

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF GEORGIA
ATLANTA DIVISION**

MICROTECH KNIVES, INC.,

Plaintiff,

v.

OUTDOORS ONLINE, LLC and JON
JANECEK,

Defendants.

Civil Action No.

1:23-cv-04381-VMC

ORDER

Before the Court are the following motions:

- Defendant Jon Janecek’s Motion for Partial Summary Judgment (Doc. 82); and
- Defendant Janecek’s Motion for Leave to File Amended Answer (Doc. 89); and
- Defendant Gunbroker d/b/a Outdoors Online, LLC’s (“Gunbroker”) Motion for Summary Judgment (Doc. 98).

The Court held a hearing on the motions on May 22, 2025, after which it took the motions under advisement. For the reasons that follow, the Court enters the following Order.

Background¹

I. The Parties

A. Outdoors Online, LLC (“Gunbroker”)

GunBroker.com is an online marketplace that was established in 1999. (Doc. 103-1 ¶¶ 1-2). GunBroker serves as a web-based platform allowing sellers to sell their products to buyers; in other words, it provides the means for users to buy and sell products. (*Id.* ¶¶ 6-7).

Buyers and sellers must agree to GunBroker’s User Agreement to use GunBroker.com. (*Id.* ¶ 3). Buyers and sellers must also register with GunBroker.com to buy or sell through GunBroker.com. (*Id.* ¶ 4). Registered users on GunBroker.com can buy and sell a wide range of products, including firearms and knives. (*Id.* ¶ 5). Apart from GunBroker’s own branded or other promotional items, GunBroker itself does not sell products listed on GunBroker.com directly to consumers. (*Id.* ¶ 8). GunBroker does not take physical possession of the products sold by third parties on GunBroker.com. (*Id.* ¶ 9). Because GunBroker never has physical contact with products sold by third parties through GunBroker.com, it

¹ The following facts are drawn from the parties’ respective Statements of Material Facts. Citation to the relevant responsive statement without explanation or clarification indicates the Court has deemed the underlying statement admitted. For clarity and ease of reading, the Court omits quotation marks from admitted statements that are reproduced in this Order. Citations to the parties’ respective briefs are to the internal pagination, rather than the ECF header stamps, unless indicated otherwise.

has no way to physically inspect products. (*Id.* ¶ 10). GunBroker does not participate in negotiation of terms of sale or terms of delivery of products sold by third parties through GunBroker.com. (*Id.* ¶ 11). GunBroker does not receive, hold, or transfer legal ownership or title of products sold by third parties through GunBroker.com. (*Id.* ¶ 12).

Most listed items sold on GunBroker.com pass through Federal Firearms Licensees (“FFLs”), which carry out appropriate background checks. (*Id.* ¶ 13). The FFLs that carry out background checks relating to sales made through GunBroker.com are independent of GunBroker. (*Id.* ¶ 14). GunBroker derives revenue from a small percentage of the sales price of every transaction on GunBroker.com. (*Id.* ¶ 15).

GunBroker.com is one of the largest online marketplaces in the United States. (*Id.* ¶ 16). GunBroker.com is the #1 website in the United States in the Hunting and Shooting category by web traffic. (*Id.* ¶ 17). GunBroker brokered over \$1 billion in transactions involving its registered users within the first decade of its operation. (*Id.* ¶ 18). As of March 31, 2023, GunBroker had 7,732,548 registered users. (*Id.* ¶ 19). As of March 31, 2023, GunBroker.com hosted an average of 1,859,362 listings per day. (*Id.* ¶ 20). As of March 31, 2023, an average of 155,132 new listings were added daily to GunBroker.com. (*Id.* ¶ 21). As of March 31, 2023, GunBroker.com garnered an average of 5,355,166 unique visits per month. (*Id.* ¶

22). In the year ending November 30, 2024, GunBroker.com had 41 million active users. (*Id.* ¶ 23). As of December 2024, GunBroker has over 8.2 million registered users. (*Id.* ¶ 24). As of December 2024, GunBroker.com hosts an average of 3,299,852 listings per day. (*Id.* ¶ 25). As of December 2024, an average of 172,032 new listings are added daily to GunBroker.com. (*Id.* ¶ 26). As of December 2024, GunBroker.com garners an average of 4,716,362 unique visits per month. (*Id.* ¶ 27). GunBroker.com hosts both individual sellers and larger commercial vendors. (*Id.* ¶ 28). GunBroker.com hosts listings of products manufactured by thousands of manufacturers. (*Id.* ¶ 29).

As of January 2025, GunBroker had only 60 employees. (*Id.* ¶ 30). GunBroker employed 15 customer support staff as of December 2024. (*Id.* ¶ 31). To detect trademark infringements without specific notices from trademark owners, GunBroker would be required to monitor more than one million listings for potential trademark infringements. (*Id.* ¶ 32).

