

From Metatags to Sponsored Ads: The Evolution of the Internet-Related Trademark Infringement Doctrine

By Uli Widmaier

In recent years, many trademark practitioners have received irate messages from clients about sponsored links on Google that appeared in response to a search for the clients' trademarks. The links would connect consumers to the clients' competitors. In other words, a client's valuable and diligently policed trademark, when used as a Google search term, would aid in funneling consumers to clients' main competitors. Trademark owners do not take kindly to having their marks put to this kind of use.

The "culprits" are Google's online advertising program, AdWords, launched in 2000, and similar programs by Yahoo! and Bing. Google sells keywords to AdWords customers and provides "Sponsored Links" to the customers' websites in response to searches that include these keywords. The keywords are often trademarks belonging to competitors. The strategy makes sense—consumers looking for Company A's products on Google may well use Company A's trademark as a search term. If those consumers see sponsored links to Companies B and C (Company A's direct competitors), they may well check out the B and C offerings in addition to A's, or switch to B or C altogether. That may be in the consumers' interest, but it is not in A's.

Third-party websites with domain names that use the client's trademark together with other text create similar annoyances. These are domain names such as [www.\[client's trademark\]forsale.com](#), [www.\[client's trademark\]services.com](#), or the like. Domain names of this type may appear in both natural and sponsored search results. They are often used not by cybersquatters, but by third parties who provide some type of product or service in connection with the client's genuine goods or services—a repair shop for the client's goods, for example. Websites with domain names of this type also may use keywords consisting of the client's trademark. Thus, clients often encounter the double annoyance of running test searches for their own marks and encountering sponsored links incorporating their trademarks without authorization.

Confronted with such facts, the client's blood pressure rises, and swift and decisive legal action is demanded. Starting around 2003, several trademark infringement lawsuits based on sponsored links have been brought against the competitor, the search engine, or both. The plaintiffs faced an uphill battle on a preliminary yet potentially dispositive issue. The question was whether keyword use of the plaintiff's trademark is "use in commerce" under the Lanham Act. If not, the Lanham Act would not apply. This issue was largely resolved with *Rescuecom Corp. v. Google, Inc.*, which found that keyword use does qualify as use in commerce under the Lanham Act.¹ Resolving this preliminary question did not, however, answer the ultimate issue of trademark infringement law: was there a likelihood of confusion? *Rescuecom* itself remained agnostic—"Whether Google's

actual practice is in fact benign or confusing is not for us to judge at this time."²

Faced with such thorny legal issues, trademark owners had to make a difficult decision—let the matter go, or choose to fight a long and drawn-out battle against an adversary with very deep pockets (Google) and with a decidedly uncertain outcome. Could likelihood of confusion ever be shown?

With domain names incorporating the client's trademark, matters were similar. Where the domain name at issue was plainly misleading, legal action would be taken. But—to take a clear counterexample—where the domain name announced accessories for the client's goods, as in [www.wesell\[client's trademark\]accessories.com](#), and where that domain name is in fact connected to a website selling genuine client goods in nonmisleading fashion, lawyers often counseled forbearance. How would likelihood of confusion be proved? Might not the domain name be "nominative fair use," the doctrine that permits (roughly speaking) reasonable uses of a client's trademark by a third party to refer to the *client's* goods or services, as in the hypothetical domain name just discussed?³

Things were simpler in the days before AdWords and sponsored links, when metatags controlled the ranking of websites on search result lists.⁴ Spotting a client's trademark as a metatag in a competitor's website provided solid ground for a trademark infringement lawsuit. The seminal case, *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*,⁵ provided a simplified test for likelihood of confusion in domain name cases—the famed "Internet Troika"—that could be used to great advantage in court. In domain name cases, the plaintiff merely had to show the presence of its trademark in the defendant's domain name, similarity to the client's mark, relatedness of the parties' goods or services, and use by both parties of the Internet as a marketing channel.⁶ In metatag cases, the plaintiff had to find its trademark in the defendant's metatags and show competition among the parties and both parties' use of the Internet as a marketing channel, and the initial interest confusion doctrine would take care of the rest: "West Coast's use of MovieBuff in its metatags was likely to cause initial interest confusion. That is, by using Brookfield's mark MovieBuff to direct persons searching for Brookfield's product to the West Coast site, West Coast derived an improper benefit from the goodwill Brookfield developed in its mark."⁷ Given this standard, trademark owners were often successful in court.

What accounts for the complexities of the current legal situation? Is it true that liability for trademark infringement is

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harder to establish today than it was in the days of metatags, *Brookfield*, and the Internet Troika?

