



PANITCH TRAINING ACADEMY
Insights From Leaders In IP Law

Training Academy Session #9

Online Enforcement

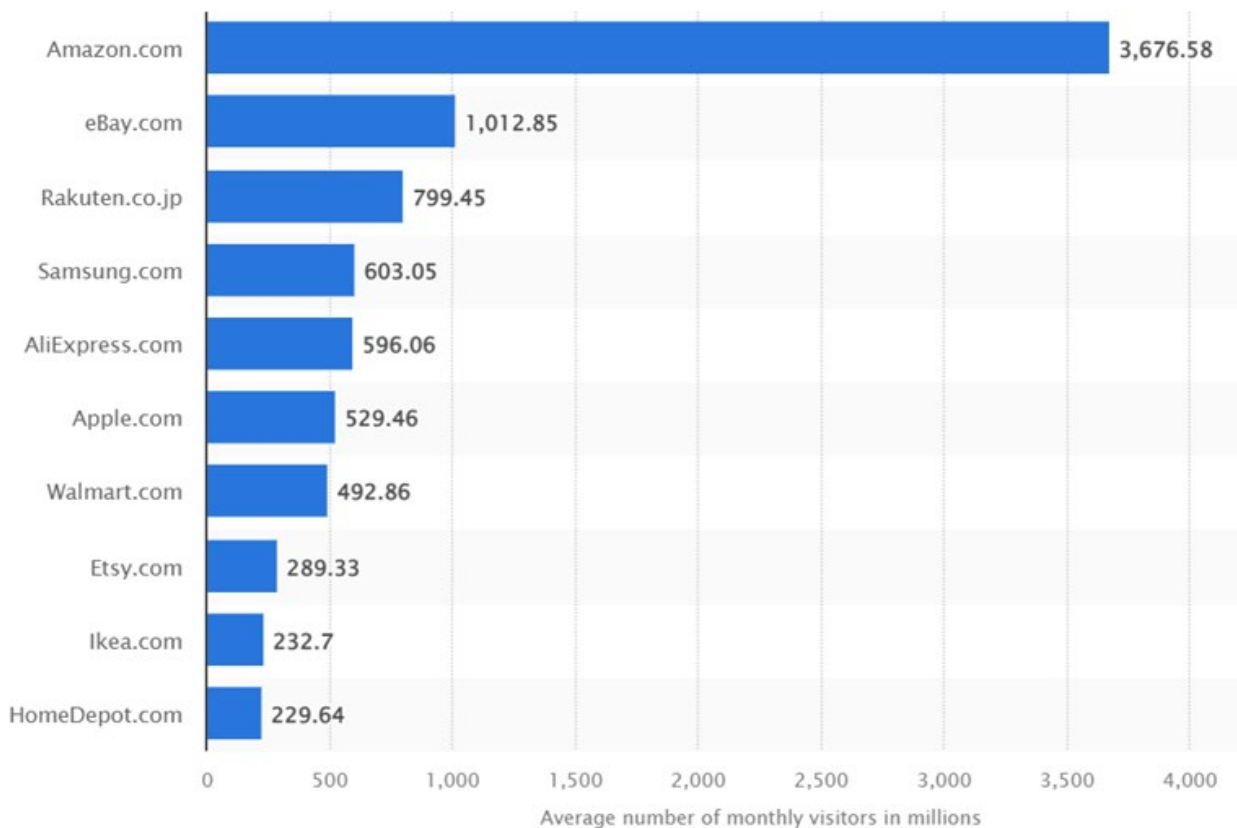
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Session Overview

1. Identifying online enforcement issues with patents, trademarks, copyrights, and domain names (Slides 3-6)
2. Take-down actions available directly and through the courts and other organizations (Slides 7-13)
3. Enforcement via ecommerce/online platforms, payment services, social media, and web development companies (Slides 14-23)
4. First steps in identifying the source of infringement, including conducting appropriate investigations (Slides 24-27)
5. Working with border control to prevent importation of infringing and counterfeit goods (Slides 28-29)

1. Identifying online enforcement issues with patents, trademarks, and copyrights



1. Identifying online enforcement issues with patents, trademarks, and copyrights

- Overview
 - Consistent strong and rapid growth of online sales
 - Over \$900 million in sales in 2021 with projected growth of 14%
 - Amazon by far the largest
- What does that mean for you?
 - Increased likelihood of infringement
 - Much of it barely trackable
 - Affects all forms of intellectual property
 - Patents/design patents
 - Trademarks
 - Copyrights

1. Identifying online enforcement issues with patents, trademarks, and copyrights

- What do I do to protect my intellectual property?
- How do I pursue smaller infringers efficiently?
- What forums exist for enforcement?
- How do I monitor online markets?
- When do I go to court?
- Where else can I go?



1. Identifying online enforcement issues with patents, trademarks, and copyrights

- Amazon has the most sophisticated private enforcement mechanisms (with lots of caveats)
- eBay and others have procedures for trademark and copyright enforcement
- And the courts loom in the distance!

