

litigating pop-up ad & tm keying cases

by

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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**

Oblon, Spivak

E.D. Va.

U.S. Patent & Trademark Office



background/interests

- ▶ **ip**
- ▶ **internet**
- ▶ **law**

legal issue focus

- ▶ **“use in commerce”**
- ▶ **comparative advertising**
- ▶ **initial interest confusion**

legal issue focus

1. “use in commerce”

2. comparative advertising

3. initial interest confusion

▶ **prohibition: commercial use in commerce of a mark in a manner likely to cause consumer confusion. § 1114(1)**

▶ **definition: bona fide use of a mark in the ordinary course of trade. § 1127**

legal issue focus

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)**

legal issue focus

1. "use in commerce"
2. comparative advertising
- 3. 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

Claria Home - Microsoft Internet Explorer

WhenU - Microsoft Internet Explorer

File Edit View Favorites Tools

File Edit View Favorites Tools Help

Back Forward Stop Refresh Home Search

Back Forward Stop Refresh Home Search Favorites

Address  http://www.claria.com/

Address  http://whenu.com/

CLARIASM



WHENU
Advertising You Want

pop-up adv'g cases

- ▶ **wells fargo v. whenu.com**
(e.d. mich. 11/2003)
- ▶ **1-800 contacts v. whenu.com**
(s.d.n.y. 12/2003)

pop-up adv'g cases

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

**BOTH
WHENU.COM
CASES**

FACTS

WhenU

Just-in-time Marketing

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

Millions in sales
WhenU drives millions in monthly sales for retail partners, through increased conversion & traffic generation.

\$ SaveNow! is a WhenU brand

WhenU disclaimer

pop-up adv'g cases

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**

pop-up adv'g cases

Wells Fargo
v.
WhenU.com

ANALYSIS

comparative advertising

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

pop-up adv'g cases

Wells Fargo
v.
WhenU.com

ANALYSIS

initial interest confusion

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

pop-up adv'g cases

pop-up ads are legit

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

Wells Fargo
v.
WhenU.com

DECISION

pop-up adv'g cases

1-800
Contacts
v.
WhenU.com

ANALYSIS

“use in commerce”

- access to website is hindered
- use of URLs in directory not okay

pop-up adv'g cases

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 adv'g cases

pop-up ads not legit

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

1-800
Contacts
v.
WhenU.com

DECISION

Address

tm keying cases

tm search



**competing
banner ad
(& hyperlink)**



**search engine
results**

tm keying cases

- ▶ **playboy v. netscape**
(c.d. cal. 2001) (9th cir. 2004)
- ▶ **geico v. google**
(e.d. va. 2004)

tm keying cases

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

Playboy
v.
Netscape

FACTS

Address

tm keying cases

Search

Google Search: playboy - Microsoft Internet Explorer

← Back → Stop Home Search Favorites

Address <http://www.google.com/search?hl=en&ie=UTF-8&>


Web Images Groups

Google

playboy

Web

Product search results for

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

Playboy.com: Sex, Playk
World Sex Site - **Playboy.com**
from around the world along ple
www.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

See your message here...

tm keying cases

tm keying legit

- no “use in commerce”
- no tm infringement (likely)

Playboy
v.
Netscape

TRIAL COURT
DECISION

tm keying cases

“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

Playboy
v.
Netscape

9TH CIR.
ANALYSIS

tm keying cases

Playboy
v.
Netscape

9TH CIR.
ANALYSIS

comparative advertising

not analyzed, but . . .

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

tm keying cases

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 cases

tm keying not legit

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

Playboy
v.
Netscape

9TH CIR.
DECISION



web search

Web Sites News

Exact Phrase

Excite

post-settlement

Now Searching: Google • Yahoo! • Ask Jeeves • About • Overture • Altavista • [Learn More](#)

Quick Find

[SearchSpy NEW!](#) | [Excite](#) | [Lite](#) | [Email](#) | [Help](#)

You've entered a search term that is likely to contain adult content.

Would you like to:

[View adult results provided by DestinationXXX.com.](#)
 DestinationXXX.com is an independent adult search service.

[View Unfiltered Excite Web results with Adult Content.](#)

[View Filtered Excite Web results with NO Adult Content.](#)

Filtered Results only include results from partners that provide such results.

Warning!!! By clicking on the links above you certify that you are of the legal age and not prohibited from viewing adult content in the place from which you are accessing this page. You acknowledge all responsibility for viewing the material that follows. Please revise your search if you are under 18 or live in a place that viewing adult content is prohibited.

Your Adult Filter is currently OFF.

Web Sites News Photos

Exact Phrase [Advanced Search](#) | [Preferences](#) | [Tools & Tips](#)

[Yellow Pages](#)
[White Pages](#)



web search

Web Sites Di
playboy
Exact Phrase

Excite

post-settlement

Now Searching: Google • Yahoo • Ask Jeeves • About • Overture • Altavista • Learn More

Quick Find

SearchSpy NEW! | Excite | Lite | Email | Help

Web search results for "playboy" (1 - 20 of 121)

1 | 2 | 3 | 4 | 5 Next >

Are you looking for?

No Suggestions Found.

Recent Searches

playboy

Hide Clear All

View By Relevance View By Search Engine

- Playboy Magazine Now Just \$15.96 a Year**
Subscriptions only. Buy **Playboy** and save 75% off the newsstand price at MagazineCity. Save up to 92% on 1500 magazines. Legitimate prices, gift cards, worldwide delivery, toll free ordering.
Sponsored by: http://www.magazinecity.com
- Playboy Online: In-depth Company Info**
Go to Hoover's Online for in-depth, first-hand, company coverage provided by business experts. Get an overview, key executive bios, financials, news, industry trends, and competitor info.
Sponsored by: http://www.hoovers.com
- Playboy Models and Pics**
Exclusive pics and 1 on 1 interview Instant Access to free sexy photos.
Sponsored by: http://www.Xposed.com/
- Nude**
Dating Resources Center for Nudist, Natural Singles. Register free.
Sponsored by: http://www.NudistFriendFinder.com/
- The BEST playboy PORN on the internet!**
Cum check out the BEST **playboy** websites on the Internet! For years we have collected only the BEST porn sites to give you what you want. We think you'll

tm keying cases

google keying policy:

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

tm keying cases

Geico
V.
Google

ANALYSIS

“use in commerce”

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

tm keying cases

Geico
V.
Google

ANALYSIS

comparative advertising

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

tm keying cases

Geico
V.
Google

ANALYSIS

initial interest confusion

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

tm keying cases

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**

litigation tips

- ▶ know your forums
- ▶ present your best claims
- ▶ focus on your most relevant defenses

litigation tips

(for plaintiffs)

- **forums finding infringement**
- **forums adopting iic**

- 1. forums**
- 2. claims**
- 3. defenses**

litigation tips

- **drop copyright claims**
- **focus on tm claims**

1. forums
2. claims
3. defenses

litigation tips

- **no “use in commerce”**
- **comparative advertising**

1. forums
2. claims
3. defenses

conclusion

Depends on . . .

- “use in commerce”
- comparative advertising
- initial interest confusion

pop-up
ads legit?

tm keying
legit?

- end -

jason allen cody



OBLON
SPIVAK
McCLELLAND
MAIER
&
NEUSTADT
P.C.