



EU AND UK REGULATION OF LINKING, FRAMING AND METATAGS

Summary

Businesses which use their own websites to carry on e-commerce need to be aware of the intellectual property rights which can be used to protect the contents and the investment made in their websites. In particular, businesses need to be aware of the intellectual property issues surrounding certain Internet practices, namely linking, framing and the use of metatags.

In general, a business which runs a website will want to encourage browsers to visit its site and will therefore be keen to ensure that there are as many links as possible to its site. However, such businesses will also want to retain a degree of control regarding the access to their site via outside links. In particular, there may be circumstances when the linking site is attempting to capitalise on the possibility that browsers may think the link is part of the linking site. Conversely, businesses will want to control the use of “deep linking” which bypasses the home page of their linked site.

Browsing via search engines is a far more common (and effective) way of browsing than by typing in domain names. So, having the right metatags to attract browsers to your website is vitally important. So it is unsurprising, that the mis-use of trade-marks in metatags to divert hits (and therefore business) away from the trade mark owner is emerging as a fertile ground for legal disputes.

Linking and Framing

What is Linking and Deep Linking?

At its simplest, a hypertext link is a highlighted piece of text or an icon on a website which can take the browser directly to another page on the same website or a completely different website. Linking therefore allows the browser to access web-based information quickly and easily without the need for a new search each time.

A “deep link” is a link which takes the browser directly to a particular page on the linked site – bypassing its homepage. Deep links can create even more problems for businesses than simple links, as there is an increased possibility that the browser could be confused as to the connection between the linking site and linked site, potentially damaging the reputation and brand image of the linked site’s business. This increased risk of confusion

may mean it is easier to claim passing off. In the Scottish case of *Shetland Times v Dr Jonathan Wills and Zetnews Ltd*, the defendants provided a deep link to articles on the claimant’s website, bypassing its homepage. The defendants reproduced on their website headlines from the *Shetland Times* and were held to have breached the newspaper’s copyright.

Another concern of deep linking is that the bypassing of the linked site’s homepage will bypass adverts or other promotions/information which may be on the home-page, affecting the advertising revenue of the site and causing problems with advertisers who may have rented space on the site.

For those businesses in the financial services sector, linking to non-authorised sites also raises issues of financial promotion under the Financial Services and Markets Act 2000¹.

What is Framing?

Framing is an alternative way of linking one website to another. Basically, a frame is a link which presents the contents of one or more pages of the linked site’s web pages within a frame on the linking site’s website.

Framing may also take the form of “white labelling”, which occurs where a whole page or pages of a site are contained within another website and are not labelled with the owner’s name, but are shown as part of the framing site. This clearly has the potential to cause confusion in the minds of site users as to the origin of the web page.

How can I control the links to my website and protect its content?

Linking and Copyright

Although websites can have the benefit of copyright as literary works, there is no “infringing act” (i.e. copying) caused by a link. A link permits direct access to the other site – no copying of the linked website is caused. This applies to both simple links and deep links.

Linking and Passing Off

¹ See Sidley Austin Brown & Wood London’s briefing paper “UK Regulation of Online Financial Promotion”.



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If the link is presented in such a way that it could cause confusion to the browser regarding the connection between the linking site and the linked site, the owner of the linked site may have an action for passing off against the owner of the linking site, providing it can show the existence of a reputation or goodwill in relation to the goods or services supplied, that there is confusion in the minds of members of the public, and that there has been damage caused to the claimant.

Linking and Database Rights

Although links will not infringe the copyright of the linked site, it is possible that they could infringe the database right of the linked site. The database right was introduced by the Copyright and Rights in Database Regulations 1998 (the "Regulations") which implemented the provisions of the EC Directive on the Legal Protection of Databases (the "Database Directive").

The database right prevents the unauthorised extraction and re-utilisation of the contents of a database. "Database" is given a very broad definition in the Database Directive and the Regulations, and can include a collection of pages on a website provided they are laid out in a systematic and methodical way, and there has been a substantial investment in obtaining, verifying or presenting the information on the website pages².

