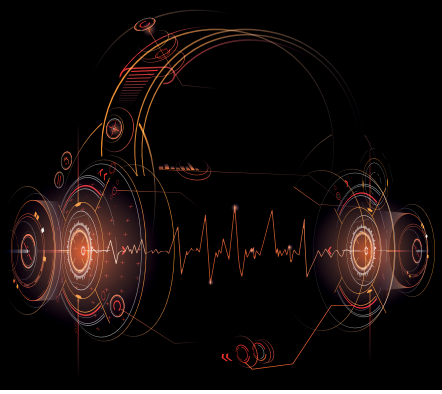
Trademark law and evolving technology



The USPTO's pilot programme may bring life to outdated registrations, explain **Farah Bhatti** and **Amanda Alameddine**

Own a trademark registration covering goods or services that have become obsolete due to technological advances? Does your trademark registration cover content delivered by floppy discs that are now provided as online software or printed books that are now only offered electronically? While trademark owners previously would have been forced to file a new application if an evolved good was no longer within the scope of the original identification, a new programme offered by the US Patent and Trademark Office (USPTO) gives trademark owners an opportunity to capitalise on prior registrations and preserve valuable trademark rights in their evolving business.

In September, the USPTO launched a pilot programme to allow amendments to the identifications of goods or services in certain trademark registrations, where evolving technology has changed the manner or medium by which the underlying content is offered to consumers. The goal of the programme is to preserve trademark registrations in situations where technology has advanced in such a way that an amendment would not create a problem of public notice.

In order to take advantage of this programme, registrants will need to file a petition to the director to propose the amendment. Under current trademark rules, the director may waive any provision of the rules when an extraordinary situation exists, justice requires a rule waiver and no other party is injured.

Here, the rule to be waived is the one covering scope – Rule 2.173(e) – which provides that no amendment to the identification of goods or services in a registration will be permitted, except to restrict the identification or change it in ways that would not require republication.

In order to show that an extraordinary situation exists, the petitioner must declare 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 with regard to the underlying content or subject matter of the original goods or services.

Amendments will only be permitted if the registrant can no longer show use of the goods or services in the original form due to evolving technology. Amendments will not be permitted if the registrant continues to provide the goods or services in the original form and is attempting to add a more evolved version to the existing registration. As long as the amendment complies with the applicable rules, an amendment can change the classification of the goods or services and will be permitted even if it changes a good into a service or *vice versa*.

The USPTO has provided a list of acceptable and unacceptable amendments under the new programme. In addition to the examples listed previously, the non-exhaustive list of acceptable amendments includes changing certain wording from "phonograph records featuring music" to "musical sound recordings", "prerecorded video cassettes" to "video recordings" and "telephone banking services" to "online banking services". An example of an amendment that would not be accepted is changing "phonograph records featuring music" to "streaming of audio material in the nature of music". This amendment would not be accepted as it attempts to change the medium of music content to a separate data transmission activity. Rather, an acceptable amendment for "phonograph records featuring music" would be "providing online music, not downloadable".

For US registrations based on international registrations under §66(a) of the Trademark Act, the scope of the international registration will factor into the acceptability of the amendment during the five-year period in which the US registration is tied to the underlying registration. For registrations under §44(e) of the Trademark Act, which exist independently of the underlying foreign registration, the scope of the foreign registration will not affect the amendment's acceptability.

One thing to note is that any incontestable status will not apply to the amended goods. In addition, the registrant must declare that it will not file or refile a section-15 declaration of incontestability as to the evolved goods or services for a period of at least five years from the acceptance of the amendment.

Accepted amendments will be published in the *Official Gazette* along with other section-7 amendments, which will give third parties 30 days to comment on the proposed amendment. The USPTO will consider the comments when assessing the third factor of the test: third-party harm. If the amendment is deemed acceptable after the public comment period, an updated registration certificate will issue.

The duration of the programme is undecided and will depend on the volume of requests received. Therefore, it would be wise for registrants with older trademark registrations to look at their portfolios and determine whether they should take advantage of this programme. This programme may also be valuable to parties considering the acquisition of old portfolios. As the USPTO considers new amendment requests in order to adapt to the constant innovation spurred by today's world, more guidance will come to light on how this programme can be used to promote the public-policy goal of preserving trademark registrations that have become obsolete.

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