

Santa Clara University

Keyword Law

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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 - Utah Trademark Protection Act (repealed)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