

US Law on Keyword Advertising & Domain Names

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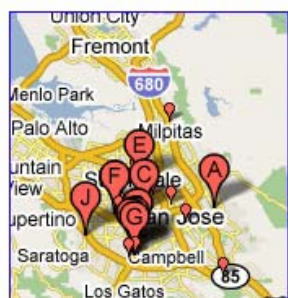
One of the print ads for the E-Class Series, which was last ...

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[2009 Mercedes](#)

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Keyword Advertising Law Overview

- TM Owner v. Search Engine
 - Currently 5 pending lawsuits against Google + Rosetta Stone appeal
 - Rosetta Stone district court ruling
 - Google gets summary judgment on consumer confusion issue
 - Google protected by functionality defense
 - Google not secondarily liable
 - Google doesn't commit dilution
- TM Owner v. Advertiser
 - Too numerous to count
 - 3 jury findings for advertisers (none for TM owners)
 - Mixed summary judgment rulings on consumer confusion
 - Lawsuits rarely make financial sense
- Search Engine Trademark Policies

Keyword Advertising

- Google's US trademark policy
 - It will not block trademarked keywords
 - It will block ads with TM in ad copy if the TM owner asks, except
 - Descriptive/generic uses
 - Resellers
 - Sellers of components, replacement parts, compatible items
 - “Informational sites”



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[Enterprise Web Based Job Scheduling Software-ActiveBatch Web Server](#) 🔍

Web Based Scheduling for Windows, UNIX, LINUX OpenVMS.

activebatch.com/products/activebatch/web.asp - Cached

[ActiveBatch Version 7 Released -- Enterprise Systems](#) 🔍

Feb 24, 2009 ... Updates include expanded jobs libraries, SOA capabilities and power-saving features.

esj.com/articles/2009/02/.../activebatch-version-7-released.aspx - Cached - Similar

[ActiveBatch® Supports Growing Use of Microsoft System Center Via ...](#) 🔍

Mar 15, 2011 ... MORRISTOWN, N.J., March 15, 2011 /PRNewswire/ -- In a move to bring even greater efficiency to Microsoft's System Center server/desktop ...

biz.yahoo.com › All Y! Services - Cached

[ActiveBatch 7 puts Web services into workflows - SD Times ...](#) 🔍

Feb 24, 2009 ... For Web developers using **ActiveBatch**, the inclusion of a library of WSDLs allows them to build workflows across applications by using ...

www.sdtimes.com › LATEST NEWS - Cached - Similar

[ActiveBatch deftly juggles Windows jobs | Platforms - InfoWorld](#) 🔍

Nov 7, 2005 ... Complex yet sophisticated, **ActiveBatch** empowers admins to easily manage and automate jobs.

March 17, 2011

Network Automation

- Initial Interest Confusion
 - Brookfield: “when the defendant uses the plaintiff’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”
 - Network Automation: “when we examine initial interest confusion, the owner of the mark must demonstrate likely confusion, not mere diversion”
- Likelihood of Consumer Confusion factors
 - “consumers searching for [ActiveBatch] are presumably looking for its specific product, and not a category of goods”
 - Most relevant factors in this case:
 - Mark strength
 - Actual confusion
 - Purchaser care
 - “labeling and appearance of the advertisements and the surrounding context on the screen displaying the results page”

Metatags

- Title tags = rarely litigated
- Description metatags = treated like ad copy
- Keyword metatags
 - Search engines don't honor (mostly)
 - If courts assume otherwise, treated as per se infringement

Domain Name-Specific Regulation (US)



- Federal Laws
 - Anti-Cybersquatting Consumer Protection Act
 - Trademark protection (15 USC § 1125(d)(1))
 - In rem jurisdiction (15 USC § 1125(d)(2))
 - Personal name protection (15 USC § 8131)
 - Domain name registrar/registry immunization (15 USC § 1114(2)(D))
 - Fraudulent Online Identity Sanctions Act
 - Enhanced IP remedies (15 USC § 1117(e); 17 USC § 504(c)(3); 18 USC § 3559)
 - Truth in Domain Names Act (18 USC § 2252B)
 - Misleading domain names leading to obscenity/porn
 - Dot Kids Implementation and Efficiency Act of 2002
 - Proposed: Combating Online Infringement and Counterfeits Act (COICA)
- State Laws (selected)
 - State anti-cybersquatting laws (including CA, HI, LA, NY, UT)
 - State anti-political cyberfraud law (CA Elec. Code §18320-23)
 - State anti-spam/anti-phishing laws
 - Sex offender registrations (tied to violations of 18 USC § 2252B) (including IA, MD)
 - Proposed: NY S953 restricting domain name sales to terrorists
- Private regulations
 - Ex ante: allocation controlled by centralized bodies with complex governance structures
 - Ex post: UDRP

Domain Name Protection



- ACPA prima facie case (15 USC §1125(d))
 - D registers, traffics in or uses domain name
 - Identical/confusingly similar to distinctive TM
 - Dilutes a famous TM
 - Bad faith intent to profit
- Remedies
 - Cancel or transfer registration
 - Damages <\$100,000
 - Attorneys' fees
- In practice
 - Rarely see “true” cybersquatting cases
 - Courts are skeptical of domaining
 - Secondary liability for privacy proxy services?

Domain Name Protection



- UDRP prima facie case
 - Domain name identical/confusingly similar to TM
 - No legitimate interests in domain name
 - Bad faith use/registration
- Remedies: cancel/transfer registration

Domain Name Protection



- ACPA Advantages
 - More remedies
 - Final resolution
 - Easy if you're already in court
- UDRP Advantages
 - Fast
 - Cheap
 - Pro-plaintiff
 - No jurisdictional problems