

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

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Mailed: March 5, 2008

Opposition No. 91176918

BEA Systems, Inc.

v.

Beyond Wireless, Inc.

Frances S. Wolfson, Interlocutory Attorney:

On January 11, 2008, applicant filed a proposed amendment to its application Serial No. 78918808, with opposer's consent.

By the proposed amendment applicant seeks to change the recitation of services in International Class 38 **from**

Telecommunications services; namely the transmission of voice, data, images, audio, video, and information via telephone or the internet; satellite communication services via global computer network; personal communications services; paging services; wireless telephone roaming communication services; leasing telecommunications equipment, components, systems and supplies; electronic mail services; voice messaging services; providing multiple-user access to global computer networks to transmit, receive and otherwise access and use information of general interest to consumers

to

Mobile telephone services; namely the transmission of voice, data, images, audio, video, and information via mobile telephone; satellite communication services via mobile telephone; paging services via mobile telephone; wireless telephone roaming communication services; leasing mobile

telephone equipment, components, systems and supplies; mobile telephone voice messaging services

The amendment impermissibly broadens the recitation of services and is therefore denied. Trademark Rule 2.71(b); see TMEP section 804.09. Specifically, "satellite communication services via global computer network" cannot be amended to "satellite communication services via mobile telephone."

Proceedings herein are suspended until TWENTY DAYS from the mailing date of this order to allow applicant time to further amend "satellite communication services via global computer network" in compliance with Trademark Rule 2.71(b), failing which proceedings will automatically resume on the following schedule:

DISCOVERY PERIOD TO CLOSE: **June 1, 2008**

30-day testimony period for party in position of plaintiff to close: **April 25, 2008**

30-day testimony period for party in position of defendant to close: **June 24, 2008**

15-day rebuttal testimony period for plaintiff to close: **August 8, 2008**

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>