



American Intellectual Property Law Association

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Coke Morgan Stewart
Acting Under Secretary of Commerce for Intellectual Property and Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
Mail Stop OPIA, P.O. Box 1450
Alexandria, VA 22314

Re: AIPLA Comments on the OECD's Working Party on Countering Illicit Trade (WP-CIT) Draft Voluntary Guidelines for Countering Illicit Trade in Counterfeit Goods on Online Marketplaces [Docket No.: PTO-C-2025-0016]

Dear Director Stewart,

The American Intellectual Property Law Association (AIPLA) appreciates the opportunity to provide comments on the OECD's Working Party on Countering Illicit Trade (WP-CIT) Draft Voluntary Guidelines for Countering Illicit Trade in Counterfeit Goods on Online Marketplaces (the "Guidelines"). We understand that the Guidelines have the purpose of offering an international, voluntary, and non-binding framework based on best practices to support efforts to curb counterfeit trade online. With respect, we submit our comments to the Guidelines for your consideration.

Founded in 1897, AIPLA is a national bar association of approximately 6,500 members, including professionals engaged in private or corporate practice, in government service, and in the academic community. AIPLA members represent a wide and diverse spectrum of individuals, companies, and institutions involved directly or indirectly in the practice of patent, trademark, copyright, trade secret, and unfair competition law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property. Our mission includes helping establish and maintain fair and effective laws and policies that stimulate and reward invention while balancing the public's interest in healthy competition, reasonable costs, and basic fairness.

General Overview:

The Guidelines represent a significant effort to create a comprehensive guide delineating best practices to mitigate the sale of counterfeit goods on online marketplaces for three primary stakeholders: Governments, Online Marketplace Operators, and Rights Holders. Below is a detailed review with comments recommending improvements or clarifications where needed. For ease of reference, the comments are organized in the context of the Guidelines. The absence of comments on any part or provision does not reflect support or lack of support of this part by AIPLA.

2.1 Introduction

Recommendations:

For clarity, consider revising Paragraph 14 to read: “The guidelines cover trade in counterfeit trademarked goods on online marketplaces, focusing on physical goods. Nothing, however, precludes the principal stakeholders from extending the scope of the guidelines to ~~trade in~~ **include** virtual goods or to other forms of intellectual property right infringement, such as ~~infringement of copyrights and/or industrial design rights~~ **counterfeit goods that may also infringe copyright or industrial design rights**. Possible extension of the scope of the guidelines to the other areas could be considered in future reviews of the guidelines.”

2.2. Definitions

Overview:

- The definitions provided in Section 2.2 are appropriate, align with common understandings of the terms, and are easy to follow.
- For clarity, and to ensure reference to the definition section, defined terms should be capitalized throughout the document.

Recommendations:

- Consider using COUNTERFEIT TRADEMARK GOOD instead of COUNTERFEIT GOOD and then using the definition provided in TRIPS, namely: “COUNTERFEIT TRADEMARK GOODS are any goods—including packaging—that bear, without authorization, a trademark that is identical to, or cannot be distinguished in its essential aspects from, a trademark validly registered in respect of those goods in the country of importation.” See ARTICLE 51, n.14, WTP Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS).
- Consider revising the term “REPEAT INFRINGER” to read “REPEAT COUNTERFEITER” to maintain the focus of the Guidelines on counterfeiting. Also, revise the definition by striking “counterfeit goods” and replacing it with “Counterfeit Trademark Goods”.
 - If this change is adopted, this term should be updated throughout the Guidelines (i.e., in the heading of Section 3.2, Section 3.3.22.b.ii, the heading of Section 4.1.4, Section 4.1.4.36.c, Section 4.1.4.36.c.iii, Section 4.1.4.36.d, and the heading of Section 5.1.2).

3. Guidelines for Governments

3.2. Repeat infringers

Overview:

- This section calls for Governments to work directly with Online Marketplace Operators and Rights Holders to identify and act against parties engaged in repeated, confirmed counterfeit sales, including support for registers or watch lists that track entities that engage in, facilitate, or benefit from trade in counterfeit goods.

Recommendations:

- Add a guideline suggesting that Governments promote and support a website that hosts resources that educate the public regarding the extent, effects, and harms of illicit trade in counterfeit goods and provide means for the public to report repeat counterfeiters.

- Consider providing clearer, objective guidance on defining what constitutes a “Repeat Counterfeiter” (e.g., number of confirmed counterfeiting violations within a defined time period). Consider whether this definition and any associated thresholds should be set at the Government level, so that they are applied consistently across all marketplaces, at the Online Marketplace Operator level, or through a combined approach. Transparency of the chosen approach should be strongly encouraged.