The Ninth Circuit's New Legal Standards

Before we get into the legal discussion, an important real-world factor needs to be spelled out. Google's AdWords program is extremely popular, as shown by Google's \$28 billion in revenue in 2010.⁸ Sponsored advertising on Google, Yahoo!, or Bing is a reality of modern marketing. This has two consequences. First, a good number of trademark owners simply do not object to their competitors' using their trademarks as keywords for sponsored ads—after all, the trademark owners (and potential plaintiffs) are doing the same thing. Second, sponsored ads are so important for some companies that they do not wish to jeopardize their relationship with the search engines by attacking the legitimacy of sponsored advertising, even when they believe that a competitor's keyword practices and sponsored ads are harming them. These two factors have tended to have a dampening effect on litigation.

Now, on to the law. Trademark doctrine is in the process of settling on a much more permissive approach to trademark usage in keyword and domain name situations than was the case in prior years. Two recent decisions from the Ninth Circuit—*Toyota Motor Sales, U.S.A., Inc. v. Tabari*,⁹ and *Network Automation, Inc. v. Advanced Systems Concepts, Inc.*¹⁰—embody the new doctrine.

Under *Network Automation*, a defendant's use of the plaintiff's trademark as a keyword to bring up the defendant's website as a sponsored link does not, without more, create a likelihood of confusion and is thus not actionable under the Lanham Act. For cases involving keyword advertising and sponsored links, "the most relevant factors for the analysis of the likelihood of confusion are: (1) the strength of the mark; (2) the evidence of actual confusion; (3) the type of goods and degree of care likely to be exercised by the purchaser; and (4) the labeling and appearance of the advertisements."¹¹

Under *Tabari*, a defendant's use of the plaintiff's mark in the defendant's domain name, combined with other verbiage that makes it clear the domain name refers to the plaintiff's goods or services, constitutes nominative fair use and is not actionable under the Lanham Act. In cases where the defendant is using a domain name incorporating the plaintiff's mark to refer to the plaintiff's goods or services, the nominative fair use test is to be applied, and the court should "ask whether (1) the product was 'readily identifiable' without use of the mark; (2) defendant used more of the mark than necessary; or (3) defendant falsely suggested he was sponsored or endorsed by the trademark holder."¹² The court also explained that "[a] defendant seeking to assert nominative fair use as a defense need only show that it used the mark to refer to the trademarked good. . . . The burden then reverts to the plaintiff to show a likelihood of confusion."¹³ That likelihood of confusion is to be evaluated according to the three-factor test, which replaces the ordinary multifactor confusion test once the defendant has made the initial showing necessary to invoke the nominative fair use defense.

From Brookfield to Today

Brookfield

As briefly explained above, the Ninth Circuit's 1999 decision in *Brookfield* is a foundation case for much Internet-related trademark infringement law in the ensuing years. The case established two important and widely-followed principles for analyzing trademark infringement on the Internet.

Likelihood of Confusion

Brookfield simplified the likelihood of confusion analysis as it pertains to a defendant's domain name alleged to be confusingly similar to a plaintiff's mark. In traditional trademark infringement cases, courts normally examine all eight confusion factors—known as *Sleekcraft* factors in the Ninth Circuit¹⁴—strength of plaintiff's mark, proximity of the goods, similarity of marks, evidence of actual confusion, marketing channels, degree of consumer care, defendant's intent, and likelihood of expansion of product lines.

Brookfield found that in domain name cases, three of these factors are decisive: "(1) the virtual identity of marks, (2) the relatedness of plaintiff's and defendant's goods, and (3) the simultaneous use of the Web as a marketing channel."¹⁵ This condensation of the *Sleekcraft* factors from eight to three made infringement easier to prove, especially as over time the Internet became a ubiquitous marketing tool. As *Network Automation* noted, the fact that the plaintiff and the defendant use the Internet as a shared marketing channel may have been remarkable in 1999, but certainly is no longer so in 2011. "Today, it would be the rare commercial retailer that did not advertise online, and the shared use of a ubiquitous marketing channel does not shed much light on the likelihood of consumer confusion."¹⁶ *Brookfield's* doctrinal innovation took root and gave rise to a significant body of case law applying this so-called "Internet Troika" of confusion factors in the Internet context.¹⁷

Initial Interest Confusion

Brookfield made metatag cases relatively easy to win for the plaintiff. Metatags were at the time a novel technology used by search engines to assess the relevance of websites to users' search terms. *Brookfield's* explanation of metatag technology may read quaint today, but it is nevertheless instructive because it shows how similar in function metatags were for early search technology to the role keywords play today.

