Use of Another's Trademark in a Web Page Meta Tag: Why Liability Should Not Ensue Under the Lanham Act for Trademark Infringement

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Recommended Citation

Michael R. Sees, *Use of Another's Trademark in a Web Page Meta Tag: Why Liability Should Not Ensue Under the Lanham Act for Trademark Infringement*, 5 Tex. Wesleyan L. Rev. 99 (1998).
Available at: https://doi.org/10.37419/TWLR.V5.I1.5

USE OF ANOTHER'S TRADEMARK IN A WEB PAGE META TAG: WHY LIABILITY SHOULD NOT ENSUE UNDER THE LANHAM ACT FOR TRADEMARK INFRINGEMENT

INTRODUCTION

John Developer, a budding entrepreneur and computer hacker,[1] decided to start and operate a sports news information service on the Internet. He planned to incorporate sponsor paid advertising in order to make enough money to keep his web site operating while turning a nice profit for himself. John's success ultimately depended on attracting enough people to his web site to entice advertisements on it. But, how could John lure people to his web site? John finally realized that the solution to his problem involved adding the names of other prominent sports news services in the meta tag[2] of his home page. As luck would have it, John's web site was an overnight success. Unfortunately, one of the names that John Developer incorporated in his web page's meta tag was a federally registered trademark owned by Charlie Marker.

Jill Searcher also conducts business on the Internet; she owns and operates a search engine. Her search engine subsequently accessed and cataloged John's web site and recorded its information for future use by anyone searching the Internet.

Soon thereafter, Charlie Marker accessed Jill Searcher's search engine. Charlie entered his trademark as the query term and began running his search. When the results were returned, Charlie noticed that John Developer's web site was prominently displayed in the search results. To ease his curiosity, Charlie visited John's web site. Not finding his registered trademark anywhere on the visible portion of John's home page, Charlie proceeded to view the underlying source document of the web page. Charlie Marker discovered that his trademark was contained as a keyword in the meta tag of John's home page. Outraged, Charlie Marker proceeds to sue John Developer for

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1. "Among professional programmers, the term *hacker* implies an amateur or a programmer who lacks formal training. Depending on how it [is] used, the term can be either complimentary or derogatory, although it is developing an increasingly derogatory connotation." *hacker – PC Webopaedia Definition and Links* (last modified Jan. 19, 1998) <http://webopedia.internet.com/TERM/h/hacker.html>.

2. A meta tag is "[a] special HTML tag that provides information about a [w]eb page. Unlike normal HTML tags, meta tags do not affect how the page is displayed. Instead, they provide information such as who created the page, how often it is updated, what the page is about, and which keywords represent the page's content. Many search engines use this information when building their indices." *meta tag – PC Webopaedia Definition and Links* (last modified Feb. 15, 1998) <http://webopedia.internet.com/TERM/m/meta_tag.html> [hereinafter *Meta Tag*]. *See infra* Part II for a more detailed discussion of the Internet and its components.

trademark infringement under the Trademark Act of 1946, commonly referred to as the Lanham Act.[3]

This Comment argues that liability for trademark infringement should not ensue under the Lanham Act when an unauthorized user incorporates a senior holder's registered trademark in a web page meta tag.[4] Part I discusses the Lanham Act and the various elements that must be satisfied in order to prevail on a cause of action for trademark infringement. Part II provides a background of the Internet and World Wide Web. Part III discusses how a typical cause of action for trademark infringement in this situation may arise. Part IV analyzes the issue and demonstrates why liability should not ensue. In short, the argument takes the position that an action for trademark infringement stemming from the unauthorized use of another's trademark in a meta tag cannot be sustained.

I. THE LEGAL FRAMEWORK UNDER THE LANHAM ACT FOR A TRADEMARK INFRINGEMENT ACTION

A. *Statutory Provisions*

In order to understand how a trademark infringement action can arise through the use of another's trademark in a meta tag, it is necessary to set forth the general legal framework for an infringement action. A trademark is regarded as a type of intellectual property.[5] More specifically, a trademark "is a word, name, symbol, device, or other designation, or a combination of such designations, that is distinctive of a person's goods or services and that is used in a manner that identifies those goods or services and distinguishes them from the goods or services of others."[6]

The term trademark is also commonly used to refer to three other types of protected symbols: service marks, trade dress, and trade names.[7] A service mark is typically a trademark that is used in connection with advertising and sales of services.[8] On the other hand, trade dress is "[t]he design of elements that constitute the appearance or image of goods or services as presented to prospective purchasers, including the design of packaging, labels, containers, displays, decor, or the design of a product, a product feature, or a combination of product features."[9] Finally, a trade name is "any name used by a per-

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3. Trademark Act of 1946 §§ 1-50, 15 U.S.C. §§ 1051-1127 (1994).
4. This Comment will not address other related causes of action that might be raised, such as federal trademark dilution under the Lanham Act of 1946 § 43(c), 15 U.S.C. § 1125(c) (1994).
5. *See* L.L. Bean, Inc. v. Drake Publishers, Inc., 811 F.2d 26, 29 (1st Cir. 1987).
6. RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995).
7. *See* RICHARD L. KIRKPATRICK, LIKELIHOOD OF CONFUSION IN TRADEMARK LAW xvii (1995).
8. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 9 (1995).
9. *Id.* § 16.

son to identify his or her business or vocation."[10] Trademark holders can utilize these three types of trademarks to identify their goods, services, or businesses, which consumers recognize as emanating from a particular source.[11] However, for the purposes of this Comment, the use of the word "trademark" will include only typographical symbology—trademarks and service marks—that are protected under federal law and can be textually represented as machine readable software instructions.[12]

Under federal law, the substantive rights of trademark holders are set forth in the Lanham Act.[13] Owners of registered trademarks can assert trademark infringement and false advertising claims under sections 32(1) and 43(a) of the Lanham Act. Specifically, section 32(1)[14] states:

> (1) Any person who shall, without the consent of the registrant—
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>   (a) use in commerce any reproduction, counterfeit, copy, or colorable imitation of a registered mark in connection with the sale, offering for sale, distribution, or advertising of any goods or services on or in connection with which such use is *likely to cause confusion, or to cause mistake, or to deceive*; or
>
>   (b) reproduce, counterfeit, copy, or colorably imitate a registered mark and apply such reproduction, counterfeit, copy, or colorable imitation to labels, signs, prints, packages, wrappers, receptacles or advertisements intended to be used in commerce upon or in connection with the sale, offering for sale, distribution, or advertising of goods or services on or in connection with which such use is *likely to cause confusion, or to cause mistake, or to deceive*,
>
> shall be liable in a civil action by the registrant for the remedies hereinafter provided.[15]

Moreover, section 43(a)[16] provides that

> (a) Civil action
>   (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false designation of origin, false or misleading description of fact, or false or misleading representation of fact, which—
>   (A) is *likely to cause confusion* . . . as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of

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10. 15 U.S.C. § 1127 (1994).

11. *See* White Tower Sys., Inc. v. White Castle Sys., 90 F.2d 67, 69 (6th Cir. 1937).

12. Since meta tags do not currently support the inclusion and use of imagery, trade dress will not be addressed in this Comment.

