of trademark uses.<sup>174</sup> This Article will explore three types of uses: referential uses, associative uses, and misappropriative uses. While these three uses are not exhaustive, the interaction between them sheds important light on the Internet search context.

### *1. Referential Uses*

Words<sup>175</sup> successfully transfer information between a speaker and listener when both parties attach the same meaning to them. Mechanically, when the speaker uses a word, the listener attempts to cognitively associate the word with a pre-existing definition. If the listener does not have a pre-existing

<sup>171</sup> See *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808 (7th Cir. 2002); *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036 (9th Cir. 1999).

<sup>172</sup> See *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

<sup>173</sup> 1 MCCARTHY, *supra* note 170, § 2:18.

<sup>174</sup> See generally *Dogan & Lemley*, *supra* note 166, at 786–88 (discussing the role of trademarks in lending precision to words as communicative tools).

<sup>175</sup> This discussion principally refers to word trademarks, but this discussion applies with equal force to nonword trademarks.

definition and cannot figure out a definition from the context, the word fails to communicate.

Trademarks work the same way.<sup>176</sup> A speaker using a trademark attempts to cognitively trigger the listener's definition for the trademark. However, trademarks have special properties as words because the trademark owner has caused consumers to establish a new and unique definition in their minds—i.e., when a listener is exposed to X's trademark, the listener thinks of X's products.<sup>177</sup>

By definition, trademarks necessarily enter the social lexicon.<sup>178</sup> Once a trademark owner has created a new proprietary definition for a term, the term becomes the exclusive way to reference that definition; there is no other effective way to implicate that definition without doing so.<sup>179</sup> Therefore, if I ask my wife to pick up a package of "Sudafed" at the drugstore, I am hoping she and I will each make the same cognitive association—the association created by Pfizer.

I define trademark use for its lexical content, not as a source identifier, as a "referential use." My reference to Sudafed treats Sudafed just like any other word as the only logical term available to describe the referent.

Referential uses should not be restricted by trademark law, which applies only to trademark "uses in commerce."<sup>180</sup> Therefore, my repeated use of the term Sudafed in this Article should be excluded from trademark law on that basis. Alternatively, referential use in commerce still should not be trademark infringement because there should be no consumer confusion about the referent's source. In some cases, courts excuse referential use under the

<sup>176</sup> Landes & Posner, *supra* note 166. See generally *Playboy Enters., Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070 (C.D. Cal. 1999) (treating "Playboy" and "Playmate" as dictionary words, not trademarked terms), *rev'd* 354 F.3d 1020 (9th Cir. 2004).

<sup>177</sup> This is true whether the word has a single definition (i.e., only one trademark owner has trademark rights in the word) or if multiple trademark owners all have protectable rights in the same word. In the latter case, the word can take on additional definitions in the consumer's mind, but the consumer distinguishes each definition from the others.

<sup>178</sup> See Mark A. Lemley, *The Modern Lanham Act and the Death of Common Sense*, 108 YALE L.J. 1687, 1711 (1999).

<sup>179</sup> See, e.g., *Playboy Enters., Inc. v. Welles*, 279 F.3d 796, 802 (9th Cir. 2002) (giving examples of how silly it would be to try to describe the Chicago Bulls basketball team without using the words "Chicago Bulls" or *Playboy Magazine* without using the word "Playboy").

<sup>180</sup> 15 U.S.C. § 1125(a)(1) (2000).

“nominative use” doctrine,<sup>181</sup> which applies when a junior user uses a trademark to describe the senior user’s product.<sup>182</sup>

## 2. *Associative Uses*

Some referential uses form associations in the listener’s mind with other words or concepts that the listener already knows. A paradigmatic example is comparative advertising.<sup>183</sup> To make the comparison, the junior user needs the listener to associate the junior user’s product with the senior user’s product, by finding common properties between the two products, such as that the products serve the same consumer need, but the junior user’s product has a superior attribute (e.g., cheaper price or better quality).

Associative trademark uses thus work similarly to referential trademark uses. In each case, the junior user taps into the listener’s pre-existing definition and uses the word for that referential effect. However, in associative uses, the junior user links that trademark’s definition with some communicative point the junior user is trying to make.

If the communicative point is that the junior user’s product comes from the senior user, the junior user may be creating confusion about the product’s source and the trademark use may be infringing. The Article revisits this point under misappropriative uses. False associative uses may create harms beyond trademark infringement, such as false advertising or possibly trademark dilution.

<sup>181</sup> McCarthy defines nominative use as “a use of another’s trademark to identify, not the defendant’s goods or services, but the plaintiff’s goods or services . . . so long as there is no likelihood of confusion.” 3 MCCARTHY, *supra* note 170, § 23:11; *see* Brother Records, Inc. v. Jardine, 318 F.3d 900, 903–04 (9th Cir. 2003), *cert. denied*, 540 U.S. 824 (2003); *Playboy Enters.*, 279 F.3d at 801. Sometimes the term “nominative fair use” is used.

<sup>182</sup> Not all courts recognize nominative use as a defense. *See* PACCAR Inc. v. TeleScan Techs., L.L.C., 319 F.3d 243, 256 (6th Cir. 2003), *overruled in part* by 125 S. Ct. 542 (2004); *see also* Chad J. Doellinger, *Nominative Fair Use: Jardine and the Demise of a Doctrine*, 1 NW. J. TECH. & INTELL. PROP. 66 (2003), available at <http://www.law.northwestern.edu/journals/njtip/v1/n1/5>. Under my approach, the plaintiff cannot establish a *prima facie* case of trademark infringement when a trademark is used referentially in the Internet context, so there should be no need to reach defenses.

<sup>183</sup> Another example of associative use is parody. For a trademark parody to work, the trademark must be used enough to conjure up the subject trademark. *See* 5 MCCARTHY, *supra* note 170, § 31:153; *see also* Davis & Boustani, *supra* note 38, at 10–11 (discussing initial interest confusion and parody).

Otherwise, accurate associative uses help consumers by facilitating useful cognitive links.<sup>184</sup> If Canon says that “If you are considering a Nikon digital camera, you should also consider Canon’s digital cameras,” the associative use helps the listener understand that there are two product families in the digital camera group of products, and both Canon and Nikon may fill the same consumer needs. Unquestionably, this type of statement references the definition of “Nikon” in consumer’s heads, but linking the definition of Nikon to Canon facilitates a quick understanding of Canon products’ properties and how they interrelate with the already-known properties of Nikon’s products.<sup>185</sup> This may also cause the consumer to expand his or her consideration set, but so long as the consumer’s search is not tainted by some defect (like credibility transference, as discussed below), adding competitors to a consumer’s search promotes socially beneficial competition.<sup>186</sup> Canon could reach the same point by brute force—that is, by defining its product attributes without any association to Nikon’s attributes—but this is both socially wasteful and, more importantly, the consumer ends up worse off because the consumer’s respective understandings of the attributes of Canon and Nikon are less easily compared.<sup>187</sup>

The previous example focused on comparative advertising and suggests that any accurate comparative advertising should be a permitted associative use.<sup>188</sup> More generally, any associative uses that help consumers build cognitive taxonomies of relationships between products and services should be

<sup>184</sup> See Stacey L. Dogan, *An Exclusive Right To Evoke*, 44 B.C. L. REV. 291, 316–19 (2003) (discussing some of the social benefits that can arise when a junior user evokes a senior user).

<sup>185</sup> See *August Storck K.G. v. Nabisco, Inc.*, 59 F.3d 616, 618 (7th Cir. 1995) (noting how comparative advertising referencing the competitor helps consumers because “[t]hey learn at a glance what kind of product is for sale and how it differs from a known benchmark”).

<sup>186</sup> See Katherine Ivancevich, Comment, *Promatek Industries, Ltd. v. Equitrac Corporation: Perpetuating the Metatag Fallacy*, 12 DEPAUL-LCA J. ART & ENT. L. 351, 383–84 (2002) (discussing how trademark owners will feel competitive pressure to improve their products as a result); Brian D. Kaiser, Note, *Contributory Trademark Infringement by Internet Service Providers: An Argument for Limitation*, 7 J. TECH. L. & POL’Y 65, 99 (2002) (same).

<sup>187</sup> The Federal Trade Commission encourages naming competitors in comparative advertising. See 16 C.F.R. § 14.15(b) (2004) (“Commission policy in the area of comparative advertising encourages the naming of, or reference to competitors [sic], but requires clarity, and, if necessary, disclosure to avoid deception of the consumer.”).

<sup>188</sup> See generally 4 MCCARTHY, *supra* note 170, § 25:52 (trying to make sense of confused comparative advertising jurisprudence).

excluded from trademark infringement. Nothing proprietary to the trademark owner is taken in this associative process.<sup>189</sup>

### 3. *Misappropriative Uses*

In contrast, a class of associative uses goes beyond building cognitive taxonomies. At some point, the association also takes advantage of a trademark owner's goodwill, and should be classified as a misappropriative use.

To distinguish associative uses from misappropriative uses, there should be a clearer understanding of consumer goodwill. As indicated earlier, goodwill has no broadly accepted definition, so I offer my own: Goodwill represents a consumer's aggregated positive feelings towards the trademark owner's products that may facilitate subsequent transactions with the trademark owner. A junior user can take advantage of these positive feelings towards the senior user to increase a consumer's propensity to transact with the junior user. Goodwill misappropriation occurs when a junior user makes a trademark associative use that causes consumers to transfer good feelings established by the senior user over to the junior user, and the junior user derives some benefit from that transference. This Article refers to the transference of good feelings as "credibility transference."

Properly cabined within the MFLOCC test, treating this misappropriative use as goodwill misappropriation serves a valuable purpose. To find goodwill misappropriation, courts should isolate the good feelings developed by the senior user, determine how those good feelings have been transferred to the junior user, and identify some benefit the junior user derived from the transference. As a practical matter, a properly executed MFLOCC test will make many of these inquiries; this means that the goodwill misappropriation doctrine should collapse back into the MFLOCC test. Indeed, McCarthy counsels that trademark "misappropriation" should not be used as a shortcut around trademark law's standard doctrines.<sup>190</sup>

<sup>189</sup> See John P. Liefeld, *How Surveys Overestimate the Likelihood of Consumer Confusion*, 93 TRADEMARK REP. 939, 962-63 (2003) (pointing out that just because a consumer has a trademark definition in his or her head, the consumer is not necessarily confused at time of purchase).

<sup>190</sup> 2 MCCARTHY, *supra* note 170, § 10:72. McCarthy adds: "[O]ne cannot dispense with the carefully constructed requirements for trademark protection by blithely claiming that defendant 'misappropriated' some symbol of plaintiff. . . ." *Id.*

Unfortunately, some courts have used goodwill misappropriation in a far less nuanced way. Instead of requiring credibility transference, courts have found trademark infringement in situations where associative uses, or in some cases mere referential uses, were being made. Such unrestrained views of misappropriative uses makes trademark law unpredictable, illogical and socially counterproductive, by inhibiting socially beneficial or necessary secondary uses.

### C. *Initial Interest Confusion*

The “initial interest confusion” doctrine (“IIC”) exemplifies the devolution of trademark law. IIC lacks a rigorous definition, a clear policy justification, and a uniform standard for analyzing claims. With its doctrinal flexibility, IIC has become the tool of choice for plaintiffs to shut down junior users who have not actually engaged in misappropriative uses.

#### 1. *The Development of the Doctrine*

IIC traces its roots to the 1975 Second Circuit case *Grottrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*.<sup>191</sup> In that case, two high-end piano manufacturers used trademarks that were partial homonyms (“Steinway” and “Grottrian-Steinweg,” with the latter word pronounced in German phonetically the same as Steinway). Although piano purchasers are careful and sophisticated, the court still found the trademark usage harmful:

The harm to Steinway, rather, is the likelihood that a consumer, hearing the “Grottrian-Steinweg” name and thinking it had some connection with “Steinway,” would consider it on that basis. The “Grottrian-Steinweg” name therefore would attract potential customers based on the reputation built up by Steinway in this country for many years. The harm to Steinway in short is the likelihood that potential piano purchasers will think that there is some connection between the Grottrian-Steinweg and Steinway pianos.<sup>192</sup>

Although the Second Circuit did not expressly state it, the court predicated the harms on credibility transference between competitors. In other words, potential piano purchasers might transfer their good sentiments towards Steinway pianos to the benefit of Steinway’s competitor. Thus, if piano purchasers considered Steinway a credible choice based on their past

<sup>191</sup> 523 F.2d 1331 (2d Cir. 1975).

<sup>192</sup> *Id.* at 1342 (footnote omitted).

interactions with the brand, Grotrian-Steinweg might also be considered a credible choice if the purchasers viewed the two competitors as related.

Perhaps recognizing the risks of recognizing harm even when the implied sponsorship does not directly cost the trademark owner sales, the court issued two important caveats. First, the court said that the mere possibility of consumers making an association between the two companies would not be enough.<sup>193</sup> Second, the court immediately cautioned that “each trademark infringement case is to some extent *sui generis*,”<sup>194</sup> suggesting the court was concerned that this particular portion of the ruling would be applied too mechanically.

The Second Circuit reiterated the link between IIC and credibility transference in a 1987 case involving two companies in the oil business, *Mobil Oil Corp. v. Pegasus Petroleum Corp.*<sup>195</sup> Mobil Oil had a consumer-oriented retail petroleum business branded under its familiar Pegasus logo.<sup>196</sup> Mobil Oil also had a business-to-business bulk oil trading business that did not use the Pegasus logo. The junior user, Pegasus Petroleum, competed with Mobil Oil in the oil trading business but not the retail consumer business. The court observed that Pegasus Petroleum gained additional credibility in initial sales pitches because bulk oil customers might assume, based on the name, that Pegasus was associated with Mobil Oil.<sup>197</sup> Based on that implicit association, customers might be willing to listen to Pegasus’s sales pitch where they may have otherwise rejected it. Thus, despite the purchasers’ sophistication and no evidence of actual confusion, Pegasus Petroleum misappropriated goodwill from Mobil Oil.

*Grotrian* and *Mobil Oil* squarely locate IIC in the realm of sponsorship confusion.<sup>198</sup> In other words, the credibility transference is problematic because the purchaser may believe that the senior user is sponsoring or affiliated with the junior user. While sponsorship confusion is not a crystal-clear doctrine, treating the IIC doctrine as a subset of sponsorship confusion kept IIC from having a huge impact on trademark jurisprudence.

