

MAKING YOUR MARK ON GOOGLE

I. INTRODUCTION

Google is the most popular Internet search engine in the United States,¹ so much so that it has entered the lexicon as a synonym for web searching.² Yet companies cannot live on popularity alone; Google relies on advertising for the vast majority of its revenues³ and where money is, lawsuits follow. Google's most recent round of litigation involves trademark disputes over its sale of "sponsored links," or promises to display pointers to web sites or other advertisements when an Internet user searches for specified keywords. For example, a store offering running shoes might buy the terms "tennis shoes" or "jogging," and users entering either of those terms into Google's search engine will receive links to that store. If the merchant also purchased a trademarked keyword like "Nike," however, Google could face a trademark infringement suit.⁴ A number of trademark holders have indeed sued Google both in the United States and abroad as a result of "adword" sales.⁵ In December 2004, the Eastern District of Virginia issued the most recent decision in such a suit, granting in part Google's motion for judgment as a matter of law against the plaintiff, Government Employees Insurance Company ("GEICO").⁶

This Comment examines *GEICO* and analogous lawsuits from both the domestic and the international perspective. Part II begins by explaining the basic idea behind trademark protection and surveying

1. See Danny Sullivan, *Nielsen NetRatings Search Engine Ratings*, SEARCH ENGINE WATCH (Feb. 11, 2005), at <http://searchenginewatch.com/reports/article.php/2156451>.

2. See Wikipedia, Google (verb), at [http://en.wikipedia.org/wiki/Google_\(verb\)](http://en.wikipedia.org/wiki/Google_(verb)) (last visited Apr. 12, 2005) (defining the verb "google" as "a neologism meaning 'to perform a web search'"). The Wikipedia entry also notes that this widespread usage of "google" as a verb can dilute the value of the trademark — even kill it completely — if use of the word becomes too generic. See *id.* Google has accordingly issued a cease and desist letter to the creator of a website that tracks neologisms. *Id.*

3. For the first three quarters of 2004, Google derived at least 97 percent of its revenues from advertising. See Google, Inc., Form 10-Q, SEC File No. 000-50726, at 19 (Sept. 30, 2004), available at http://www.sec.gov/Archives/edgar/data/1288776/000119312504197540/d10q.htm#tx90561_6.

4. There is no indication that Nike plans to bring a trademark infringement claim against Google for the sale of advertising keywords. It simply offers a more vivid example than any of the marks belonging to parties that have actually filed suit. See *infra* notes 16–19 and accompanying text.

5. See *infra* notes 16–20, 31–38, and accompanying text; see also Links & Law, Google's Ad Words Under Attack — Overview Over the Pending Lawsuits, at <http://www.linksandlaw.com/adwords-pendinglawsuits.htm> (last visited Apr. 12, 2005) (providing a fairly comprehensive listing of past or pending lawsuits against Google with some links to related articles and other resources).

6. Gov't Employees Ins. Co. v. Google, Inc., No. 04-507 (E.D. Va. Dec. 15, 2004). See *infra* notes 27–30 and accompanying text.

the various adword suits that mark holders have brought against Google in America and abroad. Part III outlines domestic trademark law and contrasts *GEICO* with other cases in order to demonstrate the incoherencies and inconsistencies that have developed as courts struggle to adapt the law to the Internet. Part IV examines existing international agreements relating to trademark law, then discusses conflicting international rulings against Google to illustrate how the current framework is inadequate to deal with the unique transborder issues that Internet search engines create. Part V concludes by suggesting that adword infringement suits should primarily target advertisement purchasers on a direct infringement theory; search engines themselves should be at most a secondary focus. Such an approach would be more congruent with conventional domestic trademark law and could also solve some of the international issues that arise when the primary infringer lacks clear boundaries.

II. GOOGLE UNDER SIEGE

A. Foundations of Trademark Law

A trademark is an identifying feature of a specific product that serves to distinguish it in the marketplace.⁷ Such a feature can be any of a number of things: a word, name, symbol, slogan, or even package design.⁸ A business that develops a distinctive mark can use it to market its products. Analogously, consumers that come to associate the products of a certain business with a particular mark can rely on that mark when making purchasing decisions.⁹ A business can thus enhance sales by developing goodwill for its trademark. However, if a competitor uses the trademark on dissimilar or inferior goods, consumer confusion can result: people will no longer rely on the trademark for their purchasing decisions.¹⁰ By suppressing such infringing attempts, both domestic and international trademark law seek to ensure that producers and consumers are able to benefit from the reliable and accurate association of marks with certain products.¹¹

7. See Int'l Trademark Ass'n, FAQs, at <http://www.inta.org/info/faqsD.html#1> (last visited Apr. 12, 2005).

8. See *id.*

9. Dogan and Lemley argue that the primary rationale of trademark law is to reduce consumer search costs. See Stacey L. Dogan & Mark A. Lemley, *Trademarks and Consumer Search Costs on the Internet*, 41 HOUS. L. REV. 777, 786–801 (2003) (“Rather than having to inquire into the provenance and qualities of every potential purchase, consumers can look to trademarks as shorthand indicators.”).

