

Recent Developments in U.S. Trademark Law 美国商标法近来发展

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USAID
FROM THE AMERICAN PEOPLE



The Asia Foundation

Outline

大纲

- Proposed legislation to address online sale of counterfeit goods on foreign websites
针对国外网站在线出售仿冒商品的立法建议
- Trademark bullying
商标欺凌

Outline

大纲

- Online auctions 在线竞拍
 - *Tiffany v. eBay* *Tiffany* 公司诉*eBay*公司案
- Keyword advertising 关键词广告
 - *Rosetta Stone v. Google*
*Rosetta Stone*公司诉*Google*案
- Questions 提问
 - But please ask questions any time
如有疑问，可随时提问

Proposed Legislation 立法建议

- Issue: Sale of counterfeit goods by parties outside reach of U.S. courts

问题：美国法院管辖范围之外的卖家销售仿冒产品

- Brand owners' goal is to stop playing "Whac-A-Mole"

商标所有人的目标是停止
“打地鼠”游戏

Proposed Legislation 立法建议

- Preventing Real Online Threats to Economic Creativity and Theft of Intellectual Property Act (PROTECT-IP or PIPA) – Senate

防止现实的对经济创造力的在线威胁和窃取知识产权法案（简称 PROTECT-IP or PIPA）——参议院

Proposed Legislation 立法建议

- Stop Online Piracy Act (SOPA) – House
停止在线盗版法案（简称SOPA）-- 众议院
- Online Protection and Enforcement of Digital Trade Act (OPEN) - House and Senate
在线保护和执行数码贸易法案（简称OPEN）
-- 众议院和参议院

Proposed Legislation 立法建议

- U.S. trademark owners are believed to lose billions of dollars to counterfeiters
据称美国商标所有人因仿冒损失了数十亿美元
- Counterfeiting is believed to cost U.S. economy thousands of jobs
仿冒行为使美国丧失了数以万计的工作机会

Proposed Legislation 立法建议

- Current protections are ineffective – particularly when counterfeit goods are sold on foreign websites, outside the reach of U.S. courts

当前的保护不够有效 – 特别是仿冒商品在外国网站销售时，不在美国法院的管辖范围

Proposed Legislation 立法建议

- SOPA and PIPA would give the U.S. Justice Department authority to require U.S.-based search engines and internet service providers to block websites that contain infringing content, and to stop advertisers and payment processors from doing business with such sites

SOPA和**PIPA**法案将授权美国司法部可要求服务器设在美国的搜索引擎和互联网服务提供商拦截包含侵权内容的网站，并停止为这些网站提供广告和支付处理服务

Proposed Legislation 立法建议

- Blocked websites would not appear in search results, arguably rendering them invisible

被拦截的网站将不会出现在搜索结果中，可以说是使这些网站不可见

- Opponents argue this would amount to censorship, risk blocking legitimate websites, and would turn search engines into “online police” for fear of liability

反对者称这将意味着网络审查而导致拦截合法网站的危险，并且导致搜索引擎因害怕承担责任而变成“在线警察”。

Proposed Legislation 立法建议

- Clash of titans 产业巨头间的冲突:



vs.



Proposed Legislation 立法建议

- On January 18, online providers pushed back ahead of a January 20 vote on PIPA
在1月20日就PIPA法案的投票前，在线供应商于1月18日反击
 - Believed to be the most widespread online lobbying campaign by Internet companies ever
这被认为是迄今为止最广泛的一次互联网公司在线立法游说行动

