

Anti-Counterfeiting

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We develop prevention and enforcement strategies to help protect you against counterfeiters and intellectual property pirates.

On the prevention side, we help you identify and fill gaps in your intellectual property portfolios, protection programs and customs guides that make you vulnerable to counterfeiters and pirates seeking to profit from your intellectual property and goodwill. Our Shanghai office can help reduce the risk of intellectual property theft should you choose to manufacture in China. We design custom solutions that range from regional to global in scale, depending on your business objectives. Here are a few examples of prevention services we offer:

- Filing for patent, trademark and copyright protection in the U.S. and abroad.
- Registering trademarks with customs agencies in U.S., China, South America, and Central America to block the import/export of infringing goods, including the development of customs guides for Border Agents.
- Negotiating manufacturing, non-disclosure and intellectual property agreements with foreign manufacturers to protect against intellectual property theft.
- Applying for enhanced protection on e-commerce and social media sites, including brand registry and brand gating on Amazon.
- Assisting with implementing anti-counterfeit technologies, tracking and serialization.
- Developing intellectual property portfolio strategies and systems to minimize counterfeit risks.

If knockoff products or bootlegs do appear on the market, we help stop infringers in their tracks through takedown notices, enforcement actions and litigation. Our team has extensive experience addressing product counterfeiting and piracy both in and out of court. Our services include the following:

- Investigating infringers to discover where they are located.
- Coordinating investigations within China, South America, and Central America regarding suspected counterfeiters.
- Utilizing take-down procedures and cease and desist letters to efficiently remove counterfeit products and pirated materials from e-commerce and social media sites like Amazon, Alibaba, eBay, Twitter, Etsy, Facebook and YouTube.
- Filing Digital Millennium Copyright Act (DMCA) notices to removing infringing copyright material.
- Attacking domain-name hijacking through the Uniform Domain Name Dispute-Resolution Policy (UDRP).

- Pursuing gray-market sellers who disrupt the legitimate supply chain.
- Combatting internet fraud involving 1-800 numbers where counterfeiters set up fake websites and use our clients' trademarks to dupe customers into thinking that they are viewing the real websites. If customers call the 1-800 numbers on the fake webpage, they may end up divulging personal or financial information without realizing that the websites are fake.
- Negotiating settlements with larger counterfeiters to remove infringing products from the market and compensate for past infringement.
- Litigating against counterfeiters or pirates who refuse to stop and obtaining restraining orders and injunctions against persistent patent, trademark and copyright infringers.
- Seizing goods that bear counterfeit trademarks.

Experience

Our team has decades of experience working on intellectual property matters and issues involving counterfeiting, piracy and the China market. Here are a few recent examples of our work:

- Represented the Estate of Prince Rogers Nelson in litigation concerning the late superstar's intellectual property assets. In one case, we brought a suit against a bootleg record label asserting claims for trademark infringement, trademark counterfeiting, copyright infringement, bootlegging and violating Prince's right of publicity. We obtained a default judgment against one of the bootleggers for \$7 million plus attorney's fees.
- Helped a start-up company assert its patent and copyright assets against counterfeiters selling knockoff products on Amazon, eBay, Alibaba and other e-commerce sites. We prevented the infringers from gaining any traction by taking them down as soon as they appeared, which allowed our client to build its brand without fear of being undercut by cheap, knockoff products.
- Obtained a default judgment against a defendant who was selling counterfeit products on Amazon. The district court found willful patent infringement, entered a permanent injunction against the seller, awarded treble damages and attorney's fees to our client and held the defendant in contempt when it violated the injunction. We succeeded in removing the counterfeiter's fake products from the market.
- Brought a suit for patent infringement against a large group of related counterfeiters who were selling on Amazon. We obtained a consent judgment against the largest violator and negotiated settlements with the remaining defendants. As a result of the lawsuit, the infringing products were removed from Amazon.
- Brought lawsuits enforcing utility and design patents when counterfeit products from China began appearing in U.S. retail outlets. We negotiated favorable settlements that compensated our client for the infringement and forced changes in purchasing channels to reduce the risk of counterfeits going forward.

- Created and implemented strategies for acquiring patent protection covering a replacement part component of a client's next generation product. A similar replacement component of the previous generation product had been the subject of knockoffs causing lost profits associated with the prior product.
- Engaged in all aspects of brand protection in the U.S. for a retail jewelry brand, including enforcement actions against knockoffs and brand protection in the Trademark Trial and Appeal Board.
- Used take-down procedures and cease-and-desist letters to remove bootleg and pirated music from Facebook and YouTube, as well as from independent websites operated directly by bootleggers.
- Helped clients investigate the sources of counterfeits in China, South America and Central America.
- Removed 1-800 numbers from websites that were using our clients' trademarks to trick customers into calling fake customer support centers and divulging personal or financial information.