



European
Commission

Case Study: Taking Down Counterfeit Products on Amazon Mexico

LATIN AMERICA
IP SME HELPDESK

✓ Background

Boost2Party S.L. is a Spanish SME dedicated to online selling of costumes, accessories and party decorations. With their own online shop and running in 10 European countries, they decided on expanding to Latin America. First in their list was Mexico, and to save costs, they opted for using the online market platform, Amazon.

Following a similar IP strategy as in the EU, they applied for a trade mark in Mexico and extended their surveillance to this country. A couple of months after, they found on Amazon Mexico a list of counterfeit costumes and accessories that looked almost identical to theirs.

⚙️ Actions taken

The Spanish SME contacted an IP expert who informed them that Amazon counts with an internal online mechanism called “**report infringement**”, only available for registered sellers who can demonstrate that they are the IP owners. Taking this into account, the company was advised to submit a notice of infringement air-tight and supported by their Mexican trade mark application. Without a trade mark application or registration, the SME would have required further legal actions in court.

To submit a report infringement to Amazon, the Spanish SME had to fill in an online form, providing the following data:

- Company’s information, including contact details and a statement including proof of their IPRs (trade mark application record; trade mark registration record; etc.)
- Their ASIN (Amazon Standard Identification Number), or the URL of the products they reported; and
- A description of how the infringement had taken place. This is done by categorizing the type of infringement, e.g., counterfeiting, trade mark abuse, design abuse or copyright.

Additionally, once the company had a final trade mark registration in Mexico, the IP expert recommended them the following protective measures:

- To apply for the Amazon’s Brand Registry program (available in Mexico and Brazil), as Amazon collaborates with some National Trademark Offices, making it easier to monitor and remove suspected infringing content.
- To inform custom authorities about their products and trade marks, because if counterfeit products are found online, it is likely they might also be circulating in the physical market.

📊 Outcome

Having submitted a solid report infringement, the online platform sent a warning to the infringer. They were given the chance to dispute the claim, which they did not. Then, Amazon removed the infringing listing of products.

Besides, once the trade mark was registered in Mexico, the company decided to incorporate the recommendations of the expert into their IP strategy to avoid future potential infringements. Accordingly, they applied for the Amazon’s Brand Registry program and informed customs authorities as protective IP measures.

📖 Lessons learned

- Trade marks are territorial, so think globally: before offering your products on an online platform, make sure you have at least a trade mark application for that country, preferably a trade mark registration.
- Bear in mind that only registered trade marks provide full coverage when running a business online and offline in the country of interest.
- Check whether the online platform where you want to sell your products offers an internal procedure for IPRs violations. This could save you tons of money and time.

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