litigating pop-up ad & tm keying cases

by

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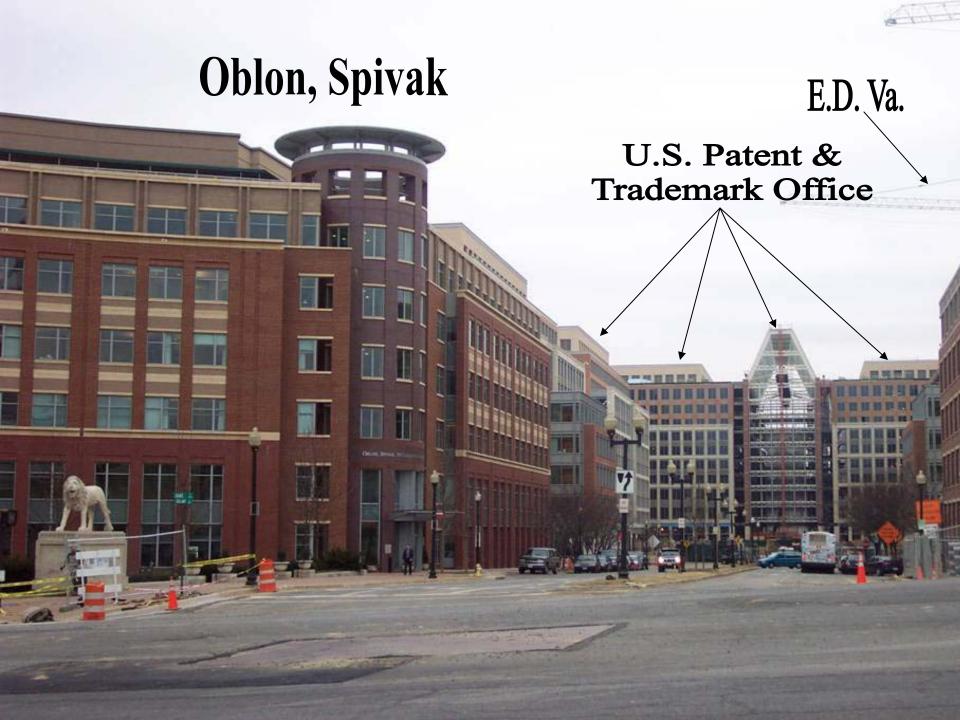
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overview

- 1. background/interests
- 2. legal issue focus
- 3. pop-up adv'g cases
- 4. tm keying cases
- **5.** litigation tips



background/interests

- **▶** ip
- internet
- law

"use in commerce"

comparative advertising

initial interest confusion

1. "use in commerce"

- 2. comparativeadvertising3. initial interestconfusion
- prohibition: commercial use in commerce of a mark in a manner likely to cause consumer confusion.
 § 1114(1)
- <u>definition</u>: bona fide use of a mark in the ordinary course of trade. § 1127

1. "use in commerce"

2. comp. adv'g

3. initial interest confusion

tm owner protected against sales of an advertiser's goods/services as those of the tm owner

a tm owner's rights are subject to comparative fair uses of its mark. § 1115(b)(4)

"use in commerce"
 comparative advertising
 initial interest confusion

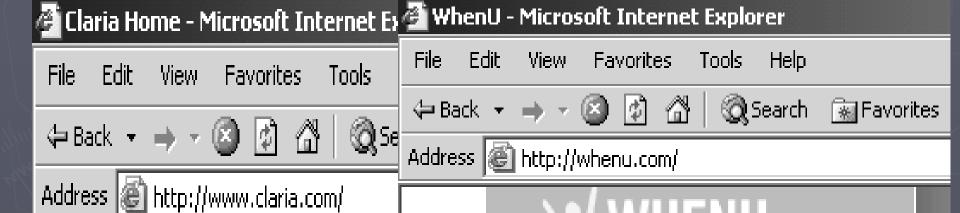
actionable trademark infringement, despite no consumer confusion at the time of the purchasing decision

Address

pop-up adv'g cases



Gator.com - Home - Microsoft Internet Explorer





wells fargo v. whenu.com (e.d. mich. 11/2003)

1-800 contacts v. whenu.com (s.d.n.y. 12/2003)