13. *See* Trademark Act of 1946 §§ 1-50, 15 U.S.C. §§ 1051-1127 (1994).

14. 15 U.S.C. § 1114(1) (1994).

15. *Id.* (emphasis added).

16. 15 U.S.C. § 1125(a)(1) (1994).

his or her goods, services, or commercial activities by
another person, or

(B) in commercial advertising or promotion, *misrepresents*
the nature, characteristics, qualities, or geographic ori-
gin of his or her or another person's goods, services, or
commercial activities,

shall be liable in a civil action by any person who believes that he
or she is or is likely to be damaged by such act.[17]

In short, these two sections of the Lanham Act forbid the unauthor-
ized use of a registered trademark where such use is *likely to cause
confusion* as to the source or origin of the trademark or where it *mis-
represents* the nature or quality of the goods or services associated
with it. Thus, the Lanham Act is a mechanism that provides protec-
tion in the marketplace for registered marks.

Protection under the Lanham Act extends to several key areas.
First, the Lanham Act protects a business' goodwill by protecting the
consumer's ability to distinguish between goods of competing produ-
cers.[18] Consequently, a trademark serves to guarantee to the pur-
chaser a level of assurance of quality with respect to the particular
good bearing the mark.[19] A consumer's ability to buy or not to buy,
free from confusion, is protected.[20] Under this protection, if goods
bought under a particular trademark are satisfactory, a purchaser
might readily purchase them again based on recognition of the associ-
ated trademark. A corollary to this is that if the goods bearing the
trademark are unsatisfactory, potential purchasers can readily avoid
them in the future.[21]

Second, the Lanham Act enables the trademark owner to create
and subsequently develop a market for his product or service through
advertising.[22] Although consumer demand for goods and services is
usually created through advertising, secondary demand for it may be
created by acknowledgment of the trademark itself.[23] In addition,
since a trademark serves to associate a level of quality assurance with
a particular good or service, the owner's right to control product con-
sistency is protected.[24]

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17. *Id.* (emphasis added).

18. *See* Park 'N Fly, Inc. v. Dollar Park and Fly, Inc., 469 U.S. 189, 198 (1985).

19. *See* DAPHNE ROBERT, THE NEW TRADE-MARK MANUAL 5 (1947).

20. *See* Kenner Parker Toys, Inc. v. Rose Art Indus., Inc., 963 F.2d 350, 354 (Fed.
Cir. 1992) ("By identifying the source of products, a trademark brought consumers
back often to buy from a reliable producer and thus provided economic rewards for
excellence. Thus, trademarks both encourage quality products and reduce consumers'
costs for market searches.").

21. *See* ROBERT, *supra* note 19, at 5.

22. *See id.* at 6.

23. *See id.*

24. *See* El Greco Leather Prods. Co. v. Shoe World, Inc., 806 F.2d 392, 395 (2d Cir.
1986) ("One of the most valuable and important protections afforded by the Lanham

With respect to its place in the law, trademark law "is but a part of the broader law of unfair competition."[25] Consequently, trademark infringement actions under the Act are a subset of the larger realm of law dealing with the protection of persons and businesses from unfair competition in the marketplace. In general, "[trademark] [i]nfringement is that species of unfair trading which comes about when one person adopts and uses either the same mark previously used by another or a mark which so resembles that of another in sound or appearance as to mislead, confuse, or deceive purchasers."[26]

B. *Notable Requirements for the Cause of Action*

1. Subject Matter Jurisdiction and Standing

Before an action for trademark infringement can be sustained, the plaintiff must allege subject matter jurisdiction and standing. Subject matter jurisdiction exists where the defendant's mark or advertising is being used in interstate commerce or where it substantially affects interstate commerce.[27] On the other hand, in order to have standing to raise a claim, the Act requires that a plaintiff show some competitive injury.[28] It is important to note, however, that standing is not extended to those consumer-plaintiffs who have been deceived merely by the defendant's conduct.[29]

2. Likelihood of Confusion

In addition to subject matter jurisdiction and standing, it is necessary to show that the alleged infringing action on the part of the defendant was "likely to cause confusion" as set forth in sections 32(1) or 43(a) of the Lanham Act.[30] This phrase is the key in establishing a claim for trademark infringement or false advertising.[31] Courts have typically analyzed the phrase "likely to cause confusion" on an elemental basis. In particular, the word "likely" means probable, as it is insufficient that such confusion be merely "possible."[32] The phrase

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Act is the right to control the quality of the goods manufactured and sold under the holder's trademark.").

25. United Drug Co. v. Theodore Rectanus Co., 248 U.S. 90, 97 (1918).

26. ROBERT, *supra* note 19, at 158.

27. *See* Kampgrounds of Am., Inc. v. North Del. A-OK Campground, Inc., 415 F. Supp. 1288, 1291 (D. Del. 1976) (finding that advertising and apprising potential customers "constitute[s] sufficient indicia of interstate business to fall within the 'commerce' requirements of the Lanham Act.").

28. *See* KENT D. STUCKEY, INTERNET AND ONLINE LAW § 7.02(1)(a)(i) (1996).

29. *See* Halicki v. United Artists Communications, Inc., 812 F.2d 1213, 1214 (9th Cir. 1987) ("The statute is directed against unfair competition. To be actionable, conduct must not only be unfair[,] but must in some discernible way be *competitive.*") (emphasis added).

30. *See supra* text accompanying notes 14-17.

31. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(iv), at 7-11.

32. *See* Bongrain Int'l (Am.) Corp. v. Delice de France, Inc., 811 F.2d 1479, 1486 (Fed. Cir. 1987) ("The statute refers to likelihood, not the mere possibility, of confu-

"to cause" means that the trademark's unauthorized use "must be the legal cause and cause in fact of the confusion."[33] And finally, the word "confusion" is generally construed as "an act of mistaking one thing for another, of failing to note distinctions, and of falsely identifying."[34] Thus, to show that the use of another's trademark is "likely to cause confusion," the three parts of this phrase must be satisfied.

With respect to "confusion" as set forth under the Lanham Act,[35] courts have recognized several different types of confusion as being actionable. The first type, source confusion,[36] results when the public associates the goods or services with the wrong source or sponsor.[37] A second type, sponsorship confusion,[38] results from the misperceived endorsement, approval, affiliation, or certification by one source of goods or services with that of another.[39] A third type, reverse confusion,[40] occurs when the consumer believes that the newcomer is actually the source or sponsor of the prior user's goods.[41] And the final

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sion."). *See also* KIRKPATRICK, *supra* note 7, § 1.1, at 1-3. This inquiry will be referred to as the "likeliness test for trademark infringement." *See infra* Part IV.B.1.

33. *See* KIRKPATRICK, *supra* note 7, § 1.1, at 1-4. *See also* Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193, 195 (1st Cir. 1980) ("Confusion, in the legal sense means confusion of source."); Smithkline Beckman Corp. v. Pennex Prod. Co., 605 F. Supp. 746, 752 (E.D. Pa. 1985) ("The characteristic that all the unfair competition claims share is that confusion is the direct and proximate result of an act undertaken by the defendant."). *See generally* RESTATEMENT (SECOND) OF TORTS §§ 430-34 (1965) (describing the causal connection required to establish liability). This inquiry will be referred to as the "causation test for trademark infringement." *See infra* Part IV.B.1.

