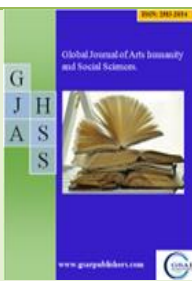
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EXTRAPOLATING META-TAGS AS THE BASIS OF TRADEMARK INFRINGEMENT

BY

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Abstract

Where a person applies his/her own trademark, he is at liberty to exercise a right to use such mark in meta-tags and in the matter of his own website. The incorporation or, otherwise unsolicited existence of technology and its many mechanisms in the field of law is one which has given rise to brewing issues and controversies in the legal jurisprudence. The existence of these controversies is further complicated by the borderless nature of scientific development and the depth of sophistication that comes with each new form of technology. Meta-tags is one of these new forms and has had profound impact on law, generally. The nature of meta-tags enables it to manifest in search engines as keywords and /or descriptions and direct web page users to sites they intend to visit. However, and rather unfortunately, meta-tags have been used to promote the infringement of the trademarks of companies, thereby violating all that the law seeks to protect. This paper, therefore analyses the concept of meta-tags and its use for trademark infringement. The discourse begins with a contextualization or overview, underscoring a succinct explanation of the keywords in view of their relevance to the theme. It continues by considering ways in which meta-tags can actually augment or perpetrate trademark infringement sequel to the laws already existent on the subject matter. The researchers went on to conduct an extrapolation of the subject matter in consideration of the technological sophistication evident in the 21st century, and beyond within selected jurisdictions while proffering plausible recommendations for the redemption of our trademark laws. The paper concludes on this note.

Keywords: Meta-tags, Technology, Trademark, Infringement.

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1.0 INTRODUCTION

The law of trademark infringement is basically in technology-instigated chaos. It is expectedly so, because even though the laws had seemed quite simple or uncomplicated to enforce, the tendencies of technology in the Intellectual Property (IP) sphere remain alarming, thus invasions and disruptions of IP laws like the one currently perpetrated by meta-tags are more foreseen than unexpected. Hyperlinks, frames, including meta-tags are among the few tools available to a search engine to set the result for preferred question by the web user. After query by the web user, search engines use meta-tag to set the web links in a manner for the desired query of the web user and prioritises the web links accordingly. Meta-tags are small blocks of text that are attached to web page and serve as a code to provide information about the web

page.¹ They are programming codes containing hidden pieces of text that describes or tend to describe the keywords, content and

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purpose of a web page. They also perform the gravity function of aiding the identification of the source or origin of the web pages, especially when trademarks are used as part of the title tags, and herein lies the issue. A lot of companies and individuals have engaged in the exploitation of this benefit by using the trademarks of other companies or establishments in order to attract traffic and promote sales. This amounts to infringement of the rights of those whose trademarks have been used and exploited in such manner. The virtual nature of these acts of infringement has made it both easy to perpetrate and difficult to be controlled and eventually curbed by law. Meta-tags therefore formed the basis for the infringement of trademark rights.

This has raised concerns for the laws on infringement of trademark. How, then does the law address this pressing issue that got intertwined with huge technological benefits? What, exactly are these ways meta-tags aid trademark infringement? Is there any legal framework regulating such infringements? What does the future hold for trademark laws in view of the continued and, of course, developed existence of meta-tags? It is, in fact to the end that these questions are answered that this paper is tilted.

2.0 Conceptual Framework of Meta-tags and Trademark Infringement

A riddle, how can a company be liable for trademark infringement when the infringing material is invisible to a consumer? The answer – by using trademarked phrases in a company’s meta-tag.²

Meta-tags are “word or phrase in HTML computer code that usually identifies the subject of a web page and acts as a hidden keyword for Internet search engines. A person who uses a trademark as a meta-tag without permission may infringe on the trademark owner’s rights.”³ Meta-tags are HTML⁴ codes, hence their invisibility which are used in the creation of websites and directly correlate with the ability of search engines to enable consumers identify sites. While meta-tags are invisible to the website consumers, the keywords and descriptions they manifest are seen by these consumers and primarily helps them identify various websites. The purpose of these tags is to augment the ability of the search engine to retrieve user results according to the user’s input in the search engine, such as Google, Yahoo, etc. Generally, meta-tags do not affect the appearance of a website and are not visible when you look at a Web page, but they provide information regarding the content of the site⁵ such that when a search engine

finds a term for search in a meta-tag, they index the Web page and make a display in the search results.

Meta-tags are of various types, however just three are commonly used, namely: Title tags, description tags, and keyword tag. Title tags are the kinds of meta-tags which often constitute the subject and main purpose of the website. They are usually visible on Search Engine Results Page (SERP) and are key elements both in Search Engine Optimization [SEO] and relevant audience perception of brands. Description tags, on the other hand, contain a longer version of the summary of page content than the information already displayed on the title tag. And while these description tags do not directly aid search engine rankings, they are key factors in the determination of the percentage of viewers clicking the link after viewing the SERP page. This is succinctly known as the SERP conversion rate. Keyword tags, finally are used by web pages that add keywords to their codes such that their sites can be found in SERPs after searching for one or more of these words. The use of keyword meta-tags has reduced though, but they still hold relevance as metadata.

