

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

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Mailed: August 29, 2014

Opposition No. 91210075

InterCommunications, Inc.

v.

Intercom, Inc.¹

**M. Catherine Faint,
Interlocutory Attorney:**

On July 22, 2014, applicant filed a proposed amendment to its application Serial No. 85580111, with opposer's consent.

By the proposed amendment applicant seeks to amend the identification of goods from International Class 9 to services in International Class 42 as follows:

from

"Computer software platforms for use in customer relationship management (CRM); computer communications software used for customer relationship management"

to

"Computer software platforms for use in customer relationship management (CRM); computer communications software used for customer relationship management, all of the foregoing software

¹ Applicant's change of name was filed with the assignment branch of the Office on December 2, 2013 and is viewable at Reel/Frame No. 5164/0275.

goods for communicating directly with customers over the Internet and other communications networks."

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 inasmuch as a party may not amend definite identification of goods to specify services, or vice versa with an exception for computer software. Where the software was not previously identified as "recorded" or "downloadable," the identification can be narrowed to "non-downloadable" software which is a service in Class 42. *See* TMEP § 1402.07(c).

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

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resume proceedings and reset dates, and the opposition will go forward on the present application.
