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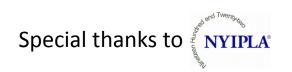








SheppardMullin





The McCarthy Institute

Online Platforms: Trademark Rights and Relevance

- Marc Greenberg, Professor of Law, Golden Gate University School of Law (moderator)
- Marc Cooperman, Attorney, Banner Witcoff
- Xinghao Wang, Director, Global IP Enforcement, Alibaba Group
- Eric Gelwicks, Director, Business & Legal Affairs, Live Nation
- Dan Chen, Senior Partner, G.M., Unitalen IP Consulting LLC
- Patchen Haggerty, Partner, Perkins Coie
- Michael Kelly, Senior Corporate Counsel, IP, Amazon
- David Franklyn, Professor of Law, Golden Gate University School of Law

Overview of TM Online Platform Law "The Wild West" **



Marc Cooperman
Brian Apel
Banner & Witcoff, Ltd

Starring Roles

The Rancher (Brand Owner):



The Cattle Rustler (Infringer):





Authentic "PUCCI" Handbags



Counterfeit "PUCCI" Handbags



Other Similar Handbags

Supporting Role

Online Platform

Bystander?





General Store Owner?

Deputy?



Potential Platform Liability

(TM Law First Principles)

Direct (Strict Liability)



Indirect (Knowledge)



Platform Liability Leading Case

Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010)

Both authentic and counterfeit Tiffany products sold on eBay



eBay knew of counterfeiting

eBay precautions:

- "Trust & Safety" Team
- Notice and takedown provisions
- Warnings when sellers listed products



No direct or indirect liability

Potential <u>Direct</u> Platform Liability



Actions Under Scrutiny

<u>Sales</u> of trademarked products on platform

- Platform sold (traditional analysis)
- Third party sales (*Tiffany*)

Potential <u>Direct</u> Liability

Platform Response Matter? (Notice & Takedown)



"As we discuss below, eBay's knowledge vel non that counterfeit Tiffany wares were offered through its website is relevant to the issue of whether eBay contributed to the direct infringement of Tiffany's mark by the counterfeiting vendors themselves, or whether eBay bears liability for false advertising. But it is not a basis for a claim of direct trademark infringement against eBay, especially inasmuch as it is undisputed that eBay promptly removed all listings that Tiffany challenged as counterfeit and took affirmative steps to identify and remove illegitimate Tiffany goods."

Potential <u>Direct</u> Liability



Actions Under Scrutiny

Advertising of trademarked products on platform

- False advertising suggesting infringing/counterfeits are authentic
- 2nd Circuit gave traction
- Failed on remand

Use of trademarks on platform

- Metatags/Search Algorithms
- 1-800 Contacts, Inc. v. Lens.com, Inc., 722 F.3d 1229 (10th Cir. 2013)

Potential Indirect Platform Liability



Actions Under Scrutiny

<u>Third Party Sales</u> of trademarked products on platform

Platform Knowledge, Response (or Lack of Response) and Control are Key

Platform Liability Key Case

Inwood Labs., Inc. v. Ives Labs., Inc., 456 U.S. 844, 854 (1982)

Knowledge for contributory trademark infringement requires either:

(1) Intentionally inducing another to infringe a mark

or

(2) Continuing to supply a product (or service) to one it knows, "or has reason to know" is engaging in infringement

Potential Indirect Liability

Platform Knowledge, Response & Control Matter (General v. Specific)



"For contributory trademark infringement liability to lie, a service provider **must have more than a general knowledge** or reason to know that its service is being used to sell counterfeit goods. Some contemporary **knowledge of which particular listings** are infringing or will infringe in the future is necessary."

-Tiffany, 600 F.3d at 107

Potential Indirect Liability

Platform's Control of Marketplace



"Direct control and monitoring of the instrumentality used by a third party to infringe the plaintiff's mark permits the expansion of *Inwood Lab*.'s "supplies a product" requirement for contributory infringement."

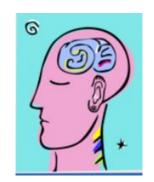
- Lockheed Martin Corp. v. Network Sols., Inc., 194 F.3d 980, 984 (9th Cir.