<sup>193</sup> *Id.* at 1342 n.20.

<sup>194</sup> *Id.* at 1342.

<sup>195</sup> 818 F.2d 254 (2d Cir. 1987).

<sup>196</sup> 

<sup>197</sup> *Mobil Oil Corp.*, 818 F.2d at 259.

<sup>198</sup> See 3 MCCARTHY, *supra* note 170, §§ 23:6, 23.8.

In 1999, in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,<sup>199</sup> the Ninth Circuit divorced IIC from credibility transference. Instead, *Brookfield* merely required searcher “diversion.” In this case, Brookfield commercially licensed, under the trademark “moviebuff,” databases of entertainment industry information targeted towards high-end customers.<sup>200</sup> Meanwhile, West Coast intended to make available a searchable database of movie information at moviebuff.com and include the term “moviebuff.com” in its keyword metatags. The court found that, as the junior user, West Coast’s domain name infringed using a standard MFLOCC analysis.<sup>201</sup>

Addressing keyword metatags, the court found IIC because West Coast’s keyword metatags diverted traffic from Brookfield to West Coast, which meant that West Coast “improperly benefit[ed] from the goodwill that Brookfield developed in its mark.”<sup>202</sup> The court explained its reasoning with a billboard analogy:

Using another’s trademark in one’s metatags is much like posting a sign with another’s trademark in front of one’s store. Suppose West Coast’s competitor (let’s call it “Blockbuster”) puts up a billboard on a highway reading—“West Coast Video: 2 miles ahead at Exit 7”—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast’s store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there. Even consumers who prefer West Coast may find it not worth the trouble to continue searching for West Coast since there is 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.<sup>203</sup>

The Article defers a substantive critique of this analogy to Part V.C.3. For now, the analogy illustrates how *Brookfield* changed the basis of IIC from credibility transference to diversion. As the analogy states, customers do not

<sup>199</sup> 174 F.3d 1036 (9th Cir. 1999).

<sup>200</sup> *Id.* at 1041.

<sup>201</sup> *See id.* at 1054–60.

<sup>202</sup> *Id.* at 1062.

<sup>203</sup> *Id.* at 1064.



consider Blockbuster because of some transferred credibility from West Coast; instead, customers transact with Blockbuster because the advertising diverted them to a place where Blockbuster would be considered.

The *Brookfield* definition of IIC reflects this shift. *Brookfield* defined IIC as “the use of another’s trademark in a manner calculated to capture initial consumer attention, even though no actual sale is finally completed as a result of the confusion.”<sup>204</sup> The linchpin is capturing initial consumer attention; everything after that appears immaterial.<sup>205</sup>

Following *Brookfield*, courts have characterized IIC in a variety of ways.<sup>206</sup> Some courts have focused on “deceptive diversion.”<sup>207</sup> For example, IIC in the Seventh Circuit has required bait-and-switch competitive passing off<sup>208</sup> or some deception that causes consumers to think the junior user is the senior user.<sup>209</sup>

Other courts have focused on competitive diversion.<sup>210</sup> For example, in the January 2004 *Playboy v. Netscape* ruling, the Ninth Circuit redefined IIC as “customer confusion that creates initial interest in a competitor’s product.

<sup>204</sup> *Id.* at 1062 (quotations and citations omitted). McCarthy echoes this definition. See 3 MCCARTHY, *supra* note 170, § 23:6.

Other cases have used more abbreviated definitions, such as “momentary” or “brief” confusion. See, e.g., *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808, 812 (7th Cir. 2002) (“briefly”); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 195 (W.D.N.Y. 2000) (“momentarily”); *Simon Prop. Group v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1049 (S.D. Ind. 2000) (“Even if the consumer immediately became aware of his or her mistake and immediately learned that mySimon is not affiliated with SPG, initial interest confusion still would have occurred.”); *Westchester Media Co. v. PRL USA Holdings, Inc.*, 103 F. Supp. 2d 935, 972 (S.D. Tex. 1999) (“fleeting”); *N.Y. State Soc’y of Certified Pub. Accountants v. Eric Louis Assocs.*, 79 F. Supp. 2d 331, 342 (S.D.N.Y. 1999) (“momentarily”).

<sup>205</sup> *Promatek Indus.*, 300 F.3d at 812–13 (“What is important is not the duration of the confusion, it is the misappropriation of [the trademark owner’s] . . . goodwill. [The metatag user] . . . cannot unring the bell.”).

<sup>206</sup> See David M. Klein & Daniel C. Glazer, *Reconsidering Initial Interest Confusion on the Internet*, 93 TRADEMARK REP. 1035, 1039–41 (2003).

<sup>207</sup> See, e.g., *Savin Corp. v. The Savin Group*, 2004 WL 2829324, at \*17 n.13 (2d Cir. Dec. 10, 2004) (“Internet initial interest confusion requires a showing of intentional deception.”); *Deere & Co. v. MTD Holdings Inc.*, 2004 WL 324890, at \*15 (S.D.N.Y. Feb. 19, 2004); see also 3 MCCARTHY, *supra* note 170, § 23:6 (“Initial interest confusion can be viewed as a variation on the practice of ‘bait and switch.’”); Martin Schwimmer, *Inured to False Starts: Applying Initial Interest Confusion Doctrine to Paid Search* (July 2003) (unpublished manuscript on file with author) (defining and applying the tort of “deceptive diversion”).

<sup>208</sup> See *AM Gen. Corp. v. DaimlerChrysler Corp.*, 311 F.3d 796, 830 (7th Cir. 2002) (saying no IIC in trade dress case where there was no “bait and switch”); *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 382 (7th Cir. 1996).

<sup>209</sup> See *Promatek Indus.*, 300 F.3d at 812–13.

<sup>210</sup> See, e.g., *Flow Control Indus. v. AMHI, Inc.*, 278 F. Supp. 2d 1193, 1200 (W.D. Wash. 2003); Klein & Glazer, *supra* note 206, at 1037.

Although dispelled before an actual sale occurs, initial interest confusion impermissibly capitalizes on the goodwill associated with a mark and is therefore actionable trademark infringement.”<sup>211</sup> The *Playboy* case aligns (for now) the Ninth Circuit with the Third Circuit, which also constrains IIC to competitors.<sup>212</sup>

So far, this Article has addressed four different characterizations of IIC: (1) as a subset of sponsorship confusion predicated on credibility transference (Second Circuit *Grotrian* and *Mobil Oil* cases), (2) attention diversion (*Brookfield*), (3) deceptive diversion (Seventh Circuit cases), and (4) competitive diversion (*Playboy v. Netscape*).<sup>213</sup> The First Circuit has a fifth approach, which does not recognize IIC at all.<sup>214</sup> Given these varying approaches, courts clearly lack consensus about what causes IIC. The confusion over IIC does not stop there. Courts have used divergent methods to determine the interaction between IIC and the MFLOCC test.

Originally, IIC was a nondispositive tool to analyze one or a couple of MFLOCC factors,<sup>215</sup> including purchaser care,<sup>216</sup> consumer sophistication,<sup>217</sup> evidence of actual confusion,<sup>218</sup> and competitive proximity.<sup>219</sup> Then, *Brookfield*, in a footnote, suggested that in cases involving keyword metatags, the MFLOCC test was inappropriate, allowing the IIC doctrine to become a

<sup>211</sup> *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1025 (9th Cir. 2004) (citations omitted).

<sup>212</sup> See *Checkpoint Sys., Inc. v. Check Point Software Techs., Inc.*, 269 F.3d 270, 294 (3d Cir. 2001); see also *Albert & Abbati*, *supra* note 84, at 356–57 (noting that noncompetitiveness appears to be a defense to IIC).

<sup>213</sup> Admittedly, the division of cases into these four buckets is somewhat arbitrary. For example, *Brookfield* can be accurately characterized as a competitive diversion case even though the court’s language focuses on attention diversion.

<sup>214</sup> See *The Beacon Mut. Ins. Co. v. OneBeacon Ins. Group*, 290 F. Supp. 2d 241 (D.R.I. 2003), *rev’d on other grounds*, 376 F.3d 8 (1st Cir. 2004); *Astra Pharm. Prods., Inc. v. Beckman Instruments, Inc.*, 718 F.2d 1201, 1207 (1st Cir. 1983). Based on *Weiss Associates, Inc. v. HRL Associates, Inc.*, 902 F.2d 1546 (Fed. Cir. 1990), some also argue that the Federal Circuit does not recognize IIC either. See, e.g., Rachel Jane Posner, *Manipulative Metatagging, Search Engine Baiting, and Initial Interest Confusion*, 33 COLUM. J.L. & SOC. PROBS. 439, 462 (2000).

<sup>215</sup> *Davis & Boustani*, *supra* note 38, at 7.

<sup>216</sup> *Dr. Seuss Enters., L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1404 (9th Cir. 1997).

<sup>217</sup> See, e.g., *Rust Env’t & Infrastructure, Inc. v. Teunissen*, 131 F.3d 1210 (7th Cir. 1997); *Mobil Oil Corp. v. Pegasus Petroleum Corp.*, 818 F.2d 254 (2d Cir. 1987); *Grotrian, Helfferich, Schulz, Th. Steinweg Nachf. v. Steinway & Sons*, 365 F. Supp. 707 (S.D.N.Y. 1973), *aff’d*, 523 F.2d 1331 (2d Cir. 1975).

<sup>218</sup> See, e.g., *Elvis Presley Enters., Inc. v. Capece*, 141 F.3d 188, 194 (5th Cir. 1998).

<sup>219</sup> See, e.g., *Interstellar Starship Servs., Ltd. v. Epix Inc.*, 184 F.3d 1107, 1110–11 (9th Cir. 1999), *aff’d*, 304 F.3d 936 (9th Cir. 2002).

bypass of the MFLOCC test.<sup>220</sup> The MFLOCC bypass approach has since been followed by a number of courts.<sup>221</sup>

The Ninth Circuit has twice reversed *Brookfield* to eliminate IIC as a bypass to the MFLOCC test, first in the 2002 *Interstellar Starship* case<sup>222</sup> and then again in the 2004 *Playboy* case.<sup>223</sup> However, not every court in the Ninth Circuit has gotten the message,<sup>224</sup> and even the Ninth Circuit bypassed the MFLOCC test in the 2003 *Horphag* case involving keyword metatags.<sup>225</sup>

Courts have also been unclear whether IIC supports a determination of a “likelihood of consumer confusion,” or if IIC creates a different measurement for infringement, such as a “likelihood of initial interest confusion.” Once again, the Ninth Circuit has led the way, implying in the 2002 *Interstellar Starship* case that the appropriate standard is “likelihood of initial interest confusion,”<sup>226</sup> a standard fully endorsed in the 2004 *Playboy* case.<sup>227</sup> However, most other courts considering IIC have not adopted a “likelihood of initial interest confusion” standard.<sup>228</sup> Other courts have used IIC in unusual

<sup>220</sup> Specifically, the court said:

As a district court within our circuit recognized in a recent case involving a claim of trademark infringement via metatags usage, “[t]his case . . . is not a standard trademark case and does not lend itself to the systematic application of the eight factors.” Because we agree that the traditional eight-factor test is not well-suited for analyzing the metatags issue, we do not attempt to fit our discussion into one of the *Sleekcraft* factors.

*Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1062 n.24 (9th Cir. 1999) (internal citation omitted).

<sup>221</sup> See *Key3Media Events, Inc. v. Convention Connection, Inc.*, 2002 U.S. Dist. LEXIS 4043, at \*8 (D. Nev. Jan. 25, 2002); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190–91 (W.D.N.Y. 2000); *Simon Prop. Group v. mySimon, Inc.*, 104 F. Supp. 2d 1033, 1049 (S.D. Ind. 2000); *Bihari v. Gross*, 119 F. Supp. 2d 309, 319 (S.D.N.Y. 2000) (but finding no violation).

<sup>222</sup> *Interstellar Starship Servs., Ltd. v. Epix, Inc.*, 304 F.3d 936, 942 (9th Cir. 2002).

<sup>223</sup> *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020 (9th Cir. 2004).

<sup>224</sup> See *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1120, 1124 n.2 (N.D. Cal. 2003); *Edge Wireless, LLC v. U.S. Cellular Corp.*, 2004 WL 1661992, at \*17 (D. Ore. July 23, 2004).

<sup>225</sup> *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036, 1040–42 (9th Cir. 2003), *cert. denied*, 540 U.S. 1111 (2004). The court did not conduct an MFLOCC analysis or reference IIC at all.

<sup>226</sup> See *Interstellar Starship*, 304 F.3d at 945.

<sup>227</sup> See *Playboy*, 354 F.3d at 1026–27; see also *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003) (also using a “likelihood of initial interest confusion” standard).

<sup>228</sup> I did a search in Westlaw’s ALLCASES database on December 12, 2004 for the term “likelihood of initial interest confusion.” The search yielded only twelve cases using the term out of the 100+ cases referencing IIC (search results on file with the author).

ways, such as treating IIC as a new ninth *Polaroid* MFLOCC factor<sup>229</sup> and finding that IIC supported a trademark *dilution* claim.<sup>230</sup>

As should be evident by now, the *Brookfield* case took an already unclear IIC doctrine and threw it into chaos. Courts simply have no idea how to apply the IIC doctrine.<sup>231</sup> Perhaps there is no better evidence of that chaos than the Ninth Circuit's own jurisprudence, which has addressed IIC (or analogous keyword metatags) six times in five years and seemingly made up new rules each time.<sup>232</sup> Realizing the illogic of the Ninth Circuit's approach to IIC, Judge Berzon's concurrence in *Playboy* calls for the Ninth Circuit "to consider whether we want to continue to apply an insupportable rule" articulated in *Brookfield*.<sup>233</sup>

## 2. The Failings of the Doctrine

Judge Berzon is correct: The IIC rule is unsupportable. IIC commits the cardinal sin of enabling a finding of trademark infringement when the junior user is making associative or referential uses of a trademark. It does this in large part because IIC is predicated on multiple mistaken and empirically unsupported assumptions about searcher behavior.<sup>234</sup>

<sup>229</sup> See *Katz v. Modiri*, 283 F. Supp. 2d 883, 899 (S.D.N.Y. 2003); *Savin Corp. v. The Savin Group*, 2003 WL 22451731 (S.D.N.Y. Oct. 24, 2003), *rev'd on other grounds*, 391 F.3d 439 (2d Cir. 2004).

