Beyond Domains: Digital Platform Liability for Trademark Infringement in the US

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Direct Liability

- Search Engine Liability for Keyword Advertising
  - *Rescuecom v. Google*, 562 F.3d 123 (2nd Cir. 2009)
    - Statutory definition of “use in commerce” for purposes of infringement/dilution needs work
  - *Rosetta Stone v. Google*, 676 F.3d 144 (4th Cir. 2012)
    - Adwords Suggestion Tool = “use in commerce”
      - https://adwords.google.com/KeywordPlanner
Direct Liability

*Multi Time Machine, Inc. v. Amazon.Com, Inc.*, 804 F.3d 930 (9th Cir. 2015)
Summary Judgment for Amazon affirmed:

“In light of Amazon’s clear labeling of the products it carries, by brand name and model, accompanied by a photograph of the item, no rational trier of fact could find that a reasonably prudent consumer accustomed to shopping online would likely be confused by the Amazon search results.” (emphasis added)
Direct Liability

- **Gucci America Inc et al v. Alibaba Group Holdings Ltd**, U.S. District Court, Southern District of New York, No. 15-03784 (currently pending)
Indirect Liability

- *Rosetta Stone v. Google*, 562 F.3d 123 (2nd Cir. 2009)

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

- *Academy of Motion Pictures Arts and Sciences v. GoDaddy.com, Inc.*, Case No. CV 10-03738 (C.D. Cal. 2015)
Platform Takedown Experience and Takeaways....

- App Store
- Twitter
  https://support.twitter.com/forms/trademark
- Facebook
  https://www.facebook.com/help/440684869305015/
- Amazon
  https://www.amazon.com/gp/help/reports/infringement
- Advising client platforms
  Digital Millennium Trademark Act (DMTA)?