Meta-tags are essentially crucial when it comes to making connections between themselves and search engine robots in order to enable persons locate their sites for the content, and purposes they embody. They are, simply key identifiers of web pages on the internet space.

The concept of trademark infringement is quite more traditional and straightforward than meta-tags. By virtue of Section 5(2) of the 1965 Trade Mark Act (TMA) of Nigeria, a trademark

...shall be deemed to be infringed by any person who, not being the proprietor of the trademark or a registered user thereof using it by way of the permitted use, uses a mark identical with it or so nearly resembling it as to be likely to deceive or cause confusion, in the course of trade, in relation to any goods in respect of which it is registered, and in such manner as to render the use of the mark likely to be taken either –

- a) as being used as a trademark; or
- b) in a case in which the use is use upon the goods or in physical relation thereto or in an advertising circular or other advertisement issued to the public, as importing a reference to some person having the right either as proprietor or as registered user to use the trademark or goods with which such a person as aforesaid is connected in the course of trade.

The following, including three-dimensional marks, **can be registered as a trademark**, any device, brand, heading, label, ticket, name, signature, word, letter, colour mark, numeral, shape,

July, 2024

² Law Firm of Conway, Olejniczak & Jerry, S.C., “Trademark Infringement through Meta-tags” [2024] <https://www.lcojlaw.com/legal-resources/trademark-infringement-through-metatags/> Accessed 11th July, 2024.

³³ Bryan A Garner (ed), *Black’s Law Dictionary* (9th edn, West Publishing Company 2009) 1080

⁴ Hypertext Markup Language

⁵ Stimmel, Stimmel & Roeser, “Web Page Meta Tags: What They Are and the Legal Issues Affecting Their Use” [2024] <https://www.stimmel-law.com/en/articles/web-page-meta-tags-what-they-are-and-legal-issues-affecting-their-use> Accessed 18th

and packaging of goods, or any combination thereof, may be registered as a trade mark.⁶

Any unauthorized use of a mark that is likely to adversely affect the origin or source function of the mark constitutes an infringement for which the proprietor is entitled to sue.⁷ Such use must, actually or be intended to affect the origin or source of the marks adversely. In other words, the trademark owner does not have an unlimited monopoly over the marks and the kind of use which constitutes infringement is one that negatively affects the trademark, especially in its functions of identifying the source of the products and promoting its marketability. It suffices, therefore that the use of such marks ought to be in the same course of trade or business as the mark itself, else one cannot be certain that the trademark has been adversely affected.

Asides the foregoing, it is also important, as was stated in *Ferodo Limited & Anor v Ibet Industries Limited*⁸ that there be a likelihood of confusion or deception in goods to the average consumer. In determining whether or not the trademark presents a likelihood of confusion, the court considers the marks in terms of two factors – sight and sound. This examination is carried out in the perspective of the average consumer who does not always have the opportunity to place the items side by side before making his purchase but simply relies on a recollection of the trademark. This has been considered in a plethora of cases including *Nigeria Distillers Ltd. v Gybo & Son (Nig.) & Anor*⁹.

Put succinctly, the unauthorized use of a third party's mark amounts to trademark infringement. It is important, therefore to consider how these meta-tags constitute or aid trademark infringement under the law. For reference, relevant pieces of trademark legislation in Nigeria includes:

- i. The Trademarks Act, CAP T13 Laws of the Federation of Nigeria (“LFN”), 2004
- ii. The Trademarks Regulation, 1967.
- iii. The Merchandise Marks Act, CAP M10 LFN, 2004.
- iv. The Trademark Malpractices (Miscellaneous Offences) Act, CAP T12 LFN, 2004.
- v. The Counterfeit and Fake Drugs and Unwholesome Processed Foods (Miscellaneous Provisions) Act, CAP C34 LFN, 2004.
- vi. The Cybercrimes (Prohibition, Prevention) Act, 2015

2.1 Understanding Meta-Tags and How it is Misused

So what exactly does a Meta-Tag do? By definition, these are HTML codes similar to programming codes, located at the header known as the meta-title-tag, and the description of the website mentioned in the meta-description-tag. The purpose is to facilitate

⁶ TMA, Nigeria section 9

⁷ DO Oriakhogba, & IA Olubiyi, ‘*Intellectual Property Law in Nigeria: Emerging trends, theories and practice*’, Paclerd Press Limited, Benin City. 2nd Edition, 2023, pp 350 - 355

⁸ [2004] LPELR-1275 (SC)

⁹ [1997-2003] 4IPLR 464

search engines ability to retrieve user results according to the user's input in the search engine, such as Google, Yahoo, etc. Meta-tags are not displayed on the websites evidently and require certain inputs to view them. For the same reason, trademarks sometimes get infringed on due to their veiled attributes.

An Illustration:

To view them go to any website, right-click anywhere on the website, right-click on a blank space within the website, and press on open “View Page Source” or simply press Ctrl + U (only for Windows), Option + Command + U (for Mac users).

