

Bird & Bird & IPR Protection in China 鸿鹄律师事务所与中国的知识产权保护

#E-commerce #Cosmetics #Counterfeits #IPR infringements

#电商 #化妆品 #假冒 #知识产权侵权

2020.11

Counterfeits in 2020

2020年假冒活动

Why is it still so difficult?
为何情况依然如此困难?

Counterfeits in 2020 2020年假冒活动

More complicating than ever before 比以往更复杂

- Similar look-and-feel, not exact copy 外观/感觉相似，不完全照抄
- Registering famous brands' TM/Design/Patent/Copyright, company names, domain names etc 注册知名品牌的商标/设计/专利/著作权、公司名称、域名等
- Creating fake 'official website', 'flagship online store', 'official WeChat account' 创建虚假的 “官网”、“旗舰店”、“微信公众号”
- Copying similar business model 复制相似的业务模式
- Even copying corporate structures (e.g., Headquarter in Paris, Asia headquarter in Hong Kong, PRC regional headquarter in Shanghai) 甚至复制企业架构（例如，总部在巴黎、亚洲总部在中国香港特区、中国内地总部在上海）
- Virtual market 网络市场
- Health risks (product quality, parallel import etc) 健康风险（产品质量、平行进口等）

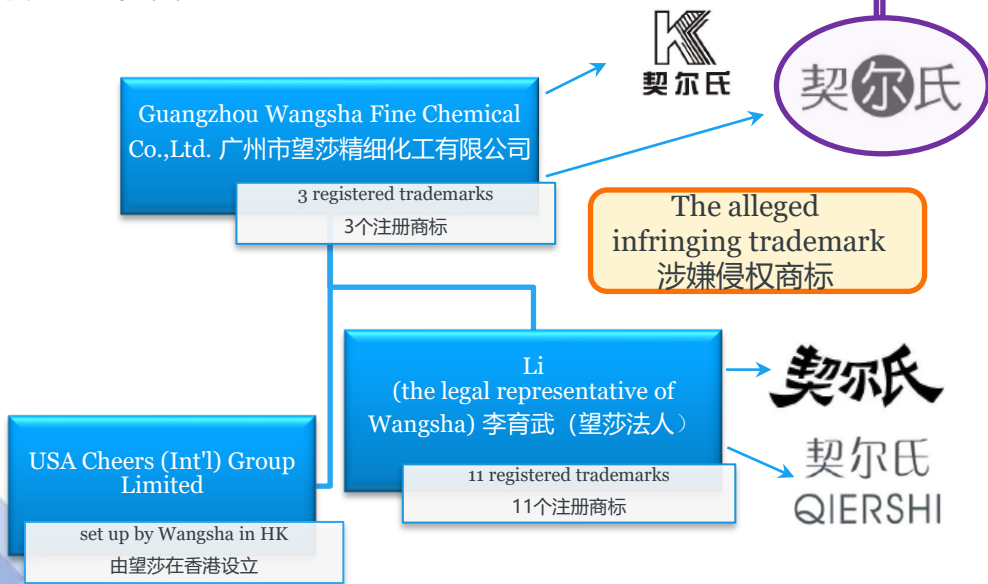
L'ORÉAL VS Li Yuwu

欧莱雅诉李育武

Facts 事实

A Chinese chemical company registered "契尔氏" (Kiehl's in Chinese) in several categories and sold cosmetics products under the name of "契尔氏".

一家中国化工公司以“契尔氏” (Kiehl's为英文名) 为名注册并出售多类化妆品。



The screenshot shows the trademark registration details for '契尔氏' (Kiehl's). The page includes the following information:

- 商品/服务: 洗发液; 洗面奶; 去污剂; 上光剂; 芳香剂(香精油); 香水; 化妆品; 增白霜; 牙膏; 香; 查看
- 类似群: 0301;0302;0303;0305;0306;0307;0308;
- 申请/注册号: 5046068
- 申请日期: 2005年12月06日
- 国际分类: 3
- 申请人名称(中文): 李育武
- 申请人名称(英文):
- 申请人地址(中文): 广东省普宁市流沙镇城西赵厝寮管区水电路南中央厝2巷16号
- 申请人地址(英文):
- 初审公告期号: 1156
- 注册公告期号: 1168
- 是否共有商标: 否
- 初审公告日期: 2009年02月20日
- 注册公告日期: 2009年05月21日
- 商标类型: 一般
- 专用权期限: 2019年05月21日至2029年05月20日
- 商标形式:
- 国际注册日期:
- 后期指定日期:
- 优先权日期:
- 代理/办理机构: 北京派诚商标代理有限公司
- 商标流程: 点击查看
- 商标状态图标: 注册

A callout bubble indicates 'Still valid 依然有效' (Still valid).