There is as yet no UK case law on database rights involving linking, but it has been argued in other European member states that that the storing of the links to the linked sites' web-pages can amount to extraction and re-utilisation of those pages. Also, causing the browser to access the page from the link can amount to re-utilisation of the underlying information in the linked site even though there are no copies made of the information.

This was the approach taken in a recent German case on this issue regarding the provisions of the Database Directive (*Step Stone v. OFiR* [2001]). In this case, Danish media group OFiR were using deep links to Stepstone's German job site, so that Stepstone's home page was bypassed and visitors did not see its banner advertising. Stepstone were granted an injunction to stop OFiR using the links.

The UK courts have interpreted the database right as giving a broad protection to the rights of the "database"

owner (*British Horse Racing Board v. William Hill* [2001]). Although this case has been referred to the European Court of Justice, it seems likely that under English law database owners will be able to take action against sites which infringe their rights through linking or framing provided that their sites meet the database criteria laid out in the Regulations.

Framing and Website Protection

Framing raises similar intellectual property issues to linking. As with linking, it would be difficult to show copyright infringement regarding unauthorised framing, as no copies are made through this technique (although any adaptation of the page within the frame by the linking site could in theory infringe copyright). It may, however, be easier to claim passing off in the case of a framing site, as the likelihood of confusion in the mind of the browser as to the origin of the framed site may be greater.

In the UK, Haymarket, the publisher commenced proceedings against Burmah Castrol oil for infringement of copyright and passing off. The claim concerned links on Castrol's website which framed content from two of Haymarket's sites, *whatcar.com* and *autosport.com*. The matter was settled out of court, with Castrol writing a letter accepting that they should not have framed the Haymarket site without permission and would not do so again.

It is also possible that framing could infringe the database right of the framed site. The German database right case on framing (*Baumarket.de* [1999]) considered this issue. The German court found that a set of webpages could be a database, and thus the rights of the owner could be infringed by unauthorised extraction and re-utilisation through framing. However, in the above case, the Court found that the owner was unable to take advantage of the database right as there had not been a substantial investment in the database as required by the provisions of the Directive (and consequently the UK Regulations).

It is clear that the only safe way to carry out framing is to put in place a Framing Agreement between the owner of the content being framed and the owner of the framing site.

Metatags

What are Metatags?

Metatags consist of a series of words which form part of the Hypertext Mark Up Language (HTML) of a particular

² For further details, see Sidley Austin Brown & Wood London's paper entitled "EU Database Rights – A Valuable Source of Revenue?"



website. Metatags are used to describe the content of a website, thus making it easier for browsers using search engines to locate particular websites of interest. For example, sidley.com's metatags include "Sidley Austin Brown & Wood", "Law Firm" and "Legal Services" amongst others.

Trade mark Infringement and Metatagging

Under the Trade Marks Act 1994, there are 3 potential types of trade mark infringement:

- The use of a sign or a mark identical to one which has been registered as a trade mark in relation to identical goods or services. It is not necessary to show that the consumer has been confused by the identical marks as to the origin of the goods or services.
- The use of a sign or mark similar or identical to one which has been registered as a trade mark in relation to similar or identical goods or services. Here it is necessary to show that there has been a "likelihood of confusion" between the marks in order to prove the infringement. The issue here is therefore whether a consumer using a search engine which displays 10-20 results when searching for a trade-marked and metatagged word or phrase will be "confused" by the different results. In the recently decided case of *Reed v Reed* [2002], it was held that a trade mark could be infringed by "invisible uses" such as use of trade marks as a metatag in a website's source code. In this case, the defendant's services were found to be similar to the claimant's, although not identical. Confusion had arisen in the minds of members of the public about whether the parties' services were connected. The claimant succeeded in its claim for trade mark infringement and passing off.
- The use of a sign or a mark which is identical or similar to one which has been registered as a trade mark in relation to non-similar goods or services where the owner of that trade mark has established a reputation and the later mark takes unfair advantage or is detrimental to that reputation. A good example of this would be a pornographic site metatagging a well known trade mark like McDonalds, Starbucks or Disney. There is no need to show confusion.