Supposing a user searches for a sports brand, the search engine, relying on the meta-tags and meta-data of various sports brand and their trademarks and keywords, can provide results according to the user inputs on the search bar; websites like Adidas and Puma are displayed on the search result, but rivals resorting to unfair means on the internet are relying on abusive practices meta-tags to gain unfair momentum on the internet through the diversion of traffic from the big players and brands to their own, simply by adding the trademark of these big brands as their meta tags.

For example, a fake shoe seller company named “Adibas” might add “Adidas” (a genuine brand name) as a meta-tag on their website to divert traffic towards the fake shoe seller company's website, “Adibas.”

2.2 The Role of Meta-Tags in Search Engine Optimisation (SEO)

Search engine optimisation is a process through which a search engine result page (SERP) for Google, Yahoo, Bing, etc. gets relevant feedback to align the ranks depending on various factors such as user traffic, paid search via Google AdsWords, etc. The search shows SERP by evaluating these factors accordingly.

The higher the traffic volume (the higher the volume of traffic, the higher the rank of a website and the web visibility), but if the SEO process is not optimised correctly, the website visibility will be lower amongst internet users and browsers. The visibility of websites in search engines can be drastically improved through meta-tags and SEO. The purpose of search engines is to show search results, or SERP, that include an enormous amount of websites depending on additional factors such as information, usage, and good quality content, which in turn generates a high volume of traffic towards the websites.

Meta-tags, if used properly, can assist websites in enticing enormous amounts of consistent user traffic. Since search engines rely on Hypertext Text Mark-up Language (HTML) and keywords, meta-tags being an HTML code in itself, influence the search result.

2.3 Basic Types of Meta-Tags

Meta-Tags as earlier highlighted have many parts but we shall look at three basic types, which are:

- **Meta-Title Tag-** Concealed on the header of the web page, the role of these tags is to describe the website type and brand; they contain the important

keywords, for example, Sports, Shoes, etc., or brand names such as Colgate, LexisNexis, and other such keywords that persuade users to open the website

- **Meta- Description Tag-** Includes a synopsis of the website, if the website deals with an e-commerce platform keywords summarising the details of the website are usually mentioned.
- **Meta- Keyword Tag-** Though the use have reduced considerably, keyword tags are used by web pages that add keywords to their codes such that their sites can be found in SERPs after searching for one or more of those words.

3.0 Perpetration of Trademark Infringement by the Use of Meta-tags

Apparently, intellectual property law has been well-occupied, seeking ways to chart its course through the brewing controversies created in the legal jurisprudence by technological innovations and algorithms, as is evident in the numerous case reviews on the subject. However, this process is stifled by the boundless nature of scientific developments and the altitude of complexity that comes with each new form of development, such that while the law is still dealing with the possibilities, opportunities, and challenges that could result from granting patent rights to creations of AI machines like DABUS¹⁰ or the consequences of declaring peer-to-peer sharing devices like Napster¹¹ capable of infringement, more sophisticated forms of technology – Meta-tags, for instance – keep coming into existence as explained above. As known, meta-tags are one of the most important aspects of business identification for consumers on the World Wide Web (WWW). With the exponential growth in importance of the internet as a platform for sales, advertising, and communication, the issue of trademark infringement has arisen both in disputes related to cybersquatting on domain names and those involving use of a third party's trademark online.¹²

Over time, trademarks have been embedded as a crucial part of website meta-tags, and while this is not a problem, its misuse has created a plethora of issues for trademark users and the legal landscape in entirety. If used properly, which is unfortunately not the case, trademarks as meta-tags have the potentials of increasing web consumers, creating awareness of both the company owning the trademark and the article or products on the website and augmenting company sales. However, in a bid to exploit these benefits, a lot of persons/companies have engaged in treacherous use of this well-meaning opportunity presented by technology, to

¹⁰ Device for the Autonomous Bootstrapping of Unified Sentience. See *Thaler v The Comptroller-General of Patent, Designs and Trademarks* [2020] EWHC 2412; *Thaler v Vidal* 43 F.4th 1207 (Fed. Cir. 2022)

¹¹ *A & M Records v Napster Inc.* 239 F.3d 1004 (9th Cir.2001)

¹² David Llewelyn & Prashant Reddy T., "Meta-tags using third party trademarks on the internet" SSRN [January 31, 2020] https://papers.ssrn.com/sol3/papers.cfm?abstract_id=3683824 Accessed 17th July, 2024.

the detriment of the perpetrators and victims of such treachery. These persons use the trademarks of other companies as part of their meta-tags, thereby representing their sites and products as emanating from or endorsed by the companies whose trademarks they have used. This constitutes trademark infringement as has been explicitly provided for in Section 5(2) of the Trademark Act of Nigeria reproduced above.

