



A Change of Mark Specification

Should your IP office allow amendments to identifications of goods or services in registrations based on changes in the manner or medium by which products or services are offered? And if such amendments are permitted, should they only be allowed post-registration to account for changes in technology? Experts talk in depth with **Johnny Chan**.

As technology evolves, trademarks can sometimes lose an essential part of their registration. After all, more and more people are consuming music and video content

floppy disc to load software onto your computer, or watched your favourite movie on a prerecorded video cassette? Many jurisdictions have taken technological changes into account, and now allow relatively easy amendments to trademark specifications.

Amendment of the specification of goods or services is only permitted in certain circumstances in New Zealand. An applicant could only amend the specification of goods or services for an application or registration to reflect changes in the manner by which products or services are offered, by limiting the specification of goods or services; or correcting any error or omission if, in the commissioner's opinion, the correction of the error or omission does not materially alter the meaning or scope of the application.

"This highlights the need to file a broad and forward-looking specification of goods or services that avoids, if possible, any limitations around the manner by which goods or services are offered,"

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Unlike some jurisdictions, IPONZ will accept comparatively broad **specifications and does not require evidence of use**, so there is often **no disadvantage in filing a broad specification.**

- *Matthew Hayes, senior associate,
AJ Park, Wellington*

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through the internet – and when was the last time you used a floppy disc to load software onto your computer, or watched your favourite movie on a prerecorded video cassette? Many jurisdictions have taken technological changes into account, and now allow relatively easy amendments to trademark specifications. says Matthew Hayes, a senior associate at AJ Park in Wellington.

"Unlike some jurisdictions, IPONZ will accept comparatively broad specifications and does not require evidence of use in order to obtain or maintain a registration, so there is often no

disadvantage in filing a broad specification."

The existing trademark laws in the Philippines should allow such types of amendments to be made at any time (i.e., both pre-registration and post-registration), especially if the amendments sought in the identification of goods or services can be reasonably contemplated or covered by the existing classes of goods or services of the trademark (i.e., mere addition of goods or services under existing identified classes of goods or services), says John Paul M. Gaba, a partner at ACCRALaw in Manila. "However, if the amendments sought contemplate goods or services categorized in classes not covered by the existing identified classes of the mark, then a new trademark application to cover the new classes of goods or services must be filed."

According to Article 23 of the Taiwan Trademark Act, no amendments shall be made to the reproduction of a trademark and the designated goods or services after the application is filed, unless such amendment is a restriction of designated

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The registry does not allow any **amendment in the identification of goods or services based on changes in the manner or medium by which products or services are offered.** Should an amendment be desired, fresh applications would have to be **filed.**

- *Rahul Chaudhry, managing partner,
Lall Lahiri & Salhotra, Gurgaon*

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goods or services or an amendment to the reproduction of a trademark which does not substantially change such mark, says

registration is granted, unless such amendment is a restriction of designated goods or services. If an application for opposition,

invalidation or revocation has been entered at the Registrar's Office, any division of the registration or restriction of the designated goods or services shall be requested before the disposition of the application is rendered."

In the US, the US Patent and Trademark Office has instituted a pilot programme to allow amendments to the identification of goods or services in registrations, so as to account for changes in technology formats. This programme allows a registrant to modify a registration when products or services (e.g., banking, entertainment, music, technology/software and publishing) have changed due to evolving technology. If a registration is potentially in jeopardy due to an inability to prove that a mark is currently used in the technology that was originally identified

in a registration, a trademark owner can seek to correct the problem under that pilot programme. The initial period for the programme will depend on the volume of requests, and the

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The amendments should be permitted for both products that are outdated as well as those for which technology is evolving to ensure that protection progresses together with rapid technology advancement.

- Gregory Ross, partner,
Eakin McCaffery Cox, Sydney

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Ruey-Sen Tsai, a partner at Lee and Li in Taipei. "Article 38 also stipulates that no amendments shall be made to the reproduction of a trademark and the designated goods or services after



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USPTO will determine whether to implement procedures for making such amendments on a permanent basis after the pilot programme has concluded, says Christopher J. Rourk, a partner at Jackson Walker in Dallas.

There are several requirements, though, Rourk says. "First, amendments are only permitted post-registration via a petition

due to evolving technology. The amendment must also replace the existing goods or services for which use can no longer be shown with the goods or services in their evolved form – if the registrant continues to use the mark with the goods or services in their original form, a new trademark application must be filed to seek registration for the evolved goods or services."

