

## **Announcement of Pilot Program to Allow Amendments to Identifications of Goods and Services in Trademark Registrations Due to Technology Evolution**

On September 1, 2015, the USPTO will commence a pilot program to allow, under limited circumstances, amendments to identifications of goods/services in trademark registrations that would otherwise be beyond the scope of the current identification. Amendments will be permitted where they are deemed necessary because evolving technology has changed the manner or medium by which the underlying content or subject matter of the identified products and services are offered for sale or provided to consumers. This pilot program is based on user input, including a roundtable discussion on April 11, 2014, a request for comments on the proposal issued on September 4, 2014, and numerous discussions with practitioners.

This piloted change in trademark practice takes into account the policy goal of preserving trademark registrations in situations where technology in an industry has evolved in such a way that amendment of the goods/services in question would not generate a public-notice problem. The duration of the pilot will depend on the volume of requests.

### **Amendment Requirements**

- Amendments will be permitted post-registration upon petition to the Director under Trademark Rule 2.146, 37 C.F.R. §2.146. During the pilot period, amendments will not be permitted prior to registration.
- The petition procedures only apply to amendments not permitted under current practice because they would be considered to be beyond the scope of the current identification. Amendments permitted under current practice remain unaffected by these procedures. For example, a petition would not be necessary for an amendment from “newsletters in the field of accounting” in International Class 16 to “providing on-line newsletters in the field of accounting” in International Class 41 because, regardless of the change in classification, such an amendment falls within the scope of the original wording, and would be permitted under current practice. *See* TMEP §1402.07(c).
- In the proposed amendment, the existing goods/services for which the petitioner is no longer able to show use must be replaced with the goods/services in their evolved form.
- Amendments will only be permitted in situations where the registrant is no longer able to show use of the mark with the goods/services in their original form due to evolving technology. If the registrant is continuing to use the mark with the goods/services in their original form, a new trademark application may be filed in order to seek registration for the evolved goods/services.
- Amendments that change the classification of the goods/services and change the identification from goods to services (or vice versa) may be considered. However, proposed amendments must comply with all applicable rules and requirements, including current requirements regarding specificity and classification.

- U.S. registrations under §66(a) of the Trademark Act, 15 U.S.C. §1141f(a), are based on the underlying international registration for a period of five years from the international registration date. Thus, during that period, the scope of the international registration will factor into determining the acceptability of the amendment.
- Since registrations under §44(e) of the Trademark Act, 15 U.S.C. §1126(e), exist independent of the underlying foreign registration, the scope of the foreign registration will not factor into determining acceptability.
- The USPTO will post on its website a non-exhaustive list of acceptable amendments under the new practice, to be updated periodically as amendments are permitted. Examples of acceptable and unacceptable amendments have been provided below.
- 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.

### **Petition Requirements**

- The petition must meet all requirements of Trademark Rule 2.146, 37 C.F.R. §2.146, including payment of the petition fee.
- On petition, the petitioner must request a waiver of the “scope” rule, Trademark Rule 2.173(e), 37 C.F.R. §2.173(e). Trademark Rule 2.173(e) provides that 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.
- Under Trademark Rules 2.146(a)(5) and 2.148, 37 C.F.R. §§2.146(a)(5) and 2.148, the Director may waive any provision of the rules that is not a provision of the statute, when: (1) an extraordinary situation exists; (2) justice requires; and (3) no other party is injured.
- In order to show that an extraordinary situation exists, for which justice requires a rule waiver, the petitioner must declare, to the best of petitioner’s knowledge, that:
  - 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.
- The petitioner must additionally declare that it will not file (or refile, if applicable) an affidavit or declaration of incontestability under §15 of the Trademark Act, 15 U.S.C.

§1065, as to the evolved goods/services for a period of at least five years from the date of acceptance of the amendment. For additional information, see “Third-party Harm Considerations,” below.

