

LEGAL UPDATE

THIRD PARTY POP-UP ADVERTISEMENTS: *U-HAUL INT'L, INC. V. WHENU.COM*

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I. INTRODUCTION

Pop-up advertising has been an enormous success for internet advertisers¹ and a huge annoyance to internet users.² Pop-up advertisements automatically open a new browser window containing an advertisement.³ Originally, these pop-up windows were spawned solely by the web page that the user was currently visiting, however companies such as The Gator Corporation (“Gator”) and WhenU.com (“WhenU”) have developed software that spawns pop-up windows without identification of their source.⁴

While some internet publishers and site owners sell and produce pop-up advertisements as part of advertising agreements, other publishers and site owners have challenged the use of the advertisements that automatically pop-up from hidden third-party sources.⁵ There have been a number of lawsuits against these third party pop-up advertisers, but the issue of whether the use of these types of advertisements infringe on the trademark or copyright rights of

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¹ Brian Morrissey, *Study: Pop-Ups Work*, INTERNET ADVERTISING REPORT, May 28, 2003, at <http://www.internetnews.com/IAR/article.php/2213101>.

² David A. Vise, *AOL Says It Will Phase Out Pop-Ups; A Victory for Users As Ad Revenue Sags*, THE WASHINGTON POST, Oct. 16, 2002, at E1 (explaining that America Online plans to phase out pop-up advertisements due to user complaints).

³ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *27-28 (E.D. Mi. Nov. 19, 2003).

⁴ Bob Tedeschi, *E-Commerce Report; Legal Battles Pit Online Advertising Companies That Create Pop-Up Ads Against the Owners of Web Sites*, N.Y. TIMES July 7, 2003, at C6 (“Rather than being displayed by the site’s publisher, these ads are triggered by software that resides on a user’s computer.”).

⁵ *Id.*

the internet publisher or site owner has yet to be clearly determined.⁶

The summary judgment decision in *U-Haul International, Inc. v. WhenU.com*⁷ addressed trademark and copyright infringement claims brought by a website owner against a third party pop-up advertiser. The court concluded that the advertiser did not infringe either the trademark or copyright of the web site owner.⁸ However, other recent cases have resulted in preliminary injunctions holding that publishers are likely to prevail on trademark infringement claims.⁹

II. BACKGROUND

A. Pop-up Advertising Cases

Numerous website publishers have brought suits against the purveyors of third party pop-up advertisements. WhenU and Gator are the two major advertising companies that have been subject to these suits. At the time of this writing, only the *U-Haul* case has reached a final judgment, but courts in several other cases have issued preliminary injunctions. The *U-Haul* decision will have strong ramifications for pending lawsuits which focus on similar facts.

Prior to the *U-Haul* decision, the Eastern District Court of Virginia (the same court that decided *U-Haul*) issued a preliminary injunction against pop-up advertiser Gator in *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*¹⁰ In that case, the court enjoined Gator from “[c]ausing its pop-up advertisements to be displayed on any website owned by or affiliated with the Plaintiffs” until the conclusion of the trial.¹¹ The parties reached a settlement agreement and ceased litigation before the case went to trial.¹²

Gator has settled at least one other lawsuit alleging that the use of pop-up advertisements infringes the publisher’s intellectual property rights.¹³ Nine other actions involving Gator and concerning the use of pop-up advertisements

⁶ See *infra* pp. 2-3.

⁷ *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723 (E.D. Va. 2003).

⁸ *Id.* at 726.

⁹ *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *104 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004); *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 U.S. Dist. LEXIS 20879, at *1 (E.D. Va. July 16, 2002).

¹⁰ *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 U.S. Dist. LEXIS 20879, at *1 (E.D. Va. July 16, 2002).

¹¹ *Id.*

¹² *Hertz Corp. v. Gator Corp.*, 250 F. Supp. 421, 423 n.1 (D.N.J. 2003).