B. Microtech Knives, Inc. (“Microtech”)

Microtech is a manufacturer of knives. (*Id.* ¶ 33). Anthony Marfione is Microtech’s founder, owner, and president. (*Id.* ¶¶ 34–36). Microtech manufactures knives with an automatic opening function and knives that spring open at the push of a button. (*Id.* ¶¶ 37, 38). The retail prices of Microtech’s knives range from several hundred to several thousand dollars. (*Id.* ¶ 39). At least

fourteen models of Microtech models are at issue in this case (the “Models”), and Microtech sells each model under a different registered trademark (respectively, the “Marks”) (Doc. 1 ¶ 7).

The parties agreed at oral argument that the distinctions between the Models did not matter for the purpose of the pending motions, and all of the Models fall within the definition of a “switchblade knife” under 15 U.S.C. § 1241(b). (Transcript of May 22, 2025 Hrg., “Tr.” 8:24–9:3, 19:8–9, 16–17, Doc. 121; *see also generally* Doc. 97-2).²

C. Jon Janecek

Jon Janecek resides in Texas. (Doc. 11 ¶ 3). Microtech alleges in this case that Mr. Janecek advertises for sale on GunBroker.com clones³ of Microtech knives bearing at least fourteen of the Marks, which he denies. (Doc. 1 ¶ 7; Doc. 11 ¶ 7).

II. GunBroker’s Anti-Counterfeiting Policy and Other Preventative Measures

As noted above, users seeking to buy or sell items on GunBroker.com must register with GunBroker.com and agree to GunBroker’s Terms & Conditions before offering items for sale on the GunBroker.com site. (Doc. 103-1 ¶¶ 40–41).

² Counsel for Microtech did observe that some of the Models differ in structure and operation, which may impact differences in exemptions from the Federal Switchblade Act. (Tr. 19:15–20:8).

³ As the Court explains below, a “clone” is a replica of an existing knife.

GunBroker's User Agreement expressly prohibits users from selling products that infringe others' trademarks. (*Id.* ¶ 43). The User Agreement requires sellers on GunBroker.com to "represent and warrant . . . that: . . . [t]he sale of your Items on the Site, including the Content of your Listings, will not . . . involve the sale of counterfeit or stolen items." (*Id.* ¶ 44). The User Agreement requires sellers on GunBroker.com to "represent and warrant . . . that: . . . [y]our sale of any item and your listing or posting of text, graphics or any other content does not infringe on any intellectual property of any person or company and you have currently in your possession written authorization from any trademark or copyright holders or other rights holders that you have the legal right to make the sale or use that creative content." (*Id.* ¶ 45). The User Agreement includes an express anti-counterfeiting policy which prohibits counterfeiting. (*Id.* ¶ 46). The User Agreement provides that GunBroker may terminate listings identified as counterfeit. (*Id.* ¶ 47). Registered users provide the content for their product listings on GunBroker.com, including the title of the listing, the images associated with the listing, and the product description. (*Id.* ¶ 48).

Since January 2019, GunBroker has received only 13 complaints of counterfeiting in total from 11 different manufacturers (including Microtech). (*Id.* ¶ 51). Each complaint of counterfeiting received by GunBroker since January 2019 was addressed and resolved on a case-by-case basis. (*Id.* ¶ 52). The 10 trademark

owners *other* than Microtech who notified GunBroker of an alleged infringement identified the specific listings that they believed were being infringed – by URL, listing or item number, and/or Seller ID. (*Id.* ¶ 53). After receiving notice, GunBroker reviews specific listings flagged for infringement by manually searching text entered in listings. (*Id.* ¶ 54). If, after receiving notice, GunBroker determines from its manual review that product listings infringe a mark owner’s trademark, it terminates the listings. (*Id.* ¶ 55). GunBroker maintains no record of product manufacturers’ trademarks. (*Id.* ¶ 56). GunBroker lacks immediate knowledge of the intellectual property rights of the thousands of manufacturers whose products are listed on GunBroker.com. (*Id.* ¶ 57).

III. Microtech’s Intellectual Property Enforcement

Microtech alleges, and GunBroker does not dispute, that Defendant Janecek has sold 780 knives through GunBroker.com that are accused of infringing and counterfeiting Microtech’s asserted trademarks. (Doc. 107 ¶ 10).⁴ Microtech alleges that GunBroker has identified more than 1,000 listings on Gunbroker.com that advertised clones of Microtech’s knives bearing Microtech’s registered trademarks. (*Id.* at ¶ 113) (disputing statement of fact).⁵ Each accused listing on

⁴ This fact is not deemed admitted as to Mr. Janecek.

