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

Mailed: August 30, 2006

Opposition No. 91125727

POWER MEASUREMENT, INC. AND
POWER MEASUREMENT LTD.

v.

SILICON ENERGY CORP.

Elizabeth A. Dunn, Attorney:

On July 17, 2006, applicant filed a proposed amendment to its application Serial No. 76118728 with no allegation of opposer's consent.[1]

An application which is the subject of a Board inter partes proceeding may not be amended in substance, except with consent of the other party or parties and the approval of the Board, or except upon motion. See Trademark Rule 2.133(a). In the usual case, the Board now would defer determination of the unconsented motion to amend in substance until final decision, or until a case is decided upon summary judgment. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990). However, the Board notes that the proposed amendment

[1] Opposer's consented motion, filed August 2, 2006, to extend testimony periods is granted. Trademark Rule 2.127(a).

was accompanied by a certificate of service which referred to the filing as “Application to Amend Application and Conditional Stipulations for Withdrawal of Opposition with Prejudice.” Inasmuch as it seems likely that the parties have discussed the matter and applicant’s failure to include opposer’s consent was inadvertent, we also advise the parties as follows regarding the substance of the proposed amendment.

Application Serial No. 76118728 for the mark EEM SUITE in stylized form includes a disclaimer of the term SUITE. By the proposed amendment applicant seeks to add the disclaimer "No claim is made to the exclusive right to use EEM apart from the mark as shown". The Trademark Manual of Examining Procedure (3rd ed. 2003)(“TMEP”) states, in pertinent part:

> An entire mark may not be disclaimed. If a mark is not registrable as a whole, a disclaimer will not make it registrable. There must be something in the combination of elements in the mark, or something of sufficient substance or distinctiveness over and above the matter being disclaimed, which would make the composite registrable after the import of the disclaimer is taken into account. *See In re Anchor Hocking Corp.*, 223 USPQ 85 (TTAB 1984); *Ex parte Ste. Pierre Smirnoff Fls, Inc.*, 102 USPQ 415 (Comm’r Pats. 1954).

TMEP §1213.06.

Here, the stylization in the mark consists of nondistinctive block lettering. Thus, in the event that the proposed amendment was re-submitted with opposer’s consent,

it would be denied because an entire mark may not be disclaimed.

Testimony periods are reset in accordance with opposer’s motion.

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