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A Dive Into Intellectual Property Liability For E-Commerce Platforms

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Online shopping has become increasingly popular in recent years. E-commerce sales surpassed \$6.5 trillion in 2023 and are expected to total over \$8.1 trillion by 2026.¹ Convenience of product variety and online competition have contributed to this trend, as many retailers have also expanded their online presence to meet the growing demand for virtual shopping experiences. Ten years ago, for example, retail leader H&M had physical stores in 83% of its target markets.² Today, 78% of its target markets feature a combination of both offline and online stores.³ The spike in online shopping means more merchants and more transactions via online marketplaces, exposing e-commerce platforms like Amazon, eBay, and Alibaba to increased potential liability for intellectual property violations.

Online platforms are exposed to potential liability when they directly violate intellectual-property rights and, under certain circumstances, when merchants operating on these platforms engage in intellectual-property violations. Copyright, trademark, and patent law come into play, requiring these platforms to act on infringing products and images on their websites. Still, certain safe harbors and exceptions may shield e-commerce companies from liability. This nuanced legal landscape ultimately makes it challenging for intellectual-property owners to hold e-commerce platforms liable for intellectual-property violations.

Copyright Liability

E-commerce platforms often face copyright-infringement lawsuits because the Copyright Act safeguards the exclusive rights of copyright owners, including the rights to reproduce, distribute, perform,

display, and create derivative works of copyrighted works, which can be particularly relevant when listing products or showcasing images on e-commerce platforms.⁴ In protecting a copyright owner's exclusive entitlement to this bundle of rights, the Copyright Act "expressly creates liability only for direct copyright infringers."⁵ Direct infringement occurs when a party violates at least one of these exclusive rights granted to a copyright owner.⁶ But others can be held liable through two copyright doctrines that establish secondary liability: contributory infringement (the intentional inducement or encouragement of direct infringement) and vicarious liability (profiting from direct infringement while declining to exercise a right to stop or limit it).⁷ In sum, copyright infringement may be direct, contributory, or vicarious providing a plaintiff with three discrete pathways to demonstrate an alleged infringer's liability.

The DMCA as an Affirmative Defense

E-commerce companies are often shielded from copyright liability under the Digital Millennium Copyright Act (DMCA) safe-harbor provisions.⁸ Signed into law in 1998, the DMCA provides a framework for addressing copyright infringement on the Internet and contains a safe harbor that protects online service providers, including e-commerce platforms, from liability for copyright infringement committed by their users. The Ninth Circuit has characterized the DMCA as "plac[ing] the burden of policing copyright infringement ... squarely on the owners of the copyright."⁹ E-commerce defendants commonly raise the DMCA as an affirmative defense in copyright-infringement lawsuits because eligible defendants cannot be held liable for infringement.¹⁰

To qualify for DMCA safe-harbor protection, a service provider must meet threshold conditions, including that the service provider (1) implements a policy with a working notification system that allows it to terminate users who repeatedly violate

the rules, (2) informs users about its policy, and (3) does not actively prevent copyright owners from collecting information needed to issue notifications.¹¹ Providers must also meet additional conditions determined by the type of online material at issue.¹²

Section 512(c) of the DMCA, which immunizes a service provider from liability for copyright infringement stemming from its “storage at the direction of a user of material that resides on a system or network controlled or operated by or for the service provider,” is commonly at issue in cases involving e-commerce platforms. To be eligible for protection under Section 512(c), a service provider must also establish that it does not have knowledge that material on its network is infringing, does not receive a financial benefit directly attributable to any infringing activity that it has the right and ability to control, has expeditiously disabled access to allegedly infringing material, and has a designated agent to receive notifications of claimed infringement.

