

Counterfeits, Knockoffs and Knockdowns: Controlling your Company and Product Image on E-commerce Platforms

The Cold E-commerce War Games

Robert P. Ziemian, Denver, CO

Haynes and Boone LLP

Robert.Ziemian@haynesboone.com

UT LAW/CLE 33rd Annual Technology Law
Conference

Live Webcast – 2:55p.m., Friday, May 22, 2020

haynesboone

© 2020 Haynes and Boone, LLP

The Problem – The WOPR

- Over a decade ago brick and mortar commerce were still prevalent.
 - Brands and product creators would physically police stores.
 - Especially effective with major chains
 - A finite problem?
 - Path to market a product required overhead and infrastructure
 - Typically a highly centralized, supply chain dependent distribution system
 - Typically a single source for a knockoff/counterfeit
- Enter Online retailers
 - Distribution through online retailers
 - Amazon, eBay, Wish, Alibaba, etc.
 - Little overhead to start selling
 - Innumerable listings
 - Instant creation and propagation
 - A infinite problem?

haynesboone

© 2020 Haynes and Boone, LLP

Comprehensive Counterfeit and Knockoff Wargames

- Individual takedown requests
 - On various platforms
 - eBay
 - Amazon
 - Alibaba
 - Wish
 - For various types of IP
 - Copyright
 - DMCA
 - Trademark/trade dress
 - Patent/design patent
 - Contrast success using various types

haynesboone

© 2020 Haynes and Boone, LLP

3

Comprehensive Counterfeit and Knockoff Wargames

- CBP
 - Registering trademarks
 - Registering copyrights
 - Working with CBP
 - John doe and other suits to pursue infringers
- Neutral Patent Evaluation program on Amazon
 - The process
 - Pitfalls
 - Strategy

haynesboone

© 2020 Haynes and Boone, LLP

4

Comprehensive Counterfeit and Knockoff Wargames

- District Court Cases
- ITC actions
- Foreign Actions
- Crafting portfolios specifically for use fighting online knockoffs and counterfeits
- Enhancing client ability to monitor for counterfeits and knockoffs

haynesboone

© 2020 Haynes and Boone, LLP

5

DEFCON 5 – Takedown requests - Amazon

- Amazon Brand Registry – Must
 - Registered trademark
 - Proprietary text and image search
 - Predictive automation based on your reports of suspected intellectual property rights violations
 - Increased authority over product listings with your brand name
- Select complaint category
 - Copyright
 - Registered
 - Trademark
 - Registration
 - Patent
 - Design
 - Utility – do you have a court order
 - Other

haynesboone

© 2020 Haynes and Boone, LLP

6

Find the full text of this and thousands of other resources from leading experts in dozens of legal practice areas in the [UT Law CLE eLibrary \(utcle.org/elibrary\)](https://utcle.org/elibrary)

Title search: Counterfeits, Knockoffs, and Knockdowns: Controlling your Company and Product Image on E-commerce Platforms

Also available as part of the eCourse

[2020 Technology Law eConference](#)

First appeared as part of the conference materials for the
33rd Annual Technology Law Conference session

"Counterfeits, Knockoffs, and Knockdowns: Controlling your Company and Product Image on E-commerce Platforms"