

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

EJW/nmt

Mailed: April 6, 2016

Opposition No. 91224074

eOriginal, Inc.

v.

Kore Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On April 1, 2016, pursuant to a settlement agreement between the parties, Applicant filed an unopposed motion to amend its opposed applications Serial Nos. 86508475, 86508491, and 86508548, indicating that Opposer had consented to the amendment. Specifically, Applicant seeks to amend its goods and services in International Classes 9 and 42, as follows:¹

From: ~~Downloadable~~ software for secure messaging and data transfer using instant messaging and email systems, and for secure data management; ~~Enterprise-grade~~ messaging computer software platform for communication, collaboration and commerce between **people**, teams, business and systems; ~~Computer software platform for business messaging and execution of business processes, thus enhancing productivity~~ (International Class 9);

and

~~Providing a website featuring technology that allows secure data management;~~ Software as a service (SAAS) services featuring software platform ~~for business messaging and execution of business processes, thus enhancing productivity~~ (International Class 42).

¹ Lined through wording is to be deleted and wording shown in bold type font is to be added.

To: **Computer** software for providing a messaging **platform for bots that enables** instant messaging, **sharing, networking** and collaboration **between individual users, members of discrete groups, such as teams within an organization, individuals, and teams across entire organizations** (International Class 9);

and

Providing software as a service (SAAS) featuring **software that serves as a virtual agent enabling persons to accomplish tasks across disparate applications and systems; and as a messaging platform for controlled communication and collaboration available for use on a smartphone, tablet or computer** (International Class 42).

There are two problems with Applicant's proposed amendments to the identifications of services:

- (1) With respect to the goods in International Class 9, it is unclear which identification phrase is being amended. In view thereof, it is unclear whether deleting the wording highlighted in yellow, *i.e.*, "downloadable" or "enterprise-grade" is effectively broadening the scope of the proposed identification. Likewise, because the term "business" has been deleted following the SAAS services in the proposed identification in International Class 42, it is unclear whether the "software that serves as a virtual agent" is a subset of a "software platform for business messaging and execution of business processes." In view of the foregoing, it appears that Applicant proposes identifications of goods and services that are impermissibly broader in scope than the original identifications. *See* Trademark Rule 2.71(a).

(2) Application Serial Nos. 86508475, 86508491, and 86508548 are the subjects of both this opposition and related Opposition No. 91225028 (Opposer KORE Wireless Group Inc.). The parties are advised that when a request to amend an application is filed that is also the subject of another inter partes proceeding, the consent of the **other Opposer(s)** in each of the other proceedings must be of record before the amendment may be approved. Trademark Rule 2.133(a) and TBMP Section 514.02.

(3) In this case, Applicant has not provided the written consent to the proposed amendment of the Opposer KORE Wireless Group Inc. in Opposition No. 91225028.

In view of the foregoing, Applicant herein is allowed until **THIRTY DAYS** from the mailing date of this order in which to: (i) submit revised amended identifications of goods and services which comply with Trademark Rule 2.71(a);² and (ii) submit the written consent of the related Opposer, KORE Wireless Group Inc., to entry of said proposed amendments, failing which the proposed amendments will be given no further consideration, the proceeding shall be resumed, and trial dates shall be reset.

Proceedings herein are otherwise **SUSPENDED**.

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² The parties may first contact the assigned Interlocutory Attorney, Elizabeth Winter, at 571-272-9240, to discuss any proposed changes to the identifications of goods and services.