

THE ROLE OF INTERNET PLATFORMS IN THE FIGHT AGAINST COUNTERFEITING

互联网平台在打击假冒中的作用

IP Key – CAASA
IP Key – 北京反侵权假冒联盟

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Fighting counterfeits *online* or *offline* .. what difference ?

线上线下打假.....区别为何?

- Counterfeiters tend more and more to move from offline → online
 - Less risk to be caught
- Main difference between Offline and Online : they are "invisible"
- This is why the Internet Platform's cooperation is essential :
 - To help **locate** the infringer/seller and take action
 - To **take down** the sale offer made by the infringer/seller
- 造假团伙越来越倾向于从线下转移到线上
 - 被抓获的几率相对较低
- 线下与线上的主要区别：“隐蔽性”
- 故而，互联网平台的配合至关重要：
 - 协助**锁定**侵权人/商家，并采取措施
 - **下架**侵权人/商家商品



Locating the infringer

锁定侵权人

- **SAMR Measures for the Supervision and Administration of E-Commerce**

Issued March 15, 2021 → In effect May 1st 2021

Imposes more precise obligations on the platforms about the identity of the sellers

- Each seller must have a **business registration**, (except in certain specified conditions) ;
- Sellers must publish their identity in a **prominent way**;
- The **platform must verify** the business registration of the sellers and facilitate its publication.

- **网络交易监督管理办法（市场监管总局）**

2021 年 3 月 15 日公布，2021 年 5 月 1 日起施行

针对商家（平台内经营者）身份信息，对平台经营者的主体义务进行了细化

- 商家必须办理市场主体登记（特定情形除外）
- 商家应当在页面显著位置公示身份信息
- 平台应当核实商家市场主体登记信息，为商家履行信息公示义务提供技术支持



SAMR Measures 2021

网络交易监督管理办法（2021年）

- **Failure to comply** with the above obligations by sellers and operators are subject to the sanctions provided by E-Commerce Law
 - Article 76 (rectification + fine below RMB 10k) and
 - Article 81 (fine ranged from RMB 20k – 500k)
- 商家和平台**未履行**上述义务的，将依照《电子商务法》的规定进行处罚
 - 第七十六条（整改 + 一万元以下罚款）
 - 第八十一条（二万元至五十万元罚款）

Taking down 下架（删除）

The EU MoU approach

- 2011 Memorandum of Understanding between EU rights holders and E-Commerce platforms
- Code of practice
 - **Proactive** and **preventive** measures (via agreements with rights holders)
- Periodic evaluation (2013, 2017) : **positive results**

欧盟谅解备忘录的做法

- 欧盟权利人与电子商务平台经营者谅解备忘录（2011年）
- 行为守则
 - **主动预防措施**（通过与权利人签署协议）
- 定期评估（2013年、2017年）：积极成果



General principles 总体原则

-It is the parties' goal to ***collaborate*** in the fight against the sale of Counterfeit Goods over the Internet.
- ...Platforms and Rights Owners are in all instances ***governed by commercial reasonableness standards***, taking into consideration the respective business models of the signatories.
- **Non-binding - No litigation**
-双方目标是通过**合作**打击网售假冒商品
-无论情形如何，平台经营者和权利人均**受合理商业准则规制**，并顾及协议签署各方的业务模式。
- **不具约束力——不诉讼**



Notices and Take Down 通知-下架

- NTD are indispensable measures
- Right owners may notify of sellers when they have ***a good faith belief that they are generally engaged in the sale of Counterfeit Goods,***
- Internet Platforms ***commit to take this information into consideration*** as part of their Pro-active and Preventive Measures.
- 通知-下架是必要手段
- 权利人**遵循诚实守信原则，认定商家销售假冒商品的，**可以向平台发出通知
- 平台**承诺**将该等信息（权利人通知）作为其主动预防措施的一部分**加以考虑**

- Rights Owners commit to**notify** Internet Platforms in an **efficient and comprehensive manner**, of the presence of Offers of Counterfeit Goods
- And **commit to ensure that their use of NTD is undertaken in good faith.**
- 权利人承诺.....以**高效、全面的方式通知**互联网平台经营者有关 “许诺销售假冒商品” 的信息
- 并**承诺善意使用通知-下架机制**



