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2021

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY



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FICPI WEBINAR SERIES

Liability for online marketplaces

2021

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY



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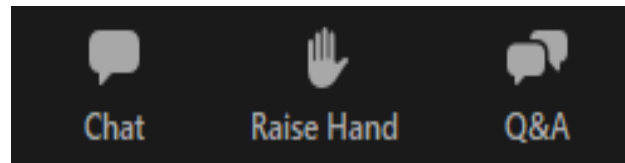
Petter Rindforth

Fenix Legal, Sweden



Questions?

*Ask using the 'Q&A' function
at the bottom of your screen*





Liability of online marketplaces...

Petter Rindforth / Fenix Legal KB
FICPI CET Special Reporter (ICANN)



Intermediary services providers

The good example

- Put buyers and sellers together without taking ownership of the product, service or property.
- Act as “go-betweens”. Are not wholesalers/ distributors.
- Have the skill, knowledge, experience and a network the buyer or seller may not have.
- Online marketplaces...





Intermediary services providers

The bad example

- The “Corona Effect”:
Traditional fake “pay-per-click” sites are now “online market places”
- General Data Protection Regulation (GDPR):
Domain name registries + registrars has shut off public WHOIS access



Andy's computer gets 'personal'...

<http://www.UnlikelyStories.com> (c) 1999 Michael P. Stype



What are the options today in EU?

- Member-States must ensure that rights holders can apply for an injunction against intermediaries whose services are used by a third party to infringe an IP right

(Article 11 of EU IP Enforcement Directive 2004/48/EC)

- Online marketplaces & Internet Service Providers: Obligation to remove or disable access to any infringing information expeditiously upon becoming aware of it

(Article 14 of the e-Commerce Directive (Directive 2000/31/EC))



Is that enough?

Coty Germany vs Amazon (C-576/2018)

Court of Justice of the European Union (CJEU)

- It is not enough for an e-commerce platform operator to merely store and distribute orders consisting of unauthorized or infringing goods in order to be found liable for trademark infringement.
- To be liable, a company “must pursue, like the seller, the aim of offering the goods for sale or putting them on the market”, to be liable.



Digital Services Act (DSA) Digital Markets Act (DMA)

- Users empowered to report illegal content in an easy and effective way.
- A privileged channel for trusted flaggers to report illegal content
- Member State authorities able to order any platform operating in EU to remove illegal content.
- Very large online platforms will need to take mitigating measures at the level of the overall organisation of their service to protect their users from illegal content
- Online marketplaces will also be requested to trace their traders (“know your business customer”).



1 232 new TLDs...and more to come...

Question:

Are you always sure that you have reached the right website?

dot HAMBURG

berlin

dotRadio™

DotGreen
Non-Profit Registry Corporation



HEALTH

paris
l'identité capitale



shop 
byGMO

hotel
The .hotel top-level domain



Thank you!
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.fenixlegal
IP from a different angle

STRENGTHENING THE PRACTICE OF THE INDEPENDENT IP ATTORNEY



U.S. Perspective

1. How the liability of online intermediaries is dealt with currently by the US legislature and courts
2. New initiatives for changing the regulatory framework



Current status

Notice and Takedown/Safe Harbor Statutory Regime...

❖ *no Digital Millennium Trademark Act*



Contributory Liability

Requires:

1. Material contribution

2. Knowledge

- primary source of contention and evolution
- actual knowledge often not at issue



Vicarious Liability

- Construed to be virtually **indistinguishable from direct liability**
- Thus is of **limited use** as a tool for secondary liability



New Initiatives

Laws clarifying platform responsibility

On-line marketplace legal obligations--

- make their sites safer for consumers
- provide transparent seller identity



Clarifying secondary infringement liability online

- *The Shop Safe Act*
- *INFORM Consumers Act*
- *DSE applies to U.S. Entities*



The Shop Safe Act



INFORM Consumers Act



European Union's Digital Services Act



CONCLUSION

For online providers to be held to standard required of brick-and-mortar contemporaries:

- Clearer liability regime
- Require standard practices to prevent, detect, sanction and deter counterfeiting

Enhancing IP protection on e-commerce marketplaces

FICIP Webinar - 31 March 2021

Expert Group on “COOPERATION WITH INTERMEDIARIES”

Objectives:

- Further the understanding on different intermediary services,
- How they can be misused for IP-infringing activities, and
- What the good practices are to undermine such misuses.