¹³ *Id.*

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remain in dispute.¹⁴ In April, 2003, the Judicial Panel on Multidistrict Litigation consolidated these cases to be heard in the Northern District of Georgia.¹⁵ That court has not yet reached its decision.

Similar cases are also pending against WhenU.¹⁶ In *Wells Fargo & Co. v. WhenU.com*,¹⁷ the Eastern District of Michigan denied a website publisher's motion for a preliminary injunction.¹⁸ This post *U-Haul* decision relied on much of the same case law and rationale as the *U-Haul* decision, and the court cited *U-Haul* to support its reasoning.¹⁹ However, in the recent *1-800-Contacts, Inc. v. WhenU.com*²⁰ decision, a court granted a website publisher's motion for a preliminary injunction.²¹ At the time of writing, *1-800-Contacts* is pending appeal in the Second Circuit.²²

B. The U-Haul Case

The *U-Haul* case may prove very influential in determining the outcome of the pending Gator cases. However, recent decisions have produced varied outcomes under similar facts.²³ The facts and allegations in the *U-Haul* case are similar to those in other pending pop-up advertising litigation.²⁴

¹⁴ See *In re Gator Corp. Software Trademark & Copyright Litigation*, 259 F. Supp. 2d 1378, 1380 (J.P.M.L. 2003).

¹⁵ *Id.* (transferring the pending Gator cases to the Northern District of Georgia for coordinated or consolidated proceedings).

¹⁶ *Hertz Corp.* 250 F. Supp. 421, 423-424 (noting that there were four cases pending involving WhenU and pop-up advertising on March 13, 2003).

¹⁷ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756 (E.D. Mi. Nov. 19, 2003).

¹⁸ *Id.* at *112.

¹⁹ See *id.* at *62-107.

²⁰ *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *119-120 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).

²¹ *Id.*

²² *Id.*

²³ Compare *Washingtonpost.Newsweek Interactive Co. v. Gator Corp.*, 2002 U.S. Dist. LEXIS 20879, at *1 (E.D. Va. July 16, 2002), and *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *119 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004) (granting a preliminary injunction in favor of plaintiff website publishers), with *Wells Fargo & Co.*, 2003 U.S. Dist. LEXIS 20756, at *112 (denying plaintiff website publishers' motion for preliminary injunction).

²⁴ Compare *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723 (E.D. Va. 2003), with *Wells Fargo & Co.*, 2003 U.S. Dist. LEXIS 20746; see *Hertz Corp. v. Gator Corp.*, 250 F. Supp. 421, 423 n.1 (D.N.J. 2003) (noting that four cases involving WhenU.com involve similar issues to a Gator case); see also *In re Gator Corp. Software Trademark & Copyright Litigation*, 259 F. Supp. 2d 1378, 1380 (J.P.M.L. 2003) (finding that nine pending cases involving pop-up advertising involve common questions of fact).

WhenU distributes free software bundled with a program called SaveNow.²⁵ When a user installs the free software and accepts the license agreement, the SaveNow program is also installed on that user's computer.²⁶ The SaveNow program creates a directory of search phrases, websites, and keyword algorithms.²⁷ It then monitors the user's internet browsing activity and searches the created directory for similar information.²⁸ When the user's activity matches an item from the SaveNow directory, the SaveNow program causes an advertisement to open in a new browser window (to "pop-up").²⁹

The result of this system is that when a user with the SaveNow program installed visits the U-Haul website, the SaveNow program causes a pop-up advertisement to appear.³⁰ Often, the advertisements that SaveNow produces are for a rival or competing product.³¹

U-Haul brought several claims against WhenU for this practice. They alleged that WhenU's software infringed on Uhaul's trademarks and violated unfair competition and trademark dilution laws.³² They also alleged that WhenU violated Uhaul's copyrights.³³ Plaintiffs in similar cases have alleged the same.³⁴

III. THE ANALYSIS OF *U-HAUL*

A. Trademark Arguments

U-Haul alleged that WhenU violated U-Haul's trademark and unfair competition rights by causing pop-up advertisements to appear on the user's computer screen next to the U-Haul website and logo and additionally by WhenU's use of the "U-Haul" mark in the software that determines which advertisements to show.³⁵ The court applied the five-factor test articulated in

²⁵ *U-Haul*, 279 F. Supp. 2d at 725.

