

Priority: N2

Issue: Validation Standard for Proof of Use

Description: A trademark holder must demonstrate use of a trademark to establish eligibility to participate in sunrise registrations.

The Applicant Guidebook provides that: *For validation of marks by the Clearinghouse that were not protected via a court, statute or treaty, the mark holder shall be required to provide evidence of use of the mark in connection with the bona fide offering for sale of goods or services prior to application for inclusion in the Clearinghouse. Acceptable evidence of use will be a signed declaration and a single specimen of current use, which might consist of labels, tags, containers, advertising, brochures, screen shots, or something else that evidences current use.*

Additional guidance is required to define the process followed by the Clearinghouse in examining and accepting the evidence of use presented.

Business

Requirements:

- (1) Protect the existing legal rights of registered mark holders
- (2) Limit creation of new requirements affecting trademark holders
- (3) Ensure financial and operational feasibility
- (4) Avoid imposing a role for the clearinghouse that is inconsistent with the role agreed upon by the community
- (5) Establish a standard that is globally accessible
- (6) Avoid unfair prejudice in favor of or against any particular TM holder

Proof of Use Elements

A single standard should be applicable across all jurisdictions, to avoid confusion and to provide service to users across the globe. A process that minimizes subjective reviews by the Clearinghouse will serve this goal and will also help to minimize the costs for Clearinghouse users. A preliminary framework for proof of use validation is described in this document for discussion:

1) Declaration:

This declaration would only be relevant in the event that a submitter requests validation by the Clearinghouse for proof of use. While all parties submitting records into the Clearinghouse will make a declaration concerning the data submitted, a declaration specifically concerning the proof of use documentation will be made. This could take the form of the following:

The [Trademark Holder/Representative/Licensee/Agent] hereby certifies that the information submitted to the Clearinghouse, is, to the best of [Trademark Holder/Representative/Licensee/Agent's] knowledge complete and accurate, that the trademarks set forth in this submission are currently in use in the manner set forth in the accompanying specimen; that this information is not being presented for any improper purpose; and that if, at any time, the information contained in this submission is no longer accurate, the [Trademark Holder/Representative/Licensee/Agent] will notify the Clearinghouse within a reasonable time of that information which is no longer accurate, and to the extent necessary, provide that additional information necessary for the submission to be accurate. Furthermore, if any Clearinghouse-validated mark subsequently becomes abandoned by the holder, the holder will notify the Clearinghouse within a reasonable time that the mark has been abandoned.

The declaration can be built around check-boxes so that users have the appropriate flexibility according to the party completing the form; however, the substance of the declaration must be completed in all cases.

2) Sample/Specimen of Use:

The baseline standard is intended to be flexible to accommodate practices from multiple jurisdictions. The specimen should be something *that evidences an effort on behalf of the holder to communicate to a consumer so that the consumer can distinguish, without the possibility of confusion, the products or services of one from those of another.*

Examples of such evidence would include:

- Labels
- Tags
- Containers
- Marketing materials
- Advertising
- Brochures
- Screen shots

Given the need for flexibility, other evidence that could be considered includes:

- Applications for business licenses that include the mark as part of the business name
- Letterhead
- Licenses to use the mark in question

- Catalogs
- Manuals
- Displays
- Pamphlets
- Infomercial/video presentation excerpts
- Electronic display
- Press release
- Business cards
- Social media marketing materials

Mere inclusion of a mark in a domain name should not constitute use, nor should email messages or blog postings.

Questions for Discussion

1. Is it desirable or necessary to establish more onerous standards for certain parts of the review of samples in validating for use? For instance, should validation for use include consideration as to how the sample matches the class of goods or services? Is there additional value to mark holders and to Clearinghouse users of more detailed (and thus more expensive) examination of samples?
2. How frequently should proof-of-use be re-verified? For example, could a verified proof of use be valid for a year or more?
3. What should be the process for notifying the Clearinghouse if the mark holder abandons use of the mark?