⁵ As Microtech is the non-movant as to GunBroker’s motion, the Court assumes this fact, and the other facts in this paragraph, are true for the purpose of this Order, because it does not prevent summary judgment as explained below.

GunBroker.com described the knife being sold as a clone of a Microtech knife. (Doc. 103 at 10). Each accused listing included photos of the cloned knife, product packaging, and/or manual bearing one or more of Microtech's asserted trademarks. (*Id.*). Each accused listing stated that the knife, product packaging, and/or manual would be delivered as shown in the photos. (*Id.*).

In 2018, Joseph Stutz, General Counsel for Microtech, sent a letter on behalf of Microtech to GunBroker.com ("2018 Letter"). (Doc. 103-1 ¶ 58). The 2018 Letter alleged that certain items offered for sale through GunBroker.com infringed Microtech's patents. (*Id.* ¶ 59). In the 2018 Letter, Mr. Stutz identified the specific product listings Microtech alleged were infringing its patents by providing the merchant's name, Item ID numbers, and the particular URLs for the listings. (*Id.* ¶ 60).

In June and July of 2023, when providing notice on behalf of his client Microtech, Microtech's attorney, Steve LeBlanc provided Facebook with specific URLs of allegedly infringing listings. (*Id.* ¶ 62). Mr. LeBlanc testified he did not believe the elements of a contributory infringement claim would be present against Facebook with respect to the listings flagged in 2023. (*Id.* ¶ 63).

Mr. LeBlanc discovered product listings on GunBroker.com in 2022 that Microtech believed infringed Microtech's trademarks. (*Id.* ¶ 64). As early as March 2022, Microtech discovered listings on GunBroker.com advertising and selling

knives described as “clones” of Microtech knives. (*Id.* ¶ 65). Mr. LeBlanc did not alert GunBroker of any allegedly infringing product listings until February 2023. (*Id.* ¶ 66). A “clone” is a replica of an existing knife. (*Id.* ¶ 67). As Mr. Marfione admitted, a clone does not necessarily infringe a trademark. (*Id.* ¶ 68). He testified that it is “very difficult” to tell from images alone whether a knife is authentic or a clone. (*Id.* ¶ 69). Informational materials put out by Microtech state, “[L]et’s establish the difference between a counterfeit and a clone A clone is a knife that is modeled after an authentic Microtech knife but does not claim to be a Microtech.” (*Id.* ¶ 71).

IV. Communications Between Microtech and GunBroker

A. The 2023 Letter

On February 15, 2023, Mr. LeBlanc sent a cease-and-desist letter (“2023 Letter”) on behalf of Microtech to GunBroker. (*Id.* ¶ 72). Mr. LeBlanc sent the 2023 Letter by email to GunBroker.com’s customer service mailbox at support@gunbroker.com. (*Id.* ¶ 73). Mr. LeBlanc also sent a copy of the 2023 Letter to GunBroker by regular U.S. mail addressed to “Outdoors Online, LLC, P.O. Box 2511, Kennesaw, GA 30156.” (*Id.* ¶ 74). The mailed copy of the 2023 Letter was not addressed to the attention of the legal department, to any particular individual, or to GunBroker’s registered agent. (*Id.* ¶ 75). The 2023 Letter stated that Mr. LeBlanc represented Microtech. (*Id.* ¶ 76). The 2023 Letter listed, by registration number,

17 of Microtech’s trademarks and alleged that these marks were being used “in conjunction with knives advertised on your website as clones.” (*Id.* ¶ 77). The 2023 Letter demanded takedowns of “every listing on [GunBroker.com] that advertises for sale a clone of any product bearing a registered Microtech trademark.” (*Id.* ¶ 78). The 2023 Letter did not include any identifying information for specific product listings, any merchant names related to accused product listings, any Item ID numbers related to accused product listings, or any URLs related to accused product listings. (*Id.* ¶¶ 79-82). Mr. LeBlanc acknowledged during his deposition with regard to the 2023 Letter that “there [was] nothing in this letter that [was] attempting to put GunBroker on notice of anything, other than they need to stop what they are doing and not do it anymore.” (*Id.* ¶ 83).

Mr. LeBlanc’s February 15 email attaching the 2023 Letter received an automated reply from the customer service mailbox: “Your request (1837596) has been received and is being reviewed by our support staff. To add additional comments, reply to this email.” (*Id.* ¶ 86). Mr. LeBlanc followed up on his February 15 email by replying to the customer service mailbox email on March 1, 2023. (*Id.* ¶ 87). Because Mr. LeBlanc’s February 15 and March 1 emails were sent to a generic customer-service inbox, his communications were not reviewed by a GunBroker employee until March 6, 2023. (*Id.* ¶ 88).

