Keyword Law

Prof. Eric Goldman
Director, High Tech Law Institute
http://www.ericgoldman.org • http://hightechlaw.scu.edu
egoldman@gmail.com
Keyword Law

- **Prima facie TM infringement case**
  - Ownership of valid trademark
  - Priority
  - Use in commerce in connection with sale of goods/services
    - Use in “commerce” = “all commerce which may lawfully be regulated by Congress”
    - “Use in commerce” = “bona fide use of a mark in the ordinary course of trade”
  - Likelihood of consumer confusion
    - Wentworth: SJ for defendant based on keyword triggering
    - Storus: SJ for plaintiff based on TM in ad copy

- **State legislation**
  - Utah Spyware Control Act
  - Alaska SB 140
  - Utah Trademark Protection Act (repealed)
Best Practices

- If you’re a trademark owner
  - Don’t be duplicitous
  - Use search engine complaint procedures
  - Typical litigation costs > value of “diverted” consumers
    - 800-JR Cigar: defendant had gross revenues of $345
    - Storus: defendant got 1,347 clicks in 11 months

- If you’re an advertiser
  - Beware prisoners’ dilemma/arms race
  - Don’t reference competitor’s trademark in ad copy
  - If broad matching, consider using negative keywords