

Law

Protecting your trademark in the legal Web

By JEREMY HARRELL

The Internet is a confusing place, legally speaking.

Barely a decade old, the World Wide Web is still in many ways the Wild Wild West, and the court system is trying to impose a sense of order. It's best to think of this process as a work in progress.

Take, for example, the growing debate over the use of keywords in Internet advertising. One of the ways Google substantiates its high-flying stock value is to charge advertisers for keyword searches. Type the phrase "Hamptons bed and breakfast" into the search engine, and aside from hundreds of search results matching the input, down the right hand side of the page appear listings from advertisers that have paid good money to have their Web sites and brands associated with the search phrase.

Where it gets interesting is if the keyword is a trademarked

phrase. In some cases, companies have bought the rights to the trademarked keywords of their competitors. To take a recent example from Minnesota: If you submit the phrase "Edina Realty" – the actual name of a real estate brokerage – the first paid advertisement listing on Google belongs to a competitor, TheMLSOnline.com, and its home listings for the lovely Minneapolis suburb of Edina. (Some of Google's search competitors, including Yahoo, have stopped allowing companies to purchase the advertising rights to their competitors' marks).

Two weeks ago, a federal court judge in Minnesota decided to let Edina Realty's trademark infringement and dilution suit against TheMLSOnline.com go to trial, and the outcome could finally bring to a close this particular debate about online trademarks.

Or not, said Keith Weltsch, an associate with Scully, Scott, Murphy & Presser, who used to work in the U.S. Patent and Trademark Office. It turns out the

courts are all over the place on the matter. Two years ago, insurer Geico brought suit against Google for pretty much the same reason. A Virginia federal judge – the same one now hearing the Zacarias Moussaoui case – sided with Google. A judge in the Southern District of New York reached a similar conclusion not too long ago, Weltsch noted.

"There's certainly disagreement," he said. "It's a shady area."

It's murky enough, in fact, that Weltsch said he would urge clients to avoid the advertising strategy altogether. Case law would seem to support the practice of buying the rights to a competitor's trademark, but the whole legal area is so fluid that litigation would probably arrive as swiftly as the first customer.

"I would recommend against it because you're inviting a lawsuit," Weltsch said. "Because this is an issue that's in flux nationally, I would advise against it."

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