

USPTO INSTITUTES PILOT PROGRAM TO ADDRESS CHANGES IN TECHNOLOGY

There have been protests in the trademark community that trademark owners must unnecessarily relinquish registrations or parts of registrations if the manner or medium of the goods/services (collectively “goods”) changed because of technology. An example is a mark originally registered for use in connection with 8-track tapes. Because of changes to technology, the mark owner is now stuck with an outmoded registration for goods no longer offered in the marketplace. Requesting an update to the evolved technology, e.g., DVDs, is considered to be an unacceptable addition or outside the “scope” of the registration (U.S. law only accepts narrowing of the goods in a registration).

Under the pilot program, trademark owners will be allowed to petition the director for a waiver of the “scope” rule for the specific purpose of updating the goods because of changes in technology. Amendments permitted under current trademark practice are not affected by this program. (See www.uspto.gov/sites/default/files/documents/Technology_Evolution_Pilot_Program.docx).

Since the program is in its infancy, no actual data is yet available. Updates will be provided when the first set of proposed amendments are published on the USPTO website in the next coming weeks.
Therefore to be continued ...

Pilot Program Details

Starting September 1, 2015, a trademark owner is allowed to petition to change the goods and/or classes in a registration if the change is due to evolving technology.

Important notes:

- **REPLACEMENT OF OLD GOODS WITH NEW EVOLVED GOODS:** Amendments are permitted when the trademark owner can show use in connection with the new evolved goods.
- **AMENDMENT TO GOODS AND CLASSES MAY BE PERMITTED:** Changes to classification of goods and changes from goods to services (or the reverse) will be considered.
- **DECLARATION OF INCONTESTABILITY FOR ORIGINAL GOODS DOES NOT CARRYOVER TO NEW GOODS:** Trademark owner must not file a Declaration of Incontestability until 5 years after the accepted amendment.
- **REGISTRATIONS BASED ON INTERNATIONAL REGISTRATION (MADRID):** Acceptability of an amendment may be affected if the underlying registration is less than 5 years old.
- **SCOPE OF FOREIGN REGISTRATION NOT A FACTOR:** Registrations under §44(e) exist separate from a foreign registration and are therefore not affected by the scope of a foreign registration.
- **PROPOSED AMENDMENT PUBLISHED FOR 30 DAYS TO ALLOW FOR OBJECTION:** Interested parties will have 30 days to explain a potential 3rd party harm if an amendment is accepted by sending an explanation and evidence to TMTechEvolutionComments@uspto.gov.
- **PUBLICATION OF PROPOSED AMENDMENTS WILL BE ON A ROLLING BASIS:** According to a staff attorney at the USPTO, proposed amendments will be published on the website as petitions are received with the publication cycle depending on the response to the pilot. The USPTO is beginning to receive petitions and anticipates publication of the first proposed amendments in the next coming weeks.
- **ACCEPTED AMENDMENTS TO BE PUBLISHED:** Once an amendment is accepted, it will be published in the *Official Gazette* along with the other amendments.



Examples of Acceptable Amendments

From	To
Phonograph records featuring music	Musical sound recordings
Prerecorded video cassettes in the field of mathematics instruction	Video recordings featuring mathematics instruction
Floppy discs for computers for word processing	Providing on-line downloadable software for word processing
Downloadable software for use in database management	Software as a service (SAAS) services featuring software for use in database management
Printed books in the field of art history	Downloadable electronic books in the field of art history
Telephone banking services	On-line banking services
Entertainment services, namely, an ongoing comedy series provided through cable television	Entertainment services, namely, an ongoing comedy series broadcast via the Internet

Examples of Unacceptable Amendments

From	To	Reason
Downloadable software for use as a spreadsheet in the field of accounting	Providing on-line non-downloadable software for use as a spreadsheet in the field of business management	Subject matter changed from accounting to business management
Printed Magazines in the field of finance	Printed magazines in the field of finance; and providing on-line magazines in the field of finance	Still using goods in original form
Phonograph records featuring music	Streaming of audio material in the nature of music	Moving from one medium to a separate data transmission activity
Video game tape cassettes and video game cartridges	Video game discs and video game cartridges	Still using with video game cartridges