However, one of the steps in establishing trademark infringement is to demonstrate that the trademark in question has, in fact, been 'used' by the alleged infringer: the whole basis of the cause of action is the illegitimate 'use' of another's trademark. This has, as expected brewed a lot of controversies as many have been of the opinion that the use of trademarks as meta-tags should be denied on the grounds that a meta-tag is not perceptible to average user of the internet. While this appears largely true, it apparently flows from a lack of basic understanding of meta-tags and how they operate. It is, therefore important to reiterate that while the meta-tags themselves are invisible to the consumers/customers, they manifest as keywords in the search engines and these can be perceived by the website visitors who eventually get confused if these tags have been misused. Also, what constitutes trademark infringement is the use of a third party's trademark, which are very much visible, and not the use of meta-tags. This line of thought was emphatically endorsed by the Supreme Court of Germany in *Impuls Medienmarketing GmbH's Application*¹³. Therein, the court stated that "the use as a trademark cannot be denied on the grounds that a meta-tag is not perceptible to the average user of the internet". The court further reasoned that even if the keyword is not visible in such cases, the use of the keyword influences the search results, and the user's attention is deflected to the competitor [the defendant's website]¹⁴. While meta-tags are minute and largely unseen, they have incredible impacts especially when they involve trademarks. In fact, the misuse of website meta-tags embody all forms of trademark infringement, placing it at the root and bourne of all trademark infringements.

3.1 Initial Interest Confusion

The court, in *Discovery Ltd. & Ors v Liberty Group Ltd.*¹⁵, stated emphatically that infringement occurs when the use of trademark affects the functions of the trademark, especially in its role of identifying the source or origin of goods to the consumers of such goods. In other words, any trademark or use of trademark which tends to place the consumers in confusion as regards the origin of particular goods and services or lead them into believing untrue state of events presented as facts amounts to trademark infringement. It is this state of confusion and the adverse effects it has on the company whose trademark is being used that the law seeks to protect. In *Cheval Int'l v Smartpak Equine, LLC*¹⁶, the

¹³ [2007] E.T.M.R. 46

¹⁴ Supra

¹⁵ Case No. 21362/2019 (SA). See also *Anheuser-Busch Inc. v Budejovicky Budvar*, narodni podnik Case C-245/02.

¹⁶ [2016] U.S. Dist. LEXIS 33023 (D.S.D. Mar.15, 2016). See also *PW Stoelting, L.L.C. v Levine*, No. 16-C-381, 2018 U.S. Dist.



defendant had, on agreement with the plaintiff sold individually repackaged portions of the plaintiff's supplement. However, after performance and subsequently, discharge of the agreement, the defendant went on to use the plaintiff's trademark in their website meta-tag wherein they stated that the product was out of stock. Confused customers reached out to the plaintiff with this information and the plaintiff, in shock sued. The court, without equivocation held that the use of trademarks in the meta-tags was enough to allege initial interest confusion and there was, therefore trademark infringement.

Basically, 'Initial interest confusion' is a legal doctrine that allows a finding of infringement where there is temporary confusion.¹⁷ More elaborately put, whenever there is a likelihood of confusion on the part of consumers/customers as regards the source or origin of particular goods or products, the doctrine of initial interest confusion makes the finding of infringement. In determining the likelihood of confusion, the courts consider a number of factors, including but not limited to; the similarity of the marks, the relatedness and proximity of the two companies' products or services, the strength of the registered mark, the marketing channels used, the purchaser's degree of care exercised in selecting goods, the accused infringer's intent in selecting the mark, evidence of actual confusion and the likelihood of expansion in product lines.¹⁸

This is further illustrated by the decision of United State court in *Brookfield Communications Inc. v West Coast Entertainment Corp.*¹⁹. In *Brookfield*, an entertainment industry information provider brought an injunction action against a video rental store chain, West Coast which used its trademark, "MovieBuff" in its meta-tags. The District Court had denied the injunction on the grounds that there was no likelihood of confusion. This decision was, however, reversed by the Court of Appeal who consequently instructed the district court to grant the preliminary injunction. The Court of Appeal had reasoned that using the trademark of another company in one's meta-tags is akin to posting a sign with another's trademark in front of one's store or company. The fact remains, indisputably that even if the customers are not confused at the time of purchase, the initial interest confusion which, definitely would have occurred is sufficient to sustain a claim for trademark infringement. Therefore, by aiding the confusion of consumers/customers through use of others' trademarks in themselves, meta-tags have positioned themselves at the root of trademark infringement on the internet and eventually, physical space.

3.2 Consumer Diversion

LEXIS 211914 (E.D. Wis. Dec.17, 2018)

¹⁷ Darin M. Klemchuk, "Meta Tag Trademark Infringement and How to stop it" Ideate blog. (26th February, 2024) <https://www.klemchuk.com/ideate/meta-tag-trademark-infringement> Accessed 17th July, 2024.