Rosen v. eBay, Inc. is illustrative. There, e-commerce giant eBay successfully invoked the DMCA safe-harbor defense under Section 512(c). Plaintiff Barry Rosen sued eBay for infringing his copyright on photographs offered for sale by third-party merchants on eBay.¹³ Rosen argued that although eBay had implemented a termination policy for repeat infringers, eBay had not provided documentation showing terminations for such offenders, and had not adequately informed users of the terms of its policy because users did not know “specifically what eBay’s policy is.”¹⁴ The court, however, found that a declaration from eBay that it suspended repeat offenders was sufficient to evidence terminations, and that eBay sufficiently put users on notice that they face exclusion from eBay if they repeatedly violate copyright laws. The DMCA “does not require that a service provider reveal its decision-making criteria to its users,” and “implementation of a policy need not be perfect” to qualify a service provider for protection under the DMCA.¹⁵

Rosen also argued that eBay received a financial benefit from infringing activity that it could control, and therefore was not eligible for protection under Section 512(c).¹⁶ The court disagreed, finding that eBay did not control the infringing activity because eBay “does not direct users what to list, does not come into contact with the items being posted, and beyond the basic content requirements, has no control over what its users list until the listing is complete.”¹⁷ As a result, the court granted summary judgment on the grounds that eBay was eligible for safe-harbor protection under Section 512(c).

Direct Infringement and the “Volitional-Act” Requirement

Direct copyright infringement occurs when a party violates one of the exclusive rights granted to a copyright owner,¹⁸ but a party cannot be held liable unless they have committed a “volitional act” that facilitates the infringement.¹⁹ A volition act is established by the active participation in, or exercise of control over, the infringing activities, such as “selecting” copyright works for upload, download, transmission, or storage, or “instigating” any copying, storage, or distribution of copyrighted works.²⁰ General operation of a website and activities instigated by others may not meet the threshold.²¹

This issue arose in *VHT, Inc. v. Zillow Group, Inc.*, where photography studio VHT sued real-estate-marketplace website Zillow for copyright infringement of its photographs.²² The Ninth Circuit affirmed that Zillow did not directly infringe VHT’s copyright because Zillow did not engage in “volitional conduct.”²³ Zillow had received VHT’s photos through feed providers, which were displayed on Zillow’s website.²⁴ The Ninth Circuit was persuaded that the feed providers, not Zillow, selected and uploaded every photo, and that Zillow therefore did not “exercise control” over these photos beyond generally operating the website.²⁵

Notably, in the same case, a jury found, the district court upheld, and Zillow did not appeal, that Zillow directly infringed on a separate set of VHT photographs displayed elsewhere on Zillow’s site.²⁶ For those photographs, Zillow employed moderators to manipulate certain photographs to make them searchable.²⁷ This active conduct and exercise of control met the volitional-conduct requirement.²⁸

The volitional-conduct test was also met in *Williams-Sonoma, Inc. v. Amazon.com, Inc.*, where home-goods retailer Williams-Sonoma sued Amazon for directly infringing its photograph of its signature Peppermint Bark candy.²⁹ Williams-Sonoma alleged that once Amazon’s sellers upload images to Amazon’s catalog, the sellers have no role in image-selection, and that Amazon in its sole discretion decides which photos to display.³⁰ Amazon argued that Williams-Sonoma did not plausibly allege that Amazon, as opposed to its marketplace sellers, engages in volitional conduct that infringed Williams-Sonoma’s copyrights.³¹ The court disagreed, explaining that Amazon “not only curates and selects the images to be searched out by others, it publishes them”—“[u]nlike the moderators in *Zillow*, Amazon is actually performing the acts of reproduction and display that constitute

infringement,” transforming Amazon “from a passive host to a direct cause of the infringement.”³²

As intermediaries in online transactions between buyers and sellers, e-commerce companies may find advantages in the volitional-conduct test. Holding an e-commerce platform directly liable for copyright infringement can be challenging due to its role as a facilitator. If the platform primarily serves as a medium for users to engage in buying and selling activities without actively participating in volitional conduct contributing to copyright infringement, it may not be held directly responsible for the actions of its users.