Online Shop in 1688 1688平台上的网店

1688 广州市望莎精细化工有限公司 货描 响应 发货 回头率 2%↑ 8%↑ 6%↓ 39% ☆收藏领券

望莎 MOKSHA 清远市望莎生物科技有限公司 广州市望莎精细化工有限公司 14年专业OEM/ODM/OBM化妆品定制加工

首页 镇店之宝 公司档案 供应产品 公司相册 公司动态 在线询价

契尔氏 水润饱满 释放寡肽活能量

小分子玻尿酸安瓶补水套 长时保湿+隐形锁水+精研补水配方

产品分类: 护肤彩妆、身体护理、母婴用品、洗护用品、个人护理、宠物用品、家居用品、办公用品、工业用品、农业用品、其他用品

供应产品: 玻尿酸安瓶、玻尿酸精华液、玻尿酸面膜、玻尿酸眼霜、玻尿酸唇膏、玻尿酸身体乳、玻尿酸洗发水、玻尿酸沐浴露、玻尿酸洗面奶、玻尿酸卸妆膏、玻尿酸防晒霜、玻尿酸隔离霜、玻尿酸粉底液、玻尿酸口红、玻尿酸指甲油、玻尿酸香水、玻尿酸护手霜、玻尿酸润唇膏、玻尿酸发乳、玻尿酸护发素、玻尿酸发膜、玻尿酸护发精油、玻尿酸护发喷雾、玻尿酸护发精华液、玻尿酸护发精油、玻尿酸护发喷雾、玻尿酸护发精华液

工商注册信息: 诚信于2020年10月22日通过中诚信专业认证

公司名称: 注册资本: 注册地址: 统一社会信用代码: 91440114MA59A7Q893 成立日期: 登记机关: 营业期限: 法定代表人: 企业类型: 经营范围: 化妆品批发;化妆品及卫生用品批发;化妆品及卫生用品零售;互联网商品销售(许可审批类商品除外);日用品批发;日用器皿及日用杂货批发;厨房用具及日用杂品零售;化妆品零售;百货零售(食品零售除外);互联网商品零售(许可审批类商品除外);商品零售批发贸易(许可审批类商品除外);商品零售贸易(许可审批类商品除外);保健食品批发(具体经营项目以《食品经营许可证》为准);保健食品零售(具体经营项目以《食品经营许可证》为准)

通过第三方认证

Slide 6

#E-commerce #Cosmetics #Counterfeits #IPR infringements #电商 #化妆品 #假冒商品 #知识产权侵权

Bird & Bird

**Zhaoxiang
Cosmetics Trading
(Shanghai) Co.,
Ltd.**



Zhou Xixiang

兆享化妆品贸易（上海）有限公司诉周细香

Facts 事实

Zhou Xixiang opened a store in Pinduoduo (an e-commerce platform) and sells counterfeit Herbacin hand cream. 周细香在拼多多经营一家网店，销售假冒贺本清手霜。



Counterfeit Good
假冒品

Genuine Good
正品



Judgment 判决

Zhou shall compensate the Plaintiff: 周细香应赔偿原告:



MATIS Company



Liu Decheng

魅力匙公司诉Liu Decheng (下称刘某)

Facts 事实

Liu Decheng opened a store in Taobao (an e-commerce platform) and sells counterfeit MATIS cosmetics. Taobao did not ban Liu's shop Completely.

刘某经营一家淘宝店，销售假冒魅力匙化妆品。淘宝没有完全封禁刘某的店铺。

MATIS
Company
魅力匙公司

Sue 起诉

Liu Decheng
刘某

Zhejiang Taobao
Network Limited
浙江淘宝网络有限公司

Did Liu sell goods that infringe MATIS Company's right to use the trademark?
刘某是否出售了侵犯魅力匙公司商标使用权的产品?

Whether Taobao's conduct constitutes joint infringement?
淘宝的行为是否构成联合侵权?