B. Elbein's March 9 Phone Call with LeBlanc

In March 2023, Brad Elbein was GunBroker's outside general counsel. (*Id.* ¶ 89). On March 9, 2023, Mr. Elbein called Mr. LeBlanc in response to the 2023 Letter. (*Id.* ¶ 90). During the March 9 call, Mr. Elbein introduced himself, stated he represented GunBroker, and apologized for not calling sooner. (*Id.* ¶ 91). During the March 9 call, Mr. Elbein approached Mr. LeBlanc's allegations collaboratively, offering to take appropriate steps on behalf of GunBroker should Mr. LeBlanc provide the necessary information regarding accused product listings. (*Id.* ¶ 92). During the March 9 call, Mr. Elbein asked Mr. LeBlanc to notify him of which particular listings Microtech was asserting as infringing. (*Id.* ¶ 93). During the March 9 call, Mr. LeBlanc agreed to furnish Mr. Elbein with details of all of the allegedly infringing product listings. (*Id.* ¶ 94). Mr. LeBlanc did not disclose specific accused listings to Mr. Elbein during the March 9 call. (*Id.* ¶ 95). Mr. LeBlanc did not make a demand for settlement or damages during the March 9 call. (*Id.* ¶¶ 96–97). Mr. LeBlanc testified that he does not recall “disclosing any specific users” during the March 9 call with Mr. Elbein. (*Id.* ¶ 98).

C. Elbein's Follow-up Emails with LeBlanc Memorializing the Phone Call

After the March 9 call, Mr. Elbein emailed LeBlanc, stating, “Good talking to you this evening. My contact information is below. If you could scan the examples and send them to my email address, it would be easiest.” (*Id.* ¶ 99). Mr.

Elbein’s reference to “examples” in his March 9 email to LeBlanc memorialized his request during the March 9 call for specific examples of allegedly infringing product listings. (*Id.* ¶ 100). Mr. LeBlanc responded to Mr. Elbein on March 10 stating, “Found it. I’m traveling for the next 3 hours, so let me know if you still want some examples, and I’ll send them this evening.” (*Id.* ¶ 101). Mr. LeBlanc’s reference in his March 10 email to “some examples” was to examples of allegedly infringing product listings. (*Id.* ¶ 102). Mr. Elbein responded to Mr. LeBlanc’s March 10 email the same day, copying Kevin Grierson and noting that Mr. LeBlanc “graciously granted us an extension of his deadline. He had other questions today when I called to tell him what GunBroker intended to do and by when.” (*Id.* ¶ 103). Kevin Grierson was a trademark attorney representing GunBroker in March 2023. (*Id.* ¶ 104).

D. GunBroker’s Immediate Takedown of All Microtech “Clone” Listings

By March 10, out of an abundance of caution, GunBroker had removed all product listings that appeared to fit the description offered by Mr. LeBlanc, including 21 listings using the terms “Microtech” and “clone” in the product description. (*Id.* ¶ 105). In March 2023, GunBroker sent takedown notices to the sellers with listings that used the terms “Microtech” and “clone” in the product description. (*Id.* ¶ 106).

Mr. Janecek admitted during his deposition that he received a takedown notice from Jay Zwitter at GunBroker on March 10, 2023. (*Id.* ¶ 107). He also admitted during his deposition that he did not list any Microtech “clones” after March 10, 2023. (*Id.* ¶ 108).

E. LeBlanc’s Final Communication before Filing Microtech’s Complaint

On March 13, Mr. LeBlanc emailed Mr. Elbein, stating, “It was nice speaking with you last week, and I appreciate your efforts to resolve this matter quickly. It looks like your client has removed almost all of the pages that were advertising clones of Microtech knives, so that is progress.” (*Id.* ¶ 109). In Mr. LeBlanc’s March 13 email, he did not point to any specific product listings or URLs that remained active and “were advertising clones of Microtech knives.” (*Id.* ¶ 110). In Mr. LeBlanc’s March 13 email, he stated, “I’ll provide Microtech’s settlement demand once I receive the seller and sales information described in my February 15 letter. In the meantime, please let me know if you need anything further to provide the requested information.” (*Id.* ¶ 111). After Mr. LeBlanc’s March 13 email, there were no further communications between Microtech and GunBroker before Microtech filed the instant lawsuit on March 22, 2023. (*Id.* ¶ 112).

Microtech filed the initial Complaint in this litigation on March 22, 2023. (*Id.* ¶ 113). GunBroker received no notice from Microtech of allegedly infringing product listings between the time of the takedowns on March 10, 2023, and the

filing of Microtech’s initial Complaint on March 22, 2023. (*Id.* ¶ 114). None of Microtech’s communications to GunBroker before the Complaint was filed included a specific product listing, a specific URL for a product listing, a specific Item ID for a product listing, or a merchant of a product listing. (*Id.* ¶¶ 115-118).