¹⁸ Ibid

¹⁹ 174 F.3d 1036, 50 U.S.P.Q.2d (BNA) 1545 (9th Cir. 1999)

The rationale for instigating confusion is to divert consumers and eventually get them to buy ones goods in the name of that of the trademark owner. The case of *Adidas Am. Inc. v. Skechers USA Inc.*²⁰ is very instructive in this regard. Therein, the defendant had designed a shoe which looked noticeably similar to a high-end style of shoe sold by the plaintiff and placed meta-tags on their website containing the plaintiff's sneaker line. The plaintiff, in suing argued that such act amounted to trademark infringement on the ground that the only reason the defendants used that name in their meta-tags was because consumers associate the name with the specific shoe line and would search for it. Both the trial court and the Appeals court agreed with them. The courts determined that the design of the shoe which was very identical to that of the plaintiff and the presence of the meta-tags show an intent to direct consumers to defendant's website instead of that of the plaintiff and that amounted to trademark infringement.

Essentially, consumer diversion is what intellectual property laws seek to prevent by the creation of the genre of trademark, and rather unfortunately, the existence of meta-tags makes it more difficult for the law to prevent such occurrence. Of course, trademark offices do their best to prevent the registration of trademarks which are similar or possess any likelihood of confusion to the consumers as regards any existing trademark and this reduces trademark infringements to a considerable level. However, infringement by meta-tags on the internet space is a lot more difficult to control and this further underscores meta-tags as the basis of trademark infringement.

To further elucidate the ability of meta-tags to divert consumers, the case of *Eli Lilly & Company v Natural Answers Inc.*²¹ presents a very interesting scenario. In that case, the company, "Natural Answer" opened a website for the advertisement of its 'Herbscriptions line', mixtures of herbs that the defendant claimed replaced the drug 'PROZAC' in function and effectiveness. The defendants went further to incorporate the term, 'Prozac' as a meta-tag which eventually directed web users in search of the drug, 'PROZAC' to their site. The court ordered that the meta-tag be removed on the ground that it was an unfair infringement on the trademark of the plaintiff and served to divert customers or consumers in search of the plaintiff drug company to the defendant's site.

Also, in *Hydentra HLP Int. Ltd. v Luchain*²², the defendants included the plaintiff's trademark in the meta-tags of their websites, and following this backdrop, third-party users were uploading plaintiff's videos to defendant's websites. The court ruled that this was enough proof. Accordingly, by its ability to divert consumers, meta-tags have enabled mischievous individuals to infringe on the trademarks of others.

3.3 Trademark Dilution

²⁰ 890 F.3d 747 (9th Cir. 2018)

²¹ 11/21/2000, 00-1375 – US 7th Circuit

²² No. 1:15-cv-22134-UU, 2016 U.S. Dist. LEXIS 193457 (S.D. Fla. June 2, 2016)



Trademark dilution is a type of infringement where association with other products lessens the value of a registered trademark. The commercial use by someone else of a company's trademark can lead the consumers/customers to believe that the products presented are that of the company whose trademark have been used and where the products turn out to be substandard, the value of the company lessens. The law also seeks to protect against such occurrences.

Trademark dilution, as a significant concern for companies and individuals who have built strong identities for their brands is that kind of infringement which does not just affect the temporary reaction and purchase of consumers, as aforementioned, but goes ahead to damage the brand over a long period of time. The case of *Playboy Enterprises, Inc. v Welles*²³ offers a practical illustration. The plaintiff, an international publishing and entertainment company had published *Playboy* magazine alongside other specialty magazines such as *Playboy's Playmate Review*, *Playboy's Playmates of the Year*, and *Playboy's Calendar Playmates*, among others. Accordingly, the company has 'PMOY' and 'PEI' as their trademarks. However, Terri Welles who had been featured in *Playboy* magazine twice or more opened a website, <https://www.terriwelles.com> where she featured photographs of herself (nude and clothed), a fan club posting board, an autobiography section, and a listing of current events and personal appearances. Rather disrespectfully, the title meta-tag attached to the site read, "Terri Welles Playboy Playmate of the Year 1981" while the heading for the website was "Terri Welles Playmate of the Year 1981". More unfortunately, each of the pages used "PMOY '81" as a repeating watermark in the background.

While this may not arouse initial interest confusion in the minds of the consumers or divert their patronage, it tarnishes the image and reputation of the plaintiff company and lessens the value and estimation with which they are held in the society. This is what trademark law seeks to prevent.

3.3.1 Trademark Dilution occurs in two known ways:

- a. Trademark tarnishing
- b. Trademark blurring

Trademark tarnishing

As the name implies, trademark tarnishing occurs when the infringement and use tends to harm the trademark by causing it to lose its value by being associated with inferior products. Where a producer of detergent incorporates 'Viva', for instance into his meta-tags and sells his goods as a product from the Viva Company, it is most likely that consumers begin to associate that product with the company. And when the product is unable to meet up with the standard Viva has built over the years, the consumers associate such inferiority with the company and thus, tarnishes the trademark of Viva. Meta-tags can be used to be perpetrate this.

Trademark blurring

Trademark blurring simply refers to the reduction of the distinctiveness of the mark such that it becomes confusingly

similar to something substandard. This, too spells harm for the trademark being infringed and is a key aspect of the protection the law seeks to grant.