Infringed
侵权 ✓

Liu's shop name
刘某的店铺名

"Real MATIS"
"魅力匙正品"

"Hongxiu Shop MATIS
Branch"
"红袖店铺魅力匙分店"

Goods in the shop
店内商品

MATIS: counterfeit
(Prime Facie Evidence)
魅力匙：假冒（初步证据）

Liu: no evidence

刘某：无证据



NOT Infringed
未侵权 ×



HAVE
TAKEN
MEASURES
已采取措施

RULE: An Internet service provider bears joint infringement liability when it:
规则：互联网服务提供商在以下情况承担联合侵权责任：

- 1) **knows or should have known** the infringement, **and 知道或者应当知道** 侵权行为，**且**
- 2) **still provides Internet service** for the infringer **or fails to take proper measure** 依然为侵权人提供互联网服务 **或者** 未能采取适当措施



Judgment 判决

Liu shall compensate MATIS: 刘某应当赔偿魅力匙:

Reasonable
Expenses to Stop
the Infringement
RMB50,000
制止侵权行为的
合理费用5万元

Economic
Losses
CNY450,000
经济损失45万元

Amounts of Illegal gains 非法所得金额

Duration of the infringing act 侵权行
为的持续期

Product reputation 产品知名度

The scale of Liu's infringing shop
刘某侵权店铺的规模

*Christian
Louboutin*



**Guangzhou VerTEAM
Trading Co., Ltd.**

**Guangzhou Beilingfei
Cosmetics Co., Ltd.**

**克里斯提·鲁布托诉广州问叹贸易有限公司
及广州贝玲妃化妆品有限公司**

Bird & Bird

Facts 事实

Verteam entrusted Belingfei and Oumu to manufacture the lipsticks that appear the same as or similar to Christain Louboutin, and sold the alleged infringing products on Taobao and WeChat.

问叹委托贝玲妃和欧慕制造的口红外观与克里斯提·鲁布托的口红相同或相近，并在淘宝和微信上出售被控侵权产品。



Christain Louboutin
克里斯提·鲁布托



Sue 起诉



Supervising Company 委托公司:
Guangzhou VerTEAM Trading Co., Ltd. 广州问叹贸易公司

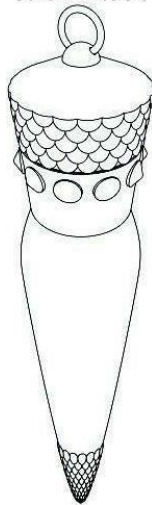
Manufacturing Repackage Company 制造再包装公司:
Guangzhou Beilingfei Cosmetics Co., Ltd. 广州贝玲妃化妆品公司

Guangzhou Oumu Bio Technology Co., Ltd: Process and fill lipstick paste (but the company name isn't in the package)
广州欧慕生物科技有限公司: 加工和填充口红膏 (但是公司名称不在包装上体现)

Appl. Date: 2014.12.28

申请日期: 2014年12月28日

设计1立体图



Christain Louboutin's Patent
克里斯提·鲁布托的专利

Infringer's Patents in Case
案中侵权人的专利

Appl. Date: 2015.12.18

申请日期: 2015年12月18日



Queen's Scepter -1
女王权杖1号



Queen's Scepter -2
女王权杖2号



Queen's Scepter -3
女王权杖3号



Queen's Scepter -4
女王权杖4号

Sheng Yuze (legal representative of Guangzhou VerTEAM Trading Co., Ltd.)'s Patent
盛玉泽 (广州问叹法定代表人) 的专利



Judgment 判决

The court instructed that: 法院裁定:



*Pierrefabredermo-
cosmetique*



Changsha Huiji E-
Commerce Co., Ltd.

Pierrefabredermo-cosmetique诉长沙慧吉电子商务有限公司

Bird & Bird

Facts 事实

Without permission, Changsha Huiji E-Commerce Co., Ltd. claimed that the website it created was the official website of Avene.

长沙慧吉电子商务有限公司擅自声称自己创建的网站是雅漾的官网。



Trademark Infringement?

商标侵权?

NO. 否。



Defendant Sells
**Authentic
Products of
Avene.**
被告销售**正品**雅
漾。



Unfair Competition?

不正当竞争?

YES!!! 是!!!

**Confuse
the Public!!!
误导公众**





Judgment 判决

The court instructed that: 法院裁决:



Tips for dealing with counterfeit issues in 2021!

2021年处理假冒问题的技巧!

Simple steps 简单步骤

Tip 1 correct understanding of a case

第1点 正确理解案件

Tip 2 two-wheel approach

第2点 “双齿轮” 法

Tip 3 set priorities

第3点 设定优先级

Tip 4 create simple workflows

第4点 简化工作流程

Common challenges 共同挑战

Many actions were taken but..... 虽然采取了很多措施, 但是.....