- The petitioner must (1) submit a specimen showing current use of the mark in commerce on or in connection with the amended goods/services; and (2) provide dates of use for the goods/services in their evolved form, both verified with an affidavit or signed declaration under Trademark Rule 2.20, 37 C.F.R. §2.20. Although the original dates of use would remain in effect in the registration, the “evolved” dates would be made of record within the TSDR database.
- The petitioner must additionally submit as part of the petition a request for amendment that meets the requirements of §7(e) of the Trademark Act, 15 U.S.C. §1057(e), including payment of the prescribed fee. Accepted amendments will be published in the *Official Gazette* with other accepted §7 amendments, and an updated registration certificate will issue.
- Petitioners must file their petitions and requests for amendment under §7 together through the Trademark Electronic Application System (TEAS) using the “Petition to the Director under Trademark Rule 2.146,” form number 3, located under [Petition Forms](#). The free-text area of the form may be used to provide both the information needed on petition and the proposed amendment under §7. For proper handling, the petition should be captioned “Petition to Allow Amendment Due to Technology Evolution.” The required specimen must be attached to the form and both the “petition fee” and §7 “filing amendment to registration fee” must be provided. The declaration may be used to support both parts of the filing.

### **Third-Party Harm Considerations**

- The USPTO will perform a new search of Office records in considering possible third-party harm in allowing the amendment.
- Any “incontestable” status under §15 of the Trademark Act, 15 U.S.C. §1065, that applied to the original goods/services will not apply to the newly amended goods/services in their evolved form. Moreover, in order to reduce the possibility of third-party harm in relation to registrations, the petitioner must declare that it will not file (or refile, if applicable) an affidavit or declaration of incontestability under §15 as to the evolved goods/services for a period of at least five years from the date of acceptance of the amendment.
- As an additional means of reducing the possibility of third-party harm and to provide a mechanism for interested parties to comment about proposed amendments prior to acceptance, the USPTO will publish on a webpage, to be accessed from the [Trademark Official Gazette](#) and [Trademark Official Gazette Notices](#) webpages of the uspto.gov website, all proposed amendments that appear likely to be acceptable prior to granting the petition and amending the registration. Interested parties will have 30 days from

publication to comment on proposed amendments and such comments will factor into assessing the third-party harm aspect of the petition.

- Comments regarding proposed amendments may be submitted to [TMTEvolutionComments@uspto.gov](mailto:TMTEvolutionComments@uspto.gov). Commenters are encouraged to explain the potential third-party harm and provide supporting evidence when available. Comments relevant to the decision may be included in the electronic records for the registration at the discretion of the Director.

### **Examples of Acceptable and Unacceptable Amendments**

#### **Acceptable Amendments**

- “Phonograph records featuring music” in International Class 9 to “Musical sound recordings” in International Class 9
- “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
- “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
- “Printed books in the field of art history” in International Class 16 to “Downloadable electronic books in the field of art history” in International Class 9
- “Telephone banking services” in International Class 36 to “On-line banking services” in International Class 36
- “Entertainment services, namely, an ongoing comedy series provided through cable television” in International Class 41 to “Entertainment services, namely, an ongoing comedy series broadcast via the Internet” in International Class 41

#### **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: This amendment would not be allowed because the subject matter of the spreadsheet software has 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: This amendment would not be allowed because the petitioner is still using the goods in their current form and therefore would not be able to show that an extraordinary situation exists; absent the amendment, the petitioner would not lose protection in the registration in relation to the underlying content of the original goods. The petitioner may file a new trademark application for the services in International Class 41.

- “Phonograph records featuring music” in International Class 9 to “Streaming of audio material in the nature of music” in International Class 38.

NOTE: This amendment would not be allowed because the petitioner is attempting to amend the identification from a particular medium of music content to a separate data transmission activity. This proposed substitution of a different telecommunication-provider service is not acceptable as it does not maintain the original use of the mark to identify content provided in a new manner. An amendment would be permitted from “phonograph records featuring music” in International Class 9 to “providing on-line music, not downloadable” in International Class 41, which is a service of providing content in a new manner, i.e., “on-line.”

- “Video game tape cassettes and video game cartridges” in International Class 9 to “Video game discs and video game cartridges” in International Class 9.

NOTE: This amendment would not be allowed because although the petitioner is no longer using the mark on “video game tape cassettes,” it is still using the mark on “video game cartridges,” and therefore would not be able to show that an extraordinary situation exists; absent the amendment, the petitioner would not lose protection in the registration in relation to the underlying content of the original goods. The petitioner may file a new trademark application for “video game discs” in International Class 9.