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KERNOCHAN CENTER FOR LAW, MEDIA AND THE ARTS

Spring 2014

SYMPOSIUM ADDRESSES SECONDARY INFRINGEMENT ON THE WEB



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*Graeme Dinwoodie J.S.D.'00 at the Center's
Secondary Liability for Trademark Infringement on
the Internet Symposium on November 8*

On November 8, 2013, the Center hosted its annual Symposium which this year focused on trademark issues. "Who's Left Holding the [Brand Name] Bag? Secondary Liability for Trademark Infringement on the Internet" brought speakers from the government, academia, and private practice specializing in trademark enforcement and technology to CLS. They discussed the state of secondary liability for internet trademark infringement in the United States and abroad. Major themes included the need for flexibility and balance in developing trademark secondary liability rules, knowledge and participation requirements for contributory liability, and the possibility of statutory amendment to include secondary liability in the Lanham Act.

In his keynote address, Professor Graeme Dinwoodie J.S.D.'00 began by defining the meaning of secondary liability as liability of an intermediary for infringements by a third party. He noted that secondary liability claims might be strategically preferable to direct liability actions because the mark

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KERNOCHAN CENTER WELCOMES NEW IP FELLOW BRAD GREENBERG

Last fall, the Kernochan Center welcomed Brad Greenberg, the Center's new Intellectual Property Fellow. Greenberg received his J.D. from UCLA School of Law and then clerked for Senior Judge James Lawrence King of the U.S. District Court for the Southern District of Florida.

Greenberg also received his B.A. in Communication Studies from UCLA. As a former journalist, Greenberg finds his prior experience has significantly informed his current legal career.

"The five years I spent as a reporter helped me develop my voice as a writer, and write quickly and clearly," he explained. "Moreover, as an academic, journalism gave me a unique window into my primary research areas. I was able to see, on the ground, how copyright and media-related laws and the First Amendment affect creators."

He always knew he wanted to be a writer, which attracted him to journalism. However, he quickly found out that

he was interested in more than just the facts.

"Often, I found that the real issues were legal structures and their impacts on everyday life," he said. "As a content creator, I was particularly drawn to issues involving IP and media law. And I wanted to be a legal academic so that I could explore and analyze issues in great depth."

When Greenberg first heard about the Kernochan Center's Fellowship he was intrigued by what the Center had to offer.

"I appreciate that the Center is interested in not just copyright users, but also copyright authors, and I was thrilled about the prospect of getting feedback on my scholarship from Jane Ginsburg, whose copyright casebook I used in law school," he said.

While at Columbia, Greenberg's research will focus on the intersection of copyright and press issues. His other main focus will be managing the Cen-

ter's presence on social media. You can now follow the Kernochan Center at @KernochanCenter on Twitter.

"Twitter provides a wonderful forum for sharing Center events and new scholarship from the Center's fellows and affiliated faculty. It also helps include the Center in the legal discussions that occur every day on Twitter involving scholars, activists, authors, and users."

In his spare time, Greenberg is an avid basketball player and tries to fit in a game at least once a week. He has a son, Ben, who is almost two years old and his wife works in public relations. They live on the Upper West Side and love spending time with their two Pekingese rescue dogs.



Brad Greenberg

SYMPOSIUM ON SECONDARY LIABILITY FOR TRADEMARK INFRINGEMENT ON THE INTERNET

(Continued from page 1)

owner can secure relief against a party whose activity enables infringement by a number of infringers. But he questioned whether U.S. secondary liability doctrine is flexible enough to accommodate the emergence of new technologies and business models. According to Dinwoodie, the EU Commission favors voluntary solutions like memoranda of understanding, which it seeks to implement to avoid imposing affirmative rules through international organizations like WIPO. Dinwoodie then focused on online marketplaces and search engines as intermediaries. He stressed that, though the defendants are usually eBay or Google, it is important to avoid structuring the law around the resources of these large companies. He then discussed the influence that EU Directives such as the 2000 E-Commerce Directive and the 2004 Enforcement Directive have had on trademark policy.

The first panel offered an overview of principles of secondary liability in the U.S., the E.U. and China. Stacey Dogan, Professor of Law at Boston University School of Law, began this panel by identifying several normative goals that drive the U.S. courts in determining the scope of secondary liability. She noted fairness as one – it seems fair to the courts to impose liability on parties that are involved in someone else’s infringement. Another principle is that of the best cost avoider – if one party would be in a better position to combat infringement, it should be fair to impose a duty. Annette Kur, Senior Research Fellow, Max Planck Institute for Intellectual Property and Competition Law, laid out the general landscape of secondary liability in the EU, which is generally dependent on actual knowledge of infringements and the nature of the ISP’s role in the infringement.