<sup>230</sup> See *Avlon Indus. v. Robinson*, 2003 WL 22025004, at \*3 (N.D. Ill. Aug. 27, 2003).

<sup>231</sup> See generally Deborah F. Buckman, Annotation, *Initial Interest Confusion Doctrine Under Lanham Trademark Act*, 183 A.L.R. FED. 553 (2003) (collecting, and trying to organize, the conflicting cases).

<sup>232</sup> The chronology in order:

- Apr. 1999: IIC bypasses MFLOCC test; keyword metatags create IIC. *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999).
- Feb. 2002: Keyword metatag usage was nominative use; nominative use bypasses the MFLOCC test. *Playboy Enters., Inc. v. Welles*, 279 F.3d 796 (9th Cir. 2002).
- June 2002: IIC is subordinate to MFLOCC test; articulating a likelihood of initial interest confusion standard. *Interstellar Starship*, 304 F.3d 936.
- July 2003: Keyword metatag usage infringes; no reference to either IIC or MFLOCC. *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036 (9th Cir. 2003).
- Jan. 2004: IIC subordinated to MFLOCC test; search provider who enables keyword-triggered ads may cause likelihood of initial interest confusion; court does not distinguish between direct or contributory trademark infringement for determining the search provider's liability. *Playboy*, 354 F.3d 1020.
- Aug. 2004: Considering only a few MFLOCC factors, but not linking IIC to any of those factors; IIC found because the website was displaying relevant content that searchers might find useful. *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004).

<sup>233</sup> *Playboy*, 354 F.3d at 1036 (Berzon, J., concurring); see Doellinger, *supra* note 53, at 174 (calling the IIC doctrine "muddled and nearly incoherent").

<sup>234</sup> Cf. Mueller Report, *supra* note 121 (IIC "lacks an established corpus of social science research confirming its existence and defining its characteristics.").

First, IIC assumes that a searcher using a trademarked keyword is looking for the trademark owner (or, perhaps, some authorized licensee or secondary user).<sup>235</sup> This assumption is unsupportable because of objective opaqueness. Searchers' objectives cannot be inferred from the keywords they employ. As the examples above in Part II.B illustrate, it is improper to assume that using a trademarked keyword means that the searcher wanted to find the trademark owner. Because of objective opaqueness, any IIC doctrine built on diversion is inherently flawed. Finding searcher "diversion" is not possible until one knows where searchers were heading in the first place.<sup>236</sup>

Second, a keyword search at a search engine should result in some filtering content (Stage 5). IIC ignores the impact this content can have on the searcher's decision to proceed with the search. A searcher who proceeds from the results evaluation stage (Stage 5) to the investigation stage (Stage 7) has already made a decision (Stage 6) that the results may be relevant to the searcher's objectives.

Third, filtering content may educate the searcher in ways that cause the searcher to dynamically change search objectives.<sup>237</sup> For example, a searcher seeking more information about Canon cameras might search using the keyword "Canon" and receive a Nikon ad that reminds the searcher about prior positive impressions of Nikon.<sup>238</sup> The searcher may then decide to suspend the search for Canon cameras and digress to explore more about Nikon. At this point, the searcher is no longer searching for Canon. Thus, based on the

<sup>235</sup> See *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000); see also Shipman, *supra* note 1, at 276 (trademark owners suffer harm because they are not at the top of the search results list); Note, *supra* note 53, at 2405–07.

<sup>236</sup> See Yelena Dunaevsky, Comment, *Don't Confuse Metatags with Initial Interest Confusion*, 29 FORDHAM URB. L.J. 1349, 1384–85 (2002).

Presuming diversion without knowing searcher objectives brings to mind Alice's conversation with the Cheshire Cat:

"Would you tell me, please, which way I ought to go from here?"

"That depends a good deal on where you want to get to," said the Cat.

"I don't much care where —" said Alice.

"Then it doesn't much matter which way you go," said the Cat.

LEWIS CARROLL, *ALICE'S ADVENTURES IN WONDERLAND* 100 (Richard Kelly ed., Broadview Press 2000) (1865).

<sup>237</sup> See ROSENFELD & MORVILLE, *supra* note 9, at 104; Kurt M. Saunders, *Confusion Is the Key: A Trademark Law Analysis of Keyword Banner Advertising*, 71 FORDHAM L. REV. 543, 573–74 (2002).

<sup>238</sup> See Mark S. Nadel, *The Consumer Product Selection Process in an Internet Age: Obstacles To Maximum Effectiveness and Policy Options*, 14 HARV. J.L. & TECH. 183, 250 (2000) (noting how memory prompts can facilitate beneficial competition).

exposure to Nikon-oriented filtering content, the searcher dynamically develops a new search objective—“get more information about Nikon”—and investigates the search result accordingly. The dynamic shift in search strategies might frustrate some trademark owners, but so long as the searcher is not confused, the searcher will optimize the search as he or she sees fit. The fact that it was prompted by a search for Canon, which may reinforce in the searcher’s mind that Nikon and Canon are in the same product class, is an example of associative use discussed earlier.

Finally, to the extent that IIC has been used in metatag cases, the IIC doctrine has been predicated on incorrect understandings about metatags, particularly keyword metatags. From a legal standpoint, keyword metatags have earned mythical status, which has led to some courts to deem their usage as per se infringing<sup>239</sup> or, at minimum, confirmation of a publisher’s bad faith.<sup>240</sup>

However, keyword metatags’ powers have never been all that mythical. Starting in the mid-1990s, some search engines weighted keyword metatags in their relevancy algorithms.<sup>241</sup> When publishers then manipulated their keyword metatags to provide suboptimal keyword associations, search engines progressively realized that keyword metatags were a poor indicator of relevancy.

As a result, almost all search engines have removed keyword metatags from their relevancy algorithms.<sup>242</sup> Since 2002, only one major search engine, Inktomi, still incorporates keyword metatags in its algorithm<sup>243</sup>—meaning that

<sup>239</sup> See *Horphag Research Ltd. v. Pellegrini*, 337 F.3d 1036, 1040 (9th Cir. 2003).

<sup>240</sup> See *Eli Lilly & Co. v. Natural Answers, Inc.*, 233 F.3d 456, 465 (7th Cir. 2000), *see also* Doellinger, *supra* note 53, at 220 (“[T]he only reason a competitor would include the trademarks of another in the metatags of its web site would be to attempt to divert some of the trademark holder’s potential customers.”); O’Rourke, *supra* note 67, at 303 (“[T]here seems to be general agreement that metatagging at best is an unfair way to compete and at worst is morally reprehensible.”).

<sup>241</sup> Danny Sullivan, *Death of a Meta Tag*, at [http://www.searchenginewatch.com/sereport/print.php/34721\\_2165061](http://www.searchenginewatch.com/sereport/print.php/34721_2165061) (Oct. 1, 2002). Sullivan says that Infoseek and AltaVista both started recognizing keyword metatags in early 1996, Inktomi starting in mid-1996 and Lycos starting in mid-1997. *Id.*

<sup>242</sup> *Id.*

<sup>243</sup> *Id.* As of Fall 2002, Inktomi remains the only major search engine to recognize keyword metatags; Google, FAST, AltaVista, and Lycos do not. According to Inktomi, “The meta keywords value is just one of many factors in our ranking equation, and we’ve never given too much weight to it.” *Id.*

A secondary search engine, Teoma, is also rumored to include keyword metatags in their algorithm, but Teoma has not clearly announced its policy. See Email from Darcy Cobb, Dotted Line Communications (public relations firm for Teoma), to Eric Goldman, Assistant Professor of Law, Marquette University Law School (Sept. 2, 2003, 10:23 am) (on file with author) (citing Teoma’s policy as “When crawling a site, Teoma

keyword metatags currently influence search result rankings for a small percentage of searches. Because of their low impact, search engine industry analysts now routinely advise publishers not to waste their time carefully crafting keyword metatags.<sup>244</sup>

Concern has also been expressed about the surreptitious or invisible operation of keyword metatags,<sup>245</sup> but these concerns are misguided on several fronts. Even if keyword metatags operate invisibly, so do most other aspects of search engine operations. Because search engine algorithms are secret, searchers have no idea how search results are generated<sup>246</sup> or what the results are (editorial content versus ads).<sup>247</sup> Thus, a search engine's consideration of "invisible" keyword metatags text is just one more factor that searchers do not understand.<sup>248</sup> By way of comparison, searchers cannot see or understand anchor text used to Google bomb. The fact that invisible words were used to match searchers with content is immaterial to searchers. Searchers care about the relevancy of the results, not how they were generated.<sup>249</sup> If keyword metatags lead to relevant results, the searcher accomplishes his or her goals even if the process is opaque to searchers.<sup>250</sup>

collects as much information as possible. While metatags are not always helpful, they can sometimes be helpful. Therefore, Teoma collects metatag information when it helps improve the relevance of search results.").

<sup>244</sup> See Andrew Goodman, *An End to Metatags (Enough Already, Part 1)*, at <http://www.traffick.com/article.asp?aID=102> (Sept. 2, 2002); Markus Hoevenier, *The Death of the Meta Tags*, at [http://www.bloofusion.com/white\\_papers/meta\\_tags/death-of-meta\\_tags.pdf](http://www.bloofusion.com/white_papers/meta_tags/death-of-meta_tags.pdf) (last visited Apr. 1, 2005) ("Most of the web sites operated by Bloofusion don't even have meta tags and still rank on #1 positions."); Sullivan, *supra* note 241; Jill Whelan, *No Meta Keyword Tags*, at [http://www.searchengineguide.com/whalen/2002/1004\\_jw1.html](http://www.searchengineguide.com/whalen/2002/1004_jw1.html) (Oct. 4, 2002).

<sup>245</sup> See, e.g., Nathenson, *supra* note 53.

<sup>246</sup> See Introna & Nissenbaum, *supra* note 79, at 177; Marable, *supra* note 23, at 5; see also Olsen, *supra* note 90 (discussing Nutch, an effort to develop an open-source search engine with transparent algorithms).

<sup>247</sup> Marable, *supra* note 23, at 5. This report followed up an earlier report also showing that searchers did not understand how search engines work. See Consumer WebWatch, *A Matter of Trust: What Users Want From Web Sites*, at [http://64.78.25.46/view\\_article.cfm?id=10155&at=510](http://64.78.25.46/view_article.cfm?id=10155&at=510) (Apr. 16, 2002) ("Users are largely unaware that search engines may not be neutral guides to the online world.").

<sup>248</sup> This same critique applies with equal force to keyword-triggered ads. See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1034 (9th Cir. 2004) (Berzon, J., concurring).

<sup>249</sup> See Stefanie Olsen, *Are Search Engines Confusing Surfers?*, CNET News.com, at [http://news.com.com/2102-1024\\_3-5090701.html?tag=st\\_util\\_print](http://news.com.com/2102-1024_3-5090701.html?tag=st_util_print) (Oct. 13, 2003) (quoting Yahoo! spokesperson Diana Lee).

<sup>250</sup> Introna and Nissenbaum argue that search engines do not disclose enough information about their practices, hindering searchers from making informed choices between search engines. Introna & Nissenbaum, *supra* note 79, at 181. While search engines do withhold crucial information about their coverage and algorithms to prevent search results manipulation, that information may be irrelevant to searchers so long as the searchers subjectively feel that they are getting good results.

Furthermore, publishers can visibly use third party keywords in ways that are, in practice, no less invisible than keyword metatags.<sup>251</sup> For example, publishers can display a trademark using a font color that is virtually identical to the web page's background color or using a miniscule font size, or in text so far "below the fold"—i.e., below the top portion of the page initially displayed to a searcher who visits the page—that few searchers realize it is there. Trying to distinguish keyword metatags from these techniques would emphasize form over substance. And, of course, if the keyword in the keyword metatag also appears in the "on the page" content, there is nothing surreptitious about putting the keyword in the keyword metatag.

Finally, no matter what the publisher does, search engines ultimately decide what data to collect, how to weigh it, and how to present it.<sup>252</sup> Therefore, a publisher's inclusion of a term in a keyword metatag does not guarantee that the search engines will index it, that the publisher will appear in the search results,<sup>253</sup> or that any searcher will ever see the search results. No matter what steps a publisher takes to be indexed on a third party trademark, search engines have the final say. While it may never have been appropriate to craft special legal rules for keyword metatags, evolved practices make these rules anachronistic. The keyword metatag is dead from a marketing standpoint;<sup>254</sup> its legal significance should end as well.

Description metatags operate differently from keyword metatags, so they warrant a brief discussion. Unlike keyword metatags, some search engines display the description metatags verbatim as filtering content in the search results. In these cases, the searcher may see the text—and any trademark references by the publisher—and use it to decide whether to investigate the search results further. In those cases, the description metatag actually filters

<sup>251</sup> See Nathenson, *supra* note 53, at 62 (discussing a variety of practices). Note that keyword metatags are not completely hidden from searchers; anyone can see keyword metatags by viewing the web page's source file. See Lastowka, *supra* note 20, at 861 n.131. Keyword metatags just seem invisible because searchers have to take that extra step, and usually there is no reason to do so.

<sup>252</sup> See Perkins, *supra* note 69 (stating that keyword metatags should not be considered bad search engine practices because search engines decide what to do with them).

<sup>253</sup> Many search engines truncate the number of search results made available to searchers. For example, Google cuts off search results at 1000. Ridings & Shishigin, *supra* note 82, at 7. Truncation reduces the amount of computations a search engine needs to make in determining its search results order. *Id.*

<sup>254</sup> Sullivan, *supra* note 241.



searchers before they make the choice to investigate the website, and this filtering function may save searchers time.<sup>255</sup>

On the other hand, not every search engine indexes or displays description metatags. As discussed earlier, Google may display a description in its search results authored by a third party.<sup>256</sup> In these cases, including a trademark in the description metatag (like putting the trademark in the keyword metatag) may not affect search engine indexing.

