

ACTIONABLE INTELLIGENCE SPECIAL REPORT:

Canon Keeps Pressure on Vendors Selling Infringing Cartridges Online



It's been over five years since Canon Inc. first announced that it was working with Amazon to remove toner cartridges that infringe its intellectual property (IP) from the enormous e-commerce platform. What started with the removal of a couple of obscure third-party cartridge brands from Amazon.com in the United States has grown to the takedown of tens of thousands of listings from Amazon sites around the world, including sites across Australia, Europe, and North America.

While we know that printer original equipment manufacturers (OEMs) like Brother, Epson, HP, and others have had products removed from Amazon for violating their IP, Canon is by far the most vocal about the takedowns it initiates. Although we cannot say for certain, we also suspect that the firm has initiated the greatest number of removals. Most of these takedowns involve the removal of third-party toner cartridges. As the supplier of many of the printing technologies found in HP LaserJet machines, Canon holds most of the patents related to LaserJet units and the toner cartridges used in them. The company routinely announces the removal of Amazon Standard Identification Numbers (ASINs) for third-party toner cartridges designed for use in an assortment of HP LaserJet devices.

Canon's effort to rid global markets of products that violate its IP is neither exclusive to Amazon nor to cloned HP LaserJet SKUs. Rather, the Amazon takedowns can be seen as part of a broader IP protection strategy. The firm routinely initiates takedowns on other online marketplaces, including sites like Alibaba, TMall, and others in China. Canon also works with its stakeholders and various authorities to identify and seize counterfeit goods. In addition, the company uses the courts and other governmental agencies to ensure its IP-holder rights are not violated.

Amazon Takedowns

Canon says that in June 2018 it began removing from Amazon LaserJet compatible toner cartridges that infringe its patents. The first public announcement of the activity that we're aware of came in September 2018.

For more information about Canon's initial takedowns, see the 136-page Actionable Intelligence whitepaper released in July 2020. "[Canon Grows Toner Cartridge Takedown Tally on Amazon](#)" offers a comprehensive view of the first two years of Amazon takedowns. The report provides a breakdown of Canon's Amazon takedown announcements by country and date and includes the patents asserted as well as each listing removed.



Canon had announced that over 36,000 patent-infringing LaserJet compatible toner cartridge SKUs had been removed from Amazon sites in 14 countries.

Canon's campaign ramped up quickly, and it was soon issuing weekly statements that identified which sellers' toner cartridges had been removed, what patents were allegedly violated, and in what countries. The company limited its takedown announcements to quarterly starting halfway through 2021, although it seems to make exceptions when asserting a new patent that hasn't been involved in a previous Amazon takedown. We routinely see Canon make a one-time announcement that lists the seller and the patent being asserted, which marks the first time the patent has been used in an Amazon removal. Recent announcements have also shared the brands of the infringing cartridges that have been removed. According to our last count, which was made in late October 2023, Canon had announced that over 36,000 patent-infringing LaserJet compatible toner cartridge SKUs had been removed from Amazon sites in 14 countries: Australia, Belgium, Canada, France, Germany, Italy, Mexico, the Netherlands, Poland, Spain, Sweden, Turkey, the United Kingdom, and the United States.

Amazon is stepping up its ability to identify sellers that ignore its rules and sell products using fraudulent or deceptive means. In April, Amazon released its third annual Brand Protection Report detailing how the company protects customers, brands, and selling partners. Amazon has seized counterfeit products that infringed trademarks belonging to BMW, Hugo Boss, Lacoste, Under Armour, and other premium brands. Through initiatives like its Brand Registry and the Transparency program, Amazon now provides an assortment of tools and services for IP holders to identify and remove products alleged to be violating patents, copyrights, and trademarks.

Most products sold on Amazon originate in China so Chinese manufacturers producing infringing goods have become of particular concern for Amazon. This concern is heightened by the so-called *shanzhai* culture in China's industry, which allows skills and techniques for cloning IP-protected goods to be shared among manufacturers through open-source networks. The practice of *shanzhai* in China's third-party supplies industry is evident by the swiftness with which certain companies bring to market new ink and toner cartridges. Actionable Intelligence is aware of Chinese knockoffs being available on Amazon within a day of the release of the OEM's original cartridge.

It appears that Amazon is increasingly working with IP holders selling consumables. The firm recently teamed up with Lexmark and Xerox to file suit in the United States against counterfeiters selling fake toner cartridges. It filed a similar action in Germany along with Brother. Amazon also filed suit against counterfeiters selling bogus Canon camera batteries in the United States.

