

No. 19-3388

---

**In the United States Court of Appeals  
for the Sixth Circuit**

---

THE OHIO STATE UNIVERSITY  
*Plaintiff – Appellant,*

v.

REDBUBBLE, INC.  
*Defendants – Appellees.*

**Appeal from the United States District Court, Southern District of Ohio,  
Case No. 2:17-cv-1092, Hon. Algenon L. Marbley**

---

**PRINCIPAL BRIEF OF APPELLEE REDBUBBLE, INC.**

---

Gerhardt A. Gosnell II  
JAMES E. ARNOLD & ASSOCIATES, LPA  
115 W. Main St., Fourth Floor  
Columbus, Ohio 43215  
Telephone: (614) 460-1600  
Facsimile: (614) 469-1093  
Email: ggossnell@arnlaw.com

Kenneth B. Wilson  
COASTSIDE LEGAL  
455 1st Avenue  
Half Moon Bay, California 94019  
Telephone: (650) 440-4211  
Email: ken@coastsidelegal.com

Joshua M. Masur  
ZUBER LAWLER & DEL DUCA LLP  
2000 Broadway Street, Suite 154  
Redwood City, California 94063  
Telephone: (650) 434-8538  
Facsimile: (213) 596-5621

*Attorneys for Appellee Redbubble, Inc.*

**ORAL ARGUMENT REQUESTED**

---

**STATEMENT OF CORPORATE AFFILIATIONS**  
**AND FINANCIAL INTEREST**

Pursuant to 6th Cir. R. 26.1, Appellee, Redbubble Inc., makes the following disclosures:

1. Is said party a subsidiary or affiliate of a publicly-owned corporation? If the answer is YES, list below the identity of the parent corporation or affiliate and the relationship between it and the named party:

Yes. Redbubble Inc. is a wholly owned subsidiary of Redbubble Limited, an Australian publicly traded company.

2. Is there a publicly-owned corporation, not a party to the appeal, that has a financial interest in the outcome? If the answer is YES, list the identity of such corporation and the nature of the financial interest:

No.

/s/ Gerhardt A. Gosnell II  
(Signature of counsel)

November 21, 2019  
Date

## **STATEMENT REGARDING ORAL ARGUMENT**

Redbubble agrees with OSU that oral argument should be permitted.

## **TABLE OF CONTENTS**

DISCLOSURE OF CORPORATE AFFILIATIONS AND FINANCIAL INTEREST .....	i
STATEMENT REGARDING ORAL ARGUMENT .....	ii
TABLE OF AUTHORITIES .....	vi
STATEMENT OF ISSUES .....	1
INTRODUCTION .....	2
STATEMENT OF THE CASE.....	7
A.    BACKGROUND OF DEFENDANT REDBUBBLE.....	7
B.    REDBUBBLE DOES NOT DESIGN OR UPLOAD CONTENT SOLD ON THE MARKETPLACE .....	8
C.    REDBUBBLE DID NOT SELL OR OFFER TO SELL THE ACCUSED PRODUCTS .....	9
D.    REDBUBBLE DOES NOT PRINT, MANUFACTURE, PACKAGE OR SHIP PRODUCTS .....	12
E.    REDBUBBLE’S SUBSTANTIAL EFFORTS TO COMBAT PIRACY .....	13
F.    BACKGROUND OF THIS DISPUTE .....	14
G.    THE LITIGATION .....	15
SUMMARY OF THE ARGUMENT .....	20
ARGUMENT .....	22
I.    REDBUBBLE WAS ENTITLED TO SUMMARY JUDGMENT ON OSU’S TRADEMARK INFRINGEMENT CLAIMS .....	22