²⁶ *Id.*

²⁷ *Id.*

²⁸ *Id.* at 725-726.

²⁹ *Id.* at 726.

³⁰ *See id.*; *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *23 (E.D. Mi. Nov. 19, 2003) (explaining that the web address that the user enters into the browser causes a related advertisement to appear)

³¹ *Tedeschi*, *supra* note 4; *see e.g.* *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *54-56 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004) (explaining that the advertisements triggered by WhenU's software are for a company that is in direct competition with the plaintiff publisher).

³² *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 726 (E.D. Va. 2003).

³³ *Id.*

³⁴ *See supra* text and accompanying notes 2-3.

³⁵ *U-Haul*, 279 F. Supp. 2d at 727.

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People for the Ethical Treatment of Animals v. Doughney.³⁶ “A plaintiff alleging causes of action for trademark infringement and unfair competition must prove ‘(1) that it possesses a mark, (2) that the defendant used the mark, (3) that the defendant’s use of the mark occurred ‘in commerce’, (4) that the defendant used the mark ‘in connection with the sale, offering for sale, distribution, or advertising’ of goods or services, and (5) that the defendant used the mark in a manner likely to confuse consumers.’”³⁷

The court found that WhenU’s use of the marks did not meet the third element of this test.³⁸ “WhenU’s pop-up advertisements do not constitute ‘use in commerce’ of U-Haul’s trademarks.”³⁹ The court gave four reasons for this finding.

1. Single Presentation Argument

First, the court addressed U-Haul’s argument that WhenU’s advertisements appeared as “a single visual presentation of U-Haul’s website.”⁴⁰ The court noted that the pop-up advertisement opens in a new window that is clearly identified.⁴¹ It also pointed out that multiple windows are part of the user experience in a Microsoft Window’s operating environment.⁴² Therefore, the court reasoned, the pop-up window does not appear as part of a single visual presentation.⁴³

The *Wells Fargo* preliminary injunction decision, which generally mirrors the analysis of *U-Haul*, also addresses the “single visual presentation” argument.⁴⁴ In its factual findings, the court in *Wells Fargo* elaborated on the relationship of pop-up windows to websites. *Wells Fargo* notes that “[the] graphical computer ‘desktop’ was intentionally designed to represent what a user would experience when using an actual physical desktop . . . [t]he advertisements and coupons that SaveNow delivers to a participating consumer’s desktop appear in a window . . . which is separate and distinct from any other window already open on the desktop.”⁴⁵

³⁶ *People for the Ethical Treatment of Animals v. Doughney*, 263 F.3d 359, 364 (4th Cir. 1995).

³⁷ *U-Haul*, 279 F. Supp. at 727 (quoting *People for the Ethical Treatment of Animals*, 263 F.3d at 364).

³⁸ *U-Haul*, 279 F. Supp. at 727.

³⁹ *Id.*

⁴⁰ *Id.* at 727-728.

⁴¹ *Id.*

⁴² *Id.*

⁴³ *Id.*

⁴⁴ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *70-77 (E.D. Mi. Nov. 19, 2003).

⁴⁵ *Wells Fargo*, 2003 U.S. Dist. LEXIS 20756, at *16-17, *27.