10. See Dan L. Burk, *Trademark Doctrines for Global Electronic Commerce*, 49 S.C. L. REV. 695, 699–700 (1998).

11. See *id.* at 699; Dogan & Lemley, *supra* note 9, at 787.

In the specific context of search engine providers that face litigation as a result of selling trademarked adwords, the infringement claims generally allege that the sale of the ads will confuse consumers as to the source of the ad, the owner of the website linked to the ad, or the producer of any products on the linked website.¹² On occasion, the trademark suits also include contributory infringement claims.¹³ Although still requiring allegations that a primary infringer has copied or misappropriated the protected trademark, these indirect infringement claims actually target entities that allegedly encourage or induce the primary infringer's actions.¹⁴ For instance, A might supply imitation products to B, which in turn imprints the goods with a third party's trademark and later sells them. B would be guilty of direct infringement, but A could also face liability as a contributory infringer.

Despite the compelling reasons for protecting trademarks by targeting unauthorized users, there are several drawbacks. Particularly in the context of search engines, overly-broad trademark protection might stifle legitimate commerce and afford owners of marks unwarranted power to block consumers from obtaining comparative information about products.¹⁵

B. Google at Home

Although Google currently faces adword suits from Rescuecom¹⁶ and American Blind & Wallpaper Factory,¹⁷ the only written opinion involving such a case stems from a complaint that GEICO filed against Google and Overture Services¹⁸ in May 2004.¹⁹ GEICO alleged that the defendants were responsible for both direct and con-

12. See, e.g., *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 701 (E.D. Va. 2004).

13. See, e.g., *id.* at 704–05.

14. Because this Comment does not consider the intricacies of foreign substantive laws, this overview of indirect infringement draws primarily on standards of American courts. See *infra* Part III. However, the idea of indirect liability as the liability of one for another is intuitive and applicable across disciplines and countries.

15. See Dogan & Lemley, *supra* note 9, at 831–37.

16. See Complaint, *Rescuecom Corp. v. Google, Inc.*, No. 5:04-CV-1055 (N.D.N.Y. filed Sept. 7, 2004), available at <http://www.resourceshelf.com/resvgoogle.pdf>; see also Nat Ives, *A Trademark Infringement Suit Against Google May Alter How the Search Industry Makes a Profit*, N.Y. TIMES, Dec. 13, 2004, at C10.

17. See Ives, *supra* note 16.

18. Overture is a subsidiary of Yahoo!, Inc. that conducts marketing services for online businesses, including sponsored search placements. See Overture, Company Overview (2005), at <http://www.content.overture.com/d/CAm/about/co/engbvision.jhtml> (last visited Apr. 12, 2005).

19. See Matt Hicks, *Google, Overture Trademark Case Moves Forward*, EWEEK.COM (Sept. 3, 2004), at http://www.eweek.com/print_article2/0,2533,a=134767,00.asp.

tributory trademark infringement.²⁰ The direct infringement claims arose out of Google's sale of the plaintiff's trademark as an adword.²¹ GEICO maintained that Google was using the mark in commerce in a way that was likely to confuse consumers.²² The indirect infringement claims likewise sought to hold Google liable for the infringing activities of the purchasers that had used the trademarks in their advertising.²³ These claims turned on Google's alleged ability to control the content of the advertisements.²⁴ In August, the Eastern District of Virginia denied Google's motion to dismiss for failure to state a claim on both GEICO's trademark infringement and contributory trademark infringement claims ("*GEICO I*").²⁵ Overture, Google's co-defendant, settled out of the case in early December.²⁶

Overture's decision may have been unduly hasty. After a bench trial in mid-December, the district court partially granted Google's motion for judgment as a matter of law.²⁷ In an oral ruling ("*GEICO II*"), the judge distinguished between the sale of trademarked words to companies that made use of the marks in their ads and sales to companies that did not.²⁸ Finding insufficient evidence of consumer confusion over "sponsored links" that were triggered by trademarked adwords but did not display the protected mark, the court dismissed direct infringement claims against Google that were based solely on the selling of trademarked adwords.²⁹ However, the court reserved the question of Google's contributory liability for the actions of those who bought the adwords and used them to trigger ads containing the trademarked term.³⁰

20. See *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 701 (E.D. Va. 2004).

21. See *id.* at 702.

22. See *id.* at 703.

23. See *id.* at 704.

24. See *id.*

25. See *id.* at 704–05. The Court granted Google's motion to dismiss on the plaintiff's state law claims for tortious interference with prospective business advantage and statutory business conspiracy, but as explained above in note 14, this Comment is solely concerned with the trademark claims. See *id.* at 706.