The removal process Canon uses seems to vary by country. Most often, Canon files an infringement report with Amazon requesting the removal of certain toner cartridges.

However, the firm may also contact the Amazon seller directly with an informational letter before an item may be considered for removal. In some instances, Canon will submit reports to Amazon using the Amazon Reporting Tool. According to Canon, “The ‘Amazon Reporting Tool’ is a service offered by Amazon and does not encompass any official finding of validity or infringement of a patent.” The information letters and reports describe why Canon believes a product should be taken down.

Canon’s Busy

Like it did with Brother, Lexmark, and Xerox, Amazon teamed up with Canon in 2023 to jointly file a trademark-infringement lawsuit in the United States against 29 Amazon sellers for peddling counterfeit Canon camera batteries and chargers. The lawsuit was filed on May 10 in federal court in Washington State. The plaintiffs in the suit seek a permanent injunction against the defendants, damages, interest, attorneys’ fees, and court costs. The filing detailed how Amazon tries to keep counterfeits off its site and how sellers including the defendants must agree that the sale of counterfeit goods is a “deceptive, fraudulent, or illegal activity.” It also explained how Canon fights counterfeiting and protects its IP.

Canon, of course, also protects its IP via litigation it files on its own. In 2022, the company initiated a lawsuit against 52 Chinese defendants that sell products on Amazon, eBay, and Wish.com for marketing counterfeit Canon inkjet print heads and camera components such as batteries, chargers, and lens caps. The case moved quickly and about half of the defendants acknowledged the validity and enforceability of Canon’s trademarks and agreed to immediately cease and desist from selling counterfeit products. Nearly two dozen of the Chinese companies, however, defaulted, and the court awarded Canon \$11.5 million in damages after finding the defendants infringed Canon’s trademarks via the sale of counterfeit Canon products on large online marketplaces such as Amazon and eBay.

Over the past couple of years, counterfeiters in China have developed new tactics to get their fake products into the United States, so Canon has developed new approaches to stop the sale of these Chinese counterfeits. Rather than ship directly to consumers, China-based counterfeiters increasingly send their goods in bulk to large fulfillment warehouses in the United States, which makes the infringing products harder to detect. The Chinese goods are then shipped from the warehouse to consumers. Early in 2022, Canon indicated that it had convinced one of China’s leading logistics and fulfillment companies to stop shipping products marketed by China-based counterfeiters. Canon did not identify the fulfillment company at the center of the matter but did say it had reached a settlement agreement with the company, and the logistics firm agreed to cease distribution of infringing Canon products to U.S. consumers.

Canon is also stepping up its IP-enforcement efforts within China. In 2021, the firm announced that it had prevailed in a long-running case that originated at the Beijing Intellectual Property Court and ended with a favorable ruling from China’s Supreme Court. Canon filed suit initially in 2017 in the Beijing Intellectual Property Court against three companies affiliated with China’s CET Group. In 2020, a fourth defendant, Zhongshan Tiantong Printer Consumables, was added. Alleging that certain HP compatibles from the defendants violated Chinese patent ZL200880003520.0, Canon won its case at the Beijing Intellectual Property Court in July 2020. The court then ordered the four defendants to cease their infringement and compensate Canon an undisclosed amount in damages. The defendants appealed the judgment to China’s Supreme Court, which in November 2021 upheld the IP court’s ruling.

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In 2022, Canon once again asserted Chinese patent ZL200880003520.0. In this matter, Canon used the patent to have infringing products removed from Tmall.com, the enormous consumer online marketplace operated by the Alibaba Group in China and formerly known as Taobao Mall. The Tmall.com removals came after Canon filed complaints with the Alibaba Intellectual Property Protection Platform against three sellers—Befon, Goodream, and Jinwensm. Canon found that all three were selling infringing color toner replacement cartridges employed in various HP Color LaserJet devices. The infringing compatibles removed from Tmall.com included replacements for the HP CE310A, CE311A, CE312A, and CE313A cartridge series and the HP CF350A, CF351A, CF352A, and CF353A series.

The removal of the Befon-, Goodream-, and Jinwensm-branded HP compatible toner cartridges from Tmall.com is the first instance that we know of where Canon initiated takedowns on this ecommerce platform. These takedowns were not the last, however. In October 2023, Canon indicated that it was working to have infringing toner packs taken off Tmall.com and other sites in China, including 1688.com and JD.com. The ecommerce sites were alleged to have offered compatible infringing versions of the HP W1580A and W1580X toner reload kits. These kits are sold exclusively in China and India and are used in the HP LaserJet Tank 1602 series, 1604 series, 2602 series, 2603 series, 2604 series, 2605 series, and 2606 series. Canon alleged six brands on the Chinese sites, including Gezhige, Gowin, iBEST, Jingcheng, NAINUO, and V4Ink, had violated the OEM's Chinese Design Patent Number ZL202230121386.7. According to the company, after the Chinese sites were notified that they were marketing infringing products, the accused reload kits were removed.