Proposed Legislation 立法建议



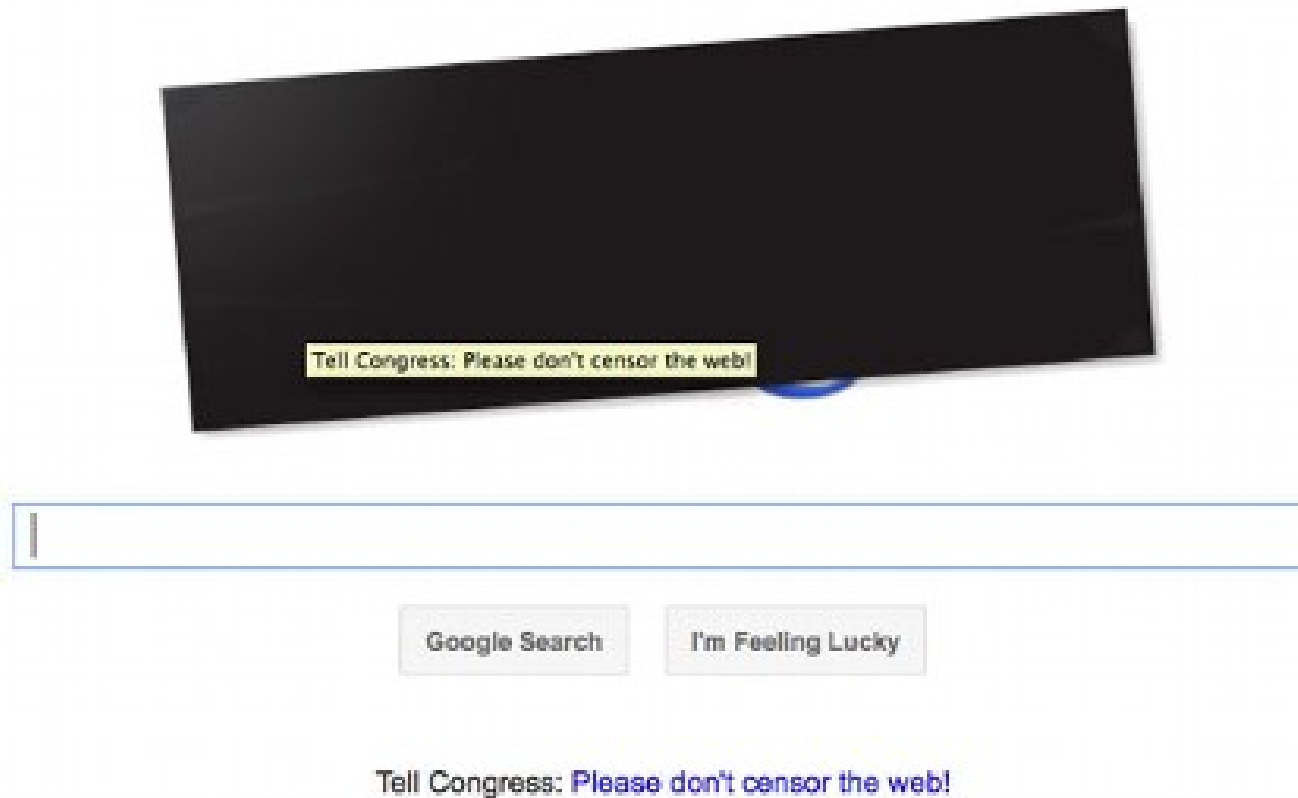
Wikipedia “goes dark” for a day Wikipedia 全天是黑色的

Proposed Legislation 立法建议



Wired magazine's January 18 home page
Wired 杂志1月18日的主页

Proposed Legislation 立法建议



Google's January 18 home page
Google 1月18日的主页

Proposed Legislation 立法建议

- On January 18, House and Senate introduced OPEN bill to address criticism of SOPA and PIPA

1月18日，参众两院提出了OPEN法案，以应对针对SOPA和PIPA法案的批评

- Vests enforcement authority with the International Trade Commission (ITC)

授予国际贸易委员会（ITC）执行权

Proposed Legislation 立法建议

- If ITC found foreign website is “primarily” and “willfully” infringing on rights of U.S. IP holder, ITC could issue cease-and-desist order to payment processors and advertisers doing business with the site
如果ITC发现网站“主要”或“故意”用于侵犯美国知识产权持有人的权利，ITC可以向与该网站有业务往来的支付处理器和广告客户发出“停止令”。
- Website owner would have opportunity to be heard
网站所有者可以有机会参加听证
- Excepts websites that follow a notice-and-takedown policy for removing infringing material
依照“通知后拿下”政策移除侵权内容的网站除外

