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CLIENT ALERT

USPTO Announces Pilot Program Allowing Changes to Trademark Registration Coverage

In early September 2015, the U.S. Patent and Trademark Office (USPTO) commenced a pilot program that permits trademark registrants to amend the goods/services coverage of their existing registrations without forfeiting the priority provided by the underlying application filing date, claimed dates of first use, and/or registration grant date. In some cases the amendment may actually expand coverage beyond the existing identification, an exception to the normal rule that once an application is filed, coverage can only be narrowed, never expanded. While at first glance this might be viewed as an opportunity to audit your existing U.S. trademark portfolio and improve coverage or fill “gaps” without penalty, the program has some significant limitations.

Under previous USPTO practice, if the identification of goods/services contained items that were no longer in use due to technological advancement, trademark owners were required to file new trademark applications to cover the new technology goods/services. Under the pilot program’s requirements, a trademark owner may petition the USPTO to amend the existing goods/services identification due to such advancements, if the owner is “no longer able to show use of the mark with the goods/services in their original form due to *evolving technology*” (emphasis added). If the petition requirements are met, the pilot program provides an opportunity to update the goods/services in a registration via amendment while still retaining the old filing and use dates of the existing registration. For instance, music publishers may be able to amend registrations for “phonograph records featuring music” in International Class 9 to “musical sound recordings” in Class 9 to cover downloads of music.

The duration of the pilot program will depend on the number of amendment requests from trademark owners. After the end of the pilot, the USPTO will decide whether to allow such amendments on a permanent basis.

Description of the Pilot Program

The full pilot program and accompanying USPTO forms and guidelines are available at this link: <http://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>. But we summarize the key aspects of the pilot program below.



Amendments permitted under the pilot program allow for changes in the goods/services that would normally be considered beyond the scope of the original goods and services.ⁱ The program applies to U.S. registrations (not applications), including registrations based on foreign registrations and International Registrations.ⁱⁱ As noted above, the filing dates and dates of first use for the existing trademark registrations will be maintained, but the first use dates of the “evolved” goods/services will be made of record on a new registration certificate.ⁱⁱⁱ

Further examples of amendments deemed acceptable by the USPTO include the following^{iv}:

- “Floppy discs for computers for word processing” in Class 9 to “Providing on-line non-downloadable software for word processing” in Class 42
- “Downloadable software for use in database management” in Class 9 to “Software as a service (SAAS) services featuring software for use in database management” in Class 42
- “Printed books in the field of art history” in Class 16 to “Downloadable electronic books in the field of art history” in Class 9

Amendment requests must be submitted with (i) a specimen of use for each of the “evolved” goods/services, (ii) the dates of first use, (iii) a petition fee, (iv) a petition to the Director of the USPTO, and (v) a declaration that:

- the Registrant cannot show use of the original goods and services “due to evolving technology in the manner or medium by which products and services are offered for sale and provided to consumers”^v;
- the Registrant “still uses the mark on other goods/services reflecting the evolved technology, and the underlying content or subject matter remains unchanged”^{vi}; and
- without an amendment, the Registrant 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.”^{vii}

In addition, the Registrant must declare that it will not file or refile a declaration of incontestability for the evolved goods or services for at least five years from the date of acceptance of the amendment.”^{viii}

Consideration of “third-party harm”

The USPTO announcement stresses the steps that will be taken to avoid potential harm to third parties. For example, the USPTO will conduct a new search of the trademark registry for any conflicting registrations. In addition, the USPTO will publish for review by third parties a list of amendments likely to be successful, for a period of 30 days. Third parties will therefore have an opportunity to submit comments to the USPTO based on potential harm caused by any amendments.



Potential Concerns Raised by the Program

The program raises a number of uncertainties, particularly with respect to the requirement to maintain use of goods/services:

- Will there be any legal effect or implication from the admitted non-use of goods or services? In addition, a delay in filing an amendment may increase the period of any non-use.
- Will this program provide a way for a registrant to revive registrations that, because of non-use for over three years, were legally “dead”? Will this be a factor to be evaluated for possible third-party harm?
- The USPTO’s decisions on amendments may include some fine distinctions. For example, although the USPTO may allow amendment of “phonograph records featuring music” to “musical sound recordings”, amendment to “streaming of audio material in the nature of music” in Class 38 is deemed unacceptable. The USPTO has indicated that it will publish lists of acceptable amendments. This list should help to inform trademark owners and practitioners about what kinds of amendments are likely to be successful.

Conclusion and Suggested Actions

In light of the pilot program, we suggest that trademark owners and their representatives consider the following actions:

- Review existing trademark portfolios to see if goods/services listed on registrations have been superseded by evolving technology.
- Identify goods/services that are not in use when preparing to file a statement of use or declaration of use. There may now be an alternative to simply deleting goods and services that are no longer in use.

Our firm can help trademark owners evaluate their portfolios to determine whether amendments under the pilot program may be permissible. In some cases, filing a new application may still be the more appropriate step to take. We can also assist trademark owners with concerns about the potential harm from amendments filed by competitors and other third-parties. We will continue to monitor the development and impact of the pilot program.

For Further Information and Assistance

The Trademark & Copyright Department at Cantor Colburn LLP stands ready to answer any questions you may have about this USPTO pilot program.

Please do not hesitate to contact us if we can be of further assistance:

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ⁱ Under current practice, the goods and services identified in trademark registrations can be amended only if the amendment falls within the scope of the original registration. See *TMEP §1402.07(c)*.

ⁱⁱ Amendments to registrations based on foreign registrations (under §44(e)) and International Registrations (under §66(a)) are treated differently. The scope of goods and services of an International Registration will factor into determining acceptability of any amendments to a §66(a) registration for the first five years from the registration date of the International Registration. By contrast, the scope of foreign registrations used will not play a role in the amendment of §44(e) registrations because they are considered by the USPTO to be independent of underlying foreign registration.

ⁱⁱⁱ It should be noted that any “incontestability” status will be removed for the “evolved” goods/services.

^{iv} See USPTO Pilot Program announcement, page 4.

^v See USPTO Pilot Program announcement, page 2.

^{vi} Id.

^{vii} Id.

^{viii} Id.