- Rights Owners commit to ***avoid unjustified, unfounded and abusive notifications.***
- Rights Owners and Internet Platforms commit to ***cooperate to minimize potential consequences to sellers in cases of erroneous notifications.***
- 权利人承诺.....**避免发出不合理、无根据和不正当通知**
- 发出错误通知的，权利人和平台经营者承诺**相互配合，将对商家（平台内经营者）的潜在损失降到最低**

PRO-ACTIVE AND PREVENTIVE MEASURES

主动预防措施

- **By right owners**
- Rights Owners commit to **actively monitor** Offers on the websites of Internet Platforms
- Rights Owners commit to**provide and update general information** *specific products* thatpresent a substantial and pervasive *counterfeit problem*(such as products or ranges/measures of products that do not exist in a Rights Owners' product line but have been specifically developed by counterfeiters to attract consumers).
- Right Owners commit to provide *key words* commonly used by sellers.; and to **assist Internet Platforms**, as appropriate, with their Proactive and Preventive Measures.
- **权利人方面**
- 权利人承诺对互联网平台网页上的商品进行**主动监控**
- 权利人承诺.....对存在实质性、普遍性假冒问题的具体商品**提供并更新相关信息**（例如，不存在于权利人产品目录，侵权人专门开发以吸引消费者的假冒产品/型号/款式）
- 权利人承诺提供商家常用关键词.....并适当**协助互联网平台经营者**采取主动预防措施



PRO-ACTIVE AND PREVENTIVE MEASURES

主动预防措施

- **By Internet platforms**

- Internet Platforms commit to **request seller contact information** and to verify this information,
- Internet Platforms commit to take into consideration information received (from Right Owners) commit to use this information at their discretion.
- Internet Platforms commit to **take appropriate, commercially reasonable and technically feasible measures, to identify and/or prevent pro- actively the sale of Counterfeit Goods**, especially obvious Counterfeit Goods, and to prevent such goods being offered or sold through their services. **The measures taken by Internet Platforms shall be at their discretion.**

- **互联网平台经营者方面**

- 互联网平台经营者承诺.....**要求商家提供联系方式**并进行核验
- 互联网平台经营者承诺考虑权利人提供的信息，并自行决定如何使用该信息
- 互联网平台经营者承诺采取**恰当合适、商业合理、技术可行**的措施.....**识别和/或主动防止商家销售假冒商品**（尤其是明显的假冒商品），并防止商家通过其平台服务许诺销售或销售该等商品。**互联网平台经营者应自行决定采取何等措施。**



- **Internet Platforms commit** to deal with notifications in an *efficient and comprehensive manner*,
- **In cases of doubt**,Internet Platforms may **request additional information** from the notifying party.
- Such requests shall be made *in good faith and should not lead to an unreasonable or undue delay* in taking down notified Offers
- **互联网平台经营者承诺以高效、全面的方式处理通知**
- **如有疑问.....互联网平台经营者可以要求通知方补充信息**
- **该等要求应遵循诚实信用原则，不得因此无故推迟下架通知所涉商品**



IP Key "Lessons from the EU experience with the MoU in tackling the online sale of counterfeit goods in the Internet (21 November 2019)".

IP Key报告——《关于打击互联网销售假冒商品谅解备忘录的欧盟经验》（2019年11月21日）

- "Could the EU memorandum of Understanding help, and if so, how ?"
 - Analysis of positive results of the European MoU
 - Positive conclusion on the feasibility of an equivalent MoU in China
-
- “欧盟谅解备忘录是否有助打击假冒？如是，通过何等方式？”
 - 欧洲谅解备忘录积极成果分析
 - 对在中国制定类似谅解备忘录的可行性得出肯定结论

E-Commerce Law - 1 January 2019

电子商务法（2019年1月1日起施行）

- **E-Commerce Law** in China (6 years preparation)
 - Proposals to introduce in the law a **legal obligation** on platforms to take "**reasonable proactive and preventive measures**"
 - Failed...
- 中国**电子商务法**（筹划六年）
 - 建议引入平台经营者“采取**合理主动预防措施**”的**法律义务**
 - 未被采纳.....



