

Good Morning!

In-House Perspective

BIC GC: E-Commerce Platforms Accelerate IP Rights Infringements

As general counsel for BIC Corporation, Steve Burkhart leads the family-owned company's efforts to stop counterfeit products from proliferating across a growing number of e-commerce platforms. He shared insights on how his team stays ahead of the threat, and what other general counsel can do to safeguard their company's intellectual property rights.

BIC recently filed a lawsuit to stop importation of knock-offs. What can you tell us about the status of the lawsuit, and how do you stay apprised of counterfeit breaches by third-party sources?

The cases were filed in the U.S. International Trade Commission and the U.S. Federal District Court for the Eastern District of New York in December 2018. Defendants have been served and the discovery process is underway. In the coming months we are confident we will prove our case against the manufacturers of the Chinese-made, knock-off pocket lighters, and those U.S. companies that import and sell them.

BIC has taken a leadership role in our industry to combat counterfeit and gray market goods, as well as the illegal transportation of hazardous material consumer goods. We are actively involved with the International Consumer Product Health and Safety Organization. I serve on [the ISO technical committee] for lighters, and am immediate past chairman of the board of the Product Liability Advisory Council. These groups, along with others that BIC supports, are important resources for any general counsel seeking to protect a company's intellectual property rights.

What impact are e-commerce platforms having on the proliferation of counterfeit products — particularly hazardous knock-offs under the guise of “consumer products” — and how are you and your team mobilizing to stay ahead of this development?

IP rights infringements and counterfeit goods have always presented challenges, but e-commerce platforms compound the problem. These platforms enable the distribution of more infringing and otherwise illegal products than ever before, creating an even greater threat to consumers.

As a consumer product company, we employ global surveillance resources that [use] proprietary algorithms to conduct weekly investigations of e-commerce sales platforms, along with traditional monitoring of brick-and-mortar wholesalers and retailers to protect the integrity of our brand and IP, and of course the well-being of consumers. For BIC, protecting consumers from counterfeit knock-offs literally means looking out for their safety.

BIC will always take aggressive action against companies that attempt to piggyback off our success, especially when those companies manufacture sub-par, dangerous products that threaten the safety of our consumers. As these lawsuits demonstrate, we will exhaust every possible remedy to fight for what is right.

With nearly 26 years of experience with BIC, what are you most excited about tackling next?

BIC is a family business with highly skilled and dedicated employees, and a global brand that stands for quality and safety for all. My marching orders are the same today as they were when I was hired nearly 26 years ago — always do right by our consumers, customers, employees, and shareholders. Such direction is easy to respect and empowers the legal team to help develop and enforce the law.

Business is moving faster than ever, and the law evolves slowly. At BIC, the lawyers not only see the changing business landscape, we see how the law needs to respond to those changes. We share our views with business colleagues, and industry and government leaders. We are extremely proud of the respect we enjoy from our colleagues inside and outside the company for the counsel we provide on many legal issues, like IP, counterfeit and gray good products, transportation, and other product-related liabilities, [and] product safety, to name a few.

Our counsel to the company comes with an important responsibility — when we are right, we fight. As a lawyer, who wouldn't be excited to have a client like that?