

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

RA

Mailed: March 21, 2016

Opposition No. 91218442

Veeam Software AG

v.

Veam Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

On February 17, 2016, Applicant filed a proposed amendment to its application Serial No. 85795280, with Opposer's consent.

By the proposed amendment Applicant seeks to amend the description of goods and services by, among other things, broadening the computer software so that it is no longer limited to “computer system and application development, deployment and management for distributing and publishing multimedia content” but expands, as shown below, to include any computer software for “development, deployment and management”, except computer software for data backup data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services.

International Class 9 (as published)

Computer application software for mobile phones, portable media players, handheld computers, laptops, and desktops, namely, software for publishing multimedia content; Computer software for processing multimedia content, namely, digital music, images, and video files; and Computer software for computer system and application development, deployment and management for distributing and publishing multimedia content

International Class 9 (proposed)

Mobile software applications for others for publishing multimedia content, namely, digital music, images, and video files, excluding computer software for data back-up, data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services; and Computer software for development, deployment and management, excluding computer software for data backup, data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services.¹

International Class 42 (as published)

Application service provider (ASP) featuring software for use in publishing multimedia content

International Class 42 (proposed)

Application service provider (ASP), namely, managing and developing mobile software applications for others for publishing music, images, video content, fitness-related content, all of the above excluding computer software for data back-up, data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services.

Amendments to the application made during an inter partes proceeding must comply with the same rules and statutory provisions applied during ex parte examination.

Trademark Rule 2.133; *Vaughn Russell Candy Co. v. Cookies In Bloom, Inc.*, 47 USPQ2d 1635, 1636 (TTAB 1998).

With respect to amendments to the identification of goods, the Board will not approve a proposed amendment which involves an addition to the identification of goods or

¹ An example of an acceptable International Class 9 amendment:

Mobile software applications for others for publishing multimedia content, namely, digital music, images, and video files, excluding computer software for data back-up, data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services; and Computer software for computer system and application development, deployment and management for distributing and publishing multimedia content, excluding computer software for data backup, data protection, data replication, disaster recovery, and related computer, cloud, and network monitoring services.

services. See Trademark Rule 2.71(a) (“The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services.”) and *Aries Systems Corp. v. World Book Inc.*, 26 USPQ2d 1926, 1930 (TTAB 1993) (“any revision to the description of goods in a registration or application cannot exceed the scope of the goods as currently identified in the registration or as set forth in the application”).

Because the proposed amendment expands the International Class 9 goods, the proposed amendment is DENIED.

Proceedings are suspended, and Applicant is allowed until thirty days from the mailing date of this order to submit an acceptable amendment, with Opposer’s consent, failing which proceedings herein will go forward based on the application as published for opposition.