26. See Stefanie Olsen, *Overture, GEICO Settle Trademark Dispute*, CNET NEWS.COM (Dec. 1, 2004), at http://news.com.com/Overture,+Geico+settle+trademark+dispute/2100-1030_3-5473231.html?tag=nl.

27. *Gov't Employees Ins. Co. v. Google, Inc.*, No. 04-507 (E.D. Va. Dec. 15, 2004); see also Dee McAree, *Key Battle Over Search Engine Fees is Not Over*, NAT'L L.J., Feb. 7, 2005, at 6; Martin Samson, *Government Employees Insurance Company v. Google, Inc.*, Phillips Nizer LLP Internet Library, at http://www.phillipsnizer.com/library/cases/lib_case360.cfm (last visited Apr. 12, 2005). While a written memorandum decision is forthcoming, an April 12, 2005 PACER search indicates that the court has not yet released it.

28. See *id.*

29. See McAree, *supra* note 27; Samson, *supra* note 27.

30. See McAree, *supra* note 27; Samson, *supra* note 27.

C. Google Abroad

Google has also fought adword trademark suits in Germany and France with differing results. All of the cases involved the same basic situation as *GEICO*: a trademark holder suing Google for selling trademarked adwords to a competitor.

In Germany, Google successfully defeated suits brought by Metaspinner Media³¹ as well as Nemetschek, a software company.³² The latter decision, finding that Google's advertisers are responsible for the key words that they purchase, appears particularly favorable to search engines.³³

French courts seem considerably more hostile. On February 4, 2005, the Paris lower court found in favor of Louis Vuitton in its suit against Google for trademark counterfeiting, unfair competition, and misleading advertising.³⁴ In a prior suit against Google for preliminary relief, a French court found for hotel chain Le Meridien.³⁵ Google also lost a pair of cases that two French travel firms, Viaticum and Lucetiel, filed in 2003.³⁶ Google is still facing a suit brought by AXA, the world's third largest insurer.³⁷ Given the earlier decisions and the broad definition of infringement that French courts have adopted,³⁸ Google stands in a difficult position.

III. DOMESTIC TRADEMARK LAW IN CYBERSPACE

A. Statutory And Judicial Bases For Trademark Claims

Liability for direct trademark infringement is governed by Section 32 of the Lanham Act.³⁹ There are two provisions, only the first of which is relevant to these cases:

31. Metaspinner filed suit in response to Google's sale of ads triggered by searches for "Preispiraten" ("Price Pirate") comparison-shopping software. A regional court in Hamburg dismissed the case. See Associated Press, *German Court Nixes Lawsuit Against Google*, E^WEEK (Sept. 21, 2004), at <http://www.eweek.com/article2/0,1759,1649054,00.asp>.

32. See Links & Law, *supra* note 5; Nemetschek, at <http://www.nemetschek.com> (last visited Apr. 12, 2005).

33. See Links & Law, *supra* note 5.

34. See Matthew Broersma, *Ruling Against Google Could Bring Dire Consequences*, E^WEEK (Feb. 14, 2005), at <http://www.eweek.com/article2/0,1759,1764678,00.asp>.

35. See Broersma, *supra* note 34; Stephanie Olsen, *Google Loses Trademark Dispute in France*, CNET NEWS (Jan. 20, 2005), at http://news.com.com/Google+loses+trademark+case+in+France/2100-1030_35564118.html. For excerpts of the order translated by Emanuela Catichi, see Juriscom.net, Nanterre Court (TGI) Emergency Order, Hotel Meridien v. Google (Dec. 16, 2004), at <http://www.juriscom.net/jpt/visu.php?ID=631>.

36. See *id.*

37. See *id.*

38. See *infra* note 83.

39. 15 U.S.C. § 1114 (2000).

Any person who shall, without the consent of the registrant . . . 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 deceive⁴⁰

Thus, after proving a protectible trademark, a plaintiff must prove “use in commerce” that is “likely to cause confusion.”

The standard for contributory trademark infringement is currently described by *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*⁴¹ A manufacturer or distributor can be held liable for the actions of others if it (1) “intentionally induces another to infringe a trademark” or (2) “continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement.”⁴² The prototypical contributory trademark infringer manufactures counterfeit goods that another party sells.⁴³ In *Lockheed Martin Corp. v. Network Solutions, Inc.*, the Ninth Circuit specified that the *Inwood* standard applied only to goods and not to services.⁴⁴ Concluding that the defendant, a registrar of Internet domain names, provided a routing service rather than a good, the court declined to hold the defendant liable.⁴⁵ Thus, direct and contributory infringement claims are distinct inquiries, requiring different means of proof. Indeed, the *GEICO II* court ruled on one and not the other.⁴⁶

B. Comparable Contemporary Cases

Although one might conclude from the various attacks against Google that comparable cases are ubiquitous, there is little existing relevant precedent against which to measure *GEICO*. Cases involving other kinds of triggered advertising supply the most natural analogies. Unfortunately, the courts have not applied trademark law consistently to comparable facts.

