



FROM BRAND PROTECTION TO IPR PROTECTION:
TACKLING ONLINE COUNTERFEITS IN THE FASHION
INDUSTRY THROUGH THE ENFORCEMENT OF THE
WHOLE IP PORTFOLIO”

ING. MICHELE PROVERA – CONVEY S.R.L.

MILAN – 22ND NOVEMBER 2016

WHO IS CONVEY?



Innovative services and solutions for **Intellectual Property protection and enforcement** in Internet:

- ✓ Online Anti-Piracy and Anti-Counterfeiting services in the sectors of Fashion, Luxury Watches, Jewelry, Classic Shoes, **Sportswear and Athletic Apparel, Bicycles, Football Jerseys/Apparel**, Automotive, Sunglasses, Food and Beverages, Pharma – on all the Internet different environments, including:
 - **Web 1.0** -> Generic Websites and Domain Names
 - **Web 2.0** -> Social Media, Video/Image Sharing, Social Networks
 - **Mobile Applications and Instant Messaging Portals**
 - **Online Marketplace and Auction Sites**
- ✓ Internet Brand Compliance services for distribution channels control and licensee/distributors management
- ✓ TM Clearing House accredited Agent for new generic Top Level Domains protection



WHAT IS HAPPENING TO FASHION BRANDS ONLINE

- **THE INTERNET PROVIDED ABUSERS/COUNTERFEITERS WITH THE IDEAL PLATFORM TO EXPLOIT AND DAMAGE FAMOUS BRANDS, NAMELY**
 - A. counterfeit offerings on major E-Commerce platforms and online marketplaces;
 - B. the creation of counterfeit online shops with/without Trademark (TM) abuses in the Domain Names;
 - C. the highjacking of Websites with TM abuses and traffic diversion with pay per click revenue generating models;
 - D. videos/Advertisements/Links to counterfeit shops on the major social media networks such as Facebook, Twitter, YouTube, Pinterest, etc.;

THE RELEASE OF THE NEW GENERIC TOP LEVEL DOMAINS (.SHOP; .LUXURY; .STORE; .CHEAP; .SITE; ETC...) IS BOOSTING 100X COUNTERFEITERS' ILLEGITIMATE BUSINESS

LIMITS OF A 'TRADITIONAL' APPROACH

Method:

The IPR Owner targets the digital counterfeiter/abuser through:

1. Sending of Cease&Desist letters, or
2. Starting a court proceeding

Results:

FAILURE FREQUENTLY GUARANTEED

Reasons:

- ✓ Counterfeiters conceal their identity and have hundreds of alter-egos
- ✓ C&D are too weak – It's scrap paper in the eye of a counterfeiter
- ✓ Lawsuits are too slow and expensive
- ✓ Internet is ever-changing – contents appear/disappear/change in minutes

THE NEW PARADIGM OF ONLINE COUNTERFEITING

Method:

The IPR Owner forgets the counterfeiter and targets the 'PROXY' through a 'TAKE DOWN NOTICE'

What does 'PROXY' mean in this context?

1. The **Internet Service Provider (ISP)** i.e. Godaddy, Tucows, Marcaria, etc...
2. The **Hosting Provider**, i.e. 1and1., Hetzner, etc...
3. The **Marketplace**, i.e. eBay, Amazon, Alibaba, Taobao, Dhgate, Rakuten, etc...
4. The **Social Network**, i.e. Facebook, Twitter, Instagram, etc...

Results: GREAT CHANCES OF SUCCESS

Reasons: IF THE PROXY, UPON THE IP HOLDER'S REQUEST, DOES NOT INTERVENE EXPEDITOUSLY TO STOP ITS CUSTOMER FROM INFRINGING MY RIGHTS, IT BECOMES LIABLE AND I CAN TAKE IT TO COURT

JURIDICAL GROUNDS

[EUROPE] Directive 2000/31/EC on eCommerce

[...] the service provider is not liable for the information stored[...] on condition that:

(a) the provider does not have actual knowledge of illegal activity or information [...]; or

(b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.

