

UNITED STATES PATENT AND TRADEMARK OFFICE  
**Trademark Trial and Appeal Board**  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

EJS/kk

Mailed: October 5, 2015

In re KTM-Sportmotorcycle AG

Serial No. 79147140(Parent)

Serial No. 79147141

Filed: 9/11/2013

**By the Trademark Trial and Appeal Board:**

It is noted that Applicant has filed appeals in connection with the above-identified applications, and that both applications are for very similar marks (E SPEED in standard characters, and E SPEED in stylized form), for the same goods and services. Accordingly, it is appropriate to consolidate the appeals. It is further noted that with its appeal briefs Applicant has submitted an amendment to its identification of goods in an attempt to comply with the Examining Attorney's requirement for an acceptable identification. Applicant is advised that the proper procedure in such a situation is to file with the Board a separate request for remand, as a request for remand (or amendment without a request for remand) may not be noticed by the Board, and the application may be forwarded to the Examining Attorney for preparation of her brief without the Board's acting on the request for remand. Indeed, that is what happened in the appeal for Application Serial No. 79147140. As for Application Serial No. 79147141, the Board did note the

amendment included with Applicant's appeal brief, and therefore suspended proceedings in the appeal and remanded the application to the Examining Attorney to consider the amendment. Unfortunately, the Examining Attorney treated Applicant's amendment as a request for reconsideration, as shown by her comments that she "has carefully reviewed applicant's request for reconsideration" and "if applicant has already filed a timely notice of appeal." The Board's September 16, 2015 order clearly stated that the amendment to the identification of goods was in Applicant's appeal brief, and therefore the time had passed for Applicant to file a request for reconsideration.

It is further noted in connection with Application Serial No. 79147141 that, with the Examining Attorney's denial of the "request for reconsideration," she submitted evidence in support of the refusal (as would have been proper if she were considering a request for reconsideration). However, because Application Serial No. 79147141 had been remanded to the Examining Attorney to consider only the amendment to the identification of goods in Classes 6 and 7, any evidence generally in support of the refusal of registration would be improper. The only evidence that would have been proper would have been to show that the proposed identification was still unacceptable, or to show that the amended identification, even though acceptable, would not obviate the likelihood of confusion refusal. Because we cannot determine from the material submitted by the Examining Attorney what evidence submitted with the September 30, 2015, Office action goes specifically to the issue of the registrability of the mark with respect to the amended identification of goods,

we hereby remand the application to the Examining Attorney to issue a new Office action directed specifically to the Board's September 16, 2015 remand order. That is, the Examining Attorney should confirm the statement in the September 30, 2015 Office action that the amendment to the identification of goods is acceptable, and include with the Office action only that evidence directed to why the amended identification does not obviate the refusal of registration under Section 2(d).

With respect to Application Serial No. 79147140, as noted, Applicant also submitted with its brief a proposed amendment to the identification of the goods in Classes 6 and 7. The proposed amendment was not noted by the Board, and therefore the application was forwarded to the Examining Attorney for preparation of her brief. Apparently the Examining Attorney did not notice this Board order, because she issued, on September 30, 2015, a denial of a request for reconsideration. Because the application had not been remanded to the Examining Attorney, and because, indeed, there was no request for reconsideration, the Office action issued on September 30, 2015 is deemed void. However, because we now treat Applicant's proposed amendment as a request for remand, we hereby suspend proceedings in the appeal and remand the application to the Examining Attorney for consideration of the amendment. If the amendment is accepted and registration is found on the basis thereof, the appeal will be moot. If the amendment is accepted but the refusal of registration is maintained, the Examining Attorney should issue an Office action explaining this. The Examining Attorney may include with the Office action only evidence directed to why the amendment does not obviate the

likelihood of confusion refusal. If the proposed amendment to the identification of goods is not acceptable, the Examining Attorney should issue an Office action to that effect. The amendment to the identification should not be treated as raising a new issue. However, if the Examining Attorney believes that any problem with the identification can be resolved, she is encouraged to contact Applicant by telephone in an attempt to do so.

In summary, proceedings in the consolidated appeal are suspended. The applications are remanded to the Examining Attorney to consider the proposed amendments to the identification, as indicated above. If all issues with the amendment or the refusal of registration under Section 2(d) are not resolved by the amendments, the applications should be returned to the Board. The Board at that time will resume proceedings in the appeal.