A.	OSU’s Only Trademark Claim Is for <i>Direct</i> Trademark Infringement; OSU Chose Not to Bring Any Secondary Liability Claims .....	22
B.	OSU Failed to Present Evidence that Redbubble “Used” Any OSU Trademark .....	24
1.	“Use in Commerce” Encompasses Placing a Mark on a Product or Related Advertising or Sales Materials, as Well as Manufacturing, Selling or Offering to Sell Infringing Products, But Excludes Enabling, Facilitating or Assisting the Performance of These Acts by Others .....	25
2.	Redbubble Did Not Manufacture or Place the OSU Marks on the Accused Products.....	27
3.	Redbubble Did Not Advertise the Accused Products.....	29
4.	Redbubble Did Not Sell the Accused Products .....	30
a.	The Relevant Case Law Uniformly Supports the Conclusion that Redbubble Is Not a Seller.....	32
b.	The Case Law Involving the Amazon Marketplace Is the Most Analogous to the Case at Hand .....	34
5.	Redbubble Did Not Offer to Sell the Accused Products .....	39
C.	The District Court Correctly Held that Redbubble Is Not Liable for Enabling or Facilitating Infringement .....	40
D.	Redbubble Cannot Be Held Liable for Vicarious Trademark Infringement .....	41
1.	OSU’s and University Counsel Amici’s Argument that Redbubble Can Be Held Vicariously Liable Was Not Raised Below and Is Therefore Waived on Appeal.....	41
2.	There Is No Evidence in the Record that Would Support a Vicarious Trademark Infringement Claim.....	45

a.	There Is No Evidence that Redbubble Had “an Actual or Apparent Partnership” with Fulfillers .....	45
b.	There Is No Evidence that Redbubble and Fulfillers “Have Authority to Bind One Another in Transactions.” .....	47
c.	There Is No Evidence that Redbubble and Fulfillers “Exercise Joint Control Over the Infringing Product.” .....	49
E.	The Cases Cited by OSU Are Largely Inapposite to the Issues on Appeal .....	51
F.	Contrary to the Argument Made in the INTA Amicus Brief, the District Court Did Not Prematurely Grant Judgment in Favor of Redbubble.....	53
G.	The Court Should Not Consider the Brief of the University Counsel Amici Because It Improperly Contains and Extensively Relies Upon New Factual Material Outside the Record, and Therefore Exceeds the Scope of a Permissible Amicus Brief .....	55
II.	REDBUBBLE WAS ENTITLED TO SUMMARY JUDGMENT ON OSU’S RIGHT OF PUBLICITY CLAIM .....	58
	CONCLUSION .....	59
	CERTIFICATE OF COMPLIANCE.....	61
	CERTIFICATE OF SERVICE .....	62
	DESIGNATIONS OF RELEVANT DISTRICT COURT DOCUMENTS .....	63

## **TABLE OF AUTHORITIES**

### **Cases**

<i>1-800-Contacts, Inc. v. Lens.com, Inc.</i> , 722 F.3d 1229 (10th Cir. 2013) .....	43
<i>Almeida v. Amazon.com, Inc.</i> , 456 F.3d 1316 (11th Cir. 2006) .....	58
<i>Anheuser-Busch, Inc. v. L &amp; L Wings, Inc.</i> , 962 F. 2d 316 (4th Cir. 1992) .....	15
<i>Armstrong v. City of Melvindale</i> , 432 F.3d 695 (6th Cir. 2006) .....	42
<i>Bird v. Parsons</i> , 289 F.3d 865 (6th Cir. 2002) .....	32, 33
<i>Bormuth v. County of Jackson</i> , 870 F.3d 494 (6th Cir. 2017) ( <i>en banc</i> ) .....	54, 56
<i>Cellnet Comms., Inc. v. F.C.C.</i> , 149 F.3d 429 (6th Cir. 1998) .....	42, 54, 57
<i>Coach, Inc. v. Goodfellow</i> , 717 F.3d 498 (6th Cir. 2013) .....	22, 23, 26, 28, 43
<i>Cross v. Facebook, Inc.</i> , 14 Cal. App. 5th 190 (2017) .....	58
<i>Downing/Salt Pond Partners, L.P. v. R.I. &amp; Providence Plantations</i> , 643 F.3d 16 (1st Cir. 2011) .....	42
<i>E.E.O.C. v. Ford Motor Co.</i> , 782 F.3d 753 (6th Cir. 2015) ( <i>en banc</i> ) .....	55
<i>Evans v. Georgia Reg'l Hosp.</i> , 850 F.3d 1248 (11th Cir. 2017) .....	42

