

International Trademark Association

Comments in Response to:

Informal Request for Comments Regarding a Proposal to Allow Amendments to Identifications of Goods and Services Due to Technology Evolution

The International Trademark Association (INTA) appreciates the opportunity to provide comments in response to the USPTO's request for comments regarding a proposal to allow amendments to identifications of goods and services due to technology evolution. The USPTO Subcommittee of INTA's Trademark Office Practices Committee prepared the following comments.

INTA is a not-for-profit membership association of more than 6,400 trademark owners and professionals from more than 190 countries, dedicated to the support and advancement of trademarks and related intellectual property as elements of fair and effective national and international commerce. One of INTA's key goals is the promotion and protection of trademarks as a primary means for consumers to make informed choices regarding the products and services they purchase. INTA serves as a leading voice for trademark owners.

INTA supports a limited change in practice to permit amendments to identifications of goods/services in situations where a trademark owner's use of a mark on goods/services has changed due to rapidly changing technology. Overall, INTA believes that the USPTO's proposal accomplishes that objective, but INTA notes the following issues and concerns regarding the proposal:

(1) Showing of an extraordinary situation

In order to establish the existence of an extraordinary situation under 37 C.F.R. §§2.146(a)(5) and 2.148 that necessitates waiver of the applicable "scope" rule, the proposal requires a registrant to make the unqualified statements that: (a) it cannot show use on the original goods/services; and (b) absent the requested amendment, it would be forced to delete the original goods/services from the application or registration. INTA recommends that the USPTO make the language of the required declarations less absolute. For example, petitioner could be required to declare that it "*has a reasonable belief*" or "*to the best of petitioner's knowledge*" it cannot show use on the original goods/services listed in the registration.

As currently proposed, the showing of extraordinary situation would require the petitioner to declare in absolute terms that no current use of the goods/services identified in the registration exists. In certain cases, making such a statement may not be possible or would be impracticable, such as cases where the petitioner may have residual minimal use on the goods/services in question, despite having transitioned to a new technology. Consequently, INTA recommends that this requirement be amended to a less categorical statement, namely a declaration indicating that the petitioner, on information and belief, is no longer able to demonstrate current use of the mark for the good/services identified in the registration and is/or may be at risk of having to delete the original goods/services in the very near future. Such a modified declaration would still ensure that the petitioner has

demonstrated the existence of an extraordinary situation and is entitled to amend the registration based on technology evolution.

(2) Ability of the public to contest the amendment

INTA believes that, in order to minimize the potential of third-party harm, it is essential for the public to have an opportunity to contest the amendment to the application or registration. For applications, the USPTO has proposed that a new search and republication of the application would be required, which would give the public the opportunity to oppose. For registrations, however, the only safeguard explicitly proposed is a waiver of incontestability. INTA notes that a waiver of incontestability under Section 15 does not mean that the five year term to cancel a registration under Section 14 is waived. So, under the present proposal, it is not clear that the public would have an opportunity to contest the amendment in a registration more than five years old. INTA notes that TMBP 307.02(c)(2) may provide a solution. The Section states:

When a Principal Register registration has been amended, the registration is subject to attack under Trademark Act § 14, 15 U.S.C. § 1064, to the extent that the amendment of the registration has in any way enlarged registrant's rights, as though the registration had issued on the date of the amendment. That is, even though the Trademark Act § 14, 15 U.S.C. § 1064 five-year period following issuance of the registration, or publication under Trademark Act § 12(c), 15 U.S.C. § 1062(c), may have expired, if a petition to cancel the registration is filed within the 5 years following the amendment of the registration, the petition is not limited to Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) grounds, to the extent that the amendment has in any way enlarged the registrant's rights. Rather, during the 5 years after the amendment, "the modified registration, not having been in existence for 5 years, may be challenged in a cancellation proceeding as long as petitioner states grounds [not limited to Trademark Act § 14(3) or Trademark Act § 14(5), 15 U.S.C. § 1064(3) or 15 U.S.C. § 1064(5) grounds] for the cancellation indicating how he believes he is or will be damaged by the modified registration."

Therefore, INTA suggests that the USPTO should clarify that, following amendment of the registration under this proposal, the registration would be subject to cancellation under TMBP 307.02(c)(2) for a new five year term to the extent that the basis for the cancellation arises from the amendment to the registration (e.g., the amendment to the goods or services renders the registration confusingly similar to the petitioner's prior mark, or renders the mark merely descriptive for the amendment goods or services).

(3) The amended specification should be required to specify the current use medium.

The USPTO proposal specifies the following:

- "[E]xisting goods/services for which the petitioner is no longer able to show use should be replaced with the goods/services in their evolved form."
- "The petitioner may wish to consider, when practical and possible, 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."

INTA believes that the petitioner should be able to substitute the current medium/technology for that which has become obsolete, but should not be allowed to amend the identification to delete a medium of distribution or technology reference where a medium or technology appears in the original registration. Such an amendment could potentially result in an expansion of the scope of goods/services covered by the registration beyond the current technology used by the petitioner. In cases where amending the medium of distribution or a technology reference is at issue, the subject matter or details related to the content of the goods/services should be indicated to minimize the potential of expanding rights.

The language “amending the identification to one that does not limit protection to a particular medium” suggests that the resulting identification could be broader than the original. A substantially broader specification of goods/services could bestow a significant advantage upon a petitioner and potentially prejudice third parties who use a similar mark on goods/services that do not conflict with the petitioner’s original specification but do conflict with the amended goods/services specification.

INTA supports the USPTO’s effort to help trademark owners avoid forfeiture of their longstanding registrations due to technology evolution. However, INTA believes that amendments should not enable a petitioner to enlarge the scope of its rights materially without providing the public with notice and the opportunity to oppose. Rather, the petitioner should be required to replace a reference to obsolete technology in its specifications of goods/services with the current technology used by the petitioner. If a trademark owner wishes to delete the medium of goods/services delivery from its specification altogether, and such a goods/description would be acceptable under current Office practice, a trademark owner should consider filing a new application that would be subject to examination and publication for opposition.

(4) Clarification regarding date(s) of first use

The USPTO proposal requires petitioners to provide a date of first use of the goods/services in their evolved form to be made of record within the TSDR database. INTA encourages the USPTO to clarify that, although a petitioner must provide dates of use for the goods/services in their evolved form, the date of first use in the application/registration will remain as it was stated prior to the amendment due to technological change, and the date(s) of use in the evolved form will be provided for informational purposes only, rather than for purposes of establishing priority.

(5) Guidelines

The USPTO proposes to publish a non-exhaustive list of acceptable and unacceptable amendments, but it does not propose to issue general guidelines or criteria for permitted amendments. INTA reiterates its suggestion from its response to the USPTO’s Request for Comments last year, that in addition to a listing of acceptable and unacceptable amendments (which could be presented in a form similar to the Acceptable Identification of Goods and Services Manual), the USPTO should publish guidelines identifying the appropriate criteria and circumstances that qualify as an “extraordinary situation” where the requested amendment does not appear in a list of acceptable amendments. Such criteria might include:

- That the amendment does not change the essential function of the original goods/services, or intended market for the original goods/services, but rather changes only the medium of delivery of the goods/services;
- That the relevant industry is engaged in a transition from the older form of the goods and services to the newer form due to technology evolution; and

The amended goods and services otherwise comply with applicable rules and requirements regarding specificity and classification.

Conclusion

In conclusion, INTA supports the USPTO's effort to address the loss of rights that trademark owners suffer due to rapidly evolving technologies and looks forward to further discussions with the USPTO regarding the issues raised in its comments.