40. *Id.* § 1114(1)(a).

41. 456 U.S. 844 (1982).

42. *Id.* at 854.

43. *See, e.g., id.* (concerning a pharmaceutical firm’s suit against a manufacturer that produced a look-alike capsule and also facilitated and encouraged the illegal substitution or mislabeling of the generic capsule for the trademarked drug).

44. 194 F.3d 980, 984–85 (9th Cir. 1999).

45. *Id.*

46. *See* Sampson, *supra* note 27.

One of the cases most similar to *GEICO* is *Playboy Enterprises, Inc. v. Netscape Communications Corp.*⁴⁷ Playboy sued Netscape and Excite for “keying,” or linking, banner advertisements to trademarked Playboy terms⁴⁸ — essentially the same scenario involved in *GEICO*. The district court granted the defendants summary judgment on the trademark claims,⁴⁹ but the Ninth Circuit reversed.⁵⁰ After concluding that “Playboy” and “Playmate” were trademarks in use in commerce, the court decided that plaintiffs had presented sufficient evidence to create a genuine issue of material fact about consumer confusion and mark dilution.⁵¹

Several cases concerning pop-up ads also supply potential analogies, but the outcomes were strikingly inconsistent. In *U-Haul International, Inc. v. WhenU.com, Inc.*⁵² and *Wells Fargo & Co. v. WhenU.com*,⁵³ district courts granted summary judgment to WhenU.com on the plaintiffs’ trademark claims after concluding that the defendant’s use of the protected terms to trigger pop-up ads was not “use in commerce.”⁵⁴ In *U-Haul*, the court concluded that neither displaying the ads over the genuine webpage of the trademark holder nor including the trademark holder’s URL in the directory governing the pop-up ads constituted use in commerce.⁵⁵ A third district court, however, denied summary judgment to WhenU.com in a case that involved essentially identical facts.⁵⁶ It concluded that the appearance of pop-up ads alongside the genuine webpage of the trademark holder and the inclusion of the trademark holder’s URL in the defendant’s directory did satisfy the use-in-commerce requirement.⁵⁷

C. Analysis

Despite the differences in outcome, one cannot simply conclude that the relevant law is in shambles. The apparent tension between the latest *GEICO* ruling and *Playboy Enterprises*, for example, conceivably reflects factual distinctions. The ruling in *GEICO II* turned largely on deficiencies in the survey evidence that the plaintiff offered to

47. 354 F.3d 1020 (9th Cir. 2004).

48. *See id.* at 1022–23.

49. *Playboy Enter., Inc. v. Netscape Communications Corp.*, Nos. 99-320 & 99-321, 2000 WL 1308815 (C.D. Cal. Sept. 13, 2000).

50. *Playboy Enter.*, 354 F.3d at 1022.

51. *See id.* at 1034.

52. 279 F. Supp. 2d 723 (E.D. Va. 2003).

53. 293 F. Supp. 2d 734 (E.D. Mich. 2003).

54. *Id.* at 759–64; *U-Haul Int’l*, 279 F. Supp. 2d at 727.

55. *Id.* at 727–29.

56. *See 1-800-Contacts, Inc. v. WhenU.com*, 309 F. Supp. 2d 467 (S.D.N.Y. 2003).

57. *Id.* at 489.

show consumer confusion,⁵⁸ while *GEICO I* relied upon *Playboy Enterprises* to find that Google was making use of the plaintiff's trademark "in commerce."⁵⁹ Courts could agree that the same process of keyword-linked advertising is "use in commerce" but differ on whether or not consumers are more or less susceptible to confusion regarding the specific trademark at issue. The appellate courts could resolve the *WhenU.com* cases. Indeed, the circuits might take note that courts hearing trademark infringement claims concerning the use of metatags⁶⁰ have been fairly consistent in assuming "use in commerce" after the Ninth Circuit implicitly did so in *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*⁶¹

However, metatag suits are distinguishable because the plaintiffs are normally suing bona fide competitors that are directly making use of the plaintiff's mark. Search engines are instead essentially intermediaries between the plaintiff that owns the trademark and the competitor that is actually specifying the keyword to buy.⁶² Ads differ from traditional goods in that they are not tangible, fixed, or otherwise predetermined; the purchaser instead designates or creates the adword independently.⁶³ Courts should not treat a search engine's use of a trademark in an ad as if it were equivalent to a competitor's use of a trademark in an ad, for the simple reason that the search engine's use is likely inadvertent.⁶⁴ It is under this lens that the *Playboy* court's

58. See Samson, *supra* note 27.

59. See *Gov't Employees Ins. Co. v. Google, Inc.*, 330 F. Supp. 2d 700, 703–04 (E.D. Va. 2004).

60. Metatags are "invisible text within Websites that are used by search engines for indexing." *Id.* at 703.

61. 174 F.3d 1036, 1062–67 (9th Cir. 1999) (reversing the trial court's judgment and holding that the plaintiff was entitled to a preliminary injunction precluding the defendant from using the plaintiff's trademark as a metatag). Subsequent cases have assumed metatags to be use in commerce before delving into the more fact specific inquiry regarding consumer confusion. See, e.g., *N.Y. Soc'y of Certified Pub. Accountants v. Eric Louis Assocs., Inc.*, 79 F. Supp. 2d 331, 339–40 (S.D.N.Y. 1999) (assuming use of plaintiff's domain name and metatag was commercial and in turn finding a likelihood of consumer confusion).

