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ron coleman's blog on trademark, copyright, internet law and free speech

The question of LIKELIHOOD OF CONFUSION is the signal test to determine if a trademark infringement claim is valid. This blog is about trademark law, copyright law, free speech (mostly as it relates to the Internet) and legal issues related to blogging.

As for me, I'm Ron Coleman, a trademark lawyer in New York. More precisely, I'm a commercial litigator, business attorney and "IP maven" with a special interest in copyright and trademark infringement involving the Internet--including advising clients how to avoid them. I am also a writer and notional general counsel of the largely notional Media Bloggers Association. My firm, Goetz Fitzpatrick LLP, has offices in New York and New Jersey. I'm also a contributor to a few other blogs, including Dean's World.

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COICA: Big IP supersizes it

November 15th, 2010 by Ron Coleman | Print

Everything I've written about here for the last five years, or just about everything, is about to get a lot worse, explains David Post:

> *Congress is set to once again consider the Sen Leahy's Combating Online Infringements and Counterfeit Act, a truly awful bill (with the appropriately awful acronym "COICA" . . .). I have written a (relatively brief) "Law Professors' Letter in Opposition," which now has about 35 signatories, which you can read here. [There's a summary of the bill's provisions in the Letter — and the full text of the current version is posted here]*
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> *The bill would allow the Attorney General to institute an in rem action against the domain name of any Internet site "dedicated to infringing activities" — defined to include any site that "engages in" copyright or trademark-infringing activities where those activities, "taken together," are "central to the activity" of the site. The court would then be authorized to issue injunctions — not against the offending website, but against "the domain name" itself — ordering the domain name registrar where the target site's domain name was registered, and the domain name registry responsible for maintaining the authoritative database of names for the target site's top-level domain, to "lock out" the domain name (and therefore prevent access to the site through use of the domain name). The court could also enjoin any of the thousands of Internet Service Providers, or any "operator of a nonauthoritative domain name server" (a category that includes virtually all ISPs or operators of networks linked to the Internet), ordering them to "take technically feasible and reasonable steps designed to prevent [the] domain name from resolving to that domain name's Internet protocol address."*
>
> *It's awful on many fronts. It would allow a court to effectively shut down a site operated out of Brazil, or France, without any adversary hearing (unless, I suppose, "the domain name" itself comes into court to argue the case) or any reasoned determination that the site actually is engaged in unlawful activity. There is a name for that in our law: "prior restraint," and we don't like them — even in cases where truly compelling governmental interests are at stake, let alone where the purpose is merely to protect the rights of copyright and trademark owners.*

The fact is, these proposals are reactions to real problems. But in typical piggy fashion, Big IP wants to use a sledgehammer where perhaps some fine carpentry would do.

Now learning how to build things right — even radically different things, but things that will stand up — takes hard work, diligence and practice, and not just everyone can be a cabinet maker. The IP enforcement community, however, is flummoxed. They don't want to spend the money on craftsmanship; they want the big, wide problem of IP enforcement to be amenable to solution by journeymen. This reaction is understandable, considering how expensive the work of master can be — and often, how little there can be to show for it.

Consider, for example, Gibson Dunn & Crutcher: As elite a litigation department as you can think of (unless perhaps you're in Montana, but who cares about flyover country?) and leaders in IP-enforcement litigation. What has this leadership achieved for its clients? I don't say this lightly, but not a whole heck of a lot. Not much for Rosetta Stone. Not much for Tiffany. Heck, even on the defense side, they didn't exactly work any magic for Baidu. Well, it isn't really whether you win or lose, now, is it? I sure don't feel that way. So we, their colleagues, still think the world of Gibson Dunn, and envy its success and wealth. But as a cost-effective solution to the IP enforcement problems of Big IP, Big Law is not working out so well . . . except for Big

FRIEND.

The term of art maven is used to mean "wise guy" here and is not meant to suggest that I have certified or other "expertise" in any particular field of legal practice. But try me.

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Law.

Thus Big IP wants cookbook enforcement laws that can be handled by the journeyman IP law firms whose rates are about half the going price for white shoes. (No, I won't link anywhere for this; either you know who I'm talking about or you won't get it anyway.) The anti-counterfeiting amendments to the Lanham Act and the DMCA, which so much that is, contrary to Anglo-Saxon tradition, self-executing, along with statutory damages provisions that make neat-o press releases, are quite rationally seen in this community as an ideal model for how this can work, at least on the streets and at the swap meets.

Well, almost ideal — in fact, there is some tension here, because the DMCA has not been all good for Big IP, what with its judicially stretched Section 230 carve-out, and the tendency of judges to borrow from it, improperly in my view, when deciding trademark cases. But the shortcuts enshrined in these laws still beat the heck out of annoying things like burdens of proof and rigorous evidentiary and procedural standards, which some judges sometimes require plaintiffs to trouble themselves with. It's enough to tax your average meatball IP bucket shop in the rare case a plaintiff is called on it — which is, again, not usually a problem.

Big IP's problem, however, is real. It got no respect from the courts in the *Tiffany* case when its master carpenters argued, not meritlessly in my view, that brand owners should not bear essentially the whole cost of enforcing trademarks against counterfeiting when outfits such as eBay are profiting magnificently from such illegitimate sales. Offshore websites are immune from practical judicial enforcement. Outliers such as *Baidu* aside, IP enforcement by proxy — secondary trademark liability — has not ported well from flea markets to the Internet. And at the same time, what has Big IP reaped using bulldozers to harvest low-hanging fruit such as casual file-sharers? Despite a goal of protecting those monopoly-like profit margins of the past, the paradoxical result has been strange fruit indeed: a cultural crisis of buy-in to the whole concept of IP, as I argued in this recent article. As a result, the tycoons of brand equity are flailing helplessly in a world that, far from needing "protection" from counterfeits, is pretty cool with fake Rolex watches and Vuitton bags and considers paying for music a sucker's game.

The answer, however, is not more bulldozers, though it's not as if Congress won't always buy whatever heavy equipment is requested by these generous donors. It is to be hoped that David Post is right and COICA won't survive judicial scrutiny — that eventually some plaintiff whose rights matter enough will find a judge who takes the trouble to care about the law and the old fashioned concepts of due process, burdens of proof and the Rules of Evidence (no, really, listen to Mike Masnick and read the article!).

Returning to our carpenter image, yes, when you're a hammer, everything looks like a nail, yes — but do you have to smash it to smithereens? The IP crackup continues and, as is always the case in any good crackup, it is happening mainly at the hands of those that claim to love it best.

And what's not to love?

UPDATE: Ed Morrissey focuses on the free expression piece of it all — which is a big piece. (Hat tip to Instapundit.)

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