- BOTH WHENU.COM CASES
 - **FACTS**

- download free software
- monitor web surfing
- deliver competing ads

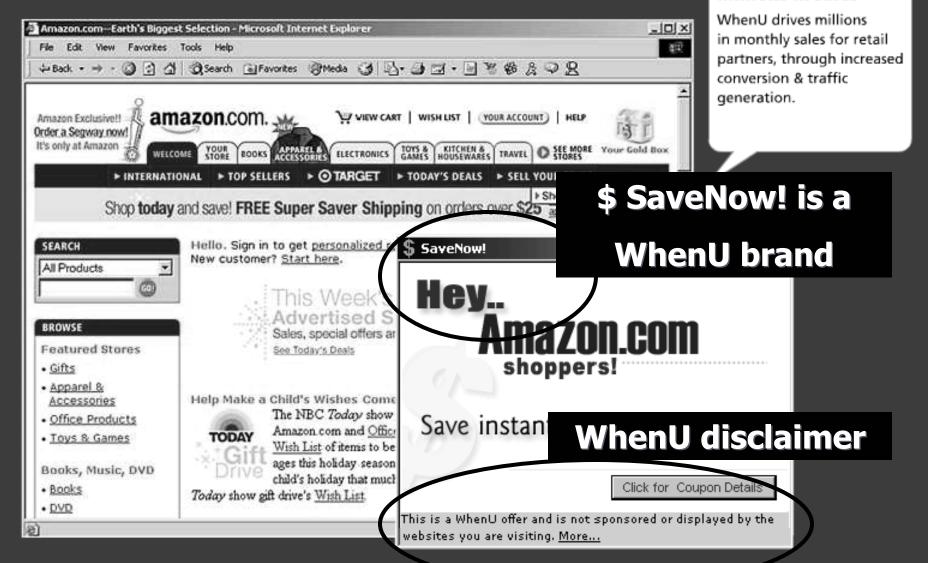
____×

Millions in sales

O WhenU

Just-in-time Marketing

WhenU's relevant offers lead to extremely high click rates (3-20%).



Wells Fargo v. WhenU.com

ANALYSIS

"use in commerce"

- access to website not hindered
- ads appear in separate window
- use of URLs in directory okay

comparative advertising

- yep . . .
- even if benefit from tm owner's goodwill

Wells Fargo v. WhenU.com

ANALYSIS

Wells Fargo v. WhenU.com

ANALYSIS

initial interest confusion

- some courts use iic doctrine in internet cases . . .
- but, rejected here!

Wells Fargo v. WhenU.com

DECISION

pop-up ads are legit

- no "use in commerce"
- comparative adv'g
- no initial interest confusion
- no tm infringement (unlikely)

"use in commerce"

- access to website<u>is</u> hindered
- use of URLs in directory <u>not</u> okay

1-800 Contacts v. WhenU.com

ANALYSIS

1-800 Contacts v. WhenU.com

ANALYSIS

initial interest confusion

- luring/diverting consumers
- harm consumers & tm owner
- I.o.c. analysis to cinch infringement

pop-up ads <u>not</u> legit

- "use in commerce"
- initial interest confusion
- tm infringement (likely)

1-800 Contacts v. WhenU.com

DECISION

Address

tm keying cases

tm search

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search engine results

competing banner ad (& hyperlink)

playboy v. netscape(c.d. cal. 2001) (9th cir. 2004)

geico v. google(e.d. va. 2004)

- Playboy v. Netscape
 - **FACTS**

- internet search for tm
- competing banner ads appear
- banner ads were unlabeled

Address:

tm keying cases



Web

<u>Product search results for</u>



Playboy: Jenny McCar PLAYBOY White with s Playboy-Embrace The

Playboy.com: Sex, Playboy.com
World Sex Site - Playboy.com
from around the world along playboy.com/) 36k - Oc

Sponsored Links

Playboy Models and Pics

Exclusive pics and 1 on 1 interview Instant Access to free sexy photos. www.Xposed.com

<u>See your message here...</u>

tm keying legit

- no "use in commerce"
- no tm infringement (likely)

Playboy v. Netscape

TRIAL COURT DECISION

Playboy v. Netscape

9TH CIR. ANALYSIS

"use in commerce"

FN 11: fed'l jurisdiction over tm cases rests on the Commerce Clause, sweeps as broadly as possible, and clearly encompasses the circumstances of this case

comparative advertising

not analyzed, but . . .