Strategic
Project

Expert Group
Paper

E-COMMERCE



Discussion Paper
(March 2021)

DOMAIN NAMES



Expert Group
Cooperation with
intermediaries



PAYMENTS

Workstreams

Automated
Content
Recognition



SOCIAL MEDIA



Phase 2 Report
in progress

Phase 1 Report
Published
(Nov 2020)

PROJECT PREPARATORY WORK

- **Expert Group on cooperation with intermediaries**
Workstream on online platforms identifying a number of friction areas in the collaboration between e-commerce marketplaces and IP owners
- **Mapping exercise on e-commerce marketplaces IP protection measures**
Analysing IP policies, notification processes and IP protection programmes of 20 e-commerce marketplaces
- **Workshops on “Enhancing IP protection on e-commerce marketplaces”**

Testing solutions envisioned with:

- E-commerce Marketplaces (Feb 2020)
- IP Owners (May 2020)

STATE OF PLAY – Identified friction areas



IP right holders

- Increasing number of marketplaces with different notification and IP protection mechanisms
- Resource intensive processes to verify IP rights, and authenticate with marketplaces
- Duplication of efforts to provide information on IP infringing products to different marketplaces



E-commerce marketplaces

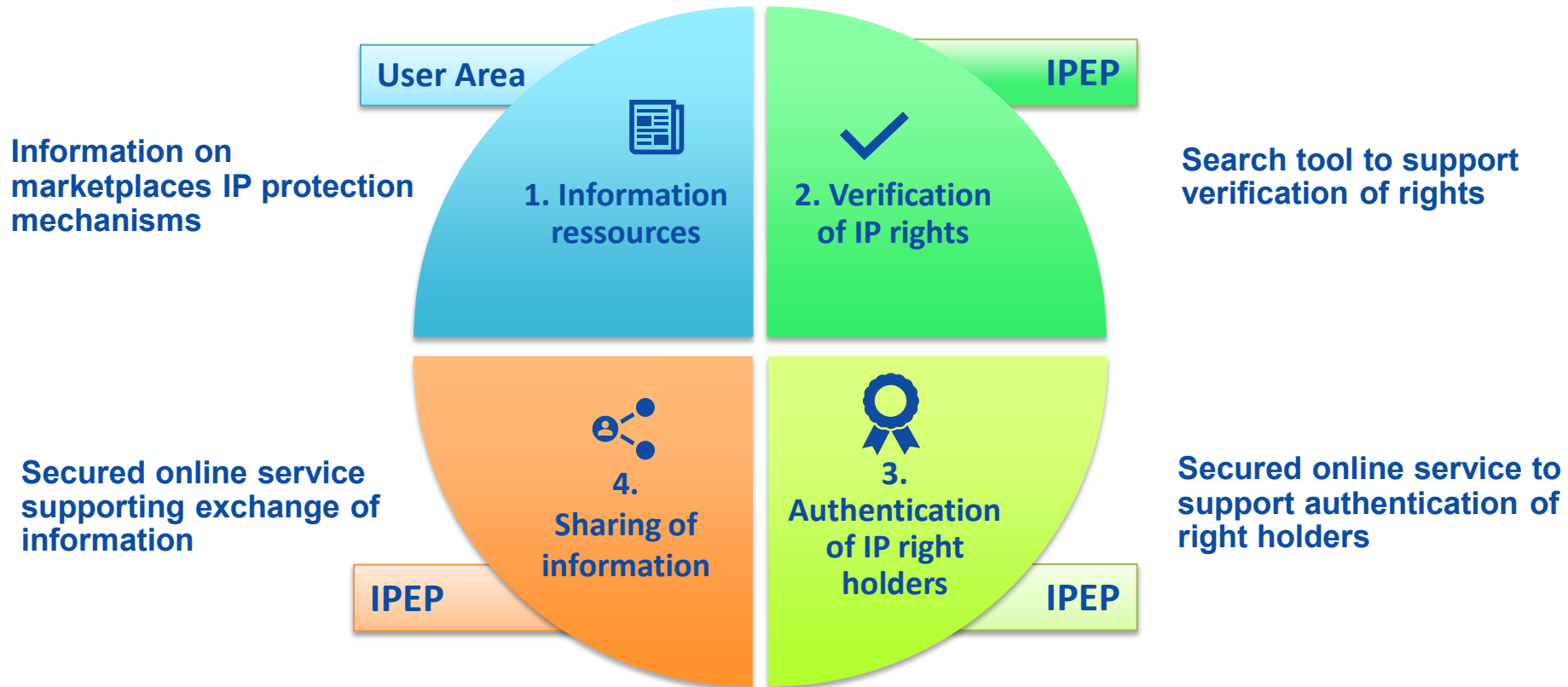
- Notification and IP protection mechanisms reaching a limited number of IP right holders
- Resource intensive and unsecured processes to verify rights and authenticate IP right holders