### 3. *Deconstructing Brookfield*

The various failings of the IIC doctrine (including the mistaken assumptions about metatags) pervade almost every case finding infringement due to IIC or metatags. The multiple and repeated errors courts make regarding IIC and metatags can be seen by re-examining the seminal *Brookfield* case and, in particular, the oft-cited (and oft-criticized) billboard analogy.<sup>257</sup>

First, in the billboard analogy, the searcher is not actively conducting a search. Rather, the driver is passively exposed to content (the billboard). The court's hypothetical assumes that the content is impactful enough to cause the driver to instantly develop a search objective and start implementing the search. The court further presumes that the search objective is to find West Coast Video, an assumption that may be reasonable in context.<sup>258</sup>

In the search engine context, the searcher proactively selects a keyword that encapsulates his or her search objective. Due to objective opaqueness, the searcher's goals are not clear from the keyword. Thus, making an inference that a searcher using the keyword "moviebuff.com" is looking for Brookfield's

<sup>255</sup> See *Bihari v. Gross*, 119 F. Supp. 2d 309, 320 (S.D.N.Y. 2000) (discussing how a gripe site's filtering content—that clearly disparaged the trademark owner in the filtering content itself—removed any confusion the searcher might have experienced before investigating the site).

<sup>256</sup> See *supra* Part IV.A.5.

<sup>257</sup> See *supra* note 203.

<sup>258</sup> However, this fact pattern is especially stylized because of the unique attributes of video rental searches. To watch a video, a searcher needs access to a video player. This usually limits video rentals to geographic locations where the searcher has easy access to a video player, such as the searcher's house or business or a friend's house—in other words, usually in geographic areas the searcher knows. In the billboard analogy, the searcher is attempting to spontaneously rent from a store in an unfamiliar neighborhood. Though possible, this type of search seems extremely rare.

website is far less reasonable than the analogous presumption when a driver initiates a search in response to a billboard featuring West Coast Video.<sup>259</sup>

Second, the analogy makes an apples-to-oranges comparison.<sup>260</sup> In the search engine context, keyword metatags act as a *trigger* to cause the display of filtering content, but the searcher never sees the text contained in the keyword metatags. In the billboard analogy, the billboard *is* the filtering content. Therefore, keyword metatags and billboards do not perform the same search function.

Furthermore, the filtering content displayed to searchers using the keyword “moviebuff.com” remains unknown. The billboard analogy deliberately uses a stylized example of intentionally false filtering content that prominently displayed the competitor’s trademark. In the Internet context, this is most closely analogizable to pagejacking. However, imagine if the search engine filtering content displayed for the keyword “moviebuff.com” was both accurate and did not reference a Brookfield trademark. For example, assume the filtering content triggered by “moviebuff.com” said: “Welcome to West Coast Video, A Great Place to Rent Movies.”<sup>261</sup> At that point, does it seem likely that a searcher would expect to find Brookfield’s offerings at this site? Especially if another search result unambiguously indicated that the associated site was Brookfield’s? Because the content the searchers saw is unknown, there is no fair comparison of the billboard’s false filtering content to the metatag’s trigger of unknown filtering content.

In any case, the display of filtering content triggered to a moviebuff.com metatag is an associative use. It merely educates the searcher about products

<sup>259</sup> The presumption was also unreasonable in *Brookfield* because West Coast Video had legitimate and protectable trademark rights in the term “Movie Buff” in some contexts. See *Brookfield Communications, Inc. v. W. Coast Entm’t Corp.*, 174 F.3d 1036, 1042 (9th Cir. 1999). The court makes a point of distinguishing between “movie buff” and “moviebuff” based on the omission of the space. *Id.* at 1066. Yet, this distinction seems unreasonable given that searchers do not choose keywords precisely and some search engines automatically correct typographical errors. See *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808, 811 (7th Cir. 2002) (finding that including the term “copitrack” in the keyword metatags was infringing when the plaintiff had a trademark in “copitrak,” even though a searcher using the keyword “copitrak” would not find the defendant’s website unless the search engines reinterpreted the keyword to include the typographically erroneous version “copitrack”).

<sup>260</sup> See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1035–36 (9th Cir. 2004) (Berzon, J., concurring); see also Jason Allen Cody, Note, *Initial Interest Confusion: What Ever Happened to Traditional Likelihood of Confusion Analysis?*, 12 FED. CIR. B.J. 643, 681 (2002/2003) (discussing this point generally).

<sup>261</sup> Because West Coast Video had some protectable rights in a phrase that included the term “Movie Buff,” I think the same result attaches if West Coast Video’s filtering content displayed “Movie Buff.”

that may share some attribute. The *Brookfield* case improperly manufactured goodwill misappropriation out of a benign associative use.

Finally, the court ignored differential search costs between physical space and cyberspace. In the billboard analogy, the driver initiates a search doomed to fail, but during the course of conducting the search, the driver does not get additional feedback along the way about whether or not the driver is making progress towards the objective. Furthermore, the driver may not have a cost- or time-effective way to obtain more information to correct the search. In contrast, cyberspace searchers get continuous feedback about their search progress each time searchers see an additional web page, and the "costs" to correct their search can be as minimal as hitting the back button.<sup>262</sup>

The *Brookfield* court's analogy of keyword metatags to a deliberately deceptive billboard fundamentally misapprehends the nature of Internet search.<sup>263</sup> However, the point of deconstructing the billboard analogy is not to prove that it reached the wrong outcome. Instead, the analogy's fact pattern may appropriately give rise to a Lanham Act violation, either as false advertising<sup>264</sup> or perhaps under a standard MFLOCC analysis. Nonetheless, a

<sup>262</sup> Indeed, because of the constant feedback and lower correction costs, Internet searchers may become much more willing to take chances in their Internet searches than they would be in physical space searches.

<sup>263</sup> Compare the deficiencies of the *Brookfield* analogy with a counteranalogy offered in the district court opinion in *Playboy v. Netscape*:

This case presents a scenario more akin to a driver pulling off the freeway in response to a sign that reads "Fast Food Burgers" to find a well-known fast food burger restaurant, next to which stands a billboard that reads: "Better Burgers: 1 Block Further." The driver, previously enticed by the prospect of a burger from the well known restaurant, now decides she wants to explore other burger options. Assuming that the same entity owns the land on which both the burger restaurant and the competitor's billboard stand, should that entity be liable to the burger restaurant for diverting the driver?

*Playboy Enters., Inc. v. Netscape Communications Corp.*, 55 F. Supp. 2d 1070, 1075 (C.D. Cal. 1999). Notice that the searcher forms a search objective based on accurate, nonbranded filtering content. Then, the searcher receives additional relevant, accurate, nonbranded filtering content responsive to that search objective. Unlike videotapes, searchers may spontaneously seek fast food in an unfamiliar geographic area. Thus, while all billboard examples are poor analogies to Internet searching, the *Playboy* analogy may be closer to describing Internet search than the *Brookfield* analogy.

<sup>264</sup> Professor McCarthy similarly confuses the applicable doctrines in his analogy describing IIC:

The analogy to trademark initial interest confusion is a job-seeker who misrepresents educational background on a resume, obtains an interview and at the interview explains that the inflated resume claim is a mistake or "typo." The misrepresentation has enabled the job-seeker to obtain a coveted interview, a clear advantage over others with the same background who honestly stated their educational achievements on their resumes. In such a situation, it is not possible to say that the misrepresentation caused no competitive damage.

billboard-initiated search cannot be properly analogized to Internet search. The policy inferences made by the *Brookfield* court, and followed by many other courts, based on such an analogy are erroneous.<sup>265</sup>

#### 4. *Consequences of a Bad Doctrine*

Because IIC lacks a rigorous definition, defendants are virtually powerless to combat it—especially under *Brookfield*'s framework of treating any efforts to capture initial consumer attention as goodwill misappropriation. Search engine robots can capture and index every word on every page, making it possible for those words to capture initial consumer attention.<sup>266</sup> Further, some publishers can successfully communicate with searchers only by using trademarks for their referential and socially-beneficial associative uses. As Judge Berzon said in *Playboy*, “the metatag holding in *Brookfield* would expand the reach of initial interest confusion from situations in which a party is initially confused to situations in which a party is never confused.”<sup>267</sup>

The contradictory and unstable results in IIC cases may be, in part, due to courts' desires to reach a less harsh result than the result *Brookfield* seems to require. However, courts still do not have a solid doctrinal grasp of the harms IIC supposedly causes. The lack of a clear understanding of the harm leads to paradoxical rulings like those permitting publishers to put a third party trademark on their web pages—where it is almost guaranteed to be indexed by search engines, while, at the same time, deeming it infringement for the publisher to put the same term in the keyword metatags—where, more likely than not, it would be ignored by search engines.<sup>268</sup>

3 MCCARTHY, *supra* note 170, § 23.6. McCarthy's analogy is perplexing because the job seeker uses the university's trademark as a false “product” *attribute* (i.e., inflated credentials of the person's services being sold), not a confusing designation of the product *source* (the job seeker, not his degree-granting institution, supplies those services). Further, the job seeker does not use the trademarks of other job seekers, so the other job seekers would not have standing to sue for trademark infringement. Therefore, the “competitive damage” experienced by other job seekers may be due to false advertising or misrepresentation, but not trademark infringement.

<sup>265</sup> See *Playboy*, 354 F.3d at 1036 (Berzon, J., concurring).

<sup>266</sup> All marketing is, by definition, an effort to capture initial consumer attention. See Dunaevsky, *supra* note 236, at 1376 (“[W]hat other purpose can a business owner have in setting up a website, if not to attract consumers?”).

<sup>267</sup> *Playboy*, 354 F.3d at 1034 (Berzon, J., concurring).

<sup>268</sup> See *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808, 811 (7th Cir. 2002) (finding Equitrac's use of the term “Copitrack” in its metatags infringing, but at the same time *mandating* that Equitrac display the text on its website in a manner that should likely cause search engines to index the term “Copitrack”); *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036, 1066 (9th Cir. 1999) (permitting West Coast Video to display an advertisement saying “Why pay for MovieBuff when you can get the same

More problematically, the IIC doctrine has been used as a content regulation tool to shut down websites that the trademark owner does not like, such as parody websites,<sup>269</sup> gripe websites,<sup>270</sup> websites marketing gray market goods,<sup>271</sup> websites publishing information about used equipment dealers,<sup>272</sup> websites publishing information relevant to their inquiries,<sup>273</sup> websites providing conference attendees with a directory of resources for their trip,<sup>274</sup> and websites advertising a provider of postsale equipment servicing.<sup>275</sup> Normally, trademark law should not interfere with these socially beneficial trademark uses. Also troubling are cases suggesting that search providers can be liable for IIC,<sup>276</sup> a result that could circumscribe search providers' ability to facilitate keyword searches. These results are deeply troubling for the free flow of relevant content. Trademark law should not deplete the social discourse of valuable content, yet IIC has emerged as a tool to do just that.

thing here for FREE?" but preventing West Coast Video from including "moviebuff.com" in the metatags); *cf.* O'Rourke, *supra* note 67, at 298 (giving the example of a clothing website putting the phrase "This site is not in any way affiliated with the Gap gap or Babygap babygap" into the keyword metatags).

<sup>269</sup> See *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359 (4th Cir. 2001); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176 (W.D.N.Y. 2000); see also *Dr. Seuss Enters., v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997).

<sup>270</sup> See *J.K. Harris & Co. v. Kassel*, 2002 WL 1303124 (N.D. Cal. Mar. 22, 2002), *rev'd*, 253 F. Supp. 2d 1120 (N.D. Cal. 2003); *OBH*, 86 F. Supp. 2d 176. See generally Jonathan Band & Matthew Schruers, *Towards a Bright-Line Approach to [Trademark]sucks.com*, 20 COMPUTER & INTERNET LAW., July 2003, at 4, 10 (criticizing the use of IIC against gripe sites).

<sup>271</sup> See *Bayer HealthCare LLC v. Nagrom, Inc.*, 2004 WL 2216491 (D. Kan. Sep. 7, 2004); see also *Bayer Corp. v. Custom Sch. Frames, LLC*, 259 F. Supp. 2d 503 (E.D. La. 2003) (although based on the facts in this case, the usage may have violated the Lanham Act in other ways); *cf.* *Empresa Cubana del Tabaco v. Culbro Corp.*, 2004 WL 602295 (S.D.N.Y. Mar. 26, 2004) (IIC found even though the trademarked goods are embargoed), *rev'd in part*, 399 F.3d 462 (2d Cir. 2005).

<sup>272</sup> See *PACCAR Inc. v. TeleScan Techs., LLC*, 319 F.3d 243 (6th Cir. 2003) (providing information about accessories and dealers using the plaintiff's trademarks in the domain names); *Caterpillar Inc. v. TeleScan Techs., LLC*, 2002 U.S. Dist. LEXIS 3477 (C.D. Ill. Feb. 13, 2002) (providing database of dealers of plaintiff's products).

<sup>273</sup> See *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004) (displaying automobile-related information at *nissan.com* is IIC).

<sup>274</sup> See *Key3Media Events, Inc. v. Convention Connection, Inc.*, 2002 U.S. Dist. LEXIS 4043 (D. Nev. Jan. 25, 2002).

<sup>275</sup> See *Promatek Indus., Ltd. v. Equitrac Corp.*, 300 F.3d 808 (7th Cir. 2002). See generally Ivancevich, *supra* note 186 (criticizing the *Promatek* case for failing to recognize the defendant's role as an after-market service provider).

<sup>276</sup> See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020 (9th Cir. 2004); *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

## VI. DEVELOPING AN INTEGRATED LAW OF KEYWORDS

Recognizing the foregoing problems, some commentators have tried to salvage IIC by limiting it to competitors<sup>277</sup> or metatags.<sup>278</sup> While these alternatives would improve upon the existing law, minor patches to IIC do little to cure the problem. More structural doctrinal reform is needed.

The problem of achieving reform is that trademark law has principally derived from situations where consumers passively receive commercial communications. Cases like *Mobil Oil* provide such an example, where the customer had a latent search—"will buy oil at the right price"—that was activated by an unsolicited telephone call using a trademark that allegedly transferred some credibility. Similarly, in the *Brookfield* billboard analogy, the driver did not have any search objective until the deceptive billboard created one. With passive search processes like these, there may be a greater risk that a consumer is sent in the wrong direction ("diverted") because the content containing the trademark also creates the search objective. At minimum, it becomes more supportable to treat those searchers as having homogeneous search objectives, because the search objectives derived from the same content.

Keyword-based Internet searches are different. In most situations, searchers actively pick the keywords they use to find information and actively choose between intermediaries to help convert those words into relevant content. Models built on passive-based search strategies do not work. To enable searchers to pick keywords that manifest their interests, and to permit publishers and search providers to cater to those interests, deregulation of the keyword is necessary. This Part proposes three complementary ways to do so.

