

December 2, 2013

The Honorable Deborah Cohn
Commissioner for Trademarks
United States Patent and Trademark Office
600 Dulany Street
Alexandria, VA 22314

via email: TMFeedback@uspto.gov

Re: AIPLA Comments in Response to the USPTO announcement “Request for Comments: Post Registration Amendments to Identifications of Goods and Services Due to Technology Evolution”

Dear Commissioner Cohn:

The American Intellectual Property Law Association (AIPLA) is pleased to have the opportunity to present its views with respect to the United States Patent and Trademark Office (USPTO) Notice entitled “Request for Comments: Post Registration Amendments to Identifications of Goods and Services Due to Technology Evolution” which was posted on the USPTO website at <http://www.uspto.gov/trademarks/notices/ReqComments-IDAmendmentsDuettoTechEvolution.doc>.

AIPLA is a national bar association with approximately 15,000 members engaged in private and corporate practice, in government service, and in academia. AIPLA represents a wide and diverse spectrum of individuals, companies and institutions involved directly or indirectly in the practice of patent and trademark law, as well as other fields of law affecting intellectual property. Our members represent both owners and users of intellectual property.

AIPLA welcomes this opportunity to comment on the USPTO’s request for comments concerning post-registration amendments to identifications of goods and services due to technology evolution.

INTRODUCTION

The request for comments concerns amending 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. For example, users have sought to amend the Class 9 services, “computer software programs,” to “providing software as a service” in Class 42, and to amend Class 9’s “audio cassettes, audio tapes, disks, diskettes, vinyl records,” to “musical sound recordings,” remaining in Class 9. The USPTO previously has taken the position that such amendments impermissibly expand the scope of a registration under 37 CFR Section 2.173(e) and Section 7(e) of the Trademark Act.

Under this proposal, registrants would be able to change their identification of goods or services to reflect changes and evolution in technology that have rendered the original goods or services obsolete or enhanced to the point where the original identification does not adequately or accurately describe the present iteration of the goods or services.

AIPLA recognizes that technology has had an enormous impact on commerce and many goods and services that were commonplace twenty years ago – or less – have been replaced by analogous but different goods and services. As such, the question arises as to whether trademark registrants must file new applications requiring fees and other related costs to register the same marks for those goods and services that are effectively the same as those in the original registration but for their evolution due to changes in technology. The alternative proposed by the USPTO is to allow registrants to amend their identification of goods and services after registration to reflect the evolution of their goods and services due to the evolution of technology. This proposal would be a benefit to registrants who find themselves in this situation. However, this aspect of the proposal must be weighed against the effect these amendments would have on those who have existing registrations or use of marks in the public domain that are not aware that these amendments have taken place.

Each of the questions raised in the USPTO's Request for Comment are addressed below.

ANALYSIS

1. 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?

As indicated above, allowing amendments to goods and service in registrations due to technological evolution would be advantageous to registrants since this would avoid the necessity to file new applications for the same mark used on goods or services that have reasonably evolved from previously existing goods and services. However, the impact of these amendments must be evaluated in light of other registrants or common law users who have developed their trademarks based on the previously existing identification of goods and services in these registrations. Thus, AIPLA is of the opinion that the basic concept is valid so long as the process also protects the interests of these other parties and thus preserves the notice aspect of the trademark registration system.

2. 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)?

If these amendments are permitted in post-registration, AIPLA agrees that they be permitted prior to registration. In fact, it seems that if these amendments are instituted prior to registration, the notice requirement of the Lanham Act would be better served since they would be published in the Official Gazette as are all other applications that are deemed appropriate for registration by the USPTO.

3. 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?

AIPLA is of the opinion that some sort of showing should be required for these amendments to avoid a registrant foreseeing changes in technology that it may or may not incorporate into its goods or services. The showing may not need to be a formal specimen but it should require a clear indication that the registrant is currently making the evolved goods or offering the evolved services and that these goods or services are available in commerce.

4. 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?

If such a policy is put into place, there is no reason to limit the amendments to certain goods, services or fields. Any concerns AIPLA may have in this area are addressed in some of the questions below.

5. 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?

As indicated in the response to Question 4 above, if such a policy is put into place, there is no reason for a distinction to be drawn between products that have been phased out due to technology and those that have evolved due to that technology.

6. 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?

AIPLA finds that the scope of protection concept would have to be evaluated on a case-by-case basis. This would add to the work burden of the USPTO. This point also speaks directly to the notice function of the Lanham Act which is discussed in Question 8 below.