62. Google's arguably passive role in the choice and use of trademarked adwords also raises the possibility of a "safe harbor" defense akin to that in the Digital Millennium Copyright Act ("DMCA"), which exempts innocent Internet service providers from monetary damages for copyright infringement if they meet certain conditions. See 17 U.S.C. § 512 (2000). However, the fact that Google refuses to remove trademarked keywords from its database even in the face of a direct challenge from a party that holds American or Canadian rights to the mark, see *infra* text accompanying notes 86–87, makes such a solution unlikely.

63. Cf. Ian C. Ballon, *Pinning the Blame in Cyberspace: Towards a Coherent Theory for Imposing Vicarious Copyright, Trademark, and Tort Liability for Conduct Occurring over the Internet*, 18 HASTINGS COMM. & ENT. L.J. 729, 762 (1999) ("Because so much of what happens online is automatic — based on operating software and established protocols — direct copyright and trademark liability should not be imposed on an access or content provider unless there is some element of volition or causation present.").

64. The Lanham Act provides for an "innocent infringer" defense:

Where the infringement or violation complained of is contained in or is part of paid advertising matter in a newspaper, magazine, or other

analysis seems inchoate, possibly explaining why there is a lack of agreement among other courts.

Furthermore, the *Playboy* court made its summary judgment ruling without actually deciding whether the defendants were liable as direct infringers or merely as contributors, reasoning instead that the parties “are potentially liable under one theory and that we need not decide which one.”⁶⁵ Although this seems superficially plausible — there was infringement, the rest will be decided at trial — the doctrines of direct and contributory liability in trademark law are distinct inquiries,⁶⁶ and require separate analyses.

Thus, the *Playboy* court’s conflation of direct and contributory infringement seems to be an admission that its main concern is with some notion of law as justice rather than doctrine.⁶⁷ The court seems driven primarily by the idea that linking ads to Playboy’s trademark “impermissibly capitalizes on the goodwill associated with a mark.”⁶⁸ Although the law does seek to ensure that businesses can reap the rewards of their investments in developing goodwill associated with trademarks,⁶⁹ the governing statute does not mention goodwill at all and instead focuses on consumer confusion.⁷⁰ Such a split between

similar periodical or in an electronic communication as defined in section 2510(12) of Title 18, the remedies of the owner of the right infringed or person bringing the action under section 1125(a) of this title as against the publisher or distributor of such newspaper, magazine, or other similar periodical or electronic communication shall be limited to an injunction against the presentation of such advertising matter in future issues of such newspapers, magazines, or other similar periodicals or in future transmissions of such electronic communications. The limitations of this subparagraph shall apply only to innocent infringers and innocent violators.

15 U.S.C. § 1114(2)(B) (2000). Thus, publishers of advertisements have been protected from damage liability. *See, e.g.,* Polo Fashions, Inc. v. Ontario Printers, Inc., 601 F. Supp. 402 (N.D. Ohio 1984). A 1988 amendment added protection for advertisements “in an electronic communication.” Pub. L. No. 100-667, § 127, 102 Stat. 3935 (1988). This should include search engines. *Cf. Hendrickson v. eBay, Inc.*, 165 F. Supp. 2d 1082, 1095 (C.D. Cal. 2001) (applying innocent infringer defense to eBay, an online auction site). Granted, none of the advertising cases discussed in this Comment have considered an innocent infringer defense, and search engines might have difficulty meeting the requirements for innocence — especially if they are notified by the trademark holder. This statutory provision nevertheless suggests a plausible distinction between the actions of a company actively choosing to purchase a trademarked keyword and the actions of a search engine running an automatic algorithm.

65. *Playboy Enter., Inc. v. Netscape Communications Corp.*, 354 F.3d 1020, 1024 (9th Cir. 2004).

66. *See supra* text accompanying notes 41–46.

67. While nothing in the opinion actually suggests that the defendants could face an adverse final judgment without a definitive resolution of the question, the concepts are sufficiently distinct that courts need to distinguish them even when reviewing the viability of claims.

68. *Playboy Enter.*, 354 F.3d at 1025.

69. *See* Dogan & Lemley, *supra* note 9, at 837–38.