Contributory Infringement and Specific Knowledge

Contributory copyright infringement is one of two copyright doctrines that establish secondary liability. Under this doctrine, a plaintiff must prove direct infringement by a primary infringer, knowledge of the infringement, and inducement or material contribution to the infringing conduct.³³ E-commerce platforms risk liability for contributory infringement where they receive notice about an alleged act of infringement on their platform and then take no action to end it.³⁴ But a plaintiff must show that a contributory infringer has knowledge of specific infringing activity.³⁵ Generalized knowledge is not enough.³⁶

The court examined whether Amazon had sufficient specific knowledge to establish contributory infringement in *Lee v. Amazon.com Inc.*, where the heirs to a composer sued Amazon for the sale of karaoke machines that allegedly infringed the copyrights of the composer’s music.³⁷ The plaintiffs argued they had submitted five takedown requests to Amazon through its online infringement report form, giving Amazon knowledge of the infringement, but that Amazon rejected the submissions as inaccurate or incomplete.³⁸ Amazon claimed that it only had a generalized knowledge of the infringement because it does have the practical ability to supervise the millions of third-party sellers who utilizes its services, and therefore relies primarily on the information contained in the takedown notices, “as a rights owner is in the best position to know what it owns ... and what it believes is infringing.”³⁹ The court agreed with Amazon and held that plaintiff’s takedown notices “failed to identify the specific work he claims was infringed or the material he claims was infringing,” and were therefore insufficient to provide Amazon with specific knowledge of infringement.⁴⁰ The court’s rationale tracks with that of the DMCA which, as noted above, “place[s] the

burden of policing copyright infringement ... squarely on the owners of the copyright.”⁴¹

The court also dismissed the complaint because plaintiff failed to prove the last element of contributory infringement: that defendant “induces, causes or materially contributes to the infringing conduct of another.”⁴² That is, plaintiff was required to show that Amazon took “affirmative steps...to foster infringement,”⁴³ but the only evidence was that Amazon played a passive role. The court stated that “Amazon’s indisputably passive role in a third party’s sale of the [machine] does not translate to Amazon intentionally inducing or encouraging [a third party] to infringe on Plaintiffs copyright.”⁴⁴

The specific knowledge requirement to establish contributory infringement can impact rights holders’ ability to establish liability against e-commerce companies in cases of contributory copyright infringement. E-commerce platforms often host a wide array of user-generated content, and determining whether the platform has the requisite knowledge of infringing activities can be a complex legal challenge. If rights holders fail to adequately inform online marketplaces of infringement, it will reduce their chances of success.

Needle in a Haystack—Vicarious Copyright Infringement

The other method to establish secondary copyright liability is vicarious infringement, which requires showing that a defendant has the right and ability to supervise the infringing conduct and a direct financial interest in the infringing activity.⁴⁵ A key factor in cases involving e-commerce defendants is whether the platform “has both a legal right to stop or limit the directly infringing conduct, as well as the practical ability to do so.”⁴⁶

In *VHT*, for example, the court found that Zillow lacked practical ability to police copyright infringement for real estate photos uploaded to its website.⁴⁷ Although Zillow could identify a property by its address, that was not sufficient to identify a specific photo.⁴⁸ The court held that “ferreting out claimed infringement ... was beyond hunting for a needle in a haystack,” and Zillow was not required to change its operations to avoid assisting users’ infringement.⁴⁹

Likewise, in *Atari Interactive, Inc. v. Redbubble, Inc.*, the Court found that Redbubble, a global online marketplace, was not liable for vicarious infringement because it lacked the ability to monitor infringing images and required cooperation from the content

owners to determine whether particular content infringes.⁵⁰ The Court reasoned “that finding infringement would be like ‘searching for a needle in a haystack’ (where Redbubble lacks knowledge of needles’ appearance).”⁵¹

The practical feasibility of monitoring and preventing infringement is a key factor in determining vicarious copyright infringement liability for e-commerce platforms. If a defendant lacks the practical ability to police and control infringing activities, it may not be held vicariously liable for copyright infringement.