34. *See* Rockland Mortgage Corp. v. Shareholders Funding, Inc., 835 F. Supp. 182, 196 (D. Del. 1993) (quoting WEBSTER'S NEW INTERNATIONAL DICTIONARY 477 (3d ed. 1971)).

35. *See supra* text accompanying notes 14-17.

36. *See* KIRKPATRICK, *supra* note 7, § 1.4.A, at 1-15.

37. *See* James Burrough Ltd. v. Sign of The Beefeater, Inc., 540 F.2d 266, 275 (7th Cir. 1976) ("[T]he test is not whether the public would confuse the *marks*, but whether the viewer of an accused mark would be likely to associate the product or service with which it is connected with the source of products or services with which an earlier mark is connected.").

38. *See* KIRKPATRICK, *supra* note 7, § 1.4.B, at 1-15.

39. *See id* at 1-15 to -16. *See, e.g., James Burrough Ltd.*, 540 F.2d at 274 (stating that the goods or services must be "in some way related to, or connected or affiliated with, or sponsored by").

40. *See* KIRKPATRICK, *supra* note 7, § 1.4.C, at 1-17.

41. *See* Fisons Horticulture, Inc. v. Vigoro Indus., Inc., 30 F.3d 466, 474 (3d Cir. 1994).

> Ordinarily, one expects that the new or junior user of the mark will use to its advantage the reputation and good will of the senior user by adopting a similar or identical mark. Reverse confusion occurs when a larger, more powerful company uses the trademark of a smaller, less powerful senior owner and thereby causes likely confusion as to the source of the senior user's goods or services. *See* Sands, Taylor & Wood Co. v. Quaker Oats Co., 978 F.2d 947 (7th Cir. 1992) (Quaker Oats Co.'s use of 'Thirst-Aid' in advertising for Gatorade was trademark infringement of the 'Thirst-Aid' registered trademark owned and formerly used by a small Vermont company).

Id.

type of actionable confusion is associational or subliminal confusion.[42] Associational confusion results when the consumer subliminally or subconsciously identifies the properties and reputation of one product with those of another, even though the consumer can identify the particular manufacturer or producer of each product.[43] With associational confusion, a newcomer could gain a foothold in the first user's market by exploiting association with the prior user's trademark.[44]

3. Intent to Cause Mistake or to Deceive or Misrepresent

Another important factor in an action for trademark infringement is the defendant's intent. Under the Lanham Act, it is not necessary to allege that the defendant's conduct was deceptive or fraudulent so long as a likelihood of confusion exists.[45] Absent evidence of misrepresentation or fraud, a standard of strict liability is imposed.[46] If evidence of intent to defraud, cause mistake, or misrepresent exists, the plaintiff can make allegations against the defendant per sections 32(1)[47] and 43(a)[48] of the Act. However, such allegations must be pleaded with particularity in order to avoid a motion to dismiss.[49]

4. Contributory Infringement

An action for contributory infringement can also be raised under the Lanham Act against any party "who knowingly play[s] a significant role in accomplishing a wrongful purpose."[50] In order to sustain an action of contributory trademark infringement, the aforementioned requirements for a direct infringement action must be satisfied.[51] Absent an allegation of a third party's direct knowledge of the infringing action, some measure of understanding must be proven in

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42. *See* KIRKPATRICK, *supra* note 7, § 1.4.D, at 1-18.

43. *See* Farberware, Inc. v. Mr. Coffee, Inc., 740 F. Supp. 291, 302 (D. Del. 1990) ("Subliminal confusion causes 'the consumer to identify the properties and reputation of one product with those of another, *although he can identify the particular manufacturer of each.'"*) (quoting Ortho Pharm. Corp. v. American Cyanamid Co., 361 F. Supp. 1032, 1044 (D.N.J. 1973)).

44. *See* KIRKPATRICK, *supra* note 7, § 1.4.D, at 1-19.

45. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(vi), at 7-14; *see, e.g.,* Henri's Food Prod. Co. v. Kraft, Inc., 717 F.2d 352, 359 (7th Cir. 1983) (stating that a finding of fraudulent intent or bad faith is not required to prove infringement when there already exists a likelihood of confusion) (citing Task Hotels, Inc. v. Americana Inn, Inc., 350 F.2d 609, 613 (7th Cir. 1965)).

46. *See* Hard Rock Cafe Licensing Corp. v. Concession Serv., Inc., 955 F.2d 1143, 1152 (7th Cir. 1992) ("Sellers bear strict liability for violations of the Lanham Act.") (citing Henri's Food Prod. Co., 717 F.2d at 359).

47. *See supra* text accompanying note 15.

48. *See supra* text accompanying note 17.

49. FED. R. CIV. P. 9(b) ("In all averments of fraud or mistake, the circumstances constituting fraud or mistake shall be stated with particularity.").

50. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(iii) (citing Inwood Lab., Inc. v. Ives Lab., Inc., 456 U.S. 844, 853-54 (1982)).

51. *See supra* Part I.B.1-3.

order to render the third party contributorily liable for trademark infringement.[52]

5.   Evidentiary Considerations

Another important consideration in the analysis is the evidentiary support required to sustain a cause of action for trademark infringement. Of particular interest in such an action is where the burden of proof lies. Specifically, the party alleging such infringement has the burden of proof.[53]

Another factor is the effect of registration of the trademark. Registration does not automatically entitle the registrant's trademark to protection under the Act.[54] The registrant must still establish that the requisite elements of infringement set forth in the Lanham Act, particularly the likelihood of confusion or intent to defraud, are satisfied in order for an action to be sustained.

The use of expert opinion to support an action for trademark infringement is also worth noting. Courts have typically viewed expert opinion on infringement actions with disfavor.[55] A majority of the courts have determined that infringement is within the realm of everyone's common knowledge and experience, and that the jury has a duty to make the determination on such issues.[56] Thus, it is generally held that expert opinion is given little weight.[57]

In summary, several factors should be considered when pursuing an action for trademark infringement. Of notable importance are (1) the jurisdictional requirements, (2) the confusion threshold, (3) the defendant's intent, (4) contributory infringement considerations, and (5)

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52. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(iii) (citing Fonovisa, Inc. v. Cherry Auction, Inc., 76 F.3d 259, 264 (9th Cir. 1996) (stating that defendant may be vicariously liable for trademark infringement if he knows or has reason to know of infringement). *But c.f.* Hard Rock Café Licensing Corp. v. Concession Serv., Inc., 955 F.2d 1143, 1152 (7th Cir. 1992) ("Although the 'reason to know' part of the standard for contributory liability requires [defendant] (or its agents) to understand what a reasonably prudent person would understand, it does not impose any duty to seek out and prevent violations.") (citing RESTATEMENT (SECOND) OF TORTS § 12(1) & cmt. a (1965)).

53. *See* E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 510 n.4 (E.D.N.Y. 1975) ("The traditional rule [is] that the burden of proof is on the plaintiff to establish a likelihood of confusion by a fair preponderance of the evidence.").