Professor Du Ying of China’s Central University of Finance and Economics then discussed the state of internet secondary liability in Asia. She described the development of e-commerce regulation in China and some recent cases involving secondary trademark infringement liability. She identified two elements underpinning secondary liability in Chinese courts: a direct infringement, and knowledge of the infringement on the part of the ISP.

On the second panel of the day, which focused on international choice of law, Susy Frankel, Director of the New Zealand Centre of International Economic Law at Victoria University of Wellington, expressed her interest in the possibility of multilateral trademark solutions, especially given the problems with choice of law in international trademark disputes. Édouard Treppoz, Director of the Institute of Art and Cultural Law, University of Lyon, and Visiting Professor of Law, Columbia Law School, questioned whether territorial perspectives are appropriate in an age of global-reaching internet intermediaries such as Google. He explored a few cases that illustrated the problems with choice of law in the internet age. For instance, how do you determine the place of infringement when the internet transcends national boundaries? He argued that dependence of contributory infringement on direct infringement should be maintained for policy and technical reasons.

Attorney Wendy Larson from Pirkey Barber, PLLC

began the afternoon’s discussion on proposed liability regimes by questioning whether we should be examining the services that are provided to consumers in addition to the companies or intermediaries that provide these services. Some services that prove problematic for Larson’s clients include domain name registration services, privacy services, and monetized parking pages, among others. She called for a change in the Lanham Act to add statutory secondary liability, but acknowledged that achieving such an amendment would be difficult. Tom Rubin, Chief Intellectual Property Strategy Counsel at Microsoft, identified a number of considerations and investigative techniques that the company uses in enforcing its trademarks, including focusing on the quality of takedown requests and a focus on finding the identities of the infringing parties. He also mentioned that he thought brands and online service providers should work together to devise policies and technology to help deter infringement as effectively as possible in a way that reflects both parties’ interests.

The final panel was a roundtable focusing on issues that had been raised throughout the day. Amy Cotton from the Patent and Trademark Office introduced the government’s perspective on the new ICANN top-level domain system, which emphasizes collaboration and market-driven solutions. These Top-Level Domain Systems (TLDs) provide trusted spaces for consumers and brand-owners which can be controlled by the TLD owner. She added that the government is monitoring the voluntary agreements that are emerging in the marketplace with regard to the new TLDs, and enthusiastically endorsed the idea of the industry setting the standards for reasonableness and sustainability.

Robert Weigel of Gibson Dunn observed that, given evolving technology, in the future it may be possible to implement a “should have known” standard for secondary infringement. He noted, though, that more stringent enforcement against ISPs that affirmatively monitor may push infringers towards less-traditional ISPs. Bruce Rich of Weil, Gotshal & Manges LLP said that trademark infringement laws require a system that produces robust protection for trademark owners but also promotes innovation and good-faith enforcement by ISPs like eBay.

Miquel Peguera, Professor of Law at the Universitat Oberta de Catalunya, stressed the need for balance in secondary liability policy for trademark infringement, particularly cautioning against overextending trademark rights in the internet context. However, he urged that United States trademark law be improved to provide more certainty for ISPs. Irene Calboli, Professor of Law at Marquette University Law School and Visiting Professor at the National University of Singapore, stressed the need for flexibility in determining trademark policy. She also expressed hesitation about the implementation of a statutory notice-and-takedown regime in the face of rampant technological change.

Professor Jane Ginsburg suggested that trademark infringement is primarily financially motivated, and that working with payment providers as intermediaries could be an effective way to combat trademark infringement. Rich responded to Ginsburg’s comment to “follow the money” by questioning how far secondary liability should reach in the chain of investors in an internet service.

