

Fordham Intellectual Property Law and Policy Conference

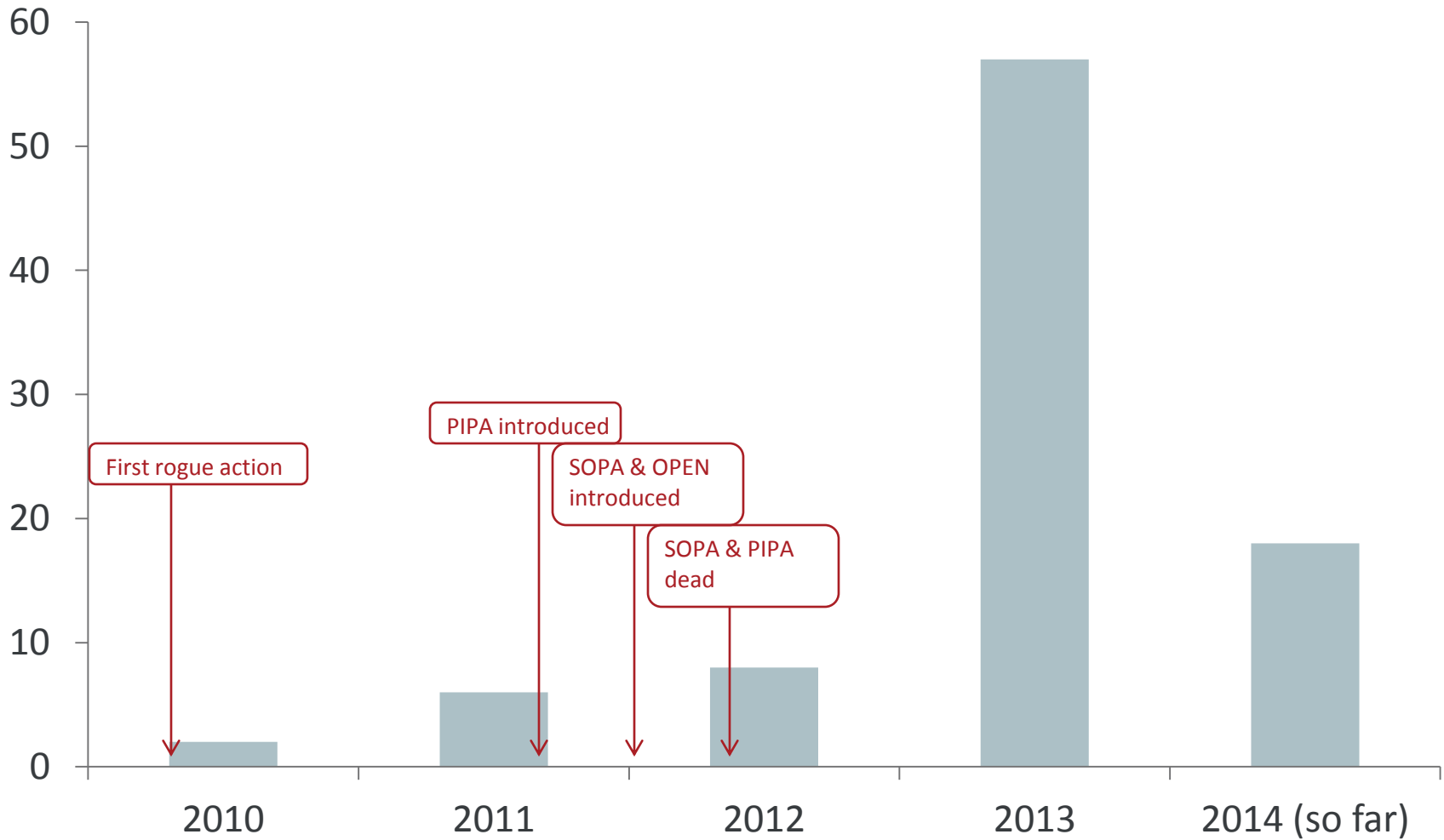
Session 4A: ENFORCEMENT, TRADEMARK & MULTILATERAL

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Rogue Actions each year



Due Process Concerns Under SOPA/PIPA

- Where notice to the owner/operator of the site is required under PIPA, there is no corresponding opportunity for the aggrieved site operator to be heard before the allegedly offending site or link is removed from the Internet.
- Under SOPA's private right of action, no notice is necessary before a plaintiff can have a site cut off from payment network providers and internet advertising services.

Due Process Under Rogue Website Litigation

- Due process requires that any service of notice be reasonably calculated, under all circumstances, to apprise interested parties of the pendency of the action and afford them an opportunity to present their objections.
- Rule 65: Court may issue a preliminary injunction only on notice to the adverse party
- What about Ex Parte Orders?

Ex Parte TRO – Without Notice

- Must make a showing: Specific facts showing immediate and irreparable harm, efforts to provide notice and/or notice would be futile
- Limited in Time (14 days, good cause, 28 days)
- PI hearing is set for earliest possible time, PI is on notice
- In counterfeiting, must also meet requirements of 1116
 - Seizure and restraint under 16 USC 1116 that meets requirements of FRCP 65 but not 15 USC 1116 is invalid
 - Applicant has not publicized the requested seizure

Rogue Actions – In Practice

- Service
 - Email – Given knowledge that Whois is often fake, does this comport?
 - Publication to Website (violation of 1116/no publication)?
 - Service by Third Parties
 - Combination of one/more

Third Party Liability Concerns Under SOPA/PIPA

- **Expands secondary liability.** In defining an infringing website, SOPA uses words like ‘facilitate’ and ‘enable’. There is potential that a site could qualify under the statutory definition but not meet the requirements for secondary liability under existing law. In this regard, SOPA could cause a lot of uncertainty in the law.

Rogue Actions – Third Party Liability

- Vicarious/Contributory differ between trademark and copyright law
- Third Parties added to Injunctive Relief
 - Active concert and participation
 - Where a domain name registry refused to comply with, and challenged the reach of, the *Fujian* injunction, the court stated that the injunction should have put the registry on notice and alerted it to “no longer play its role in allowing customers to connect to” the defendants’ websites because failing to take corrective action once noticed would constitute the “unlawful act” of aiding and abetting the defendants’ unlawful activities and would violate the injunction. Order [Doc. No. 56], *The North Face Apparel Corp. v. Fujian Sharing Import & Export Ltd.*, No. 10-civ-1630, at 5 (S.D.N.Y. June 24, 2011).