E-Commerce Law - 1 January 2019

电子商务法（2019年1月1日起施行）

- **Article 42** : - Take down notice + prima facie evidence → measures (**deletion**, etc.)
 - **Forward** to seller
 - **Wrong** notice → **liability** / **Malicious** notice → **double liability**
- **Article 43** : - **Counter notice non infringement** + prima facie evidence
 - **Forward** to IPR holder
 - **15 days** send notice **complaint** (administrative or judicial)
- **Article 44** : - Platform **knows or should know** → take measures → liability
- **Article 84** : Possible sanctions on Platforms (max 2MRmb)

- **第42条**：发出**要求下架通知** + 初步证据 → 采取措施（删除等）
 - 将通知**转送**商家（平台内经营者）
 - **错误通知** → **承担民事责任** / **恶意通知** → **加倍承担赔偿责任**
- **第43条**：发出反通知（不存在侵权行为的声明） + 初步证据
 - **转送**权利人
 - 权利人可在**十五日内**进行**投诉或起诉**
- **第44条**：平台经营者**知道或者应当知道** → 采取措施 → 未采取措施的，承担责任
- **第84条**：平台或被罚款（不超过二百万元）



SPC - 12 September 2020

最高法 – 2020年9月12日

- ***SPC Official reply on Several Issues Concerning the Application of the Law to Online IP Rights Infringement Disputes***
 - If the platform does not delete → application to the court for **injunction**
 - **15 days** does not include authentication/notarisation of documents → **20 days max**
 - Take down notice **not in bad faith** → **no liability**
 - Malicious counternotice → **punitive damages**
- **最高法关于涉网络知识产权侵权纠纷几个法律适用问题的批复**
 - 平台不采取下架措施的 → 向法院申请采取**保全措施**
 - **15个工作日**不包括办理公证、认证手续等导致的延迟 → 不超过**20个工作日**
 - **非恶意**发出下架通知 → **不承担责任**
 - 恶意反通知 → **惩罚性赔偿**



SPC- 12 September 2020 最高法 – 2020年9月12日

- **SPC Guiding Opinion on the Trial of Civil IP Rights Cases involving E-commerce platforms**
 - Explains "knows of should know" infringing activity
 - **Take down notice** rules should **not impose unreasonable conditions**
 - Proof of IP Holder identity / IP right / infringement
 - For **Designs** and Utility Models → may require an **evaluation report**
 - Bad faith take down notice / bad faith counter notice explained
 - Possibility to apply for **injunction to stop deletion measures** and reinstate link
- **最高法关于审理涉电子商务平台知识产权民事案件的指导意见**
 - 对“知道或应该知道”平台内经营者侵害知识产权的情形予以解释
 - **不得对发出下架通知设置不合理的条件或者障碍**
 - 知识产权权利证明及权利人的真实身份信息
 - 实用新型或者外观设计专利维权 → 可能需要**评价报告**
 - 对恶意发出错误通知/恶意发出声明（反通知）予以解释
 - 可以向法院申请采取**保全措施**，要求**通知人撤回或停止发送通知**，并恢复商品链接



Jurisprudence before the E-Commerce Law

电子商务法施行前的司法实践

- **Beijing IP Court 2017 : Discovery Communications vs. Zhongshan Discovery Outdoors Products**
 - Discovery owns the trademark **DISCOVERY EXPEDITION** (cl18 and 25)
 - Zhongshan uses DISCOVERY ACTIVE on outdoor products → Opens a store "OFFICIAL FLAGSHIP STORE OF DISCOVERY OUTDOORS on JD.
 - Discovery asked JD to close the store → no response
 - JD's rule about "official" flagship stores :
 - The seller must be the registrant of the brand
 - Being an authorized dealer is not sufficient
 - **Court : JD did not verify** position of Zhongshan → **JD committed contributory infringement**
 - (appeal confirmation in 2019)
- **北京知识产权法院（2017年）：Discovery Communications诉中山市探索户外用品有限公司（简称“中山户外”）**
 - Discovery系商标**DISCOVERY EXPEDITION**（18类、25类）权利人
 - 中山探索在其户外用品使用DISCOVERY ACTIVE商标 → 在京东平台开设“Discovery户外用品官方旗舰店”
 - Discovery要求京东关停商家网店 → 未获回应
 - 京东关于“官方”旗舰店的规定：
 - 商家主体必须系品牌注册人
 - 授权经销商不满足开设“官方”旗舰店的条件
 - **法院：京东未核实中山户外主体身份，构成共同侵权**
 - （2019年：驳回上诉，维持原判）

