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Intellectual Property Alert

Have You "Googled" Yourself Lately?

On April 3, 2009, in *Rescuecom Corp. v. Google Inc.*, the U.S. Court of Appeals for the Second Circuit issued an order that has the potential to significantly impact the multibillion-dollar keyword advertising business.

At issue was whether registering another company's trademark through Google's AdWords program was a violation of the Trademark Act. Also in dispute was Google's Keyword Suggestion Tool, which recommends potential keywords to advertisers for use in the AdWords program.

While most decisions outside of the Second Circuit that considered the issue have held that utilizing a competitor's keyword to trigger ads states a claim for infringement, this was the first time that the Second Circuit had reached such a conclusion.

The uniformity created by this opinion essentially removes an often used defense to trademark infringement actions based on the misuse of trademarks in keyword search programs, namely: registering a trademark as a keyword is not a "use in commerce" under the Trademark Act and therefore is not technically a violation.

We recommend that all clients search their trade names and trademarks on major search engines (e.g., www.google.com, www.yahoo.com, www.ask.com) to determine whether competitors have impermissibly registered them as key words through a keyword search program. In addition, clients should be advised of the potential ramifications of registering a competitor's name or mark through a search engine advertising program.

In light of this new ruling, Ungaretti & Harris is offering clients a free basic audit to determine whether competitors may be infringing a client's trademark. To take advantage of this offer, please contact your Ungaretti & Harris attorney.

To view the decision in its entirety, please [click here](#).

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Ungaretti & Harris' Intellectual Property Department provides a full range services focusing on patents, trademarks, trade dress, copyrights, trade secrets, unfair competition, computer technologies, franchising, licensing, IP litigation, IP portfolio management, M&A due diligence and lending due diligence.

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