1999)

Potential Indirect Liability

Platform Knowledge, Response & Control Matter

(Willful Blindness, at what point?)



Constructive knowledge can be shown through **willful blindness** – suspecting wrongdoing and deliberately failing to act.

- Hard Rock Cafe Licensing Corp. v. Concession Services, Inc., 955 F.2d 1143, 1148 (7th Cir. 1992)
- Louis Vuitton Malletier, S.A. v. Akanoc Sols., Inc., 658 F.3d 936, 943 (9th Cir. 2011) (citing Amazon.com, 508 F.3d at 1172) ("'Intent may be imputed' as a result of 'a service provider's knowing failure to prevent infringing actions."').

**Graphics

Wannapik Studio www.wannapik.com



Bag Graphics from GUCCI

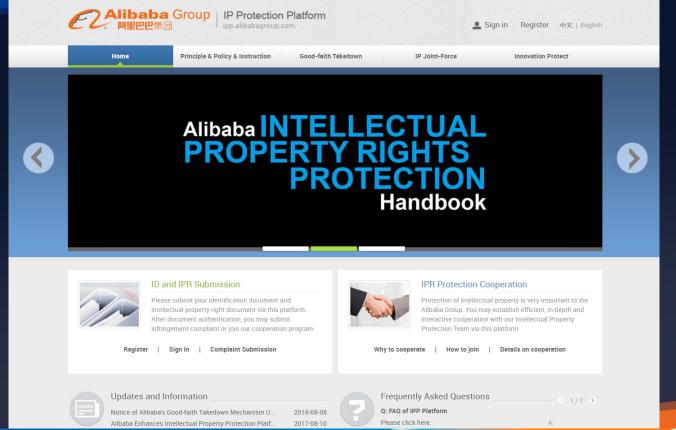
Alibaba IPR Protection Program

Alibaba Group 阿里巴集团

THE ALIBABA ECOSYSTEM

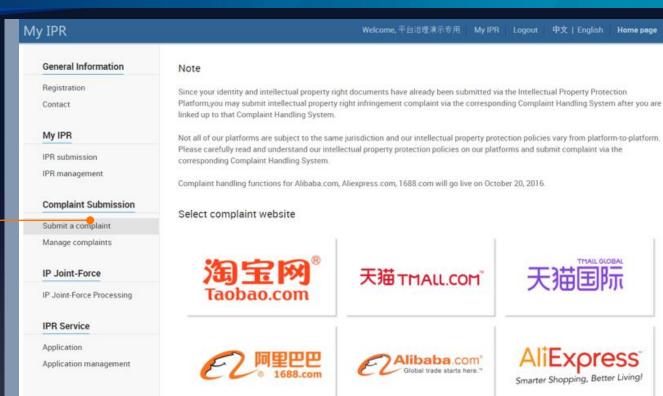


NOTICE AND TAKEDOWN - IPP PLATFORM





NOTICE AND TAKEDOWN - IPP COMPLAINT SUBMISSIONS



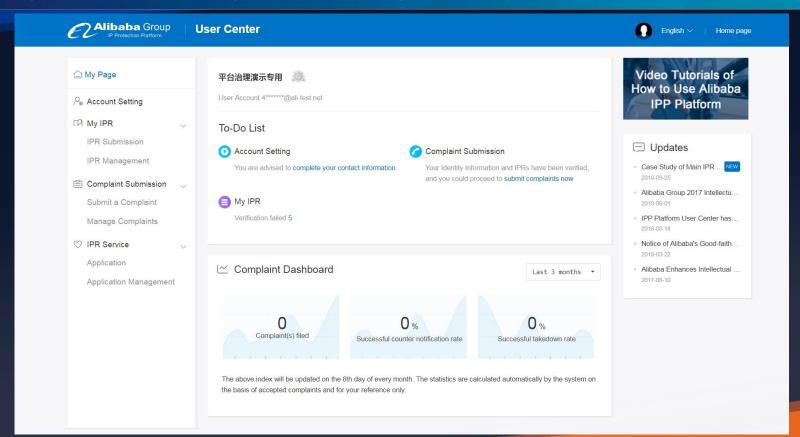


Complaint Submission

Submit a complaint

Manage complaints

NOTICE AND TAKEDOWN - IPP HOME PAGE

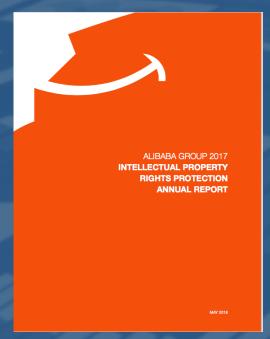


RESOURCES AND TRANSPARENCY IN IPR PROTECTION

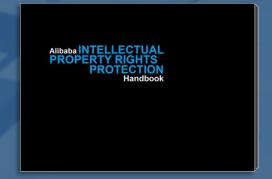
Alibaba's commitment to transparency.

Published its

ALIBABA GROUP 2017 IPR ANNUAL REPORT



an INTELLECTUA L PROPERTY RIGHTS PROTECTION HANDBOOK





GLOBAL IP ENFORCEMENT

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THANK YOU

BRAND OWNER PERSPECTIVE

ERIC GELWICKS

LIVE NATION MERCHANDISE

PLATFORMS

- Marketplaces Amazon, Alibaba, eBay, JD, DHGate, Rakuten, Flipart, Wish, Etsy, Mercado Libre, etc.
- eComm Solutions Shopify, Bigcommerce, Magento, Woocommerce, etc.
 - General website building platforms Wix, Weebly, Squarespace, etc.
- **Print-On-Demand (POD)** Redbubble, TeeChip, Viralstyle, GearLaunch, SunFrog, Zazzle, FAA, etc.
- **Social Networks** Facebook, Instagram, Twitter, WeChat, Reddit, etc.

CURRENT STATE OF THE LAW

• Favors the so-called "whack-a-mole" game; most of the time the user / seller is invisible

- Some Platforms make it extremely easy to create new accounts, duplicate storefronts, upload content, sell anonymously, etc., but rely on the Brand Owner to make the case against a bad actor or "repeat infringer"
- The legal framework and the platforms place hurdles in the way of Brand Owner enforcement – some hurdles are warranted, some not