Proposed Legislation 立法建议

- Google, Facebook, LinkedIn, Twitter support OPEN

Google, Facebook, LinkedIn, Twitter支持OPEN

- Motion Picture Association of America argues OPEN is too soft on counterfeiters, and too cumbersome to be effective

美国电影协会认为OPEN对仿冒行为约束力度不够，过于繁琐而难以有效执行

Proposed Legislation 立法建议

- Formerly broad support for SOPA/PIPA softens
SOPA/PIPA之前的支持者态度普遍软化
 - White House announces it opposes SOPA and PIPA
白宫宣布其反对SOPA和PIPA
 - Two co-sponsors withdraw support
两大共同发起者撤回支持
 - January 20 vote on PIPA cancelled
原定1月20日针对PIPA的投票取消
 - However, bills are not dead
但是，这两个法案没有死亡
- Mainstream public now aware of the issues
大众现在已经意识到了这些问题

Trademark Bullying 商标欺凌



Trademark Bullying 商标欺凌



Big brand owner
大品牌所有人

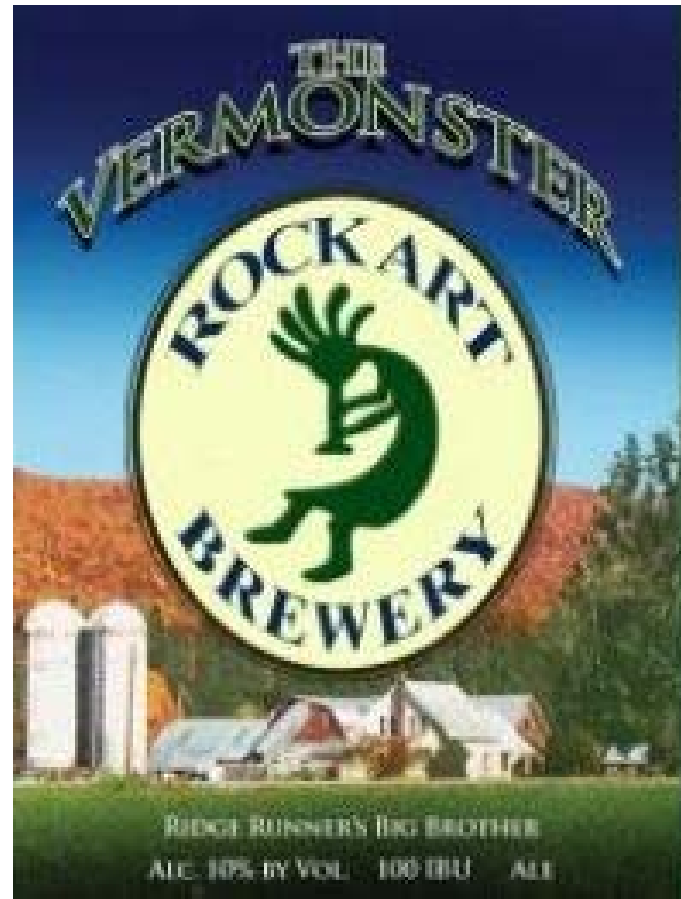


Little brand owner
小品牌所有人

Trademark Bullying 商标欺凌



VS.



MONSTER for energy drinks vs. VERMONSTER for beer

Trademark Bullying 商标欺凌

- Over-reaching enforcement of trademark rights by large, well-funded brand owners

大的有实力的品牌所有人过度实施商标权

– Threat of suit; also carrying out the threat

诉讼威胁； 并且提起诉讼

Trademark Bullying 商标欺凌

- Bad for small brand owners

对小品牌所有人的危害

- Pressure to abruptly abandon trademark is expensive, disruptive

突然放弃商标的压力是昂贵且具破坏性的

- Defending rights is unrealistic

捍卫权利是不现实的

Trademark Bullying 商标欺凌

- Bad for large brand owners 对大品牌所有人的危害
 - *ChillingEffects.org* （ 这是由电子前沿基金会和哈佛大学，斯坦福大学，乔治华盛顿大学法学院等多家法学院联合进行的一个项目 ） （寒蝉效应）
 - Internet campaigns, boycotts
互联网运动，抵制
 - Empty threats waste money and risk eroding legitimate trademark rights
空口威胁浪费资金，且带来削弱合法商标权利的风险

