Testing Section

After many months of experiencing healthy increases in online sales, a florist in the Midwest was shocked to see its Web site sales plummet beginning about a week before Valentine's Day. That shock was nothing compared to what the shop owner experienced when he did a search on Google for his company name — we’ll call it “ABC Florist” (with ABC replacing the family name). The top sponsored listing read “ABC Florist,” but the link under it was for ProFlowers.com.

The florist, who asked not to be named because of ongoing legal proceedings, is not the only business owner who has been, in his terms, “Goggled” by another floral company. In fact, there’s no apparent law prohibiting a company from purchasing another company’s name or product as a keyword on a search engine. But Google AdWords are a different matter — both in terms of their power to the advertiser and their ability to confuse the consumer. AdWords are the underlined, bolded text that shows up as the “title” in the sponsored links after a Google search. (See image at right.)

The florist says he submitted a trademark complaint form to Google when he saw someone using his name. “If you submit the trademark form, they can still use it as an AdWord.”

Unlike a reseller of trademarked items, however, floral companies such as ProFlowers.com are allowed to run with the term at issue in their ad. "Googled" by another floral company. In fact, there’s no apparent law prohibiting a company from purchasing another company’s name or product as a keyword on a search engine.

Regardless of the advertiser’s technique, however, if the practice ultimately confuses the consumer, it can have a trademark infringement case on its hands. "The definition of infringement is tied to consumer confusion," said attorney Cydney Tun, who leads the copyright practice section at Pillsbury Winthrop Shaw Pittman LLP in San Francisco.

Currently, the federal courts are split on the issue, Tun said. Those that have ruled in favor of the advertiser contend that once the consumer clicks on the link, it’s obvious that the consumer did not land on the intended site. The courts ruling against the advertiser, however, cite "initial interest confusion," contending that, while the consumer is not confused once the consumer clicks on the link, it’s obvious that the consumer did not land on the intended site. The courts have found that the Google AdWords are the underlined, bolded text — both in terms of their power to the advertiser and their ability to confuse the consumer.

That policy reflects a significant change Google made last summer when it began allowing some advertisers to use trademarks in the ad text. In a blog post by Dan Friedman, a member of the Inside AdWords team, he explained that resellers of certain trademarked items, like iPods or Nike shoes, can use that term as an AdWord even if they don’t own the trademark or have permission from the owner to use it.

Unlike a reseller of trademarked branded items, however, floral companies such as ProFlowers.com are using the name of the florist, not a kind of flower or branded item, to direct visitors to their site. ProFlowers.com did not return calls or e-mails about the practice, and the Google spokesperson did not answer questions about whether that specific practice violates its policy, which explicitly states, "Ads using the term in a competitive, critical or negative way will not be allowed to run with the term at issue in their ad."

Regardless of the situation, Google will not intervene unless a complaint is filed. Geddes suggests filling out Google’s trademark complaint form first, getting the ads removed, and then sending any future screenshots to Google when you see someone using your name. "If you submit the trademark form, they can still use it as a keyword," he said. "But they won’t be able to use it (as an AdWord)."

While going after Google might seem like the most natural course of action, it has prevailed in several early cases of trademark infringement with keywords, according to Michael McCue, a trademark partner with Lewis and Roa LLP in Las Vegas. “There are now several suits pending against Google, but this is still a developing area of law and it is unclear how it will be decided.”

The more effective, and less expensive, course of action is to send a “cease and desist” order to the advertiser, as “ABC Florist” has done.
In addition, having a registered trademark — while not absolutely necessary to prove infringement — "offers a presumption of trademark ownership and trademark validity, so you don't have to prove it," said Tune. Plus, if a cease and desist letter has registrations attached to it, "it gets more attention than just saying, 'I've been using this (name) for XX years,"' Tune said.

Try this:
- Common law may protect your business name in your geographic region, but online is border-free, so consider getting your company name trademarked. Get information here.
- If you see your company name come up as an AdWord, file a complaint with Google and consult with your attorney.
- Assign someone in the shop to do a search on your shop's name weekly, to check to make sure if its comes up as an AdWord on another business.

— Kate Penn
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We have had our website www.PerryHallFlorist.com for more years than I can remember. Last year I noticed a competitor in the same town use a listing www.PerryHallFlowers.com which then redirected the person to their florist's website www.FlowerExpressionsofPerryHall.com. This year they have changed their deceitful name to www.PerryHallFlorist.net. We have fought the phone imposters in the past & were instumental in having a state bill passed. All I want is fair trade to do my own flower arrangements. How do I get this person to play fair?

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