

Leveraging USPTO Technology Evolution Pilot Program

Amending Identifications of Goods and Services in Trademark Registration

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1pm Eastern | 12pm Central | 11am Mountain | 10am Pacific

Today's faculty features:

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Leveraging USPTO Technology Evolution Pilot Program

Beth Seals



What is the pilot program?

- Allows amendments to identifications of goods/services that would otherwise be beyond the scope of the current identification.
- Amendment requirements:
 - Evolving technology has changed the manner or medium of delivery to consumers
 - Must be same underlying content or subject matter
 - Would not permitted under current practice because they would be beyond the scope of the current identification

What is the authority for the pilot program?

- No amendment to the identification of goods/services in a registration will be permitted except to restrict the identification or change it in ways that would not require republication.
 - Trademark Rule 2.173(e)

- Director may waive any provision of the rules that is not a provision of the statute, when:
 - an extraordinary situation exists;
 - justice requires; and
 - no other party is injured.
 - Trademark Rules 2.146(a)(5) and 2.148

Procedures for pilot program

- File a post-registration petition to the Director under Trademark Rule 2.146 AND a Section 7 request for amendment.
 - TEAS: “Petition to the Director under Trademark Rule 2.146,” form number 3
 - Caption: “Petition to Allow Amendment Due to Technology Evolution”
 - Use free-text area to provide the information needed on the petition and the proposed amendment under §7
- Payment of fees:
 - Petition fee: \$100
 - Filing amendment to registration fee: \$100



Procedures for pilot program

- Submit a specimen
- Provide dates of use for the goods/services in their evolved form
 - original dates of use remain in effect in the registration
 - the “evolved” dates would be made of record



- Request to waive Trademark Rule 2.173(e)

- Declaration
 - based on changes due to evolving technology in the manner or medium by which products and services are offered for sale and provided to consumers, the petitioner cannot show use on the original goods/services;

 - 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 of the identification, the petitioner would be forced to delete the original goods/services from the registration, and thus lose protection in the registration in relation to the underlying content or subject matter of the original goods/services.

- Available only with respect to registrations, NOT applications

- Amendments must comply with all applicable rules and requirements
 - §66(a) registrations
 - During the five year period that §66(a) registrations are based on the underlying international registration, the scope of the international registration will factor into determining the acceptability of the amendment.

 - Amendments that cause a change in class are not permitted since the classification cannot be amended from that assigned by the International Bureau.



What will happen after petition is filed?

- New search will be conducted to assess possible third-party harm
- Proposed amendments that are likely acceptable will be posted on a webpage accessible from the *Official Gazette*
 - Interested parties have 30 days to comment
 - Comments will factor into assessing the third-party harm factor
 - Comments may be included in the record
 - <http://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>

What will happen after petition is filed?

- If approved:
 - Accepted amendments will be published in the *Official Gazette* with other accepted §7 amendments for notice purposes; and
 - An updated registration certificate will issue.

- If denied, the identification will not be amended.
 - The new goods/services will not be added; and
 - The original goods/services will not be deleted.

Pros of program

- Can substitute in a different good/service without having to file a new application
- Can change classification of goods/services (except §66(a))
- Can change the identification from goods to services (or vice versa)



- Risk
 - Registrant declares that it cannot show use on the original goods/services.

- Incontestability
 - Any “incontestable” status that applied to the original goods/services will not apply to the newly amended goods/services in their evolved form.
 - Registrant must declare that it will not file declaration of incontestability as to the evolved goods/services for at least five years from the date the amendment is accepted.