Case 1: Counterfeit facial masks (exact copy) found online

Investigation => Sample purchases => Test

Case 2: Counterfeit snacks (similar package design) found online

HK Co had PRC factories manufacture and sold online. Investigation => CD letters (HK Co/Factories/Retailers)

Case 3: Trademark piracy

Investigation => Negotiation => Purchase/Assignment => New app

Case 4: Counterfeit snacks (similar package design) found at trade fairs

Investigation => CD letters => Quality tests => Admin actions => Copyright recordation and Customs recordation

Case 5: Counterfeit snacks (similar package design) found at trade fairs

Investigation

Case 6: Counterfeit snacks (similar package design) found at trade fairs

Investigation

Case 7: Counterfeit pharmaceuticals (similar package but different products) found online

Desktop search => Copyright recordation => CD letter

案例1: 网上发现假冒口罩 (完全仿制)

调查 => 购买样品 => 检测

案例2: 网上发现假冒零食 (包装设计相似)

香港公司安排内地工厂制造, 然后在网上销售。调查 => 停止警告函 (香港公司/工厂/零售商)

案例3: 商标侵权

调查 => 协商 => 购买/转让 => 新APP

案例4: 贸易展会上发现假冒零食 (包装设计相似)

调查 => 停止警告函 => 质量检测 => 行政措施 => 著作权备案与海关备案

案例5: 贸易展会上发现假冒零食 (包装设计相似)

调查

案例6: 贸易展会上发现假冒零食 (包装设计相似)

调查

案例7: 网上发现假冒药品 (包装相似, 但产品不同)

桌面搜索 => 著作权备案 => 停止警告函

Feedback from Business 企业反馈

- It seems like they are responding on an *ad hoc* basis.
- 相关部门似乎只对具体情况做以响应。
- It lacks a sense of speed.
- 缺乏速度意识。



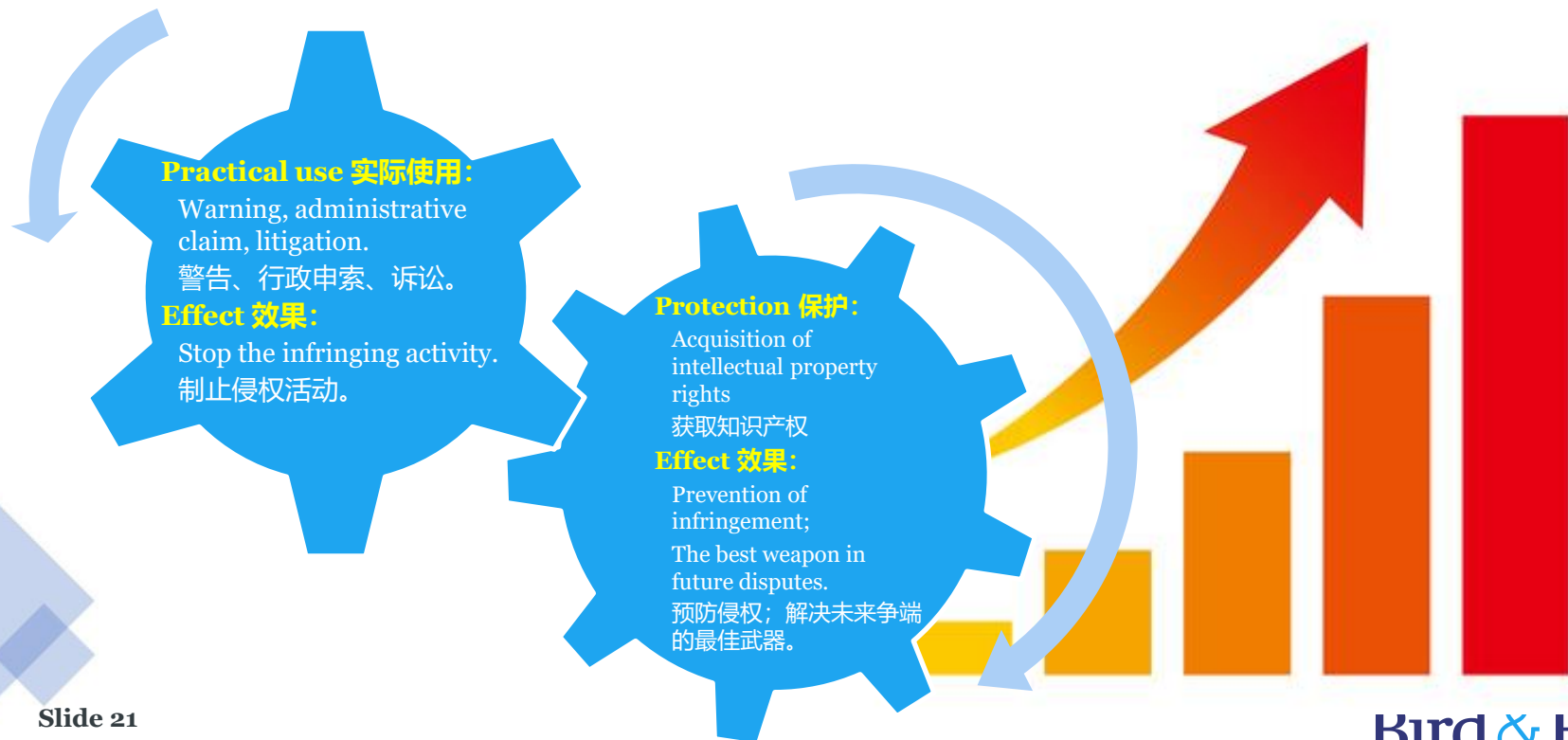
Goal 目标:

