



# Secondary Liability for Trademarks

Trademark & Unfair Competition

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## Secondary liability in the trademark context generally

- The U.S. Supreme Court has said that trademark law observes a narrower conception of secondary liability than in the copyright context. ([Sony v. Universal Studios \(U.S. 1984\) at 439 n.19](#))
- Courts have used tort law to draw the scope of secondary liability for trademark infringement.

## Contributory infringement – law

- Intentional inducement creates contributory liability
  - “if [one] intentionally induces another to infringe a trademark ... the [one] is contributorially responsible” [Inwood Laboratories v. Ives Laboratories, 456 U.S. 844, 854 \(1982\)](#)
- The defendant’s willful blindness to infringement done with defendant’s instrumentalities that are in the defendant’s control creates contributory liability
  - “To be willfully blind, a person must suspect wrongdoing and deliberately fail to investigate.” [Hard Rock Cafe Licensing v. Concession Serv, 955 F.2d 1143, 1149 \(7th Cir. 1992\)](#)

## Contributory infringement – Tiffany v. eBay

"Tiffany's general allegations of counterfeiting failed to provide eBay with the knowledge required under Inwood. Tiffany's demand letters and Buying Programs did not identify particular sellers who Tiffany thought were then offering or would offer counterfeit goods. And although [notices] and buyer complaints gave eBay reason to know that certain sellers had been selling counterfeits, those sellers' listings were removed and repeat offenders were suspended from the eBay site. Thus Tiffany failed to demonstrate that eBay was supplying its service to individuals who it knew or had reason to know were selling counterfeit Tiffany goods." [Tiffany \(NJ\) Inc. v. eBay Inc., 600 F.3d 93, 109 \(2d Cir. 2010\)](#)