V. The Present Litigation

A. The Initial Complaint

On March 24, 2023, Mr. LeBlanc emailed Mr. Grierson a service copy of the Complaint. (*Id.* ¶ 121). The Complaint included only “illustrative listing[s]” of allegedly infringing product listings on GunBroker.com. (*Id.* ¶ 122). None of the product listings included in the Complaint were still active at the time Microtech filed the Complaint on March 22, 2023. (*Id.* ¶ 125). Microtech stated in its interrogatory responses that, “after being included as a Defendant in this action,” GunBroker removed all listings “described as ‘clones’ of Microtech’s knives.” (*Id.* ¶ 126).

Legal Standard

Federal Rule of Civil Procedure 56(a) provides “[t]he court shall grant summary judgment if the movant shows that there is no genuine dispute as to any material fact and the movant is entitled to judgment as a matter of law.” A factual dispute is genuine if the evidence would allow a reasonable jury to find for the nonmoving party. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). A fact is

“material” if it is “a legal element of the claim under the applicable substantive law which might affect the outcome of the case.” *Allen v. Tyson Foods, Inc.*, 121 F.3d 642, 646 (11th Cir. 1997).

The moving party bears the initial burden of showing the court, by reference to materials in the record, that there is no genuine dispute as to any material fact that should be decided at trial. *Hickson Corp. v. N. Crossarm Co.*, 357 F.3d 1256, 1260 (11th Cir. 2004) (citing *Celotex Corp. v. Catrett*, 477 U.S. 317, 323 (1986)). The moving party’s burden is discharged merely by “‘showing’ – that is, pointing out to the district court – that there is an absence of evidence to support [an essential element of] the nonmoving party’s case.” *Celotex*, 477 U.S. at 325. In determining whether the moving party has met this burden, the district court must view the evidence and all factual inferences in the light most favorable to the party opposing the motion. *Johnson v. Clifton*, 74 F.3d 1087, 1090 (11th Cir. 1996). Once the moving party has adequately supported its motion, the non-movant then has the burden of showing that summary judgment is improper by coming forward with specific facts showing a genuine dispute. *Matsushita Elec. Indus. Co. v. Zenith Radio Corp.*, 475 U.S. 574, 587 (1986). All reasonable doubts should be resolved in the favor of the non-movant. *Fitzpatrick v. City of Atlanta*, 2 F.3d 1112, 1115 (11th Cir. 1993). In addition, the court must “avoid weighing conflicting evidence or making credibility determinations.” *Stewart v. Booker T. Washington Ins.*, 232 F.3d 844, 848

(11th Cir. 2000). When the record as a whole could not lead a rational trier of fact to find for the nonmoving party, there is no genuine dispute for trial. *Fitzpatrick*, 2 F.3d at 1115 (citations omitted).

Discussion

Each Defendant seeks, in whole or part, summary judgment on Microtech's claims against it for vastly different reasons. Mr. Janecek argues that Microtech's trademark registrations are invalid, and Gunbroker argues Microtech has not submitted evidence that Gunbroker contributorily infringed Microtech's trademarks. The Court takes up each motion separately.

I. Janecek's Motion for Partial Summary Judgment

Mr. Janecek seeks cancellation of the Marks on the grounds of unlawful use, arguing that the Models at issue are manufactured and distributed in violation of the Federal Switchblade Act. In response, Microtech makes several arguments as to why Mr. Janecek waived his right to raise invalidity. However, because the Court finds that Mr. Janecek cannot prevail on the unlawful use doctrine, the Court need not reach those arguments and denies as moot Mr. Janecek's motion to amend to more clearly raise the defense.

A. Unlawful Use Doctrine

The Eleventh Circuit has not officially adopted the unlawful use doctrine, but it assumed it applied in *FN Herstal SA v. Clyde Armory Inc.*, 838 F.3d 1071, 1086–

87 (11th Cir. 2016). In that case, it explained that “[t]he ‘unlawful use doctrine’ appears almost exclusively in the administrative setting, originating in United States Trademark Trial and Appeal Board (‘TTAB’) proceedings to oppose trademark applications or cancel registrations.” *Id.* at 1086 (citing *In re Garden of Eatin’ Inc.*, 216 U.S.P.Q. 355, 357, 1982 WL 52032, at *2 (T.T.A.B. 1982)). *Id.* “Since the TTAB interprets the ‘use in commerce’ requirement to mean ‘lawful use,’” the court explained, “it has stated that ‘the sale or shipment of [a] product under [a] mark ha[s] to comply with all applicable laws and regulations’ before a party may claim trademark protection for that mark.” *Id.* at 1086–87 (citing *Clorox Co. v. Armour–Dial, Inc.*, 214 U.S.P.Q. 850, 851, 1982 WL 50434, at *1 (T.T.A.B. 1982) and quoting *In re Pepcom Indus., Inc.*, 192 U.S.P.Q. 400, 401, 1976 WL 21138, at *1 (T.T.A.B. 1976)).

