

October 30, 2014

The Honorable Michelle K. Lee
Deputy Under Secretary of Commerce for Intellectual Property and
Deputy Director of the United States Patent and Trademark Office
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

via email: TMPolicy@uspto.gov

**Re: AIPLA Comments in Response to the USPTO announcement “Request for
Comments on Proposal to Allow Amendments to Identifications of Goods
and Services Due to Technology Evolution”**

Dear Deputy Under Secretary Lee:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (“USPTO”) Notice entitled “Request for Comments on Proposal to Allow Amendments to Identifications of Goods and Services Due to Technology Evolution” (“Request”).

AIPLA is a national bar association with approximately 15,000 members who are primarily lawyers in private and corporate practice and government service and in the academic community. AIPLA’s members represent a wide and diverse spectrum of individuals, companies, and institutions, and are involved directly or indirectly in the practice of patent, trademark, copyright, and unfair competition law. Our members represent both owners and users of intellectual property.

AIPLA welcomes this opportunity to comment on the USPTO’s Request concerning post-registration amendments to identifications of goods and services due to technology evolution.

INTRODUCTION

The Request concerns amending identifications of goods/services due to changes in the manner or medium by which products and services are offered for sale and provided to consumers, particularly because of evolving technology. For example, users have sought to amend Class 9 computer software programs to providing software as a service in Class 42, or amend Class 9 audio cassettes, audio tapes, disks, diskettes, vinyl records to musical sound recordings in Class 9. The USPTO previously has taken the position that such amendments impermissibly expand the scope of a registration under 37 CFR Section 2.173(e) and Section 7(e) of the Trademark Act.

Under this proposal, registrants would be able to change their identification of goods or services to reflect changes and evolution in technology that have rendered the original goods or services obsolete, or that have been enhanced to the point where the original identification does not adequately or accurately describe the present iteration of the goods or services.

AIPLA recognizes that technology has had an enormous impact on commerce, and many goods and services that were commonplace years ago have been replaced by analogous but different goods and services. The question arises as to whether trademark applicants and registrants must file new applications requiring fees and other related costs to register the same marks for goods and services that are effectively the same as those in the original registration but for their evolution due to changes in technology. The alternative proposed by the USPTO is to allow registrants to amend their identification after registration to accurately reflect their goods and services due to the evolution of technology.

ANALYSIS

AIPLA believes that the purpose and procedures announced by the USPTO in this proposal are reasonable and legally sound. This change in practice would provide for review of the amendments through Petitions to the Director under Trademark Rule 2.146, require a Section 7 filing in the case of amendments to existing registrations resulting in publication in the Official Gazette, republication of applications in the case of amendments that are entered following the initial publication of the mark, and finally, nullification of any existing rights in a registration under Section 15 of the Trademark Act and postponement of invoking those rights for five years from the date of amendment.

However, AIPLA still has concerns about a number of points in the USPTO Request.

1. The proposal would require a statement to the effect that “the petitioner still uses the mark on other goods/services reflecting the evolved technology and the underlying content or subject matter remains unchanged.” This seems to suggest that the applicant/registrant already has such evolved goods in its application or registration. If that is the case, then amendment under this policy would not be necessary.
2. AIPLA is concerned about the statement referring to the petitioner amending the identification to one that does not limit protection to a particular medium in order to make the identification more flexible with regard to evolving technology. It is understood that these amendments will be reviewed for acceptability through the petition process; however, including this suggestion in the statement of policy could encourage overly broad amendments in order to allow for future evolutions in technology. This could result in unintended protection for goods or services that do not exist at the time of the amendment.

3. AIPLA has an on-going concern about amending goods to services and vice-versa. An example to illustrate the concern, as set forth in AIPLA's previous comments concerning this practice post-registration, could possibly be that a registration for phonograph records may be allowed to amend to compact discs, but to amend to streamed music could result in a notice problem for registrants with services such as radio broadcast services. With some difference in the marks, the radio broadcast service provider may not have been concerned with a registration for phonograph records or compact discs. However, an amendment to streamed music could be an issue for the radio broadcast service registrant.

Another example in the more unusual context of amending from services to goods, could be a request to amend from "consulting services in the field of business management" to "informational software in the field of business management." In this example, the subject matter is the same and the purpose of the information provided by both is the same, but the manner and means of providing the goods and services to the public is quite different.

Again, it is noted that these amendments will be reviewed through the petition process and each amendment will be evaluated on a case-by-case basis, and that there will be opportunities for third party intervention through an opposition or cancellation due to the lifting of any existing Section 15 rights. However, it may not be beneficial to include language in the proposal that focuses on the ability to move between goods and services. This would encourage submission of unacceptable amendments, often resulting in unproductive use of time for USPTO officials and outside counsel, and unnecessary expense on the part of applicants/registrants. It would be helpful if more examples of unacceptable amendments of goods to services or services to goods were included in the "Unacceptable Amendments" section of the proposal and, if the proposal is put into practice, also included in explanatory material that should accompany the announcement of the change in practice.

Conclusion

In conclusion, AIPLA's position is that this proposal has some very positive features. However, if it is implemented, great care should be taken that the notice requirement of the Lanham Act is served and that the amendments are appropriately supported by evidence that the applicant or registrant is actively engaged in the provision of the goods or service in the amendment. The USPTO has addressed these issues in its proposal but their importance merits this re-emphasis. Also, more examples of unacceptable amendments of goods to services and services to goods should be included, in order to reduce submission of unacceptable amendments.

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Thank you for giving AIPLA the opportunity to provide comments on this important initiative. AIPLA looks forward to further dialogue with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO's mission.

Sincerely,

A handwritten signature in black ink, appearing to read "Sharon A. Israel", enclosed in a thin black rectangular border.

Sharon A. Israel
President
American Intellectual Property Law Association