Trademark Bullying 商标欺凌

- Source of problem may be uninformed lawyers
问题的来源可能是对情况不了解的律师
- 2010 revision of trademark statute required study
需要研究2010年修订的商标法
 - PTO's conclusion: "It is unclear" whether problem exists; suggests lawyer education
美国专利和商标局的结论：“还不清楚”问题是否存在；建议律师学习
- Attorney's fees provision part of solution?
律师费条款可能一定程度解决问题？

Online Auctions 在线竞拍

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

ebay® Welcome! Sign in or register.

Go My eBay Sell Community Customer Support Cart

CATEGORIES ELECTRONICS FASHION MOTORS TICKETS DEALS CLASSIFIEDS

tiffany All Categories Search Advanced ☐ Include description





44,532 results found for tiffany Save search Tell Us What You Think?

Categories

- Jewelry & Watches (11,461)
 - Designer Brands (9,188)
 - Fine Jewelry (778)
 - Watches (599)
 - Vintage & Antique Jewelry (679)
 - Fashion Jewelry (195)
 - More
- Sports Mem, Cards & Fan Shop (8,612)
 - Cards (8,063)
 - Fan Apparel & Souvenirs (506)
 - More
- Home & Garden (6,139)
 - Inside the Home (5,700)
 - More
- Antiques (4,622)
 - Silver (4,123)
 - Decorative Arts (284)
 - More

All items Auctions only Buy It Now Products & reviews Beta Customize view

View as: Sort by: Best Match Page 1 of 872

	Tiffany & Co PLAT Diamond Engagement Ring 4.42Ct F-VS1 OVER 300 TIFFANY PIECES AT 35% OFF OR MORE! TAKE A LOOK Expedited shipping available Returns: Not accepted	Top-rated seller	Buy It Now	\$270,000.00 Free shipping	20d 17h 25m
	TIFFANY & CO. PALOMA PICASSO LOVING HEART DIAMOND NECKL... GREAT GIFT FOR VALENTINE'S, ANNIVERSARY, BIRTHDAY... Expedited shipping available Returns: Not accepted		46 Bids	\$203.17 Free shipping	1m
	Tiffany & Co Sterling Silver Oval Locket Charm Pendant ... Expedited shipping available Returns: Accepted within 7 days	Top-rated seller	11 Bids	\$130.00	2m
	Tiffany & Co glass gift box trinket wrapped present Ger... Returns: Accepted within 7 days	Top-rated seller	2 Bids	\$25.49	2m

Online Auctions 在线竞拍

- In 2004 and 2005, Tiffany found 73.1% and 75.5%, respectively, of its branded merchandise sold on eBay was counterfeit

在2004和2005两年间，Tiffany公司发现eBay销售该品牌商品的仿冒率分别为73.1%和75.5%

- Between 2000 and 2004, eBay earned \$4.1M from the sale of TIFFANY-branded goods

2000年至2004年期间，eBay销售带TIFFANY标识的商品获利4.1百万美元。

Online Auctions 在线竞拍

- Tiffany sued eBay for direct and contributory trademark infringement for enabling the sale of counterfeit TIFFANY-branded goods

Tiffany公司以帮助销售仿冒TIFFANY的物品为由，起诉eBay直接和帮助商标侵权

- eBay argued it never comes into possession of the goods, so it can't determine if they are counterfeit
eBay应诉称，其从来没有实际占有这些商品，因此其不能判断是否仿冒
- eBay also argued it suspends auctions if the trademark owner establishes that they involve counterfeit goods, or if the sellers have a history of selling counterfeit goods
eBay还称，如果商标所有人证明拍卖涉及仿冒商品，或者出售者有销售仿冒商品历史，eBay 会暂停竞拍

Online Auctions 在线竞拍

- No direct infringement 没有直接侵权
 - Elements: Defendant's use of trademark causes likelihood of confusion with senior user's trademark
要件：被告人使用商标导致与在先用户的商标发生混淆的可能

