

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

nmt

Mailed: June 5, 2015

Opposition No. 91220481

Pivotal Software, Inc.

v.

Cloudfounders NV

**M. Catherine Faint,
Interlocutory Attorney:**

On May 18, 2015, Applicant filed a renewed proposed amendment to its application Serial No. 79121528, with Opposer's consent, and Opposer's withdrawal of the opposition with prejudice, contingent upon entry of the amendment.

By the proposed amendment Applicant seeks to amend International Classes 9, 38 and 42 as follows:

International Class 9

from

"Computer hardware and computer peripheral devices; blank magnetic data media; blank sound recording discs; computer terminals; computer servers; computer hardware and software, namely, software for database management and software for database synchronization; data processing equipment; interfaces for computers; telecommunication equipment, namely, equipment for cloud computing, namely, servers, routers, networking switches, firewalls; blank data media; disk drives for computers; computer central processing units; integrated circuit chips; computer housings; housing, cabinets and racks specifically adapted for

computers; electric measuring devices not for medical purposes, namely, for assessing the condition of servers such as power consumption, fan speeds, water leakage, gas leakage, power supply, physical security; electric monitoring equipment, namely, software to monitor power consumption, state of servers, state of networking equipment, state of software processes running on those servers, physical environment, to provide remote access to equipment; detectors, namely, motion, smoke, power monitoring detectors, gas detectors for detecting the presence of gas, water detectors for measuring water levels, detectors for physical security, namely, personal security alarms; temperature indicators; heat regulating apparatus, namely, thermostats; hygrometer; air flow meters; computer power supply units and control units; inverters; computer cables and wiring"

to

"Computer hardware and computer peripheral devices; blank magnetic data media; blank sound recording discs; computer terminals; computer servers; computer hardware and software for data storage; data processing equipment; interfaces for computers; telecommunication equipment, namely, equipment for cloud computing, namely, servers, routers, networking switches, firewalls; blank data media; disk drives for computers; computer central processing units; integrated circuit chips; computer housings; housing, cabinets and racks specifically adapted for computers; electric measuring devices not for medical purposes, namely, for assessing the condition of servers such as power consumption, fan speeds, water leakage, gas leakage, power supply, physical security; electric monitoring equipment, namely, software to monitor power consumption, state of servers, state of networking equipment, physical environment, to provide remote access to equipment; detectors, namely, motion, smoke, power monitoring detectors, gas detectors for detecting the presence of gas, water detectors for measuring water levels, detectors for physical security, namely, personal security alarms; temperature indicators; heat regulating apparatus, namely, thermostats; hygrometer; air flow meters; computer power supply units and control units; inverters; computer cables and wiring."

International Class 38

from

"Telecommunication services, namely, electronic transmission of voice, audio, video, visual images and data via cloud computing, virtual

servers, physical servers and remote desktops; transmission of data and information over the Internet and over other telecommunication networks; rental of telecommunication equipment, namely, equipment for cloud computing, namely, networking equipment for providing remote Internet access; providing access to databases, including access to computer databases, to the Internet and to other telecommunication networks; rental of access time to databases"

to

"Telecommunication services, namely, electronic transmission of voice, audio, video, visual images and data via cloud computing, virtual servers, physical servers and remote desktops; transmission of data and information over the Internet and over other telecommunication networks; rental of telecommunication equipment, namely, equipment for cloud computing, namely, networking equipment for providing remote Internet access; providing access to the Internet and to other telecommunication networks."

The amendments to Classes 9 and 38 are clearly limiting in nature as required by Trademark Rule 2.71(a), and Opposer consents thereto, thus the amendments would be acceptable. The amendments are not entered at this time, however, to allow the parties a chance to respond to this order.

While an Applicant may amend to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. *See* Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

The proposed amendment to Class 42 is unacceptable in part inasmuch as it identifies services that are not within the scope of the present identification. Specifically, deletion of the wording, "that allows for the rapid development of highly interactive and customizable learning applications, computer services, namely, integration of private and public cloud computing environments" from the phrase, "Scientific and technological services, namely, research and design in the

field of integrated system architecture” in the proposed amendment broadens this portion of the recitation of services beyond the scope of the present recitation.¹

Therefore, the Board cannot accept the proposed wording in Class 42 and will not enter the amendment.

In view of these findings, the motion to amend is denied without prejudice. The present identification of goods/recitation of services, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of future amendment in Class 42. *See* Trademark Rule 2.71(a); TMEP §1402.07(d).

However, inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are suspended, and the parties are allowed until thirty days from the mailing date of this order to file a revised motion to amend, failing which the Board will resume proceedings and reset dates, and the opposition will go forward on the present application.

¹ The other proposed deletion from the Class 42 services would be acceptable.