Canon successfully asserts its IP protections in court and after winning the case the firm then begins hunting online for third-party products that violate the IP in question.

Tried-and-True Strategy

Although Canon has developed certain new legal tactics, especially in China, from what we can see the firm's overall legal strategy isn't changing. Like we witnessed with the TMall.com takedowns, first Canon successfully asserts its IP protections in court and after winning the case the firm then begins hunting online for third-party products that violate the IP in question. Asserting its patents on A4 toner cartridges or sometimes A3 toner containers, Canon has won or settled many infringement suits in courts in Europe, Russia, and the United States, as well as in China. Once the case is resolved, takedowns on Amazon and other online marketplaces follow—sometimes for years.

Consider European patent 2087407 (EP '407), which was granted in 2013 and covers Canon's dangle-gear drive mechanism found on an assortment of LaserJet toner cartridges. Canon first asserted the patent in Europe in a string of separate lawsuits filed in France, Germany, the Netherlands, and the United Kingdom in 2014 and later in Italy. The defendants in the suits included some of Europe's leading third party-supplies vendors such as Armor, KMP PrintTechnik, Turbon AG, and many others. Although the exact outcome of every single case isn't clear, we do know that in time they were settled. Canon then began signing cease-and-desist declarations with various European Amazon sellers that agreed to remove the infringing products they were selling. Since Canon began announcing Amazon takedowns in 2018, the firm has alleged EP '407 to have been violated by an assortment of products sold on Amazon sites across Europe, which have been removed as a result. As recently as April 2023, Canon has reported that cartridges were removed from Amazon sites in certain European countries because they infringed EP '407 patent.

Canon continues to use dongle-gear patents to remove infringing products from Amazon sites.

Canon has asserted similar patents in the same manner in other regions and achieved similar results. In the United States, for example, there were Amazon.com takedowns after the company alleged violations of one or more of the following U.S. patent numbers: 8,280,278 (US '278), 8,630,564 (US '564), 8,682,215 (US '215), 8,688,008 (US '008), and 8,676,090 (US '090). Like EP '407, the patents covered Canon's dongle gear and were used for Amazon takedowns into 2023. In Australia, Canon has asserted another dongle-gear patent, Australian Patent Number AU2014208277, for Amazon removals as recently as 2021.

Recent Takedowns

As noted, Canon continues to use dongle-gear patents to remove infringing products from Amazon sites, and it has also added to the list of patents it has been asserting. The table below lists the Canon patents used to remove infringing third-party LaserJet cartridges from various Amazon sites since 2020 up to the writing of this report.

Amazon Takedowns By Country and Patent (July 2020-October 2023)

Type of patent	Country where takedowns occurred	Patents asserted	Quarters takedowns occurred*													
			Q3 2020	Q4 2020	Q1 2021	Q2 2021	Q3 2021	Q4 2021	Q1 2022	Q2 2022	Q3 2022	Q4 2022	Q1 2023	Q2 2023	Q3 2023	
Australian	Australia	2,014,208,277	✓	✓	✓											
		2,007,205,464	✓	✓	✓											
Canadian	Canada	2,635,791	✓	✓	✓	✓			✓	✓	✓	✓	✓	✓	✓	
		2,910,527	✓	✓	✓	✓			✓	✓	✓	✓	✓	✓	✓	
European	Belgium, Poland, Sweden	2,087,407												✓	✓	
		1,977,289												✓	✓	
		2,137,577												✓	✓	
		3,470,931												✓	✓	
		3,270,230												✓	✓	
	France, Germany, Italy, Spain, United Kingdom	2,087,407	✓	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓
		1,977,289	✓	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓
		2,137,577			✓	✓				✓	✓	✓	✓	✓	✓	✓
		3,470,931								✓	✓	✓	✓	✓	✓	✓
		3,270,230								✓	✓	✓	✓	✓	✓	✓
	Netherlands	2,087,407			✓	✓				✓	✓	✓	✓	✓	✓	✓
		1,977,289			✓	✓				✓	✓	✓	✓	✓	✓	✓
		2,137,577			✓	✓				✓	✓	✓	✓	✓	✓	✓
		3,470,931								✓	✓	✓	✓	✓	✓	✓
		3,270,230								✓	✓	✓	✓	✓	✓	✓
	Turkey	2,087,407	✓		✓	✓				✓						
		1,977,289	✓		✓	✓				✓						
		2,137,577			✓	✓				✓						
		3,470,931								✓						
		3,270,230								✓						
Mexican	Mexico	308,881	✓	✓	✓	✓			✓	✓	✓	✓	✓	✓	✓	
		317,598	✓	✓	✓	✓			✓	✓	✓	✓	✓	✓	✓	
US	United States	8,280,278	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		8,630,564	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		8,682,215	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		8,688,008	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		8,676,090	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		8,588,646	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		9,581,958	✓	✓	✓				✓	✓	✓	✓	✓	✓	✓	
		11,169,483									✓	✓	✓	✓	✓	
		11,156,954										✓	✓	✓	✓	
		11,199,807											✓	✓	✓	
11,314,199												✓	✓			

