

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

jh

Mailed: June 23, 2008

Opposition No. 91163119

LEVEL 3 COMMUNICATIONS, INC.

v.

PALMERSTON LIMITED

Elizabeth A. Dunn, Attorney:

On May 6, 2008, applicant filed a proposed amendment to its application Serial No. 78103682, with opposer's consent.

By the proposed amendment applicant seeks to change the identification of goods in International Class 9

from

Telematics apparatus and instruments, namely, web consoles, electric distribution consoles; wireless network enabled appliances, namely, TVs, DVD machines, radios, personal monitors, wireless video gateway systems, namely, apparatus and equipment combining hardware and software to enable decoding of binary information to transmit over a network standard for distant reception, apparatus and equipment for video calling, video messaging, streaming and browser download of data in the fields of sports and entertainment; television antennas; television sets; television set top boxes to facilitate communication between television sets and mobile telephones or mobile electronic devices; telecommunications equipment and telecommunications equipment making use of a short-range network protocol for connecting different types of electronic devices, namely, telephones, mobile telephones, mobile electronic devices, facsimile machines, mobile telephones and mobile electronic devices used to access enterprise applications, telegram machines and modems for

accessing the Internet and databases on the Internet; electronic devices for receiving television, local, satellite, wireless, personal network, meshed network, IEEE 802;11 standard network, dedicated wireless data network for professional users, OFDM (orthogonal frequency division multiplexing), ultrawideband network and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; optical disc players and computer programs therefor; blank magnetic data carriers; pre-recorded magnetic data carriers and compact discs featuring computer software to enable audio and visual monitoring in the nature of a web-cam, and computer software for device location, for determining the position of vehicles and for tracking of vehicles or moveable equipment or apparatus; pre-recorded magnetic data carriers and compact discs featuring musical recordings, text, graphics, sound recordings, visual images, audio-visual recordings, electronic databases, multimedia information and materials all in the fields of entertainment, education, and information on news, sport, music, games, business, finance, lifestyle and weather; blank smart cards; encoded smart cards containing programming used to authenticate, access, enable, operate, enhance and activate wireless products and services, memory cards, memory sticks, IEEE 802;11 standard cards, PCMCIA (Personal Computer Memory Card International Association) cards, USB memory devices, namely, a device which provides capacity for storing data, and which is designed for use with the USB standard; laptop PC cards, encoded electronic chip cards containing programming used to authenticate, access, enable, operate, enhance and activate wireless products and services; data cards, namely, external mass storage devices; blank recording compact discs; electronic equipment making use of a short-range network protocol for connecting different types of electronic devices for recording, transmission, sending, receiving, reproducing, facilitating and enabling transmission of sound, images, data, textual material, voices, audio, video, audio-video and multi-media, namely, video recorders, DVD machines, tape recorders, stereos, MP3 players, personal stereos, calculators; teleprinters, telegram machines, telephones, mobile telephones, mobile electronic devices, namely, bar code readers, bar code scanners, bar code readers and scanners for stock-taking, stock control purposes, and for use in the reading of medical prescriptions; bar code readers and scanners with wireless data transfer capabilities; PDAs, pagers, computers, handheld computers, pocket PCs, tablet PCs, keyboards, joysticks, portable web consoles, portable electric distribution consoles, computer hardware used for generating a virtual keyboard, computer cameras, digital cameras, 35mm cameras, video cameras, cameras being mobile phone accessories, radios, AM/FM radios, computer terminals,

