

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Mailed: July 10, 2002

Opposition No. 91123455

Sun Microsystems, Inc.

v.

MCM Integrated  
Technologies LTD.

**Jyll S. Taylor, Attorney:**

Opposer's motions (filed April 19, 2002 and May 9, 2002, respectively) to reset the testimony periods so that the parties may pursue settlement negotiations are noted. In accordance with Board practice and to facilitate the negotiations, the motions are granted to the extent that proceedings herein are suspended until **six months** from the mailing date of this action, except as noted below, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

In the event that there is no word from either party concerning the progress of their negotiations within the next six months, the Board will issue an order resuming proceedings and resetting the time for applicant to respond to opposer's motion (filed April 5, 2002) to compel. In that regard, the Board notes that opposer's memorandum in support of the motion

**Opposition No. 91123455**

to compel has not been associated with the proceeding file.<sup>1</sup> Opposer is requested to refile a copy thereof with the Board no later than thirty days from the mailing date of this order.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.

Applicant's "Request for Amendment" (filed April 30, 2002) is also noted. However, Trademark Rule 2.133(a) provides, in pertinent part, that an application which is the subject of an inter partes proceeding may not be amended in substance except with the consent of the adverse party and the approval of the Board, or upon motion. In addition, the proposed motion must comply with all other relevant rules and statutory provisions. In this case, the proposed amendment was not filed with the consent of opposer or upon motion served upon counsel for opposer as required by Trademark Rule 2.119. Accordingly, it will be given no consideration until it is served on counsel for opposer and proof of such service is filed with the Board.

The Board hastens to add that even if we had considered the amendment, it would not have been accepted. By the proposed amendment, applicant seeks to modify the drawing from a typed drawing consisting of the term "NETRAC" to a

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<sup>1</sup> However, the Board notes that opposer's motion to compel, the declaration of Jedediah Wakefield and accompanying exhibits have been associated with the proceeding file.

**Opposition No. 91123455**

stylized drawing consisting of the term "netRAQ." Pursuant to Trademark Rule 2.72, amendments may not be made to the drawing of a mark if the character of the mark is materially altered. See Trademark Rule 2.72. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration to fairly present the mark for purposes of opposition. *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-744 (TTAB 1983).

In this instance, the proposed stylization of the term would alter a singular discrete term into a term with two distinct components, "net" and "RAQ," with the term "net" being suggestive of the services provided in connection with the applied-for mark.

Another test that is typically used to determine whether an amendment to a mark changes its impression involves the question of whether the examining attorney would have to conduct a new search of the register if the change was proposed after the initial search was done. In this case, the examining attorney, in its original search, would have searched terms that featured the letters "NETRAQ." The searched required of applicant's proposed amended mark would focus on terms including the letters "RAQ."

**Opposition No. 91123455**

For those reasons, the proposed amendment would materially alter the character of applicant's mark and would not be acceptable.