*Note that Canon did not provide separate tallies for Q1 2020 or Q2 2020 Actionable Intelligence, based on information provided by Canon

After successfully settling patent disputes in Germany with various third-party suppliers vendors involving European Patents 1977289 (EP '289), 2087407 (EP '407), and 2137577 (EP '577), Canon has used these patents to remove infringing LaserJet products from certain Amazon sites in Europe. In 2022, the firm also began asserting European patents 3470931 (EP '931) and 3270230 (EP '230) to initiate takedowns in various European Union member states. In 2023, the OEM continued asserting the five patents as it expanded its takedowns to include Amazon sites in Belgium, Poland, and Sweden. See the table on the previous page for a complete list of countries.

In the United States, Canon reports that third-party toner cartridges removed from Amazon.com (Amazon USA) infringed one or more of eleven patents. In addition to the five U.S. patent numbers noted above, which are related to Canon's dongle gear, the firm has asserted 8,588,646 (US '646), 9,581,958 (US '958), 11,169,483 (US '483), 11,156,954 (US '954), 11,199,807 (US '807), and 11,314,199 (US '199) in its takedowns. Canon has been asserting the US '646 and US '958 patents since 2019 and it first asserted US '483 in 2022 to remove infringing products from Amazon.com.

Canon began asserting new claims on three additional patents in the United States during 2023. In January, Canon requested that Amazon remove listings for various brands from Ninestar and its affiliates for violating US '954. In June, the OEM asserted US '807 for the first time, and once again requested that Amazon remove listings for toner cartridges from Ninestar and its subsidiaries sold under various brands, including Valuetoner, myCartridge, and MYTONER. It also requested that Amazon remove the products sold under brands such as Amstech, Aztech, TRUE IMAGE, and others affiliated with Aster Graphics. More were also removed for violating the same patent sold under brands from manufacturers that we cannot identify. In July, Canon announced 18 ASINs associated with various Aster Graphics brands had been removed from Amazon for violating US '199, which was issued to Canon in April 2022.

In addition to keeping a close eye on Amazon's flagship site in the United States, Canon has been monitoring North America's two other sites: Amazon.ca and Amazon.com.mx. The first takedowns on Amazon's Mexican site that we are aware of came in 2020 after Canon asserted Mexican patent numbers 308,881 and 317,598 to remove infringing aftermarket toner cartridges. Canon has been removing infringing toner cartridges from Amazon in Canada since 2019. Canon has asserted its Canadian patents 2,635,791 (CA '791) and 2,910,527 (CA '527) for the past several years to remove infringing product from Amazon.ca.