SPRING IP SPEAKER SERIES EXPLORES COPYRIGHT AND ARTISTS' RIGHTS

The first installments of the Center's Spring IP Speaker Series brought heated debates on copyright policy to the Law School. On January 28, Hillel Parness '95 and Yafit Lev-Aretz LL.M. '09 spoke on the possibilities of secondary liability legislation in copyright. Parness, a partner at Robbins, Kaplan, Miller & Ciresi L.L.P., noted that many of those critical of the legislation introduced in Congress in 2011, had not read the bills and had a poor understanding of their content. This ignorance was the real impediment to passing effective legislation allowing government action in cases where a website's main purpose was to participate in infringing trade. Lev-Aretz credited the death of the bills to the rise of the "tech lobby" and three factors which galvanized the public: the threat to UGC sites; events around the world such as Occupy Wall Street and the Arab Spring that focused on the common man exercising his power of choice; and the ease of public engagement. Lev-Aretz noted that since 2011, service and content providers have increasingly resolved these issues through private ordering which diminishes infringement on the internet but at the cost of public input into copyright policy.

On February 11, ReDigi CEO John Ossenmacher and BSA counsel Emery Simon discussed the first sale doctrine in the digital age. Simon argued that the world is made up of various contracts and that consumers license many more things than they buy outright, especially in the digital arena. He added there should be a secondary market for born-digital works, but it is extremely hard to use a law conceived for hardcopies to police the resale of digital goods which were likely licensed rather than bought in the initial transaction. Ossenmacher maintained that many transactions in the digital market are not licenses. ReDigi, a service which offers a secondary market in digital goods, requires sellers to prove ownership of their items and removes digital files from the seller's computer when a sale is processed. He argued that if a digital good is bought, it should be treated under the same terms as a non-digital good and, thus, sold pursuant to Section 109 of the Copyright Act.

On February 18, Shyam Balganes, an Assistant Professor at the University of Pennsylvania Law School, and Jonathan Zavin '73, partner at Loeb and Loeb, debated the role of laches in copyright litigation. They discussed *Petrella v. MGM*,

in which the heir of an author sued a major movie studio for infringement of a work written in 1973 and soon after made into the movie "Raging Bull." Plaintiff did not sue until 2009 and the 9th Circuit rejected the claim as barred by laches. The judges wrote that due to the length between the release of the movie and the heir's claims, many of the important parties had passed away and the studio had relied on being able to make derivative works of the film. Zavin compared the ruling to a sanction of adverse possession of copyright that sent creators the message that if they do not immediately sue when they feel a work has been infringed then they run the risk of losing their claim entirely while Balganes noted the decision threatens to be a sign to authors to sue early or risk losing their claim and that statutes of limitations as set out in the Copyright Act should prevail.

In the fourth installment of the series, Debevoise & Plimpton's Jeffrey Cunard and NYU Clinical Professor Jason Schultz discussed *WNET et. al. v. Aereo*, a copyright case to be argued before the Supreme Court later this month. Cunard, who represented the broadcasters in the lower courts, explained that the issue was whether Aereo was violating the broadcasters' public performance rights by retransmitting broadcast programming for a fee, and whether Aereo's conduct falls within the Transmit Clause, found in Section 101's definition of "to perform or display a work 'publicly.'" Aereo claims its activities result only in private performances, since it uses multiple small antennae each of which is temporarily assigned to an individual customer. Noting that many other courts and the EU Commission have ruled against Aereo and similar companies, Cunard argued that allowing Aereo's interpretation of the Transmit Clause would spell the end of royalty payments to creators of the programs. Jason Schultz agreed that the Court's decision will have resounding business and policy implications, but disagreed with Cunard's interpretation of the Transmit Clause. Stating that Aereo's service is no different than using slingshot technology to distribute audiovisual works to multiple personal devices, Schultz noted that the concepts of the public and private sectors are becoming less defined. He added it shouldn't be the case that "everything we gain in mobility, we lose in copyright law," and argued that a ruling against Aereo would unduly narrow the scope of private performance.

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KERNOCHAN CENTER WELCOMES VISITING PROFESSOR ÈDOUARD TREPPOZ



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Édouard Treppoz

Professor Édouard Treppoz, Professor of Law at the University of Lyon III Jean Moulin, has been in residence at Columbia since September.

At Lyon, he teaches intellectual property law and international private law and is currently teaching International Copyright Law with Professor Jane Ginsburg at Columbia.

This is the second time Treppoz has visited Columbia; he was a Fulbright scholar here in 1997, a stay which he says made him very interested in returning. His primary research is in the areas of copyright law and conflict of laws. He has written extensively on international copyright treaties and conflict of laws issues,

particularly in the EU and America, and is currently working with Professor Jane Ginsburg on a textbook in the field.

He is enjoying his time in the classroom and has been struck by the caliber of students in his class. When not teaching, he explores New York with his wife and three children.



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