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WHILE REGISTERING YOUR BRAND ON AMAZON WILL NOT KEEP SELLERS FROM LISTING AND SELLING YOUR PRODUCTS, IT DOES GIVE BRAND OWNERS BETTER CONTROL OVER PRODUCT DETAIL PAGES, WHICH INCLUDES THE LISTINGS' TITLES, DESCRIPTIONS, AND PRODUCT IMAGES.

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ONLINE BRAND ENFORCEMENT: Amazon's New Tool for Brand Owners

By Paul A. Borovay



Since its founding in 1995, Amazon.com has become renowned for offering its customers deals and steals. Unfortunately, as it has grown and opened itself up to sellers from foreign countries, manufacturers and brand owners have seen a variety of counterfeit and grey market products being sold on the platform. This article discusses Amazon's newest tool to give brand owners better control over how their products are sold on Amazon, as well as some tips on filing Amazon takedown notices.

Amazon's Business Model

As most of the world knows, Amazon.com is an online retailer, serving as a centralized marketplace for third parties to sell just about anything under the sun. While some products are shipped directly from third parties, Amazon also provides a fulfillment service that allows sellers to store products at an Amazon warehouse and have Amazon ship the product directly to the purchaser. Amazon makes and sells some products itself under its "Amazon Basics" brand, but a vast majority of the products sold on its websites are listed and sold by third parties.

When a third-party seller uses Amazon's website to sell a product, the seller provides information regarding the product, such as a product description, images of the product, and a price for the product.¹ Amazon's website then automatically generates a "product-detail page" that displays the information and identifies the seller.² Sellers then decide at what price to sell their items. Notably absent from the listing process is the brand owner, who has had little control over its product descriptions, images and listings. That is, until recently.

Brand Registry

If brand owners meet certain requirements, they can register their trademarks on Amazon. To enroll a brand in Brand Registry, they must provide the following information:

1. *Milo & Gabby LLC v. Amazon.com, Inc.*, No. 2016-1290, 2017 WL 2258605, at *1 (Fed. Cir. May 23, 2017)

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- Brand name subject to a live/active registered trademark (*only standard character trademarks may be registered using Brand Registry).
- United States Trademark Registration Number or Application Serial Number.
- Image(s) of the brand's logo.
- Images of products or packaging that display the brand name.
- A list of product categories (e.g., apparel, sporting goods, electronics) in which the brand is used and should be listed.
- A list of countries where the branded products are manufactured and distributed.³

While registering your brand on Amazon will not keep sellers from listing and selling your products, it does give brand owners better control over product detail pages, which includes the listings' titles, descriptions, and product images. Having your brand registered also streamlines Amazon's takedown policy, as you have already proved that you own the brand and know what the products' title and detail-page should include.⁴

Takedown Request

Even without registering your brand, trademark and copyright owners can still file takedown notices on Amazon.⁵ Amazon will remove listings that use copyrighted photographs without your permission. Amazon will also remove or amend listings if the details page is inaccurate or uses a trademark incorrectly.

Amazon does place limitations on what it is willing to enforce, though. Amazon does not enforce exclusive distribution agreements between manufacturers and distributors. This policy does not necessarily affect a brand owner's ability to enforce its trademarks against grey market sales on Amazon.⁶ Despite its policy against enforcing exclusive distribution agreements, Amazon will remove listings if the grey market product is materially different than what is sold in the United States. For example, a medication that is sold in Germany would likely include doses in milliliters instead of ounces, not to mention that the packaging, dosing, and emergency contact information would be specific to Germany. Therefore, despite the U.S. and German drug sharing the same name, the U.S. and German products could vary significantly and could be dangerous for U.S. consumers.

Similarly, if a copyright owner's photograph is being used without its authorization, Amazon will remove the photograph associated with the listing. One exception exists, however, which is that Amazon will not take down a photograph if the copyright owner had previously uploaded the photograph to Amazon. When you add a 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."⁷ If a third party has used your photograph with a listing that does not accurately describe the pictured product, Amazon can remove the photograph from that detail page. While the detail page would still be live, customers may be less likely to purchase a product without knowing what it looks like.