laptops, cell phones, WLAN (wireless LAN) phones; downloadable software, computer software and programs for use in accounting, downloading electronic publications from the Internet, searching data on the Internet, enabling connection to databases and the Internet, searching of data and databases, managing communications and data exchange between computers, facilitating interactive multimedia communications, creating, editing and delivering textual and graphic information via computer communication networks and wireless networks, transmitting and receiving electronic mail and facsimiles over the Internet, digital publishing, printing and imaging, word processing, electronic document storage, manipulation, transfer and retrieval, enterprise applications for transportation and asset tracking; downloadable software for use in the utilities industries, namely, remote meter reading software; downloadable software for inventory tracking and management, for the retail industry and point of sale and IEEE 802.11 standard based retail WLAN (wireless LAN), for the wholesale trade industry and for handheld scanners for inventory applications, for the financial, insurance and real estate industries, for sale teams, for remote sale force automation, for the healthcare industry and for wireless personal monitors linked to hospitals and for wireless personal monitors linked to emergency databases, for security and for wireless security systems for buildings, for professional business services, for durable manufacturing and production tracking systems; computer operating system programs; computer network operating system programs; downloadable data and computer software and programs for use in telecommunications, namely digital publishing, printing, imaging, and electronic document storage, manipulation, transfer, retrieval, processing, logging, storing, transmission, delivering, display, reception, input, output and printing of non-pictorial, textual and graphical data; software for production, fulfillment, distribution and publishing of multimedia content over fixed line and wireless networks; downloadable software, computer software, mobile telephones, mobile electronic devices and networking hardware for the facilitation of interactive multimedia communications, SMS (simple messaging service) and MMS (multimedia messaging service); downloadable programs and computer programs for managing communications and data exchange between handheld computers and desktop computers; computer printers; photocopiers; computer printing hardware, namely, image setters, proofers, platemakers and electronic screen displays; wireless telecommunications hardware and software, namely, wireless communication antennas, routers, switches, towers, handsets and wireless devices to enable or facilitate transmission of textual material, data, voice, audio, video, audio-video and multimedia services to wireless devices;

downloadable electronic publications in the nature of magazines, books, newspapers, brochures and leaflets supplied on-line from databases or from facilities provided on the Internet all in the field of entertainment, sport, lifestyle, music, games, news and weather; electronic and computer game software, computer games programs, computer game cartridges, electric distribution consoles for video game machines for use with televisions; parts and fittings for all the aforesaid goods

to (changes, except deletions, shown in **bold**):

Telematics apparatus and instruments, namely, web consoles, electric distribution consoles; wireless network enabled appliances, namely, TVs, DVD machines, radios, personal monitors, wireless video gateway systems, namely, apparatus and equipment combining hardware and software to enable decoding of binary information to transmit over a network standard for distant reception, apparatus and equipment for video calling, video messaging, streaming and browser download of data in the fields of sports and entertainment; television antennas; television sets; television set top boxes to facilitate communication between television sets and mobile telephones or mobile electronic devices; telecommunications equipment and telecommunications equipment making use of a short-range network protocol for connecting different types of electronic devices, namely, telephones, mobile telephones, mobile electronic devices, facsimile machines, mobile telephones and mobile electronic devices used to access enterprise applications, telegram machines and modems for accessing the Internet and databases on the Internet; electronic devices for receiving television, local, satellite, wireless, personal network, meshed network, IEEE 802.11 standard network, dedicated wireless data network for professional users, OFDM (orthogonal frequency division multiplexing), ultrawideband network and global communication network transmissions and transmitting them to a television or other display device and computer programs for use therewith; optical disc players and computer programs therefor; blank magnetic data carriers; pre-recorded magnetic data carriers and compact discs featuring computer software to enable audio and visual monitoring in the nature of a web-cam, and computer software for device location, for determining the position of vehicles and for tracking of vehicles or moveable equipment or apparatus; pre-recorded magnetic data carriers and compact discs featuring musical recordings, text, graphics, sound recordings, visual images, audio-visual recordings, electronic databases, multimedia information and materials all in the fields of entertainment, education, and information on news, sport, music, games, business, finance, lifestyle and weather;

