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October 22, 2014

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Deborah Cohn

Commissioner for Trademarks

U.S. Patent and Trademark Office

P.O. Box 1451

Alexandria, VA 22313-1451

Re: *Comments on Proposal to Allow Amendments to Identifications of Goods and Services Due to Technology Evolution*

Dear Commissioner Cohn:

I write on behalf of the American Bar Association Section of Intellectual Property Law (“ABA-IPL Section” or “Section”) in response to the United States Patent and Trademark Office’s (“USPTO” or “Office”) *Proposal to Allow Amendments to Identifications of Goods and Services Due to Technology Evolution* (the “Proposal”). The American Bar Association is the largest voluntary professional association in the world, and the ABA-IPL Section is the largest intellectual property law association, with nearly 23,000 members. The views expressed in this letter are those of the Section. These comments have not been approved by the ABA House of Delegates or Board of Governors and should not be considered as views of the American Bar Association.

The Section appreciates the Office’s inquiry regarding possible changes to USPTO policies regarding pre- and post-registration amendments, and specifically, its invitation for responses to the items set forth in the Proposal.

The Section provided comments last year in response to the Office’s *Request for Comments: Post Registration Amendments to Identifications of Goods and Services Due to Technology Evolution* (“*Request for Comments*”). Several of the issues and questions raised by the current Proposal were addressed by the Section at that time, and we take this opportunity to reaffirm the positions and opinions presented in the Section’s letter of November 27, 2013 (the “Letter”) (including those related to the availability of both pre- and post- registration amendments, the need for public notice and opportunity to comment, and the accuracy of dates of first use). A copy of the Letter is attached hereto for reference as Exhibit 1.

The Letter was supported by results of a survey taken of ABA-IPL members directed toward the issues in the Request for Comments. Where applicable to support the Section's response in this current letter, the Section again makes reference to that survey. Copies of both the survey results and a summary thereof are appended to the Letter (Exhibit A) as attachments.

While similar in scope, the current Proposal sets forth a more detailed and focused amendment process and procedure than that initially contemplated in the previous Request for Comments. As such, the Section is limiting its response herein to only those new issues presented by the Proposal not previously addressed in the Letter.

1. Re: the Office's proposed process for amending identifications of goods/services based on changes in the manner or medium by which products and services are offered for sale and provided to consumers due to evolving technology.

The Section respectfully disagrees with the Office's proposed amendment policy, whereby owners of registrations and pending applications seeking such amendments would be required to not only submit a Section 7 request for amendment (for registered marks), but would also be required to petition the Director requesting a waiver of the applicable "scope" rule (Trademark Rule 2.71(a), pre-registration, or Rule 2.173(e), post-registration) pursuant to Trademark Rule 2.146 and make a showing that an "extraordinary situation" exists. This would require declarations by the petitioner that the mark in question is no longer used in connection with the original goods/services, and that the petitioner is using the mark in connection with goods/services reflecting evolved technology.

As supported by the survey results, the Section generally favors a change to the current amendment policy to accommodate evolving technology, so long as the subject matter of the goods/services is unchanged and the change in medium of the good/services due to evolving technology does not materially expand the scope of the identification of the goods/services in the registration or application.¹ Accordingly, the Section views the amendment process set forth in the Proposal as more complicated and restrictive than is necessary to accomplish the goals of a broader amendment policy aimed at accommodating new technology.

The Section is in favor of allowing the amendments contemplated herein based on the premise that such amendments are necessarily non-material and/or do not change the scope of the application or registration at issue. If the amendment is neither material nor changes the scope, it follows that a waiver of the applicable "scope" rule and a showing of an "extraordinary situation" is likely unnecessary.

¹ 91% of survey respondents were in favor of a broader post-registration amendment policy. Of those in favor, 13% responded that, so long as the subject matter of the respective product or service is unchanged, the trademark owner should not be required to file a new separate application; 28% responded that a mere change in medium of delivery of the good/service due to evolving technology does not materially expand the scope of the identification of the goods/services in the registration; and 50% agreed with both of these statements.