### A. *Move Infringement Analysis Back in Time*

As currently applied, the IIC and goodwill misappropriation doctrines have pushed trademark infringement analysis into the early stages of the search process. Doing so creates two principal concerns: (1) liability may reduce the information searchers receive to conduct predictive evaluations, which may

<sup>277</sup> Brief of Amicus Curiae Google, Inc. at 12–13, *1-800 Contacts, Inc. v. WhenU.com*, (2d Cir. 2004) (No. 04-0026-cv) (authored by Mark A. Lemley and supporting neither appellants nor appellee—but supporting reversal) [hereinafter Google Brief]; Maynard, *supra* note 55.

<sup>278</sup> Brief of Amicus Curiae Electronic Frontier Foundation, *J.K. Harris & Co. v. Kassel*, 253 F. Supp. 2d 1130 (N.D. Cal. 2003) (No. C 02-0400 CW) (authored by Fred von Lohmann and supporting the defendant's motion for reconsideration), available at <http://www.eff.org/IP/20020710-taxes-com-amicus.pdf> (last visited Apr. 1, 2005).

make searches less efficient and effective, and (2) there is less confidence that trademark owners suffer actual harm from diversion because whether the searcher intends to transact with anyone is unknown.

### 1. *Searchers Benefit from Filtering Content*

This Part turns first to problems arising from reducing information at early search stages. At early stages, the searcher may be doing associative learning. If trademark law restricts information considered by the searcher based on assumptions about the searcher's objectives, trademark law may counterproductively increase the search costs by delaying or preventing associative learning.

In addition to facilitating associative learning, filtering content speeds up predictive judgments. Filtering content allows searchers to quickly grade for topicality and make decisions about which search results to investigate more deeply. Therefore, searchers benefit from more filtering content earlier in the process, not less.<sup>279</sup> This is especially true for searchers using a keyword for a "minority" or esoteric definition; good filtering content helps them make efficient topicality determinations to find publishers who use the keyword for the same nonmajority meaning.<sup>280</sup> All of this suggests that searchers benefit by having an appropriate quantity of accurate filtering content; or stated negatively, searchers are harmed by legal doctrines that dissuade search providers and publishers from providing filtering content.

Along these lines, the *Playboy* court tried to mandate filtering content with its suggestion that liability for keyed banner ads could be avoided if the ad "clearly identifies [the ad's] source . . . or a search engine clearly identifies a

<sup>279</sup> See Rieh, *supra* note 25, at 159 ("Web users would make their predictive judgments more efficiently if they could see more clues to indicate the facets of information quality and cognitive authority . . . . Without enough clues, users often had to open one Web page based on guessing rather than decision, and often had to come back to the search results page because their choice was not what they expected."); Zachary Rodgers, *Ask Jeeves Bows New Search Functions, Hints at Future Plans*, at [http://www.clickz.com/resources/search\\_reference/heavyweights/print.php/3370961](http://www.clickz.com/resources/search_reference/heavyweights/print.php/3370961) (June 21, 2004) (discussing how better filtering content virtually eliminated "pogo sticking" between search results and associated publisher pages); see also Julie A. Rajzer, Comment, *Misunderstanding the Internet: How Courts Are Overprotecting Trademarks Used in Metatags*, 2001 L. REV. M.S.U.-D.C.L. 427.

<sup>280</sup> Consider that in some cases, lower-ranked search results result in higher conversion-to-sale. See Nico Brooks, *The Atlas Rank Report—Part II: How Search Engine Rank Impacts Conversions*, Atlas Institute Digital Marketing Insights (2004), available at <http://www.atlasdmt.com/media/pdfs/insights/RankReportPart2.pdf>. This data suggests that searchers may be more interested in specific search results because they have sorted through the filtering content on the search results page.

banner advertisement's source."<sup>281</sup> Unfortunately, the court had no empirical evidence to demonstrate that the labels would dispel confusion or that searchers have any confusion that needs to be dispelled.<sup>282</sup> In a choice between judges and search providers as to who is better positioned to decide how to present filtering content, search providers—guided by information scientists and market forces—will always reach better results.<sup>283</sup>

The *Playboy* court also worked from the wrong premise. The court, and many others, believed that searchers who see filtering content in response to a trademarked keyword search are confused about the sponsorship or affiliation of the filtering content.<sup>284</sup> This assumption has never been backed up empirically,<sup>285</sup> and it appears to be another intuition-driven myth. As discussed earlier, searchers do not understand why they get the search results they get, so they have no basis to infer some connection between a trademark owner and search results.<sup>286</sup> There is also zero evidence that searchers care about the behind-the-scenes machinations that produce the content they see.

More problematically, the assumptions about sponsorship or affiliation build off the false assumption that we know what the searcher expected to find based on the keyword they chose. Instead, searchers' "true" search objectives are partially revealed only when they act upon the filtering content.<sup>287</sup> If a searcher decides to investigate search results further, the searcher indicates that the publisher's information may be relevant to the search objectives. On the other hand, if a searcher ignores the filtering content, then it is possible to infer

<sup>281</sup> *Playboy*, 354 F.3d at 1030.

<sup>282</sup> Compare *Playboy's* mandatory disclosure with *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 757–58 (E.D. Mich. 2003), in which the court said that WhenU's keyword-triggering of ads was not a use in commerce in part because it did *not* display the trademark owner's trademarks.

<sup>283</sup> Cf. Jon H. Oram, Note, *The Costs of Confusion in Cyberspace*, 107 YALE L.J. 869, 874 (1997) ("Technological solutions often will do a better job of solving intellectual property problems than legal institutions could ever hope to do.").

<sup>284</sup> This assumption pervades the *Brookfield* case. See also Doellinger, *supra* note 53, at 219 ("The mere appearance of a defendant's website on a search engine results list necessarily indicates consumer confusion at a certain level."); Mark Sableman, Search Service Keyword-Based Advertising: Trademark Infringement or Fair Competition? 134 (Aug. 6, 2004) (unpublished manuscript on file with author).

<sup>285</sup> The surveys offered in the 2004 *Playboy* and *1-800 Contacts* cases did try to establish this proposition but both surveys were flawed beyond repair.

<sup>286</sup> See Klein & Glazer, *supra* note 206, at 1061–63; cf. *Wells Fargo*, 293 F. Supp. 2d at 749 (making that determination for keyword-triggered ads).

<sup>287</sup> Cf. Google, *Optimization Tips*, at <https://adwords.google.com/select/tips.html> (last visited Apr. 1, 2005) (discussing the importance for advertisers to write good ad copy/filtering content to generate cost-effective leads).



that the searcher deemed the content irrelevant. Either way, the searcher suffers no harm.

This discussion prompts an obvious solution: Do not base trademark infringement on a search provider's or publisher's accurate display of filtering content.<sup>288</sup> Such liability jeopardizes the delivery of filtering content, to searchers' detriment, assuming phantom harms to the searcher and the trademark owner.

In contrast, false filtering content raises some concern because it can increase search costs, such as when filtering content causes searchers to incorrectly believe that the search results are from the senior user.<sup>289</sup> Once searchers pursue this search result, a publisher can cause searchers to continue their investigation without clarifying or removing the false expectations. In some cases, even after searchers realize the mistake, searchers may stick with the publisher because they irrationally overvalue the sunk search costs.<sup>290</sup>

Alternatively, searchers may persist with the falsely induced search because "switching costs"—i.e., the search costs incurred from stopping the existing search and starting a new one—to find the trademark owner are not justified by the benefit.<sup>291</sup> Unclear or deceptive information from the publisher could lead searchers to a "point of no return," where even rational searchers will persist with the publisher rather than find the originally intended trademark owner. The searcher reaches the "point of no return" because the searcher's goodwill towards the trademark owner caused the searcher to invest more search costs into the publisher. A publisher who causes a searcher to reach the point of no return on that basis has engaged in "switching cost exploitation." In this sense, switching cost exploitation is a species of credibility transference.

<sup>288</sup> While this is a simple solution, it would unavoidably reverse decisions like *Playboy v. Netscape* and *1-800 Contacts v. WhenU*, both of which held the search provider liable merely for displaying filtering content (in both cases ads) triggered by keywords. See *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020 (9th Cir. 2004); *1-800 Contacts v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

<sup>289</sup> See Saunders, *supra* note 237, at 565 (discussing differences between true, false and unclear filtering content).

<sup>290</sup> Economists generally consider it irrational to include sunk costs in decisionmaking about future behavior. However, psychological studies suggest that people do so nonetheless. See, e.g., Hal R. Arkes & Catherine Blumer, *The Psychology of Sunk Costs*, 35 *ORG. BEHAV. & HUMAN DECISION PROCESSES* 124 (1985).

<sup>291</sup> See H.A. Simon, *Rationality as Process and as Product of Thought*, 68 *AM. ECON. REV.* 1, 10 (1978); see also Romanos, *supra* note 67, at 91.

The *Mobil Oil* case presents a possible example of switching cost exploitation. When the Pegasus salesperson cold-called buyers, the implicit credibility (that the call was coming from Mobil Oil, a major industry player) caused buyers to investigate a transaction further. Ultimately buyers would realize, prior to closing, that Pegasus was not Mobil Oil. However, price was a paramount basis of competition for commodity oil,<sup>292</sup> so a buyer might transact with Pegasus rather than seeking out Mobil Oil if the price savings from dealing with Mobil Oil did not warrant the search costs. By then, the buyer had passed the point of no return.

However, online searches differ from offline searches because the switching costs online are trivial throughout most search stages. The buyers in *Mobil Oil* needed to find Mobil Oil and negotiate a new deal from scratch, with no certainty that they would achieve a comparable or superior price. Internet searchers on the wrong path can hit the back button, pull down a bookmark, or type a new address in the address bar.<sup>293</sup> With such low switching costs, few online publishers will cause searchers to reach the point of no return prior to an actual transaction.

This discussion prompts three legal conclusions. The first conclusion is that filtering content, by itself, cannot cause trademark infringement. If the filtering content accurately informs searchers what to expect from a publisher, neither the searcher nor the trademark owner is being exploited. Even when the filtering content falsely creates the impression that the publisher is the senior user, the publisher may immediately correct the impression at the website before searchers invest anything further in their search.<sup>294</sup>

<sup>292</sup> Credibility about delivering on promises also could have been a major factor, and the implicit association with Mobil Oil may have helped. However, during the course of negotiations, buyers would form their own independent assessment of Pegasus's ability to deliver. When the buyer realized that Mobil Oil and Pegasus were two different companies, Pegasus could have successfully earned enough independent credibility during the negotiations that Pegasus cleared the buyer's minimum threshold for credibility.

<sup>293</sup> See *Bihari v. Gross*, 119 F. Supp. 2d 309, 320 n.15 (S.D.N.Y. 2000) ("[R]esuming one's search for the correct website is relatively simple. With one click of the mouse and a few seconds delay, a viewer can return to the search engine's results and resume searching for the original website.").

<sup>294</sup> See Thomas F. Presson & James R. Barney, *Trademarks as Metatags: Infringement or Fair Use?*, 26 AIPLA Q.J. 147, 170 (1998).

For an example of how website content can cure any initial misapprehensions, see *Scholastic, Inc. v. Escholastica.com*, 100 Fed. Appx. 152 (4th Cir. 2004), in which the fact that the allegedly infringing activity led English-speaking customers to the Spanish-language website supported the court's finding that no consumers were actually confused. See also *Sullivan v. CBS Corp.*, 385 F.3d 772, 779 (7th Cir. 2004) (proximate display of search results does not confuse consumers when website visits will allow searchers to distinguish the parties).

Furthermore, as previously discussed in Part IV.A.5, publishers do not control what filtering content searchers see. Even if a publisher tries to disseminate deceptive filtering content, such as by putting misleading text into the description metatag, there is no guarantee that any search engine will display that content or that any searchers will see the false content, act upon it or find the resulting content irrelevant. The dissemination of false filtering content might trigger other legal doctrines, such as false advertising,<sup>295</sup> but it would be inappropriate to find trademark infringement per se based on false filtering content.

The second conclusion is that, due to the low switching costs, publishers will likely need to publish a significant quantum of deceptive content to exploit switching costs.<sup>296</sup> Searchers will constantly judge the progress they are making towards their objectives, and can exit at any time with low costs.

This leads to the third conclusion: The MFLOCC test can adequately handle any situation where a publisher has engaged in sufficiently deceptive conduct to exploit switching costs.<sup>297</sup> No heuristic, like IIC or goodwill misappropriation, is necessary to cover these circumstances. Further, all factors should be considered what false filtering content searchers saw, how the publisher perpetuated the misconception, and why searchers did not switch despite the putatively low cost of doing so.

Similarly, disclaimers also can serve the purpose of correcting initial searcher impressions, although some courts have rejected disclaimers as a fix to IIC because the courts improperly found harm in a referential or associative use. See *Ford Motor Co. v. Ford Fin. Solutions, Inc.*, 103 F. Supp. 2d 1126, 1128 (N.D. Iowa 2000); *OBH, Inc. v. Spotlight Magazine, Inc.*, 86 F. Supp. 2d 176, 190 (W.D.N.Y. 2000).

<sup>295</sup> See *FTC v. Pereira*, No. 99-1367-A (E.D. Va. 1999), available at <http://ftc.gov/os/caselist/9923264/9923263.htm>; see also O'Rourke, *supra* note 67, at 296-99 (discussing metatags and false advertising); Dogan & Lemley, *supra* note 166, at 821; Saunders, *supra* note 237, at 575 (discussing false banner ads).

<sup>296</sup> Searchers are surprisingly tolerant of lost time in searches. It takes, on average, twelve minutes for a searcher to get frustrated with a search. Danny Sullivan, *WebTop Search Rage Study*, at [http://searchengine.watch.com/sereport/print.php/34721\\_2163451](http://searchengine.watch.com/sereport/print.php/34721_2163451) (Feb. 5, 2001). Only 7% were frustrated in three minutes or less. *Id.*

Pernicious mousetrapping seems like another type of switching cost that publishers might impose. However, mousetrapping that blocks the searcher's exit, but does not increase the searcher's propensity to transact with the publisher, is not really a switching cost that dissuades the searcher from finding the senior user (although it may support other causes of action).