[US] 17 U.S. Code § 512

A service provider shall not be liable for monetary relief for infringement of copyright by reason of the storage at the direction of a user [...] if the service provider

(i) does not have actual knowledge [...] of the infringement;

(ii) [...] is not aware of facts or circumstances from which infringing activity is apparent; or

(iii) upon obtaining such knowledge or awareness, acts expeditiously to remove, or disable access to, the material.

[CHINA] Art. 36 Chinese Tort Law 侵权行为

A network service provider who infringes upon the civil right or interest shall assume the tort liability.

Where a network user commits a tort through the network services, the victim of the tort shall be entitled to notify the network service provider to take such necessary measures as deletion, block or

disconnection. If, after being notified, the network service provider fails to take necessary measures in a

timely manner, it shall be jointly and severally liable for any additional harm with the network user.

1ST ISSUE – FIND THE PROPER WAY TO OPERATE WITH EACH PROVIDER

- A. THERE ARE **HUNDREDS OF DIFFERENT PROVIDERS**, EACH WITH ITS OWN WAY TO ACCEPT AND HANDLE THE ‘NOTICE & TAKEDOWN’ REQUESTS - **WHAT WORKS WITH ONE ISP, FAILS WITH ANOTHER**
- B. PROVIDERS ARE COUNTRY BASED: MANY REQUIRE **LOCAL LANGUAGE SKILLS**
- C. MAJOR PROVIDERS HAVE COMPLEX IP PROTECTION SYSTEMS, REQUIRING:
- **ACCREDITATION PROCEDURES OF THE COMPANY**
 - **ACCREDITATION PROCEDURES OF IP RIGHTS**
 - **OTHER PRE-REQUISITES (EXTENSION OF THE IP RIGHTS, % OF SUCCESS RATES, ETC...)**



2ND ISSUE – COMBATING HUNDRED THOUSANDS CASES

NO MATTER THE INDUSTRY - RENOWNED BRANDS ARE WIDELY EXPOSED TO INTERNET ABUSES AND COUNTERFEITS, WITH:

- HUNDREDS OF THOUSANDS OF ROGUE WEBSITES;
- THOUSANDS OF ABUSED DOMAIN NAMES;
- TENS OF THOUSANDS OF COUNTERFEIT OFFERINGS ON THE ONLINE MARKETPLACES;
- THOUSANDS OF ABUSIVE POSTS/IMAGES/VIDEOS/GROUPS ON THE SOCIAL NETWORKS;

HOW TO DEAL WITH SUCH A VOLUME OF ISSUES?

HOW TO MONITOR THE WHOLE INTERNET AND DETECT THE EXISTING ABUSES?

WHAT ARE THE TARGETS?

HOW TO PREVENT FUTURE CASES?

116.295
overall
results for
«ARMANI»

The screenshot shows a search results page for 'ARMANI' on an online marketplace. The search bar at the top displays '116.295' results. The page lists various items, including Armani jeans and shirts. A red box highlights a specific listing for '3件免運 美國大牌 Calvin Klein 高品質 Armani 阿曼尼 男款 CK 夏' (3 free shipping, American brand Calvin Klein high quality Armani Armani men's CK summer). The listing shows a direct purchase price of 600元, 632 items sold, and a lowest shipping fee of 150元. The seller is identified as 'xbsw9655(1253)'. The listing also includes a '加入追蹤' (Add to watchlist) button.