<i>Fox v. Amazon.com, Inc.</i> , 930 F.3d 415 (6th Cir. 2019) .....	4, 37, 38
<i>GMA Accessories, Inc. v. BOP, LLC</i> , 765 F.Supp.2d 457 (S.D.N.Y. 2011) .....	31, 32, 33, 36
<i>Grubbs v. Sheakley Group, Inc.</i> , 807 F.3d 785 (6th Cir. 2015) .....	23, 42, 43, 45, 47
<i>H-D USA, LLC v. SunFrog LLC</i> , 311 F.Supp.3d 1000 (E.D. Wisc. 2018).....	28, 41, 51, 52
<i>Hendrickson v. Amazon.com, Inc.</i> , 298 F.Supp.2d 914 (C.D. Cal. 2003) .....	36
<i>Hensley Mfg. v. ProPride, Inc.</i> , 579 F.3d 603 (6th Cir. 2009) .....	24
<i>Holbrook v. Dumas</i> , 658 F.App'x 280 (6th Cir. 2016) .....	45
<i>Holiday Inns, Inc. v. 800 Reservation, Inc.</i> , 86 F.3d 619 (6th Cir. 1996) .....	24
<i>Inwood Laboratories, Inc. v. Ives Laboratories, Inc.</i> , 456 U.S. 844 (1982).....	23, 26
<i>Lorillard Tobacco Co. v. Amouri's Grand Foods, Inc.</i> , 453 F.3d 377 (6th Cir. 2006) .....	25, 30, 44, 45
<i>Metro Communications Co. v. Ameritech Mobile Communications, Inc.</i> , 984 F.2d 739 (6th Cir. 1993) .....	31
<i>Milo &amp; Gabby, LLC v. Amazon.com</i> , 144 F. Supp. 3d 1251 (W.D. Wash. 2015).....	31
<i>Milo &amp; Gabby, LLC v. Amazon.com, Inc.</i> , 2015 WL 4394673 (W.D. Wash. July 16, 2015) .....	<i>passim</i>

<i>Milo &amp; Gabby, LLC v. Amazon.com, Inc.</i> , 693 F.App'x 879 (Fed. Cir. 2017) .....	3, 4, 35, 36, 39
<i>National Business Forms &amp; Printing, Inc. v. Ford Motor Co.</i> , 671 F.3d 526 (5th Cir. 2012) .....	51
<i>Perfect 10, Inc. v. Google, Inc.</i> , No. CV 04-9484 AHM (SHx)), 2010 WL 9479060 (C.D.Cal., July 30, 2010), <i>aff'd</i> 653 F.3d 976 (9th Cir. 2011) .....	58
<i>Smith v. United States</i> , 343 F.2d 539 (5th Cir. 1965) .....	55
<i>Stiner v. Amazon.com, Inc.</i> , 120 N.E.3d 885 (Ohio Ct. App. 2019) .....	38
<i>The Ohio State University v. Skreened Ltd.</i> , 16 F.Supp.3d 905 (S.D. Ohio 2014) .....	51, 52
<i>Tiffany (NJ) Inc. v. eBay, Inc.</i> , 600 F.3d 93 (2d Cir. 2010) .....	5, 23, 28, 33, 41
<i>Too, Inc. v. TJX Cos.</i> , 229 F. Supp. 2d 825 (S.D. Ohio 2002) .....	53
<i>Tre Milano, LLC v. Amazon.com, Inc.</i> , No. B234753, 2012 WL 3594380 (Cal. App. 2012) .....	<i>passim</i>
<i>Unan v. Lyon</i> , 853 F.3d 279 (6th Cir. 2017) .....	54
<i>University of Alabama v. New Art Life, Inc.</i> , 683 F.3d 1266 (11th Cir. 2012) .....	15
<i>Victoria's Secret Stores v. Artco Equip. Co.</i> , 194 F. Supp. 2d 704 (S.D. Ohio 2002) .....	53
<i>White v. Anchor Motor Freight, Inc.</i> , 899 F.2d 555 (6th Cir. 1990) .....	42

