

US TM Prosecution Update – Is Your Trademark Portfolio Keeping Pace With Technological Evolution?

Late in 2015, the USPTO announced a pilot program designed to allow amendments to identifications of goods and services in trademark registrations due to technological evolution. Previously, at the time a renewal or other maintenance filing was due, a Registrant would be required to delete all goods and services with which a mark was no longer in use from its registration, and addition of new goods was not allowed for any reason. Under the old system, if a registrant had a mark registered for use with “phonograph records featuring music” and the registrant was no longer making records but was now making CDs or digital recordings, it could not maintain the registration for the goods claimed, nor could it amend the id to reflect the change. Now, the PTO is allowing changes of this nature in these limited circumstances where the change in use is a result of change in technology.

Other examples of acceptable amendments the PTO has provided include the following:

- “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.

Interestingly, the USPTO has opined that the following change would not be acceptable:

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

The USPTO note on the subject emphasizes that this change would not be acceptable because the petitioner attempts to amend not just the medium of the music content but rather introduces a separate data transmission activity. So, it appears that technological changes that sound too transformative may be more difficult to reflect in amendments.



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To submit a successful petition for such an amendment, the petitioner must declare, to the best of the petitioner's knowledge, that:

- A) based on the changes in technology, the petitioner cannot show use on the original goods/services;
- B) the registrant still uses the mark on other goods/services reflecting the technology change and the underlying content remains unchanged; and
- C) without the amendment, the petitioner would be forced to delete the original goods/services from the registration and thus lose protection relating to the underlying content.

The duration of the pilot will depend on the volume of requests. The USPTO is publishing a webpage in which all proposed amendments that appear likely to be acceptable will appear prior to granting the granting and amending the registration. The proposed amendments can be located on the USPTO site at this link:

<http://www.uspto.gov/trademark/trademark-updates-and-announcements/proposed-amendments-identifications-goods-and-services>. Interested parties will have 30 days from publication to comment and those comments will be considered in reviewing the petition.

Encourage your clients to review their U.S. trademark portfolios and consult with U.S. trademark counsel to determine if their registrations should be amended to reflect the technological changes in their industry. If amendments are warranted, it is advisable to act now as it is unclear how long the pilot program will be in effect.