



European Communities Trade Mark Association

ECTA is the European Communities Trade Mark Association. ECTA numbers approximately 1,500 members, coming from all Member States of the European Union, with associate members from all over the world. It brings together all those persons practising professionally in the Member States of the European Community in the field of trade marks, designs and related IP matters. ECTA members represent more than 50% of all registered Community Trademarks.

ECTA welcomes the opportunity to comment on the document entitled “*New gTLD Program: Trademark Clearinghouse Explanatory Memorandum: Implementing the Proof of Use Verification*”.

ECTA has the following specific comments:

1. The proposed wording of the Declaration of Use goes beyond what is necessary to achieve the objectives in that:
  1. The Declaration of Use contains language as to completeness. However, the proposal is that there should only be a single sample of use. Accordingly, it cannot be correct to describe such as "complete"; and
  2. It contains an undertaking as to future notification. ECTA believes that this places an unnecessary administrative burden on rights holders in having to maintain procedures to notification of changes of use to the TMCH, which are not even required by a national or international trademark office. Many trademark offices do not require proof of use at all to maintain a registration, let alone an obligation to notify about change of use. Having to notify abandonment of a trademark, when there is an annual verification exercise, is also an unnecessary administrative burden on rights holders.

2. ECTA would propose the following revisions to the Declaration of Use:

*The [Trademark Holder/Licensee/Agent] hereby certifies that the information submitted to the Clearinghouse, is, to the best of [Trademark Holder/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, in connection with the class of goods or services specified when this submission was made to the Trademark Clearinghouse; and 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/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-verified mark subsequently becomes abandoned by the holder, the holder will notify the Clearinghouse within a reasonable time that the mark has been abandoned.~~*

3. ECTA is further concerned that the proof of use requirement does not correspond with trade mark law in various countries or regions. For example, once registered, the owner



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of a Community Trade Mark has 5 years in which to use the mark before any third party can challenge the registration on the grounds of non-use.

4. Finally, so far as the proposed challenge procedures are concerned, ECTA believes that challengers ought to have the ability to obtain copies of the Declarations of Proof and samples

Andrew Mills  
Chair - ECTA Internet Committee

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