2. Re: the Proposal’s requirement that a trademark owner show that an “extraordinary situation” exists.

The Section does not favor requiring owners of registrations and applications to declare that their marks are no longer in use in connection with the original goods/services (in addition to declaring that the marks are in use in connection with the evolved technology). Similar to our initial point, if an amendment based on evolving technology is not considered material, then arguing that an “extraordinary situation” exists seems unnecessary and overly burdensome. Additionally, Owners that use their marks in connection with both older and evolved technologies would be prejudiced by the Office’s proposed policy. For example, consider two hypothetical trademark owners: (i) the owner of a mark originally registered in connection with vinyl records that ceases use of the mark for vinyl records and commences use of the mark for MP3s (“Owner 1”); and (ii) the owner of a mark originally registered in connection with vinyl records may currently be using the mark in connection with respect to MP3s, while still using the mark in connection with vinyl records (“Owner 2”). Owner 1 would be permitted to amend its registration to include “MP3s” and claim priority going back to its priority date for vinyl records. But Owner 2 would be prejudiced by its decision to continue selling vinyl records: it would be limited to filing a new application for its mark for MP3s and could not claim an earlier priority date applicable to its prior registration for vinyl records.

While the Section favors a change to the current amendment policy, we believe the new process and requirements set forth in the Proposal are too restrictive.

3. Re: the Office’s proposal that petitioners requesting amendments due to evolving technology must abandon any “incontestable” status under § 15 of the Trademark Act, 15 U.S.C. § 1065, as to the evolved goods/services, and must declare that they 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 five years from the date of amendment.

The Section generally supports the Office’s proposal to require owners of registrations to abandon incontestable status under Section 15 as to the evolved goods/services. However, the Section respectfully disagrees with the Office’s proposal that owners be prohibited from filing an affidavit or declaration of incontestability until five years after the date of the amendment. If a trademark owner can show at least five years of continuous use of the mark in connection with the goods/services at issue in the amendment (e.g. the evolved technology), the Section sees no reason why owners should not be able to immediately claim incontestable status under Section 15 as to those evolved goods/services, if they meet the other relevant requirements under the statute.

Sixty-one percent (61%) of survey respondents concurred with the proposition that, if the essential nature of the good or service has not changed, the medium by which the public receives the good or service should not affect the timing of its entry into the marketplace. Accordingly, the Section noted in its previous letter that it does not believe amendments based on evolved technology should necessitate a change in registrants’ dates of first use. The Section believes a requirement that owners be automatically prohibited from claiming incontestable status for five

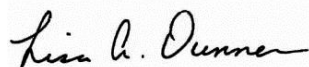
years from the date of the amendment would be inconsistent with a rule allowing registrants' to keep their original dates of first use.

Moreover, owners who obtain amendments based on evolved technology would necessarily have to declare that their marks have been in continuous use in commerce for a period of five years in connection with the evolved goods/services in order to claim incontestable status, the same as any other owner. If the amendments are justified on the basis that they do not materially expand the scope of the identification of the goods/services in the registration, then owners should not automatically be barred from claiming incontestable status until five years from the date of the amendment.² Alternatively, if the amendments are ultimately allowed only for goods and services that specify a particular medium, such as sound recordings or software (as favored by 55% of survey respondents) and the amended goods/services retain the same inherent and identifiable character (as supported by relevant case law³), then it is the Section's view that the benefit to owners in being able to immediately claim incontestable status outweighs any potential harm to third parties. For example, if the mark used in connection with vinyl records (see above) has been registered for 50 years, and Owner 2 is now requesting amendment of the registration to reflect the fact that the mark has been used in connection with MP3s for the past 10 years, there would seem to be no reason to require the owner to wait an additional five years before allowing the owner to claim incontestable status with regard to the evolved goods.

Conclusion

The ABA-IPL Section commends the Office for considering these issues and appreciates the opportunity to offer these comments.

Very truly yours,



Lisa A. Dunner
Section Chair
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Section of Intellectual Property Law

² 78% of survey respondents indicated that they do not consider a mere change in the medium of delivery of a good or service due to evolving technology to be a material expansion of the scope of the identification of goods and services.

³ See, e.g., *Ralston Purina Co. v. On-Cor Frozen Foods, Inc.*, 746 F.2d 801, 805 (Fed. Cir. 1984); *E.I. du Pont de Nemours & Co. v. G.C. Murphy Co.*, 199 U.S.P.Q. 807, 813 (T.T.A.B. 1978); see also *Societe de Developments et d'Innovations v. Int'l Yogurt Co.*, 662 F. Supp. 839, 852 (D. Or. 1987).