Wells Fargo also addressed an additional presentation argument. The plaintiffs alleged that the positioning of the pop-up advertisements “gives consumers the ‘impression that the pop-up is affiliated with or approved by the plaintiffs.’”⁴⁶ Plaintiffs in *Wells Fargo* cited *Hard Rock Cafe International (USA) v. Morton*⁴⁷ to support this argument.⁴⁸ In *Hard Rock Cafe*, the court explained that when a web page is framed within another web page, it may be unclear to the computer user that the pages are from different sources.⁴⁹ The court in *Wells Fargo* dismissed this argument by distinguishing the pop-up advertisements from the framed web pages of the *Hard Rock Cafe* case.⁵⁰ “WhenU’s advertisements pop-up and partially overlap plaintiffs’ sites on the computer screen, it seems apparent to the user that what is appearing on his or her screen are two distinct sources of material.”⁵¹

However, in contrast to both *U-Haul* and *Wells Fargo*, the recent *1-800-Contacts, Inc. v. WhenU.com* preliminary injunction decision found that pop-up advertisements appearing next to web pages are displayed “in the . . . advertising of” the defendant’s product.⁵² In *1-800-Contacts*, the court found that that pop-up advertisements triggered by a competitor’s web page can constitute use in commerce.⁵³ “Here, WhenU.com is doing far more than merely “displaying” Plaintiff’s mark. WhenU’s advertisements are delivered to [the user] when the user directly accesses Plaintiff’s website . . .”⁵⁴

2. Comparative Advertising Argument

The *U-Haul* decision next addresses the argument that causing the simultaneous display of the “U-Haul” mark and an advertisement for a competing product would satisfy the “use” requirement.⁵⁵ The court cited comparative advertising cases that authorize the use of a competitor’s trademark as long as the mark does not create confusion about origin or quality.⁵⁶ The court explained that the simultaneous display of the U-Haul website and the WhenU advertisement that results from the Windows

⁴⁶ *Id.* at *70-71.

⁴⁷ *Hard Rock Cafe International (USA), Inc. v. Morton*, 1999 U.S. Dist. LEXIS 8340 (S.D.N.Y. June 1, 1999).

⁴⁸ *Wells Fargo*, 2003 U.S. Dist. LEXIS 20756, at *70-71.

⁴⁹ *Id.* (citing *Hard Rock Cafe International* 1999 U.S. Dist. LEXIS 8390, at *24-25).

⁵⁰ *Id.* at *75-76.

⁵¹ *Id.* at *75.

⁵² *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *54 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).

⁵³ *Id.* at *54-57.

⁵⁴ *Id.* at *57.

⁵⁵ *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 728 (E.D. Va. 2003).

⁵⁶ *Id.*

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operating environment does not constitute “use” for the purposes of determining trademark infringement.⁵⁷

3. URL / Machine Linking Argument

The third argument that the *U-Haul* decision addressed was whether WhenU’s use of U-Haul’s uniform resource locator (“URL”) and the “U-Haul” mark in the SaveNow computer program could constitute “use in commerce.”⁵⁸ The court relied on the facts that WhenU did not sell or display the U-Haul URL or mark.⁵⁹ Therefore, the court reasoned, WhenU’s use could not constitute “use in commerce” because the mark and URL were used purely for their machine-linking function.⁶⁰ Neither was ever displayed to the consumer.⁶¹

The *Wells Fargo* decision elaborated on the machine linking argument.⁶² In *Wells Fargo*, plaintiffs argued that the use of a trademark for a machine linking function can satisfy the “use in commerce” requirement of a trademark infringement claim.⁶³ The *Wells Fargo* decision explained that most courts addressing this issue have held that the use of trademarks in metatags (a type of machine linking use) can violate the Lanham Act if the use also causes customer confusion or initial interest confusion.⁶⁴

The *Wells Fargo* decision, however, distinguishes WhenU’s use of trademarks.⁶⁵ The court reasoned that WhenU’s “keying” a trademark to cause certain advertisements to appear is not “use in commerce.”⁶⁶ “[The use of plaintiff’s URLs] to identify websites . . . does not constitute the ‘use’ of any trademark belonging to plaintiffs . . . because WhenU does not use any of the plaintiffs’ trademarks to indicate anything about the source of the products or services it advertises.”⁶⁷

Again, however, the recent *1-800-Contacts* decision reaches the opposite result. In that case, the court accepted the argument that machine linking can constitute use.⁶⁸ “Defendant WhenU.com includes Plaintiff’s URL . . . in the

⁵⁷ *Id.*

⁵⁸ *Id.* at 728.