BRAND OWNER + PLATFORM PARTNERSHIP

Streamline takedown process; find a direct point of contact to notify and discuss issues

• Develop counterfeit identification and blocking protocol; is additional technology an option or solution (e.g., automated OCR or image recognition)

Ongoing, two-way conversation; collect examples and screenshots; share screens

INVEST IN A TOOLKIT FOR GLOBAL TAKEDOWNS

IP May Vary By Brand Owner

- Trademark, Trade Dress, Design Registered v. Common Law; Relevant Classes; Literal Interpretation of Rights by Platforms
- Copyright Berne; Complete Registration File; "Super Trademarks"
- Publicity Rights Dependent on Jurisdiction; Postmortem Rights; Attached TM rights
- Patent
 - Utility
 - Design

TOOLKIT CONTINUED...

Online Forms v. Template Emails

Build and maintain a collection of IP info, phrases, responses, keywords, and links

Takedowns v. Demand Letters

- Belt-and-Suspenders
- Content Removal v. Pre-Litigation

Tools to Build your Case

- Screenshots
- · Information collection and issue tracking
- · Connecting the dots
- Calendaring for follow-up; building the record

INTERNAL & EXTERNAL EDUCATION

Internal

- Educate internal stakeholders
- Encourage sales, retail, eComm, marketing teams to participate in the effort

External

- Platforms, customers, clients, and bad actors may all need a crash course
- Show risks & downside of buying from unauthorized sources
- Create or work with the platforms to create educational martials that send the right message (e.g., not buried in dense T&Cs or IP Policy)

ONLINE ENFORCEMENT IN CHINA

UNITALEN ATTORNEYS AT LAW

E-Commerce Law of China

effective on 01/01/2019

IP right owners:

- ➤ Notify E-commerce platform operator to delete or block relevant information, disable relevant links and terminate transactions and services.
- > Provide preliminary evidence of infringement

E-Commerce Law of China

effective on 01/01/2019

E-commerce platform operators:

- > Take measures and forward IP right owner's notice to target
- Forward target's statement of non-infringement and preliminary evidence, if any, to IP right owner
- ➤ Terminate measures if IP right owner does not file a suit within 15 days
- ➤ Shall retain information on commodities, services, and transactions for at least 3 years

ARE YOU READY FOR IT?