Assuming the doctrine applies outside of the TTAB context, to assert a defense based on the doctrine, the defendant must show the following by clear and convincing evidence: (a) a per se violation by the trademark holder of a statute regulating the sale of goods at issue, (b) a nexus between the use of the mark and the violation, and (c) materiality. *VPR Brands, LP v. Shenzhen Weiboli Tech. Co.*, No. 23-1544, 2024 WL 3811774, at *4 (Fed. Cir. Aug. 14, 2024) (quoting *FN Herstal SA*, 838 F.3d at 1087)). The first element, a violation of the statute, may be established by showing a “court or agency with competent jurisdiction has previously found

a violation. *Id.* (quoting *FN Herstal SA*, 838 F.3d at 1087)). “To be material” as required by the third element, “the violation must be of ‘such gravity and significance that the usage must be considered unlawful’” *Id.* (quoting *FN Herstal SA*, 838 F.3d at 1087)).

B. Federal Switchblade Act

Under the Federal Switchblade Act (the “Act”), “[w]hoever knowingly introduces, or manufactures for introduction, into interstate commerce, or transports or distributes in interstate commerce, any switchblade knife, shall be fined not more than \$2,000 or imprisoned not more than five years, or both.” 15 U.S.C. § 1242. “The term ‘switchblade knife’ means any knife having a blade which opens automatically--”

(1) by hand pressure applied to a button or other device in the handle of the knife, or

(2) by operation of inertia, gravity, or both.

15 U.S.C. § 1241(b). The Act contains exceptions, however, and two are relevant here. The prohibition does not apply to:

(2) the manufacture, sale, transportation, distribution, possession, or introduction into interstate commerce, of switchblade knives pursuant to contract with the Armed Forces;

. . . [or]

(5) a knife that contains a spring, detent, or other mechanism designed to create a bias toward closure of the blade and that requires exertion applied to the blade

by hand, wrist, or arm to overcome the bias toward closure to assist in opening the knife.

15 U.S.C. § 1244.

C. Application to Facts

The first element of the unlawful use doctrine is a per se violation of the statute. There is no dispute that the Models are switchblades as defined by the Act. The only issue is whether a fact dispute exists as to the exceptions to the Act. But unpacking that question requires untangling a knot of burden-of-proof issues.

By default, an exception to a penal statute is an affirmative defense on which the accused has the burden of proof by a preponderance of evidence. *Dixon v. United States*, 548 U.S. 1, 8 (2006) (“[A]t common law, the burden of proving ‘affirmative defenses—indeed, ‘all . . . circumstances of justification, excuse or alleviation’—rested on the defendant.”) (quoting *Patterson v. New York*, 432 U.S. 197, 202 (1977)). But with the unlawful use defense, the accused infringer has the burden of showing unlawful use by clear and convincing evidence, as explained above. And of course, at trial, the party bringing the infringement claim has the ultimate burden of proof by a preponderance of the evidence. So, where the accused infringer seeks summary judgment on an unlawful use defense, who bears the burdens of presentation and persuasion on whether there is a genuine fact dispute as to an exception to an alleged unlawful use?

The Court thinks it is the accused infringer, because the test requires showing a *per se* unlawful use. *VPR Brands*, 2024 WL 3811774, at *4 (quoting *FN Herstal SA*, 838 F.3d at 1087)). The Court finds TTAB authority on point to be helpful. *The Clorox Co. v. Armour-Dial, Inc.*, 214 U.S.P.Q. 850, 1982 WL 50434 (T.T.A.B. June 29, 1982).

In Clorox, Armour-Dial, Inc. (“Armour”) company sought to register the trademark ‘ALIVE’ for ‘toilet soap.’” *Id.* at *1. The Clorox Co. (“Clorox”) opposed the application on the ground that it already had an identical mark for bathsoap and shampoo. *Id.* Armour argued that Clorox’s prior use was unlawful because “in its failure to label ingredients, [Clorox] allegedly violated the provisions of Section 301 of the Federal Food, Drug and Cosmetic Act and implementing regulations.” *Id.* (citations omitted) In response, Clorox claimed that “the Food, Drug and Cosmetic Act specifically excludes ‘soap’ from the ingredient labeling requirements of the Act applicable to cosmetics” and claimed that “its ‘bathsoap and shampoo’ product qualifie[d] as ‘soap’ under the applicable regulations.” *Id.*