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

AIPLA is of the opinion that original dates of use could be retained if the original goods or services remained in the registration. If the original goods or services have become obsolete due to technological developments and are deleted from the registration, the dates of use should be changed to the dates of use for the amended goods and services with specimens that meet statutory requirements.

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

AIPLA is concerned that these amendments would, indeed, impact the public policy objective of the Lanham Act in ensuring notice of the coverage afforded under a registration. The scope of the amendment may have to be considered when evaluating its impact on notice. For example, a registration for phonograph records may be allowed to amend to compact discs but to amend to

streamed music could result in a notice problem for registrants with services such as radio broadcast services. With some difference in the marks, the radio broadcast service provider may not have been concerned with a registration for phonograph records or compact discs. However, an amendment to streamed music would be an issue for the radio broadcast service registrant. If some sort of public notice of these amendments were not provided, the integrity and usefulness of the trademark register would become jeopardized.

Some further questions raised by the notice issue are:

How do third parties object to these changes if the USPTO accepts an amendment that raises infringement issues for those third parties that did not exist with the original identification?

Would the holder of an incontestable registration with an amended identification be allowed to enforce their registration against parties they never before considered?

The following question was raised by AIPLA membership.

9. How many times may such an amendment be allowed during the life of a registration? If multiple amendments are allowed, should they always be compared to the original identification and should only those that result in a clarification or limiting of the original identification be allowed?

AIPLA is of the opinion that multiple amendments may be allowed but they should be compared to the original identification in the registration. The concern is that goods or services may change incrementally through multiple amendments and the final identification may be radically different from the original thus raising notice issues. An extreme example would be for a registration for a stage coach to evolve, incrementally over time, to a high speed train. Both are vehicles for mass transit but the notice impact of a high speed train is entirely different from that of a stage coach.

Also of considerable concern is an evolution from goods to services that results in a change in classification. In the phonograph record to streamed music example in Question 8, the phonograph records would have been in Class 9 while the streamed music service is in Class 38. Allowing a registration to evolve from goods to services would greatly compromise the notice objective of the trademark register. This could result in a disincentive for trademark owners to apply for registration of their trademarks in the USPTO which would further undermine the notice purpose and general integrity of the trademark register.

10. Please provide any additional comments you may have.

In the past, the USPTO has taken it upon itself to approve changes of this type. For instance, phonograph records were allowed to be amended to musical sound recordings and typewriters were allowed to be amended to word processors. It should be noted that this was at a time when word processors were stand-alone pieces of equipment and not a program or application in a multi-purpose computer. However, allowing a change from phonograph records in Class 9 to streaming of music in Class 38 seems to be a change that must be viewed in light of notice and scope of protection.

AIPLA suggests that the USPTO make these decisions and announce them to the public as significant changes in technology and product evolution are brought to the attention of the USPTO with appropriate supporting documentation. It is doubtful that this would result in the opening of a floodgate of suggestions for “from/to” amendments of this type. Having them reviewed by the Identification/Classification section of the Commissioner’s Office might be a workable solution that could meet the needs of those registrants who wish to amend their identifications of goods or services and those who could be impacted by those changes if notice of these changes were made through various public communication means available to the USPTO.

The existing TMIDSuggest mailbox could be used for suggestions but should be clearly indicated that they are suggestions for a determination as to the acceptability of the ID in a “from/to” situation and not a routine request to add the language to the ID Manual, although that could be done with the suggestion as well. Using this method for determining acceptability of an updated amendment for an existing identification of goods and services would result in consistency since there would be one small section of the office with expertise in the area of identifications reviewing the suggestions.

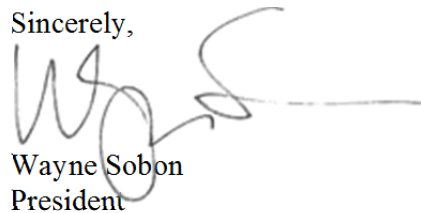
This leaves open the question of whether additional evidence would be needed when submitting such an amendment in post- or pre-registration but at least the amendment itself would have been vetted in a consistent manner.

CONCLUSION

The position of AIPLA is that this proposal has some very positive features. However, if it is implemented, great care should be taken that the notice requirement of the Lanham Act is served and that the amendments are appropriately supported by evidence that the registrant is actively engaged in the provision of the goods or service in the amendment.

Thank you for allowing AIPLA the opportunity to provide comments on this important initiative. AIPLA looks forward to further dialogues with the USPTO in finding solutions and defining programs to maintain and enhance the USPTO’s mission.

Sincerely,

A handwritten signature in black ink, appearing to read 'Wayne Sobon', with a horizontal line extending to the right.

Wayne Sobon
President

American Intellectual Property Law Association