

Solution for Evolution in the Trademark Arena

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The USPTO's Welcome Initiative for Technology-Driven Changes in Registered Trademark Use.

Under a pilot program announced by the ***United States Patent and Trademark Office (USPTO)*** on September 1, 2015, trademark owners may now be able to maintain federal trademark registrations previously at risk of cancellation because of changes in their products and services attributable to the evolution of technology. If your business or organization has modernized its products or services, or the delivery method of its products or services, to accommodate advances in technology, we recommend a review of the company's US trademark portfolio to assess whether the company can take advantage of this pilot program. Doing so may allow your business or organization to salvage existing, but otherwise potentially unsupportable, registrations.

Background

Under USPTO rules, goods and services must be identified with specificity in all federal trademark registrations. Those identifications may be so specific that they do not reflect how quickly the goods and services may change due to technology advances. For example, trademark registrations may cover such goods as phonograph records, video cassettes, or floppy discs, or refer to the provision of services by telephone or by facsimile. Given developments in technology, the owners of such trademark registrations may continue to provide goods or services that have the same function, content, or subject matter, but in different formats, such as downloadable music files, electronic publications, or online services.

Under historic USPTO rules, trademark registrations often could not be amended to account for such technology shifts, where the amendments would be deemed to change or go beyond the original description of goods and/or services. Consequently, some trademark owners face losing potentially valuable registration protection.

The USPTO's pilot program is intended to help address these situations. Given the potential for harm to third parties in allowing amended identifications that go beyond the original scope, however, the pilot program is limited in nature. Its duration will be dictated by the volume of requests, and it has certain built-in protections to address third-party concerns.

When Will Such Amendments Be Permitted?

A number of requirements must be met for a registration amendment to be permitted by the USPTO under this pilot program. Such requirements include:

- The requested amendment must be submitted post-registration, and must be considered to go beyond the scope of the original identification. The registrant must request a waiver of the USPTO rule that permits amendment of the identification only where the amendment restricts the identification or changes it in a way that would not require republication.
- The registrant must no longer be using its mark in connection with the originally identified goods and/or services. If use continues on some or all of the original goods and/or services, a new application can and in many cases should be filed for the goods and/or services that reflect the technological evolution.
- The registrant must submit a Declaration, to the best of its knowledge, that:
- The registrant cannot show use of the mark with the original goods or services as a result of technological developments in the manner or medium in which they are offered;
- The underlying content or subject matter of the goods and/or services has not changed;
- The registrant would otherwise be forced to abandon the registration or at least delete the goods and/or services from the registration; and
- The registrant will not file (or re-file) a Declaration of Incontestability as to the amended goods and/or services for at least five years from the date of acceptance of the amendment.
- The registrant must submit a specimen of current use of the mark in commerce in connection with the goods and/or services (as proposed to be amended) and a date of first use for such amended goods and/or services. The registration's first-use date(s) for the original goods and services will remain in effect; however, the date(s) of first use for the amended goods and/or services would also be made of record.
- Requests must be submitted to the USPTO electronically as a Petition to the Director (specifically, captioned as a Petition to Allow Amendment Due to Technology Evolution), with a request for amendment under §7 and payment of \$200 (covering the current petition fee and the fee to file the amendment to the registration).

What Types of Amendments Will Be Permitted?

The USPTO's announcement of the pilot program provides some guidance on acceptable versus unacceptable amendments, a few examples of which are noted below. The USPTO will also provide a list of acceptable amendments on its website, which will be updated from time to time.

Acceptable Amendments

- "Downloadable software for use in database management" in Class 9 to "Software as a service (SAAS) services featuring software for use in database management" in Class 42.
- "Printed books in the field of art history" in Class 16 to "Downloadable electronic books in the field of art history" in Class 9.
- "Telephone banking services" in Class 36 to "On-line banking services" in Class 36.

Unacceptable Amendments

- "Downloadable software for use as a spreadsheet in the field of accounting" in Class 9 to "Providing on-line non-downloadable software for use as a spreadsheet in the field of business management" in Class 42. (This amendment would change the subject matter).

- “Phonograph records featuring music” in Class 9 to “Streaming of audio material in the nature of music” in Class 38. (This amendment would change the medium to a different data transmission activity and therefore would not maintain the original use. An acceptable alternative would be “providing on-line music, not downloadable” in Class 41.)

Third-Party Considerations

The USPTO will take several steps to take into account potential third-party harm associated with requested amendments, including conducting a search of USPTO records, publishing proposed amendments that appear acceptable prior to amending the associated registrations, allowing 30 days for interested parties to comment and explain potential third-party harm, and not extending any existing incontestable status to the amended goods and/or services or allowing a Declaration of Incontestability as to the amended goods and/or services for at least five years after the amendment is accepted.

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National Law Review, Volume V, Number 274

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