One single fake offering

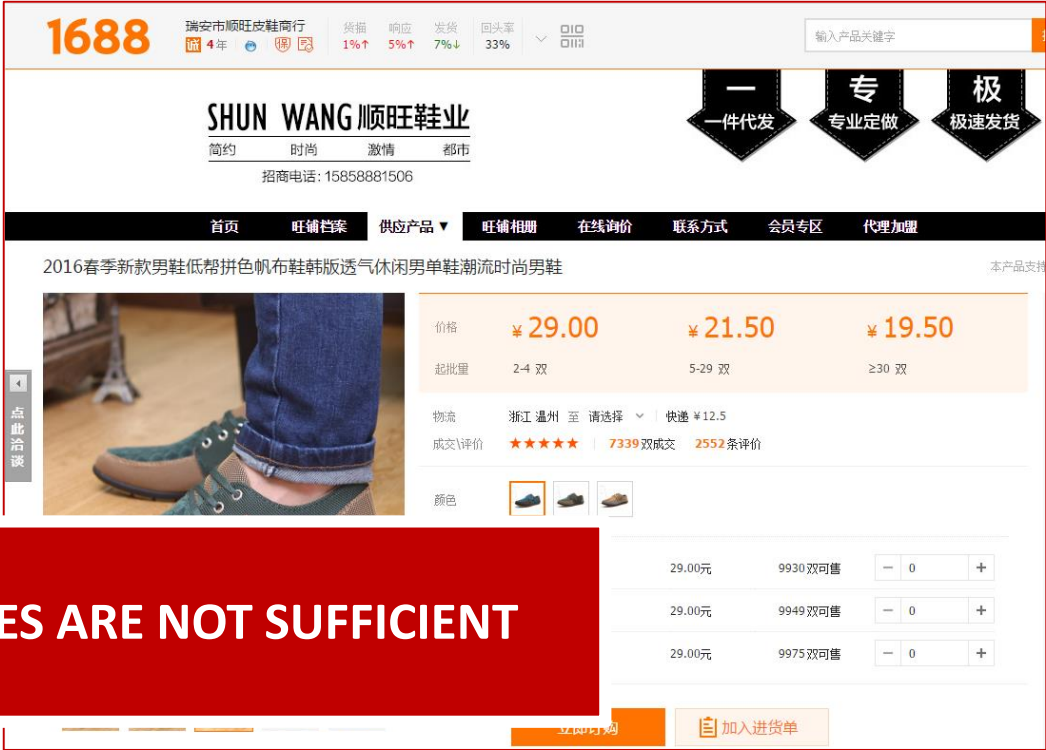
- Price: 17,63 EUR
- Items sold: 632
- Counterfeit turnover €: 11.142,16

3RD ISSUE – COUNTERFEITERS ARE SMART...

TRADITIONAL MONITORING IS TEXT BASED



Counterfeiters are getting smarter and raise the bar against enforcement activities by REMOVING EVERY CITATION OF THE BRAND/COMPANY IN THE TITLE/TEXT OF THE OFFERINGS



TEXTUAL QUERIES ARE NOT SUFFICIENT

4TH ISSUE – TRADEMARKS ARE NOT ENOUGH...

TRADEMARKS ARE THE MOST IMMEDIATE WEAPON TO TACKLE COUNTERFEITS, BUT...

COUNTERFEITERS ARE INFRINGING UPON ALL YOUR IP RIGHTS, INCLUDING

- TECHNOLOGY PATENTS
- DESIGN RIGHTS
- COPYRIGHTS

... AND THEY ARE SMART ENOUGH TO ADAPT THE CONTENTS OF THEIR OFFERINGS TO AVOID ENFORCEMENT. SEE BELOW...

A FAKE belt (the TM is visible)

ENFORCEMENT ON THE GROUND OF A TM

Same FAKE belt (TMs disappeared)
AND NOW???



ONE WEEK
LATER...



