



Protecting Brands on the New Amazon Brand Registry

By Mei Tsang, Esq.

With 300 million users in the U.S., and 95 million of them (63 percent of the households) using Amazon Prime, it is no surprise that large retailers and private labels continue to flock to Amazon to sell their branded products. With about 100,000 new sellers joining every month, counterfeits continue to be a battle for Amazon and brand owners.

Over the years, Amazon has set up a Brand Registry which allows owners to register their marks. The original version was fairly easy to use. Brand owners would simply show an image of their product and an e-commerce site. Quickly this version was found to be problematic as many do not have legitimate rights to their trademarks. Amazon overhauled its program and launched the new Amazon Brand Registry aka Amazon Brand Registry 2.0.

One of the main differences between Amazon Brand Registry 2.0 and the original version is that the brand owner must have a valid federal trademark registration. The federal trademark registration also must be active on the *Principal Register*. Many descriptive marks have a U.S. Trademark Registration, but they may be on the Supplemental Register instead of the Principal Register, and thus not eligible.

The benefits outweigh the extra effort for brand owners under this program. First, it allows greater protection for brand owners to report brand violations and combat illegitimate claims of trademark ownerships. Furthermore, Amazon is also providing brand owners with a powerful search tool for infringing products. Amazon now has over 300 employees in the U.S. who only deal with infringement claims. Finally, the burden of proof on

infringement has shifted now to the accused sellers instead of the brand owners.

Infringement litigation can be long and costly. Stopping infringers on Amazon is a quick way for brand owners to protect themselves in an increasingly competitive marketplace. The key factor for brand owners is to have a valid federal trademark. The U.S. Patent and Trademark Office continues to become stricter in allowing trademarks to get through the process. Many marks face common rejections of either a likelihood of confusion with other similar marks or being too descriptive. These rejections can be hard to overcome. Thus, brand owners would be wise to choose brands that have been cleared and consulted through a trademark attorney to ensure a higher chance of getting on the Principal Register.

Mei Tsang

Mei is an intellectual property partner at the law firm of Umberg/Zipser LLP. She helps clients build and enforce their IP portfolio - patents, trademarks and copyrights. Mei is fluent in both Cantonese and Mandarin.