2. Take-down actions available directly and through the courts and other organizations

- Direct Take-Down Actions
 - Online Platforms are Private Entities
 - DMCA Requirements
 - Default position – Leave it to the parties/Enforce court orders
 - Amazon Brand Registry
 - eBay VeRO
 - Other online platforms

2. Take-down actions available directly and through the courts and other organizations

- Amazon Brand Registry

- Registry allows owners of trademarks to report listings that may infringe on their rights.
- Trademark (brand) must have a pending application or registration.
- Amazon only accepts applications/registrations from specific countries.
- The trademark (brand) must be enrolled in the Amazon Brand Registry by the trademark owner.
 - The trademark owner can add authorized agent as an additional user.
- The brand owner must provide: the brand name, trademark registration/application number, and a list of product categories in which the brand should be listed

2. Take-down actions available directly and through the courts and other organizations

- eBay Verified Rights Owner (VeRO) Program
 - The Verified Rights Owner (VeRO) Program allows owners of intellectual property (IP) rights and their authorized representatives to report eBay listings that may infringe on those rights
 - If you are reporting trademark infringement, you need to provide trademark application/registration information.
 - If you are reporting patent infringement, you need to provide a **court order** and the patent information
 - You report a listing by submitting a Notice of Claimed Infringement (NOCI).
 - NOCI forms asks you to select from a list of Reason Codes to indicate the type of infringement you are reporting.
 - The brand owner must provide: the item infringement or listing infringement

2. Take-down actions available directly and through the courts and other organizations

- Other Platforms: Twitter, Instagram, etc.
 - Generally, each platform has its own IP enforcement policy
 - When receiving complaints, each platform must abide by its own policy
 - When submitting complaints, abide by the policy, and submit adequate proofs to tell your side of the story
 - If platform denies complaint, you can re-submit
 - If platform accepts complaint, other side has opportunity to respond
 - Platform is not obligated to take action, and may be concerned about tortious interference with a business.
 - Courts are always available

2. Take-down actions available directly and through the courts and other organizations

- Trademark Infringement – Likelihood of Confusion



- Copyright Infringement – Access and Substantial Similarity
 - Infringer must have access to the protected work
 - Exact or Verbatim copying not necessary
 - Expert evaluation may be necessary in court

2. Take-down actions available directly and through the courts and other organizations

- Example of successful take-down: Trademark
 - Submitted U.S. trademark registration as proof of rights
 - Submitted evidence of how the trademark was used by the brand owner
 - Submitted evidence of how the infringing trademark was used by the infringer
 - Submitted evidence of likelihood of confusion
 - Submitted evidence of *actual* confusion
 - Submitted argument that rights, infringement, and evidence all fit squarely within the platform's policy, so that a take-down was justified.

2. Take-down actions available directly and through the courts and other organizations

- Example of successful take-down: Copyright
 - Submitted U.S. copyright registration as proof of rights
 - Submitted evidence of the protected work of authorship
 - Submitted evidence of how the infringing work copied specific pieces of the protected work of authorship
 - Submitted evidence of author receiving complaints about infringing work
 - Submitted evidence of infringer being taken down at other platforms
 - Submitted argument that rights, infringement, and evidence all fit squarely within the platform's policy, so that a take-down was justified.

3. Enforcement via ecommerce/online platforms

- Amazon Utility Patent Neutral Evaluation Program
 - Purpose: Resolve patent infringement claims where the alleged infringer is selling via Amazon
 - By invitation only after “application”
 - Single patent, single claim

3. Enforcement via ecommerce/online platforms,

- Amazon Utility Patent Neutral Evaluation Program
 - Initial steps
 - Email to Amazon legal department
 - Patent
 - Claim charts
 - Proof of ownership
 - List of allegedly infringing Amazon standard identification numbers

3. Enforcement via ecommerce/online platforms,

- Amazon Utility Patent Neutral Evaluation Program
 - What happens next? An Agreement!

Amazon Utility Patent Neutral Evaluation Agreement

This Amazon Utility Patent Evaluation Agreement (“Agreement”) is between the Patent Owner (or Patent Owner’s authorized representative) listed in Exhibit 1 and the Seller or Sellers (or their authorized representative(s)) listed in Exhibit 2 (collectively, “Participants”).

Amazon.com, Inc. (“Amazon”) has developed the Amazon Utility Patent Neutral Evaluation Procedure (“Procedure”) for owners of United States utility patents to obtain an evaluation of their patent infringement claims against products offered by third-party sellers on amazon.com (“Evaluation”). By executing this agreement, the Patent Owner represents and warrants that it owns or has the right to enforce the patent identified in Exhibit 1 (“Patent”), and asserts that listings identified by the Amazon Standard Identification Numbers (“ASINs”) in Exhibit 1 (“Products”) infringe the patent claim identified in Exhibit 1.