4.0 Legal Framework for Trademark Infringement by the Use of Meta-tags/ Permissible Use of Meta-tags for Trademark Infringement

As expected, there is no legal regulation or provision for infringement of trademarks by meta-tags, however the general elements and principles of infringement can be applied to determine whether or not there has been infringement in any case, as well as the suitable reliefs to be granted to the plaintiff, where the court decides in his favour as held in plethora of cases *herein* above.

The more remarkable impacts the law has made in such matters is the creation of permissible use of meta-tags for trademark infringement. In fact, the law provides for situations when a person can use a third person's trademark as meta-tags without constituting infringement. This falls under the doctrine of "fair use".

Fair use of trademarks involves situations entirely devoid of commercial exploitation. Where a trademark is merely used to describe the goods being advertised or marketed, the use of such trademark is allowed under the fair use doctrine. For instance, Amazon is a well-known online distributor and shipping company on the one hand. On the other hand, Amazon is a well-known river and rainforest. 'Amazon.com (The trademark and domain name of the online distributor) cannot prevent a person from using Amazon (the rainforest) as a meta-tag to describe products or services from the Amazon rainforest.

The case of *Playboy Enterprises Inc. v Welles*²⁴, cited above is a perfect illustration of trademark tarnishing and the liability that comes with it. However, it is important to note that the court did not rule in favour of the plaintiff whose trademark had been apparently tarnished. The Ninth Circuit, instead held that the defendant's use of the trademarked items fell within a three-step normative test for trademark usage and as such was well protected by the fair use doctrine.

The normative test and its application to the instant case are, hereby given:

- a. The trademark is descriptive of the product. In the instant case, the defendant draws the trademark used from her status as "former Playmate of the Month", therefore the defendant was exonerated.
- b. The mark is only used when needed for identification
- c. The user does not suggest sponsorship, endorsement, or license by the trademark holder.

²³ 7 F. Supp. 2d 1098 (S.D. Cal. 1998)

²⁴ *Supra*



Therefore, the courts indeed consider the purpose for which the trademark has been used and the effects such use have on the individual or company whose trademark has been infringed.

5.0 Infringement of Trademark due to Invisible Abuse of Meta-tags in certain jurisdictions²⁵

In essence, the core principle of infringement of a trademark is that once a person abuses or creates similarities in design, logo, or brand name, the identical trademark of the registered owner to whom such proprietor belongs is liable for infringement of the trademark. The same way, all over the world, it is a settled law in itself, with the only exception being an act done in good faith. The infringement of trademark rights through invisible abuse meta-tag was long recognised in the 90s itself in different countries:

5.1 The United Kingdom

In 1996, the case of *Road Tech vs. Mandata*, in which the trademark of the claimant “Road Runner” as Meta-Tag was abused by the defendant and was considered by the court to be an infringement of the trademark, was again confirmed in the decision.

2002 Reed Executive Plc. vs. Reed Business Information (2004)

Despite the confirmation in the original suit, it is relevant to mention that in an appeal suit of 2004 EWCA Civ 159, the appellate court examined the legal issue of whether the prohibition against identical reproduction of a mark covered only reproduction of that mark without addition or omission.

Brief facts of the case: The defendants (Reed Business) had initiated an appeal suit, aggrieved and not satisfied by the original judgement, which held that it had infringed the claimant’s employment’s agency’s registered trademark, i.e., the word “Reed,” set up in 1986 dedicated to employment services and advertisement of jobs. In 1999, the defendants set up another website, totalijobs.com. The claimant asserted that all websites using the word “Reed” visibly or invisibly amounted to infringement of trademark and passing off²⁶, also, the “own name” defence was not viable for the defendants. Defendants used the word “Reed” with their logos and as part of the composite “Reed Business Information.”

Decision of the Appellate Court

The appellate court gave a reversed judgement stating that the claimant had to prove that the alleged misuse of the meta-tag led to confusion, but the claimant failed to prove the same, and also that the ‘own name’ defence was available to a company under the law of the UK since meta-tags did not amount to trademark

infringement if they did not suggest a connection with another trader and the invisible use did not create confusion.

5.2 France

The Paris Court of First Instance held that reproduction of the competitor trademark “Odin” (on the defendant’s website) without the consent of the registered owner of the trademark amounts to trademark infringement; it would also harm the trademark holder’s rights, financially as well as the brand in itself since the keyword “Odin” would direct to the site of the principal infringer.

Louis Vuitton Malletier vs. S. Gulab Singh & Sons Pvt. Ltd. (2018)

In the significant case of *Louis Vuitton Malletier v. S. Gulab Singh & Sons Pvt. Ltd. (2018)*, the Delhi High Court made a landmark decision recognising the iconic monogram of Louis Vuitton as a well-known trademark. This ruling underscores the enduring legacy and distinctive character of the Louis Vuitton brand, solidifying its status as a globally renowned symbol of luxury and craftsmanship.

The case centred around the defendant, S. Gulab Singh & Sons Pvt. Ltd., which was found to have used a pattern that bore a striking resemblance to Louis Vuitton’s iconic monogram. The court, recognising the potential for confusion and deception among consumers, granted an injunction against the defendant, effectively prohibiting them from using a confusingly similar pattern.

