

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

Baez

Mailed: December 2, 2004

Opposition No. 91161333

TIBCO Software Inc.

v.

TMAX SOFT CO., LTD

**Peter Cataldo, Interlocutory Attorney**

On September 22, 2004, applicant filed a proposed amendment to its application Serial No. 76/494,782, with opposer's consent.<sup>1</sup>

By the proposed amendment applicant seeks to amend the identification of goods from:

recorded computer operating program; notebook computer; laptop computer; software programmable microprocessors; CD-ROM drive; magnetic tape drive; computer software for use as an Enterprise

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<sup>1</sup> The parties are advised that amendment of any application or registration which is the subject of an inter partes proceeding before the Board is governed by Trademark Rule 2.133. Thus, an application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion. See Trademark Rule 2.133(a). See also *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986); and *Greyhound Corporation and Armour and Company v. Armour Life Insurance Company*, 214 USPQ 473 (TTAB 1982). Thus, the determination of the above proposed amendment to applicant's involved application is made by the Board. Accordingly, applicant's request that the Board remand the involved application to the Trademark Examining Operation for consideration of the proposed amendment is denied.

Application Integration solution, namely, providing integrated interface between various enterprise applications and user applications, which is recorded in floppy disk, CD-ROM, or magnetic tape device, or downloaded from a website

to:

recorded computer operating program; notebook computer, laptop computer; software programmable microprocessors; CD-ROM drive; magnetic tape drive; computer software for use a database, namely, recording, sorting, sharing and managing the data, which is recorded in floppy disk, CD-ROM, or magnetic tape device, or downloaded from a website.

Trademark Rule 2.71(b) provides that the identification of goods or services may be amended to clarify or limit the identification, but additions will not be permitted. See Trademark Rule 2.71(b); and *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926 (TTAB 1993). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991).

In this case, the proposed amendment of the identification of goods is unacceptable because the wording

"computer software for use a database, namely, recording, sorting, sharing and managing the data"

falls outside of the scope of the wording

"computer software for use as an Enterprise Application Integration solution, namely, providing integrated interface between various enterprise applications and user applications"

in the previous identification of goods. Thus, the addition of the above wording to the amended identification broadens the scope of the goods beyond that set forth in the previous

identification of goods. The applicant may further amend this wording, with opposer's consent. The remainder of the identification of goods is acceptable as amended.

Accordingly, applicant's consented request to amend the identification of goods is denied without prejudice. The parties may submit a further amendment to the identification of goods in conformance with discussion above and Trademark Rule 2.71(b).

Because the parties are negotiating for a possible settlement of this case, and in view of the Board's decision above regarding the proposed amendment to the identification of goods, proceedings herein are suspended until six months from the mailing date of this action, subject to the right of either party to request resumption at any time prior thereto. See Trademark Rule 2.117(c).

Unless the parties sooner request resumption, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Applicant is allowed until THIRTY DAYS from resumption in which to file and serve its answer to the notice of opposition.

The parties are allowed THIRTY DAYS from resumption in which to serve responses to any outstanding discovery

requests. Trial dates, including the close of discovery, are reset as follows:

<b>Proceedings Resume:</b>	<b>June 1, 2005</b>
Discovery period to close:	<b>September 29, 2005</b>
Thirty-day testimony period for party in position of plaintiff to close:	<b>December 28, 2005</b>
Thirty-day testimony period for party in position of defendant to close:	<b>February 26, 2006</b>
Fifteen-day rebuttal testimony period to close:	<b>April 12, 2006</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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