<sup>297</sup> See Klein & Glazer, *supra* note 206 (arguing that the MFLOCC test should apply, and giving examples of how IIC is redundant with other legal doctrines); see also Cody, *supra* note 260.

2. *At Early Search Stages, There Is Less Reason To Believe that Trademark Owners Suffer Any Harm*

Having discussed the benefits of filtering content, this subsection turns to the second principal problem of pushing trademark law too early into the search process. At early stages, there is less reason to believe that the searcher will actually transact with anyone. Therefore, any purported harms to the trademark owner are especially speculative.<sup>298</sup>

Consider the following assertion from the *1-800 Contacts v. WhenU.com* case, where the WhenU system caused a competitor's advertisement to appear when a searcher entered 1800contacts.com into their browser's address bar: "consumers who have typed Plaintiff's <1800contacts.com> URL into the browser bar are clearly searching for contact lens products, and expect to complete a transaction with Plaintiff in a short span of time, with little effort or transaction costs."<sup>299</sup>

Not surprisingly, the court did not cite any supporting evidence for this statement. In doing so, the court made three unsupportable assumptions that contravene the objective opaqueness principle:

- Searchers using the keyword "1800contacts.com" are "clearly" searching for contact lens products. There could be lots of reasons why they selected that keyword.
- Those searchers expect to complete a transaction with 1-800 Contacts. Searchers could be comparison shopping or could be dissuaded by stockouts or high prices.
- Those searchers expect to transact "in a short span of time." Searchers may transact in stages, separating an investigation from an associated transaction by hours, days, or even months.

As this discussion illustrates, judging trademark infringement at the outset of a search requires the court to make too many assumptions about subsequent searcher behavior. As one expert explained:

<sup>298</sup> See *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 755 (E.D. Mich. 2003) (stating that, in keyword-triggered ads case, "plaintiffs have failed to come forward with concrete evidence of even a single customer or potential customer who failed to purchase products or services from them because of WhenU").

<sup>299</sup> *1-800 Contacts, Inc. v. WhenU.com*, 2003 WL 22999270, at \*27 (S.D.N.Y. Dec. 22, 2003).

Online shoppers do not conduct the linear purchases that many retailers envision. Rather they browse a catalog, talk to friends, go online to research a product, visit the store to experience it, go back to the Web to comparison shop, then make the purchase either online or offline . . . . Retailers think of shopping as a funnel . . . but it's non-linear, sporadic and [unpredictable].<sup>300</sup>

In contrast, deeming the keyword-triggered ad as infringing treats every searcher exposed to the ad as a lost customer to 1-800 Contacts<sup>301</sup>—even though some searchers may never transact for contact lens products at all, other searchers who were comparing prices choose to transact with competitors for procompetitive reasons, and yet other searchers end up transacting with 1-800 Contacts anyway despite the ads. In other words, the *1-800 Contacts* court assumed an immediate and linear shopping process even though consumer behavior does not necessarily follow that model.

Instead, it is very likely that not every person who entered “1800contacts.com” was going to transact. Ecommerce websites measure “conversion to sale,” the ratio between the number of visitors to the website to the number of actual purchasers. No website has 100% conversion to sale; conversion to sale varies by industry and website, but it is often expressed in

<sup>300</sup> See Eisenberg, *supra* note 60 (quoting Kelly Mooney); see also Q3 2004 E-Commerce Site Trend Report, at [http://www.doubleclick.com/us/knowledge\\_central/documents/trend\\_reports/dc\\_q304ecommerce\\_0411.pdf](http://www.doubleclick.com/us/knowledge_central/documents/trend_reports/dc_q304ecommerce_0411.pdf) (Nov. 2004) (26% of all online retailer sales came from searchers who returned to abandoned online shopping carts) [hereinafter DoubleClick Trend Report]; Press Release, comScore Networks, Inc., comScore Study Reveals the Impact of Search Engine Usage on Consumer Buying (Dec. 13, 2004), at <http://www.comscore.com/press/release.asp?id=526> (“[O]nly 15 percent of online purchases following a [consumer electronics or computer (CE/C)] search occurred in the same user session as the search itself, with 85 percent of conversions occurring in a latent (or non search) session.”).

<sup>301</sup> Consider the following statement from American Blind’s lawsuit against Google based on searchers who click on keyword-triggered text ads for competitors: “these competitors will have obtained a customer, or potential customer, *solely* as a result of the goodwill and reputation associated with American Blind and its products and services.” See Complaint at 13, *Am. Blinds & Wallpaper Factory, Inc. v. Google, Inc.*, (S.D.N.Y. Jan. 27, 2004) (04-CV 00642) (emphasis in original). Competitors will need to provide lots of information to searchers between the time the searcher clicks from Google and closes a transaction, much of which will inform the searcher about the respective goodwill and reputation of their company. American Blinds conveniently omits all of that activity in trying to connect the dots.

A recent Note in the Harvard Law Review systematically makes this same error, presuming that the mere selection of a trademark as a keyword guarantees business to the trademark owner to the exclusion of all other competitors. See Note, *supra* note 53. This erroneous assumption leads the Note to conclude that trademark owners will overinvest in preemptive or combative marketing and underinvest in product quality because of the “diversions.” *Id.* at 2400–05. At minimum, these arguments ignore objective opaqueness, dynamic evolutions of search objectives and nonlinear behavior between searching and transacting.

the 1% to 2% range.<sup>302</sup> In other words, for every 100 visits to a retail website, only one or two of those visits will result in a transaction with the retailer; the other 98 or 99 visits do not result in a sale. Therefore, without any empirical evidence to show what happened with specific users, the *1-800 Contacts* court's massive overestimation of lost sales manufactured a significant quantum of harm where none may have existed.<sup>303</sup>

At the same time, while shopping processes may be episodic and nonlinear, it is important not to forget that searchers pick keywords with a search objective in mind. In that regard, consider the following from the *Playboy* case: "We *presume* that the average searcher seeking adult-oriented materials on the Internet is easily diverted from a specific product he or she is seeking if other options, particularly graphic ones, appear more quickly."<sup>304</sup>

On what basis did the court presume this?<sup>305</sup> To make this presumption, the court must oxymoronically assume that (1) the searcher entered the search term "playboy" into the search engine with such strong brand loyalty that the searcher was looking only for Playboy Enterprises, and (2) the searcher's brand loyalty was not strong enough to prevent diversions the moment that alternative graphic options were presented.

The *Playboy* court cannot have it both ways. Without any empirical support, it strains credibility to believe that easily diverted searchers actually intended to transact with Playboy. One might feel differently if the filtering content (i.e., the contents of the ads) caused a credibility transference such that searchers clicked on the ads thinking they were heading towards Playboy Enterprises. In that case, the advertisers may commit switching cost exploitation, depending on what content the advertisers displayed on their site. However, without a credibility transference, why did these Playboy diehards abandon their search objective so easily? I offer one theory: Searchers who

<sup>302</sup> See Bryan Eisenberg, *Benchmarking an Average Conversion Rate*, at <http://www.clickz.com/experts/crm/traffic/print.php/3362641> (June 4, 2004); cf. *Wells Fargo*, 293 F. Supp. 2d at 756 (noting the plaintiff's low conversion rates). As another way of evidencing the vast chasm between searches and conversion, note that searchers who put items into an online shopping cart (thus strongly manifesting an interest in transacting with the website) abandon those shopping carts 57% of the time. See DoubleClick Trend Report, *supra* note 300, at 3.

<sup>303</sup> See Klein & Glazer, *supra* note 206, at 1045-47 (IIC protected lost sales in offline world, but no evidence of lost sales online).

<sup>304</sup> *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1028 (9th Cir. 2004) (emphasis added).

<sup>305</sup> This is an especially vexing question given that the appeals court made this finding of fact, even though it remanded the case for trial.

were so easily diverted were using Playboy as a proxy or otherwise were not really looking for Playboy Enterprises. If so, treating their “diversion” as a harm overestimates the real consequences.

### 3. *Summary on the Timing of Infringement Analysis*

The *Playboy* and *1-800 Contacts* courts simply made up the trademark owners’ harms—and, in the process, significantly overinflated them—by mistakenly focusing on early stages in the searchers’ process. Pushing the infringement determination later in the search process will inhibit the speculation that can lead courts astray.

#### B. *Modernize the MFLOCC Test*

Perhaps surprisingly, given its venerability and the lack of academic criticism directed towards it, the MFLOCC test lacks any deep pedigree in the social sciences. The MFLOCC test traces its roots to the 1961 *Polaroid* case,<sup>306</sup> where Judge Friendly laid out the factors with a brief citation to the 1939 *Restatement of Torts*.<sup>307</sup> There is no evidence that the MFLOCC test was predicated on social science, nor did any body of literature validate that the MFLOCC test accurately characterized consumer search behavior at the time.

Since the *Polaroid* case, the information science field has grown substantially and search behavior has changed radically (due in large part to changes in mass media), but the MFLOCC has remained basically unchanged. At some point, the MFLOCC test should be revised to reflect evolutions in consumer search behavior. For now, this Article suggests some short-term modifications to the MFLOCC test to reflect Internet search practices.

#### 1. *Add a “Relevancy” Factor to the MFLOCC Test*

The MFLOCC test should include a factor considering if searchers found the junior user’s content *relevant* to their search. The current factors do not directly consider search objectives and content relevancy, but they should. Without a content relevancy factor, courts mechanically applying the existing

<sup>306</sup> *Polaroid Corp. v. Polarad Elec. Corp.*, 287 F.2d 492 (2d Cir. 1961).

<sup>307</sup> See *id.* at 495 (citing RESTATEMENT (FIRST) OF TORTS §§ 729–31 (1939)).

factors can reach the anomalous conclusion that content was relevant but infringing.<sup>308</sup>

In some cases, courts attempted to resolve this anomaly by basing infringement on consumer confusion about the *content's* source.<sup>309</sup> Unfortunately, this inquiry contradicts basic trademark law, which should focus on consumer confusion about *the source of goods*.<sup>310</sup> Confusion about content source at an intermediate stage does not, by itself, give us any insight into the consumer's ultimate confusion about a transaction. Furthermore, even if a searcher is confused about content source, this confusion may be alleviated or eliminated by the content itself (i.e., the filtering content). Finally, even if the searcher is confused about the content's source, the content could still be relevant to the searcher's objectives; in which case the searcher may not care about the content's source so long as the content helps the searcher.

Content relevancy does not need to be a *per se* defense to trademark infringement. Perhaps it will become that in practice, but for now the suggestion is relatively narrow. Content relevancy should be a factor in the MFLOCC test as a way to remind courts not to allow trademark law to block content that reduces search costs.<sup>311</sup>

## 2. Consider the Search Stage

As previously discussed in Part VI.A.2, courts should consider a search's stage when the searcher is exposed to a junior user's trademark usage. That section proposes that filtering content delivered in response to a contextless keyword should never be trademark infringement, while trademark uses that create switching cost exploitation could be.

<sup>308</sup> A prime example of this is *Nissan Motor Co. v. Nissan Computer Corp.*, 378 F.3d 1002 (9th Cir. 2004), which found IIC because searchers would find the provided content relevant and useful.

<sup>309</sup> See *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

<sup>310</sup> See *Taubman Co. v. Webfeats*, 319 F.3d 770, 776 (6th Cir. 2003) ("[I]t is irrelevant whether customers would be confused as to the origin of the web sites, unless there is confusion as to the origin of the respective products."); *Murphy v. Provident Mut. Life Ins. Co.*, 923 F.2d 923 (2d Cir. 1990) (rejecting confusion about advertising content as actionable trademark confusion when the source of the advertised services was clear). This analysis becomes more complicated where the trademarked product *is* the content, such as with publishers like newspapers.

<sup>311</sup> Cf. O'Rourke, *supra* note 67, at 306–07 (expressing concern that the MFLOCC factors do not account for increases in consumer search costs, creating the possibility that no trademark infringement will be found even if such costs increase). While I completely agree with this concern, I reject any assumption that metatagging increases consumer search costs.



### 3. Consider Minority Definitions

The MFLOCC test currently does not account for variations among searchers in their search objectives or tactics. As McCarthy says, "In determining trademark infringement and unfair competition, everything hinges upon whether there is a likelihood of confusion in the mind of an appreciable number of 'reasonably prudent' buyers."<sup>312</sup>

Unfortunately, the reasonably prudent buyer standard necessarily leads to incorrect legal results. By measuring activity against a single standard, the reasonably prudent buyer standard treats searchers as having equal information needs or ultimate objectives. However, this contradicts fundamental principles of information science, which is built on the principle that different searchers have different needs.<sup>313</sup>

The reasonably prudent buyer standard does have some utility. For example, when competitive products are on a store shelf, and a consumer is trying to select between them, the reasonably prudent buyer standard makes a lot of sense. In those cases, given the relative proximity of the transaction, it is efficient to consider if the packaging and trademark usage would confuse a reasonably prudent buyer.

However, Internet search suggests a different approach. Because the test only requires an "appreciable number" of confused consumers, the reasonably prudent buyer standard forecloses majority definitions of words, in some cases protecting only 11% of the relevant population.<sup>314</sup> Stated alternatively, a usage that 89% of the population understands could be trumped by an 11% minority.

This makes no sense, and it has a collateral cost. In order to recognize and preserve space for minority definitions of a trademarked word, it is important to make sure that even if only a small fraction of the consumer base understands the term as used, they can still communicate with each other. In the search engine environment, where keywords are decontextualized, this is

<sup>312</sup> 3 MCCARTHY, *supra* note 170, § 23:91. See generally Michael J. Allen, *The Scope of Confusion Actionable Under Federal Trademark Law: Who Must be Confused and When?*, 26 WAKE FOREST L. REV. 321 (1991) (discussing the various approaches used to determine the relevant class of consumers in a consumer confusion analysis); Shashank Upadhye, *Trademark Surveys: Identifying the Relevant Universe of Confused Consumers*, 8 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 549 (1998).

<sup>313</sup> ROSENFELD & MORVILLE, *supra* note 9, § 6.2.1 ("Many studies indicated that users of information systems aren't members of a single-minded monolithic audience who want the same kinds of information delivered in the same ways.").

<sup>314</sup> 3 MCCARTHY, *supra* note 170, § 23:2.

especially crucial. Otherwise, the reasonably prudent buyer standard will, in effect, remove minority definitions from the social lexicon.<sup>315</sup>

The MFLOCC test can accommodate multiple definitions of trademarked words merely by segmenting users into classes. Each class of users would be evaluated separately. If an appreciable number of users fit into a class that wants to communicate with each other using a trademark, and those users all clearly understand the word usage, trademark law should step aside.

