

**To:** Imagination Holdings Pty Ltd ([Jacqueline.Lesser@icemiller.com](mailto:Jacqueline.Lesser@icemiller.com))  
**Subject:** TRADEMARK APPLICATION NO. 85088171 - IMAGINATION - N/A  
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**United States Patent and Trademark Office (USPTO)**

**U.S. Application Serial No.** 85088171

**U.S. Registration No.** 4001241

**Mark:** IMAGINATION

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**Owner:** Imagination Holdings Pty Ltd

**Reference/Docket No.** N/A

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**PETITION TO DIRECTOR GRANTED**

**Issue date:** December 15, 2022

Imagination Holdings Pty Ltd (petitioner) has petitioned the Director of the United States Patent and Trademark Office (Director) to waive Trademark Rule 2.173(e) and allow an amendment to the identification of goods for the above identified registration. 37 C.F.R. §2.173(e). The Director has authority to review the request under 37 C.F.R. §§2.146(a)(5), 2.148 and has delegated this matter to the Commissioner for Trademarks and the staff of the Office of the Deputy Commissioner for Trademark Examination Policy. 35 U.S.C. §3(a)-(b); 37 C.F.R. §2.146(h). The petition is granted.

**FACTS**<sup>[1]</sup>

On July 26, 2011, the United States Patent and Trademark Office (USPTO) issued the above identified registration for “pre-recorded DVDs featuring computer game programs,” in International Class 9.

On September 1, 2015, the USPTO launched a pilot program to allow, under limited circumstances upon petition to the Director, amendments to identifications of goods and services in trademark registrations that would otherwise be beyond the scope of the current identification, but are deemed necessary because evolving technology has changed the manner or medium by which the underlying content or subject matter of the identified products and services are offered for sale or provided to consumers (pilot program).<sup>[2]</sup> Under the pilot program, petitioner was required to submit a request for amendment that meets the requirements of Trademark Act Section 7(e) with the petition. 15 U.S.C. §1057(e).

On August 31, 2021, petitioner filed a petition to the Director and a Section 7 request.<sup>[3]</sup> Petitioner requested to amend the identification and classification of goods from:

- pre-recorded DVDs featuring computer game programs, in International Class 9

to:

*downloadable computer game applications*, in International Class 9;

- *providing online non-downloadable interactive computer game applications featuring accessories in the nature of game buzzers, game questions, and game wheels*, in International Class 42 [as amended].<sup>[4]</sup>

As required by the pilot program, petitioner submitted a specimen showing current use of the mark in commerce on or in connection with the amended goods and services, and dates of use for the goods and services in their evolved form. The proposed amendment published for public comment on the USPTO website on September 13, 2022. No public comments were received.

## DISCUSSION

Under Trademark Rule 2.173(e), no amendment to the identification of goods or services in a registration will be permitted except to restrict the identification or change it in ways that would not require republication. 37 C.F.R. §2.173(e). The Director may waive Rule 2.173(e) “in an extraordinary situation, when justice requires and no other party is injured.” 37 C.F.R. §§2.146(a)(5), 2.148, 2.173(e); *Trademark Manual of Examining Procedure* (TMEP) §1708. To waive this rule, the Director must determine that all three conditions are satisfied. *See* TMEP §1708. In this case, the Director finds that a waiver of Rule 2.173(e) is appropriate.

In order to show that an extraordinary situation exists, for which justice requires a rule waiver, petitioner has declared, to the best of petitioner’s knowledge, that (1) based on changes due to evolving technology in the manner or medium by which products and services are offered for sale and provided to consumers, petitioner cannot show use on the original goods or services; (2) petitioner still uses the mark on other goods or services reflecting the evolved technology, and the underlying content or subject matter remains unchanged; and (3) absent an amendment of the identification, petitioner would be forced to delete the original goods or services from the registration, and thus lose protection in the registration in relation to the underlying content or subject matter of the original goods or services.

In considering third-party harm in allowing the amendment, the USPTO performed a new search of the Trademark database of registered and pending marks and identified no marks that might be harmed by the acceptance of the amendment. As an additional means of reducing the possibility of third-party harm and to provide a mechanism for interested parties to comment about proposed amendments prior to acceptance, the USPTO published the proposed amendment for public comment on the USPTO website and no comments were received.

Moreover, in order to reduce the possibility of third-party harm, petitioner has declared, as required under the pilot program, that it will not file (or refile, if applicable) an affidavit or declaration of incontestability under Trademark Act Section 15 as to the evolved goods or services for a period of at least five years from the date of acceptance of the amendment. 15 U.S.C. §1065. Additionally, it is noted that any “incontestable” status under Trademark Section 15 that applied to the original goods will not apply to the newly amended goods in their evolved form. *See generally* 15 U.S.C. §1065.

Accordingly, the Director has determined that all three conditions have been satisfied and waives Rule 2.173(e) to permit petitioner to amend the identification as requested. *See* 37 C.F.R. §§2.146(a)(5), 2.148, 2.173.

## DECISION

The petition to waive Trademark Rule 2.173(e) and allow amendment to the identification of goods due to technology evolution is granted. Since the registration file is currently pending with the Trademark Trial and Appeal Board (TTAB), it will be forwarded to the TTAB for continuation of the cancellation proceeding.<sup>[5]</sup>

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<sup>[1]</sup> This decision recites only facts relevant to the issue on petition.

<sup>[2]</sup> *See Announcement of Pilot Program to Allow Amendments to Identifications of Goods and Services in Trademark Registrations Due to Technology Evolution at* [http://www.uspto.gov/sites/default/files/documents/Technology\\_Evolution\\_Pilot\\_Program.docx](http://www.uspto.gov/sites/default/files/documents/Technology_Evolution_Pilot_Program.docx).

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— Petitioner filed its combined Trademark Act Section 8 affidavit or declaration of use or excusable nonuse and Section 9 renewal application on July 20, 2021. 15 U.S.C. §§1058, 1059.

[4] A petition to Director inquiry letter issued on March 10, 2022 and July 13, 2022, which provided petitioner thirty (30) days to complete the petition by providing a petition and additional class fee, an acceptable amendment to the identification of goods, dates of use, an acceptable specimen, and the requisite statements as set forth under the pilot program. On April 11, 2021 and August 12, 2022, petitioner submitted the required fees, amended the identification of goods, and provided dates of use, specimens, and the requisite statements. 37 C.F.R. §2.6; TMEP §§1609.04 and 1403.02(c).

[5] On October 5, 2021, the TTAB proceeding was suspended pending disposition of the instant petition to Director.