54. *See* Scott v. Mego Int'l, Inc., 519 F. Supp. 1118, 1127 (D. Minn. 1981) (indicating that "registration does not assure the protection of a trademark in an infringement action").

55. *See* KIRKPATRICK, *supra* note 7, § 1.8.C, at 1-40.

56. *See* Ford Motor Co. v. Summit Motor Prods., Inc., 930 F.2d 277, 300 n.29 (3d Cir. 1991) ("The testimony of industry insiders on likelihood of confusion should be given little weight, since . . . the determination of likelihood of confusion must be made from the standpoint of a reasonable prudent buyer from the lowest stratum of the relevant buying class.").

57. *See* KIRKPATRICK, *supra* note 7, § 1.8.C, at 1-40.

evidentiary considerations. If any of these requirements cannot be addressed with specificity, the action should fail.

II. WEB-BASED FRAMEWORK

To analyze a problem involving trademark infringement when a third party uses another person's trademark in a web page meta tag, it is necessary to have a basic understanding of the Internet as well as its associated protocols and programming mechanisms.

The Internet is actually a large collection of computer networks that runs a common protocol known as the Transmission Control Protocol/ Internet Protocol ("TCP/IP").[58] Computer users access the Internet via the common protocol, which then enables them to communicate with other users throughout the network.[59]

Another commonly referred to aspect of the Internet is the World Wide Web ("Web"). The Web is simply a mechanism used to distribute and access data throughout the Internet, which uses another protocol called the Hypertext Transfer Protocol ("HTTP").[60] It was designed to combine certain aspects of information retrieval with multimedia communications.[61] Through the underlying HTTP protocol, the Web allows users to access information in many different types of formats—including text, sound, images, animation, and video—and treats all searchable files on the Internet as hypertext documents.[62]

Hypertext, on the other hand, refers to text that contains pointers or "links" to other text. The use of hypertext allows computer users to jump from one document to another, while being able to return to the first document, even when the documents are on different computers at remote locations.[63] Hypertext documents are beneficial because they can employ images, sound, graphics, video, and animation in addition to traditional textual characters.[64]

Hypertext documents are accessed via the Web through the use of software processes known as web servers, each of which is located and runs on a host computer, thereby forming a configuration known as a

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58. *See* Gary Scott Malkin & April N. Marine, *FYI on Questions and Answers; Answers to Commonly Asked 'New Internet User' Questions,* § 3, RFC 1325 (May 1992) (last modified Oct. 12, 1998) <http://ds.internic.net/rfc/rfc1325.txt>. *See generally* W. RICHARD STEVENS, UNIX NETWORK PROGRAMMING § 5.2 (1990) (background information on TCP/IP); T.J. Socolofsky & C.J. Kale, *A TCP/IP Tutorial,* RFC 1180 (Jan. 1991) (visited Feb. 27, 1998) <http://ds.internic.net/rfc/rfc1180.txt>.

59. *See* Malkin & Marine, *supra* note 58, § 3.

60. *See* Tim Berners-Lee et al., *Hypertext Transfer Protocol-HTTP/1.0,* RFC 1945 (May 1996) (visited Feb. 27, 1998) <http://ds.internic.net/rfc/rfc1945.txt>.

61. *See* Gary C. Kessler & Steven D. Shepard, *A Primer on Internet and TCP/IP Tools and Utilities,* § 7 RFC 2151 (June 1997) <http://ds.internic.net/rfc/rfc2151.txt>.

62. *See id.*

63. *See id.*

64. *See id.*

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web site.[65] To access and view hypertext documents on a web site, computer users employ web browsers, which are nothing more than consumer software running on a personal computer.[66] Both the client browser and the host web server communicate through the use of the HTTP.[67]

The portion of a hypertext document that is visually displayed through the use of a web browser is known as a web page.[68] The hypertext document that actually comprises the underlying web page is typically written in a base language known as hypertext markup language ("HTML"), a text-based formatting language that is both hardware and software platform-independent.[69] Each construct of the language is delineated by a plurality of different machine-readable computer commands or codes called "tags," and the meta tag comprises one of these commands.[70] And finally, a web page source document is the raw file of HTML commands (i.e. the hypertext document), which allows the creation of the web page when accessed via a browser.

Users access a particular web page by "pointing" their browser at a unique address, which allows retrieval of a particular web page on a web site. This address is expressed in a shorthand format called the uniform resource locator ("URL"). In general, the URL designates the location of a unique host computer on the Internet and the location of the web page source document within that host computer's file structure.[71] Thus, when a user designates a specific URL to visit, by typing the URL or "clicking" on a link, this user will obtain those web pages from any location on the Internet.[72]

In order to facilitate the retrieval of information on the Internet, a variety of Internet search engines are available. A search engine is basically a remote accessible program that allows users to perform keyword[73] searches to facilitate the location of information on the In-

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65. *See Web site – PC Webopaedia Definition and Links* (last modified June 16, 1997) <http://webopedia.internet.com/TERM/w/web_site.html>.

66. *See Browser – PC Webopaedia Definition and Links* (last modified May 14, 1998) <http://webopedia.internet.com/TERM/b/browser.html>.

67. *See* Kessler, *supra* note 61.

68. *See Web page – PC Webopaedia Definition and Links* (last modified June 16, 1997) <http://webopedia.internet.com/TERM/w/web_page.html>.

69. *See* HTML *– PC Webopaedia Definition and Links* (last modified Dec. 22, 1997) <http://webopedia.internet.com/TERM/H/HTML.html>.

70. *See generally* World Wide Web Consortium, *W3C's HTML Home Page* (last modified Oct. 12, 1998) <http://www.w3.org/MarkUp/MarkUp.html> (provides access to HTML specifications).

71. *See URL – PC Webopaedia Definition and Links* (last modified June 24, 1998) <http://webopedia.internet.com/TERM/U/URL.html>.

72. *See id.*

73. A keyword is an index entry that identifies a specific record or document in a database management system. *See Keyword – PC Webopaedia Definition and Links* (last modified Oct. 27, 1997) <http://webopedia.internet.com/TERM/k/keyword.html>.

ternet.[74] Search engines typically access web pages and index or cata-
log them according to the information contained therein. Thereafter,
they construct databases that can be queried by a user through a
browser.[75] There are various types of search engines with facilities
that allow searching to cover titles of text documents or web pages,
URLs, or web page source documents. Several of the more popular
search engines[76] include Altavista,[77] Hotbot,[78] Infoseek,[79] and
Excite.[80]

Although the indexing operation performed by the search engine
can be accomplished independent of user interaction, it is possible for
a creator of a web page to control how the web page is indexed by the
search engine. In particular, HTML provides a programming con-
struct called a "meta tag."[81] The meta tag allows web page authors to
specify additional keywords for search engines to index and catalog, as
well as accompanying descriptive information for use by other In-
ternet web servers. This is really nothing more than a short abstract of
the web page itself.[82] Therefore, meta tags are useful because they
can be used to augment documents with additional information that is
not normally displayed by an Internet browser. Information stored in
meta tags is not normally displayed when the web page is loaded into
a web browser. However, that information can be extracted and used
by web servers and search engines to identify, index, and catalog the
web page.[83]

As a consequence, the meta tag of an associated web page provides
a way for the designer to have some control over the way a meta tag-
capable search engine indexes and catalogs the web page. In opera-
tion, a keyword contained in the meta tag of a target web page source
document is accessed by a meta tag-capable search engine at a given
time and lexically analyzed,[84] then the resulting information is stored

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74. *See Search Engine – PC Webopaedia Definition and Links* (last modified Oct.
27, 1997) <http://webopedia.internet.com/TERM/s/search_engine.html>.