The Court’s decision highlights several key points:

- a. **Protection of consumers:** The ruling emphasises the importance of safeguarding consumers from potential confusion and deception. By recognising Louis Vuitton’s monogram as a well-known mark, the court ensured that consumers would not be misled into believing that products bearing a similar pattern were genuine Louis Vuitton products.
- b. **Reputation and goodwill:** The court acknowledged the immense reputation and goodwill associated with the Louis Vuitton brand. The iconic monogram has become synonymous with luxury, quality, and craftsmanship, and the court recognised the need to protect this valuable asset.
- c. **Distinctiveness and uniqueness:** The court’s decision reaffirms the distinctiveness and uniqueness of Louis Vuitton’s monogram. The monogram’s combination of interlocking LV initials and quatrefoils has become instantly recognisable worldwide, setting it apart from other designs and patterns.
- d. **Global recognition:** The recognition of Louis Vuitton’s monogram as a well-known trademark underscores its global reach and appeal. The monogram has transcended cultural and geographical boundaries, solidifying its status as a timeless and iconic symbol of luxury.

²⁵ <https://blog.ipleaders.in/invisible-use-of-trademark--as-meta-tag-infringement-under-29-of-trademark-act> Accessed 18th July, 2024

²⁶ Attempting to sell goods or services as their own, but originally ownership was held by someone else; even if the trademark is not registered, a competitor can still be challenged on the infringement of passing off

6.0 Google AdWords Program, a Controversial Case

6.1 What is Google AdWords

SEO and meta-tags play a crucial role for the registered proprietor of a trademark to include brand names, unique descriptions, and details under their meta-tags exclusively. If a third party adds the trademark of the registered proprietor, intending to infringe the trademark rights, gain financial profit, and divert traffic, it can be a direct or indirect infringement of the trademark. Despite the settled position of the law, an exception was created by Google. It provided service to third parties to use the registered trademark name, for advertisement usage to the competitors using Google AdWords, an advertisement service that auctioned “keywords” by third parties bidding for it, and trademarks were also included, not just the logos but the name of the brand; Google termed it only “marks” and not “trademarks.”

Google AdWords relied on the keywords that were searched the most based on ranks; these keywords were auctioned; the higher the rank and visibility of a keyword in the search engine, the higher the value; the keyword, if owned by any particular business, would then have a higher visibility and rank; henceforth, the business that paid for the “paid search services” would remain on top. Keyword Planner is another additional service, part of Google AdWords, dedicated to providing users with statistical data on the volume of traffic generated by a keyword.

Google LLC vs. DRS Logistics (P) Ltd. & Ors. (2022)

Facts of the case

DRS claimed that the use of its registered trademarks “AGGARWAL PACKERS” and Movers” as keywords by third parties infringed on its trademark rights. The plaintiff further claimed that there was a diversion of traffic through the use of their trademarks by third parties, which led to a decrease in traffic to the website.

The discernment of the single judge

The single-judge bench of the Delhi High Court held that a trademark is prone to infringement by the invisible use of a mark. Google profited from advertisers, by providing service to third parties through the Google AdWords service traffic diversion and by goggles direct engagement in keyboard planner mechanisms. It was perspicuous since Google policies did not recognise trademarks, contending that they were just keywords. Therefore, the court held that:

Google cannot have the protection of a safe harbour by being an intermediary under [Section 79](#) of the IT Act. (Internet service providers have immunity as a form of exemption as intermediaries from hosting third data and services related to it, such as information, data, or communication.)

The claimant cannot have rights to generic words and surnames such as packers and movers. Allowing the injunction applications of the plaintiffs, the single-judge bench directed the defendants to:

- a. Investigate all complaints of the plaintiffs that allege the use of their trademark to divert traffic.
- b. Review the overall effect of such an ad to determine if it infringes on the plaintiff’s trademarks.
- c. And if they discover such use to have the effect of infringing the plaintiff’s trademarks, they will remove or block them.

Not satisfied with the judgement of the single judge, Google filed an appeal before the Division Bench of the Delhi High Court.

Division Bench Findings and Decisions

The primary issue of the matter was whether the use of a trademark as a keyword leads to infringement of the trademark even if used for advertisement purposes only?

The Division bench relied solely on the concept of keywords and stated that the use of trademarks as keywords does not amount to infringement of trademarks because, according to [Section 29\(4\)](#) of the Trademark Act of India, the provision states that infringement of registered requisite essential ingredients to constitute an infringement of trademarks are:

- Similarities of goods and services which are provided by the registered trademark
- Similarities in design and identity
- Creating confusion due to similarities among customers and users.

Advertisement purposes through the use of keywords through an intermediary did fall under the ambit of Section 29(6) of the TM Act of India; the mere use of the trademark as a keyword does not automatically result in infringement of the trademark; fair use of the trademark is permissible but unfair use of the trademark is not.