#### 4. *Require Plaintiffs To Provide More Rigorous Evidence of Confusion or Harm*

McCarthy says that “There are at least three routes of proof of likelihood of confusion: (1) Survey evidence; (2) Evidence of actual confusion; and/or (3) Arguments based on a clear inference arising from a comparison of the conflicting marks and the context of their use.”<sup>316</sup>

Throughout the Internet era, courts have skipped options (1) and (2), instead basing their likelihood of confusion finding on option (3). However, the intuition based approach has been riddled with errors, as courts make unsupportable assumptions and misapprehend facts about the Internet.

This Article has already addressed several examples of poor judicial factfinding, such as the overemphasis on keyword metatags as misleading consumers (even as search engines have phased out reliance on them) and the *1-800 Contact* court’s belief that entering a domain name into the address bar meant that consumers were ready to close deals. There are plenty of other examples.

The solution is simple: Courts should not rely on their own intuition about possible harms.<sup>317</sup> Instead, they should require trademark plaintiffs to provide rigorous evidence of proof of confusion or harm.<sup>318</sup>

<sup>315</sup> See James Gleick, *Get Out of My Namespace*, N.Y. TIMES, Mar. 21, 2004, at §6, p. 44 (discussing the problem of overlapping namespaces and the risk of overriding legitimate names).

<sup>316</sup> 3 MCCARTHY, *supra* note 170, § 23:2.1 (citations omitted).

<sup>317</sup> See generally Ann Bartow, *Likelihood of Confusion*, 41 SAN DIEGO L. REV. 721 (2004) (discussing how judicial intuition and stereotyping has lessened the standards for actual harm from trademark usage).

<sup>318</sup> See Lemley, *supra* note 178, at 1713; Feingold, *supra* note 50, at S2 (discussing how empirical evidence of consumer expectations is the analytically proper way to determine trademark infringement); Uli Widmaier, *Use, Liability, and the Structure of Trademark Law*, 33 HOFSTRA L. REV. 603 (2004); cf. *Moseley v. V Secret Catalogue, Inc.*, 537 U.S. 418 (2003) (requiring trademark dilution plaintiffs to provide evidence of actual dilution rather than being able to assert “likelihood of dilution”). See generally Stephen W. Feingold et al., *Web-Tracking Data: An Under-Utilized Legal Resource*, INTERNET L. & STRATEGY, Mar. 2004, at 1

In fact, two recent cases suggest a small trend towards Internet plaintiffs actually providing survey evidence. In *1-800 Contacts* and *Playboy*, trademark plaintiffs introduced surveys purporting to show the likelihood of consumer confusion.<sup>319</sup> While this is a positive development, the courts have overweighed defective surveys. In both cases, the courts effectively deemed the survey evidence methodologically tainted but still found the defective survey probative of a likelihood of initial interest confusion.<sup>320</sup>

Given the judicial casualness towards survey evidence, it is not surprising that courts generally are willing to accept weak evidentiary proof from plaintiffs. And there is no question that it is not easy to provide rigorous evidence.<sup>321</sup> However, without courts requiring plaintiffs to prove some harm, there have been too many inconsistent and indefensible outcomes.

### C. Immunize Search Providers

#### 1. Why Search Providers Need a Safe Harbor

By casting search providers in a starring role as Internet power brokers, this Article diverges from prevailing stereotypes that publishers control search results. Due to search providers' active editorial role—especially where search providers draw a profit from the trademarked keyword—it seems logical that trademark owners would want to hold them liable for trademark infringement.<sup>322</sup> In fact, a few attempts to hold search providers liable for

(discussing the type of evidentiary showings that trademark owners might make to establish consumer diversion).

<sup>319</sup> In addition, in *Wells Fargo*, the court noted its inability to find confusion about the source of WhenU's ads "without evidence of how [WhenU users] perceive WhenU's ads," implying it needed to see that evidence on an advertiser-by-advertiser (or even an ad-by-ad) basis. See *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 766 (E.D. Mich. 2003).

<sup>320</sup> *Playboy Enters., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1026–27 (9th Cir. 2004) ("The expert study [Playboy] introduced establishes a strong likelihood of initial interest confusion among consumers . . . . Defendants may have valid criticism of Dr. Ford's methods and conclusions, and their critique may justify reducing the weight eventually afforded Dr. Ford's expert report."); *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467, 499–500 (S.D.N.Y. 2003) ("Plaintiff's survey statistics rely on numerous leading questions that suggested their own answers, and that are therefore entitled to little weight in assessing consumer confusion . . . . [T]he survey is burdened by other flaws . . . . Accordingly, Mr. Neal's survey, as designed and carried out, is not dispositive of whether pop-up advertisements generated by the SaveNow software has caused actual confusion among SaveNow users, and is not evidence of actual confusion. However, Mr. Neal's survey is at least suggestive of the likelihood of initial interest confusion.").

<sup>321</sup> See Allen, *supra* note 312, at 344; Doellinger, *supra* note 53, at 217–18.

<sup>322</sup> See Christine D. Galbraith, *Electronic Billboards Along the Information Superhighway: Liability Under the Lanham Act for Using Trademarks To Key Internet Banner Ads*, 41 B.C. L. REV. 847, 877–79 (2000) (arguing for such liability); Lastowka, *supra* note 21 (reaching the opposite conclusion).

trademark infringement based on keyword usage already have been made to date in the courts<sup>323</sup> and by legislators.<sup>324</sup>

In contrast, domain name registrars have long enjoyed protection from trademark infringement lawsuits for performing their DNS functions. *Lockheed Martin v. Network Solutions*<sup>325</sup> gave domain name registrars a common law shield from liability, and Congress subsequently codified an expansive safe harbor in 1999 as part of the Anticybersquatting Consumer Protection Act.<sup>326</sup>

It is anomalous to treat domain name registrars differently from other keyword-based search providers.<sup>327</sup> As explained above in Part IV.B.1, the DNS is just another form of keyword search, where the registrars are the search providers and the registrants are the publishers.

Further, domain name registrars manage the keywords in their database, just as other search providers do. For example, in the late 1990s, Network Solutions manually reviewed 10% of domain name registrations and rejected

<sup>323</sup> See *Playboy*, 354 F.3d 1020 (finding liability was possible; reversing the district court opinion finding no liability); *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700 (E.D. Va. 2004) (denying the search engine's summary judgment motion); *1-800 Contacts*, 309 F. Supp. 2d 467 (finding liability); *U-Haul Intern., Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723 (E.D. Va. 2003) (no liability); *Wells Fargo*, 293 F. Supp. 2d 734 (no liability); *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 WL 31356645 (E.D. Va. Jul. 17, 2002) (granting injunction).

Other lawsuits against search providers have been irresolute because these cases have settled. See *In re The Gator Corp. Software Trademark & Copyright Litig.*, Case No. MDL-1517 (N.D. Ga. 2003); *Reed Elsevier, Inc. v. Innovator Corp.*, 105 F. Supp. 2d 816 (S.D. Ohio 2000); *Estee Lauder, Inc. v. The Fragrance Counter, Inc.*, 189 F.R.D. 269 (S.D.N.Y. 1999). Some have been abandoned. See *Mark Nutritionals, Inc. v. Alta Vista Co.*, No. SA-02-CA-0087 EP (W.D. Tex. filed Jan. 31, 2002). Some are pending. See *Am. Blinds & Wallpaper Factory, Inc. v. Google, Inc.*, No. 04-CV-00642 (S.D.N.Y. complaint filed Jan. 27, 2004); *Rescuecom Corp. v. Google, Inc.* (N.D.N.Y. complaint filed Sept. 6, 2004), available at [www.rescue.com/googlesuit.pdf](http://www.rescue.com/googlesuit.pdf).

The issue has been litigated internationally as well, in some cases resulting in adverse rulings against search providers. See Pamela Parker, *German Firm Vows To Take Google to Court*, at <http://www.clickz.com/news/print.php/3350371> (May 6, 2004); David A. Vise, *Firms Sue Google for Ad Links to Competitors*, WASH. POST, May 26, 2004, at E1.

<sup>324</sup> These efforts have principally been attached to laws addressing "spyware" or "adware." See, e.g., Utah Spyware Control Act, H.B. 323, 2004 General Session, Part 2 (Utah 2004) (codified at UTAH CODE ANN. § 13-40-201).

<sup>325</sup> *Lockheed Martin Corp. v. Network Solutions Inc.*, 985 F. Supp. 949 (C.D. Cal. 1997), *aff'd*, 194 F.3d 980 (9th Cir. 1999).

<sup>326</sup> Anticybersquatting Consumer Protection Act, Pub. L. No. 106-113 § 3004, 113 Stat. 501 (1999) (codified at 15 U.S.C. § 1114(2)(D) (2000)).

<sup>327</sup> See Google Brief, *supra* note 277, at 18-19.

registrations that contained “prohibited” character strings.<sup>328</sup> Domain name registrars also “sell” third party trademarks by prompting potential registrants to select alternative domain names as a way to generate more domain name registrations.<sup>329</sup> Further, some domain name registrars serve keyword-triggered ads on the “coming soon” pages displayed for “parked” domain names.<sup>330</sup>

Based on this behavior, it is impossible to distinguish the DNS from other search providers. If domain name registrars “deserve” a safe harbor, then so do all other search providers. However, there are at least two compelling policy reasons why Internet search providers warrant a safe harbor. First, search providers compete with each other to do a better job for searchers. The search engine market is dynamic and competitive. There has been significant turnover among the most popular search engines,<sup>331</sup> and new competitors—

<sup>328</sup> Lockheed Martin Corp. v. Network Solutions Inc., 194 F.3d 980, 982 (9th Cir. 1999) (observing that the character strings were “specific variations on the words Olympic, Red Cross, or NASA, and certain ‘obscene’ words”).

<sup>329</sup> For example, on March 7, 2004, I conducted a search at networksolutions.com for the domain name “nike.com.” Network Solutions informed me that nike.com was unavailable, but “similar names” were available, specifically i-nike.com, webnike.com, 4-nike.com, fornike.com, and freenike.com. See Network Solutions, *Domain Name Search Results*, at [http://www.networksolutions.com/en\\_US/name-it/searchresults.jhtml;jsessionid=A3ZIC2ZJTN10WCWLEAMCFEQ?\\_requestid=941422](http://www.networksolutions.com/en_US/name-it/searchresults.jhtml;jsessionid=A3ZIC2ZJTN10WCWLEAMCFEQ?_requestid=941422) (last visited Mar. 7, 2004).

Search engines also prompt keyword advertisers to consider additional terms to purchase, including terms trademarked by third parties. See Complaint ¶ 29, Perfect 10, Inc. v. Google, Inc. (No. 04-9484) (filed Nov. 19, 2004), available at <http://cyber.law.harvard.edu/blogs/gems/palfrey/Perfect10ComplaintPDFCropped.pdf> (last visited Apr. 1, 2005).

<sup>330</sup> See Zurakov v. Register.com, Inc., 304 A.D.2d 176 (N.Y. App. Div. 2003).

<sup>331</sup> See Jakob Nielsen, *Statistics for Traffic Referred by Search Engines and Navigation Directories to Useit*, at <http://www.useit.com/about/searchreferrals.html> (Apr. 11, 2003) (stating that “the Web is nowhere close to being locked down; there is still plenty of opportunity for new sites”).

Rankings of search engines are controversial, especially given complex interrelationships where some search engines integrate search results from other search providers. Nevertheless, an argument can be made that in Summer 1998, the top five search engines were, in order, Yahoo!, Excite, Infoseek, Lycos, and AltaVista. See Search Engine Guide, *Ratings of Most Visited Search Engines* (1998) (on file with author) (showing this order using three different survey providers and methodologies). By early 2003, an argument can be made (based on Nielsen NetRatings data of total search hours) that the top five search engines were, in order, Google, AOL, Yahoo!, MSN, and Ask Jeeves. See Brian Morrissey, *Search Guiding More Web Activity*, at <http://www.clickz.com/news/print.php/2108921> (Mar. 12, 2003). Assuming that these rankings can be fairly compared against each other, then in less than five years, the #1 search engine dropped to #3, and the other top four search engines dropped off the list (including two, Excite and Infoseek, that effectively went out of business), while a new #1 player emerged that was not even on top 10 lists in 1998.

An early 2004 survey shows the same top five players as in 2003, but changes the order to be Google, Yahoo!, MSN, AOL, and Ask Jeeves. See Press Release, NetRatings, Inc., One in Three Americans Use a Search Engine, According to Nielsen/NetRatings (Feb. 23, 2004), available at [http://direct.www.nielsen-netratings.com/pr/pr\\_040223\\_us.pdf](http://direct.www.nielsen-netratings.com/pr/pr_040223_us.pdf).

both powerful and small—continue to enter the market.<sup>332</sup> Search engines all share the same basic interface—a search box—making it easy for searchers to switch between them,<sup>333</sup> and many searchers regularly use multiple search engines.<sup>334</sup>

As a result, search engines compete for searchers at the search provider selection stage (Stage 2). More than any other attribute, search engines compete on the relevancy of their search results—searchers want relevant results.<sup>335</sup> Thus, search engines that do a better job anticipating and solving searcher needs should have competitive success in the marketplace.<sup>336</sup>

<sup>332</sup> See John Markoff, *Google Envy Is Fomenting Search Wars*, N.Y. TIMES, Oct. 18, 2004, at C1; see also Jim Hu & Mike Ricciuti, *Search and Destroy: Microsoft, Google May Go Head-to-Head*, at [http://ecoustics-cnet.com.com/Microsoft,+Google+may+go+head-to-head/2009-1032\\_3-1020641.html](http://ecoustics-cnet.com.com/Microsoft,+Google+may+go+head-to-head/2009-1032_3-1020641.html) (June 25, 2003); Levy, *supra* note 113; Olsen, *supra* note 115; Brad Stone, *Little Engines that Can*, NEWSWEEK, Mar. 29, 2004, at 59.

<sup>333</sup> See TELANG, *supra* note 12; cf. Nielsen, *supra* note 14 (“As we’ve seen in recent studies, [searchers] typically scan the home page looking for ‘the little box where I can type.’”) (emphasis in original).