70. *See* 15 U.S.C. § 1114(1) (2000).

carrying out equitable justice and enforcing the law might also explain the differences between the factually indistinguishable WhenU.com cases.⁷¹

IV. GOOGLE ABROAD

A. International Coordination of Trademark Law

There are a number of international agreements designed to coordinate trademark registration and protection in different countries, including The Paris Convention, The Madrid Agreement and Protocol, the Trademark Law Treaty, and the World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights ("TRIPS").⁷²

The Paris Convention, administered by the World Intellectual Property Organization ("WIPO"), applies to all industrial property — including trademarks. It is a basic non-discrimination agreement with a territoriality principle: a nation cannot treat outsiders in a different manner than its own citizens, and a nation's law extends only as far as its borders.⁷³ The Paris Convention requires that signatories provide some minimum level of protection to trademark rights, but is not itself substantive law.⁷⁴

The Madrid Agreement and Protocol are also administered by WIPO, but they mainly deal with administrative concerns. Whereas the Paris Convention provides for some minimal level of protection across countries, the Madrid Agreement and Protocol establish means for securing such protection. They serve as a "mechanism for facilitat-

71. Dogan and Lemley argued that the courts have impermissibly expanded trademark law in these keyword-linked online advertising cases in an effort to address equitable concerns about unjust enrichment from capitalizing on another's accumulated goodwill. *See* Dogan & Lemley, *supra* note 9, at 837–38. They claim that "competitors have an affirmative right to use others' trademarks to capture public attention and attempt to divert it to their own products" provided that "they do not mislead people into presuming some kind of affiliation between themselves and the trademark holder." *Id.* at 796.

72. *See* Paris Convention for the Protection of Industrial Property, July 14, 1967, 21 U.S.T. 1583, 828 U.N.T.S. 305 [hereinafter Paris Convention]; Madrid Agreement Concerning the International Registration of Marks, Apr. 14, 1891, 828 U.N.T.S. 389; Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted June 27, 1989, WIPO Pub. No. 204(E) [hereinafter Madrid Protocol]; Trademark Law Treaty, Oct. 27, 1994, 34 INDUS. PROP. L. & TREATIES 3-010, 001 (Jan. 1995); Annex 1C, LEGAL INSTRUMENTS — RESULTS OF THE URUGUAY ROUND vol. 31, 33 I.L.M. 81 (1994) [hereinafter TRIPS Agreement].

73. *See* 4 J. THOMAS MCCARTHY, TRADEMARKS AND UNFAIR COMPETITION § 29:25 (4th ed. 2004) ("The Paris convention is essentially a compact between the various member nations to accord in their own countries to citizens of the other member nations trademark and other rights comparable to those accorded their own citizens by their domestic law."); WIPO, Summary of the Paris Convention for the Protection of Industrial Property (1883), at http://www.wipo.int/treaties/en/ip/paris/summary_paris.html (last visited Apr. 12, 2005).

74. *See* 4 MCCARTHY, *supra* note 73, § 29:25.

ing the registration of a mark in several nations”⁷⁵ by reducing the administrative burden and thereby decreasing paperwork as well as expense.⁷⁶ Thus, the Madrid Agreement and Protocol create no rights and provide no substantive rules.

Similarly, the Trademark Law Treaty (“TLT”), another WIPO agreement, concerns administration alone. It standardizes forms for trademark applications, changes, and renewals.⁷⁷ For example, the TLT lays out the maximum required indications in an application for trademark: a contracting party cannot require more than “a request, the name and address and other indications concerning the applicant and his representative; various indications concerning the mark including a certain number of representations of the mark; the goods and services together with the relevant classification; and a declaration of intention to use the mark.”⁷⁸

While the TRIPS agreement differs from the prior three in that the World Trade Organization (“WTO”) rather than WIPO administers it, the agreement does incorporate several of the WIPO treaties by reference.⁷⁹ It sets out minimum standards, requirements for enforcement, and relies on the WTO’s dispute settlement procedures for adjudicating disagreements about obligations.⁸⁰

B. International Conflicts of Trademark Law

Trademark law, like many other areas of the law, is territorially constrained. The registration of a mark in France is only valid in France (although the above-discussed treaties make it easier to apply a registration across nations), and a finding of infringement in France, absent special considerations, is only binding therein.⁸¹ Although treaties and agreements govern certain aspects of international trademark law, the major agreements have nonetheless left the determination of substantive law largely in the hands of individual countries.⁸² Thus, different countries can and do operate under different substan-

75. See WIPO, Summary of the Madrid Agreement Concerning the International Registration of Marks (1891) and the Protocol Relating to that Agreement (1989), at http://www.wipo.int/treaties/en/registration/madrid_protocol/summary_madrid.html (last visited Apr. 12, 2005); 4 MCCARTHY, *supra* note 73, § 29:32.

76. See 4 MCCARTHY, *supra* note 73, § 29:32.

77. See WIPO, Summary of the Trademark Law Treaty (TLT) (1994), at http://www.wipo.int/treaties/en/ip/tlt/summary_tlt.html (last visited Apr. 12, 2005).