Metatags are HTML code intended to describe the contents of the web site. There are different types of metatags, but those of principal concern to us are the "description" and "keyword" metatags. The description metatags are intended to describe the web site; the keyword metatags, at least in theory, contain keywords relating to the contents of the web site. The more often a term appears in the metatags and in the text of the web page, the more likely it is that the web page will be "hit" in a search for that keyword and the higher on the list of "hits" the web page will appear.¹⁸

Brookfield noted, correctly, that the favorable placement of the defendant's website achieved by using the plaintiff's mark

as metatags does not necessarily lead to conventional likelihood of confusion.

Since there is no confusion resulting from the domain address, and since West Coast's initial web page prominently displays its own name, it is difficult to say that a consumer is likely to be confused about whose site he has reached or to think that Brookfield somehow sponsors West Coast's web site.¹⁹

Nevertheless, the court found liability based on initial interest confusion. The court's reasoning—known as the “Blockbuster Analogy”—is justly famous.

Using another's trademark in one's metatags is much like posting a sign with another's trademark in front of one's store. Suppose West Coast's competitor (let's call it “Blockbuster”) puts up a billboard on a highway reading—“West Coast Video: 2 miles ahead at Exit 7”—where West Coast is really located at Exit 8 but Blockbuster is located at Exit 7. Customers looking for West Coast's store will pull off at Exit 7 and drive around looking for it. Unable to locate West Coast, but seeing the Blockbuster store right by the highway entrance, they may simply rent there. Even consumers who prefer West Coast may find it not worth the trouble to continue searching for West Coast since there is a Blockbuster right there.

*Customers are not confused in the narrow sense: they are fully aware that they are purchasing from Blockbuster and they have no reason to believe that Blockbuster is related to, or in any way sponsored by, West Coast. Nevertheless, the fact that there is only initial consumer confusion does not alter the fact that Blockbuster would be misappropriating West Coast's acquired goodwill.*²⁰

Consumers see the link to the defendant's website only because the defendant is (invisibly to consumers) using the plaintiff's trademark to secure favorable placement of the link. The actionable consumer confusion consists in consumers' seeing the defendant's link solely because the defendant (unknown to consumers) availed itself of the plaintiff's mark. But is that really consumer *confusion*? And if this principle is correct, how could modern keyword and sponsored advertising practices possibly be legal? Regardless of such potential reservations, *Brookfield's* metatag analysis was widely accepted. And from the perspective of a trademark owner, it was a decidedly helpful case.

Playboy and the Berzon Concurrence

Within a few years, the factual underpinnings of *Brookfield's* initial interest confusion analysis were technologically superseded since metatags no longer played a role in search engine algorithms.²¹ Nevertheless, *Brookfield* remained valid law.

But criticism began to mount. In 2004, the Ninth Circuit decided *Playboy Enterprises, Inc. v. Netscape Communications Corp.*,²² a relatively early keyword case. At issue were third-party banner ads for adult entertainment triggered by a consumer's use of the plaintiff's mark (such as PLAYBOY) as a search term.²³ The court, relying substantially on *Brookfield*, found that this practice created initial interest confusion. The court found that the plaintiff's marks were strong, the

third-party banner ads were unlabeled, and consumer care was likely to be low, so that consumers might mistakenly assume the banner ads actually belong to the plaintiff.²⁴

The keywords in *Playboy* are conceptually similar to the metatags in *Brookfield*: both operate unseen by the ordinary Internet user and present the user with links to or advertisements for the defendant's website in response to the user's search for the plaintiff's products. In her concurrence in *Playboy*, Judge Marsha Berzon commented on this similarity and noted a possible overbreadth in *Brookfield's* analysis:

Brookfield might suggest that there could be a Lanham Act violation *even if* the banner advertisements were clearly labeled, either by the advertiser or by the search engine. I do not believe that to be so. So read, the metatag holding in *Brookfield* would expand the reach of initial interest confusion from situations in which a party is initially confused to situations in which a party is never confused.²⁵

Judge Berzon considered whether a consumer's accessing the defendant's website is due to confusion or choice.