Online Auctions 在线竞拍

- No direct infringement 没有直接侵权
 - eBay did not itself sell any goods bearing TIFFANY mark
eBay 自己没有销售任何带有TIFFANY标识的商品
 - Held: eBay's use of mark was fair use because it simply identified what the seller purported to sell
判决：eBay是合理使用标识，因为其仅仅显示卖家声称要销售的商品

Online Auctions 在线竞拍

- No contributory infringement 没有帮助侵权
 - Elements: Liability exists if defendant induces party to infringe or continues to supply service to party after it has reason to know the party is engaging in infringement
- 要件：如果被告诱导他人侵权，或者应知该人有侵权行为仍持续向该人提供服务时，则被告对侵权有责任。

Online Auctions 在线竞拍

- No contributory infringement 没有帮助侵权
 - Held: eBay had neither 判决: eBay不符合两要件
 - It did not exercise control over infringing conduct or have more than “general knowledge” that its service was being used to sell counterfeit goods
eBay没有控制侵权行为，或仅仅“大致知道”有人用其服务销售仿冒商品
 - Nor was eBay “willfully blind” that infringement was occurring; its suspension policy was reasonable
eBay也没有“故意忽视”侵权行为的发生；它的暂停竞拍政策是合理的

Keyword Advertising 关键词广告

- *Rosetta Stone v. Google*
730 F.Supp.2d 531 (E.D. Va. 2010)
- On appeal to Fourth Circuit
已经上诉至第四巡回法院
 - Oral argument heard on September 22, 2011
2011年9月22日口头辩论
 - Decision expected in 2012
判决将于2012年作出

Keyword Advertising 关键词广告

- Rosetta Stone makes language learning software

Rosetta Stone 公司制作语言学习软件

– Spent \$100M on advertising

花费1亿美元广告费

Keyword Advertising 关键词广告

- Google is search engine provider

Google是搜索引擎提供商

- Over 70% of U.S. searches use Google
超过70%的美国网上搜索使用Google的服务
- In 2004 began to sell trademarks as keywords
2004年开始以关键词的形式销售商标
- Google even suggests trademarks to sell
Google甚至为建议出售什么商标

Keyword Advertising 关键词广告

- Counterfeiters purchased Rosetta Stone's ROSETTA STONE trademark as keyword
仿冒者购买了 Rosetta Stone公司的
“ROSETTA STONE”商标作为关键词

Keyword Advertising 关键词广告

The screenshot shows a Google search for "rosetta stone". The search bar at the top contains the text "rosetta stone" and a magnifying glass icon. Below the search bar, the word "Search" is displayed in red, followed by the text "About 9,890,000 results (0.18 seconds)".

On the left side, there is a sidebar with navigation links: "Everything", "Images", "Maps", "Videos", "News", "Shopping", and "More". Below these, there are filters for "Seattle, WA" (with a "Change location" link) and "Any time" (with options for "Past hour", "Past 24 hours", "Past 2 days", "Past week", "Past month", "Past year", and "Custom range..."). At the bottom of the sidebar is a link for "More search tools".

The main content area displays several search results. The first result is an advertisement for "Official Rosetta Stone® - New Year, New Language" from "www.rosettastone.com". It includes the text "Buy Now and Get Free Shipping" and a list of languages: "Learn French", "Learn English", "Learn German", "Learn Chinese", "Learn Spanish", and "Learn Italian".

The second result is another advertisement for "Rosetta Stone at Amazon - Buy Rosetta Stone and Save." from "www.amazon.com/Rosetta-Stone". It mentions "amazon.com is rated ★★★★★ 7,043 reviews" and "Free Shipping on Rosetta Stone!".

The third result is an advertisement for "Rosetta Stone - New Year, New Language | eBay.com" from "www.ebay.com/RosettaStone". It states "ebay.com is rated ★★★★★ 1,998 reviews" and "Shop Now and Receive Free Shipping".

The fourth result is an advertisement for "Official Rosetta Stone® - Learn a Language Online - Language ..." from "www.rosettastone.com/". It describes Rosetta Stone as the world's #1 language-learning software and provides a link to "Show stock quote for RST".