78. *Id.*

79. See WTO, Overview: The TRIPS Agreement, at http://www.wto.org/english/tratop_e/trips_e/intel2_e.htm (last visited Apr. 12, 2005).

80. See *id.*

81. See, e.g., *Fuji Photo Film Co. v. Shinohara Shoji Kabushiki Kaisha*, 754 F.2d 591, 599 (5th Cir. 1985) (“The concept of territoriality is basic to trademark law; trademark rights exist in each country solely according to that country’s statutory scheme.”).

82. See *supra* Part IV.A.

tive laws that may not have transborder applicability. Even if every country operated under the same statute, there would be no guarantee that courts in each country would interpret the law the same way. Such differences have left Google facing seemingly contradictory decisions regarding liability.⁸³ This is potentially quite problematic for the company.⁸⁴

For most companies, the possibility that trademark law might be construed differently in different countries poses no substantial burden on an infringer because its transactions are probably geographically limited. Thus, responsible parties will understand that the law applicable to the sale of counterfeit shoes in the United States is U.S. law and the law applicable to the sale of such shoes in France is French law. However, the question of liability for Internet search engines creates more difficult issues because of the fluidity of national boundaries on the Net.⁸⁵ Potential consumers in France, for example, can run searches that might turn up keyword-triggered ads for American companies even though French firms would be unable to take advantage of such marketing strategies. If rulings in the United States continue to favor Google in cases like *GEICO II*, Google could conceivably find itself able to sell keywords in the U.S. or Germany that it could not sell in France or other unfavorable jurisdictions. Already, Google's Trademark Complaint Procedure differentiates between those with trademark rights in the United States or Canada and those with rights in other jurisdictions.⁸⁶ In the former case, Google advises that it "will not disable keywords in response to a trademark complaint."⁸⁷ The same line is conspicuously missing from an otherwise

83. This Comment does not conduct an in-depth analysis of the differences in the statutory regimes of the different countries. Nor does it speculate about the various cultural biases or predilections that might lead to different outcomes even with similar law. Consistent with its greater imposition of liability than either Germany or the United States in comparable trademark cases, France appears to have adopted a broad definition of infringement:

Any person who uses a mark enjoying reputation for goods or services that are not similar to those designated in the registration shall be liable under civil law if such use is likely to cause a prejudice to the owner of the mark or if such use constitutes unjustified exploitation of the mark.

See INTELLECTUAL PROPERTY CODE, art. L713-5 (Fr.) available at http://www.legifrance.gouv.fr/html/codes_traduits/cpiatext.htm#Chapter%20VI:%20Disputes.

84. See Broersma, *supra* note 34.

85. See, e.g., Jenny S. Martinez, *Towards an International Judicial System*, 56 STAN. L. REV. 429, 506-15 (2003) (discussing the Yahoo! case in France and the difficulties of navigating international judicial systems where "the very nature of the worldwide web makes it accessible everywhere" and thus possibly subject to conflicting laws).

86. See Google Inc., Trademark Complaint Procedure, at http://www.google.com/tm_complaint.html (last visited Apr. 12, 2005).

87. *Id.*

largely identical description of policies regarding rights in other countries.⁸⁸

Because of its country specific policies, jurisdictional differences may not pose serious problems for Google,⁸⁹ but they could still prove troublesome elsewhere. If an adword buyer in France can circumvent the trademark decisions of its home courts by purchasing trademarked adwords from www.google.com in the United States and then waiting for French buyers to use the American site, the result undercuts international efforts to ensure protections for mark holders across borders. Louis Vuitton, for instance, would lack any recourse in the event that an American court declined to grant a remedy parallel to the one that the company previously obtained in French court. Such results are perfectly acceptable under the Paris Convention and TRIPS as long as American courts are simply enforcing basic American trademark law and not imposing differential burdens on foreigners.

IV. CONCLUSION

Given that the law in this area is still in its infancy, the courts may yet move on their own toward a satisfactory consensus. For example, as an increasing percentage of the population becomes familiar with the Internet and with search engines, the notion of consumer confusion stemming from the sale of adwords might become ludicrous. Studies demonstrating that only 18 percent of contemporary Web searchers know when a link is paid⁹⁰ seem to support a general finding of consumer confusion whenever a consumer inputs a trademarked term and ends up clicking through to a competitor's website. However, as consumers grow more savvy and become increasingly aware that their searches will turn up sponsored links that are related to — but not necessarily affiliated with — searched-for trademark terms, claims regarding the likelihood of confusion should weaken.