There is a big difference between hijacking a customer to another website by making the customer think he or she is visiting the trademark holder's website (even if only briefly), which is what may be happening in this case when the banner advertisements are not labeled, and just distracting a potential customer with another *choice*, when it is clear that it is a choice.²⁶

Judge Berzon noted that the Blockbuster Analogy did not actually describe the facts of *Brookfield* since:

[t]here was no similar misdirection in *Brookfield*, nor would there be similar misdirection in this case were the banner ads labeled or otherwise identified. The *Brookfield* defendant's website was described by the court as being accurately listed as westcoastvideo.com in the applicable search results. Consumers were free to choose the official moviebuff.com website and were not hijacked or misdirected elsewhere.²⁷

The judge asks the Ninth Circuit “whether we want to continue to apply an insupportable rule.”²⁸

Judge Berzon's concurrence summed up much academic and judicial criticism of *Brookfield's* reasoning that had already accumulated by the time the *Playboy* decision was written.²⁹ The time seemed ripe for a reconceptualization of *Brookfield*, and generally of the courts' approach to analyzing online trademark infringement.

However, both the trademark bar and the courts became for several years entangled in a quite different and conceptually separate issue—namely, whether a defendant's use of the plaintiff's mark as a keyword to trigger banner ads or sponsored links counts as trademark use in the first place. As noted above, this question was largely resolved in the Second Circuit's decision in *Rescuecom Corp. v. Google, Inc.*, which held that such use of a plaintiff's mark was indeed trademark use and hence actionable under the Lanham Act.³⁰ In the meantime, *Brookfield* remained formally on the books, Judge Berzon's and others' criticism notwithstanding. But the writing was on the wall.

Tabari

Tabari addresses the issue of domain names that are (allegedly) confusingly similar to the plaintiff's trademark. Toyota objected to buy-a-lexus.com and buyorleaselexus.com, domain names used by Farzad and Lisa Tabari.³¹ The Tabaris are "auto brokers—the personal shoppers of the automotive world."³² After a bench trial, the district court enjoined the Tabaris from using "any . . . domain name, service mark, trademark, trade name, meta tag or other commercial indication of origin that includes the mark LEXUS."³³

The Court of Appeals reversed. "The injunction here is plainly overbroad . . . because it prohibits domain names that on their face dispel any confusion as to sponsorship or endorsement."³⁴ The court spelled out in detail what a confusion-dispelling domain name looks like.

[A] number of sites make nominative use of trademarks in their domains but are not sponsored or endorsed by the trademark holder: You can preen about your Mercedes at mercedesforum.com and mercedestalk.net, read the latest about your double-skim-no-whip latte at starbucks-gossip.com and find out what goodies the world's greatest electronics store has on sale this week at fryselectronics-ads.com. Consumers who use the internet for shopping are generally quite sophisticated about such matters and won't be fooled into thinking that the prestigious German car manufacturer sells boots at mercedesboots.com, or homes at mercesdeshomes.com, or that comcastsucks.org is sponsored or endorsed by the TV cable company just because the string of letters making up its trademark appears in the domain.³⁵

This approach is based on an important premise. Consumers seeing a domain name must pick up on the entire statement in the domain name, not just on the (possibly famous) mark itself. To do this, they must have a lot of Internet experience. That is precisely what the court assumes to be the case. According to the court, modern Internet users are:

accustomed to . . . exploration by trial and error. They skip from site to site, ready to hit the back button whenever they're not satisfied with a site's contents. They fully expect to find some sites that aren't what they imagine based on a glance at the domain name or search engine summary. Outside the special case of trademark.com, or domains that actively claim affiliation with the trademark holder, consumers don't form any firm expectations about the sponsorship of a website until they've seen the landing page—if then. This is sensible agnosticism, not consumer confusion.³⁶

Given this level of sophistication and "sensible agnosticism" among Internet users, the court explained, the district court's injunction risks "rais[ing] serious First Amendment concerns because it can interfere with truthful communication between buyers and sellers in the marketplace."³⁷ The court resolved the case by relying on the nominative fair use doctrine. "The Tabaris are using the term Lexus to describe their business of brokering Lexus automobiles; when they say Lexus, they mean Lexus. We've long held that such use of the

trademark is a fair use, namely nominative fair use. And fair use is, by definition, not infringement."³⁸

The court applied the Ninth Circuit's standard nominative fair use test (set forth above), finding that the Tabaris' domain names appear to meet it in full and would not seem to infringe Toyota's LEXUS mark. The court remanded the case to the district court with the instruction that "on remand, Toyota must bear the burden of establishing that the Tabaris' use of the Lexus mark was *not* nominative fair use."³⁹ Given the thrust of the Ninth Circuit's opinion, that showing would seem to be near impossible to make under the facts of this case.