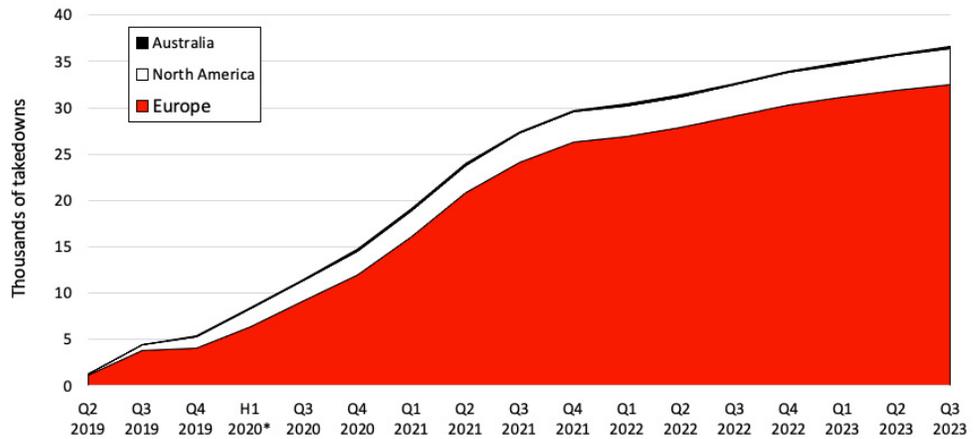
Signs of Success

It's clear from Canon's large number of takedowns that the firm continues to closely monitor Amazon sites worldwide. The number of removals from the giant e-commerce marketplace peaked a couple of years ago, suggesting that Canon is finding fewer infringing LaserJet compatibles are being listed on Amazon. Regardless, the accumulated total number of takedowns continues to grow as the firm asserts new patents and maintains its efforts to rid Amazon of products that violate Canon's IP.

Looking at the most recent numbers, Canon says during Q3 2023 it used the Amazon reporting tool, letters of inquiry, and/or information to take down 647 listings from Amazon in Belgium, France, Germany, Italy, Poland, Spain, the Netherlands, Sweden, and the United Kingdom. Of these nine countries, three are recent additions. Canon expanded its Amazon takedown activities to Sweden, Poland, and Belgium in Q2 2023 and the firm continued to monitor and have infringing products removed in Q3.

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Canon's Accumulated Amazon Toner Cartridge Listing Removals (Q2 2019-Q3 2023)



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Canon has removed fewer infringing LaserJet cartridges from Amazon over the past couple of years, but it is clear given the recent activity in Europe and the United States that the firm isn't growing any less aggressive when asserting its IP rights.

During the same period in North America, Canon used Amazon's reporting tool to remove 127 infringing third-party toner cartridge listings from Amazon in Canada, Mexico, and the United States. Although this marks a 41 percent decrease from the 214 listings removed in Q2 2023, Canon reported a significant surge in takedowns in Q2 2023 as it began to use some new patents for removals. The 127 removals in Q3 2023 is higher than the number of cartridges removed in any quarter other than Q2 2023 going back as far as Q4 2021.

Adding the total Amazon takedowns in North America to those in Europe through Q3 2023, we get a total of 36,404 listings removed in the two regions. While there have been no takedowns of infringing third-party LaserJet toner cartridges from Amazon in Australia since the end of 2020, Canon had removed a total of 198 toner cartridge listings from Amazon in Australia by that point. Including that figure, Canon's total takedowns are 36,602 listings removed across all 14 countries since June 2018.

Beyond removing tens of thousands of infringing products from Amazon, Canon has also notched some significant legal victories over the past few years. In addition to filing suit along with Amazon against sellers marketing counterfeit batteries on the marketplace, early in 2023 Canon filed its own patent-infringement lawsuits in Germany and the United States against the Chinese manufacturer Print-Rite and several subsidiaries including its distributor UTec. In the U.S. court, Canon accused the defendants of violating US '483, and in Germany it said that Print-Rite and its subsidiaries infringed EP '931. As noted above, Canon had successfully asserted both patents in its unrelated Amazon takedowns. In September 2023, Canon announced that the case had been settled. According to the firm, Print-Rite and its affiliates acknowledged that they violated the assert patents and agreed to pay Canon an undisclosed amount to compensate the OEM.

Canon also announced the successful conclusion of a major ongoing case this year. After suing third-party supplies makers and sellers in 2021 for violating patents on the toner containers used in imageRUNNER MFPs, the matter was concluded in 2023 with a district court entering consent judgments and permanent injunctions against Ninestar, Static Control Components, Easy Group, LD Products, and the Supplies Guys. In addition to the district court lawsuits involving containers for imageRUNNER MFPs, Canon also initiated parallel Section 337 investigations before the U.S. International Trade Commission (ITC), which resulted in general exclusion orders (GEOs) being awarded to the OEM in 2022.

Our Thoughts

Canon has removed fewer infringing LaserJet cartridges from Amazon over the past couple of years, but it is clear given the recent activity in Europe and the United States that the firm isn't growing any less aggressive when asserting its IP rights. Canon routinely engages courts and other governmental agencies to enforce its IP protections and punish firms deemed to have violated its IP. After prevailing in the courts, the company often leverages the lawsuits it wins to request product removals from Amazon as well as other ecommerce sites.

Canon's recent legal victories will no doubt result in additional takedowns. We are not expecting to see a sudden spike in takedowns, however. There's a good possibility that the word is getting out within the Amazon seller community that there are risks involved with selling products that violate Canon's IP. For those sellers that continue to take the risk, Canon appears to be vigilant so while there may not be a surge of takedowns we expect to continue to write about additional removals of HP compatibles and other products that encroach on Canon's IP.



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