⁵⁹ *Id.*

⁶⁰ *Id.*

⁶¹ *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 728 (E.D. Va. 2003).

⁶² *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *78-85 (E.D. Mi. Nov. 19, 2003).

⁶³ *Id.* at *78-83.

⁶⁴ *Id.* at *80.

⁶⁵ *Id.* at *82.

⁶⁶ *Id.*

⁶⁷ *Id.* at *79.

⁶⁸ *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *55

proprietary WhenU.com directory of terms that triggers pop-up advertisements In so doing, Defendant WhenU.com “uses” Plaintiff’s mark, by including a version of Plaintiff’s . . . mark, to advertise and publicize companies that are in direct competition with Plaintiff.”⁶⁹

4. Interference with Website Argument

The fourth “use” argument that the *U-Haul* decision addresses is whether WhenU’s software interferes with U-Haul’s website.⁷⁰ This argument relied on the “proposition that interference with a Web page constitutes a use in commerce.”⁷¹ The court distinguished the case at bar from those cited by U-Haul on the grounds that WhenU’s software did not prevent or hinder access to the U-Haul website.⁷² Users of WhenU’s SaveNow software accepted the SaveNow license agreement and experienced the same pop-up windows as those generated by other programs.⁷³ The court reasoned that the pop-up advertisements have no different effect on the user’s viewing of a website than any other pop-up window such as an email notification window.⁷⁴

5. Trademark Dilution and Unfair Competition

After finding that U-Haul did not satisfy the “use” element of trademark infringement and unfair competition, the *U-Haul* court quickly addressed the trademark dilution claim.⁷⁵ It reasoned that, because the “use” element, also required for a showing of trademark dilution, was not satisfied, U-Haul’s dilution claim also fails.⁷⁶

B. Copyright Arguments

In addition to alleging trademark violations, U-Haul claimed that WhenU’s pop-up advertisements violated the copyright of the U-Haul website.⁷⁷ The subsequent *Wells Fargo* and *1-800-Contacts* preliminary injunction cases mirror the arguments and conclusions of *U-Haul*.⁷⁸ U-Haul contended that

(S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).

⁶⁹ *Id.*

⁷⁰ *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 728-729 (E.D. Va. 2003).

⁷¹ *Id.* at 728.

⁷² *Id.* at 729.

⁷³ *Id.*

⁷⁴ *Id.*

⁷⁵ *Id.*

⁷⁶ *U-Haul Int’l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 729 (E.D. Va. 2003).

⁷⁷ *Id.* at 728-731.

⁷⁸ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *100-106 (E.D. Mi. Nov. 19, 2003); *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *40-51 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan.

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WhenU's pop-up advertisements created and displayed an altered U-Haul web page that constituted a derivative work of the original U-Haul web page.⁷⁹ The court concluded that WhenU neither displayed nor altered the U-Haul web page by using a pop-up advertisement.⁸⁰

U-Haul supported the display right violation argument by relying on *New York Times Co. v. Tasini*.⁸¹ *Tasini* holds that the reproduction of newspaper articles in electronic databases violated the rights of the authors.⁸² The *U-Haul* court distinguished the case at bar on the grounds that WhenU did not reproduce U-Haul's copyrighted material.⁸³ The *Wells Fargo* and *1-800-Contacts* decisions found the same.⁸⁴