<i>Yankton Sioux Tribe v. Gaffey</i> , 188 F.3d 1010 (8th Cir. 1999) .....	56
---	----

## **Statutes**

15 U.S.C. § 1114.....	20, 22, 24, 26
15 U.S.C. § 1125.....	20, 22, 24
15 U.S.C. § 1127.....	25, 26
47 U.S.C. § 230.....	59
Ohio Rev. Code § 2741.02.....	21, 58, 59
Tenn. Code Ann. § 29-28-102(7).....	37

## **Rules**

Fed. R. Civ. P. 56(d) .....	54
Fed. R. Evid. 404(b)(1) .....	57

## **STATEMENT OF ISSUES**

1. Did the district court correctly hold that Redbubble is not liable for direct trademark infringement as a matter of law because it did not “use” the allegedly infringed marks in commerce, where the undisputed evidence demonstrated that Redbubble did not place the marks in question on products or advertisements (or on anything else), and did not make, advertise, offer for sale or sell the allegedly infringing products?

2. Did the district court correctly hold that Redbubble is not liable for violation of the right of publicity of OSU’s former football coach, Urban Meyer, as a matter of law because Redbubble did not “use” any aspect of Mr. Meyer’s persona for a commercial purpose, where the undisputed evidence demonstrated that Redbubble did not place Mr. Meyer’s name or likeness on products or advertisements (or on anything else), and did not make, advertise offer for sale or sell products bearing Mr. Meyer’s name or likeness?

## **INTRODUCTION**

Plaintiff/Appellant The Ohio State University's ("OSU's") position on appeal rests on a fundamental mischaracterization of the facts and law before this Court. OSU repeatedly calls Redbubble an "on-demand printing website" or a "print-on-demand website," attempting to lump Redbubble in with printers and other companies who directly "use" infringing marks "in commerce" by printing and selling infringing T-shirts and other products. But the district court correctly determined that Redbubble cannot be held liable for direct trademark infringement for products offered or sold via the online marketplace it hosts, for the simple reason that Redbubble does not place the allegedly infringed marks on products (or for that matter anything else); it does not make, advertise, offer to sell or sell those products; and it does not otherwise use the marks in question, let alone in commerce. OSU's Brief does not point to any facts to the contrary.

OSU admits that "Redbubble did not upload Ohio State's trademarks to its website; third parties did that." (App. Br. at 17). Redbubble did not print or otherwise manufacture the products that OSU has accused of infringement (the "Accused Products"); that was done by independent third-party manufacturers who use their own facilities, employees, equipment and processes at the direction of sellers and their customers. Redbubble never took possession, control or ownership of or title to the Accused Products. Redbubble personnel did not pack,

ship, perform quality control on or otherwise handle those products. And while OSU makes conclusory statements to the contrary, Redbubble did not sell or offer to sell the Accused Products under the legal definition of “sale.”

Redbubble’s business activities differ markedly from those of SunFrog, Skreened, and other printer/sellers that have been held liable for direct trademark infringement in the opinions cited by OSU. Unlike Redbubble, both SunFrog and Skreened admittedly made and sold the products at issue. As the court below pointed out, this conduct formed the basis of the direct trademark infringement determinations in those cases.

To hold Redbubble – which has not placed the OSU Marks on anything, and never possessed, made, advertised, offered or sold the Accused Products – liable for direct infringement under the Lanham Act would be unprecedented. OSU certainly has not cited to any case imposing liability for *direct* trademark infringement on a party that did not perform any of these acts.

As the district court observed, the correct analogy is to cases analyzing the business model of the Amazon Marketplace. Amazon has repeatedly been held not liable for direct trademark infringement because, like Redbubble, Amazon does not sell or manufacture the products sold by third parties using its marketplace platform. *See, e.g., Milo & Gabby, LLC v. Amazon.com, Inc.*, 2015 WL 4394673 (W.D. Wash. July 16, 2015) (“*Milo & Gabby I*”), *aff’d* 693 F.App’x 879 (Fed. Cir.