The fifth result is an organic search result for "Rosetta Stone - Wikipedia, the free encyclopedia" from "en.wikipedia.org/wiki/Rosetta_Stone". It provides a brief description: "The Rosetta Stone is an ancient Egyptian granodiorite stele inscribed with a decree issued at Memphis in 196 BC on behalf of King Ptolemy V. The decree ...".

On the right side, there is a section titled "Ads" which displays three product images of Rosetta Stone software boxes. Each image is accompanied by a title and price information:

- Rosetta Stone Spanish (Latin America) v4 ...**
\$179.00 - Staples
Free Shipping On All Orders
- Rosetta Stone Homeschool Italian Level 1 including ...**
\$159.00 - Amazon.com
Free Shipping on Orders above \$25.
- RosettaStone Spanish (Latin America) Level 1-5**
\$434.00 - Newegg.com

Below the product images is a link that says "See your ad here »".

Keyword Advertising 关键词广告

The screenshot shows a Google search for "rosetta stone". The search bar at the top contains the text "rosetta stone" and a magnifying glass icon. Below the search bar, the text "Search" is displayed in red, followed by "About 9,890,000 results (0.18 seconds)".

On the left side, there is a sidebar with navigation links: "Everything", "Images", "Maps", "Videos", "News", "Shopping", and "More". Below these, there are filters for "Seattle, WA" (Change location) and "Any time" (Past hour, Past 24 hours, Past 2 days, Past week, Past month, Past year, Custom range..., More search tools).

The main search results are displayed in a grid. The first result is an advertisement for "Official Rosetta Stone® - New Year, New Language" from www.rosettastone.com. It includes the text "Buy Now and Get Free Shipping" and a list of languages: Learn French, Learn English, Learn German, Learn Chinese, Learn Spanish, and Learn Italian. Below this is another advertisement for "Rosetta Stone at Amazon - Buy Rosetta Stone and Save." from www.amazon.com/Rosetta-Stone, which mentions "amazon.com is rated ★★★★★ 7,043 reviews" and "Free Shipping on Rosetta Stone!". The third advertisement is for "Rosetta Stone - New Year, New Language | eBay.com" from www.ebay.com/RosettaStone, mentioning "ebay.com is rated ★★★★★ 1,998 reviews" and "Shop Now and Receive Free Shipping".

Below the advertisements, there are organic search results. The first is "Official Rosetta Stone® - Learn a Language Online - Language ..." from www.rosettastone.com/, followed by a description of the software. The second is "Rosetta Stone - Wikipedia, the free encyclopedia" from en.wikipedia.org/wiki/Rosetta_Stone, followed by a brief history of the stone.

On the right side, there is a section titled "Ads" which contains three more advertisements for Rosetta Stone products: "Rosetta Stone Spanish (Latin America) v4 ..." for \$179.00 from Staples, "Rosetta Stone Homeschool Italian Level 1 including ..." for \$159.00 from Amazon.com, and "RosettaStone Spanish (Latin America) Level 1-5" for \$434.00 from Newegg.com. A link "See your ad here »" is at the bottom of this section.

Keyword Advertising 关键词广告

- Google addresses trademark abuse with notice-and-takedown policy

Google以“通知后拿下”政策解决商标滥用

- Rosetta Stone notified Google of 123 instances of counterfeiting in 8-month period

Rosetta Stone在8个月内向Google报告了123个仿冒案例

Keyword Advertising 关键词广告

- Google responded to complaints, but counterfeiting continued
Google回应了投诉，但仿冒仍然继续
- Rosetta Stone sued for direct, contributory, and vicarious trademark infringement
Rosetta Stone以直接、帮助以及替代商标侵权起诉Google

Keyword Advertising 关键词广告

Trademark “use” in commerce 商标的商业“使用”

- “Use” of trademark in commerce required to implicate trademark statutes
商标的商业“使用”是援用商标法的前提
- Held: Sale of trademarks constituted “use”
判决：商标销售构成“使用”

Keyword Advertising 关键词广告

Trademark “use” in commerce 商标的商业“使用”