- Bird's eye view 全局观
- More proactive 更主动
- More emphasis on speed 更强调速度

Two wheels in intellectual property strategy

知识产权保护策略的“双齿轮”策略

Lead to improved business performance 可改善业务表现



Slide 21

#E-commerce #Cosmetics #Counterfeits #IPR infringements #电商 #化妆品 #假冒商品 #知识产权侵权

Bird & Bird

Possible measures in China 中国可能采取的措施

Measure 措施		Aim 目的	Merit 优势	Demerit 劣势
调查 Investigation	①Online Investigation 网上调查	To know the counterfeiters and the infringement situation. 了解造假者和侵权情况。	Easy to investigate 易于调查	Difficult to grasp the private information and the actual situation. 难以掌握非公开信息和实际情况。
	②On-site Investigation 现场调查		There is a possibility that sales, customer information, etc. that are not disclosed on the Internet can be obtained. 有可能获得互联网上未披露的销售数据、客户信息等。	Cost and time 成本、时间
协商 Negotiation	①Notice (Without rights) 通知 (不主张权益)	To notify the existence of rights and infringement, and request infringement. 通知权利和侵权存在性, 并要求停止侵权。	No cost and no time spend. If a voluntarily respond to the request is received, you may be able to resolve it early without the need for administration or filing a litigation. 零金钱与时间成本。如果收到自愿回应, 就能够及早解决问题, 无需行政干预或者提起诉讼。	It may be ignored or neglected. Notifications without underlying rights are more feasible than C&D letters. 可能被无视或忽视。不主张权益的通知比停止警告函更加可行。
	②Cease and desist letter (With rights) 停止警告函 (主张权益)			Tends to be ignored and neglected 往往被无视或忽视。
行政 Administration	①Report (Quality, license) 报告 (质量、许可)	Manufacture and sales blocked by government authorities. 政府部门制止造假和售假行为。	Manufacturing and sales can be stopped speedily. 可迅速制止造假和售假行为。	Quality testing must be done. If it is judged that there is no quality problem or if it is solved, manufacturing and sales can be resumed. You cannot claim damages. 必须进行质量检测。如果判定无质量问题或者质量问题已解决, 则可恢复制造和销售活动。
	②Raid (IP infringement) 突袭 (知识产权侵权)			You cannot claim damages. There is a high probability that projects in complex gray zones will not be accepted. 无法索赔。复杂灰色地带的问题很可能不被受理。
司法 Judicial	Civil litigation 民事诉讼	Injunction and claim for damages 禁止令、索赔	Claims for damages are possible. It is possible to judge even complicated gray zone matters 有可能索赔。还有可能就更加复杂的灰色地带问题进行裁决。	It is money and time consuming. It may be difficult to execute. Patents carry the risk of trial for invalidation. 耗费资金与时间。难以执行。专利存在被无效宣告的风险。
等待 Wait	Lay aside 搁置		Stop outflow of man-hours and costs 暂停工时和成本支出	Continuation and expansion of counterfeit 假冒行为的持续和扩张

