

# 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 33<sup>rd</sup> 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  
33<sup>rd</sup> Annual Technology Law Conference session

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