

Priority: N1

Issue: Authentication Standards

Description: The Trademark Clearinghouse is a central repository for information to be authenticated, stored, and disseminated, pertaining to the rights of trademark holders. One of the core functions of the Clearinghouse will be authentication of the data to be included.

The authentication criteria should be: (1) clearly specified; (2) made available prior to the submission of data by rights holders; and (3) subject to review from time to time to be sure that they support the goals of efficiency and accuracy in the process.

Business Requirements:

- (1) Create a workable, efficient authentication process for trademark data
- (2) Establish well-defined roles for Clearinghouse administrators and reviewers
- (3) Establish a standard that is globally accessible
- (4) Establish a standard that produces consistent, predictable results
- (4) Avoid unfair prejudice in favor of or against any particular type of rightsholder

Authentication Process Elements

A clear standard that provides notice of what does and does not constitute adequate supporting information for a Clearinghouse record should support the authentication process. A preliminary set of recommended requirements are described in this document for discussion.

To facilitate prompt authentication reviews, the process should not facilitate ongoing dialogues between submitters and the Clearinghouse. If a record is not capable of authentication as submitted it should generally be rejected without any prejudice toward resubmission of the data. However, some notice as to the basis for the deficiency should be provided in every case so that the same mistake is not made multiple times.

Review steps to be taken by the Clearinghouse could include the following:

1. Name of the Submitter – Where the name of the submitter matches the name associated with the registration of the trademark in the issuing jurisdiction, verification of the names can be a simple and straightforward process. Where issues are expected to arise is in cases where the submission is made by party A and the record shows party B. In such cases, evidence of authorization for the submission by party A will have to be established. The steps required could vary depending on whether it is an individual or a company that is

submitting the record. The objective is to ensure that the entity asserting the rights is authorized by the rights holder to exercise those rights.

2. Contact information – The ability to communicate with the submitter through electronic means is of primary concern. At a minimum, a mechanism should be employed whereby the Clearinghouse can transmit information to the electronic contact provided, such that the contact would have to respond within a fixed period of time to confirm the accuracy of the address. Additional contact verification steps could be added as needed.
3. Declaration – This would consist of a sworn statement that the information submitted is true and current and has not been supplied for an improper purpose.
4. Registration Numbers (for registered trademarks) – Registration numbers submitted to the Clearinghouse must match the numbers identified on records in the issuing jurisdiction. Such data can be confirmed by resort to the issuing office. Some jurisdictions have such data available online. For those that do not, contact will be made by the Clearinghouse to confirm the accuracy of the data. However, a principle of equitable treatment should be adopted here. The steps required of similarly situated mark holders should be essentially the same regardless of whether the relevant jurisdiction makes data available in an online database.
5. Statute/treaty information – The Clearinghouse would also perform confirmation of the treaty or statute for those marks that identify a treaty or statute as the basis of submission. In such cases, submitters will need to properly identify the relevant instruments and provide a copy of the relevant language, as well as the date of the treaty or effective date of the statute. In some cases, the Clearinghouse will be able to refer to existing data sources (e.g., <http://treaties.un.org/Home.aspx>) for confirmation of the information submitted. If the statute or treaty is not properly identified, it should not be up to the Clearinghouse to find the right authority. Nor should it be up to the Clearinghouse to interpret a statute or treaty; it must appear on the face of the authority claimed as a basis, that it confers the rights.
6. Court proceedings – As above, if the submitter is relying upon a court order to establish rights, it should appear on the face of the materials submitted that a court conferred such rights, i.e., the documentation should indicate that the relevant party has rights to <mark> for <class of goods or services>. Further, there should be evidence that the court has entered the order or judgment. A simple court document or pleading without evidence that a Court approved, adopted or entered the order or judgment should not be sufficient. Legal interpretation cannot be the basis for the submission. The Clearinghouse would verify that the court existed as of the date of the order or judgment and that the order has the indicia of authenticity (i.e., it is signed by a judicial officer, it names the parties that were the subject of the proceedings, it confers a grant of rights). The authentication process will not be an inquiry into the underlying legal basis for a court proceeding.

Questions for Discussion

1. If contact verification is employed, should this be repeated for every new trademark record submitted, or could it be only when a new contact record is initiated?
2. What is the optimal level of authentication of the party submitting the trademark rights to the clearinghouse? How much cost are users willing to bear for additional layers or levels of authentication? For any additional authentication steps proposed, what value would be added for Clearinghouse users?
3. Is it desirable or necessary to provide a more in-depth authentication of the trademark rights themselves? How much cost are users willing to bear for those additional layers or levels of authentication, and what value do they add to Clearinghouse users?
4. What safeguards or penalties could be established for misuse of data (e.g., a party takes publicly available data and makes submissions to the Clearinghouse in its own name)? Is this a significant concern?
5. How can we, and do we need to, mitigate any inequity if some data can be verified online and other data cannot?