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An Opportunity To Change TM Registration For Outdated Tech

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As technology evolves, the manner and medium of delivering content or using goods and services can change dramatically. Because [U.S. Patent and Trademark Office](#) rules, in most cases, do not permit the amendment of goods or services listed in a registration to reflect this evolution — it generally is considered to be an expansion of the scope of the registration — some trademark registrations can become effectively obsolete. A registration for YOURMARK for floppy disks was of little value until ...



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The USPTO Pilot Program

On Sept. 1, 2015, the USPTO commenced a pilot program permitting the amendment of the identification of goods and services in trademark registrations, in limited circumstances, where evolving technology has changed the manner or medium by which the underlying content or subject matter of the identified products and services are provided. See <http://www.uspto.gov/trademark/trademark-updates-and-announcements/recent-postings>. (The program applies to both goods and services, but for convenience, I will primarily use the term "goods.")

The pilot program only applies to registered trademarks. To amend the registration, the registrant must file a petition to the director demonstrating that “extraordinary circumstances” exist that warrant the waiver of the traditional rule prohibiting the expansion of the scope of goods.

To do so, the registrant must establish:

- As a result of changes in evolving technology in the manner or medium by which products and services are provided to consumers, the registrant cannot show use on the original goods;
- Registrant still uses the mark on other goods reflecting the evolved technology, and the underlying content or subject matter remains unchanged; and
- Absent an amendment of the identification, the registrant would be forced to delete the original goods from the registration, and lose trademark registration protection.

Some examples of acceptable amendments, according to the USPTO, include:

- “Floppy discs for computers for word processing” (Class 9) can be amended to “Providing on-line non-downloadable software for word processing” (Class 42).
- “Phonograph records featuring music” can be amended to “Musical sound recordings.” (But not if the mark still is being used on phonograph records, which have enjoyed something of a revival in recent years.)
- “Prerecorded video cassettes in the field of” can be amended to “Video recordings featuring” (Video cassettes have not enjoyed a similar revival.)

Not all amendments that may arguably reflect evolving technology will be permitted. For example, the USPTO has stated it would not permit the amendment of “Phonograph records featuring music” (Class 9) to “Streaming of audio material in the nature of music” (Class 38) because that would improperly amend the identification from a particular medium of music content to a separate data transmission activity.

The fate of the amendment also can depend upon the original wording in the registration. The USPTO has stated it would not permit the amendment of “Video game tape cassettes and video game cartridges” to “Video game discs and video game cartridges” because although the Registrant is no longer using the mark on “video game tape cassettes”, it is still using the mark on “video game cartridges.” The use of the word “and” seems to be the problem for the USPTO even though the goods are different. Although the USPTO does not address the issue, a different result could occur if the goods were described using a comma, as in “video game tape cassettes, video game cartridges.”

An amendment will not be permitted if the USPTO determines it will be harmful to third parties. In making this determination, the USPTO will conduct a new search of office records and will publish any proposed amendments that might otherwise be acceptable for third-party comments to be submitted within 30 days of publication.

The pilot program will apply to “Treaty” and “Madrid Protocol” registrations based on Sections 44(e) and §66(a) of the Trademark Act (15 U.S.C. §§1126(e), 1141f(a)) but there will be a difference in how they are handled. In particular, the USPTO has indicated that because Madrid Protocol registrations, under §66(a), are based on the underlying international registration for a period of five years, the scope of the international registration will be taken into account in determining the acceptability of any amendment during that period. By contrast, the scope of Treaty-based registrations, under §44(e), which exist independently of the underlying foreign registration, will not be a factor.

The duration of the pilot program will depend on the volume of requests. The USPTO will then consider making the amendment provision permanent.

What Trademark Owners Should Be Thinking About

The actual application of this pilot program will raise many interesting issues and will undoubtedly be a learning experience for all concerned. The USPTO will have to work much of this out as things develop and it has indicated it will issue other examples of acceptable amendments from time to time.

So what does this really mean? The pilot program will primarily interest trademark owners in businesses involved in evolving technologies, and many of those trademark owners have already filed new applications to cover their new products. That being said, it could be of some benefit to a number of trademark owners to help them try to establish or reinforce registered rights for new technologies. Certainly, trademark owners who are about to abandon one technology and move to a successor technology should be alert to the possibility of amending existing registrations at the time of transition.

At the very least, it should encourage trademark owners to dust off and review their trademark portfolio to see if they own any “floppy disks” registrations and to determine if there may be ways to take advantage of the pilot program. The program will also add an additional option for trademark owners who might be considering deleting obsolete goods from trademark registrations when it comes time to file a statement of use.

The determination of what, in effect, is a “successor in interest” to old technology is not always clear. If the examples provided by the USPTO are any indication, the USPTO rulings on close calls may be somewhat arbitrary. Care should be taken in determining how to describe the new technology and in being able to explain, if required, why the new technology is the successor to the original goods. The promised additional examples of acceptable and nonacceptable amendments from the USPTO should be helpful.

Which brings us to the timing of filing the petition. Trademark owners should consider whether it is better to file as early as possible or wait to see how the pilot program is working before jumping in. Where the proposed amendment is identical or very close to an amendment the USPTO has already stated is acceptable, there may be no reason not to file the petition promptly.

In other cases, consideration should be given to delaying taking action until more can be learned about how the USPTO will handle the petitions or the USPTO provides further information on what is an acceptable amendment. However, such delay raises certain risks. One risk that may argue for an earlier filing is the potential that third-party rights could be created during the period of delay, which might be considered by the USPTO.

Another risk, lurking in the background, involves the issue of abandonment. By filing the amendment, the registrant already has admitted it has discontinued use of the mark on the original goods — perhaps long before the amendment is filed — and adopted a new technology. The abandonment clock is ticking. Any delay in filing an amendment will further increase the time period of nonuse for the original goods, which could increase the possibility of a finding of abandonment.

In fact, trademark owners should consider whether they have already legally abandoned the mark for the obsolete goods notwithstanding the fact that the registration still exists and, if so, what the legal effect of the amendment is.

By way of example, suppose the trademark owner discontinued use of a registered mark for floppy disks with no intent to resume use of the mark on floppy disks ever again and the nonuse has continued for well over three consecutive years thus touching all of the bases of the legal definition of abandonment. Traditional trademark law holds that a registration for an abandoned mark is a dead man walking, even if the registration has not been officially canceled and even if use is resumed after abandonment. If a trademark owner already has legally abandoned a mark shown in a registration for floppy disks, can the registration be somehow resuscitated by an amendment to the evolved product? Or is the registration, even after amendment, forever vulnerable to a petition for cancellation? Should new backup applications be filed as a precaution in addition to amending the existing registration? Will this pilot program change the way the issue of abandonment is evaluated? These are all issues to be considered in determining whether to file an amendment.

Although the pilot program does not apply to trademark applications, it should inform the way the identification of goods is drafted in trademark applications for goods that may someday be replaced by evolving technology and may become the subject of later amendments (if the pilot program results in permanent changes in trademark office rules.) Trademark applicants should be aware of any trends in the USPTO determinations that might influence how goods should be identified. And if it does turn out that the insertion of the word “and” rather than a comma really prevents an amendment years later, try to find a way to use a comma.

In any event, expect a number of trademark owners to try to take advantage of this opportunity in the very near future, notwithstanding the uncertainties. As Bob Dylan said, “When you ain’t got nothing, you got nothing to lose.”

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