

Metatags: the invisible enemy

Website owners should monitor metatags carefully to avoid claims of trademark infringement, as one case in Mexico highlights. **Begoña Cancino** of Creel, García-Cuéllar, Aiza y Enriquez reports.

"Company A" is a leading provider of registry and information management services for personal, commercial and public data records in Mexico. Such a qualification does not come easily: it requires not only a very well-structured plan and management (as all business does) but also, and most important, a very well-drafted set of internal policies intended to process all information and use all digital mechanisms to achieve the business goals.

Most of the activities conducted by Company A depend on the use of owned or licensed IP (including, but not limited to, trademarks, software, databases, etc). Considering that reputation is a very sensitive matter of the utmost importance in this particular industry, Company A has the good internal practice of conducting freedom to operate (FTO) analysis to determine whether a particular IP right can be used without infringing valid rights of third parties.

Company A has a specific department devoted to FTO analysis, which is conducted in-house by employees who are not necessarily familiar with other search engines than those publicly available through the Mexican Institute of Industrial Property (IMPI) and the like.

Company A received a warning letter from one of its competitors alleging unauthorised use of its trademarks on Company A's website. After reviewing its website contents, Company A concluded that such allegations were not grounded and responded to the warning letter in that sense. A couple of months later, however, Company A was served notice by the IMPI with an infringement action.

In the claim, the plaintiff alleged that Company A has been engaged in practices that constitute administrative infringement of trademarks under article 213, section IX of the Mexican Industrial Property Law. It has allegedly performed acts that confuse, mislead or deceive the public by causing it to believe or assume that there exists a relationship or association between the plaintiff's services and Company A's, and to believe that the latter has obtained the plaintiff's authorisations, licences or specifications to that end.

Metatags for search engines

The first approach in response to the claim was to assume that it was not well grounded, but to Company A's surprise, the plaintiff submitted plenty of evidence documenting the alleged unauthorised use. Company A invested a lot of work to review every corner of its website again, until the whole team noticed that the infringement was apparent in the metatags linked to its website.

As the reader may know (but Company A ignored at that time), metatags are codes in the HTML, invisible to the user, that provide search engines with information about the content of a website, what program was used to create the page and any keywords that are relevant to the page (and which, by being relevant, might deserve trademark protection).



ISTOCKPHOTO.COM / JIMKRUGER

"THIS EXPERIENCE ALSO OPENED THE COMPANY'S EYES TO THE NEED FOR CONSIDERING METATAGS AS PART OF ITS OWN TRADEMARK PORTFOLIO AND PROTECTING THEM ACCORDINGLY."

There are different types of metatags (ie, the title tag, description tag, keywords tag, etc), with all of them intended to be used by search engines to index a page so that someone searching for the type of information included in the same may be able to find it. Although metatags are not visible to the users, they are decisive to find information in the World Wide Web, which as of today is the most important channel to advertise, sell and offer products and services all over the world.

In light of the foregoing, the entity responsible for a website should be sure that all metatags linked to it are appropriate and, most of all, that such a company has the proper IP rights to use them. Unfortunately, the IP standpoint is usually forgotten in practice, where a well-written metatag has the main purpose of making the website rank higher in search results.

Lessons learned

Company A found it difficult to prepare an effective defence in the infringement action, where the burden of proving infringement was on the plaintiff, but on the bright side, Company A was able to negotiate with the counterpart and learn from this experience.

Today, Company A has implemented internal policies designed to avoid trademark infringement through the use of metatags and any other links to its website. This experience also opened the company's eyes to the need for considering metatags as part of its own trademark portfolio and protecting them accordingly, to the extent that Company A is including metatags within its monitoring activities.

The key message is that when conducting an analysis to determine whether a website might trigger a potential risk, the interested party needs to look deeper and beyond its contents. It has to consider all metatags and links and other sites that may also lead to trademark infringement, and always keep in mind that what is essential may also be invisible to the eye. ■



Begoña Cancino is a partner at Creel, García-Cuéllar, Aiza y Enriquez. She specialises in IP, data privacy, regulatory and administrative litigation. Cancino counsels clients from all types of industries on the protection and enforcement of their IP rights in Mexico. She also assists with the transfer of IP portfolios within the context of complex corporate transactions involving IP rights. She can be contacted at: begona.cancino@creel.mx