Slide 22

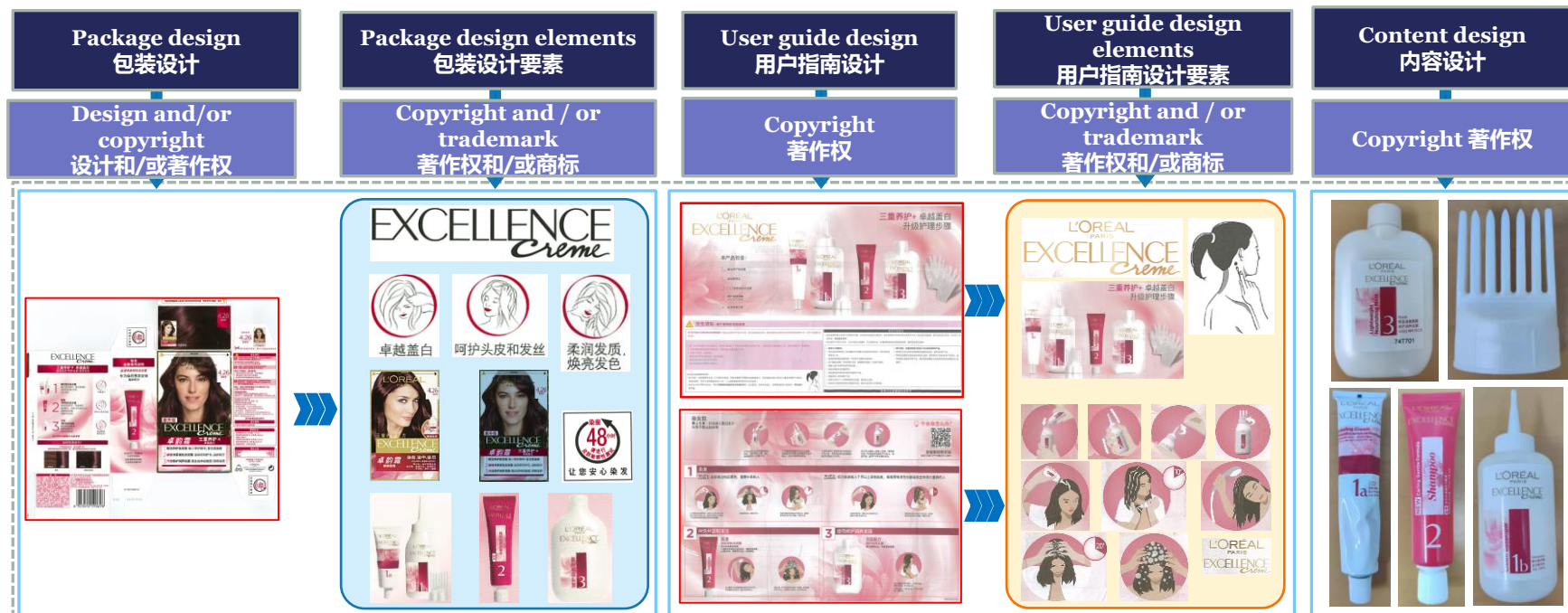
#E-commerce #Cosmetics #Counterfeits #IPR infringements #电商 #化妆品 #假冒商品 #知识产权侵权

Bird & Bird

Rights acquisition 取得权利

	Patent 专利	Design right 外观设计	Copyright 著作权	Trademark 商标	Unfair Competition Law 反不正当竞争法
Target 对象	New technical measures (inventions) for products, methods or improvements thereof; A new technical plan (utility model) that is applied to the shape, structure or combination of products and is suitable for practical use. 面向产品、方法或对其作出改善的新技术措施（干预）；适用于形状、结构或产品组合，且适合实际使用的新技术方案（实用新型）。	Package design; Tray and container shape. 包装设计；托盘和容器形状。	<ul style="list-style-type: none">Overall package design and each element;整体包装设计和每个要素；Pattern on film (interior)包装膜图案（内部）	Display showing characters, figures, logos, quality, functions, efficacy, etc. 表现文字、数字、徽标、质量、功能、效率等内容的物品。	Products, exterior designs, brands, company names, etc. that are well known in China 在中国知名的产品、外部设计、品牌、公司名称等。
Applicable condition 适用条件	Similarity 相似	Similarity 相似	Similarity 相似	Similarity and confusion 相似、混淆	Familiarity, similarity, confusion 熟悉、相似、混淆
Registration/ application 注册/申请	Yes 是	Yes 是	Yes 是 <ul style="list-style-type: none">Registration is not a copyright requirement;著作权无注册要求；Rudimentary proof of rights权利的初步证据	Yes 是	N/A 不适用
Protection period 保护期	20 years of invention, 10 years of utility model 发明专利20年，实用新型10年	10 years 10年	50 years 50年	10 years from the registration date 从注册日开始10年	As long as the name recognition continues 知名度存续期均可
Update 更新	No 否	No 否	No 否	Yes 是	N/A 不适用
Merit 优势	Suitable for litigation 适合诉讼	Suitable for litigation 适合诉讼	Suitable for litigation; Partly suitable for counterfeit 适合诉讼；部分适合处理假冒案例	Suitable for administrative actions (short-term, low cost) 适合行政措施（短期、低成本）	Suitable for litigation; Partly suitable for counterfeit, complex counterfeit matters. 适合诉讼；部分适合处理假冒、复杂假冒案例。
Demerit 劣势	Risk of invalidation request; overall similarity required; difficulty in administrative detection. 无效宣告请求风险；需整体相似；行政发现存在困难。	Risk of invalidation request; overall similarity required; difficulty in administrative detection. 无效宣告请求风险；需整体相似；行政发现存在困难。	If the rudimentary proof of rights is refuted, it is difficult to prove it and to do administrative actions. 如果权利的初步证据被驳回，则难以证明权利存在以及采取行政措施。	Since there's a substantive examination, it is difficult to obtain rights and it costs money. 存在实质性审查，难以获得权利，且耗费资金。	Difficult to prove. 难以证明。

