

Outside Counsel

"Tag" Lines on the Internet

by Roy Gordet

At the end of last month's column I enticed you to come back this month to read all about embedding of trademarks on websites. I'm glad you're back to read all about it.

Some clever website owners have had the idea to include the trademarks of other companies in HTML tags that are used to program their own websites. These so-called "meta-tags" are embedded in the website and are generally invisible to viewers of a web page. The well-known search engines, such as Alta Vista or Yahoo!, will seek meta-tags for keywords entered by users to find information that include the keywords. Thus, if you are a very small ad agency, you might want to include meta-tags for the terms "advertising" or "point-of-purchase" (if you do that sort of thing) so that searchers of the web will be directed to your site. Taking that a step further, you may also want to include terms such as "Young & Rubicam" or "Saatchi" as meta-tags.



Someone looking for a website related to these advertising giants would receive a list with your little ad agency's website on that list. Doesn't sound very legal. Guess what? Last month, Judge Legge, a San Francisco federal judge, said that he in fact did not think such a practice of using other people's trademarks in this way was very legal.

In a case entitled *Playboy Enterprises Inc. v. Calvin Designer Label*, (Case No. 97-3204, if you are interested in going over to the Federal Court at 450 Golden Gate Avenue to read more about this), Judge Legge enjoined Calvin from embedding the mark "Playboy" in these meta-tags. Although the case is far from over, the judge ruled that there is a probability that in the end *Playboy* will be able to prove that such use of (invisible) trademarks is an unauthorized exploitation of *Playboy's* valuable trademarks, and therefore Calvin must immediately cease this activity.

In one sense this is very new and exotic. In another sense, it is really old hat—don't use someone's trademark without their permission. The exotic part is that the consumers do not see the trademark, so how can they be confused? This is what is required in order to prove

trademark infringement. Who knows, maybe Judge Legge is not the last word on this subject.

Now you're on notice. There are some valuable lessons to be learned from this, and hopefully you can use the law to your advantage and still abide by its restrictions. There must be some fascinating variations on this theme that you can devise that can pass legal muster and be assets to your client's webpages. Don't disappoint me.

Next month we will discuss the latest developments on San Francisco and Oakland's proposed ordinances concerning restrictions on tobacco or alcohol advertising. The San Francisco city attorney's office has recently been ordered by a committee of the SF Board of Supervisors to draft legislation outlawing cigarette ads visible from the street, and Oakland is considering a ban on tobacco and alcohol billboards, which is expected to pass in the next few weeks. Stay tuned.

Roy S. Gordet, a San Francisco attorney and chair of the Ad Club's Legislative Affairs Committee, can be reached at rsgordet@ccnet.com, where he welcomes your comments and suggestions.