- The case was based on **Article 36 of the Tort Law (2010)**
 - **Internet users and internet service providers shall bear tort liability** if they utilize the internet to infringe upon civil rights of others.
 - If an internet user commits tort through internet services, **the infringed shall be entitled to inform the internet service provider to take necessary measures**, including, inter alia, deletion, blocking and disconnection. **If the internet service provider fails to take necessary measures in a timely manner upon notification, it shall be jointly and severally liable** with the said internet user for the extended damage.
 - If an internet service provider is **aware** that an internet user is infringing on the civil rights and interests of others through its internet services and **fails to take necessary measures**, it shall be jointly and severally **liable** with the said internet user for such infringement.
- 本案以**侵权责任法（2010年）第36条**为依据
 - **网络用户、网络服务提供者**利用网络侵害他人民事权益的，**应当承担侵权责任。**
 - 网络用户利用网络服务实施侵权行为的，**被侵权人有权通知网络服务提供者采取删除、屏蔽、断开链接等必要措施。**网络服务提供者接到通知后未及时采取必要措施的，对损害的扩大部分与该网络用户**承担连带责任。**
 - **网络服务提供者知道**网络用户利用其网络服务侵害他人民事权益，**未采取必要措施的**，与该网络用户**承担连带责任。**

Beijing IP Court (2017) 北京知识产权法院 (2017)

This decision corresponds to the definition of "**should know**" in the *Guiding Opinion* of the SPC (2020) :

“Article 11. If the operator of e-commerce platform is in one of the following circumstances, the people's court may determine that such operator "should know" the existence of the infringement:

.....

(2) **Fail to examine the right certificates of the operator of a “Flagship Store” or “Exclusive Store of certain brand”.**

该决定符合最高法指导意见（2020）中关于“应当知道”的定义：

十一、 电子商务平台经营者存在下列情形之一的，人民法院可以认定其“应当知道”侵权行为的存在：

.....

（二）未审核平台内店铺类型标注为“旗舰店”“品牌店”等字样的经营者的权利证明。

Jurisprudence

After the E-Commerce Law

电子商务法施行后的司法实践

- IP Key study on Online counterfeit in China : *Could the EU Memorandum of Understanding approach help, and if so, how ?* November 2019
 - Since January 2019 :
 - 33 cases under the E-Commerce law
 - 21 relating to E-Commerce platforms
 - 5 involved sale of counterfeit goods (no foreign-related cases)
- 关于中国网络假冒产品的IP Key研究： 欧盟谅解备忘录做法是否有助打击假冒？如是，通过何等方式？(2019 年 11 月)
 - 2019年1月以来
 - 由电子商务法规制的33起案件
 - 21起涉及电商平台
 - 5起涉及销售假冒商品（无涉外案件）



Jurisprudence

After the E-Commerce Law

电子商务法施行后的司法实践

- Jiangsu High Court : **no evidence** that **Alibaba** knew or should have known
- Zhejiang Intermediate Court : **liability of Taobao denied**
- Wuhan Intermediate Court : **liability of Taobao denied**
- 江苏高院： **没有证据**表明**阿里巴巴**知道或应当知道
- 浙江中院： **淘宝不承担责任**
- 武汉中院： **淘宝不承担责任**



CONCLUSION

结 论

MOU is based on trust

- If a right owner, signatory of the MoU, sends a Notice → immediate action. No likely bad faith. No likely counter notice

E- Commerce is based on balance of rights (right owner/seller)

谅解备忘录以信任为基础

- 权利人（谅解备忘录签署人）发出通知 → 立即采取措施。恶意通知、反通知几率较小。

电子商务以权利对等为基础（权利人/商家）

THANK YOU !
感谢!