

Enforcement Mechanisms: Takedowns, Demand Letters, and a little Litigation

Ethan Vodde

ethan.vodde@leehayes.com

Lee & Hayes, P.C.

Attorney – Copyright and Trademark & Brand Protection

Lee&Hayes 



--Disclaimer--



These materials and the related presentation are for informational purposes only and not for the purpose of providing legal advice. They relate to the U.S. only and are not necessarily indicative of information relevant to other jurisdictions.

You should contact an attorney to obtain advice with respect to any particular situation.

Introduction



Rights

- Patents and Copyrights
- Trade Secret
- Trademark

Enforcement

- Takedowns
- Demand Letters
- A little Litigation

Enforcing Your Client's Brand

- **Takedowns**
 - Designed for Copyright, Implemented for More!
- **Demand Letters**
 - Let Them Know You're Watching
- **A little Litigation**
 - TTAB
 - UDRP
 - PTAB
 - CCB
 - The Courts

Starting with the “Know-How”

- Almost every daily task in business creates know-how
(e.g., employees’ knowledge, business processes, designs, experimental results, etc.)
- Eventually, know-how becomes Identifiable Subject Matter, such as:
 - Process improvements/Innovations
 - new product designs,
 - product improvements,
 - brand names, logos, and ad slogans,
 - web design,
 - product appearance,
 - product packaging,
 - manufacturing processes,
 - engineering drawings,
 - instruction manuals,
 - product catalogs,
 - employment agreements, and
 - customer and supplier lists

Patents

- **Utility Patents** – protect functional aspects of virtually anything
 - **Requirements for Protection:** useful, novel, non-obvious
 - **Protection Afforded:** Right to exclude others from making, using, selling, offering for sale, or importing infringing goods
 - **Term:** 20 years from earliest US filing date
- **Infringement**
 - Claim construction- determine elements
 - Literal infringement of Doctrine of Equivalents

Copyright

- **Tangible form of original expression**
 - Independent, original creation
 - Minimal creativity necessary
 - Nonfunctional
- **Automatic Protection → use ©**
- **Why register? Statutory damages/costs/fees**
- **Exclusive right to:**
 - Reproduce, prepare derivative works, distribute copies, perform, display, transmit.
- **Work Made For Hire / Independent Contractor (e.g., artists)**
- **Term:** 120 for WMFH, Life + 70

Infringement

Generally:

- 1) **Plaintiff owns Valid Copyright**
- 2) **Defendant copied**
 - Defendant had access
 - Substantial similarity in protectable elements

Potential Remedies

- 1) **Registration prior to Action**
 - Actual Damages / Disgorgement of Profits
- 2) **Prompt Registration**
 - Attorney Fees
 - Statutory Damages Option

Trade Secrets

Generally--

Trade Secret:

- Anything that derives economic value from the fact that it is kept secret

Infringement (“Misappropriation”):

- Improper Means
- Knowledge thereof

Trademarks

Requirements for Protection:

- Any word, slogan, logo, color scheme, sound, packaging design
- Used in commerce in association with sale of goods or services
- Distinctive (either inherently or acquired distinctiveness)
- Must not be same or confusingly similar to another mark used on the same or similar goods or services
- Nonfunctional

Protection afforded: Protects against consumer confusion and/or dilution of the trademark

Term: Perpetual if goods/services are continuously used, trademark maintains distinctiveness, and the registration is periodically renewed.

Infringement

Generally:

- 1) **Plaintiff owns Valid Trademark**
- 2) **Defendant's Use not Authorized**
- 3) **Likelihood of Consumer Confusion**

Potential Remedies

- Injunction
- Disgorgement of Profits
- Enhanced Damages
- Attorney Fees

Takedowns

We Do Not Enforce

Detail Page Ownership and Image Restrictions: When a detail page is created, it becomes a permanent catalog page on Amazon.com that will remain even if the creator's inventory sells out. Additionally, when you add your copyrighted image to a detail page, you grant Amazon and its affiliates a non-exclusive, worldwide, royalty-free, perpetual, irrevocable right to exercise all rights of publicity over the material.

Other sellers can list their items for sale against pages that you have created or added your copyrighted images to. However, we do require sellers to list only against detail pages that exactly match their items. If you believe sellers are listing against detail pages that do not exactly match their items, we ask that you report the violation directly by using the [contact us form](#).

If your copyrighted image has been added to our catalog without your consent, please complete the [form](#) below.

Exclusive or Selective Distribution: Amazon respects a manufacturer's right to enter into exclusive distribution agreements for its products. However, violations of such agreements do not constitute intellectual property rights infringement. As the enforcement of these agreements is a matter between the manufacturer and the retailers, it would not be appropriate for Amazon to assist in enforcement activities.

Please review the [Amazon Intellectual Property Policy](#) to learn more about different infringement types.

Allegation of Infringement

Are you the Rights Owner or an Agent?

Rights Owner Agent

The primary complaint pertains to

copyright concerns - unauthorized use of copyrighted material such as text, photos, product designs, videos, music, software.

trademark concerns - unauthorized use of a word, phrase, symbol, and/or design that identifies and distinguishes the source of the goods.

patent concerns

other concerns

(taken from Amazon.com's "Report Infringement" website for illustration purposes)

Demand Letters

Demand Letter Pitfalls:

- Troll Statutes (potential liability)
- Misuse of “bugs”
- DJ Actions (potential PJ at site of demand, but no general rule)

A little Litigation

TTAB – Determining Registration of a TM

UDRP – Arbitrating Appropriate Domain Names

PTAB – Patent Registration Fun

CCB – Small Claims for Copyright

The Courts – Get Your Wallet Ready

TTAB

Trademark Trial and Appeal Board

- Solely to determine registrability of trademark
- Oppositions
- Cancellations
- Concurrent Use Proceedings
- No damages, no attorney fees
- Potential issue preclusion
- Check incontestability of mark
- Cost-effective

- Not fast

UDRP

Uniform Domain Name Dispute Resolution Policy

- Abusive registrations and uses of domain names
- Trademark-related
- Must show no rights or legitimate interest
- Must show registered *and* used in bad faith
- No damages, no attorney fees
- Solely to determine ownership of domain name
- Potential federal action may arise
- Highly cost-effective

- Fast

PTAB

Patent Trial and Appeal Board

- Post-grant proceedings
- Used to challenge registration of a patent
- *Maybe* attorney's fees
- Potential issue preclusion
- Check incontestability of mark
- Probably not as expensive as a patent litigation case in federal courts

Copyright Claims Board

- Small claims relative to copyright actions
- Attorneys' Fees – Generally not available
- Statutory Damages – Available
- Declaratory Relief – Available
- Injunctive Relief – Kind of available
- No awards greater than \$30k total / \$15k per work
- Registration-in-hand – Not required to initiate
- Optional

- Anybody done one?

Questions?

This is a really big question mark.





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Lee&Hayes 

Atlanta / Austin / Portland Metro / Rochester / Seattle / Spokane / Washington, D.C. Metro

LeeHayes.com
info@leehayes.com

For More Information, Please Contact

Ethan B. Vodde
ethan.vodde@leehayes.com
509.944.4684