BC case deals with IP issues surrounding meta tags on the internet

IP column published in *The Lawyers Weekly* June 22, 2001

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There still isn't much law about the internet and intellectual property in Canada, so British Columbia Automobile Association v. Office and Professional Employees International Union, Local 378 is an important case. It's a lengthy (234 paragraphs) decision of Justice Jon S. Sigurdson of the Supreme Court of British Columbia, released January 26, 2001.

In a nutshell, the BCAA claimed a union's website infringed its trade-marks and copyright, and was passing off. Most important, the case talks about meta tags. The principles surrounding internet domain names are now pretty clear, but there isn't much law on meta tags. Yet they raise all sorts of trade-mark issues, since we all use internet search engines all the time now.

What's a meta tag? It's that part of a website that most search engines access when they rank sites automatically by relevance. A meta tag is part of HyperText Markup Language (HTML), the programming language used to design webpages. A meta tag may not be visible to a user accessing the site. Search engines basically produce a list of sites whose meta tags contain the search term. So if we put "Gowlings" and "Blakes" in the meta tag of our law firm site, hazzardandhore.com, any internet search for Gowlings or Blakes would turn up our site too.

Is that passing off or trade-mark infringement? Some of the US cases say it is, on the grounds that it causes "initial interest confusion." That is, we would be misappropriating good will by diverting traffic and maybe sales away from Gowlings and Blakes, even if it's clear our firm site has no connection with those firms (see, for example, Brookfield Communications v. West Coast, 174 F. 3d 1036 (9th Cir. 1999)).

In various cases, Playboy Enterprises, the Heffner bunny empire, was able to stop the use of "playboy" in meta tags. Aspiring porn kings (or queens) were putting "playboy" in the meta tag of their hard-core sites. Whenever anyone did a search for "playboy," up would come all these other sites, ranked right up there with the real Playboy site.

But Playboy lost a case where the meta tag was informational. The courts said a former Playmate of the Year, Terry Welles, was not infringing Playboy's trade-marks by using

such terms as term “playmate” or “playboy” as meta tags in her site TerryWelles.com because she really had been a Playboy playmate, and a disclaimer indicated her site was not affiliated or endorsed by Playboy. (Playboy Enterprises, Inc. v. Welles, 7 F. Supp.2dd 1098 (S.D. 1998), affd. without opinion, 162 F. 3d 1169 (9th Cir. Cal. 1998)).

The BCAA case is the first Canadian case that I know of to look at this issue in depth. It discusses both US and Canadian cases at length.

The facts were pretty simple. BCAA offers drivers roadside assistance and other services and has a website, bcaa.com. Through the national organization, the Canadian Automobile Association (CAA), it has various trade-mark registrations for BCAA, CAA, and the CAA logo.

Some BCAA employees belong to a union, OPEIU Local 378. The union went on strike, and in March 1999 set up its own website: bcaaonstrike.com.

The union site went through various versions. The earlier ones were essentially parodies of the BCAA website with the same lay-out and colours, and the CAA logo upsidedown. The meta tags used trade-marks such as BCAA and CAA. The union site provided the union view on the labour dispute.

The union changed the website over time, so it eventually looked different from BCAA’s site, and used different meta tags, but this was evidently not enough to mollify BCAA, since the law suit went ahead anyway.

Because the earlier version of the site had closely resembled BCAA’s site, and there seemed was no dispute that BCAA’s site was an “artistic work ” for the purposes of the Copyright Act, the court found that there had been copyright infringement, and awarded nominal damages of $2500. It did not order an injunction since the infringing site had been changed anyway. Nothing particularly new there.

On the trade-mark and passing off issues, the court considered BCAA’s argument, based on Brookfield, that the union site's meta tags used terms such as "BCAA" with the admitted intent of diverting internet users away from the BCAA website, and towards the union website, hoping that users would not do business with BCAA.

The court found that there was no passing off or infringement on the facts of this case, because the union website did not have a commercial purpose.

Perhaps the most interesting passage in the reasons is the following (paragraph 129): “While I think that the use of similar meta tags unconnected to the defendant’s business or operation might indicate deception and might be a significant factor in determining if there is a passing-off, I think that the use of these particular meta tags is not objectionable because it is a reasonable way for the Union to bring its message to people wishing to do business with the employer.” (My italics)

So its seems clear that certain uses of meta tags could be passing off in Canada. No doubt we'll hear more about this issue in future.

Maybe we won't put "Gowlings" or "Blakes" in our firm's website meta tags after all.