TURNING RECORDS INTO DIGITAL DOWNLOADS: USPTO INTRODUCES TECHNOLOGY EVOLUTION AMENDMENTS

In the past, changes in technology rendering registered goods and services obsolete could have dire consequences for US registrations. Because of the very limited permissible scope of amendment, trademark owners were often forced to file new applications and allow their existing registration to lapse at the risk of sacrificing priority rights along with the delay, expense and uncertainty involved with filing a new trademark application. Recognizing this hardship, the USPTO recently introduced a Pilot Program designed to permit technology-based amendments to identifications of goods and services that would have previously been considered “beyond the scope” of the current identification.

Petition to Allow Amendment Due to Technology Evolution

Under the Pilot Program, trademark owners seeking technology based amendments must petition the Director by filing a sworn declaration stating 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 or services;
- The petitioner still uses the mark on other goods or 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 or services from the registration, and thus lose protection in the registration in relation to the underlying content or subject matter of the original goods or services.

Upon submission, the USPTO will perform a new search of Office records and the USPTO will also publish on its website all proposed amendments that are likely to be accepted prior to granting the petition and amending the registration. Interested third parties will be given 30 days from publication to comment on the proposed amendments, and these comments will be taken into consideration when assessing third-party harm. The USPTO has encouraged commenters to explain third-party harm and provide supporting evidence. Comments that are relevant to the USPTO’s final decision may be included in the electronic records for registration.
Acceptable Amendments

By way of example, the following are the type of amendments the USPTO will be accepting:

**Original Identification**
“Phonograph records featuring music” in Class 9.

“Floppy discs for computers for word processing” in Class 9.

“Printed books in the field of art history” in Class 16.

**Amended Identification**
“Musical sound recordings” in Class 9.

“Providing on-line non-downloadable software for word processing” in Class 42.

“Downloadable electronic books in the field of art history” in Class 9.

The Pilot Program is not available to trademark owners that are still providing “old technology” along with their “new technology.” Therefore, it would not be acceptable to amend from “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. This is simply not the kind of extraordinary situation warranting relief under the Pilot Program.

Considering the increasing pace of technological evolution, there is a significant risk that many of your client’s existing trademark registrations are susceptible to cancellation on the grounds of abandonment. If you are interested in amending your existing goods and services, rather than bearing the risk of filing new trademark applications, now is the time to file a petition to allow amendment due to technology evolution. The duration of the Pilot Program will depend upon the volume of requests. Nath, Goldberg & Meyer is available to assist in protecting your valuable trademark rights. Please contact us if you have any questions regarding the Pilot Program.

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