Small e-commerce marketplaces

- Limited resources to put in place notification or IP protection mechanisms
- Limited access to information on IP infringing products

PROJECT PHASES



PHASE 1 – INFORMATION RESSOURCES



Enhancing IP protection on e-commerce marketplaces

E-commerce keeps growing and plays an important role for many businesses. But what to do if you discover that a counterfeit version of your product is for sale on an e-commerce marketplace? Or if somebody is using your trade mark in an e-commerce listing to mislead consumers in buying fakes?

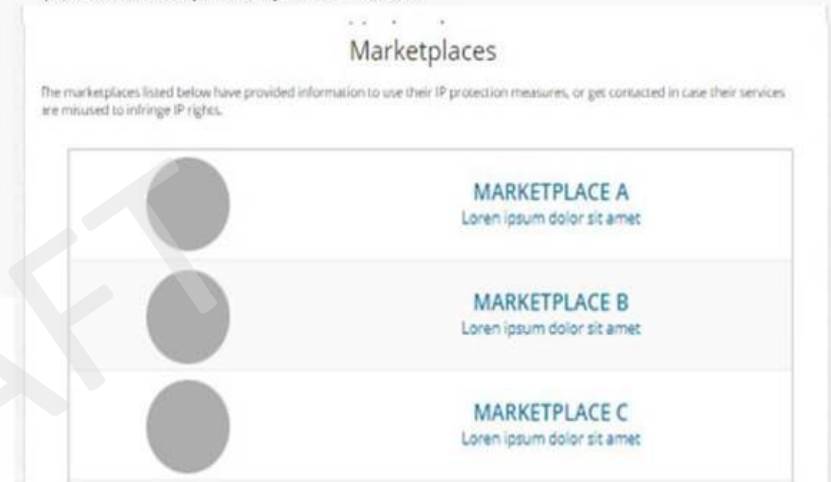
A very first step to consider, to limit damages to your business and consumers, is to get the incriminated listing(s) removed. The EUIPO have been working with a number of e-commerce marketplaces to gather information on their IP protection tools, and make it easier for you to take action and use them.

What are the main IP protection tools and what do I need to use them?

- **Notification systems:** allow you to report listings infringing your IP rights. There are many different systems, including webforms guiding you step by step through the notification process, or forms to be downloaded and sent by email. If the information requirement varies from one system to the other, they typically require you to provide information about your company, your IP rights (e.g. trade mark registration number) and the incriminated listing(s) (e.g. url). Make sure you have all information at hand to file your notification.
- **IP protection programmes:** are put in place by a limited number of marketplaces to support cooperation with IP owners. Such programmes offer different functionalities, but typically provide for a simplified process for you to notify IP infringing listings, and a dashboard to keep track of your notifications and their outcomes. They also provide tools facilitating search for listings that may infringe your rights. You will be asked to register before you can join such programmes, and required to provide detailed information about your company and your rights (e.g. trade mark registration number).
- **Contact point:** for you to get assistance in case you are facing an issue using a notification system or IP protection programme. Some marketplaces do not have notification forms, so that IP infringement can be reported by email, with no specific format, to the contact point.