CONVEY'S APPROACH

**INTERNET
INTELLIGENCE**

**EX ANTE DETECTION AND ANALYSIS OF THE EXISTING ONLINE THREATS
AND SYSTEMATIC SURVEILLANCE OF FUTURE ABUSES**



**BUSINESS
INTELLIGENCE**

**IDENTIFICATION OF THE INVOLVED PROVIDERS AND
DEFINITION OF THE OPTIMAL ENFORCEMENT STRATEGY**



**PROFOUND IP
EXPERTISE**

**EXPLOITATION OF THE WHOLE INTELLECTUAL PROPERTY
RIGHTS PORTFOLIOS**



**TACKLING INTERNET COUNTERFEITS
EFFICIENTLY**

APPLICATION OF THIS APPROACH ON ONLINE MARKETPLACES

THE MAIN SOURCE OF COUNTERFEITS



FAKES ON WESTERN
MKTPLACES ARE JUST THE
TIP OF THE ICEBERG



CHINESE/ASIAN E-COMMERCE PLATFORMS ARE THE
MAIN SOURCE OF COUNTERFEITS



1ST PHASE – SET UP OF RELEVANT COMPLAINT PROCEDURES

REQUIREMENTS FOR THE 'NOTICE & TAKEDOWN' REQUESTS:

PRELIMINARY ACCREDITATION OF THE IP OWNERS AND THE IP RIGHTS ON THE VARIOUS IPR PROTECTION PLATFORMS

The screenshot displays the '我的IPR' (My IPR) user interface. The top navigation bar includes the title '我的IPR', a welcome message '欢迎您, CONVEY S.R.L.', and links for '我的IPR', '退出', and '中文'. The left sidebar contains a menu with categories: '基本信息' (Basic Information), '我的知识产权' (My Intellectual Property), '侵权投诉' (Infringement Complaint), and '合作互动' (Cooperation Interaction). The main content area is titled '注册信息' (Registration Information) and contains the following fields:

- 登录邮箱** (Login Email): [Redacted]@convey.it (用于登录, 注册后不可修改)
- 用户名称** (User Name): CONVEY S.R.L. ✓
- 身份证明** (Identity Proof): [查看附件](#)
- 地区** (Region): 非中国大陆 (Dropdown menu)
- 地址** (Address): [Redacted]

A blue '提交' (Submit) button is located at the bottom of the registration form.

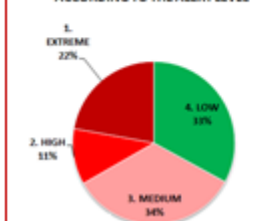
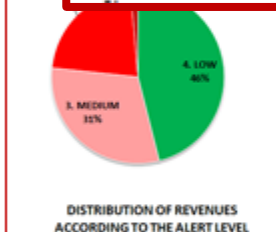
2ND PHASE – ANALYSIS OF ALL LISTINGS AND DETECTION OF ABUSIVE URLs

PLATFORM	NUMBER OF LISTINGS
TAOBAO	35.832
EVERYCHINA	2.534
RUTEN	2.531
CHINA ALIBABA	2.194
TMALL	1.662
ALIBABA	1.531
PAIPAI	235
IOFFER	181

ANALYSIS OF:

