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Can a “Meta-tag” infringe a registered trade mark?

In the online world where millions of websites exist, it can be difficult to direct traffic to your website and engage with potential users.

Companies spend large parts of their marketing budgets on activities designed to increase the usage of their online presence including an arsenal of tools such as SEO and “pay per click”. An important element of tools such as these are meta-tags. A meta-tag is code that incorporates certain “keywords” and it is used throughout a website to help increase a website’s discover-ability and effectiveness.

Often unknowingly these meta-tags will be identical to or deceptively similar to words which are in part or wholly a registered trade mark. Until recently the Courts did not consider the appearance of these meta-tags as constituting a breach of a trade mark under section 120 of the Trade Marks Act 1995 as the use of the words in this way was not seen as usage “as a mark” by the company. This has all now changed.

In the 2017 Federal Court decision of *Accor Australia and New Zealand Hospitality Pty Ltd -v- Liv Pty Ltd* [2017] FCAFC 56, the Full Federal Court of Australia upheld the findings of Justice Rangiah, that the use of meta-tags was usage as a business name and thus operated as a badge of origin, and hence as a mark under the Trade Marks Act. In this case the words used were deceptively similar to a registered trade mark and hence

a breach of section 120.

Importantly, the Court also held that even though IT consultants were used to create the website and implemented the meta-tags, it was the website owner who was liable for the breach.

As set out in earlier articles by Madison Marcus, trademark breaches can lead to:

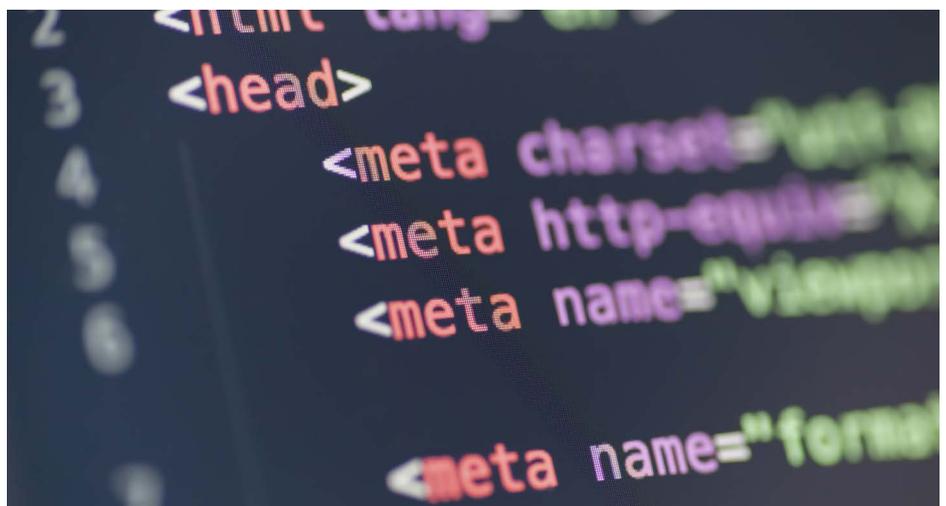
- injunctions or shut down of websites;
- payment of damages; or
- payment of account of profits being payable back to the party whose

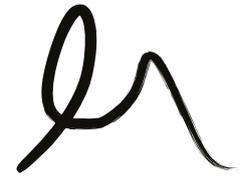
trade mark was infringed.

Therefore proper consideration should be taken before you use any “keyword” on your website.

Lessons and tips

- Business owners should advise their source code or web page creator to avoid using competitors’ registered trade marks in the back end of the website;
- Business owners should examine their current meta-tags and make changes as needed;
- Business owners should check the contractual terms and conditions with their website developers, in particular, in relation to liabilities;





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- Business owners should review the source code of websites of competitors to ascertain if their registered trade mark is appearing as a meta-tag. As a consequence a right to demand the cessation of use of your trade mark will exist.

The Intellectual Property Lawyers at Madison Marcus are experienced in assisting their clients in the proper protection of their registered trade mark and brands.

Our Lawyers can provide assistance when clients are establishing or amending their websites.

Please contact Stephen Jenkins, Partner and Head of the Intellectual Property division at Madison Marcus if you have any questions relating to this article or intellectual property generally.



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