3.3. Enforcement and sanctions

Overview:

- This section calls for robust, dissuasive civil and criminal penalties for online counterfeiting, coordinated enforcement within and across jurisdictions, and sanctions on online marketplaces that establish a pattern of not expeditiously removing counterfeit listings.

Recommendations:

- Include a list of suggested sanctions based on best practices, such as creating a watchlist and guidelines for adding Online Marketplace Operators to such a watchlist.
- Add a guideline encouraging the establishment of clear and fair laws regarding secondary liability for Online Marketplace Operators.
- In Paragraph 22b.i., strike “Trademark infringement” and replace with “Trafficking in Counterfeit Trademark Goods”.
- In Paragraph 22b.ii., strike “commercial scale operations” and replace with “commercial scale counterfeiting operations”. Also, strike “that participate” and replace with “involved”.

3.4. Information exchange, transparency, and public awareness

Overview:

- This section calls for joint public-private campaigns to raise consumer awareness of the harms and risks of counterfeit goods and calls for transparent publication of enforcement activity and trends.

Recommendations:

- Encourage the use of webinars, video campaigns via online streaming services, road shows (like the USPTO road shows), and popular social media platforms to maximize accessibility and build awareness.

4. Guidelines for Online Marketplace Operators

4.1.1. Repeat infringers

Overview:

- This section calls for Operators to proactively monitor listings (including pre-posting screening), consult with Rights Holders, enable trusted access for review of branded listings, and deploy advanced screening technologies such as image fingerprinting to identify counterfeit goods.

Recommendations:

- Consider recommending that Online Market Operators conduct periodic testing of screening and monitoring systems intended to reduce the number of listings offering Counterfeit Trademark Goods, including through methods akin to penetration testing.
- Consider providing clearer, objective guidance on defining what constitutes a “Repeat Counterfeiter” (e.g., number of confirmed counterfeiting violations within a defined time period). Consider whether this definition and any associated thresholds should be set at the Government level, so that they are applied consistently across all marketplaces, at the Online Platform level, or through a combined approach. Transparency of the chosen approach should be strongly encouraged.

4.1.2. Notifications and counternotifications

Overview:

- This section calls for a system to be established that allows interested parties to electronically notify the Online Marketplace Operators of suspected counterfeit goods. This system should include detailed information about the product and why it is suspected of being counterfeit and include a verified statement and any applicable evidence. The system would have procedures and timeframes to file counterclaims and appeals by Rights Holders and sellers, respectively.

Recommendations:

- In Paragraph 32.ii.2, more clarity is needed on what is intended by “substantiated explanation.” As currently interpreted, we suggest replacing “substantiated explanation” with “sufficient explanation.” While some threshold information regarding the suspected counterfeit nature of the products could be provided, the level of required information must be balanced against the highly confidential nature of rights holders’ internal brand protection/counterfeit detection processes and systems, to avoid unnecessary disclosure of such information, which simply compounds the counterfeiting problem.
- Consider including recommendations for the standards to be considered and thresholds required for Rights Holders to be considered to have “strong records” of successfully submitting takedowns and clarify how the system is enhanced for these users compared to standard users.

4.1.3. Takedown

Overview:

- This section calls for Online Marketplace Operators to remove listings and suspend sales for goods that are confirmed to be counterfeit. Reports by Government enforcement authorities and Rights Holders with strong notification and takedown records should receive expedited action. Rights Holders, third-party sellers, and Government enforcement authorities should be notified of actions taken to remove or restore listings of counterfeit goods. Operators should take appropriate action against third-party sellers involved in the sale of confirmed counterfeit products.

Recommendations:

- Consider providing clear guidance on the recommended timeframe for the takedown process generally, as well as the recommended timeframe for expedited action for the Government enforcement authorities and Rights Holders with strong notification and takedown records.
- In Paragraph 32i., after “to identify abuses of” insert “notifications by rights holders and”.
- In Paragraph 34a., insert at the end of the paragraph “If restoration or lifting of a suspension of a listing is confirmed as appropriate, it should be carried out promptly and without delay.”
- Establish a standard set or expectation of consequences for confirmed third-party sellers of counterfeit goods and encourage stakeholders to notify sellers of this standard at the outset so that they are aware of potential consequences.
- Establish clear guidance on what qualifies as “strong notification and takedown records.” Include provisions for consequences for improper assertion of notification and requests for takedowns.

4.1.4. Enforcement and sanctions

Overview:

- This section calls for Operators to cooperate with Governments and Rights Holders to identify Repeat Infringers [Repeat Counterfeiters] and deploy meaningful deterrents, including account suspension/termination, blocking re-registration, and cross-checking databases to detect multiple accounts.

