



WESTCHESTER COUNTY BAR ASSOCIATION NEWSLETTER

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A Labor of Love

BY SALVATORE A. LAGONIA, ESQ.



I've figured it out. The meaning of life. Well, part of it anyway. Do something you like, or better yet, do something you love, and it's like never working at all. That's how this past year has been as your President. The hours were long, the meetings were plentiful, and we ate more rubber chicken dinners than I can count. But now that it is all but over, I can look back and say what a wonderful time it has been. Meeting so many great colleagues has made this year more than worthwhile.

But as anyone who has sat in the President's seat for more than three minutes knows, your work pales in comparison to the hard work of the people around you. So many hard working members of this bar association have contributed their time, energy and intellect to making our organization a better place; no matter what the challenges.

And challenges there were! We were met head on with having to find a new Executive Director. That position is critical in the day-to-day operation of our association. Our search committee worked hard to get it right; and indeed they did. The global economic challenges did not miss our door either. Companies that we have always counted on for revenue continued to scale back on advertising and left us searching for new sources. But with every challenge there was an opportunity and the birth of the "Non-Dues Revenue Committee" has sparked a great many ideas that are leading to better long-range solutions to our financial health.

Membership is always a goal of any administration and our numerous "Membership Initiatives," led by our Vice Presidents, have given us a basis to grow our rolls on a more steady and consistent basis. Beginning with the "Bar after the Bar" event that helps us impress on graduating law students the importance of the organized bar and continuing through member retention programs. Our association sits in a good position to grow, even in the face of challenges.

For the citizens that we all serve, their challenges have led to new opportunities for the bar to have a presence and a voice. Foreclosure initiatives and bankruptcy programs have helped protect people through tough times and placed our profession in a better light.

— continued on page 2.

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BY JOHN McCARRON



The WCBA's Web site has undergone some major changes! While the existing Web site was functional, the association had long outgrown its limited structure and workarounds were more prevalent than functional process.

After months of collaboration between WCBA staff, the WCBA Web Committee, members and partners the new site quietly rolled out. *The new Web site represents not only an optical change, but also a fundamental shift in the way the WCBA will handle its business.*

The WCBA partnered with the Austin, TX firm Affiniscape to build the new site. Affiniscape's expertise lies in association management, marketing and technology. With nearly 1,000 associations using its infrastructure and expertise (including many bar associations), Affiniscape is uniquely positioned to provide cutting-edge technology tailored to the needs of associations such as the WCBA. Affiniscape worked closely with the WCBA to move all of our existing data to the new system. Furthermore, Affiniscape provided, and continues to provide support to ensure the viability of our data.

— continued on page 8.

INSIDE . . .

- Don't Panic! 4**
- WCBA's Golf Outing 9**
- CLE Center 10-11**
- IP Litigation Update 12**
- Classifieds 17**
- From the Back Bench . . . 18-19**

Litigation Update

Rescuecom v. Google – The Second Circuit Holds That Google’s Sale Of Trademarked Keywords May Give Rise To Liability For Trademark Infringement

BY YUVAL H. MARCUS, ESQ.



On April 3, 2009, the United States Court of Appeals for the Second Circuit issued its long-awaited decision in *Rescuecom Corp. v. Google, Inc.* The appeal relates to Google, Inc.’s AdWords service that permits the purchase of a competitor’s trademark as a keyword to trigger sponsored links in search engine results. Trademark owners have challenged this

practice, commencing trademark infringement lawsuits against search engines that sell keywords and competitors who purchase the keywords. In the Second Circuit, district courts have dismissed such lawsuits on the basis that when a trademarked keyword is sold or purchased, it is not used in commerce within the meaning of the Lanham Act. (NOTE: To prevail on a trademark infringement claim, the trademark owner must demonstrate use of its trademark in commerce and a likelihood of confusion.) Courts in other circuits have rejected this conclusion. In *Rescuecom*, the Second Circuit held that the sale by Google of keywords that are trademarks may constitute use in commerce. The decision is a significant departure from prior Second Circuit precedent.

Rescuecom appealed the district court’s decision on

Google’s motion to dismiss which was granted on the basis that the Complaint failed to state a claim for trademark infringement because Google’s sale of the RESCUECOM trademark as a keyword was not a use of the trademark in commerce. The district court relied on the Second Circuit’s decision in *1-800 Contacts v. WhenU.com, Inc.*, 414 F.3d 400 (2d Cir. 2005) (“1-800”) in which the Second Circuit held that including a trademark in an internal database for the purpose of generating pop-up advertisements did not constitute use in commerce. In *1-800*, the Second Circuit stated that “a company’s internal utilization of a trademark in a way that does not communicate it to the public is analogous to an individual’s private thoughts about a trademark.”

In *Rescuecom*, the Second Circuit held that the district court erred in applying the *1-800* decision to the sale of keywords that are trademarks, citing several key distinctions. For example, in *1-800*, the plaintiff’s trademark was included only in an internal database and not made known or available for purchase to advertisers. In contrast, “Google displays, offers and sells Rescuecom’s mark to Google’s advertising customers when selling its advertising services.” The Second Circuit also noted that Google’s Keyword Suggestion Tool recommends certain keywords for possible purchase, including trademarks. The Second Circuit concluded that Google’s recommendation and sale of trademarked keywords are not internal uses. Thus, Rescuecom’s allegations that Google used Rescuecom’s trademark in connection with the sale of advertising services in commerce are sufficient to state a claim for trademark infringement.

In *Rescuecom*, the Second Circuit has joined the other circuits in concluding that the sale of a trademarked keyword constitutes use in commerce under the Lanham Act. Although the *Rescuecom* decision removes an obstacle to succeeding on trademark infringement claims in Second Circuit keyword cases, trademark owners must also prove that the use of the trademark is likely to cause confusion. Companies engaged in online advertising campaigns should carefully consider the risks associated with purchasing keywords that are trademarks of their competitors. ■

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