

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

mw/mt

Mailed: March 7, 2016

Opposition No. 91222163

*Caterpillar Inc.*

*v.*

*Aktiebolaget SKF*

**Michael Webster, Interlocutory Attorney:**

On January 14, 2015, Applicant filed a proposed amendment to its application Serial No. 79138749 with Opposer's consent. In response to the Board's January 29, 2015 order denying the amendment, Applicant re-filed (on February 10, 2016) the proposed consented amendment to its application Serial No. 79138749.

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, 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

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

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;

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, 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;

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, 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.

With regard to the proposed amendment of the identification of goods and services in International Classes 9 and 42, the Board finds that the proposed amendment is limiting in nature as required by Trademark Rule 2.71(a). Because Opposer consents to the proposed amendment, the amendment is approved and entered. *See* Trademark Rule 2.133(a).

However, the Board again finds the amendment to the recitation of services in International Class 35 unacceptable for the reasons stated below.

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) (2015). 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.

Applicant contends that the wording proposed to be added to the identification of goods in Class 7 is permissible as within the scope of the original wording because the additional goods, namely “fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings” are within the broad wording “machine parts.” Applicant’s contention is incorrect. Because the wording “machine parts” is vague and overly broad, the identification of goods, as published, contained the limiting and specific wording “namely, bearing housings” to specify the particular type of machine parts. Therefore, the scope of the identification in Class 7 for purposes of amendment is “bearings as parts of machines” and “bearing housings.”

Applicant's proposed amendment deletes the goods "bearing housings" and replaces it with different goods that are not within the scope of bearing housings. The proposed amendment clearly changes the identification of goods in class 7 by deleting the unambiguous goods and adding goods that were not in the identification of goods as published.<sup>2</sup> See TMEP § 1402.07(c). Therefore, the proposed amendment to the identification of goods in International Class 7, namely, "fans, blowers, spindles, drivelines, axles, rollers, conveyors, and couplings" is unacceptable because it identifies goods beyond the scope of the wording in the identification as published.

In view of the above, the Board cannot accept the wording in the proposed amendment to the identification of goods in International Class 7 and will not enter the amendment. The proposed amendment to Class 7 is **DENIED without prejudice**. The present identification of goods for International Class 7, 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).

However, inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are suspended, and the parties are allowed until **thirty (30) days** from the mailing date of this order to file a revised motion to amend with regard to the International

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<sup>2</sup> Applicant's use of the non-precedential decision in *In re Land Sky Sea, LLC* (Application Serial No. 85923067), is misplaced. Here, the wording in the identification after "namely" clearly "focuses the scope of the identification," *Id.*, on the goods after "namely," in this case, "bearing housings." The wording "bearing housings" is not used to provide a detailed description of the machine parts. Further, even a detailed description could not be deleted from an identification and replaced with a description for a different product if the wording before "namely" was broad or unspecific

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Class 35 services, failing which the Board will resume proceedings and reset dates, and this consolidated case will go forward on the present application pursuant to the terms of this order.

Proceedings are otherwise suspended.