2017) (“*Milo & Gabby II*”); *Tre Milano, LLC v. Amazon.com, Inc.*, No. B234753, 2012 WL 3594380 (Cal. App. 2012); *see also Fox v. Amazon.com, Inc.*, 930 F.3d 415 (6th Cir. 2019) (for a strict product liability claim, Amazon was not the seller of hoverboards offered through the Amazon Marketplace because Amazon “did not choose to offer the hoverboard for sale, did not set the price of the hoverboard, and did not otherwise exercise ‘sufficient control’ over the product”). Notably, both OSU and its supporting amici omit any substantive discussion of these analogous cases.

The district court’s ruling does not prevent OSU from pursuing direct infringement claims against others. For example, OSU may have claims for direct trademark infringement against third-party Sellers who create and upload designs for and sell potentially infringing products. OSU may also have claims for direct infringement against third-party printers, although as OSU acknowledges, “they may well be entitled to the innocent printer defense.” (App. Br. at 57).

OSU and the University Counsel Amici wrongly suggest that the district court’s ruling would completely immunize companies like Redbubble from liability for hosting a marketplace where third-party sellers might upload and sell products that infringe OSU’s trademarks. For example, a marketplace provider could, under circumstances not present here, be held liable for knowingly facilitating the sales of infringing products by third-parties. But “facilitating

infringement” does not give rise to *direct* liability, although it may constitute *contributory* infringement, a form of secondary liability. *See Tiffany (NJ) Inc. v. eBay, Inc.*, 600 F.3d 93, 103 (2d Cir. 2010) (liability for direct infringement requires defendant’s personal use of the infringing mark, but liability “for contributory infringement [requires] culpably facilitating the infringing conduct of the counterfeiting vendors”). OSU has repeatedly confirmed that it brought no claim for contributory infringement; it “has only brought claims against Redbubble for direct infringement.” (Reply at 2, R. 39, PageID#594).

Apparently recognizing the deficiencies in its direct infringement theory, OSU asserts for the first time on appeal another type of secondary liability claim: vicarious infringement. While a marketplace facilitator could theoretically be held liable (on other facts) for vicarious infringement, such claim was not presented or even mentioned in OSU’s Complaint, summary judgment papers, or elsewhere below, and was therefore waived. Even if OSU had asserted such a claim below, it would have failed because there was no evidence of a “partnership” or other preferred relationship between Redbubble and the alleged direct infringers.

Finally, the district court correctly held that OSU’s claim for violation of the right of publicity of its former football coach is without merit. Such a claim requires that the defendant “use” some aspects of the plaintiff’s persona, but Redbubble made no such use.

Because Redbubble did not engage in conduct which might constitute a “use” of the content at issue, Redbubble did not directly infringe OSU’s trademarks or violate Mr. Meyer’s publicity rights. Redbubble respectfully requests that this Court affirm.

## **STATEMENT OF THE CASE**

### **A. BACKGROUND OF DEFENDANT REDBUBBLE.**

Much like the Amazon Marketplace and eBay, Redbubble is a global online marketplace platform. (Toy Decl. Exh. A, R.24-1, PageID#525-27). Founded in 2006, and publicly traded on the Australian Securities Exchange since May 2016, Redbubble was formed to “[g]ive independent artists a meaningful new way to sell their creations” and operates under the stated mission of “bringing more creativity into the world.” (*Id.* Exhs. A-B, PageID#525-28). The independent artists using the Redbubble platform upload and sell their creative designs on high-quality, everyday products such as apparel, stationery, housewares, bags, and wall art.

The Redbubble Marketplace provides a platform through which products can be listed and sold and automatically performs various services to facilitate such transactions. In particular, the Marketplace software connects third-party artists or “Sellers” automatically to third-party manufacturers, who print and pack the products, before third-party shippers pick up the products and deliver them to customers. (Luthra Decl. ¶3, R.26, PageID#559; Deshais Decl. ¶3, R.25, PageID#555). The platform also provides Sellers access to third-party payment processors who collect and process customer payments. (Luthra Decl. ¶4, R.559-60). This transaction process is entirely Seller-directed and automated by the Redbubble Marketplace software. (*Id.*). No Redbubble personnel designed,

The balance of this brief has been omitted for this sample.  
For a complete version of this brief, please contact our office.

Thank you.