blank smart cards; encoded smart cards containing programming used to authenticate, access, enable, operate, enhance and activate wireless products and services; memory cards, memory sticks, IEEE 802.11 standard cards, PCMCIA (Personal Computer Memory Card International Association) cards; USB memory devices, namely, a device which provides capacity for storing data, and which is designed for use with the USB standard; laptop PC cards, encoded electronic chip cards containing programming used to authenticate, access, enable, operate, enhance and activate wireless products and services; data cards, namely, external mass storage devices; blank recording compact discs; electronic equipment making use of a short-range network protocol for connecting different types of electronic devices for recording, transmission, sending, receiving, reproducing, facilitating and enabling transmission of sound, images, data, textual material, voices, audio, video, audio-video and multi-media, namely, video recorders, DVD machines, tape recorders, stereos, MP3 players, personal stereos, calculators, teleprinters, telegram machines, telephones, mobile telephones, mobile electronic devices, namely, bar code readers, bar code scanners, and bar code readers and scanners for stock-taking, stock control purposes, and for use in the reading of medical prescriptions; bar code readers and scanners with wireless data transfer capabilities; PDAs, pagers, computers, handheld computers, pocket PCs, tablet PCs, keyboards, joysticks, portable web consoles, portable electric distribution consoles, computer hardware used for generating a virtual keyboard, computer cameras, digital cameras, 35mm cameras, video cameras, cameras being mobile phone accessories, radios, AM/FM radios, computer terminals, laptops, cell phones, WLAN (wireless LAN) phones; downloadable software, namely computer software and programs for use in accounting, downloading electronic publications from the Internet, searching data on the Internet, searching of data and databases, managing communications and data exchange between computers, facilitating interactive multimedia communications, creating, editing and delivering textual and graphic information via computer communication networks and wireless networks, transmitting and receiving electronic mail and facsimiles over wireless or fixed wireless telecommunications networks alone or in combination with the Internet, digital publishing, printing and imaging, word processing, electronic document storage, manipulation, transfer and retrieval, and enterprise applications for transportation and asset tracking; downloadable software for use in the utilities industries, namely, remote meter reading software; downloadable software for inventory tracking and management, for the retail industry and point of sale and IEEE 802.11 standard based retail WLAN (wireless LAN), for the

wholesale trade industry and for handheld scanners for inventory applications, for the financial, insurance and real estate industries, for sale teams, for remote sale force automation, for the healthcare industry and for wireless personal monitors linked to hospitals and for wireless personal monitors linked to emergency databases, for security and for wireless security systems for buildings, for professional business services, for durable manufacturing and production tracking systems; computer operating system programs; computer network operating system programs; downloadable data and computer software and programs for use in wireless or fixed wireless telecommunications, namely digital publishing, printing, imaging, and electronic document storage, manipulation, transfer, retrieval, processing, logging, storing, transmission, delivering, reception, input, output and printing of non-pictorial, textual and graphical data; software for production, fulfillment, distribution and publishing of multimedia content over fixed line and wireless networks; downloadable software and computer software for mobile telephones, mobile electronic devices and networking hardware for the facilitation of interactive multimedia communications, SMS (simple messaging service) and MMS (multimedia messaging service) over wireless or fixed wireless telecommunications networks; downloadable programs and computer programs for managing communications and data exchange between handheld computers and desktop computers; computer printers; photocopiers; computer printing hardware, namely, image setters, proofers, platemakers and electronic screen displays; wireless telecommunications hardware and software, namely, wireless communication antennas, routers, switches, towers, handsets and wireless devices to enable or facilitate transmission of textual material, data, voice, audio, video, audio-video and multimedia services to wireless devices; downloadable electronic publications in the nature of magazines, books, newspapers, brochures and leaflets supplied on-line from databases or from facilities provided on the Internet all in the field of entertainment, sport, lifestyle, music, games, news and weather; electronic and computer game software, computer games programs, computer game cartridges; electric distribution consoles for video game machines for use with televisions; parts and fittings for all the aforesaid goods, all sold through wholesale or retail stores or Internet websites.

Inasmuch as the amendment is clearly limiting in nature as required by Trademark Rule 2.71(b), and because opposer

consents thereto, it is approved and entered. See Trademark Rule 2.133(a).

If this resolves the dispute herein, opposer is allowed until thirty days from the mailing date of this order to file a withdrawal of the opposition, failing which the opposition will go forward on the application as amended. See Trademark Rule 2.106(c).

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>