

September 19, 2014

US Patent and Trademark Office Considering Proposal to Allow Amendments to Trademark Identifications Due to Technological Changes

The US Patent and Trademark Office (USPTO) is currently considering a proposal to allow amendments to the identifications of goods/services in a trademark registration because of technological changes in how the goods/services are offered to the public. Amendments would be granted only where the underlying content or subject matter of the goods/services has not changed. The full proposal is available [here](#). The USPTO is seeking public comment on the proposal through November 3. Interested parties should send their comments to TMPolicy@uspto.gov with the subject line "Technology Evolution."

Executive Summary

In most cases, a trademark registration can be amended for good cause provided that the amendment does not materially alter the character of the mark. Currently, a registration owner can file an amendment to the identification of goods/services in order to restrict the identification or to change it in ways that would not require republication of the mark. However, a registration cannot be amended to add goods/services.

Recently, registration owners have sought to amend the identification of goods/services where technological advancement has changed the manner or medium by which their goods/services are offered to the public. Examples include changing "Class 9 items featuring music (e.g., audio cassettes, audio tapes, disks, diskettes, vinyl records, etc.) to musical sound recordings in Class 9" and changing "Class 16 printed magazines to providing on-line magazines in Class 41." The USPTO has rejected these types of amendments, claiming that they would increase a mark's scope of protection without providing adequate notice to the public. Registration owners have replied that, because the core goods/services remain the same and only the manner or medium has changed, there is no increase in a registration's scope, nor is there any adverse effect on public notice.

Consequently, the USPTO is proposing a change in its practice. The USPTO is seeking public comment on a proposal to allow amendments to be filed to the identification of goods/services "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."

Proposed Change in Practice

1. Waiver of the "Applicable Scope" Rule

Under the proposal, a petitioner would request a waiver of the "applicable scope" rule (Trademark Rule 2.71(a) for pre-registration; Trademark Rule 2.173(e) for post-registration). The director of the USPTO may grant the waiver where: (1) an extraordinary situation exists, (2) justice requires, and (3) no other party is injured. To satisfy the first two prongs, a petitioner would have to declare the following:

- 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, [the petitioner] cannot show use on the original goods/services;

For more information, or if you have any questions, please contact your Katten Muchin Rosenman LLP attorney or any of the following lawyers in the **Intellectual Property practice**.

Brian J. Winterfeldt
+1.202.625.3562
brian.winterfeldt@kattenlaw.com

John K. Whitaker
+1.312.902.5416
john.whitaker@kattenlaw.com

- The petitioner still uses the mark on other goods/services reflecting the evolved technology and the underlying content or subject matter remains unchanged; and
- Absent an amendment to the identification, the petitioner would be forced to delete the original goods/services from the application or registration, and thus lose federal trademark protection in relation to the underlying content of the original goods/services.

To satisfy the final prong of no third-party harm, the petitioner would have to abandon any “incontestable” status as to the evolved goods/services. Additionally, the petitioner would have to declare that it would not file an affidavit or declaration of incontestability on the evolved goods/services for at least five years.

2. Additional Requirements

A petitioner would have to provide dates of use for the evolved goods/services; though the original dates would remain effective, the new dates would be added to the Trademark Status & Document Retrieval (TSDR) database. Additionally, amendments would have to comply with all other traditionally applicable rules and requirements.

In a proposed amendment, the evolved goods/services would replace the originally identified goods/services for which the petitioner can no longer show use. The USPTO would consider amendments that change the classification of the goods/services and change the identification from goods to services (or vice versa). A nonexhaustive list of acceptable amendments would be posted on the USPTO website as amendments were permitted.

Examples

The USPTO has offered the following examples of acceptable and unacceptable amendments:

Acceptable Amendments

- “Prerecorded video cassettes in the field of mathematics instruction,” in International Class 9 to “Video recordings featuring mathematics instruction,” in International Class 9.
- “Floppy discs for computers for word processing,” in International Class 9 to “Providing on-line non-downloadable software for word processing,” in International Class 42.
- “Cotton oven mitts,” in International Class 24 to “Silicone oven mitts,” in International Class 24.

Unacceptable Amendments

- “Downloadable software for use as a spreadsheet in the field of accounting,” in International Class 9 to “Providing on-line non-downloadable software for use as a spreadsheet in the field of business management,” in International Class 42.

NOTE: The preceding amendment would not be allowed because the subject matter of the spreadsheet software would have changed from accounting to business management. An amendment would be permitted from “downloadable software for use as a spreadsheet in the field of accounting,” in International Class 9 to “providing on-line non-downloadable software for use as a spreadsheet in the field of accounting,” in International Class 42, if accurate.

- “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.

NOTE: The preceding amendment would not be allowed because the petitioner would still be using the goods in their current form and therefore would not be able to show that an extraordinary situation exists, because absent the amendment the petitioner would not lose federal trademark protection as to the goods in their current form due to technology evolution. The petitioner may file a new trademark application for the services in International Class 41.

Katten

Katten Muchin Rosenman LLP www.kattenlaw.com

AUSTIN | CENTURY CITY | CHARLOTTE | CHICAGO | HOUSTON | IRVING | LONDON | LOS ANGELES | NEW YORK | ORANGE COUNTY | SAN FRANCISCO BAY AREA | SHANGHAI | WASHINGTON, DC

Attorney advertising. Published as a source of information only. The material contained herein is not to be construed as legal advice or opinion.

©2014 Katten Muchin Rosenman LLP. All rights reserved.

Katten Muchin Rosenman LLP is an Illinois limited liability partnership including professional corporations that has elected to be governed by the Illinois Uniform Partnership Act (1997). London: Katten Muchin Rosenman UK LLP.