Do you have an enforceable right?

Do you have a valid proof of right?

Is your TM right broad enough?

Might the target also have a right?

Pitfalls

PUCCI does not sell in China, but it contracts a Chinese factory for manufactory and exports back to US. Several months later, PUCCI finds the same products sold on Taobao.

Pitfalls

If PUCCI has not registered its mark in China ...

If the PUCCI mark has been registered by Chinese factory ...

Pitfalls

If PUCCI registered the mark through Madrid Protocol ...

If PUCCI registered the mark on footwear, but the factory uses the mark on hosiery ...

CONCLUSION

Thank you!

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Partner

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PERKINSCOIE

COUNSEL TO GREAT COMPANIES

Online Platforms: Trademark Rights and Relevance

February 1, 2019

Patchen M. Haggerty

Partner

Perkins Coie LLP

Scope of the Internet

- The Internet has continued to grow, and recent estimates are of at least 6 billion indexed webpages on the Internet.
- This does not include individual user, group and business pages on social media and other platforms.

Scope of the Internet

With billions of active users of Facebook and hundreds of millions of active users of Twitter, Instagram, LinkedIn and other social media platforms, the Internet and social media have created enormous opportunities for companies to communicate their brand messages – and for trademark abuse.

Scope of Brand Misuse Online

- Online brand misuse can include:
 - Sale of counterfeit or gray market products
 - Impersonation and phishing scams
 - Spoof sites
 - 800-number customer service scams
 - Promotion of cheats and hacks for games
 - Fake product or gift card giveaways
 - Cybersquatting

Strategies for Protection of Brands Online

- Seek trademark protection for key brands in relevant jurisdictions
- Secure relevant domain names and social media handles
- Engage in active monitoring for infringing activity

- In many countries (including the U.S.), trademarks are "use it or lose it" rights.
- Active monitoring for infringing activity is essential to retaining strong trademark rights – and for consumer protection.

Types of Third-Party Trademark Monitoring

- Trademark application watching services
- Domain registration watching services
- Website content monitoring
- Social media watching services
- App monitoring services

Self Monitoring

- Regularly run searches for your brand on Google, alone and coupled with industryrelevant words such as "scam", "cheat", "hack", "free", "giveaway", etc.
- Set up Google Alerts for brand mentions

Self Monitoring

- Set up alerts for refusals of third-party trademark applications through the USPTO
- Search USPTO's TESS Database
- Register with the Trademark Clearinghouse (TMCH) for alerts of newly registered gTLDs: http://www.trademark-clearinghouse.com/

Enforcement Strategies

- File takedown requests with platform providers.
- Submit takedown requests to website hosting services for illegal or fraudulent activity.
- Send cease and desist letters.

Enforcement Strategies

- File Uniform Domain-Name Dispute-Resolution Policy (UDRP) Complaints.
- Work with a trademark enforcement specialist to develop an ongoing monitoring and enforcement program.

- Most platforms have takedown procedures in place for reporting and requesting removal of infringing content.
- Many require evidence of trademark rights in relevant jurisdictions prior to removing infringing content.

- Some platforms investigate claims of infringement and will remove content, profiles, etc., deemed to be infringing.
- Others will put you in contact with the other party for direct negotiation.