In short, *Tabari* is premised on the assumption that the Internet is no longer novel. People use it and are familiar with it. Not every online use by a defendant of a plaintiff's trademark is necessarily confusion. Consumers read domain names. They experiment; they quickly access websites and back out of them if they don't meet their expectations. The premise of *Brookfield* and other cases of its time—that the Internet is a strange and alien place where both consumers and trademark owners have to be carefully protected—is dead.

Network Automation

Network Automation continues *Tabari*'s theme of an Internet that has become normal, a part of everyday life, and, importantly, a part of most companies' marketing efforts. The facts of the case are analogous to the facts of the metatag portion of *Brookfield*. Network Automation and Advanced Systems Concepts are direct competitors in the job scheduling and management software market.⁴⁰ Network purchased Advanced's trademark ACTIVEBATCH as a keyword for its own sponsored advertising on Google and Bing.⁴¹ The district court, relying on *Brookfield*'s "Internet Troika" of confusion factors, issued a preliminary injunction against Network's use of that mark as a keyword.⁴²

After adopting the Second Circuit's holding in *Rescuecom* that use of a trademark as a keyword to trigger sponsored ads is "use in commerce" of the mark under the Lanham Act,⁴³ the court turned to consumer confusion, formulating the inquiry as follows:

The potential infringement in this context arises from the risk that while using Systems' mark to search for information about its product, a consumer might be confused by a results page that shows a competitor's advertisement on the same screen, when that advertisement does not clearly identify the source or its product.⁴⁴

The court analyzed the applicability of *Brookfield* and its "Internet Troika" of confusion factors in considerable depth.⁴⁵ A significant part of the court's analysis focuses on Judge Berzon's critique of *Brookfield* in her concurrence in *Playboy*.⁴⁶

The court backed away from *Brookfield*.

[W]e did not intend *Brookfield* to be read so expansively as to forever enshrine these three factors—now often referred to as the "Internet trinity" or "Internet troika"—as the test for trademark infringement on the Internet. *Brookfield* was the first to present a claim of initial interest confusion on the Internet; we recognized at the time

it would not be the last, and so emphasized flexibility over rigidity.⁴⁷

Upon applying all *Sleekcraft* factors to the facts at hand,⁴⁸ the court held that Network's sponsored ads do not create a likelihood of confusion with Advanced's trademark, even though Network's ads were not clearly labeled with Network's own marks and were triggered by Advanced's trademark as a keyword. The holding is based ultimately on the finding that the way sponsored links are graphically offset from the natural search results on the search results pages of Google or Bing inherently mitigates any likelihood of confusion.

Here, even if Network has not clearly identified itself in the text of its ads, Google and Bing have partitioned their search results pages so that the advertisements appear in separately labeled sections for "sponsored" links. The labeling and appearance of the advertisements as they appear on the results page includes more than the text of the advertisement, and must be considered as a whole.⁴⁹

In other words, as in *Tabari*, the court assumes that Internet users are thoroughly familiar with using search engines, including distinguishing between natural and sponsored search results. The court concludes the opinion by offering a new "Internet quartet" of confusion factors, customized for sponsored links and ads.

Given the nature of the alleged infringement here, the most relevant factors to the analysis of the likelihood of confusion are: (1) the strength of the mark; (2) the evidence of actual confusion; (3) the type of goods and degree of care likely to be exercised by the purchaser; and (4) the labeling and appearance of the advertisements and the surrounding context on the screen displaying the results page.⁵⁰

Only three of these factors—strength of the mark, actual confusion, and the type of goods and degree of consumer care—are part of the traditional *Sleekcraft* list. The fourth factor—which was dispositive in the case—is novel. It is likely to assume great importance for subsequent cases dealing with keywords and sponsored advertising.

Practical Guidance

There is a clear connection between *Tabari*'s belief in a certain degree of consumer sophistication when it comes to Internet use, and *Network Automation*'s belief that the graphic offset of sponsored links on search results pages mitigate the likelihood of consumer confusion. In both cases, Internet users are treated as thoroughly familiar with the basic ins and outs of search engine use and web surfing. They are not "fragile flowers" in need of coddling by the courts. They are good at separating virtual wheat from virtual chaff. As *Network Automation* put it, "the default degree of consumer care is becoming more heightened as the novelty of the Internet evaporates and online commerce becomes commonplace."⁵¹

This readjustment of judicial default assumptions as to consumers' online sophistication makes it harder to show likelihood of confusion. Trademark holders and their lawyers will have to take a hard look at the facts of each situation and decide whether the facts will stand up to the new and stricter

examination to which the courts are likely to subject them.