75. *See* Danny Sullivan, *How Search Engines Work* (visited Feb. 27, 1998) <http://
searchenginewatch.com/webmasters/work.html>.

76. *See* Danny Sullivan, *Search Engines Guide: The Major Search Engines* (visited
Feb. 27, 1998) <http://searchenginewatch.com/facts/major.html>.

77. *See AltaVista: Main Page* (visited Feb. 27, 1998) <http://www.altavista.digital.
com>.

78. *See HotBot* (visited Feb. 27, 1998) <http://www.hotbot.com>.

79. *See InfoSeek* (visited Feb. 27, 1998) <http://www.infoseek.com>.

80. *See Excite* (visited Feb. 27, 1998) <http://www.excite.com>.

81. *See* Andrew, *HTML META Tags* (last modified Oct. 7, 1998) <wysiwyg://de-
tail.54/http://vancouver-webpages.com/META/metatags.detail.html>.

82. *See The WDVL: HTML's META-Tag* (visited Feb. 27, 1998) <http://
www.stars.com/Authoring/HTML/Head/meta.html> [hereinafter *Web Developer*].

83. *See The WDVL: META Tagging for Search Engines* (visited Feb. 27, 1998)
<http://www.stars.com/Location/Meta/Tag.html>.

84. Lexical analysis is the first stage of processing a computer language. In this
stage of processing, a stream of characters making up the source document is read one
at a time and grouped into word-like pieces such as phrases, keywords, identifiers,

in the search engine's database. As a consequence, whenever a user queries the search engine with the same keyword that was contained in the meta tag of the target web page, the search engine will use this keyword to find the web page and allow the user access to it. Thus, the relationship between the search engine's access and cataloging functions and the information contained in the meta tag is both content and time dependent.

III. How a Cause of Action for Trademark Infringement Within a Meta Tag Might Arise

A cause of action for trademark infringement in this scenario could arise in several different ways. For instance, a trademark holder might happen to examine the web page source document of another's web page and find his or her trademark included in that page's meta tag.[85] This scenario is rather unlikely since it essentially requires that the trademark holder examine the web page source document without a prior indication of possible use of the trademark on the part of the web page creator.

Another scenario results when an individual discovers, through the use of a search engine, that a third party is using the mark without the holder's permission.[86] Under this scenario, a web page is created which includes another's trademark in a meta tag. That web page is subsequently accessed and cataloged by a meta tag-capable Internet search engine. Next, the trademark holder inputs the trademark as an identifying query into an Internet search engine and notices a web page that is not owned by him. Further, after examining the web page and finding that the trademark is not contained on the visible portion of the page, the trademark holder may then view the underlying web page source document of the web page to discover the trademark contained in the meta tag.[87] Since the trademark holder may not have

literals, and punctuation. *See* Denis Howe, *Free On-Line Dictionary of Computing (FOLDOC): lexical analysis from FOLDOC* (last modified Oct. 27, 1998) <http://wombat.doc.ic.ac.uk/foldoc/foldoc.cgi?query=lexical+analysis> (citing ALFRED V. AHO ET AL., COMPILERS- PRINCIPLES, TECHNIQUES AND TOOLS 4-5 (1995)).

85. *See generally* Playboy Enter., Inc. v. Calvin Designer Label, 958 F. Supp. 1218, 1219 (N.D. Cal. 1997) (finding false designation of origin by misappropriate use of plaintiff's trademark). *See generally* Joshua Paul, *Trademarks and Electronic Commerce: Protecting Your Mark from "Invisible" Trademark Infringement and Other Forms of Trickery on the Internet* (visited Feb. 27, 1998) <http://www.cll.com/pub98.html> (providing an account of the case by the firm representing the prevailing party).

86. *See, e.g.*, Oppedahl & Larson v. Advanced Concepts, No. 97-CV-1592 (D. Colo. Dec. 22, 1997 and Feb. 6, 1998) (ordering permanent injunctions). *See generally* Oppedahl & Larson Patent Web Server, *Advanced Concepts Lawsuit* (visited Feb. 27. 1998) <http://www.patents.com/ac/index.sht> (providing an account of the case by the firm representing the prevailing party).

87. The web page source document may be readily viewed by selecting the "view source" or similar user-selectable option that is available on the most popular web browsers such as the "Navigator" by Netscape Communications Corporation or the

given explicit authorization for the use of this trademark by the partic-
ular author of the web page, the holder could file an action for trade-
mark infringement.

IV. TRADEMARK INFRINGEMENT ANALYSIS AS APPLIED TO USE OF ANOTHER'S TRADEMARK WITHIN A META TAG

A. *Lack of Subject Matter Jurisdiction—The Law Does Not Contemplate Providing Protection for a Non-Exposed Trademark Within a Meta Tag*

Under the present law, a suit for trademark infringement due to the
use of another's trademark in a meta tag should be dismissed for a
lack of subject matter jurisdiction.[88] As a general proposition, "dis-
trict courts shall have original jurisdiction of all civil actions arising
under the Constitution, laws, or treaties of the Untied States."[89] Ac-
cordingly, there must be standing in order to bring forth a cause of
action. Standing may be based on an interest created by the Constitu-
tion or by statute.[90] The Lanham Act's legislative history clearly indi-
cates that the protected mark must be exposed before a violation for
infringement occurs.[91] Neither the Act itself nor its legislative history
contemplates trademark protection where the registered mark itself is
not exposed to the general public.[92] In fact, there is absolutely no
indication that the legislative history would allow a party to sustain a
cause of action for trademark infringement where the protected mark
is not visible to the public in the normal course of use. Moreover,
there is at least some case law that supports this proposition of expo-
sure.[93] As such, the Act does not contemplate violations that arise

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"Internet Explorer" by Microsoft Corporation. *See generally Welcome to Netscape
Netcenter* (visited Feb. 27, 1998) <http://www.netscape.com>; *Microsoft Corporation
Home Page; Welcome to Microsoft* (last modified Sept. 11, 1998) <http://
www.microsoft.com/>.

88. *See supra* Part I.B.1.

89. 28 U.S.C. § 1331 (1994).

90. *See* Joint Anti-Fascist Refugee Comm. v. McGrath, 341 U.S. 123, 152 (1951).

91. *See* ROBERT, *supra* note 19, at 266 (quoting S. Rep. No. 79-1333 (1946)).
    The purpose underlying any trade-mark statute is twofold. One is to protect
    the public so it may be confident that, in purchasing *a product bearing a
    particular trade-mark* which it favorably knows, it will get the product which
    it asks for and wants to get. Secondly, where the owner of a trade-mark has
    spent energy, time, and money *in presenting to the public the product*, he is
    protected in his investment from its misappropriation by pirates and cheats.
Id. (emphasis added).

