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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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| Proceeding | 91222163 |
| Party | Defendant Aktiebolaget SKF |
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| Date | 02/10/2016 |
| Attachments | Consented Motion to Amend Application (Opp. No. 91222163).pdf(319009 bytes) |

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Solar Turbines, Incorporated,)
)
 Opposer,)
)
) Opposition No. 91222163
)
Aktiebolaget SKF,) Application No. 79/138,749
)
) Applicant.)

CONSENTED MOTION TO AMEND APPLICATION

Responsive to the Board’s Order dated January 29, 2016 and pursuant to TBMP Section 514, Applicant requests the identification of goods and services for the above-identified application be amended as set forth below. As requested in the Board Order, Applicant is providing another version of the proposed amended wording to show the deletions and additions in strike-through and underlining (i.e., the track changes format requested in the Order). The description of goods and services presently reads as follows:

Class 7: Bearings as part of machines; machine parts, namely, bearing housings;

Class 9: 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; and

Class 42: 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.

Applicant, through its attorneys, seeks to further amend the identification of goods and services in the above-identified application. The amended identification of goods and services shall read as follows in the redlined version below and the final proposed amended version in Exhibit A:

Class 7: Bearings as parts 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;

Class 9: 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; and

Class 42: 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.

Applicant further confirms that the wording that is “added” to the description of goods and services, as indicated by underlining, is within the scope of the initial wording and is intended to be limiting and is permissible under the Trademark Rules. The Board Order also suggests “fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings” have been added to the goods in class 7; however, to clarify such goods are all “machine parts” and “machine parts” were initially identified in the application as published. Considering the broad wording “machine parts,” it is clear the “fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings” are a subset of such goods and within the scope. By this amendment, Applicant is deleting the word “namely” that follows “machine parts,” but under the guidance provided by the Board recently, it is clear that a namely clause might provide clarification but does not strictly limit the goods and thus the “fans, blowers, spindles, drivelines, axles, rollers,

conveyers, and couplings” are within the scope of the initially identified “machine parts.”¹ All of the revisions to the goods and services are thus within the scope of the initial wording.

This amendment is filed with the written consent of Opposer, Solar Turbines Inc., by its attorney Christopher P. Foley, Esq., pursuant to the terms of a Settlement Agreement reached between the parties in these proceedings. Counsel for both parties respectfully submits the amended wording should be accepted by the Board and counsel is available to discuss via telephone if desired by the Board.

Although it is believed no fee is due, any further fee that is due can be charged to Deposit Account No. 04-2223 to process this amendment.

The undersigned being warned that willful false statements and the like so made are punishable by fine or imprisonment or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the registration or this document, declares

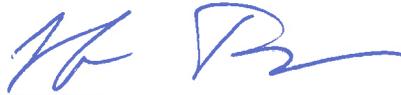
¹ The Board recently explained the ““namely” clause is *often* used in an identification of goods to clarify terminology. Using “namely” *typically* focuses the scope of the identification to those particular items following the word “namely.” See Trademark Manual of Examining Procedure (TMEP) § 1402.03(a) (October 2015). In the subject application, however, the wording after the “namely” clause merely provides a detailed description of the function and individual components of Applicant’s devices. Therefore, we find that Applicant’s goods are “electronic cigars.”” *In re Land Sky Sea, LLC*, App. No. 85/923,067 (TTAB January 4, 2016) (emphasis added)(discussing application for goods described as “electronic cigars, namely, an electronic device to heat liquids to create a vapor for a human to inhale by mouth being a battery, an LED light source, a mouthpiece, and a cartomizer, in the nature of a compartment for the fluid to be heated, a heating coil, and a vaporizing chamber”). A copy of *In re Land Sky Sea, LLC* is attached. Under the guidance of *Land Sky Sea*, there is no *per se* rule that “namely” limits the goods. See also *National Footwear Limited v. Hart, Schaffner & Marx*, 760 F.2d. 1383 (3rd Cir. 1985)(determining scope of federal registration to include all types of footwear, not just the “shoes, slippers and boots” that follow the “namely” clause).

all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

Respectfully submitted,

AKTIEBOLAGET SKF

By:



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Date: February 10, 2016

EXHIBIT A

Class 7: Bearings, 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;

Class 9: Instruments, equipment, and computer operating software for detecting, sensing, measuring, monitoring and controlling of bearings, 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; and

Class 42: Technological consulting and advisory services for detecting, sensing, measuring, monitoring and controlling of bearings, housings, fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings as well as prediction of maintenance and life prognoses for bearings, 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.

CERTIFICATE OF SERVICE

I hereby certify that on this 10th day of February, 2016, the foregoing Consented Motion to Amend Application was served, by mailing same first class and postage prepaid, with a courtesy copy by e-mail, to the following:

Christopher P. Foley, Esq.
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