

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

DUNN

Mailed: April 30, 2013

Opposition No. 91204524

Appsense Limited plc

v.

Opnet Technologies, Inc.

Elizabeth A. Dunn, Attorney (571-272-4267):

On March 26, 2013, the parties filed applicant's proposed amendment to its application Serial No. 85404735, with opposer's consent, and opposer's withdrawal without prejudice of the opposition, contingent upon entry of the amendment.

By the proposed amendment applicant seeks to add the following statement to the application:

Applicant OPNET Technologies, Inc. agrees to always use OPNET, OPNET Technologies, Inc., or RIVERBED prominently and in close proximity to the APPSENSOR XPERT Mark whenever the APPSENSOR XPERT Mark is used or the APPSENSOR XPERT software service is described in commerce. To be clear, none of these terms will form part of the APPSENSOR XPERT trademark.

The amendment is denied. When the nature of the mark is not clear from the drawing, a miscellaneous statement relevant to the mark, such as a lining or stippling statement, translation, transliteration, or color claim, may be required by USPTO or offered by the applicant. See Trademark Rule 2.173(f); Trademark

Manual of Examining Procedure § 807.15 (8th ed., rev. 2012).

Thus, while the parties characterize the proposed amendment as a "miscellaneous statement", because the mark is perfectly clear and requires no explanatory statement, the proposed amendment is not a miscellaneous statement which can be added to the registration.¹

Proceedings are suspended for THIRTY DAYS to allow the parties to inform the Board how they wish to proceed, failing which the Board will resume proceedings.

¹ The parties' filing appears to be a consent agreement, executed by the parties, in which opposer agrees to withdraw the opposition in return for applicant's agreement to restrict how the mark will be used. While not an acceptable amendment to the application, the signed agreement will remain part of the Board's proceeding file.