- no fair use
- no nominative use
- no functional use

Playboy v. Netscape

9TH CIR. ANALYSIS

Playboy v. Netscape

9TH CIR. ANALYSIS

initial interest confusion

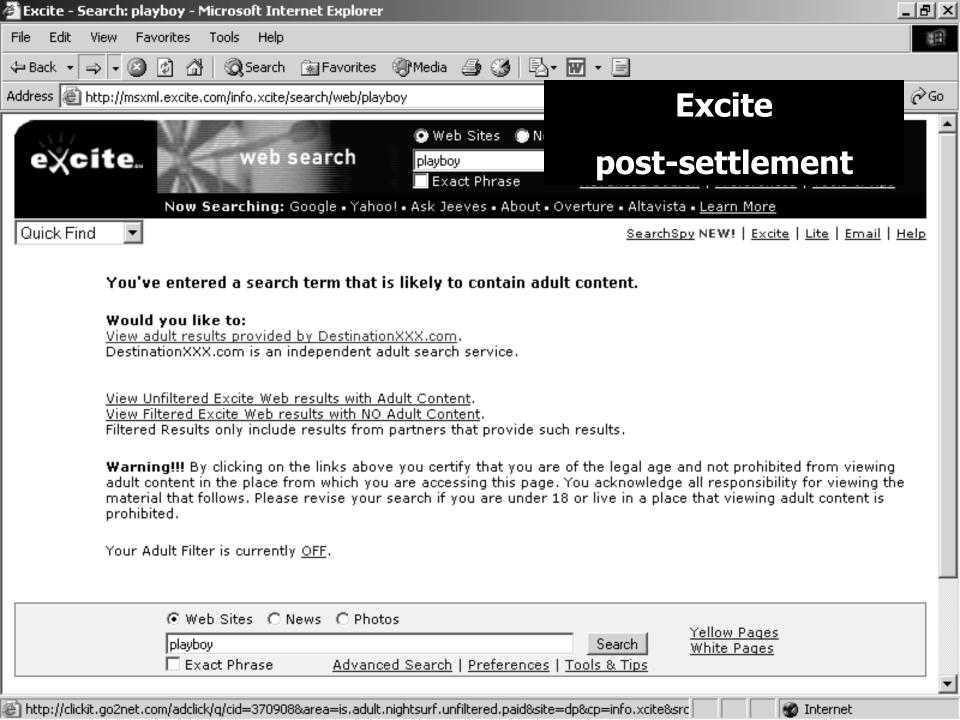
- we find insufficient evidence to defeat [sj] on any other theory"
- J. Berzon: iic doctrine is insupportable

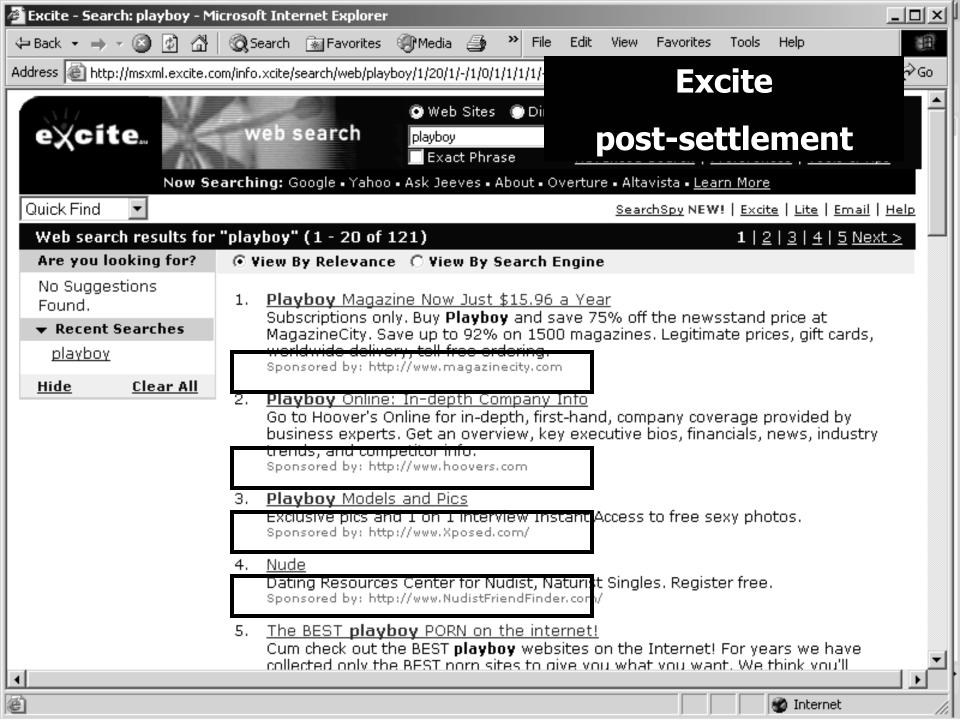
tm keying not legit

- "use in commerce"
- initial interest confusion
- tm infringement (likely)

Playboy v. Netscape

9TH CIR. DECISION





google keying policy:

- advertisers bid on any term, including trademarks
- advertisers, not google, choose key terms

Geico v. Google

FACTS

Geico v. Google

ANALYSIS

"use in commerce"

- yep . . .
- google loses motion to dismiss
- google loses motion for sj

Geico v. Google

ANALYSIS

comparative advertising

- comparative adv'g not addressed
- fair use not addressed

Geico v. Google

ANALYSIS

initial interest confusion

- 4th cir. doesn't recognize iic doctrine
- e.d. va. doesn't even mention it

tm keying legit (mostly)

- "use in commerce"
- tm keying doesn't create l.o.c.
- banner ads displaying tm in title or text create l.o.c.

Geico v. Google

DECISION from the Bench

- know your <u>forums</u>
- present your best <u>claims</u>
- focus on your most relevant <u>defenses</u>

1. forums

- 2. claims
- 3. defenses

(for plaintiffs)

- forums finding infringement
- forums adopting iic

forums
 claims
 defenses

- drop copyright claims
- focus on tm claims

- forums
 claims
- 3. defenses

- no "use in commerce"
- comparative advertising

conclusion

pop-up ads legit?

Depends on . . .

- "use in commerce"
- comparative advertising
- initial interest confusion

tm keying legit?

- end jason allen cody