Trademark Infringement

Unlike the Copyright Act, which protects original works of authorship, the Lanham Act, which codifies federal trademark law, protects distinctive symbols, names, phrases, and logos used to identify and distinguish goods or services in the marketplace. Trademark law plays a significant role in the context of e-commerce platforms. Online marketplaces host numerous sellers, so sellers rely on trademark policies to maintain a fair and competitive environment and to combat the sale of counterfeit goods. Nonetheless, trademark law provides its own set of hurdles that can make it difficult to hold e-commerce platforms responsible for infringement.

The “Use” Requirement for Direct Trademark Infringement

For direct infringement, a plaintiff must demonstrate that the accused party uses a confusingly similar mark in commerce. A party that merely facilitates or assists others in using the trademarks cannot be held liable for direct infringement.⁵² It is well-established that selling an item constitutes “use,”⁵³ but courts have wrestled over whether online marketplaces are “sellers” under this rule, as “[f]ew cases have addressed the liability of companies ... who conduct their business dealings online.”⁵⁴

Redbubble is an online marketplace where artists upload their designs for sale on a range of products. Once sold, Redbubble prints the designs on products and ships the completed items to the buyer. In *Ohio State Univ. v. Redbubble, Inc.*, OSU argued that Redbubble “used” OSU’s trademarks by selling trademark-infringing products on the Redbubble platform.⁵⁵ The district court disagreed, and held that Redbubble was a mere facilitator of sales between

other parties rather than a seller itself.⁵⁶ The Sixth Circuit reversed, first observing that “[a] retailer who sells products directly to a customer at a brick-and-mortar store is indisputably a seller to whom the Lanham Act applies.”⁵⁷ “An online marketplace like eBay that clearly indicates to consumers that they are purchasing goods from third-party sellers is not.”⁵⁸ It noted, however, that there is “no reason to restrict [Lanham Act] liability to those who actually create, manufacture[,] or package the infringing items.”⁵⁹ The Sixth Circuit ultimately held that “Redbubble brings trademark-offending products into being by working with third-party sellers to create new Redbubble products, not to sell the artists’ products. So it’s more than just a passive facilitator.”⁶⁰

The district court in *Atari Interactive, Inc. v. Redbubble, Inc.* examined the same issue.⁶¹ Atari, an old videogame company, sued Redbubble for trademark infringement of numerous designs sold on Redbubble’s platform.⁶² The court denied the parties’ cross-motions for summary judgment on the issue, ruling that a genuine dispute existed regarding whether Redbubble is a seller or facilitator.⁶³ The fact that Redbubble selects the specifications for the physical products, takes responsibility for damaged goods, and handles excess inventory generated through returns and other activities, all supported a finding that Redbubble is a seller.⁶⁴ The court also recognized, however, that Redbubble’s description of itself as the host of a marketplace “where independent artists upload their designs and creative works for sale on a range of products” has some basis in fact, and that Redbubble has no role in the selection of the art that is placed on the physical product.⁶⁵ Ultimately Redbubble, like some other e-commerce platforms, “does not fit neatly into the category of either an ‘auction house’ on the one hand, that will generally be free from liability for direct infringement, or a company that itself manufactures and ships products on the other, on which liability for direct infringement can be readily imposed.”⁶⁶ In denying summary judgment, the court held that while there is more than “no evidence” that Redbubble is a seller, Atari did not establish that Redbubble is a seller as a matter of law.⁶⁷

Whether an e-commerce platform is a “seller” and thus “uses” a trademark is a fact-intensive question that depends highly on how specific e-commerce companies operate. Some directly manufacture goods and engage in the sale of goods to consumers. Others are facilitators that simply connect buyers and sellers without directly handling the inventory. Where a specific company falls on this spectrum impacts its exposure to liability for direct trademark infringement.

