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

Baxley

Mailed: June 24, 2002

Opposition No. 124,752

Zeeks, Inc.

v.

Hyperion Solutions Corporation

Andrew P. Baxley, Interlocutory Attorney:

On May 7, 2002, applicant filed a motion to amend its application Serial No. 76/042,824, with opposer's consent, and opposer filed a voluntary withdrawal of the opposition, in apparent accordance with the parties' settlement agreement.

Turning first to applicant's motion to amend, applicant seeks to change the identification of goods **from** "computer 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** "computer 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

specialized business web portals to provide data from a variety of business related software applications."

Opposer's consent thereto notwithstanding, applicant's 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 that was set forth in the application at the time of filing. The identification as published for opposition states that applicant's computer software is for "creating customizable personal web portals to provide data from a variety of business related software applications," while the identification in the proposed amendment states that applicant's computer software is for "creating specialized business web portals to provide data from a variety of business related software applications." Notwithstanding that the identification as published and the identification in the proposed amendment indicate that applicant's software is for creating "portals to provide data from a variety of business related software applications," the proposed amendment impermissibly changes the purpose of applicant's software from "creating customizable personal web portals" to "creating specialized business web portals." This 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 original identification of goods.

In view thereof, the motion to amend is hereby denied.[1]

Turning to opposer's withdrawal of the opposition, the withdrawal appears to be in accordance with the parties' agreement which has settled this case and appears to be based upon an assumption that applicant's motion to amend the involved application would be accepted. Inasmuch as applicant's motion to amend has been denied, opposer is allowed until thirty days from the mailing date to withdraw its withdrawal of the opposition, failing which the opposition will be dismissed without prejudice.[2]

Proceedings herein are otherwise suspended.

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[1] If applicant wishes to adopt the identification set forth in the proposed amendment, it must do so in a new application.

[2] Dismissal without prejudice would be appropriate inasmuch as applicant has not filed its answer. See Trademark Rule 2.106(c). If opposer withdraws its withdrawal of the opposition, the Board will reset applicant's time to answer and discovery and trial dates in its order resuming proceedings.