The court made a distinction considering the application of Sections 29(6) with 29(1) of the said Trademark Act. It was held that the use of a trademark as a keyword by an advertising service provider to display the goods and services offered by an advertiser and not the trademark owner is not an infringement of a trademark; hence, section 29(1) of the Trademark Act cannot be applied since keywords do not perform a source-identifying function; hence, keywords used by advertisers do not hold the impression of infringement. “Use of a trademark” also does not provide any unfair advantage nor does it directly deteriorate the unique character or reputation of the trademark.

Current Legal Position in India

In the case of *MakeMyTrip India Private Limited vs. Booking.com (2016)*, the Hon’ble Delhi High Court decided the case in favour of the claimant. The court granted the claimant an interim injunction against the defendants. It was alleged by MakeMyTrip that the defendant had covertly optimised their websites, abusing the claimant’s trademark by adding keywords such as ‘MakeMyTrip’, ‘MyTrip’, ‘MMT’, etc., which were registered proprietors of the plaintiff. The court held that the defendants did infringe the trademark rights of the plaintiff under sec. 29(4)(c).

The single judge order was, however, set aside by the Delhi High Court by a Division Bench, reasoning that relying upon the case of *Google vs. DRS Logistics*, wherein the court held that mere use of trademarks as “marks” for the sole purpose of an advertisement does not amount to infringement of trademark under section 29(1) of the TM Act and the ‘use’ was in connection to the goods and services of the advertiser, this section 29(4) does not have any application.

7.0 Implications of Technological Sophistication On Trademark Infringement by Meta-tags Usage

Apparently, the landscape of the internet has been transformed from a vast library into a sprawling mall.²⁷ The purpose for which websites and search engines were invented are being hijacked by individuals and companies seeking attention and rankings at the expense of the knowledge and information they should be offering.

It must, however, be noted that meta-tags are, yet of limited significance today, and the scope of further advancement is high. As has been stated by the World Intellectual Property Organization (WIPO)²⁸, what is envisioned is a ‘sophisticated make-believe world in which consumers can experience life virtually’. What this implies is that the virtual space might get more real than the actual physical space and the effects of online trademark infringement will get more deadly. Also, there might also be some claim of rights to be made by Artificial Intelligence (AI) systems which will affect the trademark usage of meta-tags.

It is, thence, absolutely necessary to brace up and implement certain measures to ensure that the law, itself and its provisions are not affected adversely by the global technological advancements.

8.0 Conclusion

The technological advancement in this present era has been consistently surpassing previous limits; nevertheless, the laws must also develop according to the present legal requirements, keeping in consideration various metrics to formulate laws that are free from prejudice and errors. The evolutionary process or amendments has to be inclusive of the current trends, such that exclusivity of domain control by Google for example need not hamper or interfere with the trademark proprietor, and the role of intermediaries is also required to be more diligent.

The question of whether the intermediary is liable for such advertisement service practices through keywords was well decided in *DRS vs Google case*. It explained there is a distinction between the concepts, that Meta-tags are directly part of the header

and the description of the website because of the HTML coding, which is shown on the search result hence any form of abuse of trademark by invisible use of trade mark by meta-tags infringes the trademark of the registered owner directly because the third party uses the Trademark of a registered owner. Whereas Google AdWords is an Advertisement Service provider that bids keywords and the same cannot be attached directly to the websites HTML code neither being a part of a trademark, nor creating any confusion amongst the users and the sole purpose being advertisement only. The same cannot be said for meta-tags because any abusive malpractices are evident in the HTML source code of third parties. The dangers of trademark infringement are enormous, with the huge likelihood of such infringement presented by meta-tags and other forms of technology. It is important to be intentional about effective ways this form of infringement can be controlled and curbed.

For the processes of trademark registration and all others which make it cumbersome to infringe the trademarks of others, the existence of meta-tags has made it easier to infringe others’ trademark and have created difficulties in the enforceability of the laws. It is important that the basic principles of trademark enforcement be carried out on the internet space, where infringement is suspected, all documentary evidence should be filed properly followed by Orders like injunction and confiscation to communicate the severity of the law.

Again, tracking devices should be installed on searching engines with the data of all existing trademarks incorporated into it, such that when meta-tags are being created, they are created with the consciousness that systems have been put in place to check on possible infringements. While meta-tags promotes research results and identification of content sources through its sophistry, it also creates questions of trademark infringement. Hence, there exists the need to balance the pros of meta-tags against its cons via a system that selectively maximises ‘meta-tag’ mechanisms. It is to the end that the laws should be pitched for all jurisdictions, Nigeria inclusive.

²⁷ Katia Bodard & Bruno de Vuyst, “Meta Tag Litigation: An Overview and Some Policy Suggestions” [June 2002] Murdoch University Electronic Journal of Law. <https://www5.austlii.edu.au/au/journals/MurUEJL/2002/10.html> Accessed 19th July, 2024

²⁸ WIPO Magazine, “Trademarks in the metaverse” https://www.wipo.int/wipo_magazine/en/2022/01/article_0006.htm Accessed 18th July, 2024