Example of rights acquisition 取得权利示例



“Anti-unfair competition law” 《反不正当竞争法》

Article 6 The business operator shall not carry out the confusion acts listed in the following items and cause the related public to misunderstand that it is a product of another person or has a specific relationship with another person.

(1) Unauthorized use of signs that are the same as or similar to the names, packaging, decorations, etc. of products that have a certain influence on others.

第六条 经营者不得实施下列混淆行为，引人误认为是他人商品或者与他人存在特定联系。（一）擅自使用与他人有一定影响的商品名称、包装、装潢等相同或者近似的标识。

Type of exercise (budget, goal, purpose?)

行动类型（预算、目标、目的？）

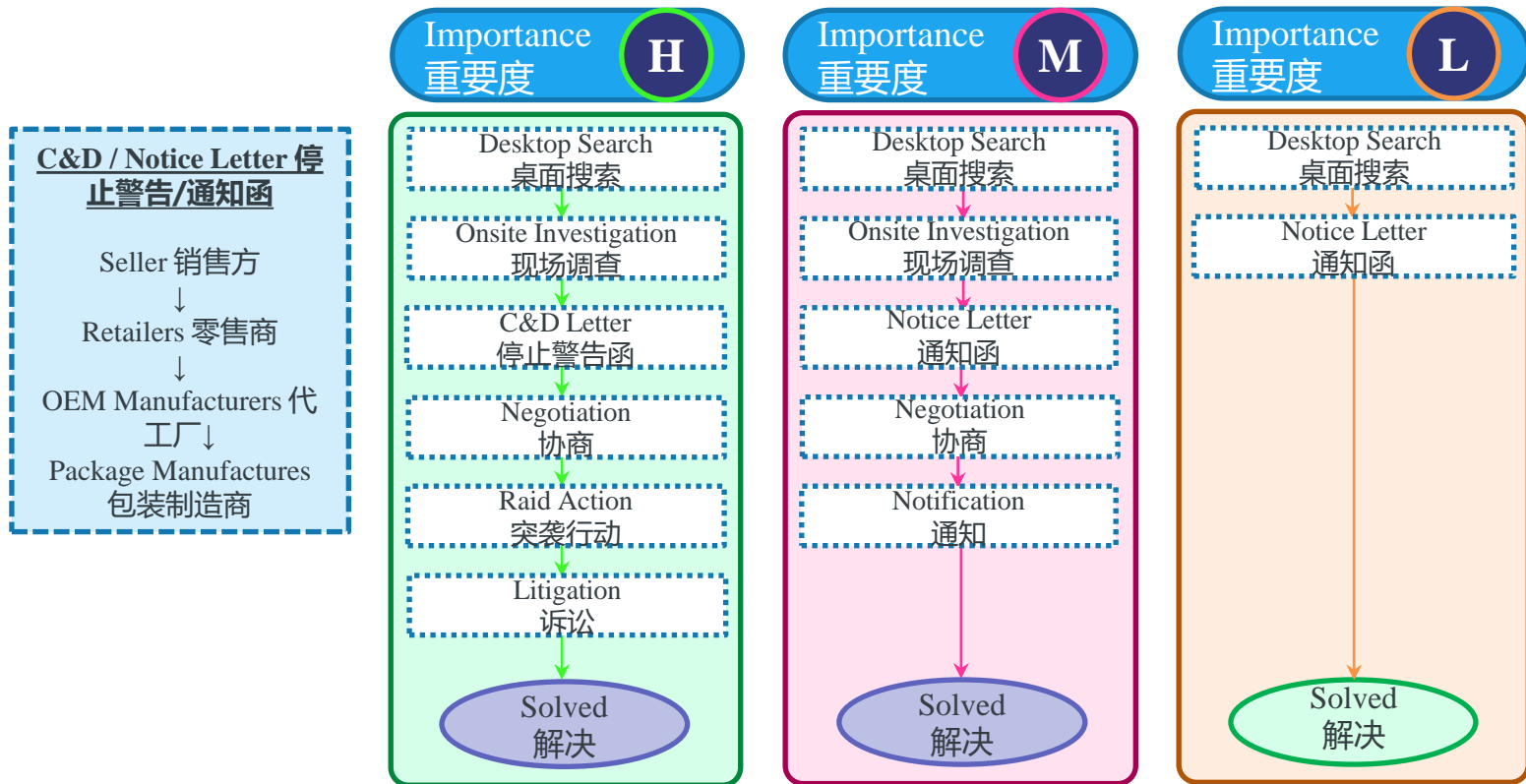
Active Defense Type 以攻代守	Post-attack Type 事后打击
Annual budget of 30 million JPY or more 年预算不低于3000万日元	Annual budget less than 3 million JPY 年预算低于3000万日元
Counterfeit manufacturer eradication goal 消除造假者	The goal is to stop visible infringement 制止可见侵权
Invest huge costs in research. Collect information on counterfeit products throughout China using various research methods 调研阶段成本巨大。利用各种研究方法收集中国的假冒品信息。	Conduct investigations based on information sent from local subsidiaries, distributors, and customers 根据本地子公司、分销商和顾客提供的信息开展调查
Civil and criminal litigations have been filed. Dozens of cases per year for administrative detection. 提起民事和刑事诉讼。每年提交行政处理的有数十起案例。	No civil or criminal litigations will be filed. Basically a warning letter and administrative raids are used. 不会提起民事或刑事诉讼。基本采取警告函和行政突袭措施。