1. SELLERS
2. PRODUCTS
3. MODELS
4. PRICES
5. PRODUCT CATEGORIES
6. AVAILABILITY
7. MIN. PURCHASE
8. ITEMS SOLD

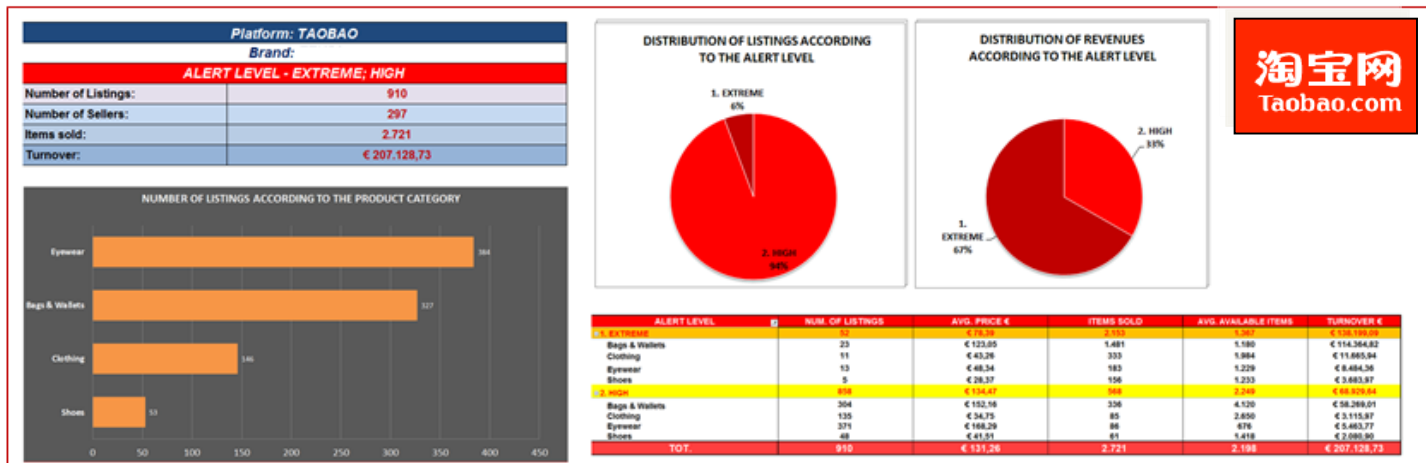
ALERT LEVEL	NUM. OF LISTINGS	AVG. PRICE €	ITEMS SOLD	AVG. AVAILABLE ITEMS	TURNOVER €
1. EXTREME	52	€ 78,30	2.153	1.367	€ 138.199,09
Bags & Wallets	23	€ 123,05	1.481	1.180	€ 114.364,82
Clothing	11	€ 43,26	333	1.984	€ 11.665,94
Eyewear	13	€ 48,34	183	1.229	€ 8.484,36
Shoes	5	€ 28,37	156	1.233	€ 3.683,97
2. HIGH	858	€ 134,47	568	2.249	€ 68.929,64
Bags & Wallets	304	€ 152,16	336	4.120	€ 58.269,01
Clothing	135	€ 34,75	85	2.650	€ 3.115,97
Eyewear	371	€ 168,29	86	676	€ 5.463,77



ALERT LEVEL	NUM. OF LISTINGS	AVG. PRICE €	ITEMS SOLD	AVG. AVAILABLE ITEMS	TURNOVER €
1. EXTREME	52	€ 78,30	2.153	1.367	€ 138.199,09
Bags & Wallets	23	€ 123,05	1.481	1.180	€ 114.364,82
Clothing	11	€ 43,26	333	1.984	€ 11.665,94
Eyewear	13	€ 48,34	183	1.229	€ 8.484,36
Shoes	5	€ 28,37	156	1.233	€ 3.683,97
2. HIGH	858	€ 134,47	568	2.249	€ 68.929,64
Bags & Wallets	304	€ 152,16	336	4.120	€ 58.269,01
Clothing	135	€ 34,75	85	2.650	€ 3.115,97
Eyewear	371	€ 168,29	86	676	€ 5.463,77
Shoes	48	€ 41,51	61	1.418	€ 2.080,90
3. MEDIUM	1.195	€ 448,02	580	69	€ 210.469,00
Bags & Wallets	299	€ 1.073,40	517	209	€ 195.791,88
Clothing	34	€ 310,27	29	78	€ 6.635,63
Eyewear	832	€ 229,58	26	18	€ 6.147,43
Shoes	30	€ 429,18	8	88	€ 1.894,06
4. LOW	1.795	€ 1.336,48	256	8	€ 205.132,49
Bags & Wallets	1.396	€ 1.613,62	196	7	€ 181.581,69
Clothing	72	€ 395,55	30	10	€ 11.961,09
Eyewear	259	€ 334,53	10	11	€ 3.260,82
Shoes	68	€ 458,91	20	12	€ 8.328,89
TOT.	3.900	€ 783,02	3.557	538	€ 622.730,22