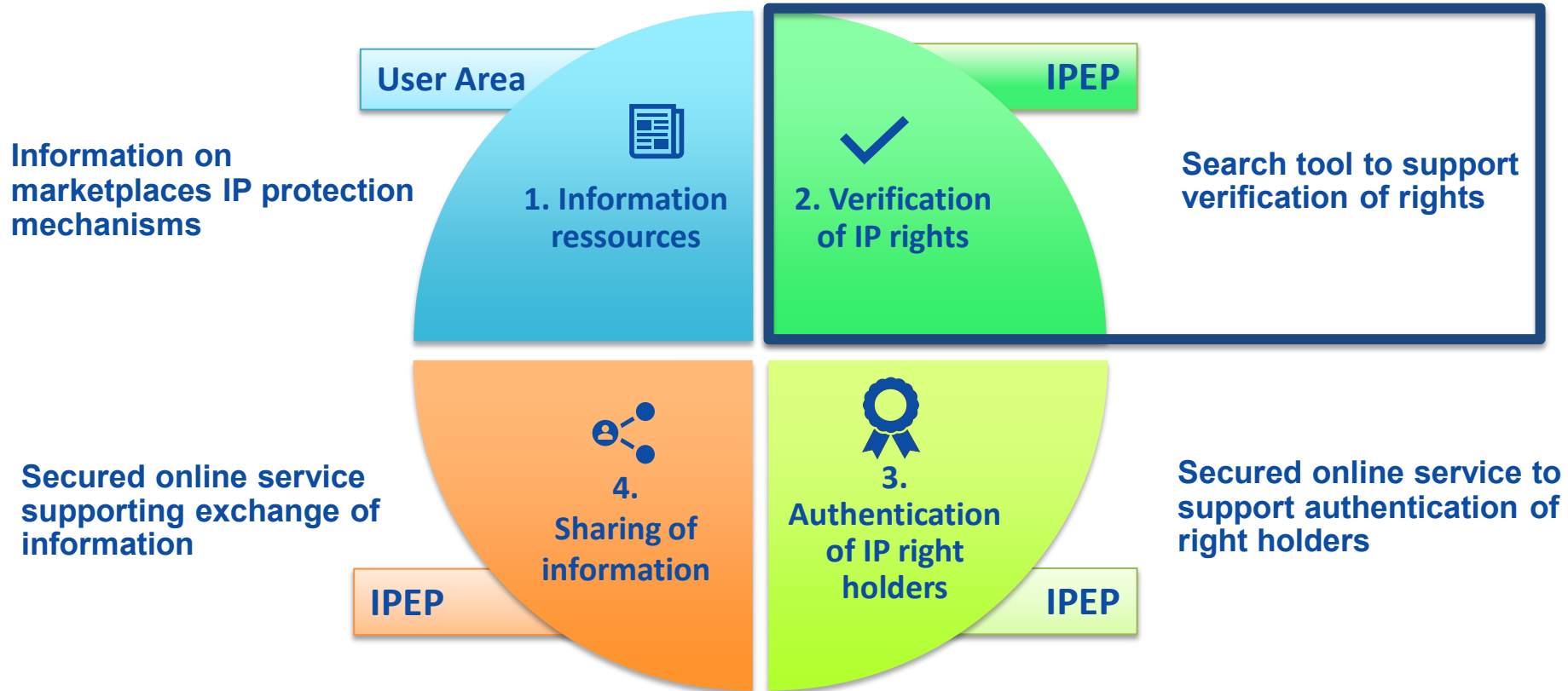
Where can I find these tools?

Below is a list of e-commerce marketplaces that have been providing the EUIPO with information and links towards their IP protection tools, so that you can easily access and use them.



Disclaimer: The EUIPO has engaged with a large number of e-commerce marketplaces to gather information about their notification mechanisms and IP protection programmes. The objective is only to facilitate IP owners' access to such information. The fact that a marketplace is listed on this webpage, cannot be construed as any form of endorsement by the EUIPO of its IP protection mechanisms.

PHASE 2 – VERIFICATION OF IP RIGHTS





Future Webinars

- **14 April**
BRACE: Best Reaction About Competing E-services
- **28 April**
Proof in the digital era: using online and digital evidence
- **12 May**
Simulations and Virtual Reality - what constitutes patent-eligible subject matter?

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Thank you for attending

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