U-Haul addressed the claim that WhenU violated U-Haul's derivative work right in two ways. First, the court noted that case law requires a work to be independently copyrightable to qualify as a derivative work.⁸⁵ Because WhenU's pop-up window is "a transitory occurrence," the court reasoned that it was not independently copyrightable.⁸⁶ Second, the court explained that the "[Microsoft] Window's environment permits a user to open multiple application and windows at the same time, with the different windows overlapping one another."⁸⁷ The court reasoned that overlapping windows is just an aspect of the way the user's desktop is displayed and that an overlapping window therefore does not constitute a derivative work.⁸⁸

Wells Fargo and *1-800-Contacts* applied similar arguments. In *Wells Fargo* the court explained that WhenU does not create a derivative work because the software does not access the plaintiffs' websites.⁸⁹ It therefore cannot incorporate the plaintiffs' websites into a new work.⁹⁰ The court explained further that, "even if the presence of an overlapping window could be said to change the appearance of the underlying window . . . the mere alteration of the

23, 2004).

⁷⁹ *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 729-730 (E.D. Va. 2003).

⁸⁰ *Id.* at 731.

⁸¹ *New York Times Co., Inc. v. Tasini*, 533 U.S. 483 (2001).

⁸² *Id.* at 506.

⁸³ *U-Haul*, 279 F. Supp. at 730.

⁸⁴ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *102 (E.D. Mi. Nov. 19, 2003); *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *41 n.37 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).

⁸⁵ *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 731 (E.D. Va. 2003).

⁸⁶ *Id.*

⁸⁷ *Id.*

⁸⁸ *Id.*

⁸⁹ *Wells Fargo & Co. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 20756, at *101 (E.D. Mi. Nov. 19, 2003).

⁹⁰ *Id.*

manner in which an individual consumer's computer displays the content sent by plaintiffs' websites does not create a derivative work."⁹¹ The court found that there was no contributory infringement because there was no reproduction of the work and because the computer user does not create a fixed work.⁹²

The *1-800-Contacts* decision also found that the Plaintiff publisher failed to meet the fixation requirement of a derivative work infringement claim.⁹³ In addition, the court reasoned that a derivative work definition that included the overlapping display of browser windows could not be valid.⁹⁴ Such a definition would be so broad as to require the Plaintiff's permission for any use overlapping windows, but the use of overlapping windows is a common method of multi-tasking with a computer.⁹⁵

IV. CONCLUSION

The *U-Haul* case is the first pop-up advertising case to reach a decision, and it has set the foundation for the analysis of the many pending third party pop-up advertising cases. While courts seem to agree that the use of third party pop-up advertisements do not violate the copyright of the internet publishers, they have yet to reach a consensus on whether these advertisements violate the trademark rights of the publishers. Much rests on courts' characterizations of this relatively new advertising medium.

U-Haul's analysis rests primarily on an interpretation of pop-up advertisements as separate websites within the Microsoft Windows operating environment. These separate windows do not "use" plaintiffs' trademarks or modify plaintiffs' websites.⁹⁶ However, other courts have interpreted pop-up advertisements the other way, finding that consumers may indeed consider them part of the plaintiffs' websites.⁹⁷ This most recent interpretation favors website publishers in pop-up advertising suits because the "use" element of trademark infringement claims is satisfied. However, the lack of case law exploring the subject of third party pop-up advertisements leaves much to be determined. Specifically, the conflicting decisions over trademark infringement arguments leave room for further argument on both sides of the issue.

⁹¹ *Id.*

⁹² *Id.* at *102-103.

⁹³ *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *48-49 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).

⁹⁴ *Id.* at *50-51.

⁹⁵ *Id.*

⁹⁶ *U-Haul Int'l, Inc. v. WhenU.com, Inc.*, 279 F. Supp. 2d 723, 725 (E.D. Va. 2003).

⁹⁷ *1-800-Contacts, Inc. v. WhenU.com, Inc.*, 2003 U.S. Dist. LEXIS 22932, at *54 (S.D.N.Y. Dec. 22, 2003), *appeal docketed*, No. 04-0446-cv (2d Cir. Jan. 23, 2004).