App/Marketplace Takedown Policies:

- Apple (iTunes/App Store/iBooks Store): https://www.apple.com/legal/intellectual-property/
- Google (Google Play/Google Shopping): https://support.google.com/legal/troubleshooter/1114905
- Amazon: https://www.amazon.com/report/infringement
- Microsoft: https://www.microsoft.com/info/cpyrtlnfrg.html

- eBay: <u>https://ir.ebaystatic.com/pictures/aw/pics/pdf/us/help/community/NOCI1.pdf</u>
- eBay Verified Rights Owner (VERO) program: https://pages.ebay.com/seller-center/listing-and-marketing/verified-rights-owner-program.html#vero
- Alibaba: https://ipp.alibabagroup.com/index.htm?spm=a2700.8293689. scGlobalHomeHeader.25.46ce65aavJcf6A&tracelog=hd_hp_r eportIPR& localeChangeRedirectToken=1

Social Media/Networking/Content Provider/Platform Takedown Policies:

- Facebook:
 https://www.facebook.com/help/441398989216951
- Twitter: https://help.twitter.com/en/rules-and-policies/twitter-report-violation
- Instagram:
 https://help.instagram.com/535503073130320/?helpref=hc
 fnav&bc[0]=368390626577968&bc[1]=285881641526716
 &bc[2]=372161259539444

• LinkedIn: https://www.linkedin.com/legal/copyright-policy (copyright infringement), https://www.linkedin.com/help/linkedin/ask/TS-NTMI (trademark infringement), https://www.linkedin.com/help/linkedin/answer/30200?lang=en (imposter accounts)

- Google (all Google products): https://support.google.com/legal/troubleshooter/1114905
- YouTube: https://support.google.com/youtube/answer/2807622?hl=en

- Pinterest: https://www.pinterest.com/about/copyright/dmcapin/ (copyright infringement); https://www.pinterest.com/about/trademark/form/ (trademark infringement)
- Reddit: https://reddit.zendesk.com/hc/en-us/requests/new?ticket_form_id=73465
- Tumblr: https://www.tumblr.com/dmca (copyright infringement); https://www.tumblr.com/abuse/trademark (trademark infringement)

Yahoo!/Flickr (Oath Holdings):

https://policies.yahoo.com/us/en/yahoo/ip/index.htm

Vimeo: https://vimeo.com/help/violations

Microsoft: https://www.microsoft.com/info/cpyrtInfrg.html

Amazon's Mission

To be the earth's most Customer-centric company

Where people can find and discover anything they want to buy onling

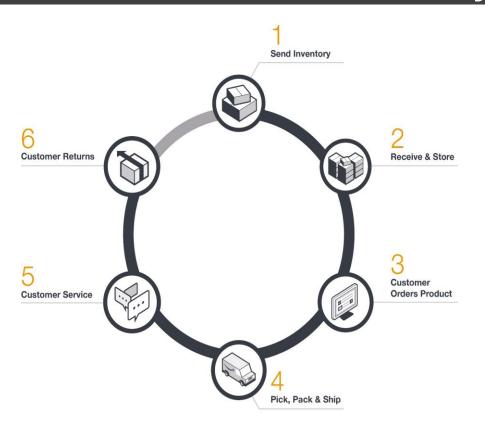
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Customer Trust is Paramount

"You can't ask for trust, you just have to do it the hard way, one step at a time."

- Amazon CEO, Jeff Bezos

Fulfillment by Amazon



Handle logistics for sellers

Prime eligible

Faster to customers

Seller Success

Over 1,000,000 US-based SMEs

13 marketplaces in 9 languages, used by sellers from over 130 countries

Over 175 fulfillment centers around the world

Over 180 countries with Amazon customers

Over 50% of the total physical units sold on Amazon are from sellers

Proactive Detection



Millions of sellers

Tens of millions of Customer Contacts and Reviews

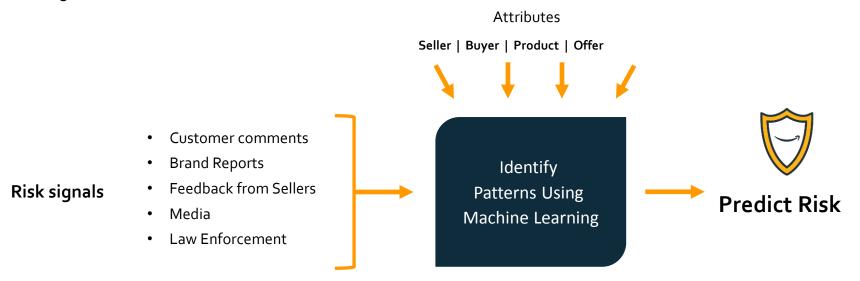
Billions of Transactions

Over 5B changes to website **per day**

Prevention is our first objective

Predicting Risk

Learning from historical data



Investment in Prevention

More than US \$200M invested in 2017

More than 3,000 employees worldwide

Over 100:1 of proactive to reactive efforts

More than 99.9% of products do not receive a notice of infringement

Over 890M bad and suspect listings removed proactively in 2017

Notices of infringement down 45% YoY (July 2018)

