IP: USPTO seeks comments on amendments to identifications of goods and services

The technology revolution has forced a change in USPTO identification standards. BY JOHN McELWAINE

As technology advances, it is not unusual for products to change their form or the manner of their delivery but still be seen as the same, or at least analogous, products in the eyes of the consumer. For instance, computer programs started out as being delivered on punch cards, and transitioned to magnetic tape, then to floppy disks, hard disks, CDs and DVDs. Now, computer software is downloaded wirelessly or hosted in the cloud.

Section 7(e) of the Trademark Act, allows a registration based on an application under §1 or §44 of the Trademark Act to be amended, provided the amendment does not materially alter the character of the mark. With respect to the identification of goods/services, pursuant to 37 CFR § 2.173(e), no amendment to the identification of goods in a registration will be accepted if the amendment would “change it in ways that would require republication of the mark.”

Unfortunately, the analysis or test for whether an amendment to the identification would require republication is not a clear standard. Further complicating this issue is USPTO guidance that “computer programs…” in Class 9 can be amended to “providing temporary use of non-downloadable computer programs…” in Class 42.

In other words, adding a method of delivery of such “programs” narrows the identification such that republication would not be required.

As a result, the USPTO in its request for comments indicated that it is seeing an increase in the “number of requests for amendment under §7, as well as inquiries from registration owners, seeking to amend 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.”

Examples of such requests include:
• Class 9 computer software programs to providing software as a service in Class 42
• Class 9 items featuring music (e.g., audio cassettes, audio tapes, disks, diskettes, vinyl records, etc.) to musical sound recordings in Class 9
• Class 16 printed magazines to providing on-line magazines in Class 41
• Class 41 entertainment services such as providing cable television entertainment programs to providing television entertainment via the Internet in Class 41

The USPTO summarized the typical argument in such cases, as follows: “[T]rademark owners typically assert that the amendment should be accepted because the content or subject matter of the respective product or service is unchanged. For example, in the case of amendments involving musical sound recordings, trademark owners explain that the music is the same, but it is simply no longer provided on audio cassettes, and now instead is provided on CDs or via downloadable audio files. They assert that merely changing the medium in which the identical music is being provided is not an expansion of the scope of the registration.”

As stated by the USPTO, “under current [Office] practice, changed circumstances, such as new technology, will not render acceptable an amendment that is not otherwise permissible.”

The example provided in the TMEP is that “if the goods in the registration are identified as ‘phonograph records’, the identification of goods cannot be amended to ‘compact discs.’” However, registration owners have argued in response that, particularly in cases where only the manner of distribution has changed, republication and additional notice to the public is unnecessary because the underlying products have not changed.

To assist the USPTO in developing policy on this issue, the USPTO has requested responses to the following ten questions be sent to TMFeedback@uspto.gov, with the subject line “Technology Evolution” no later than Nov. 1, 2013:
1. Please identify your relevant background on this issue, including whether you are a trademark owner or practitioner, and the general size and nature of your business or trademark practice, including the number of trademark applications and registrations your business has, or your practice handles.
2. Do you think the USPTO should allow amendments to identifications of goods/services in registrations based on changes in the manner or medium by which products and services are offered for sale and provided to consumers?
3. If such amendments are permitted, should they only be allowed post registration to account for changes in technology following registration, or should similar amendments be permitted in applica-
tions prior to registration (see 37 C.F.R. §2.71(a), stating that prior to registration, an applicant may clarify or limit, but not broaden, the identification)?

4. What type of showing should be required for such amendments? Should a special process be required to file such amendments, apart from a request for amendment under §7?

5. Should such amendments be limited to certain goods, services or fields (such as computer software, music, etc.), and if so, how should the determination be made as to which goods, services or fields?

6. Should a distinction be made between products that have been phased out (such as eight-track tapes), as opposed to products for which the technology is evolving (such as on-line magazines), or should amendments be permitted for both categories of products?

7. Do you believe the scope of protection in an identification of goods/services is expanded if an amendment is allowed to alter the medium of the goods/services?

8. Would the original dates of use remain accurate if such amendments are permitted?

9. What would the impact of such amendments be on the public policy objective of ensuring notice of the coverage afforded under a registration?

10. Please provide any additional comments you may have.

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