Amendments to Identifications of Goods/Services Due to Technology Evolution

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Background on Technology Evolution

- Petitions from trademark owners seeking ID amendments based on technology evolution
- Feedback from trademark owners about the challenges of technology evolution
- Request for comments by the USPTO seeking feedback about a proposal to allow amendments to identifications of goods/services due to technology evolution
- The comment period ended on November 3, 2014.
Overview of the Proposal

- Permit amendments otherwise outside the scope in limited circumstances based on changes in the manner or medium by which products and services are offered for sale and provided to consumers due to evolving technology if the underlying content or subject matter has not changed.
• Petition to the Director under Trademark Rule 2.146, 37 C.F.R. §2.146.
• Waiver of the applicable “scope” rule (Trademark Rule 2.71(a), pre-registration, or Rule 2.173(e), post-registration).
Overview of the Proposal

- Based on changes in the manner or medium due to evolving technology, the owner cannot show use on the original goods/services;
- Still using the mark on other goods/services reflecting the evolved technology and the underlying content or subject matter remains unchanged; and
- Owner otherwise would be forced to delete the original goods/services.
Overview of the Proposal

- Must abandon any “incontestable” status as to the evolved goods/services.
- Not file (or refile, if applicable) an affidavit or declaration of incontestability as to the evolved goods/services for at least 5 years.
- For applications, a new search of Office records and republication of amendments accepted post-publication would be required.
Examples of Acceptable Amendments

- “Phonograph records featuring music,” in International Class 9 to “Musical sound recordings,” in International Class 9

- “Downloadable software for use in database management,” in International Class 9 to “Software as a service (SAAS) services featuring software for use in database management,” in International Class 42
Example of Unacceptable Amendment

- “Printed magazines in the field of finance,” in International Class 16 to “Printed magazines in the field of finance,” in International Class 16 and “Providing on-line magazines in the field of finance,” in International Class 41
Comments on the Proposal

- Fourteen comments were received in response to the request for comments.
- Most support a change in practice to permit amendments.
- Concerns raised regarding the specifics of the proposal, including the ability of the public to contest amendments, the potential broadening of identifications, and the requirements for showing that an extraordinary situation exists.
Final Implementation Plans

• Move forward with a pilot, allowing a trial period to assess
• Provide a mechanism for third party objections, akin to a letter of protest
• For applications or registrations based on Section 66(a), consider international registration scope in deciding petitions
Thank You

- Questions?
- Later Feedback or Questions -- TMPolicy@uspto.gov