<sup>334</sup> See Keynote Systems, *Search Engine Industry Research Abstract*, at 5, at [http://www.keynote.com/downloads/cem/Keynote\\_SearchEngine\\_abstract.pdf](http://www.keynote.com/downloads/cem/Keynote_SearchEngine_abstract.pdf) (June 2004) (up to 20% of searchers “regularly use different search engines for different types of searches”); see also Sullivan, *supra* note 32.

<sup>335</sup> See Lloyd-Martin, *supra* note 37 (quoting a Google official as saying that searchers first determine if their search results are relevant before looking at any other aspect of a search results page); Press Release, NetRatings, Inc., *supra* note 331, (says Jason Levin, NetRatings analyst: “The message is loud and clear—search engine users value relevant and credible information over all else and they are choosing their search engines accordingly.”). This phenomenon also applies to search engines attached to ecommerce websites. See Ann Badnarz, *Staples Switches Web Search Tools*, NetworkWorldFusion, at <http://www.nwfusion.com/news/2003/0428staples.html> (Apr. 28, 2003) (“[P]eople were abandoning Staples’ consumer and small-business Web site when their searches yielded poor results”); Robert D. Hof, *Commentary: Desperately Seeking Search Technology*, at [http://www.businessweek.com/print/magazine/content/01\\_39/b3750038.htm?mz](http://www.businessweek.com/print/magazine/content/01_39/b3750038.htm?mz) (Sept. 24, 2001) (“80% of online users will abandon a site if the search function doesn’t work well.”); Nielsen, *supra* note 14 (saying that users make quick assessments about the quality of search results and abandon the site if the results “look like junk”).

<sup>336</sup> See Matt Hines, *Future of Search Rides on Relevance*, at [http://news.com.com/2102-1032\\_3-5555954.html?tag=st.util.print](http://news.com.com/2102-1032_3-5555954.html?tag=st.util.print) (Jan. 29, 2005); Susan Kuchinskas, *MSN Fights for Google Search Share*, at <http://www.internetnews.com/bus-news/print.php/3435481> (Nov. 12, 2004) (quoting an Ask Jeeves representative as saying that relevancy is one of the biggest competitive differentiators today); see also Romanos, *supra* note 67, at 96; Shannon N. King, Note, *Initial Interest Confusion*: Brookfield Communications, Inc. v. West Coast Entertainment Corp., 15 BERKELEY TECH. L.J. 313 (2000).

Introna & Nissenbaum express concern that competition will force search engines to cater to majority interests, in the process underserving minority interests. See Introna & Nissenbaum, *supra* note 79; see also Eszter Hargittai, *Open Portals or Closed Gates? Channeling Content on the World Wide Web*, 27 POETICS 233 (2000) (agreeing with Introna & Nissenbaum and proposing the creation of a publicly funded or charitable portal site to be the online analogue of public broadcasting, along with aggressive marketing of the site). However, the more likely scenario is that searchers will use multiple search providers—some catering to mass-market interests and others occupying niches—and that search providers will personalize relevancy algorithms to better serve the diversity of searcher objectives.

It bears reiteration that search providers are trying to solve a very difficult problem.<sup>337</sup> inferring searcher intent from a keyword that lacks context and may have been poorly chosen by the searcher.<sup>338</sup> To overcome these obstacles and still deliver search results that searchers consider relevant, search providers must anticipate searchers' systematic errors.<sup>339</sup> Necessarily, correcting these errors requires search providers to make editorial decisions about what searchers mean, not what they say. Further, to divine searcher intent, search providers must innovate—and some innovations may require search providers to use trademarks.<sup>340</sup> Preventing search providers from using trademarks as one of the tools to anticipate searcher needs would prevent search providers from achieving optimal content relevancy.

Second, many trademarked words can have multiple trademark owners (separated by industry, geography, or both). Search providers cannot, with 100% accuracy, determine which meanings are meant by either searchers or publishers. Creating liability for search providers based on using a trademark to make keyword associations would, in effect, force the search provider to engage in a costly and possibly irresolute inquiry into each use of that word in their database. More likely, prudent search providers would remove keyword-associated content based on unsubstantiated claims of infringement, in effect allowing trademark owners to purge search providers databases despite the potential relevance to some searchers.<sup>341</sup>

<sup>337</sup> Introna & Nissenbaum, *supra* note 79 (“Relevancy ranking is an enormously difficult task. Some researchers working on search technologies argue that relevancy ranking is currently the greater challenge facing search engines.”); Levy, *supra* note 113, at 56–58 (quoting the CEO of search engine A9.com).

<sup>338</sup> See *Novak v. Overture Servs., Inc.*, 309 F. Supp. 2d 446, 450 (E.D.N.Y. 2004) (“[T]he user’s intent is rarely crystalline. Thus, the search process is imperfect.”).

<sup>339</sup> See Hagen, *supra* note 53, at 8 (“15% of online search failures come from user errors like misspelled words or typos, and another 40% come from customers and firms using different terms.”).

<sup>340</sup> See Michael Kanellos, *Microsoft Aims for Search on Its Own Terms*, CNET News.com, at [http://news.com.com/2102-1008\\_3-5110910.html?tag=st\\_util\\_print](http://news.com.com/2102-1008_3-5110910.html?tag=st_util_print) (Nov. 24, 2003) (describing how new Microsoft products may analyze text that users are working on and may initiate queries using keywords (that may be trademarks) from the text without the user specifically initiating the query).

At least one court has hinted that making keyword reinterpretations, even if it requires the use of a trademarked term, should not necessarily dictate trademark infringement. See *Playtex Prods., Inc. v. Ga.-Pac. Corp.*, 2004 WL 2660566, at \*6 (2d Cir. Nov. 23, 2004) (even if the search engine “confuses” a defendant’s product with the plaintiff’s trademarked term, this “reflects little, if anything, about whether consumers are actually confused”) (internal quotations omitted).

<sup>341</sup> See Ina Steiner, *eBay Bans Google Keywords*, at <http://www.auctionbytes.com/cab/abn/y03/m08/i07/s02> (Aug. 7, 2003) (discussing how eBay demanded that Google curtail keyword-triggered ads for listing software that can be used with eBay’s website, a demand that Google complied with). Google has since refused to stop selling keywords on a trademark owner’s request, although Overture continues to do so. See Stefanie Olsen, *Google Plans Trademark Gambit*, CNET News.com, at [http://news.com.com/2102-1038\\_3-5190324.html?tag=st\\_util.print](http://news.com.com/2102-1038_3-5190324.html?tag=st_util.print) (Apr. 13, 2004).

In other words, if search providers are liable for using trademarked keywords, trademark owners can obtain an unwarranted outcome: exclusive ownership of the word, regardless of context.<sup>342</sup> Such exclusivity arrogates the word from the social vernacular to a single trademark owner's benefit, and in the course of doing so, deprives society of any minority definitions for the term. That particular trademark owner may benefit, but the rest of society loses.<sup>343</sup>

In contrast, when search providers do their jobs successfully, they can increase the probability that searchers will find what they were looking for. This success does not merely create private benefit for the search providers; it creates social utility by lowering social search costs,<sup>344</sup> which promotes marketplace competition (both on price and product attributes) and increases social knowledge.<sup>345</sup> Put differently, searchers want search engines to solve their needs by delivering the highest relevance results to them, and the law should remove any impediments to doing so.<sup>346</sup>

## 2. *Implementing a Safe Harbor*

Search providers could be immunized from liability using a rigorous definition of trademark "use" under the Lanham Act. Not every trademark reference is a "use." The Lanham Act says a trademark is in "use in commerce" in the following two circumstances:

(1) on goods when . . . it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto, or if the nature of the goods makes such placement impracticable, then on documents associated with the goods or their sale, and . . . (2) on services when it is used or displayed in the sale or advertising of services . . . .<sup>347</sup>

<sup>342</sup> See Lemley, *supra* note 178.

<sup>343</sup> Cf. *Bally Total Fitness Corp. v. Faber*, 29 F. Supp. 2d 1161, 1165 (C.D. Cal. 1998) (discussing how depriving publishers of the right to use indexable words would make the publisher effectively invisible).

<sup>344</sup> See George J. Stigler, *The Economics of Information*, 69 J. POL. ECON. 213 (1961).

<sup>345</sup> See *Wells Fargo & Co. v. WhenU.com, Inc.*, 293 F. Supp. 2d 734, 756 (E.D. Mich. 2003) ("Harm to WhenU would harm the public as well. WhenU benefits participating consumers by improving access to relevant, useful and money-saving information about products and services that interest them. WhenU's advertisements increase the choices available to consumers and thereby promote competition."); Elkin-Koren, *supra* note 30, at 185 ("Decentralized competition among search engines is therefore essential for keeping a competitive market in electronic commerce."); Klein & Glazer, *supra* note 206, at 1063.

<sup>346</sup> See Nadel, *supra* note 238.

<sup>347</sup> 15 U.S.C. § 1127 (2000).



The words “placed” and “displayed” make this definition fairly explicit. Consumers need to *perceive* the trademark before the mark is being used in commerce.<sup>348</sup> If the alleged junior user does not use the trademark in a perceivable manner, such as in marketing actually presented to potential consumers, the use cannot confuse consumers about a product’s source.<sup>349</sup> This is particularly true when Internet searchers have no clear understanding about search providers’ technical operations.

Cases addressing whether a search provider uses a trademark are split: Two cases involving the adware defendant WhenU.com held that automated keyword associations do not “use” the trademark,<sup>350</sup> one WhenU.com case directly and deliberately contradicted those two opinions,<sup>351</sup> the *GEICO* opinion (in the context of keyword-triggered ads sold by search engines) cast its vote with the latter WhenU.com opinion,<sup>352</sup> and the *Playboy* opinion punted on this question by saying that it did not need to decide if liability was based on direct or contributory infringement.<sup>353</sup>

While these authorities indicate the divisive nature of the question, the cases suggesting search providers “use” trademarks are both contrary to the statute and detrimental to search efficiency. Search providers do not “use” a trademark regardless of the editorial role played by search providers. This argument is not based on treating the search providers as passive conduits for the dissemination of publisher content. Instead, search providers should make editorial decisions about how third party trademarks can be used in their systems to help searchers achieve their search goals.

<sup>348</sup> Widmaier makes this point in a very detailed and compelling argument. See Widmaier, *supra* note 318; see also Dogan & Lemley, *supra* note 166, at 799, 820 (noting that trademark use requires the defendant to actually market goods and services under the trademark); Michael R. Sees, Comment, *Use of Another’s Trademark in a Web Page Meta Tag: Why Liability Should Not Ensnare Under the Lanham Act for Trademark Infringement*, 5 TEX. WESLEYAN L. REV. 99 (1998).

<sup>349</sup> See, e.g., DaimlerChrysler AG v. Bloom, 315 F.3d 932, 939 (8th Cir. 2002); Holiday Inns, Inc. v. 800 Reservations, Inc., 86 F.3d 619 (6th Cir. 1996).

<sup>350</sup> See U-Haul Int’l, Inc. v. WhenU.com, Inc., 279 F. Supp. 2d 723, 728 (E.D. Va. 2003) (noting, among other things, that WhenU.com “merely uses the marks for the ‘pure machine-linking function’”); Wells Fargo, 293 F. Supp. 2d at 762 (“WhenU does not use any of the plaintiffs’ trademarks to indicate anything about the source of the products and services it advertises”); see also Bird v. Parsons, 289 F.3d 865, 877–79 (6th Cir. 2002) (regarding a website that auctions domain names, “[t]he possibility that its customers might buy or sell infringing domain names does not alter the fact that Aftemic does not use those names”).

<sup>351</sup> See 1-800 Contacts, Inc. v. WhenU.com, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

<sup>352</sup> See Gov’t Employees Ins. Co. v. Google, Inc., 330 F. Supp. 2d 700, 704–05 (E.D. Va. 2004).

<sup>353</sup> See Playboy Enters., Inc. v. Netscape Communications Corp., 354 F.3d 1020 (9th Cir. 2004).

To ensure some breathing room for search providers to make those editorial judgments and to solve the hard relevancy problem, ultimately legislative intervention—like the registrar safe harbor in the Anticybersquatting Consumer Protection Act—may be appropriate. For now, however, the public would greatly benefit from judicial recognition of the hazards of creating search provider liability and a strict statutory reading of “use in commerce” under the Lanham Act.<sup>354</sup>

## CONCLUSION

The Internet is one of the great democratizing technologies, ranking alongside Gutenberg’s printing press and the rise of public libraries. Among other attributes, it democratizes communication by fully empowering users to search for information using their own words, rather than being constrained by words selected by some editorial intermediary.<sup>355</sup> For the first time, searchers and publishers need not rely upon the words selected by intermediate editors.

Trademark law threatens to take away what technology enables. At a time when keywords show unprecedented promise to empower searchers, the legal system is interposing itself as the new intermediary to guarantee content relevancy. Unfortunately, any effort to legally impose content relevancy is destined to fail dramatically. Blunt legal instruments cannot make the nuanced judgments required to deliver content that searchers find relevant.

The collateral costs of trademark law’s “war on relevancy” in Internet searching are substantial. Minority definitions of words may become invisible, shrinking our lexicon. Criticism of trademarks may become risky and imperiled. Trademark owners are legally mandated to garner attention at the expense of all others, increasing search costs for searchers with different expectations or desires. Cumulatively, these effects may increase overall search costs by hampering the ability of searchers to use keywords to find what they want.

<sup>354</sup> See Dogan & Lemley, *supra* note 166, at 838 (arguing that existing trademark law is “just fine,” it just needs to be applied with restraint).

<sup>355</sup> For example, the library card catalog was organized by keywords chosen by the librarians. A searcher who wanted to search on some other keyword simply could not do so. The same phenomenon occurs with every publication with an editorially-produced index, such as books, Yellow Pages and magazine indexes. See Nielsen, *supra* note 14 (“A typical comment is: ‘I don’t want to have to navigate this site the way they want me to. I just want to find the thing I’m looking for.’”).

The solution is simple: Deregulate the keyword in Internet searching. This solution, however, requires significant self-restraint to realize that judges and legislators cannot infer searcher objectives from decontextualized Internet keywords, no matter how obvious it seems. It also requires one to believe that search providers will deliver relevant content or will be punished in the marketplace for failing to do so. Keyword deregulation is essential, however, for Internet search to achieve its democratizing potential.