UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Baxley

Mailed: January 9, 2003

Opposition No. 124,752

Zeeks, Inc.

v.

Hyperion Solutions Corporation

Andrew P. Baxley, Interlocutory Attorney:

On October 21, 2002, applicant filed a proposed amendment to the identification of goods of its application Serial No. 76/042,824, pursuant to the parties' settlement agreement.[1] On October 24, 2002, opposer filed a withdrawal of the its notice of opposition, in response to the proposed amendment.[2]

The Board notes initially that applicant directed its proposed amendment to the Office of Trademark Program Control. Inasmuch as the involved application is subject of an *inter*

[1] It is noted that the proposed amendment constitutes applicant's second attempt to amend the identification of goods in this proceeding. Applicant filed its first proposed amendment on May 9, 2002; that proposed amendment was denied by the Board in an order dated July 24, 2002.

[2] It is noted that applicant directed its proposed amendment to the Office of Trademark Program Control. Inasmuch as the involved application is subject of an inter partes proceeding before the Board, the proposed amendment should have been directed to the Board. See Trademark Rule 2.133; TBMP Section 514.01.

partes proceeding before the Board, the proposed amendment should have been directed to the Board. See Trademark Rule 2.133; TBMP Section 514.01. Inasmuch as applicant has included a copy of the parties' settlement agreement with its proposed amendment, the Board will treat the proposed amendment as a consented motion to amend the involved application. See TBMP Sections 514.01 and 514.02.

By the proposed amendment, applicant seeks to change the identification of goods **from** "[c]omputer software, namely, tools for presenting, organizing, and managing data from a variety of business related software applications via a single view in a multidimensional data base; computer software for creating customizable personal web portals to provide data from a variety of business related software applications" **to** "[c]omputer software, namely, tools for presenting, organizing, and managing data from a variety of business related software applications via a single view in a multidimensional data base; computer software for creating customizable web portals to provide data from a variety of business related software applications."

Notwithstanding opposer's consent thereto, the proposed amendment must also comply with all applicable rules and statutory provisions. These include Trademark Rules 2.71 to 2.75. Thus, for example, a proposed amendment which involves an addition to the identification of goods, or

which materially alters the character of the subject mark, will not be approved by the Board. See Trademark Rules 2.71(b), 2.72, 2.173(a) and 2.173(b); and *Aries Systems Corp. v. World Book Inc.,* 26 USPQ2d 1926 (TTAB 1993). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991).

Trademark Act Section 7(c), 15 U.S.C. Section 1057(c), provides that the filing of any application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration. Therefore, the identification of goods in an application defines the scope of those rights established by the filing of an application for the Principal Register. While an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. Section 2.71(a); TMEP Sections 804.09 and 804.09(a).

The proposed amendment of the identification of goods is unacceptable because it designates goods that are outside of the scope of the identification as published for opposition. The relevant goods set forth in the identification of goods as published for opposition are set forth as "computer software for creating customizable personal web portals to provide data from a variety of business related software applications," while the proposed

amendment is presumed to seek to expand the scope of such goods to "computer software for creating [any] customizable web portals to provide data from a variety of business related software applications." See TMEP Section 1402.07. Such proposed amendment, if permitted, could well modify applicant's channels of trade, and affect other factors to be analyzed in determining likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d). See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). Were the Office to permit applicant undue latitude in changing the identification of goods during the course of prosecuting an application, it could well jeopardize the rights of a third party (e.g., someone prepared to adopt a similar mark sometime who, after the filing date of the involved application, had searched the records of the United States Patent and Trademark Office and then made a decision on potential instances of likelihood of confusion). Such a party might well rely to its detriment upon the scope of the identification of goods as published for opposition.

In view thereof, the motion to amend is hereby denied, and opposer's withdrawal of the notice of opposition, which was filed in response thereto, will not be considered.

Applicant is allowed until **thirty days** from the mailing date of this order to file an answer to the notice of opposition.

Discovery is open and the close of discovery and trial dates are set as follows:

DISCOVERY PERIOD TO CLOSE:	**4/18/03**
Plaintiff's 30-day testimony period to close:	**7/17/03**
Defendant's 30-day testimony period to close:	**9/15/03**
15-day rebuttal testimony period to close:	**10/30/03**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.