3RD PHASE – PRIORITIZING TARGETS AND OUTLINING OF A CUSTOM MADE ENFORCEMENT STRATEGY

IN-DEPTH ANALYSIS OF EACH MARKETPLACE



PLATFORM	NUM. OF SELLERS
TAOBAO	297
TMALL	0
TOT.	297

DETECTION OF SELLERS AND ASSESSMENT OF PRIORITIES ON THE BASIS OF DANGER LEVELS

Seller	Seller url	N. of Listings	Items sold	Avg. Price EUR	Avg. Available items	Turnover
446. xiehuapan	http://store.taobao.com/shop/view_shop.htm?user_number_id=68924775	8	409	€ 93,63	2.211	€ 38.895,71
800. 万美奢品	http://store.taobao.com/shop/view_shop.htm?user_number_id=1679509736	4	117	€ 311,03	335	€ 36.433,54
703. 小雪儿399	http://store.taobao.com/shop/view_shop.htm?user_number_id=2303992536	2	83	€ 253,83	280	€ 21.434,84
676. 匿名_好友	http://store.taobao.com/shop/view_shop.htm?user_number_id=676877899	11	62	€ 267,93	216	€ 13.514,93
624. 代购专柜奢侈品	http://store.taobao.com/shop/view_shop.htm?user_number_id=1885096185	5	69	€ 319,46	7.383	€ 12.462,45
737. 想要吃肉	http://store.taobao.com/shop/view_shop.htm?user_number_id=1132783091	2	71	€ 149,44	11.021	€ 10.616,32
632. 大白813	http://store.taobao.com/shop/view_shop.htm?user_number_id=199242419	1	731	€ 14,16	383	€ 10.348,77
383. tb4782820_2012	http://store.taobao.com/shop/view_shop.htm?user_number_id=2461748137	3	23	€ 260,26	656	€ 5.648,50
942. 老佛爷3366			121	€ 61,13	9.816	€ 5.032,17

XRAY ON THE TARGET AND START OFF WITH TAKEDOWNS



4TH PHASE – START OFF WITH TAKEDOWNS – REMOVAL OF ABUSIVE URLS AND SHUT DOWN OF E-SHOPS

CONVEY S.R.L. 待响应申诉 0

淘宝网 知识产权投诉平台

平台 * **淘宝网 Taobao.com**

知识产权 * 请选择

投诉链接类型 * 商品 店铺招牌、店铺公告等

投诉理由 * 请选择

投诉链接 * 一条链接一行，最多300条

验证链接

举证证明 选择文件

- 支持zip/rar/jpg/png/bmp/pdf
- 可作为举证证明的文件：(模板下载)

提交

1. SET UP OF COMPLAINT PLATFORMS/PROCEDURES

知识产权 * 商标权

投诉链接类型 * 商品 店铺招牌、店铺公告等

投诉理由 * 请选择

投诉链接 * 一条链接一行，最多300条

请选择

TOTTENHAM (7665613)

Tottenham Cockerel on ball (figurative) - Class 25 (G898793)

UNDER ARMOUR - Class 18 (4974746)

3. FILING AND MANAGING TAKE-DOWN NOTICES IN MANDARIN CHINESE

投诉单详情

投诉单号: 2159100
 投诉时间: 2015-08-25 18:04
 知识产权名称: New Balance - Class 25
 知识产权类型: 商标权
 举证证明:

致淘宝公司的法律部门,我们正式通知你们在TAOBAO.com的下列广告侵犯New Balance Athletic Shoe, Inc.的知识产权。这些产品已经由New Balance Athletic Shoe, Inc.的知识产权部门和产品专家作过精心的检验,可以确认是假货和仿制品,与原产品相比较有许多异常和不同之处(款式)。请查收附件1。这些产品完全是假冒的。请贵公司能够尽早将其撤下,以保护New Balance Athletic Shoe, Inc.的商标权。

审核通过

全部(4) 审核中(0) 审核不通过(0) 申诉中(0) 申诉待响应(0) 小二介入(0) 撤诉(0) 申诉成立(0) 最终删除(4)