Contemporary Knowledge and Contributory Infringement

As with copyright law, trademark law includes a well-developed legal doctrine for imposing liability on the proprietor of a marketplace for infringement by a third-party seller: contributory infringement.⁶⁸ The relationship between contributory and direct trademark-infringement liability can be traced back four decades to *Inwood Labs., Inc. v. Ives Labs., Inc.*, where the Supreme Court ruled that manufacturers can be held contributorily liable for trademark infringement if they intentionally induced the primary infringer to infringe, or continued to supply an infringing product to an infringer with knowledge that the infringer is mislabeling the particular product supplied.⁶⁹

Contributory infringement has since been applied to online platforms but, as the Ninth Circuit has noted, “[t]he tests for secondary trademark infringement are even more difficult to satisfy than those required to find secondary copyright infringement.”⁷⁰ This difficulty is partially attributable to the Second Circuit’s decision in the seminal case *Tiffany (NJ) Inc. v. eBay Inc.*⁷¹

There, Tiffany alleged that eBay knew or should have known that counterfeit Tiffany goods were offered on eBay.⁷² The district court agreed with Tiffany that eBay’s removal of postings and blocking of sellers when it received notices of specific instances of infringement was inadequate to avoid liability. The Second Circuit disagreed and held that “[f]or 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.”⁷³ This placed the burden of identifying and seeking the removal of counterfeit products squarely on Tiffany. Since *Tiffany*, fewer cases have been brought against online marketplaces for contributory trademark infringement, perhaps because of the high bar set in that case.⁷⁴

Protecting Inventions - Patent Liability

A patent gives the patent holder exclusive rights to an invention, including preventing others from making, using, selling, or importing the patented inventions without the patent holder’s permission. Direct patent infringement may be established by showing

that a defendant, without authority, “makes, uses or sells any patented invention, within the United States during the term of the patent....”⁷⁵

Contributory patent infringement—much like copyright and trademark law—is based on a defendant’s knowledge of the alleged infringement and knowledge of the patent itself.⁷⁶ A cease and desist letter may be used as evidence of knowledge,⁷⁷ but alone may not be sufficient to prove the knowledge required to establish contributory infringement.⁷⁸

In *Blazer v. eBay, Inc.*, the court found that eBay was not liable for direct or contributory patent infringement for bee traps sold by users, even though the plaintiff had provided notice of alleged infringement. The court held that eBay was not liable for direct patent infringement because it did not offer for sale or sell the products listed for sale by users of its website.⁷⁹ The court explained that “no reasonable consumer could conclude that by bidding on an eBay listing, he was accepting an offer from eBay itself. eBay’s terms of service explicitly advise users that eBay is not making an offer through a listing, and ... eBay lacks title and possession of the items listed.”⁸⁰ The court also determined that eBay did not “know that the product being sold infringed a patent” merely because the plaintiff repeatedly notified eBay of its claims.⁸¹ The court explained that this was not sufficient for the plaintiff to avoid summary judgment because knowledge of a patent owner’s claims is different from “actual knowledge of infringement.”⁸²

Some e-commerce platforms have patent programs that allow patent owners to address potentially infringing products on the platforms. For example, Amazon’s APEX (Amazon Patent Evaluation Express) program allows certain patent owners who suspect patent infringement on Amazon to report a violation.⁸³ Amazon will notify the seller so it can participate in an evaluation and defend their claim if they choose.⁸⁴ Participation in an evaluation requires a monetary deposit with a neutral evaluator, who reviews submissions and determines whether the reported listing infringes the patent.⁸⁵ If the evaluator determines the reported listing is infringing, Amazon removes the listing. Ostensibly, programs like these provide a cost-effective and expedited way for patent owners and sellers to handle patent disputes without resorting to courtroom litigation against the online platforms themselves.

