

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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General Contact Number: 571-272-8500

mw/mt

Mailed: January 29, 2016

Opposition No. 91222163

*Caterpillar Inc.*

*v.*

*Aktiebolaget SKF*

**Michael Webster, Interlocutory Attorney:**

On January 14, 2016, Applicant filed a proposed amendment to its application Serial No. 79138749, with Opposer's consent.

By the proposed amendment Applicant seeks to amend the identification of goods and services as follows:<sup>1</sup>

International Class 7

**From:**

Bearings as part of machines; machine parts, namely, bearing housings

**To:**

Bearings [as part of machines; machine parts, namely, bearing;], housings, fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings, all of the foregoing specifically intended for rolling element bearing applications except for use in connection with gas turbines and gas turbine applications, and except for use in connection with electric motor driven or gas turbine driven compressor packages applied in the oil and gas industry;

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<sup>1</sup> The underlined wording represents wording to be added to the identification of goods and services.

International Class 9

**From:**

Instruments and equipment for detecting, sensing, measuring, monitoring and controlling of bearings and housings or any industrial rotating machinery as well as computer operating software for the aforesaid goods

**To:**

Instruments [and], equipment, and computer operating software for detecting, sensing, measuring, monitoring and controlling of bearings [and], housings [or any industrial rotating machines as well as], fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings, all of the foregoing specifically intended for rolling element bearing applications except for use in connection with gas turbines and gas turbine applications, and except for use in connection with electric motor driven or gas turbine driven compressor packages applied in the oil and gas industry [for the aforesaid goods];

International Class 42

**From:**

Technological consulting and advisory services for detecting, sensing, measuring, monitoring and controlling of bearings and housings or any industrial rotating machinery as well as prediction of maintenance and life prognoses for bearings and housings

**To:**

Technological consulting and advisory services for detecting, sensing, measuring, monitoring and controlling of bearings [and], housings [or any industrial rotating machinery], fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings as well as prediction of maintenance and life prognoses for bearings [and], housings, fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings, all of the foregoing specifically intended for rolling element bearing applications except for use in connection with gas turbines and gas turbine applications, and except for use in connection with electric motor driven or gas turbine driven compressor packages applied in the oil and gas industry.

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.

In this case, the proposed wording “fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings” in the identification of goods in International Class 7 appears to add the underlined goods to the identification of goods in the application, thereby adding to the scope of the identification in Class 7.

In addition, the Post Registration Section of the USPTO uses single square brackets to indicate that goods/services have been deleted from a registration either by amendment under 15 U.S.C. §1057, filing of a partial affidavit of continued use under 15 U.S.C. §1058 or 15 U.S.C. §1141k, or filing of a partial renewal application under 15 U.S.C. §1059. Therefore brackets should not be used in the identification of goods and services. *See* TMEP Section 1402.12.

In this instance, it is unclear whether Applicant is using brackets in the proposed amendment to set forth wording to be deleted from the identification of goods and services. The Board recommends submission of a red-lined copy of the proposed amendment showing the proposed changes, along with a clean copy of the proposed changes. TBMP § 514.01 (2015).

In view of the above, entry of the amendment is denied, and the parties are allowed until thirty days from the mailing date of this order in which to file an amendment which is in compliance with all applicable authorities, failing which the Board will resume proceedings with respect to the identification of goods as presently identified.

Proceedings are otherwise suspended.