The USPTO has provided the following examples of amendments that would be successful:

- "Prerecorded video cassettes in the field of mathematics instruction" in International Class 9 to "Video recordings featuring mathematics instruction" in International Class 9.

- "Floppy discs for computers for word processing" in International Class 9 to "Providing on-line non-downloadable software for word processing" in International Class 42.

- "Downloadable software for use in database management" in International Class 9 to "Software as a service (SAAS) services featuring software for use in database management" in International

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If the classes are fairly general, then the amendments are less likely to change the scope of the trademark applied for in the original application.

- Christina Cavallaro, associate,
Eakin McCaffery Cox, Sydney

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to the Director. Moreover, the amendments must relate to the goods or services for which the registrant can no longer show use

Class 42.

- "Printed books in the field of art history" in International

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Class 16 to “Downloadable electronic books in the field of art history” in International Class 9.

- “Telephone banking services” in International Class 36 to “Online banking services” in International Class 36.
- “Entertainment services, namely, an ongoing comedy series

broadcast via the Internet” in International Class 41.

Evidence to Make the Amendments

India’s trademark registry allows amendments only in a pending or registered mark provided the request for the amendment is non-substantial and does not extend the scope of protection in any manner, says Rahul Chaudhry, managing partner at Lall Lahiri & Salhotra in Gurgaon. “The registry does not allow any amendment in the identification of goods or services based on changes in the manner or medium by which products or services are offered, save for deletion of some of the existing goods or services in the original specification. Should an amendment be desired to be made in the identification of goods or services in view of the manner or medium by which the intended goods or services are offered, fresh applications considering the same in the desired classes would have to be filed.”

Evidence is not usually required when amending an application or registration by limiting the specification of goods or services in New Zealand, Hayes says. “If the current

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If two businesses believe that they **can coexist and mutually benefit**, there is no reason for trademark laws to intrude unless consumer harm is apparent.

- Ashwin Julka, managing partner,
Remfry & Sagar, Gurgaon

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provided through cable television” in International Class 41 to “Entertainment services, namely, an ongoing comedy series



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policy was to change to allow amendments to identifications of goods or services in registrations based on changes in the medium by which products or services are offered, it would be likely that you would need evidence to illustrate to IPONZ how the medium has shifted.”

On the other hand, no proof is necessary in the Philippines, since this type of amendment does not entail a substantial change in the details of the mark – a simple letter requesting that additional items of goods or services be included in the existing classes covered will suffice subject to payment of fees, Gaba says. “Nonetheless, the Philippines still requires the submission of the Declarations of Actual Use within three years of the filing date and within the fifth anniversary of registration. Failure to file any of them shall result in automatic cancellation.”

Which Goods or Services Should Be Covered?

Should the amendments be limited to certain goods or services (e.g., software, music), and if so, how should the determination be made as to which goods or services? Should a distinction be made between products that are outdated (e.g., video tapes), as opposed to products for which the technology is evolving (e.g., e-magazines), or should amendments be permitted for both categories of products?

It is arguable that allowing the amendments expands the scope of protection that was originally applied for by the trademark owner. However, requiring a trademark owner to file a new application for a different medium would expose the owner to a

new period of review, and potentially opposition, which may be counterproductive and fail from a cost-benefit perspective, says Gregory Ross, a partner at Eakin McCaffery Cox in Sydney. “The goods or services that the amendments should apply to should depend on whether the medium significantly changes the nature of the goods or services being provided. If the good or service is substantially-changed by virtue of the medium, then it would be more reasonable to require a new application. On the other hand, with goods such as music, where songs are essentially the same but communicated via a different medium, then the amendments should be permitted.”

Software and music would be impacted to a large extent considering the methods of distribution are so dependent on the current technology. “There is no doubt that downloading music online has superseded distribution through cassette tapes, vinyl records or discs, which are now seen redundant by many and that raises the question of what does the trademark attach to. The amendments should be permitted for both products that are outdated as well as those for which technology is evolving to ensure that protection progresses together with rapid technology advancement,” Ross says. “It should be kept in mind that aspects of registration may overlap with copyright issues for particular goods or services and the effect of such amendments should be considered in circumstances where the circumstances of change may infringe existing copyright owned by other IP owners.”