An Alternative Approach

Intellectual-property owners may pursue alternate methods to thwart infringement and impose liability

on e-commerce platforms. For example, they may bring claims against e-commerce platforms that aid and abet merchants who defy injunctions that prohibit the sale of counterfeit goods. This recently occurred in *Kelly Toys Holdings, LLC v. 19885566 Store*, where e-commerce merchants were enjoined from selling or marketing counterfeits of plaintiff's toy.⁸⁶ The injunction prohibited nonparty Alibaba from aiding or abetting the merchants in violating the injunction.⁸⁷ Yet Alibaba refused to shutdown merchant storefronts, continued to advertise the toys, and allowed merchants to re-list the toy.⁸⁸

The court found Alibaba partially in contempt and ordered Alibaba to comply with the injunction and pay plaintiff fees and costs.⁸⁹ The court made two key findings that led to its decision.⁹⁰ First, courts can only enforce an injunction against nonparties if they have personal jurisdiction over them.⁹¹ The court held that it had personal jurisdiction over Alibaba under New York's personal-jurisdiction statute because "Alibaba.com and AliExpress.com are 'interactive' websites

that enable Defendants and other companies to sell and ship counterfeit products to consumers in New York."⁹² Second, injunctions can only bind nonparties who are in "active concert or participation" with the party subject to the injunction.⁹³ The court found that Alibaba provided "comprehensive ways" for the merchants to promote their products even after the injunction, and thus was in "active concert or participation" with them.⁹⁴ *Kelly Toys* highlights the effective use of an injunction and claim of contempt to hold nonparty e-commerce platforms accountable.

In the ever-evolving e-commerce landscape, giants like Amazon, eBay, and Alibaba contend with the complexities of intellectual-property law, constantly facing the threat of violations. But the presence of safe harbors and exceptions act as robust legal safeguards for e-commerce platforms, creating a formidable hurdle for rights holders seeking to establish liability against these platforms.

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1. Manaferra, *E-Commerce statistics To Know In 2024*, available at <https://www.manaferra.com/e-commerce-statistics/>; Anna Baluch, *38 E-Commerce Statistics of 2023*, FORBES, Feb. 8, 2023, available at <https://www.forbes.com/advisor/business/e-commerce-statistics/>.

2. Antonia Tönnies, *H&M's Offline-Online Evolution: A Look at Global Retail Expansion*, ECDB, Oct. 11, 2023, available at <https://ecommercedb.com/insights/h-ms-offline-online-evolution-a-look-at-global-retail-expansion/4660>.

3. *Id.*

4. 17 U.S.C. §§ 102, 106.

5. *John Wiley & Sons, Inc. v. DRK Photo*, 882 F.3d 394, 402 (2d Cir. 2018).

6. *Perfect 10, Inc. v. Amazon.com, Inc.*, 508 F.3d 1146, 1159 (9th Cir. 2007).

7. *John Wiley*, 882 F.3d at 402; *Ticketmaster L.L.C. v. Prestige Ent. W., Inc.*, 315 F. Supp. 3d 1147, 1165 (C.D. Cal. 2018).

8. 17 U.S.C. § 512.

9. *Perfect 10, Inc. v. CCBill LLC*, 488 F.3d 1102, 1109 (9th Cir. 2007).

10. 17 U.S.C. § 512(a)-(d).

11. *Rosen v. eBay, Inc.*, No. CV 13-6801 MWF, 2015 WL 1600081, at *7 (C.D. Cal. Jan. 16, 2015) (citing 17 U.S.C. § 512 (i)); *see also* *CCBill LLC*, 488 F.3d at 1109.

12. 17 U.S.C. § 512 (a)-(d).

13. *Rosen*, No. CV 13-6801 MWF EX WL 1600081 at *6.

14. *Id.* at *7-9.

15. *Id.* at *8 (citing *Corbis Corp. v. Amazon.com, Inc.*, 351 F. Supp.2d 1090, 1102 (W.D. Wash. 2004)).

16. *Rosen*, No. CV 13-6801 MWF, 2015 WL 1600081 at *12 ("Both elements must be established for safe harbor coverage to be denied.") (citing *Corbis Corp.*, 351 F. Supp.2d at 1090); *see also* 17 U.S.C. § 512(c).

