

INTA OFFERS GUIDE FOR COMBATING COUNTERFEIT SALES

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As retailers continue to battle the escalating problem of counterfeit products, The International Trademark Association (INTA) has released a guide titled *Addressing the Sale of Counterfeits on the Internet*. The guide is the product of INTA's Anti-Counterfeiting committee and aims to further the organization's continuing efforts to curb the problem of online sales of counterfeit goods.

According to a 2017 impact study commissioned by INTA and cited in the guide, the global value of counterfeit and pirated goods was estimated to be \$1.13 trillion in 2013 and is projected to reach \$1.9-\$2.8 trillion in 2022. Counterfeit sales not only harm businesses, but pose a risk to public health and safety and often fund criminal organizations.

INTA's guide includes updated and expanded best practices for search websites, online market places, PSPs, trademark owners, and social media, logistics, and registry companies. The guide also includes the following key recommendations:

- **Search advertising services** should have a clear and effective complaint process publicly available to report counterfeit ads.
- To the extent that there are legal frameworks applicable to removal of content on search engines and the legal grounds implicate behavior used by counterfeiters, **search engines** should provide an efficient process for parties to submit removal requests.
- **Online trading platforms** should strengthen and streamline procedures for identifying and taking more effective action against repeat offenders, as well as tighten repeat offender policies.
- **Payment service providers** should have in place policies prohibiting the use of their services for the purchase and sale of goods that are determined to be counterfeit under applicable law.
- **Trademark owners** should take steps on an ongoing basis to educate online platforms, other intermediaries, and the public as to their trademarks, as well as to actively monitor offers on

online marketplace, shopping, and social media platforms, with the aim of identifying counterfeits, and should notify the platforms and payment service providers if applicable.

- **Social media sites** should have a clear and effective process publicly available to deal with the sale and offering of counterfeit products.
- **Registrars and registries** should adopt, publish, and enforce intellectual property rights policies and effect appropriate due diligence to address and minimize misuse of their services, which they will clearly communicate and indicate on their sites and include in the contracts and terms of service that they conclude with their customers.
- **Logistics companies** should have simple procedures in conformity with the applicable laws of the respective jurisdictions for the sharing of information with enforcement agencies and trademark owners investigating counterfeiting activities and should have mechanisms in place for blacklisting consignors/consignees found to be involved in counterfeiting activities.

RELATED PRACTICE AREAS

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