Evaluation criteria: Importance 评价准则：重要度

High, Medium, Low 高、中、低

Importance 重要度	Evaluation criteria 评价准则	Possible measures 可能措施
H 高	<ul style="list-style-type: none">① Intellectual property rights acquired in China 在中国已获取知识产权② Great impact on business 对业务影响大③ Affecting business outside China 影响中国境外业务④ It can damage the brand value 可损害品牌价值	Online investigation; On-site investigation; Negotiation; Administrative actions; Litigations 网上调查；现场调查；协商；行政措施；诉讼
M 中	<ul style="list-style-type: none">① No intellectual property rights in China 在中国无知识产权② Great impact on business 对业务影响大③ Affecting business outside China 影响中国境外业务④ It can damage the brand value 可损害品牌价值	Online investigation; On-site investigation; Notification letters; Negotiation; Administrative actions 网上调查；现场调查；通知函；协商；行政措施
L 低	<ul style="list-style-type: none">① No intellectual property rights acquired in China 在中国未获取知识产权② Small impact on business (not sold in China, sales are not high, but there is potential) 对业务影响小（不在中国销售，销售额不高，但是有发展潜力）③ The impact only in China 只在中国有影响④ Product packaging is similar, but the contents are different 产品包装相似，但内容不同	Desktop investigation; Negotiation; Wait & see; Apply for IPRs “桌面”调研；协商；等等看；申请知识产权

Flowchart 流程图



Thank you & Bird & Bird 谢谢

Rieko Michishita

rieko.michishita@twobirds.com

twobirds.com

本文件中提供的技术、法律或专业事项相关信息仅供参考，不构成法律或专业意见。如有任何具体法律问题或事项，请咨询具有适当资质的律师。鸿鹄对于本文件所含该等信息概不负责，并且对于该等信息不承担任何法律责任。

本文件属于保密信息。除非另有说明，鸿鹄对本文件及其内容拥有版权。不得以任何实质形式出版、传播、摘录、再使用或复制本文件的任何部分。

鸿鹄律师事务所是一家国际律师事务所，由鸿鹄律师事务所及其附属和关联实体组成。

鸿鹄律师事务所是在英格兰和威尔士注册的一家有限责任公司，注册号OC340318，经律师监管局授权并受其监管，注册办公室及主要营业地位于伦敦12 New Fetter Lane, EC4A1JP。有关鸿鹄律师事务所成员和任何经任命担任合伙人的非成员的名单及其各自的专业资质，均可在上述地址查阅。