

# quinn emanuel trial lawyers

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## Internet Litigation Update

**Purchase of Trademarked Term for Key Word Advertising Held Not Actionable:** The District of Utah recently held that the purchase of a trademarked term for use as a key word advertising trigger on an Internet search engine was a use in commerce within the meaning of the federal Lanham Act. Nevertheless, the defendant was granted partial summary judgment because the plaintiff was unable to establish a likelihood of confusion.

The court concluded that a use that serves only to trigger advertising is nonetheless a “use” of a mark contemplated by the Lanham Act. “The Lanham Act does not require use *and* display of another’s mark for it to constitute ‘use in commerce,’” the court concluded. Even so, the plaintiff’s claim was held barred to the extent it relied on such uses of the plaintiff’s mark. The court reasoned that any “likelihood of confusion” analysis must determine whether consumers *viewing* a mark would make an improper mental association with the plaintiff or be confused as to the origin or sponsorship of the defendant’s goods or services. It then concluded that only a *visible* mark could generate such confusion.

In so holding, the court criticized the widely cited opinion in *Brookfield Communications Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036 (9th Cir. 1999). In *Brookfield*, the Ninth Circuit concluded that the defendant improperly benefited from the goodwill associated with the plaintiff’s mark when Internet users were attracted to the defendant’s Web site through the use of an invisible metatag. The Utah court criticized *Brookfield* as reflecting a misunderstanding of the mechanics of search engines. It held that activities that cause competing products to appear in search results for a mark merely expand a consumer’s options but do not divert the consumer from one product to another. See *1-800 Contacts Inc. v. Lens.com Inc.*, No. 2:07-cv-00591-CW-DN (D. Utah Dec. 14, 2010).