17. *Rosen*, No. CV 13-6801 MWF, 2015 WL 1600081 at *13.

18. *Amazon.com, Inc.*, 508 F.3d at 1159.

19. *Religious Technology Center v. Netcom On-Line Communication Services, Inc.*, 907 F. Supp. 1361 (N.D. Cal. 1995).

20. *VHT, Inc. v. Zillow Group, Inc.*, 918 F.3d 723, 732 (9th Cir. 2019).

21. *Id.* at 732 (citation omitted).

22. *Id.*

23. *Id.*

24. *Id.*

25. *Id.* at 733.

26. *Id.* at 736.

27. *Id.*

28. *Id.*

29. *Williams-Sonoma, Inc. v. Amazon.com, Inc.*, 627 F. Supp. 3d 1072 (N.D. Cal. 2020).

30. *Id.* at 1083.

31. *Id.* at 1079-80.

32. *Id.* at 1082.

33. *See Metro-Goldwyn-Mayer Studios, Inc. v. Grokster Ltd.*, 380 F.3d 1154, 1160 (9th Cir. 2004), rev'd on other grounds, 545 U.S. 913 (2005) (citing *Ellison v. Robertson*, 357 F.3d 1072, 1076 (9th Cir. 2004)).

34. *See, e.g., Religious Technology Center*, 907 F. Supp. at 1374 (failure to investigate an alleged act of infringement in response to a notice created a factual dispute that precluded the entry of summary judgment on a plaintiff's claim for contributory infringement).

35. *See Luvdarts, LLC v. AT&T Mobility, LLC*, 710 F.3d 1068, 1072 (9th Cir. 2013) (affirming that the plaintiff did not state a claim for contributory infringement against mobile phone carriers over the alleged infringement of their users in forwarding text messages containing original content without authorization to do so because a plaintiff must allege "more than a generalized knowledge ... of the possibility of infringement.>").

36. *Id.*

37. *Lee v. Amazon.com Inc*, No. 221CV01090RAJBAT WL 6931800, at *2 (W.D. Wash. July 27, 2023), report and recommendation adopted, No. 2:21-CV-01090-RAJ WL 6896663 (W.D. Wash. Oct. 19, 2023).

38. *Id.* at *8.

39. *Id.* at *6-7.

40. *Id.* at *8.

41. *CCBill LLC*, 488 F.3d at 1109.

42. *Lee v. Amazon.com Inc*, No. 221CV01090RAJBAT WL 6931800, at *8 (citing *Fonovisa v. Cherry Auction, Inc.*, 76 F.3d 259, 264 (9th Cir. 1996)).

43. *Id.* at *8.

44. *Id.* (internal quotations omitted).

45. *Perfect 10, Inc. v. Giganews, Inc.*, 847 F.3d 657, 666 (9th Cir. 2017).

46. *Amazon.com, Inc.*, 508 F.3d at 1173.

47. *VHT*, 918 F.3d at 732.

48. *Id.* at 745.

49. *Id.* at 745-46.

50. *Atari Interactive, Inc. v. Redbubble, Inc.*, 515 F. Supp. 3d 1089, 1116 (N.D. Cal. 2021), aff'd in part, appeal dismissed in part, No. 21-17062, 2023 WL 4704891 (9th Cir. July 24, 2023).

51. *Id.*

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

53. *See Lorillard Tobacco Co. v. Amouri's Grand Foods, Inc.*, 453 F.3d 377, 382 (6th Cir. 2006).

54. *Ohio State Univ. v. Redbubble, Inc.*, 369 F. Supp. 3d 840, 843 (S.D. Ohio 2019), rev'd and remanded, 989 F.3d 435 (6th Cir. 2021).

55. *Ohio State Univ. v. Redbubble, Inc.*, 989 F.3d 435, 446 (6th Cir. 2021).

56. *Ohio State*, 369 F. Supp. 3d at 843.

57. *Ohio State*, 989 F.3d at 446, 448 (internal citations omitted).