In short, *Tabari* and *Network Automation* provide key criteria to guide client decisions. It is illegitimate to "prohibit[] domain names that on their face dispel any confusion as to sponsorship or endorsement."⁵² In keyword/sponsored advertising cases, the decisive facts relate to "the labeling and appearance of the advertisements and the surrounding context on the screen displaying the results page."⁵³ ■

Endnotes

1. 562 F.3d 123 (2d Cir. 2009). *Rescuecom* contains an exhaustive discussion of the pertinent issues and citations to prior case law.
2. *Id.* at 131.
3. *See* *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302 (9th Cir. 1992).
4. Most search engines had stopped relying on metatags by 2002. *See* Danny Sullivan, *Death of a Meta Tag*, SEARCH ENGINE WATCH (Sept. 30, 2002), <http://searchenginewatch.com/article/2066825/Death-Of-A-Meta-Tag>. Google does not rely on metatags at all in creating and ranking its search results. *See* Matt Cutts, *Google Does Not Use the Keywords Meta Tag in Web Ranking*, GOOGLE WEBMASTER CENT. BLOG (Sept. 21, 2009, 10:00 AM), <http://googlewebmastercentral.blogspot.com/2009/09/google-does-not-use-keywords-meta-tag.html>.
5. 174 F.3d 1036 (9th Cir. 1999).
6. *See id.* at 1054 n.16.
7. *Network Automation, Inc. v. Advanced Sys. Concepts, Inc.*, 638 F.3d 1137, 1146 (9th Cir. 2011) (summarizing the metatag holding in *Brookfield*).
8. Google's 2010 AdWords revenues are around \$28 billion; total AdWords revenues are well over \$100 billion. *See* *2011 Financial Tables*, GOOGLE INVESTOR REL., <http://investor.google.com/financial/tables.html> (last visited Oct. 30, 2011).
9. 610 F.3d 1171 (9th Cir. 2010).
10. 638 F.3d 1137 (9th Cir. 2011).
11. *Id.* at 1154.
12. *Tabari*, 610 F.3d at 1175–76.
13. *Id.* at 1183.
14. *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341 (9th Cir. 1979).
15. *Brookfield Commc'ns, Inc. v. West Coast Entm't Corp.*, 174 F.3d 1036, 1054 n.16 (9th Cir. 1999).
16. *Network Automation*, 638 F.3d at 1151.
17. *Id.* at 1148 (citing case law).
18. *Brookfield*, 174 F.3d at 1045.
19. *Id.* at 1062.
20. *Id.* at 1064 (emphasis added).
21. *See supra* note 5.
22. 354 F.3d 1020 (9th Cir. 2004).
23. *Id.* at 1022–23.
24. *Id.* at 1025–28.
25. *Id.* at 1034.
26. *Id.* at 1035.
27. *Id.* at 1035–36.
28. *Id.* at 1036.
29. *See, e.g.*, 4 J. THOMAS MCCARTHY, MCCARTHY ON

TRADEMARKS AND UNFAIR COMPETITION § 25:69 (4th ed. 2003) (summarizing criticism).

30. 562 F.3d 123 (2d Cir. 2009).
31. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1174–75 (9th Cir. 2010).
32. *Id.* at 1174.
33. *Id.* at 1176.
34. *Id.*
35. *Id.* at 1178.
36. *Id.* at 1179 (citation omitted).
37. *Id.* at 1176.
38. *Id.* at 1175 (citing *Playboy Enters., Inc. v. Welles*, 269 F.3d 796, 801 (9th Cir. 2002); *New Kids on the Block v. News Am. Publ'g, Inc.*, 971 F.2d 302, 308 (9th Cir. 1992)).
39. *Id.* at 1182.
40. *Network Automation, Inc. v. Advanced Sys.*

Concepts, Inc., 638 F.3d 1137, 1142 (9th Cir. 2011).

41. *Id.*
42. *Id.*
43. *Id.* at 1145.
44. *Id.* at 1149.
45. *See id.* at 1145–49.
46. *Id.* at 1147–48.
47. *Id.* at 1148.
48. *Id.* at 1149–53.
49. *Id.* at 1154.
50. *Id.*
51. *Id.* at 1152.
52. *Toyota Motor Sales, U.S.A., Inc. v. Tabari*, 610 F.3d 1171, 1176 (9th Cir. 2010).
53. *Network Automation*, 638 F.3d at 1154.