

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

nmt

Mailed: April 4, 2014

Opposition No. 91209972

JPI Commercial, LLC

v.

Xylem IP Holdings LLC

Benjamin U. Okeke, Interlocutory Attorney:

On March 28, 2014, applicant filed a renewed proposed amendment to its application Serial Nos. 85519067 and 85519065, with opposer's consent.

By the proposed amendment applicant seeks to amend the identification of goods in International Classes 9 and 10 in both applications to add the following underlined language and remove the following struck language:¹

Class 9

~~Electronic apparatus for testing the sterility of medical equipment;~~
platinizing instruments in the nature of electrolysis apparatus for electroplating purposes for use in replating platinum on an electrode; industrial liquid analyzers; radiometers for detecting and measuring small amounts of electromagnetic radiant energy; dew point hygrometers; clinical laboratory analyzers for measuring, ~~testing and analyzing blood for blood glucose and blood lactate,~~
computer software for controlling environmental water quality

¹ The goods in International Classes 7 (unopposed) and 17 remain unchanged in both applications.

Opposition No. 91209972

monitoring systems; computer software for displaying, calibrating and uploading data collected by environmental monitoring instruments and transferring it to computers; analytical instruments, namely, carbon dioxide monitors for non-medical use in the bioprocessing and fermentation industries; sensor-based bioanalytical instruments for non-medical use in the nature of electronic biochemistry analyzers, monitors and probes for measuring carbohydrates, vitamins, amino acids and dissolved gases; bioanalytical systems for non-medical use comprised of optical, electrochemical, potentiometric and photometric sensors for measuring carbohydrates, vitamins, amino acids and dissolved gases.

Class 10

~~Blood glucose oxidase meters, excluding pharmaceutical preparations; heat stress instruments in the nature of medical devices for measuring heat stress in human beings that utilize ultrasonic oscillations to measure body temperature and respiration.~~

A proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must also comply with all other applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP §§ 514.01 and 605.03(b). In particular, while an applicant may amend to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. *See* Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

The proposed amendment is unacceptable in part inasmuch as a portion of the proposed amendment would result in the identification of goods that are not within the scope of the present identification. Specifically, the removal of the wording “blood for blood glucose and blood lactate” in the proposed amendment results in a clause that simply reads “clinical

Opposition No. 91209972

laboratory analyzers for measuring,” which without the a subject matter to identify the bounds of what is being measured, particularly blood for blood glucose and blood lactate is beyond the scope of the present identification, and moreover results in an unacceptably indefinite identification.

Therefore, the Board cannot accept this wording in the proposed amendment and will not enter the amendment.

In view of these findings, the motion to amend is **DENIED without prejudice**. The present identification of goods, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of future amendment. *See* Trademark Rule 2.71(a); TMEP §1402.07(d).

However, inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are **SUSPENDED**, and the parties are allowed until **THIRTY DAYS** from the mailing date of this order to file a revised motion to amend, failing which the Board will resume proceedings and reset dates, and the opposition will go forward on the present application.