Customer complaints down 31% YoY (July 2018)

False Positive Problem

"Hey BadSeller123, you sold me a **fake** handbag!"

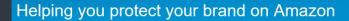
"Thanks so much for the AMAZING fake Christmas tree! It looks like the real deal!"

What is Amazon's Brand Registry?

Amazon Brand Registry helps:

- Brands protect their intellectual property on Amazon
- Create an accurate and trusted experience for customers

amazon brand registry



Amazon Brand Registry helps you protect your intellectual property and create an accurate and trusted experience for customers on Amazon.







Why Enroll?

Amazon Brand Registry provides access to powerful tools, including:

- Proprietary text and image search
- Increased authority over product listings with your brand name

What's Next?

Amazon is working on building automated and scalable mechanisms, based on data provided by brands, to prevent inaccurate listings on Amazon



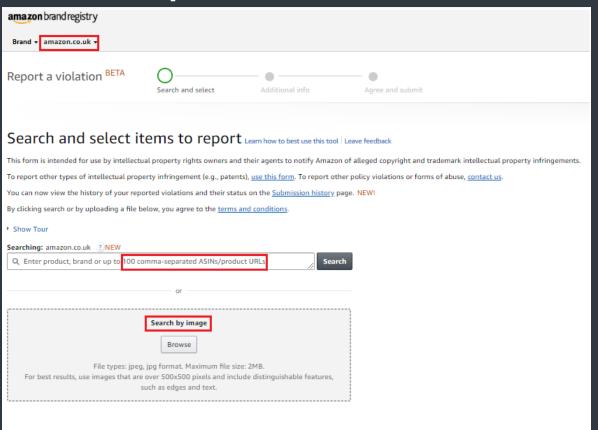
What Do Brands Need to Enro

Brands must provide:

- Valid government registered trademark for their brand name
- Images of the brand's logo
- Images of products & packaging with the trademarked brand name; if the product is not branded, the packaging must be branded
- Product categories for the brand
- Countries where the brand's products are manufactured and distributed



Report a Violation (RaV) Tool

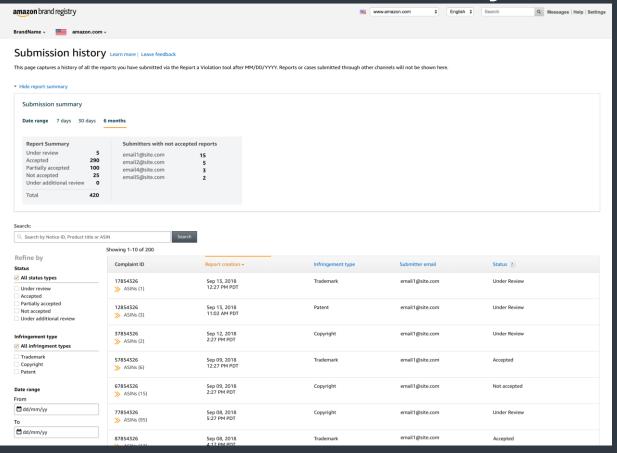


 Global search: search for content in different Amazon stores from the same screen

Image search: find product listings on Amazon that match your product(s) or logo(s) using images

Bulk ASIN search: apart from using keywords, search for a list of ASINs or product URLs in bulk

Submission History



Amazon uses Brand Registry





Submitting Infringement Notices

Brand Registry (Recommended)

Public Notice Form: https://www.amazon.com/report/infringement

Email Us: copyright@amazon.com

Suggestions:

Clearly articulate the right asserted and the infringement.

Don't throw everything at the wall to see what sticks.

Focus on partnership. We want to help.

