



**Purchasing a competitor's trademark as a keyword to trigger your company's sponsored advertising may subject you to liability through a trademark lawsuit.**

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Many companies now purchase keywords from search engines to trigger sponsored ads in response to consumer search queries as part of the companies' overall advertising efforts. Until this recent decision, courts in the Second Circuit had ruled that these purchases and a search engine's sale of trademarks as keywords were not actionable through a lawsuit because these activities did not constitute "use in commerce" of the purchased keyword trademarks. Now, the Second Circuit has joined courts throughout the country in deciding that these purchases and sales are actionable through lawsuits claiming trademark infringement. This decision may lead to a new flurry of litigation over the practice.

In *Rescuecom Corp. v. Google, Inc.*, another in the many trademark lawsuits involving keyword advertising, the Second Circuit held that Google's sale of Rescuecom's trademark as a keyword was a use of the Rescuecom mark in commerce. The Second Circuit therefore overturned the lower court decision dismissing Rescuecom's claims that Google committed trademark infringement by selling Rescuecom's trademark to competitors so that those competitors could display their text ads and links when Internet users searched for "Rescuecom. While the Second Circuit found that Google's sale of the "Rescuecom" mark was actionable, it remanded the case to the lower court for further proceedings because Rescuecom would now have to prove that Google's conduct is likely to cause consumer confusion over the association between Rescuecom and the sponsored links displayed in response to a search query.

As a result of the *Rescuecom* decision, advertisers have to be careful about their keyword purchases and search engines (as well as other web sites that sell advertising based upon keyword triggers) may have to be more careful about their keyword sales. These purchases now will not be immunized from infringement lawsuits on the ground that the purchase is not a use in commerce of the trademark that is the keyword. Trademark keyword purchases and sales may still turn out not to infringe the trademark owner's rights, however, if the text advertisement accompanying the sponsored link and the link itself does not use the mark or otherwise potentially confuse consumers into believing that the sponsored ad is affiliated with the mark owner. Of course, every sponsored link ad is different and you should evaluate your keyword advertising in light of the case law discussing when such advertising does cause confusion in the marketplace and how to avoid crossing that line.

[\*Rescuecom Corp. v. Google, Inc.\*](#), No. 2009cv00023, 2009 WL 875447 (2d Cir. Apr. 3, 2009).

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