

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: September 25, 2006

Opposition No. 91123312

INTEL CORPORATION

v.

STEVEN EMENY

Before Seeherman, Walters and Walsh,
Administrative Trademark Judges.

By the Board:

By way of background, applicant seeks to register the mark IDEAS INSIDE for a variety of services, including a computerized online ordering service featuring an assortment of goods; electronic digital transmission of messages and data via computer terminals; and computer services, namely, providing online search engines for obtaining data on a global computer network.¹ Opposer, by its amended notice of opposition, has asserted three grounds for its opposition: likelihood of confusion, dilution and that applicant lacks a bona fide intent to use the mark in commerce.

This case now comes up for consideration of opposer's motion for leave to amend the notice of opposition, which opposer filed on February 2, 2006, after all testimony

¹ Application Serial No. 75825218, filed November 11, 1999, and alleging a bona fide intent to use the mark in commerce.

periods had closed and shortly before the due date for its brief on final hearing. Specifically, opposer seeks to amend the notice of opposition to delete the claims of likelihood of confusion and dilution. While styled as a motion to amend, opposer's motion is, in effect, a withdrawal of the grounds of likelihood of confusion and dilution from the notice of opposition.

Applicant has opposed withdrawal of these claims, essentially arguing that the grounds have been tried and that he would prevail on these grounds.

At this stage of the proceeding, opposer may not withdraw grounds without prejudice without the written consent of applicant. See Trademark Rule 2.106(c). Opposer may not circumvent this rule by styling its withdrawal as a motion to amend the notice of opposition. Accordingly, the motion to amend is denied.

Opposer has also indicated that, if the Board does not grant its motion to amend, the Board should dismiss the likelihood of confusion and dilution causes of action with prejudice pursuant to Trademark Rule 2.106(c). Therefore, we dismiss the notice of opposition with prejudice as to the pleaded claims of likelihood of confusion and dilution. Applicant is advised that he has, therefore, prevailed in the opposition on these grounds.

This proceeding shall continue on the remaining ground, i.e., applicant's asserted lack of a bona-fide intent to use the IDEAS INSIDE mark.

Additionally, applicant, in his response to the motion for leave to amend, requests dismissal of the opposition because opposer "has ceased the use of the marks INTEL INSIDE & Swirl Design as outlined in the NOTICE OF OPPOSITION" and because there are "no grounds for confusion and/or dilution." This request is essentially a motion to dismiss the opposition as to the claims of likelihood of confusion and dilution. In view of our decision with respect to opposer's withdrawal of these grounds, applicant's motion to dismiss these grounds is moot and has been given no further consideration. To the extent that applicant is asserting, by his claim that opposer has ceased using its mark, that opposer lacks standing, the evidence submitted in support of that motion is not of record for purposes of the final decision on the remaining claim. The Board's determination of opposer's standing in connection with the remaining ground that applicant lacks a bona fide intent to use the mark will be based on the evidence properly submitted during trial. Moreover, opposer's motion to suspend, and request that the Board require applicant to take further steps to ensure timely service upon opposer, are moot.

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A decision on the remaining claim will issue in due course.