全选

共4条数据

投诉信息	知识产权/申诉信息	处理状态/备注	操作
<input type="checkbox"/> 迪奥服饰运动 (49643219) http://item.taobao.com/item.htm?id=4563895234 (已删除)	New Balance - Class 25	<input checked="" type="checkbox"/> 最终删除	
<input type="checkbox"/> 小娟娟专柜 (49643216) http://item.taobao.com/item.htm?id=45856086840 (已删除)	New Balance - Class 25	<input checked="" type="checkbox"/> 最终删除	
<input type="checkbox"/> 李吉宙66933 (49643217) http://item.taobao.com/item.htm?id=520652376180 (已删除)	New Balance - Class 25	<input checked="" type="checkbox"/> 最终删除	

THE GOODFAITH TAKEDOWN MECHANISM

Good-Faith Takedown Mechanism

Alibaba has also introduced a new system for Taobao.com and Tmall.com referred to as the Good-Faith Takedown Mechanism (trial). This mechanism appears to mainly codify existing Alibaba practices intended to reward IP owners with a solid history of filing accurate and concise takedown requests.

Under the new system, complainants will be classified into three categories, with the timeframe for processing and takedowns being more favourable depending on the category (see table). The timeframes indicated exclude the time required by Alibaba to review and verify the documentation submitted.

Category	Criteria	Takedown timeframe
Good	Takedown request submission accuracy rate \geq 90% Valid counter-notice rate \leq 1.5%	One to three business days

Good-faith, mak

Good-faith Take

Welcome, Sig

"Good-faith" is the value that Alibaba keep pursuing
It has been involved in our daily working and also in the cooperation w



Arrange designated staff
More effective communication



Fast Takedown
Complaints shall be p
within 1-3 working

CONVEY S.R.L. | Pending for Response to Counter-notification 24

简体中文

Submit Complaints

Manage Complaints

Status of Complaining Party

Good-faith Takedown Status

Your current status is: ✔ Good-faith complaining party.

[Good-faith Letter of Undertaking](#) [What is Good-faith complaining party?](#)

Complaints submitted by a good-faith complaining party will be processed within 1-3 working day(s) by experie
in the area of intellectual property rights based on simplified requirements of proof of infringement.

If you have any queries, please feel free to contact iprsupport@alibaba-inc.com

Your Complaint Index


Takedown rate	Successful counter-notification rate
99.33%	0.06%

Notes


- Status of complaining parties will be calculated and updated automatically on the first day of each month.