By respectively executing Exhibits 1 and 2, Patent Owner and Seller agree as follows:

3. Enforcement via ecommerce/online platforms,

- Amazon Utility Patent Neutral Evaluation Program

Exhibit 1: Patent Owner-Supplied Information

Patent Owner name:

Patent Owner physical address:

Names of any corporate parents, subsidiaries, or other entities related to Patent Owner:

Name of individual contact for Patent Owner or Patent Owner's authorized representative:

Email Address for contact (this email address will be used by the Evaluator and Amazon for communications related to the Evaluation):

United States utility patent number ("Asserted Patent") for Evaluation:

Patent Claim number for Evaluation:

Amazon Standard Identification Numbers (ASINs) of Accused Products:

Signature

Name

Title

Date

Exhibit 2: Seller-Supplied Information

Seller name:

Seller physical address:

Names of any corporate parents, subsidiaries, or other entities related to Seller:

Name of individual contact for Seller or Seller's authorized representative:

Email Address for contact (this email address will be used by the Evaluator and Amazon for communications related to the Evaluation):

Amazon Standard Identification Numbers (ASINs) of Accused Products for which Seller will participate in the Evaluation:

Signature

Name

Title

Date

3. Enforcement via ecommerce/online platforms,

- Amazon Utility Patent Neutral Evaluation Program
 - Once “invited”
 - Seller has three weeks to complete the Agreement
 - If no response, Amazon withdraws the listings
 - If response, select neutral
 - Patent owner pays \$4,000/Seller pays \$4,000 (winner gets money back)

3. Enforcement via ecommerce/online platforms,

- Amazon Utility Patent Neutral Evaluation Program
 - The evaluator sets a briefing schedule
 - Patent holder will have three weeks to submit their brief
 - Seller has two weeks to submit a response
 - Patent holder will have one week to submit an optional reply
 - Within 2 weeks of the submission of all arguments, the evaluator renders a decision.
 - Amazon does not offer an avenue to appeal.

3. Enforcement via ecommerce/online platforms,

- Alibaba
 - IPP protection allows IP owners, including for patents, to submit relevant information and seek takedowns
 - Submit proof of ownership
 - Hyperlink to sites of allegedly infringing material
 - Potential counter-notifications
 - Members who are posting will be given contact information for rights holder to allow for resolution

3. Enforcement via ecommerce/online platforms,

- eBay
 - IP protection for patent rights via VeRO
 - Submit proof of ownership
 - Identify sites of allegedly infringing material
 - As noted above, enforcement requires a court order
 - Question remains as to the ability to effectively take down goods

3. Enforcement via ecommerce/online platforms,

- Federal and State Courts
 - IP protection for all IP rights
 - Because of the inability to effectively identify many online infringers, can sue multiple infringers as Doe parties
 - Allows ability to seek alternative methods for service
 - Once served, potential for default judgment to seek enforcement at online markets, etc.

3. Enforcement via ecommerce/online platforms,

- Cease and Desist Notices
 - IP protection for all IP rights
 - Prelude to court but possibly to out-of-court settlement
 - Decide in advance the tenor of the notice – is the next step the court or further discussion
 - Don't fall prey to unwanted declaratory judgment action

4. First steps in identifying the source of infringement

- Whether you send a demand letter or sue an infringer, in most cases, you eventually need to name the defendant.
- The Internet affords anonymity.
- This can create an early obstacle for enforcement.
- The Easy Way...
 - A competitor
 - A self-identified infringer
 - A social media user using their name
 - A counterfeiter with a return address

4. First steps in identifying the source of infringement

- Clever investigations might be required.
 - Track down online identities related to your online infringer
 - Buy an infringing product and review the materials that might be shipped with it
 - Interact with a social media user

4. First steps in identifying the source of infringement

- Online infringers might only be identifiable by an Internet Service Provider platform or domain name registrar who may need to be subpoenaed in order to turn over the information.
 - File a lawsuit against a “John Doe” defendant, and seek subpoena to have ISP match the Internet Protocol address of computer user, or to have an online platform or other parties reveal infringer
 - If infringing material involves copyright, the DMCA may allow for a subpoena to an ISP without filing a lawsuit
 - With domain names, under UDRP, the registrar may reveal the registrant name upon filing of complaint.

4. First steps in identifying the source of infringement

- If the infringing activity involves counterfeit goods, you might be able to seek a seizure order or injunction without naming the infringer upon filing a lawsuit
- Seek an injunction against a payment vendor to request accounts be frozen to disrupt the infringer and potentially have then voluntarily shut down

5. Working with border control to prevent importation of infringing and counterfeit goods

- Register trademark with USPTO
- Register copyright with Copyright Office
- Record trademark/copyright registration with CBP (IPRR) and pay fees
 - Provides nexus between registered rights and enforcement
 - Provide details:
 - Authorized users: licensees, manufacturers, subsidiaries, importers
 - Evidence of how the mark is used
 - Evidence of anti-counterfeiting measures
 - Contact information



5. Working with border control to prevent importation of infringing and counterfeit goods

- In practice, CBP only inspects a small number of shipments
- Customs will notify the contact about detainment
 - Contact/IP rights owner will have the opportunity to inspect goods
 - Contact/IP rights owner can request specific physical goods with bond
 - Contact/IP rights owner tells CBP whether goods are genuine or counterfeit, and MSRP of goods
 - If detained goods are counterfeit, they will be seized for destruction and importer/infringer will be fined.

Panitch Academy is Out for Summer



Speakers



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