58. *Id.*

59. *Id.* at 446 (brackets in original) (citation omitted).

60. *Id.* at 448.

61. *Atari Interactive, Inc. v. Redbubble, Inc.*, 515 F. Supp. 3d 1089, 1104 (N.D. Cal. 2021).

62. *Id.*
63. *Id.*
64. *Id.*
65. *Id.* at 1105.
66. *Id.* at 1104 (citing Y.Y.G.M. SA v. Redbubble, Inc., No. 2:19-cv-04618-RGK(JPR) WL 3984528, at *3 (C.D. Cal. July 10, 2020)).
67. Atari, 515 F. Supp. at 1105; *see also* Alibaba.com Hong Kong LTD v. P.S. Prods., Inc. WL 1668896, at *3 (N.D. Cal. May 11, 2012) (“there is a factual dispute as to whether a reasonable buyer going to www.aliexpress.com would have believed that Alibaba itself was making an offer to sell the allegedly infringing products,” because “the name of the ‘supplier’ is only in small font” and “the buyer submits a payment to Alibaba.”).
68. Y.Y.G.M. SA v. Redbubble, Inc., No. 2:19-cv-04618-RGK(JPR), 2020 WL 3984528, at *3 (C.D. Cal. July 10, 2020).
69. Inwood Labs., 456 U.S. at 854-55.
70. Perfect 10, Inc. v. Visa Intern. Service Ass’n, 494 F.3d 788, 806 (9th Cir. 2007).
71. Tiffany (NJ) Inc. v. eBay Inc., 600 F.3d 93 (2d Cir. 2010), cert. denied, 562 U.S. 1092 (2010).
72. *Id.*
73. *Id.* at 107; *see also* trial court finding, Tiffany (NJ) Inc. v. eBay, Inc., 576 F. Supp. 2d 463, 527 (S.D.N.Y. 2008) (“It is the trademark owner’s burden to police its mark, and companies like eBay cannot be held liable for trademark infringement based solely on their generalized knowledge that trademark infringement might be occurring on their websites.”).
74. *Secondary Trademark Infringement Liability in the E-Commerce Setting*, USPTO, Aug. 2021, available at <https://www.uspto.gov/sites/default/files/documents/Secondary-TM-Infringement-Liability-Response.pdf>.
75. 35 U.S.C.A. § 271(a).
76. Sandisk Corp. v. Lexar Media, Inc., 91 F. Supp. 2d 1327, 1334 (N.D. Cal. 2000).
77. *See, e.g.*, Aro Mfg. Co. v. Convertible Top Replacement Co., 377 U.S. 476, 489 (1964) (letter notifying the seller of the patent and a claim of infringement constituted evidence of knowledge).
78. *See, e.g.*, MEMC Electronic Materials, Inc. v. Mitsubishi Materials Silicon Corp., 420 F.3d 1369, 1380 (Fed. Cir. 2005) (defendant knew of the existence of patent because it received a letter concerning it, but noting in *dicta* that while this type of evidence is relevant to establish intent, it is “not by itself sufficient.”).
79. Blazer v. eBay, Inc., Case No. 1:15-cv-01059-KOB, 2017 WL 1047572 (N.D. Ala. Mar. 20, 2017).
80. *Id.* at *4.
81. *Id.* at *7 (quoting 35 U.S.C.A. § 271(c)).
82. *Id.* at *5.
83. Amazon, Brand Registry FAQ, available at <https://brandregistry.amazon.com/brandregistry/faq>.
84. *Id.*
85. *Id.*
86. Kelly Toys Holdings, LLC v. 19885566 Store, No. 22-CV-9384 (JMF), 2023 WL 4288356, at *1 (S.D.N.Y. June 29, 2023).
87. *Id.*
88. *Id.*
89. *Id.*
90. *Id.*
91. *Id.*
92. *Id.*
93. *Id.* (citing FED. R. CIV. P. 65(d)(2)(C)).
94. *Id.*

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