**THE EXPOITATION OF THE
WHOLE IP PORTFOLIO IS THE
BASIS FOR A TOP REMOVAL
RATE AWARDED BY THE
MARKETPLACES**

THERE ARE TWO KINDS OF COUNTERFEITERS: **THOSE WHO FEEL GUILTY...**

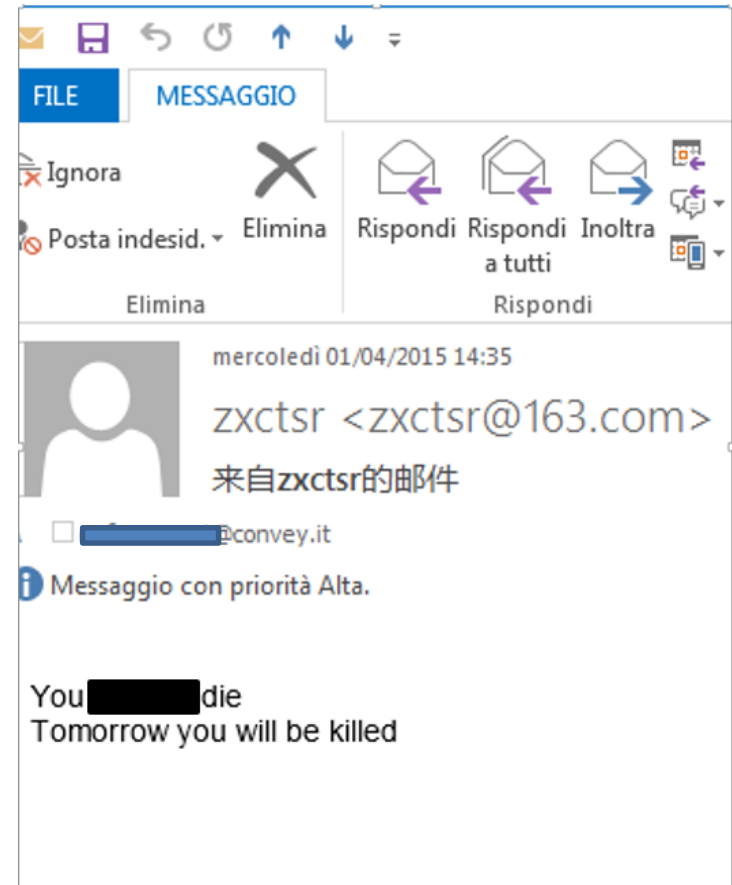
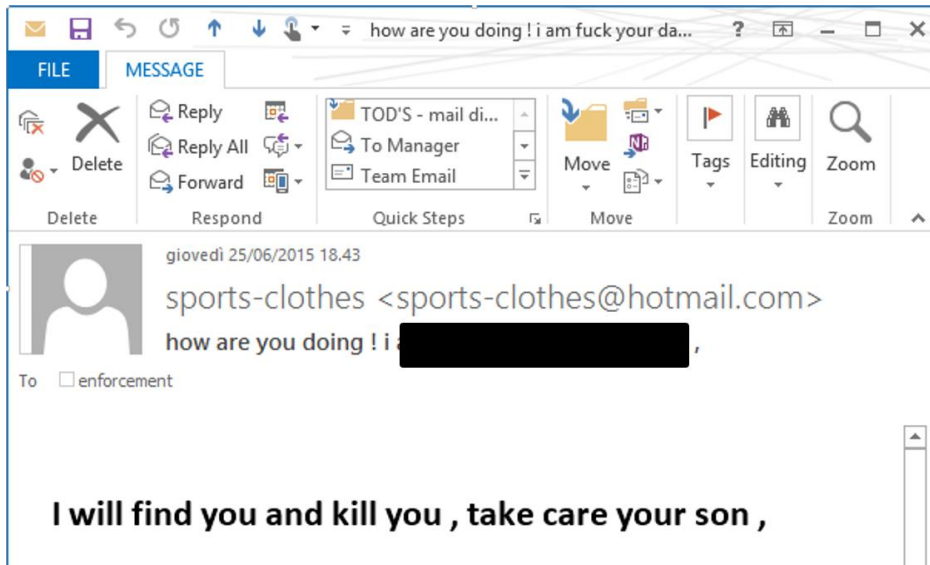
 mercoledì 16/09/2015 07.12
肖婧 <xiaojing199210@outlook.com>
Hello dear friend,
To enforcement@convey.it

Hello dear friend
I'm apologize, I have sold your company brand products, I'm so sorry, I kindly ask you to cancel a complaint, I will remove all offerings. Please give me a chance, I have to feed two children, I'm no have a job. This complaint will be close my store, I'm begging you to, please. I will remove all offerings.
Best regards
Top-rated Seller Motorcycle and Cycling

 martedì 15/09/2015 21.44
es1020550938 <wudaihan_2010@163.com>
Complaints single number: 201509100220428809
To enforcement

Hello, friend
Please forgive me, I really did not intend to use your trade names.
Please forgive me, I now remember the name of your merchandise.
Never mess with this name.
I ask you to forgive the ignorance of the mistake.
These clothes I'm not the main selling, but someone else shelves.
Please help me eliminate rut cast out okay?
I can not live without this store.
I have small children.
I know that was wrong.
Please forgive me.
thank you!

THERE ARE TWO KINDS OF COUNTERFEITERS: AND THOSE WHO DON'T 😊



... BUT WE GOT USED TO IT!

THANK YOU!



CONVEY
internet brand protection

Via Sagra di San Michele, 27
10139 TORINO
+39 011 4337606

www.convey.it
informazioni@convey.it
enforcement@convey.it
gtld@convey.it





QUESTIONS