The TTAB noted that the record was “devoid” of evidence as to whether Clorox’s product met the definition of soap under the regulations. *Id.* at *2. “Nevertheless,” the board explained “the burden was on [Armour] to come forward with evidence as to noncompliance with the definition and this it failed to do.” *Id.* (“Manifestly, the proofs submitted by the party charging

noncompliance must leave no room for doubt, speculation, surmise, or interpretation.”) (quoting *Satinine Societa in Nome Collettivo di S.A. e M. Usellini v. P.A.B. Produits et Appareils de Beaute*, 209 USPQ 958, 965, 1981 WL 48126 (TTAB 1981)). The board explained that “the party defendant [here, Armour] alleging opposer’s [here, Clorox] unlawful use must bear the burden of proof on its affirmative defense.” The board found that Armour “failed to take discovery or offer any evidence that opposer’s product was not a “soap” by composition and detergent quality, and thus has failed to meet that burden.” *Id.*

Likewise, the record indicates that Mr. Janecek has conducted little or no discovery on the application of the Federal Switchblade Act’s exceptions and has identified no witnesses who can testify to that point. (Doc. 97-2 ¶ 79).⁶ Indeed, it appears from Microtech’s Response to Mr. Janecek’s Motion for Summary Judgment that Microtech has marshaled substantial evidence as to its compliance with the exceptions to the Act, despite the Court’s holding that it does not bear the

⁶ Mr. Janecek objected to this statement of fact “because his disclosures cited do not support Microtech’s fact,” arguing that “[i]n his identification of witnesses, Janecek identified witnesses that may have information regarding the goods associated with the trademarks-at-issue.” But he does not explain in his objection which witness would testify to which aspect of the exceptions to the Act.

burden on this issue. (Doc. 95 at 11–14). At a minimum, Mr. Janeczek fails to show an absence of factual disputes on this issue and his motion is denied.⁷

II. GunBroker’s Motion for Summary Judgment

After the Court’s April 5, 2024 Order, Microtech’s sole remaining claim against GunBroker is for contributory infringement. (*See* Doc. 68). In passing on that claim previously, the Court expressed doubts, noting that

[t]he Court finds that Microtech has not alleged sufficient facts to support a plausible inference that Outdoors Online [a/k/a GunBroker] intentionally induced anyone to commit direct infringement, had actual knowledge of direct infringement, or had constructive knowledge of direct infringement.

(*Id.* at 10). The Court provided leave to amend, but in so doing put Microtech on notice about the deficiencies in its case against GunBroker. Unfortunately, discovery has not improved Microtech’s case much. As the Court explains below, Microtech fails to create a genuine issue of fact on its claims against GunBroker and summary judgment is appropriate.

A. Contributory Infringement

As the Court explained in its earlier Order, “liability for trademark infringement can extend beyond those entities that actually perform the acts of

⁷ The Court therefore does not need to reach Microtech’s Second Amendment argument. *See* Fed. R. Civ. P. 5.1(c) (providing the Court may reject a constitutional challenge to a federal statute before giving the United States an opportunity to intervene).

infringement.” *Mini Maid Servs. Co. v. Maid Brigade Sys., Inc.*, 967 F.2d 1516, 1522 (11th Cir. 1992) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844, 853 (1982)). Under the Lanham Act, the owner of a registered trademark may hold someone contributorily liable for trademark infringement if that person induces or knowingly facilitates the infringement. *Luxottica Grp., S.p.A. v. Airport Mini Mall, LLC*, 932 F.3d 1303, 1311 (11th Cir. 2019)).

To prevail on a claim for contributory infringement, the plaintiff must establish: “(1) a person or entity commits direct trademark infringement under the Lanham Act; and (2) the defendant (a) ‘intentionally induces’ the direct infringer to commit infringement, (b) supplies a ‘product’ to the direct infringer whom it ‘knows’ is directly infringing (actual knowledge), or (c) supplies ‘a product’ to the direct infringer whom it ‘has reason to know’ is directly infringing (constructive knowledge).” *Id.* at 1312. Willful blindness occurs when a person suspects wrongdoing and deliberately fails to investigate and is a form of constructive knowledge for contributory trademark infringement. *Id.* at 1313.

B. Application to Facts

Microtech argues the 1,000 listings on GunBroker that advertised clones of Microtech knives together with evidence of “photos of the cloned knives, product packaging, and/or manuals bearing one or more of Microtech’s asserted trademarks” is evidence that “serious and widespread” infringement occurred

(Doc. 103 at 11–12), which it contends is sufficient to raise a fact dispute about actual or constructive knowledge. *Mini Maid Servs. Co. v. Maid Brigade Sys., Inc.*, 967 F.2d 1516, 1522 (11th Cir. 1992).