- Issue not disputed; appears settled under U.S. law

题未经辩论；似乎根据美国法律达成和解

- *Network Automation v. Advanced Systems* (9th Cir. 2011)
- *Rescuecom v. Google* (2nd Cir. 2009)
- *GEICO v. Google* (E.D. Va. 2004)

Keyword Advertising 关键词广告

Direct trademark infringement 直接商标侵权

- Elements: Defendant's use of trademark causes likelihood of confusion with senior user's trademark

要件：被告人使用商标导致与在先商标发生混淆的可能

Keyword Advertising 关键词广告

Direct trademark infringement 直接商标侵权

- Held: No direct trademark infringement because Google's use of trademarks was functional

判决：无直接商标侵权，因为Google的商标使用是功能性的。

- Strange application of functionality doctrine
功能论的非常规运用

Keyword Advertising 关键词广告

Contributory Infringement 帮助侵权

- Elements: Defendant intentionally induces another to infringe or continues to supply product to another who knows or has reason to know is engaging in trademark infringement
要件：被告故意诱导他人侵权，或者应知该人有侵权行为仍持续向该人提供服务

Keyword Advertising 关键词广告

Contributory Infringement 帮助侵权

- Held: No contributory infringement

判决：没有帮助侵权

- Under *Tiffany v. eBay*, need more than generalized knowledge of counterfeiting

根据Tiffany 诉 eBay案确立的原则，不仅需要“大概知道”存在侵权

- Court “unpersuaded” by Rosetta Stone’s proof that Google had such knowledge

Rosetta Stone的证据不足以说服法院认定Google知情更多

Keyword Advertising 关键词广告

Vicarious Infringement 替代性侵权责任

- Elements: Absent an agency relationship, vicarious liability can only be imposed if the defendant and infringer “exercise joint ownership or control over the infringing product”

要件：除代理关系外，仅当被告和侵权人对侵权产品共同所有或者共同控制时，替代责任才成立

Keyword Advertising 关键词广告

Vicarious Infringement 替代性侵权责任

- Held: No vicarious infringement

判决：没有替代性侵权

- Google does not sell goods; it only sells space on a search results page. “This is no different than building owners in New York’s Times Square who sell space for billboards.” Since Google exercises no control over the content of the ads, it was not vicariously liable.

Google没有销售货物；它仅是销售一个搜索结果页面的空间。“这与纽约时代广场的建筑物所有人销售广告牌无异。”由于Google对广告的内容没有控制，它不承担替代责任。

Keyword Advertising 关键词广告

Support Rosetta Stone

- International Trademark Association (INTA)
- Association for Competitive Technology

支持 Rosetta Stone

- 国际商标协会(INTA)
- 竞争技术协会

Keyword Advertising 关键词广告

Support Google

- eBay and Yahoo!
- Electronic Frontier Foundation

支持 Google

- eBay 和 Yahoo!
- Electronic Frontier 基金会

Predicted outcome: Trial court got the right result for the wrong reasons. Fourth Circuit will remand with instructions to correct flawed analysis, but the outcome will be the same

预计结果: 一审法院理由错误但结果正确。第四巡回法院将把案件发回，要法院改正分析瑕疵，但判决结果还会是一样的

Keyword Advertising 关键词广告

- Trend is competitor vs. competitor lawsuits
趋势是竞争者起诉竞争者的诉讼
 - Avoids involving search engine providers
避免起诉搜索引擎供应商
 - But not effective in cases involving counterfeiting
但在涉及仿冒的案件中效果不好

Keyword Advertising 关键词广告

- *Binder v. Disability Law Group*, 772 F.Supp. 1172 (C.D. Calif. 2011)
 - Held: Law firm's purchase of competing firm's trademark constituted intentional trademark infringement
判决：律师事务所购买有竞争关系律所的商标构成故意商标侵权
 - Court awarded \$292k in damages, plus attorney's fees as "exceptional" case
法院判决29.2万美元的损害赔偿，并作为“例外”情况判决被告支付律师费
- However, liability for purchasing competitor's trademark as keyword still not settled
但是，购买竞争者的商标作为关键词的责任问题仍没有解决

Questions?

提问？

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atkinsip.com



Thank you!

谢谢！