

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

RK/mc

Mailed: September 14, 2011

Opposition No. 91193794

Medrad, Inc.

v.

MedRed, LLC

Yong Oh (Richard) Kim, Interlocutory Attorney:

On August 29, 2011, applicant filed a proposed amendment to its application Serial No. 77692548, with opposer's consent. By the proposed amendment, applicant seeks to change the identification of services in International Classes 42 and 44 as follows:

From: *Non-downloadable software that provides health information to patients and healthcare providers; in International Class 42.*

Providing health information to patients and healthcare providers at the point of care wherever medicine is practiced; in International Class 44.

To: *Non-downloadable software that provides health information to patients and healthcare providers but not in the field of monitoring, controlling or regulating the functions of a medical device; in International Class 42.*

Providing health information to patients and healthcare providers, but not in the field of monitoring, controlling or regulating the

functions of a medical device; in International Class 44.

Neither amendment is acceptable. Turning first to the Class 42 amendment, although it does narrow the description as published, the description is indefinite as "non-downloadable software" is not a service.¹ As to the Class 44 amendment, removal of the limiting language "at the point of care wherever medicine is practiced" broadens the scope of the description notwithstanding the field limitation added by applicant. Accordingly, applicant's motion to amend its application is **DENIED**.

Inasmuch as the parties appear to be interested in settling the case, proceedings herein are **SUSPENDED** for **SIXTY DAYS** from the mailing date of this order to allow the parties time to renegotiate any settlement agreement and to submit, if possible, acceptable amendments to the application. Should the parties be unable to reach an agreement by the end of the suspension period, proceedings will be resumed in accordance with the schedule below:

Plaintiff's Pretrial Disclosures Due	12/23/2011
Plaintiff's 30-day Trial Period Ends	2/6/2012
Defendant's Pretrial Disclosures Due	2/21/2012
Defendant's 30-day Trial Period Ends	4/6/2012
Plaintiff's Rebuttal Disclosures Due	4/21/2012
Plaintiff's 15-day Rebuttal Period Ends	5/21/2012

¹ The Board would be inclined to accept "Providing temporary use of non-downloadable computer software that provides health information to patients and healthcare providers but not in the field of monitoring, controlling or regulating the functions of a medical device; in International Class 42."

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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