There are two exceptions regarding the lawful use of a third party's trade mark which have particular relevance

to the use trade marks in metatags or elsewhere on the infringing party's website:

- The use of a third party's trade mark for the purposes of comparative advertising provided that such use is in "accordance with honest practices in industrial or commercial matters". So, using a competitor's trade mark in a metatag for the purposes of drawing customers attention to a comparative advert on the business's website is legitimate, provided that such advertising is not dishonest. However, it is thought that such a trade mark should be placed on the comparator's homepage with the comparative wording rather than just the metatag to ensure that this lawful exception can apply.
- The use of a third party's trade mark for re-sale of the relevant trade-marked goods or services, provided that such use does not damage the value of the trade mark (*Parfums Christian Dior S.A. v. Eora B.V.* [1998] and *Zino Davidoff S.A. v. A & G Imports Ltd* [2000]). Thus, web-based re-sellers of trade-marked products can use such trade marks in their metatags or on their websites without infringing the mark.

Passing Off and Metatagging

An action for passing off requires an element of confusion to be satisfied. In the recent UK case (*Roadtech Computer Systems Limited v. Mandata Limited* [2001]), Roadtech had registered "Roadrunner" and "Roadtech" as trade marks. Mandata, a competitor of Roadtech, used these two trade-marked terms as metatags on its website and in the hidden text on its homepage, with the intention of diverting search engine hits away from the Roadtech site to its site.

Roadtech demanded that Mandata remove its trade marks from its metatags and website. Mandata failed to remove the marks, and Roadtech issued proceedings for trade mark infringement and passing off. Mandata admitted trade mark infringement, but disputed the passing off claim. The court found for Roadtech on the passing off, and awarded £15,000 in damages for the damage done to Roadtech's business as a result of Mandata "taking a ride" on Roadtech's reputation.

The above case was a clear cut instance of a competitor passing off another's trade marks as its own. Indeed, Mandata precluded the court addressing the application of the Trade Marks Act 1994 to metatags by admitting trade mark infringement. However, not all metatag issues



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will be so straightforward. Businesses using the internet as a commercial forum need to be aware of the limits of trade mark infringement and passing off regarding the use of metatags, and the tactics which can be used to protect their trade marks (and ultimately business) on the web.

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Next Steps

Trade mark owners should be vigilant in monitoring the Internet for any infringing activity relating to their trade marks to ensure the goodwill and reputation they have built up in their marks is not diluted. This can be achieved by:

- incorporating terms and conditions of use into the website which explain the owner's policy on framing and linking. Owners should be careful to ensure that such terms and conditions are incorporated into the contract between web-users and the website owner by posting them clearly on the home page, or better still, making access to the website conditional on accepting the terms and conditions of use;
- using technical solutions such as web protection software which permits access only from specified addresses (such as search engines) if unauthorised linking or framing continues to be a problem;
- conducting regular search engine based searches using trade mark names, and regular searches of competitors' websites to check whether any infringing activity is occurring.

If the website owner is considering placing links to other websites on its site, there are various measures the owner can take to protect itself from infringing any rights the linked site may have:

- ensure that any links or frames abide with the linked site's terms and conditions;
- obtain consent from the owner of the linked site to frame or link through putting in place a framing or linking agreement;
- avoid using the linked site's trade mark as a link, as in certain circumstances this could be trade-mark infringement;
- check that the linked site does not contain illegal or infringing content itself and if the linking site is in the financial services sector, consider the financial promotion regime under the Financial Services and Markets Act 2000;
- ensure that employees are made aware of the owner's policy on the creation of links or frames.

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