In contrast, GunBroker urges the Court to follow the Second Circuit’s decision in *Tiffany (NJ) Inc. v. eBay Inc.*, 600 F.3d 93, 106 (2d Cir. 2010) to reject Microtech’s claims. GunBroker points to two aspects of that ruling it argues should control here. First, it argues that it should not be contributorily liable for listings which were promptly taken down after Microtech provided notice. It points to a passage in *Tiffany* that approved a practice whereby an online sales platform acted “promptly to remove the challenged listing from its website, warn[ed] sellers and buyers, cancel[ed] fees it earned from that listing, and direct[ed] buyers not to consummate the sale of the disputed item.” *Id.* GunBroker argues that it, too, promptly removed the listings that Microtech brought to its attention and should therefore not be liable for those listings.

Second, it argues Microtech cannot establish actual knowledge of infringing listings by pointing to evidence tending to show a “general knowledge” of infringement. In *Tiffany*, the trademark holder argued that the online sales platform “knew, or at least had reason to know, that counterfeit . . . goods were being sold ubiquitously on its website,” pointing to demand letters the trademark holder sent, survey results it had conducted, “thousands” of notices of claimed

infringement it filed, and various buyer complaints about having purchased counterfeit items. *Id.* But the Second Circuit affirmed judgment against the trademark holder, writing: “For contributory trademark infringement liability to lie, a service provider must have more than a general knowledge or reason to know that its service is being used to sell counterfeit goods. Some contemporary knowledge of which particular listings are infringing or will infringe in the future is necessary.” *Id.* at 107.

The Eleventh Circuit was urged to adopt *Tiffany* in *Luxottica*. 932 F.3d at 1313–14. The court framed the issue in that case as follows: “[W]hether the knowledge theory of contributory liability requires the plaintiff to prove that the defendant had actual or constructive knowledge of specific infringing acts[?]” *Id.* at 1313. The court did not answer the question, however, because the evidence of constructive knowledge was sufficient to establish the aforementioned “serious and widespread” violations sufficient to affirm the verdict. *Id.* at 1313–14. Specifically, that case involved a brick-and-mortar mall that had seen “raids, arrests, and seizures,” meetings with the police department, and “the defendants’ ability to visually inspect the approximately 130 booths.” *Id.* at 1315.

This fact here are miles away from *Luxottica*, and far closer to *Tiffany*. All agree that GunBroker operates one of the largest online marketplaces in the United States. (Doc. 103-1 ¶ 16). To detect trademark infringements without specific

notices from trademark owners, GunBroker would be required to monitor more than one million listings for potential trademark infringements. (*Id.* ¶ 32). This is complicated by the fact that GunBroker only lists the items for sale by third parties, it never has physical contact with products sold by them and it has no way to physically inspect products. (*Id.* ¶ 10). As of January 2025, GunBroker had only 60 employees. (*Id.* ¶ 30). GunBroker employs 15 customer support staff as of December 2024. (*Id.* ¶ 31).⁸ Indeed, GunBroker has addressed every complaint of counterfeiting it received since January 2019 on a case-by-case basis and has terminated listings that infringed a trademark after manual review. (*Id.* ¶¶ 52, 55). The Court agrees with GunBroker that under the specific facts of the case here, imposing contributory liability on GunBroker would “shift the burden of policing trademark rights from the entities that own IP rights to online marketplaces that merely facilitate transactions.” (Doc. 98-1) (citing *Tiffany (NJ) Inc. v. eBay, Inc.*, 576 F. Supp. 2d 463, 527 (S.D.N.Y. 2008), *aff’d* 600 F.3d at 93). Aside from GunBroker’s efforts to comply with trademark law in response to Microtech’s notifications, Microtech’s sole evidentiary basis for actual or constructive knowledge is alleged serious and widespread infringement, but for the reasons already given, this does

⁸ There is no evidence that GunBroker has kept an artificially small staff as a form of willful blindness. *Luxottica*, 932 F.3d at 1313.

not constitute constructive knowledge. Summary judgment is therefore warranted.

Conclusion

For the foregoing reasons, it is

ORDERED that Defendant Jon Janecek's Motion for Partial Summary Judgment (Doc. 82) is **DENIED**. It is

FURTHER ORDERED that Defendant Janecek's Motion for Leave to File Amended Answer (Doc. 89) is **DENIED AS MOOT**. It is

FURTHER ORDERED that Defendant Outdoors Online LLC's Motion for Summary Judgment (Doc. 98) is **GRANTED**. Final judgment in favor of Defendant Outdoors Online LLC will be entered upon resolution of Plaintiff's claims against Mr. Janecek. It is

FURTHER ORDERED that Plaintiff and Defendant Janecek are **DIRECTED** to file a consolidated pretrial order within 30 days after the date of entry of this Order. If they intend to mediate the dispute first, they may obtain a stay of this deadline by contacting the Court's Courtroom Deputy Clerk.

SO ORDERED this 25th day of September, 2025.



Victoria Marie Calvert
United States District Judge