92. *See* Exxon Corp., 695 F.2d at 98 n.1 (stating that the proper test for trademark
infringement is whether the general public is likely to be confused).

93. *See* Malcolm Nicol & Co. v. Witco Corp., 881 F.2d 1063, 1066 (Fed. Cir. 1989)
("The opposer or petitioner has the burden, however, to show that the use was such
that it created 'public exposure of [the] mark that would be expected to have [a]
significant impact on the purchasing public.'") (Archer, J., dissenting) (quoting Old
Swiss House, Inc. v. Anheuser-Busch, Inc., 569 F.2d 1130, 1133 (C.C.P.A. 1978)).

from the use of another's trademark within a meta tag, because the trademark is not exposed to the general public.

It would be presumptuous to extend protection under the Lanham Act to the non-exposed or "invisible" use of another's trademark in a meta tag. Since meta tags are not normally exposed to the general viewing public, a trademark infringement violation should not be sustained under the Act. Only persons with specialized computer programming knowledge, outside the realm of the general public, can actually understand the meta tag and the information contained therein when the meta tag is exposed in the web page source document.[94] In sum, if additional protection is needed to protect trademark owners from such unauthorized use, new legislation should be drafted.

B. *Failure to Satisfy Requisite Statute Requirements*

1. Use of Another's Trademark Within a Meta Tag Is Not Likely to Cause Confusion

The use of another's trademark within a meta tag is not likely to cause confusion under sections 32(1) and 43(a) of the Lanham Act[95] because the "likeliness test" for trademark infringement is not satisfied.[96] Therefore, liability under the Act should not ensue.

As a general proposition, the mere possibility of confusing the general public is not sufficient to establish liability under the Lanham Act.[97] Moreover, most users only access the visible portion of a web page, not the underlying web page source document. As such, confusion is possible only when the user displays or otherwise views the document's source of the web page. Therefore, the likelihood inquiry must focus on whether the actual or potential user is confused.[98] The likelihood inquiry is also viewed from the standpoint of an average user of the general public who may be either an actual or potential user. This standard is not based on a user who possesses specialized knowledge of the use of meta tags. Since only a small fraction of the users ever access and understand the use of meta tags, they would certainly not qualify as a normal or potential user of the general public as contemplated by the courts. Consequently, no infringing action should result.[99] However, the possibility exists that some users might

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94. *See* Andrew, *supra* note 81 and accompanying text.
95. *See* 15 U.S.C. §§ 1114(1) (1994); 1125(a)(1) (1994).
96. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(iv), at 7-11.
97. *See id.*
98. *See* Electronic Design & Sales Inc. v. Electronic Data Sys. Corp., 954 F.2d 713, 716 (Fed. Cir. 1992) ("[I]n the case of goods and services that are sold, the inquiry generally will turn on whether actual or potential 'purchasers' are confused.").
99. *See* Andrew, *supra* note 81. *See also* Exxon Corp. v. Humble Exploration Co., 695 F.2d 96, 98 n.1 (5th Cir. 1983).

examine the web page's source document in the normal course of use and only a smaller subset of these persons might even understand the meta tag's function. This level of probability does not rise to the level contemplated to sustain a trademark infringement action.

The likeliness inquiry also focuses on the meaning of the words to prospective purchasers.[100] Thus, even if the web page source document is viewed, and another person's trademark within the meta tag is exposed, the word or words that make up the trademark must be analyzed to determine whether a likelihood of confusion could result. There might be many reasons for including a registered trademark within a meta tag and none of them are related to infringement. For example, the use of the trademark could merely be a description that identifies the goods or allows an actual or potential purchaser a way to identify alternative sources of goods in the marketplace. Therefore, even if the general public were to access the web page's source document and notice the use of another's trademark in the meta tag, confusion would probably not result.

None of the types of "confusion" can be said to result through the use of another's trademark in a web page meta tag.[101] A prospective purchaser will not be in a position to be confused since meta tags are not automatically displayed when browsing the web. Exposure has always been a key element in an action for trademark infringement.[102] Since exposure of the trademark on the web page does not occur, the likelihood of confusion of the prospective purchaser does not exist, and the intended use of the trademark contained within the meta tag need not be ascertained. This position is readily apparent when considering a stand-alone web page.

In a stand-alone web page, there is no source, sponsorship, reverse, or associational confusion because the trademark is not visible on the web page by the general public. Confusion cannot arise where there is a remote chance that a user or a potential user of the general public will be confused.[103] For example, in *Advanced Sports Concepts, Inc. v. Baden Sports, Inc.,*[104] the plaintiff asserted that the defendant's sale of

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100. *See* Cullman Ventures, Inc. v. Columbian Art Works, Inc., 717 F. Supp. 96, 128 (S.D.N.Y. 1989) ("[S]imilarity for purposes of likelihood of confusion means similarity in appearance, *sound* or *meaning.*").

101. *See supra* Part I.B.2.

102. *See* Holiday Inns, Inc. v. Holiday Inn, 364 F. Supp. 775, 782 (D.C.S.C. 1973) (holding that the statutory test for trademark infringement be applied with regard to the effect of a purchaser having an indefinite recollection of the mark to which he has been previously exposed). *See also In re* Honeywell, Inc., 532 F.2d 180, 182 (C.C.P.A. 1976) ("Appellant argues that the transparent disk cannot function as a portion of a trademark because it is invisible to customers and potential customers. However, transparency is not invisibility."). In this case, the court implies that if a trademark is not visible, an infringement action may not ensue. *See id.*

103. *See* 15 U.S.C. § 1114(1) (1994); 15 U.S.C. § 1125(a)(1) (1994). *See also* ROB-ERT, *supra* note 19; STUCKEY, *supra* note 28.

104. 29 U.S.P.Q.2d. (BNA) 1227, 1230 (S.D. Ohio 1993).

an oversized basketball with its trademark "Skillcoach" taped over the plaintiff's trademark "THE BIGBALL" constituted trademark infringement under the Lanham Act. Furthermore, the plaintiff alleged that the defendant's conduct was "committed with the intent to cause confusion and to deceive and defraud the public."[105] However, the court found otherwise stating that no confusion resulted because the plaintiff's trademark was completely hidden or "obliterated" by a removable tape label that was imprinted with the defendant's trademark.[106] Only if the tape was peeled away could Baden's trademark have been exposed.[107]

A similar situation holds true for web pages containing another's trademark in its meta tag. The visible portion of the web page completely masks the underlying non-visible web page source document and the included registered trademark. Only when one "peels away" the visible portion of the web page, by viewing the web page's underlying source document, does the trademark within the meta tag become visible. Therefore, following the court's reasoning in the instant case, no confusion should result due to the inclusion of another's trademark in a meta tag of a web page.

