

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: August 31, 2005

Opposition No. **91162982**

3M Company and Quante AG

v.

Quanta Computer Inc.

Cheryl S. Goodman, Interlocutory Attorney:

On July 20, 2005, the Board issued notice of default for failure of applicant to file its answer as set forth in the Board order dated January 31, 2005. The Board allowed applicant time to show cause why default judgment should not be entered.

On August 3, 2005, applicant filed a response to the Board's notice of default advising that the notice of default was in error because on May 10, 2005, via certificate of mailing, opposer filed a consented request to further suspend proceedings for three months for settlement. Applicant has provided a copy of the consented motion to suspend as well as proof of receipt by the office. Applicant further requests, with opposer's consent, that the Board set aside default and grant the three-month suspension period requested by opposer's prior motion.

In view of the timely filing on May 16, 2005 of the consented motion to suspend for three months, the Board

agrees with applicant that notice of default was in error. Accordingly, notice of default is hereby set aside and opposer's consented motion to suspend is granted.

The Board now turns to applicant's motion to amend the involved application, filed August 26, 2005. By its motion, applicant seeks to amend Class 9 of its application Serial No. 78158027, with opposer's consent.

Applicant seeks to change the identification of goods in Class 9 **from:**

Circuit boards; computer hardware; computer peripherals; PC cards; computer adaptors for connection to the Internet; computer monitors; batteries; computer battery chargers; keyboards; PDAs; computer software for data processing and data storage; computer hardware for computer network systems; digital cellular phone, internet phones; cellular phone battery chargers; specialty holsters for carrying cellular phones and pagers; CD drives for computers; video game machines for use with televisions; digital cameras, digital video cameras; televisions; communications software for use in connecting computer network users

to

Circuit boards; computer hardware and peripherals, servers, file storages, blade servers, NAS (network attached storage devices), SAN (storage area networks) and network switches, but excluding other network equipment not aforelisted; PC cards; computer monitors; batteries; computer battery chargers; keyboards; PDAs; computer software for data processing and data storage; digital cellular phone, internet phones; cellular phone battery chargers; specialty holsters for carrying cellular phones and pagers; CD drives for computers; video game machines for use with televisions; digital cameras, digital video cameras; televisions

Class 16 would remain unchanged.

Upon consideration of the proposed amendment to the identification of goods in Class 9, the Board finds the wording "servers, file storages, blade servers, NAS (network attached storage devices), SAN (storage area networks) and network switches, but excluding other network equipment not aforelisted" in the proposed amendment to be outside the scope of the original identification. This is so because these items appear to be additions to the identification rather than a subset of the computer hardware and/or computer peripherals already identified.

Therefore, applicant should use wording such as "namely" after the wording computer hardware and/or computer peripherals to make it clear that the listed goods which follow are within the scope of the original identification.¹

In view thereof, applicant's proposed amendment is denied. Applicant is allowed until THIRTY DAYS from the mailing date of this order to provide, with opposer's consent, a second proposed amendment to Class 9 that is within the scope of the original identification.

Proceedings remain suspended pending further submission from applicant and for the parties' settlement negotiations.

¹ Applicant, could for example, state "computer hardware and computer peripherals, *namely*, servers, file storages, blade servers, NAS (network attached storage devices), SAN (storage area networks) and network switches, but excluding other network equipment not aforelisted" for this portion of the identification of goods.

