

**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

Mailed: May 27, 2015

Opposition No. 91218238

Rexair LLC

v.

EXAIR Corporation

Jennifer Krisp, Interlocutory Attorney:

On March 11, 2015, applicant filed a proposed amendment to application Serial No. 86055983, with opposer's consent, and opposer's withdrawal without prejudice of the opposition, contingent upon entry of the amendment.

The Board notes applicant's April 15, 2015 motion to suspend, which was granted by the Board's ESTTA filing system on April 15, 2015. However, in view of the ruling herein on the motion to amend, proceedings are suspended pending the filing of a response to this order.

By the proposed amendment applicant seeks to amend the identification of goods from:

Machine parts, namely, nozzles which are parts of compressed air systems for part cleaning, chip removal, part drying, liquid blowoff, part cooling, material conveying, part ejection, and air assist, and components thereof; machine parts, namely, air knives, air wipes, air jets, air amplifiers, and air guns which are parts of compressed air systems for part cooling, material conveying, part ejection, and air assist, and components thereof; machine parts, namely, atomizing nozzles for mixing liquids and compressed air for spraying coatings, cleaning, and painting parts; machine parts for compressed air systems, namely, air hoses, filters, pressure regulators, mufflers, metal pipe fittings, and magnetic bases, and components thereof; vacuum cleaners powered by compressed air for use in industrial environments, and components thereof; wet-dry vacuums

powered by compressed air for use in industrial environments, and components thereof; pneumatic tube conveyors; vacuum pumps operated by compressed air  
to

Machine parts, namely, nozzles which are parts of compressed air systems for part cleaning, chip removal, part drying, liquid blowoff, part cooling, material conveying, part ejection, and air assist, and components thereof; machine parts, namely, air knives, air wipes, air jets, air amplifiers, and air guns which are parts of compressed air systems for part cooling, material conveying, part ejection, and air assist, and components thereof; machine parts, namely, atomizing nozzles for mixing liquids and compressed air for spraying coatings, cleaning, and painting parts; machine parts for compressed air systems, namely, air hoses, filters, pressure regulators, mufflers, metal pipe fittings, and magnetic bases, and components thereof; vacuum cleaners powered by compressed air for use in industrial environments, and components thereof; wet-dry vacuums powered by compressed air for use in industrial environments, and components thereof; pneumatic tube conveyors; vacuum pumps operated by compressed air, **namely, venturis; none of the foregoing for use in domestic or commercial (as opposed to industrial) environments.**

A proposed amendment to an application or registration which is the subject of an inter partes proceeding must comply with all applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. See TBMP §§ 514.01 and 605.03(b). The proposed amendment cannot be approved for three reasons.

First, parentheses and brackets may not be used in identifications. Brackets are used to identify wording *deleted* from registered marks, and parentheses are strongly discouraged and are permitted only to explain or translate the matter immediately preceding the parenthetical phrase in such a way that it does not affect the clarity of the identification, e.g., “obi (Japanese sash).” TMEP §1402.12.

Second, the nature and definition of the term “venturis” is unclear. If this is a registered mark owned by a third party, that is, not owned by applicant, applicant may not use it in the identification, and must delete the term. A registered mark indicates origin in one party and cannot be used to define goods or services that originate in a party other than the registrant. TMEP §1402.09.

Third, depending on applicant's clarification of the term "venturis," the amendment may be beyond the scope of the present identification. While an applicant may clarify or limit the identification, adding to or broadening the scope is not permitted. Trademark Rule 2.71(a); TMEP §1104.10(b)(iii), 1402.06 *et seq.*, and 1402.07.

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).

Inasmuch as the filing of the proposed amendment indicates to the Board that the parties seek 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.