In Taiwan, the amendments will be permitted only if there is no substantial change, Tsai says. “The items of outdated goods

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cannot be amended into the items under new technology, though.”

Similarly, the amendments should not be limited to certain types of goods or services in the Philippines, Gaba says. “So long as the proposed amendments in the identification of goods or services can be reasonably contemplated or covered by the existing classes and items covered by the mark, the amendments should be allowed regardless of the nature of the goods or services.”

Is the Scope of Protection Expanded After Amendment?

Whether the scope of protection expands after the application is amended depends on the amendment being sought, but any amendment that was considered to expand the scope of protection should not be permitted if New Zealand’s current trademark law is correctly applied by IPONZ or the courts, says Hayes.

The same would apply in other jurisdictions. “The scope would not be expanded so long as the amendment does not materially affect the nature or character of the goods or services covered by the trademark and no new registrations are added as part of the amendments,” says Christina Cavallaro, an associate at Eakin McCaffery Cox. “However, this may depend on the classes in which a trademark is registered. If the classes are fairly general, then the amendments are less likely to change the scope of the trademark applied for in the original application, as opposed to where very specific classes have been detailed in the original application.”

Plus, “allowing such type of amendment is merely recognizing the changing landscape on how we transact business in our everyday life due to technology advancement,” says Gaba.

In other places, however, lawyers say it is very possible that the scope of protection is expanded if an amendment is allowed.

Deep Impact

What would the impact of the amendment be on the public policy objective of ensuring notice of the coverage afforded under a registration? Hayes says that amendments that limit or correct a specification are not specifically-advertised for opposition prior to registration, although they may be challenged by a third party during the opposition window. Post registration, amendments are not advertised for opposition.

“If the policy scenario posited previously was to be adopted and an amendment could be made that might expand the scope of protection, to prevent prejudice to third parties, it is likely that there would be a need to introduce or ensure the ability for the third party to oppose or apply to cancel any amendment that is granted, especially if it was one that expanded the scope of protection.”

There will not be a serious negative impact in the Philippines, Gaba says. “In fact, allowing the amendment would serve more the policy of keeping our existing trademark protection system in line with the actual world, i.e., how products and services are produced, marketed, and sold.”

Coexistence

The basis of a trademark is the protection of consumer interest – a trademark enables a customer to identify the source of a particular good or service. Consumer interest was previously protected even more rigidly: if entity A held the marks X and Y for tea and coffee (which are similar goods), it would be difficult for it to sell the rights for only Y to entity B. Typically, X and Y would

be designated ‘associated marks’ under the trademark statute, which meant they could only be sold or transferred together. But as business structures have grown more complex, while X and Y may ultimately be owned by entity A, they may formally exist in the names of its subsidiary or holding companies.

Since ownership patterns are no longer clearly-identifiable, and given that modern businesses do demand complex structures, trademark protection systems, too, have changed, says Ashwin Julka, managing partner at Remfry & Sagar in Gurgaon. “Coexistence may be viewed in a similar vein. If two businesses believe that they can coexist and mutually benefit, there is no reason for trademark laws to intrude unless consumer harm is apparent. When the new Indian trademark law was introduced in 2003, it formally recognized a ‘letter of consent’ as a valid defence to overcome objections based on relative grounds. Moreover, the law has always recognized and allowed coexistence in case of ‘honest concurrent use’ by different proprietors. Two businesses may choose to coexist, but if the result is going to be detrimental for consumers, the Registry is unlikely to allow it. A case where two proprietors own similar marks for medicines used to treat unrelated ailments would be a good example of marks unfit for co-existence.”

In New Zealand, a coexistence arrangement negotiated during examination, opposition or cancellation can enable a party to secure a right, and there is an obligation on the commissioner of trademarks to allow registration where the owner of cited mark consents, says Hayes.

Coexistence is also feasible in the Philippines as long as it will not result in confusion. “Allowing coexistence will negate the essence of trademark protection if it paves way to consumer confusion,” Gaba says. “If the function of a trademark as an indicator to consumers of the source of particular good or service is not served, there is no reason allowing trademark coexistence.”

Taiwan’s Trademark Act allows co-existence as well. Article 30 stipulates that a trademark should not be registered if it is identical with or similar to another’s unless the consent of the early filer or registrant has been given and is not obviously improper, meaning substantial confusion to the relevant enterprises or consumers, says Tsai. AIP