Additional support for this position is found in *Munsingwear, Inc. v. Jockey Int'l Inc.*[108] In *Munsingwear,* the plaintiff instituted a trademark infringement action against the defendant, alleging that the defendant's underwear product would ultimately be confused with the plaintiff's product by the consuming public.[109] In that case, the court found that the action for trademark infringement could not be sustained based in part on an allegation of post-sale exposure by the defendant. In reaching its conclusion, the court explained:

> As customarily worn, underwear is concealed by other articles of clothing. The general public does not ordinarily see underwear in the same manner, and to the [same] extent that it views outerwear. . . . The inherently concealed nature of worn underwear diminishes the concern for post-sale confusion . . . . The lack of . . . exposure of the product to the general public reduces the risk that any customers will be confused . . . .[110]

Similarly, the risk of confusion due to the use of another's trademark in a meta tag is slight because the underlying, "invisible" source document is not ordinarily viewed by the general public to the extent that the public views the overlying and "visible" web page. The inherently concealed nature of the source document minimizes the risk that confusion will result. As in *Advanced Sports,* the analysis set forth in

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105. *Id.*
106. *See id.*
107. *See id.*
108. 31 U.S.P.Q. 2d 1146 (D. Minn. 1994).
109. *See id.* at 1149.
110. *Id.* at 1150.

Munsingwear supports the proposition that an action for trademark infringement stemming from the use of another's trademark in a meta tag should not be sustained.

Confusion does not result even if a web page containing another's trademark is accessed and subsequently cataloged by a search engine. In this instance, no source, sponsorship, reverse, or associational confusion results.[111] A user could not be confused as to the source or sponsorship of the goods in question because the protected mark would not be visible to the user when the associated web page is returned as a result of a search query. Concededly, the only confusion that might be said to result is that of the search engine in including the web site in the query result; however, trademark infringement only protects persons from confusion—not search engines.[112]

Moreover, a search engine query returns selected web pages that are accessible by their unique URLs, which may designate the source or sponsor of the web site.[113] Since a URL provides the actual address or designation of a selected web page, there is no misimpression that could result under the reverse or associational confusion types because the URL clearly designates the origin of the web page. However, one can assume that an actual or potential purchaser[114] browsing the Internet would understand the basic use and function of the URL designation at the host computer level. This assumption is reasonable for two simple reasons: (1) URL host computer designations are needed in order to access web sites and (2) URLs are commonly advertised on television, radio, and hardcopy media. Thus, one would be hard-pressed to argue that the general public is likely to be confused when someone uses another's trademark in a meta tag, whether that web site is accessed with or without the help of a search engine.

Furthermore, liability should not ensue for an action of trademark infringement under these circumstances because the causation test for trademark infringement[115] is not satisfied. For causation to be established, the plaintiff must show that the injury is fairly traceable to the defendant's conduct.[116] Merely placing another's trademark in a meta

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111. *See supra* Part I.B.2.

112. *See* ROBERT, *supra* note 19. *See also supra* text accompanying note 91.

113. Where confusion exists at the URL level, courts have sustained an action of trademark infringement since the exposed domain names can cause consumer confusion. *See* Comp Examiner Agency, Inc. v. Juris, Inc., No. 96-CV-0213-WMB (CTX), 1996 WL 376600 (C.D. Cal. Apr. 26, 1996); Playboy Enter., Inc. v. Chuckleberry Publ'g, Inc., 939 F. Supp. 1052 (S.D.N.Y. 1996).

114. *See* Calvin Klein Cosmetics v. Parfums de Coeur, Ltd., 824 F.2d 665, 669 n.4 (8th Cir. 1987) ("In applying principles of trademark law, courts commonly refer to 'the consumer,' much like the references made to 'the reasonable person' in resolving questions of tort law.").

115. *See* RESTATEMENT (SECOND) OF TORTS § 430-34 (1965).

116. *See* Lujan v. Defenders of Wildlife, 504 U.S. 555, 560-61 (1992).
[T]he irreducible constitutional minimum of standing contains three elements. First, the plaintiff must have suffered an 'injury in fact' – an invasion

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tag causes no injury in and of itself due to the fact that the trademark is not visible to the general public when viewed as a web page.[117] Nor is injury caused when the search engine accesses, catalogs, and makes the source document of a web page available for those searching the Internet.[118] Causation is very difficult to establish under this latter instance since the plaintiff must prove that the trademark in the given meta tag contained in the web page source document was accessed and used by a particular search engine at a particular time.[119] In addition, the plaintiff would have to show that when the source document was actually cataloged, the particular search engine used the trademark in such a fashion that would probably confuse the general public when it is queried and returns the results.

The only way that a plaintiff could possibly sustain an infringement action is to require each search engine owner to identify the lexical approach used by his search engine in indexing and cataloging the plaintiff's web page. Disclosure would be necessary since different search engines perform their lexical functions in different ways.[120] The plaintiff would have the burden of proving that the particular lexical approach used by the given search engine and the plaintiff's query caused the search engine to use the trademark in such a fashion that it harmed the trademark holder.[121] Without such a disclosure from the search engine owner, there would be no means to determine whether the trademark itself or some other lexical criterion, unique to that particular search engine, or the plaintiff's query, led to the apparent injury.[122]

Requiring search engine companies to divulge their proprietary searching and cataloging methods in order to sustain another's action for trademark infringement would be unduly burdensome and impinge the other protections afforded under various intellectual prop-

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of a legally protected interest which is (a) concrete and particularized, and (b) 'actual or imminent,' not 'conjectural' or 'hypothetical.' Second, there must be a causal connection between the injury and the conduct complained of – the injury has to be 'fairly . . . trace[able] to the challenged action of the defendant, and not . . . the result [of] the independent action of some third party not before the court.' Third, it must be 'likely,' as opposed to merely 'speculative' that the injury will be 'redressed by a favorable decision.'

Id. (citations omitted).

117. *See Meta Tag, supra* note 2; *see also Web Developer, supra* note 82.

118. *See* Sullivan, *supra* note 75.

119. *See* KIRKPATRICK, *supra* note 7, § 1.1, at 1-4.

120. *See* Sullivan, *supra* note 76.

121. *See* E.I. DuPont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. 502, 510 n.4 (E.D.N.Y. 1975).

122. For example, the Excite search engine does not utilize meta tags at all, and in other search engines meta tags are only part of the criterion. *See* Danny Sullivan, *Search Engine Features Comparison Chart* (last modified Aug. 4, 1998) <http://searchenginewatch.com/webmasters/features.html>.

erty laws, such as trade secret law.[123] To force such disclosure from these companies would also have a chilling effect on the development of new technologies. For instance, searching and cataloging processes could be improved thereby eliminating the alleged infringing action itself. Absent knowledge of the infringing action,[124] a plaintiff should not be able to force a search engine owner to participate in establishing causation against a defendant in a trademark infringement action under the Lanham Act.

2. Evidence of Fraud or Mistake Cannot Be Established Simply on the Basis that Another's Trademark Was Used in a Meta Tag

Absent the likeliness of confusion, an action for trademark infringement can be negated even if one alleges that another's trademark in a web page meta tag was used with the intent to cause injury. Absent any direct evidence of fraud or mistake, such as that which may be contained in other portions of the web page source document or be available from an alternative source, an action for trademark infringement cannot be sustained by a plaintiff's mere allegation that the defendant intended to deceive, cause mistake, or misrepresent through the lone use of plaintiff's trademark in a web page meta tag.[125] Such an allegation must be pleaded with particularity.[126] The mere inclusion of a word or phrase comprising another person's trademark in a meta tag cannot be particularly ascertained to mean that the defendant acted with an adverse intent. In fact, there may be several reasons for including another's trademark in a meta tag that actually reveals the defendant's good intent.

