

International Trademark Association

Comments in Response to:

Informal Request for Comments Regarding Post Registration 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 potential change in practice 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.

Overall, INTA believes that a limited change in practice to permit amendments to identifications of goods/services that meet carefully defined criteria could alleviate the difficulties experienced by trademark owners that are subject to rapidly changing technology without causing an impermissible expansion of the scope of protection granted under a registration.

The comments below follow the questions posed in the notice.

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.

Response: INTA is a not-for-profit membership association of more than 6,300 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. Representatives of over 35 trademark owners and professionals from the United States are members of the USPTO Subcommittee of INTA's Trademark Office Practices Committee. The Subcommittee's mission is to serve as INTA's liaison with the USPTO, to evaluate practices, procedures, operations and regulations at the USPTO, and to support the USPTO's development of policies to improve such practices, procedures, operations and regulations through formal and informal comments and dialogue.

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?

Response: INTA supports such an amendment in limited and specifically defined circumstances. Such an amendment would be appropriate where: (1) there is no expansion of the goods/services in the identification as amended; (2) the proposed amendment to the

goods/services in the registration is limited to a change in the technology or manner or medium of delivery of the goods/services; (3) there is no material alteration to the essential nature of the goods/services identified in the registration (for example, there is no change in the functionality of the goods/services or in the class of purchasers of the goods/services); and (4) the change to the identification of goods and services, being immaterial, does not require republication of the registration (hereinafter referred to as “amendment criteria”).

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 applications 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)?*

Response: INTA believes that, as long as the above-defined amendment criteria are met, such amendments should be allowed both pre- and post-registration. Because there are circumstances under which an application might be pending for multiple years, whose goods or services therefore might encounter similar issues brought about by technology evolution, the rationale for allowing post-registration amendments appears to apply equally to amendments prior to registration.

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?*

Response: INTA suggests that the USPTO develop guidelines that focus on the criteria for permitted amendments, and provide a list of illustrative examples of goods/services whose technology has changed and/or where the mode of delivery of such goods/services is known to have evolved, together with descriptions and classes that reflect the new mode of delivery. It would be most helpful for the USPTO to provide guidance similar to the U.S. Acceptable Identification of Goods and Services Manual (“ID Manual”) so the public will have clear examples of acceptable amendments to identifications due to technology evolution. By way of example, the “Amendment Manual” might include:

- Prior Goods/Service Description
- Prior International Class
- New Goods/Services Description
- New International Class (if applicable)
- Effective Date of the Permitted Amendment

Once a “new” change in technology not previously included in the Amendment Manual has been approved, the Manual could be updated to include that new technology amendment. The Amendment Manual might be updated periodically, on a schedule similar to that of the ID Manual.

INTA believes that a special showing should be required for such amendments *if* the type or category of proposed amendment is not among the examples in the USPTO’s official guidelines. The party submitting such an amendment should be required to demonstrate that the proposed amendment does not change to the essential form and/or function of the original goods/services, or intended market for the original goods/services, but rather changes only the manner or mode of delivery of the goods/services.

A separate TEAS form, or a new section in the Section 7 TEAS form, could be developed specifically for use in requesting such amendments. The form would include a list of pre-approved amendments that meet the amendment criteria (for example, amendment of an ID for “phonograph records featuring music in International Class 9” to “providing nondownloadable prerecorded music via the Internet in International Class 41”). If an amendment not appearing on the list is sought, the requesting party would have the opportunity to click “OTHER” and submit an argument that details how its proposed amendment meets the Office’s criteria for amendment due to technology evolution.

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?*

Response: INTA does not believe that such amendments should be categorically and expressly limited to certain goods, services or fields. As long as the requesting party can demonstrate the applicable amendment criteria (see Response to Question 2 above), its amendment should be permissible.

At the same time, INTA recommends that the USPTO maintain an approved list of acceptable amendments analogous to the Identification Manual, the aforementioned “Amendment Manual”. As the TEAS Plus application form interfaces with Identification Manual, the applicable TEAS form (Section 7 or otherwise) should interface with the approved list in an “Amendment Manual” to facilitate expeditious processing of such amendment requests.

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?*

Response: INTA does not believe that a distinction should be made between products that have been phased out and products for which the technology is evolving. Rather, its position is that amendments should be permitted for both categories of products so long as the amendment criteria have been satisfied.

Apart from substantive reasons for not making a distinction, INTA also believes it would be difficult and impractical to determine what products/services are truly obsolete and what products/services are evolving.

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?*

Response: If INTA’s proposed guidelines are adopted, the scope of protection in an identification of goods/services would not be expanded by an amendment that alters only the medium of delivery of the goods/services. INTA considers such permissible amendments to be clarifying in nature, as the essential character of the goods/services remains unchanged. The only change in the registration is that the goods/services are provided in a different medium or form, which is not an expansion of the goods/services or of the rights in the mark.

INTA supports the efforts of the Trademark Office to simplify acceptable identifications of goods/services, and it encourages movement towards medium-neutral identifications to the extent consistent with the International Classification system. However, it is not recommending that a registrant be able to use the amendment process to broaden its rights in a registration. A registrant should be permitted to substitute a new medium of transmission or delivery of goods/services for the medium set forth in the original identification of goods/services, but should not be able to delete references to a medium of delivery altogether, even if a medium of delivery would not be required in a newly-filed application for the goods/services.

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

Response: As long as permitted amendments do not broaden the scope of the existing identification of goods/services, that is, the amendment does not alter the essential nature of the goods/services, but rather only updates the underlying technology or medium by which those goods/services are delivered, the original dates of use would remain accurate, and therefore they should be maintained in the registration. INTA recommends that, if such amendments are permitted, an additional statement should be added to the registration to indicate the original identification of goods/services, along with any previous post registration amendments to the identification of goods/services, for historical purposes. Keeping such data in the record also will provide context for the newly amended goods/services and the preserved original dates of use.

INTA also recommends that the registration be annotated to include, *for context purposes only*, the date on which the identification of goods/services in the registration was amended to reflect new technology. It should be noted, however, that the registration would continue to recite the original date of first use set forth in the registration. In other words, the date on which the amendment was made to reflect the new technology would not affect the priority of rights in the mark.

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

Response: In INTA's opinion, there should be no adverse impact on public policy ensuring proper notice of registration. With INTA's recommendation, the essential nature, purpose, function and scope of the goods/services identified in the registration remains the same. INTA's recommendation would permit amendments only to the mode or technology that delivers the goods/services, without, broadening or changing the nature or essence of the underlying goods/services set forth in the registration. Moreover, since classification alone does not affect substantive rights in a mark, a change in classification of a registration brought about by such an amendment would have no impact on notice of coverage afforded under a registration. Accordingly, there would be no need or requirement for republication of the mark.

10. Please provide any additional comments you may have.

Response: Due to the requirements of the International Registration system, at this time it does not appear that extensions of protection to the U.S. under the Madrid Protocol would be able to take advantage of the proposed change in practice. But if a change in practice is implemented, INTA would encourage discussions with WIPO to explore whether a similar change in practice could be made at the International Bureau.

INTA looks forward to further discussions with the USPTO about this issue.

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