

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 17, 2015

Opposition No. **91221202**

The Viking Corporation

v.

Viking Controls, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

This proceeding was instituted on March 23, 2015. By the Board's institution order, Applicant was allowed until May 2, 2015, to serve and file its answer to the notice of opposition. Neither an answer nor an extension to file an answer was filed. Instead, on May 11, 2015, Applicant filed a "voluntary amendment" to its **Application Serial No. 86255273** with the Trademark Examining Operation through TEAS. However, an application that is the subject of a Board *inter partes* proceeding may not be amended in substance, except with the consent of the other party and the approval of the Board, or upon motion granted by the Board. See Trademark Rule 2.133(a). Thus, a request to amend an application involved in a Board proceeding must be filed with the Board¹ and not with the Trademark Examining Operation. Additionally, Applicant should note that every paper filed in

¹ The Board encourages the filing of documents electronically via its ESTTA system. Instructions and forms for electronic filings are available at <http://estta.uspto.gov>. All Board proceeding files can be viewed via TTABVUE at <http://ttabvue.uspto.gov>.

the USPTO in *inter partes* cases must be served on the other party and be accompanied by proof of service. See Trademark Rule 2.119(a). It does not appear that Applicant served its filing on Opposer.² Nevertheless, in the interest of moving this matter forward, the Board has considered the filing.

By the proposed amendment, Applicant seeks to amend the recitation of services in International Class 37 as follows (amendment in bold type):

From: Installation, maintenance, and repair of environmental control systems for buildings; Installation, maintenance, and repair of systems for providing heating, ventilating, and air conditioning for industrial, commercial, governmental facilities; Installation, maintenance, and repair of heating, ventilating, and air conditioning systems for facility management controls; Maintenance of critical environmental control systems in industrial, commercial, and governmental facilities; in International Class 37.

To: Installation, maintenance, and repair of environmental control systems for buildings; Installation, maintenance, and repair of systems for providing heating, ventilating, and air conditioning for industrial, commercial, governmental facilities; Installation, maintenance, and repair of heating, ventilating, and air conditioning systems for facility management controls; Maintenance of critical environmental control systems in industrial, commercial, and governmental facilities; **none of the aforesaid services relating to fire detection, fire protection or fire suppression;** in International Class 37.

Although it appears that the proposed amendment may be limiting in nature, as required by Trademark Rule 2.71(a), Opposer has not consented thereto. Where an unconsented motion to amend an application is filed in an *inter partes* proceeding before trial, the Board generally will defer determination until final decision or

² Opposer is referred to <http://ttabvue.uspto.gov/ttabvue/v?pno=91221202&pty=OPP&eno=4> to view the filing. Applicant is advised that strict compliance with Trademark Rule 2.119 will be required in all future papers filed with the Board.

until the case is decided upon summary judgment. *See, e.g., Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990) (motion to amend identification of goods deferred). On the other hand, if a clearly limiting amendment is proposed and is consented to by the opposing party, it will typically be approved and entered. *See* Trademark Rule 2.133(a).

In view thereof, **Applicant is allowed until SEPTEMBER 8, 2015, to provide Opposer's consent to the proposed amendment, failing which the Board may issue a notice of default against Applicant pursuant to Fed. R. Civ. P. 55(a) for its failure to answer the notice of opposition and defer determination of Applicant's proposed amendment until final decision or until this matter is decided upon summary judgment.**

Proceedings are otherwise **SUSPENDED**.

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