One reason for including the trademark in a meta tag is just for advertisement comparison purposes. In this situation, the comparison advertisement object is contrast, not confusion.[127] Another reason for including another's trademark in a meta tag is simply to identify related secondary sources of goods or services.[128] Consequently, the capability of a consumer to find the best goods and services at the best

123. *See generally In re* Bolster, 110 P. 547, 548 (Wash. 1910) (defining a trade secret as a non-patented, secret formula or process, which is known only to certain individuals and used in producing an article of trade). *See also* IRVING KAYTON, PATENT PRACTICE 1-38 (1985) (explaining that states differ significantly in their treatment of trade secrets because it is primarily a state law matter).

124. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(iv), at 7-11.

125. *See* STUCKEY, *supra* note 28, § 7.02(1)(a)(vi), at 7-14; Henri's Food Prod. Co. v. Kraft, Inc., 717 F.2d 352, 359 (7th Cir. 1983); E.I. Dupont de Nemours & Co. v. Yoshida Int'l, Inc., 393 F. Supp. at 510 n.4. *See also supra* text accompanying notes 45 and 53.

126. *See* FED. R. CIV. P. 9(b).

127. *See* 3 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 23.01(6) (3d ed. 1992).

128. *See* New Kids on the Block v. News Am. Publ'g, Inc., 971 F.2d 302, 308 (9th Cir. 1992).

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prices in the marketplace is enhanced, not hindered. Therefore, since the defendant's intent cannot be determined by the mere use of another's trademark in a meta tag, an action for trademark infringement should be denied.

C. Strong Public Policy Considerations Preclude the Recognition of an Action of Trademark Infringement When a Third Person Incorporates the Holder's Trademark in a Meta Tag

Public policy considerations concerning the Internet and its continuing development should be taken into account when determining whether liability should ensue for the unauthorized use of a registered mark in a meta tag. Several adverse repercussions would probably result if this particular trademark infringement action were further recognized as viable.

First, search engine owners might elect to discontinue using meta tags in indexing and cataloging web pages in order to avoid possible court-ordered disclosure of proprietary algorithms or contributory infringement actions.[129] As a consequence, web site developers would no longer be able to take advantage of the benefits associated with providing descriptive information such as keywords in their web pages, which in turn helps facilitate and enhance the entire search process. Furthermore, web browser developers might choose to remove the function which allows users to view the web page source documents in order to prevent this function from being used as an instrument to enable lawsuits or to prevent itself from being named as a party in a contributory infringement action.[130] Consequently, web page developers would no longer be able to learn from their peers by viewing the other developer's HTML tags and commands.[131]

> But, where the defendant uses a trademark to describe the plaintiff's product, rather than its own, we hold that a commercial user is entitled to a nominative fair use defense provided he meets the following three requirements: First, the product or service in question must be one not readily identifiable without use of the trademark; second, only so much of the mark or marks may be used as is reasonably necessary to identify the product or service; and third, the user must do nothing that would, in conjunction with the mark, suggest sponsorship or endorsement by the trademark holder.

Id. (citation omitted). For example, a search engine query using the registered trademark, "Disneyland," might return, as part of a query result, the web pages of travel agencies who plan vacations to Disneyland. Therefore, in this example, each travel agency's web page that was returned would have a meta tag with the keyword, "Disneyland," contained therein.

129. *See supra* Part I.B.4.

130. Similar web browser functionality could also be placed in peril. For example, web browser developers may elect to remove the capability of a user to download web pages since the underlying web source documents can be readily viewed with supplemental software programs.

131. *See, e.g.,* Richard Johnson, *Elements of HTML: A Small Set of Examples* (visited Feb. 27, 1998) <http://www.wolfenet.com/~richj/elements.html>.

The current protections afforded under the Lanham Act should not be extended by the courts to provide protection to unexposed trademarks in meta tags. Expansion of the Act to protect against the use of another's trademark in a meta tag could stifle other developmental efforts in the software community.[132] Furthermore, if the Lanham Act's protections were extended to the use of trademarks in meta tags, there would be no logical reason why it could not be extended to other identifying indicia. The Act could then be construed as extending protection to other tags in machine-readable computer code or web page source documents that also cannot be seen by the general public. Consequently, the "door would be opened," and a variety of other infringement lawsuits based on the use of another's trademark in other types or formats of machine-readable computer code would be allowed.

Recognition of this action could also stifle the development of innovative search engine technology that could possibly resolve these issues before they occur via automation rather than through court enforcement. The ability of a search engine to identify appropriate web pages is a measure of the search engine's usefulness or effectiveness. This measure should be enhanced by the implementation of new computing technology by the engineering and scientific community, not through the questionable extension and application of old law by the legal community.

Allowing this type of action could also lead to the creation of new technological markets that might actually harm the continuing development of the Internet as a viable communication medium. For example, search technology could be developed to "hunt" for trademark infringement lawsuits based on the information included in meta tags. Consequently, an author's use of a particular word in a meta tag could lead to increased exposure to a multitude of trademark infringement actions in a variety of business sectors where this word is part of another's trademark. The Internet is a remarkable, history-changing information system that is still in its infancy and rapidly growing, both in size and functionality. As a result, areas may be found where someone might allege that others are attempting to gain a temporary advantage by exploiting temporary technological "holes" in the fabric of the system. However, "plugging" these "holes" is best left to software engineers and computer scientists when no apparent harm to anyone has resulted.

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132. Software could be developed to decrease the likelihood of causing confusion by examining the keywords in a meta tag, checking them against a database of registered trademarks, and then denying usage of those marks which are protected.

CONCLUSION

Meta tags are instrumental in assisting searches on the Internet. Allowing incidental trademark usage in meta tags serves not only the web page source creator, but also the general public, and Internet oriented businesses as a whole.

In sum, the inherently concealed nature of a meta tag is the defining characteristic that precludes extending protection to the unexposed trademarks contained therein. Since the viewing public does not readily see the trademark, no confusion or misrepresentation can result. Moreover, the inherently concealed nature of the meta tag prevents a plaintiff from establishing the requisite element of causation. And finally, this characteristic nullifies the intent requirement of a trademark infringement action. Therefore, the argument that trademark infringement is unjustified stems not only from a practical standpoint, but also from the language of the Lanham Act itself.

Public policy dictates that the law surrounding the Internet and its resources should not be unduly restricted in its early stages of development. Clearly, if the general public in their expertise with search engines and meta tags ever reaches the confusion threshold envisioned by Congress, the legislature will take appropriate measures to protect the trademark holder. It is not up to the judiciary to supplant the legislators' intent and extend the law. Finally, bogging down the courts in complex evidentiary hearings for trivial lawsuits is a scenario that should be avoided. Returning to Charlie Marker's suit against John Developer and his sports news information service, the court should properly issue the following holding: "Sorry, Charlie!"

Michael R. Sees