Conclusion

It is no secret that Amazon is a hotbed for counterfeit products. It was not until November 2016 that Amazon filed its first lawsuit against alleged infringers on behalf of brand owners.⁸ On March 23, 2017, a California jury awarded a brand owner \$6.8 million dollars for selling counterfeits that infringed the owner's trademarks and patents.⁹ While rampant infringement by a few recidivist sellers may require litigation, most brand owners will find themselves using Amazon's built-in enforcement tools to take down listings and remove unauthorized uses of its copyrighted content. It remains to be seen how effective Amazon's new Brand Registry tool will be for brand owners seeking control over how their brands are marketed on its platform, but it appears to be a step in the right direction. ■

3. <https://services.amazon.com/brand-registry.html>

4. <http://fortune.com/2017/03/21/amazon-counterfeit/>

5. <https://www.amazon.com/gp/help/reports/infringement>

6. Grey market products are genuine goods that are meant to be sold in foreign markets but then find their way into the United States.

7. <https://www.amazon.com/gp/help/reports/infringement>

8. *Amazon.com Inc. v. Cheng Hak Yung aka/la Joana Wong Ferreira et al.*, Case No. 16-2-27556-7 (Wash. 2016) and *Amazon.com Inc. v. ToysNet et al.*, Case No. 16-2-27563-0 (Wash. 2016)

9. *Fitness Anywhere LLC v. WOSS Enterprises LLC*, Case No. 5:14-cv-01725 (N.D. Cal. March 23, 2017)

firm UPDATE

APPOINTMENTS

■ Kristine A. Bergman



Kristine has been appointed Vice Chair of the Chicago Bar Association Intellectual Property Committee.

■ Jessica A. Ekhoﬀ



Jessica has been appointed to the Board of Directors of the University of Chicago Alumni Club of Chicago.

■ Robert W. Sacoff



Bob has been reappointed ABA Intellectual Property Law Section's Liaison to AIPPI for 2017-18.

PRESENTATIONS

■ Seth I. Appel

Seth spoke on "Freedom of Registration? THE SLANTS, REDSKINS and Registration of Disparaging Marks" at the AIPPI-US Global IP Educational Forum in Chicago on July 13, which was co-sponsored by the John Marshall Law School.

■ Phil Barendolts



Phil will speak on combatting parallel imports on behalf of the INTA Parallel Imports Committee to the A2C2 Group of automotive and transportation industry professionals in New York City on August 29.

■ Jonathan S. Jennings

Jonathan will speak at the ABA Forum on Franchising's 40th Annual Forum on Franchising meeting in Palm Desert, California, on the topic entitled "Yes I Can – Intellectual Property Fair Use in Franchising," on October 19.

PRESENTATIONS

■ Jason M. Koransky



Jason spoke at a Lawyers for the Creative Arts workshop entitled "Writers! Know Your Legal Rights: Everything you need to know, but were afraid to ask!" on June 17.

PUBLICATIONS

■ Seth I. Appel



Seth's case note, "Decorative Elements of Clothing are Eligible for Copyright Protection," was published in the June edition of *AIPPI e-News*.

■ Jonathan S. Jennings



Jonathan's commentary on the new changes to the Trademark Trial and Appeal Board's Rules of Practice appeared in the May 2017 issue of PTMG's *Law Lore & Practice* newsletter.

firm NOTEWORTHY

Chambers USA-2017

David C. Hilliard was recognized as a "Top practitioner" who "brings deep experience across the range of intellectual property proceedings, both acting as a mediator in alternative dispute resolution settlements and defending major international brands in courtroom litigation."

The Legal 500 United States

Pattishall McAuliffe was recognized for its experience in trademark litigation and "trademarks non-contentious." "The 'excellent' boutique Chicago regularly handles high-profile trademark litigation for clients from various industries." Pattishall "provides 'very good advice' to clients from a variety of industries."

Who's Who Legal: Trademarks 2017

David C. Hilliard, Janet A. Marvel, Demetra Merikas, Robert W. Sacoff, Belinda J. Scrimenti, and Joseph N. Welch II, have been recognized as being among the world's leading trademark lawyers.



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