



From Left to Right: Roberta Kraus, Ian Ross Shapiro, Jason M. Koral

December 9, 2005 CLE Luncheon Program on Pop-Up Advertising

On December 9, 2005, the NYIPLA Committees on Internet Law, Meeting and Forums and Continuing Legal Education co-sponsored a CLE Luncheon Program featuring guest speakers Jason Koral and Ian Shapiro, both associated with the law firm of Kronish Lieb Weiner & Hellman LLP. Jason and Ian spoke on the topic of “Pop-Up Advertising, Trademarks and the Current State of The Law.”

The CLE program addressed the trademark issues in pop-up and other targeted Internet advertising systems, such as keywords. The speakers began their presentation by explaining what online contextual marketing is and how it works.

Mr. Koral then summarized the relevant statutes and caselaw, including the WhenU district court decisions of *U-Haul Int’l v WhenU.com, Inc.*, 279 F. Supp.2d 723 (E.D. Va. 2003), *Wells Fargo & Co. v. WhenU.com*, 293 F. Supp.2d 734 (E.D. Mich. 2003), and *1-800 Contacts, Inc. v. WhenU.com*, 309 F. Supp.2d 467 (S.D.N.Y. 2003), *rev’d* 414 F.3d 400 (2d Cir. 2005), *cert. denied*. The focal point of Mr. Koral’s presentation was his elucidation of the various theories of “use” proposed by the brand owner plaintiffs. Mr. Koral ended his segment of the presentation by outlining the Second Circuit’s decision in *1-800-Contacts* case and the plaintiff’s failed attempt at appeal to the Supreme Court.

Mr. Shapiro spoke about another form of contextual online advertising: keywords. Decisions covered included *Playboy Enterprises, Inc. v. Netscape Comm. Corp.*, 354 F.3d 1020 (9th Cir. 2004), *GEICO v. Google, Inc.*, 330 F. Supp.2d 700 (E.D. V. 2004), and *Google, Inc. v. American Blind & Wallpaper Factory, Inc.*, 2005 WL 832398 (N.D. Cal. Mar. 30, 2005). After outlining the differences between pop-up v. keyword advertising, Mr. Shapiro discussed what may constitute trademark use in each context.

Finally, the presentation was concluded with suggestions to keyword advertisers as to how, by learning from the pop-up advertising case law, online use of others’ trademarks can be modified to avoid liability.