Conversely, the courts' decisions to date may reflect some intuition that the Internet changes the rules of trademark and what it means to be a mark holder — a change in circumstances that might be better

88. *See id.*

89. Google has country-specific platforms and could possibly immunize itself from liability by comporting www.google.fr with French law, for example, and www.google.de with German law, without responsibility for what individual users might see in the course of surfing the web. However, decisions in other areas suggest that strategic territorial division may not be so simple. *See* Stephen Hume, *Long Arm of Libel Laws Chills Free Speech on the Net*, VANCOUVER SUN, Mar. 2, 2005, at A15 (discussing how Australia's high court allowed a libel case against Dow Jones to be maintained in Australia when the story was written and published in the United States, but had been posted to the Internet and read by an Australian in Australia).

90. *See* Survey: Users Confuse Search Results, Ads, BIZREPORT (Jan. 24, 2005), at <http://www.bizreport.com/news/8610/>.

addressed by a legislature. On the one hand, increased Internet traffic might lead to the proliferation of fraudulent sellers or inferior goods.⁹¹ In addition, the Internet reduces search and comparison costs, and consequently may decrease customer loyalty. On these bases, heightened protection of trademarks would be necessary in order to preserve their meaning and thus their ability to promote legitimate commerce. On the other hand, reduced consumer search costs may make trademark law less important in cyberspace. The Internet allows consumers to communicate directly with each other and disseminate great amounts of information that individuals can independently assess.⁹² Thus, rather than rely solely on trademarks as a proxy for value, the consumer could evaluate data on her own. Legislatures are in the best position to assess the efficacy and value of trademark law in the Internet Age. They could, for example, formulate substantive laws that regulate how online advertisement is carried out so as to minimize confusion and decrease consumer diversion. Alternatively, they could create an Internet exception or safe harbor in the trademark context.⁹³

As long as courts are working within the existing context, however, the best solution may be for courts to entertain direct infringement suits only against the purchasers of adwords and find search engines liable, if at all, for contributory infringement.⁹⁴ Domestically, this would comport much better with the statutory and common law regimes. It is hard to rationalize holding Google directly liable for creating consumer confusion through using a trademark in commerce when it merely administers a program through which adword buyers name their own potentially-trademarked keywords, none of which may appear in the ads or sponsored links.⁹⁵ However, the greatest gains from such a clear, bifurcated regime would come internationally. Finding a search engine indirectly liable is necessarily premised on a finding of direct liability. Because the activities of an individual company are likely to be more geographically constrained or at least

91. See Burk, *supra* note 10, at 702–04.

92. See, e.g., ResellerRatings.com, at <http://www.resellerratings.com> (last visited Apr. 12, 2005) (offering a means for users to post and read reviews about stores); Epinions.com, at <http://www.epinions.com/> (last visited Apr. 12, 2005) (allowing users to post and read reviews about products); Ebay, Feedback Forum, at <http://pages.ebay.com/services/forum/feedback.html> (last visited Apr. 12, 2005) (explaining Ebay's system of user ratings, which allows users to evaluate the reliability of unknown buyers and sellers based on others' posted experiences).

93. Compare the safe harbor provisions for ISPs in the DMCA. See *supra* note 62.

94. Although the *GEICO* litigation has not concluded, this treatment of the adword cases seems to be what the Eastern District of Virginia was moving toward in *GEICO II*. See *supra* notes 29–30 and accompanying text.

95. See *supra* Part III; see also Heidi S. Padawer, Note, *Google This: Search Engine Results Weave a Web for Trademark Infringement Actions on the Internet*, 81 WASH. U. L. Q. 1099, 1116–21 (2003) (arguing that a search engine's use of trademarked terms should be found to infringe on a theory of contributory liability and not on a theory of direct liability).

identifiable, it would be more straightforward to determine the parameters of the search engine's enjoinable conduct as it relates to the prohibited conduct of an individual company.⁹⁶

Domestic and international courts may struggle for years to reach a manageable legal consensus regarding the status of search engine liability for the sale of adwords. In the meantime, companies might consider investigating ways to exploit the search engine rather than to litigate against it. Given the potential to reach consumers all over the world, companies should try to get themselves googled.

96. A clearer definition of territorial harm might also allow for the implementation of a technological solution. *See generally* Jonathan Zittrain, *Internet Points of Control*, 44 B.C. L. REV. 653 (2003) (discussing the availability of technology to filter Internet users from specific locations). However, even with such filtering or zoning technology, it would still make sense for a court to find a search engine indirectly rather than directly liable. Because a search engine has international reach, a finding that a search engine is directly liable for the sale of keywords does not answer the question of who is to be restricted. While a French court could certainly enjoin the access of French users to "Louis Vuitton" triggered links, that seems to be a superficial answer to questions of territoriality: Is the harm the sale of the ad to a French company? Is the harm the sale of the ad to any company that might reach French consumers? Did the harm occur in France when the French consumers accessed the ad; did the harm occur in the ethereal space of the Internet when Google sold the ad? On the other hand, if a French court were to find a French company directly liable for the provision of confusing ads to French consumers, it would be sensible to enjoin Google from allowing French consumers to trigger ads with the trademarked keywords.