Recommendations:

- Encourage Clear, objective definitions for what constitutes a “Repeat Counterfeiter” (e.g., number of confirmed counterfeit violations within a defined time period).
- In Paragraph 36.e., replace “repeat infringement” with “repeat trade in Counterfeit Trademark Goods”. Replace “infringement” with “conduct”.

4.1.5. Accountability and Liability

Overview:

- This section calls for Online Marketplace Operators to inform purchasers of confirmed counterfeit goods how to seek redress and obtain refunds from third-party sellers. Operators should consider providing refunds directly to purchasers if the latter are unable to obtain refunds from the seller. Operators should withhold payments to sellers for counterfeit goods when they are in a position to do so.

Recommendation:

- Add a guideline urging the establishment of clear standards for sellers regarding expectations that they promptly refund purchasers of counterfeit goods after the takedown process is complete and establish consequences if the sellers fail to do so.
- Consider providing recommendations for clear guidelines for the point at which Operators will suspend sales and withhold payments to sellers that are the result of counterfeit goods, and whether this is an absolute or temporary withholding.

4.1.6. Listings

Overview:

- Online Marketplace Operators should provide clear and detailed information in product listings on their platform. Consumers should have a clear means to contact Marketplace Operators if third-party sellers are not responsive to complaints or inquiries regarding the goods' authenticity. Operators should collect and publish consumer reviews that provide information on the third-party sellers' performance and the quality of the goods.

Recommendation:

- Clarify the types of measures Operators should be expected to take to ensure listings with offers from multiple sellers do not contain offers for counterfeit goods.

4.1.7. Third-Party Sellers

Overview:

- Online Marketplace Operators should collect detailed information on third-party sellers, preferably supported by official government-issued documentation, which is regularly reverified. Operators should require sellers to provide information regarding previous reports or complaints related to the sale of counterfeit goods. Operators should include terms of service agreements with sellers tailored to transparency and accountability for counterfeit goods and subsequent action, including permanent suspension or termination of a seller for major infractions or infractions with repeat infringements.

Recommendation:

- Consider providing clear guidance on or suggestions for how often third-party sellers' information and identity will be subject to reverification and encourage the establishment of a standard timeframe for reverification, which is required to continue selling on the platform.
- Correct the typographical error in paragraph 43 by replacing "conclude" with "include."
- In Paragraph 43a.ii., strike "those shipments would infringe on a registered trademark" and replace with "those goods would be deemed counterfeiting".
- In Paragraph 43c., strike "repeat infringements" and replace with "repeat trading in Counterfeit Trademark Goods."
- Consider providing guidance on what should qualify as a "major infraction" that would necessitate permanent suspension or termination.

4.1.8. Enforcement and sanctions

Overview:

- This section calls for Operators to collaborate across jurisdictions with Governments and Rights Holders to disrupt online counterfeit networks and consistently apply contractual sanctions provided in their terms of service.

Recommendations:

- Encourage periodic third-party reviews of enforcement controls and the publishing of executive summaries to bolster accountability.

4.1.9. Information exchange, transparency, and public awareness

Overview:

- This section calls on Operators to track and report trends in counterfeit activity, conduct public awareness campaigns, and publish annual reports on enforcement actions.

Recommendations:

- Encourage Online Marketplace Operators to host education page(s) with executive summaries, graphics, and/or video(s) summarizing international trends around the use of online marketplaces to sell or distribute counterfeit goods to help raise awareness.

5. Guidelines for Rights Holders

5.1.1. Market surveillance

Overview:

- This section emphasizes continuous development, refinement, and sharing of effective detection tools.

Recommendations:

- We recommend encouraging Rights Holders to share/teach surveillance techniques and best practices to other Rights Holders, where appropriate, in addition to Online Marketplace Operators, third-party sellers, and government enforcement authorities.

5.1.2. Repeat infringers

Overview:

- This section calls for Rights Holders to work with Governments and Operators to identify and act against Repeat Infringers [Repeat Counterfeiters] and support registers/watch lists that track entities involved in counterfeit trade.

Recommendations:

- Replace “Support” with “Support and contribute to” in Section 5.1.1.55.b to encourage more active participation. Also, replace “entities” with “entities and individuals”.

Conclusion:

AIPLA sincerely appreciates the opportunity to provide its comments on the OECD's Working Party on Countering Illicit Trade (WP-CIT) Draft Voluntary Guidelines for Countering Illicit Trade in Counterfeit Goods on Online Marketplaces and hopes these comments are helpful. If AIPLA can be of any further assistance in the development and implementation of the Guidelines or of any other assistance on intellectual property issues, please do not hesitate to contact us.

Regards,



Salvatore Anastasi

President-Elect

American Intellectual Property Law Association