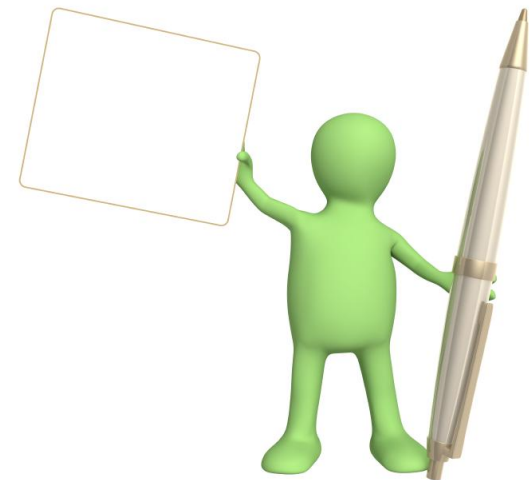
Timing for pilot program

- Pilot program commenced September 1, 2015
- Duration depends on the volume of requests
- At the conclusion of the pilot period, the Office will assess whether such amendments should be permitted on a permanent basis, and if so, whether modified guidelines are appropriate.
- Registrants can file a petition at any time



Current use of pilot program

- As of November 2015
 - 13 petitions filed
 - 3 have published for comment
 - 10 were incomplete and did not comply with all pilot requirements
 - 30-day letters were issued



- Beth Seals blog post
 - <http://www.iptechblog.com/2015/09/uspto-pilot-program-trademark-registration-owners-may-now-be-able-to-broaden-their-goods-and-services/>
- USPTO announcement
 - www.uspto.gov/sites/default/files/documents/Technology_Evolution_Pilot_Program.docx
- USPTO sample declaration
 - www.uspto.gov/sites/default/files/documents/Sample_Declaration_Under_the_Pilot.docx
- Proposed amendments
 - <http://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>

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**LEVERAGING USPTO
TECHNOLOGY EVOLUTION
PILOT PROGRAM**

FARAH BHATTI

IMPACT ON TRADEMARK REGISTRATION

- Insignificant impact
- Limited number of registrations to which this applies
- Expansion of trade protects most registrations
- Does not affect amendments that are currently allowed under TMEP 1402.07(c)
 - e.g. “newsletters in the field of accounting” (Class 16) to “providing online newsletters in the field of accounting” (Class 41)

IMPACT ON TRADEMARK REGISTRATIONS

- **HOW WILL THIS AFFECT OTHER TRADEMARK OWNERS OR THOSE FILING NEW APPLICATIONS**
- Previously “dissimilar” registrations could become potential citations as re-classification is possible.
- Monitor competitor’s registrations to see if they have filed to expand the scope
- Broaden searches in anticipation of owners amending their registrations

GUIDANCE FOR LEVERAGING

- Evaluate existing trademark portfolio for any registrations which include “old technology”
- Look for the following “old technology” terms and determine if any can be updated:
 - Phonographs
 - Prerecorded video cassettes
 - Videotapes
 - Floppy discs
 - Telephone banking services
 - Entertainment services, namely, ongoing comedy series providing through cable television

GUIDANCE FOR LEVERAGING

- Review trademark registrations for any goods for which a specimen cannot be filed to determine if amendment would allow a specimen to be submitted
- When filing a Section 8, if a specimen is not available, you must delete the goods from the registration
- If a specimen is submitted and the mark is not in use on such goods, registration is susceptible at least to partial cancellation

GUIDANCE FOR LEVERAGING

- **Subject matter cannot be changed**
 - e.g., subject matter of software must stay the same
- **If the goods are used in the old form and the current form, the old form cannot be amended.**
- **Consider whether you want to admit that the goods are no longer in use on the old goods. If amendment is not allowable, then the admission is public record. The Trademark Office will not automatically delete such goods.**
- **Amendment only applies if the failure to amend would result in a loss of rights due to an old technology that has now evolved.**

GUIDANCE FOR LEVERAGING

- Examples of acceptable amendments:

Original Goods	Proposed Amendment
DOS-based application software to manage and forecast inventory for the direct marketing industry	Application software to manage and forecast inventory for the direct marketing industry
Videotapes, videocassettes, all on the subjects of ancient peoples and cultures around the world	Video recordings on the subjects of ancient peoples and cultures around the world
Videotapes featuring basketball instruction	Video recordings featuring basketball instruction

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