

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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lg/al

Mailed: February 23, 2016

Opposition No. 91211617

Gap (Apparel), LLC

v.

Stiftelsen Gapminder

By the Trademark Trial and Appeal Board:

On November 13, 2015, Applicant filed a proposed amendment to application Serial No. 79099737, with Opposer's consent, and Opposer's withdrawal without prejudice of the opposition, contingent upon entry of the amendment.

By the proposed amendment Applicant seeks to delete the goods in International Class 35, in their entirety, from the application and seeks to amend the identification of goods in International Classes 9, 38, and 41.

International Class 9

From apparatus for recording, transmission or reproduction of sound or images; downloadable computer software for the analysis and presentation of statistics and data; downloadable documents in electronic form featuring a wide variety of statistical information in the areas of population, income, health, education, employment, safety, technology usage, and other statistical information; downloadable electronic data files featuring a wide variety of statistical information in the areas of population, income, health, education, employment, safety, technology usage, and other statistical information

To computer programs (downloadable software); electronic documents; downloadable files, all of the foregoing in connection with promotion sustainable global development and achievement of development goals by increased use of statistics and other information about social, economic and environmental development

International Class 38

From computer aided transmission of messages and images; digital transfer services and transmission services via the internet, namely, electronic transmission of data and documents via the internet; providing user access to a global computer network; transmission of messages via electronic media; transmission of video film, namely, video transmission over digital networks; providing access to databases; providing on-line electronic bulletin boards for transmission of messages among computer users concerning global computer network development, computer software, online telecommunication services, statistics, and statistical analysis and presentation of data; telecommunication and data communication via portal to acquire information, namely, communication services in the nature of electronic transmission of data and documents among users of computers; transfer and transmission of database information via telecommunications networks; providing information about telecommunication, and providing telecommunication consultation and advice in all of the above mentioned services

To Transfer and transmission of database information via telecommunications networks, all of the foregoing in connection with promotion sustainable global development and achievement of development goals by increased use of statistics and other information about social, economic and environmental development

International Class 41

From Educational services, namely, provision of web sites featuring educational materials in a wide variety of statistical fields, including population, income, health, education, employment, safety, technology usage, and other measures; providing of training in the field of statistical analysis; cultural activities, namely, organizing cultural and arts events; digital imaging services; electronic desktop publishing; publication of data media, namely, publication of electronic magazines; publication of electronic books and journals on-line; services relating to interactive games, namely, providing temporary use of non-downloadable interactive games; providing on-line electronic publications, namely blogs concerning global development, computer

software, online publishing services, statistics, and statistical analysis and presentation of data; providing information, consultation and advice concerning the foregoing educational and publishing services

To Educational services, namely, provision of web sites featuring educational materials in a wide variety of statistical fields, including population, income, health, education, employment, safety, technology usage, and other measures; providing of training in the field of statistical analysis; providing on-line non-downloadable electronic publications, namely blogs concerning global development, computer software, online publishing services, statistics, and statistical analysis and presentation of data; providing information, consultation and advice concerning the foregoing educational and publishing services, all of the foregoing in connection with promotion sustainable global development and achievement of development goals by increased use of statistics and other information about social, economic and environmental development.

International Class 42

From scientific and technological services, namely, research and design in the field of global computer network development, computer software, online computer services, statistical informational technology data, and statistical informational technology analysis and presentation of data; design and development of computer hardware and software; maintenance of computer software; updating of computer software for others; hosting of web sites, namely, providing websites featuring online, non-downloadable computer software for the analysis and presentation of statistics and data; data conversion of computer programs and data, not physical conversion; computer programming; design of computer software, web pages, and web sites, namely, providing websites with features allowing users to design and share web pages customized with embedded charts and animations; design of computer systems; duplication of computer programs; installation of computer software; conversion of data or documents from physical to electronic media; providing information, consultation and advice in the fields of scientific and technological research and design, computer software, online computer services, and computer website design

To Research and design in the field of global computer network development, computer software, online computer services, statistical informational technology data, and statistical informational technology analysis and presentation of data; design and development of computer hardware and software, all of the foregoing in connection with

promoting sustainable global development and achievement of development goals by increased use of statistics and other information about social, economic and environmental development

By the proposed amendment applicant seeks to delete the goods in International Class 35, in their entirety, from the identification of goods.

In an opposition to an application having multiple classes, as is the case here, if the applicant files a request to amend the application to delete an opposed class, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by Trademark Rule 2.135; and TBMP § 602.01.

Inasmuch as Opposer's written consent is of record, application Serial No. 79099737 stands abandoned with regard to International Class 35 only.

With regard to the proposed amendments in International Classes 38, 41, and 42 the Board finds the amendments are clearly limiting in nature as required by Trademark Rule 2.71(a), and because Opposer consents thereto, the amendments are approved and will be entered. *See* Trademark Rule 2.133(a).

With regard to the proposed amendment to International Class 9, however, the Board notes that 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 International Class 9 inasmuch as the wording "computer programs" fails to specify the function of the programs (it only indicates

the content or field of use) and the wording “electronic documents; downloadable files” is non-specific. For example, it is unclear if the downloadable files are downloadable music files or downloadable multimedia files containing text. It is also unclear if the electronic documents are downloadable documents provided via a website.

Therefore, the Board cannot accept the proposed amendment for International Class 9.

In view of these findings, the motion to amend is denied without prejudice. The present identification of goods/services, 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.