

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

RK/lw

Mailed: April 13, 2017

Opposition No. 91223410

American Medical Association

v.

Jama Software, Inc.

Yong Oh (Richard) Kim, Interlocutory Attorney:

On March 6, 2017, Applicant filed a proposed amendment to its **Application Serial No. 86547463**, with Opposer's consent. By the proposed amendment, Applicant seeks to amend its application as follows:

- Amend the mark from JAMA in standard characters to JAMA SOFTWARE in standard characters;
- Amend the filing basis from Section 1(a) to Section 1(b);
- Enter a disclaimer of SOFTWARE.

Turning first to the amendment to add the term SOFTWARE to the mark JAMA, Trademark Rule 2.72 provides that a mark may not be amended if the proposed amendment materially alters the mark. The Federal Circuit described the test for determining whether an amendment is a material alteration as follows:

“The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as

to require republication, it would be tantamount to a new mark appropriate for a new application.”

In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). Furthermore, where the proposed amendment seeks to add to the original mark and the additional element would require a further search by the Examining Attorney, such a factor supports a finding that the amendment constitutes a material alteration. See *In re Pierce Foods Corp.*, 230 USPQ 307, 308-09 and n.2 (TTAB 1986) (a material alteration “more frequently arises when matter is added to the mark than when matter is deleted from the mark.”).

Here, Applicant seeks to add SOFTWARE to the mark JAMA and asserts that since “the mark is used with software services, the addition of SOFTWARE will not materially alter the overall commercial impression of the mark.” *Motion to Amend*, 20 TTABVUE 4. The contention is not well-taken. Notwithstanding that Applicant’s services relate to software,¹ the addition of the term SOFTWARE is not so

¹ The services are identified as “software as a service (SAAS) services featuring software for product development; software as a service (SAAS) services featuring software for facilitation of product requirements and test management, goal setting, alignment, and execution, task and project tracking, product development workflow and best practices, contextual prioritization, resource management, document management, for transmission and receipt of data, images, and messages used in sharing information, collaboration and interactive discussions, including sharing information, collaboration and interactive discussions for social networking purposes, for sending and receiving electronic messages, and uploading and transferring files, all for collaboration and interaction between project managers, team members and stakeholders; online non-downloadable cloud-based software and applications for facilitation of product development; computer software deployment for others; consulting in the field of computer software deployment for others; all of the foregoing in the field of SAAS services for software to monitor product development by tracking and managing product requirements, and not for computer operating system application platforms or operating systems” in International Class 42.

insignificant such that JAMA and JAMA SOFTWARE can be said to convey the same commercial impression. Indeed, despite the descriptive nature of the term SOFTWARE, the resultant mark would require a new search for possible references. The amendment to add SOFTWARE is therefore **DENIED** thereby rendering the proposed disclaimer **MOOT**.

As for the amendment to the filing basis, such an amendment requires Applicant to confirm that it has a continuing valid basis by submitting a verified statement that Applicant has a bona fide intention to use the mark in commerce on or in connection with the subject services, and that Applicant had a bona fide intention to use the mark in commerce on or in connection with the services as of the application filing date. *See* 15 U.S.C. § 1051(b) and Trademark Rule 2.34(a)(2). Inasmuch as the amendment to the application basis does not include the required verified statement, the proposed amendment to the basis is hereby **DENIED**.

Dates are **RESET** as follows:

Expert Disclosures Due	4/28/2017
Discovery Closes	5/28/2017
Plaintiff's Pretrial Disclosures Due	7/12/2017
Plaintiff's 30-day Trial Period Ends	8/26/2017
Defendant's Pretrial Disclosures Due	9/10/2017
Defendant's 30-day Trial Period Ends	10/25/2017
Plaintiff's Rebuttal Disclosures Due	11/9/2017
Plaintiff's 15-day Rebuttal Period Ends	12/9/2017

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **THIRTY DAYS** after completion of taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

* * *

NOTICE: CHANGES TO THE TRADEMARK TRIAL AND APPEAL BOARD (“BOARD”) RULES OF PRACTICE (EFFECTIVE JANUARY 14, 2017).

The USPTO published a Notice of Final Rulemaking in the Federal Register on October 7, 2016, at 81 Fed. Reg. 69950. It sets forth **several** amendments to the rules that govern *inter partes* (oppositions, cancellations, concurrent use) and *ex parte* appeal proceedings. A correction to the final rule was published on December 12, 2016, at 81 Fed. Reg. 89382.

For complete information, the parties are referred to:

- The Board’s home page on the uspto.gov website:
<http://www.uspto.gov/trademarks-application-process/trademark-trial-and-appeal-board-ttab>
- The final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2069950.pdf>
- The correction to the final rule:
<http://www.uspto.gov/sites/default/files/documents/81%20FR%2089382.pdf>
- A chart summarizing the affected rules and changes:
<http://www.uspto.gov/sites/default/files/documents/Chart%20Summarizing%20Rule%20Changes%2012-9-16.pdf>

For **all** proceedings, including those **already in progress on January 14, 2017**, some of the changes are:

- All pleadings and submissions must be filed through ESTTA. Trademark Rules 2.101, 2.102, 2.106, 2.111, 2.114, 2.121, 2.123, 2.126, 2.190 and 2.191.
- Service of all papers must be made by email, unless otherwise stipulated. Trademark Rule 2.119.
- Response periods are no longer extended by five days for service by first-class mail, Priority Mail Express®, or overnight courier. Trademark Rule 2.119.
- Deadlines for submissions to the Board that are initiated by a date of service are 20 days. Trademark Rule 2.119. Responses to motions for summary judgment remain 30 days. Similarly, deadlines for responses to discovery requests remain 30 days.

- All discovery requests must be served early enough to allow for responses prior to the close of discovery. Trademark Rule 2.120. Duty to supplement discovery responses will continue after the close of discovery.
- Motions to compel initial disclosures must be filed within 30 days after the deadline for serving initial disclosures. Trademark Rule 2.120.
- Motions to compel discovery, motions to test the sufficiency of responses or objections, and motions for summary judgment must be filed prior to the first pretrial disclosure deadline. Trademark Rules 2.120 and 2.127.
- Requests for production and requests for admission, as well as interrogatories, are each limited to 75. Trademark Rule 2.120.
- Testimony may be submitted in the form of an affidavit or declaration. Trademark Rules 2.121, 2.123 and 2.125.
- New requirements for the submission of trial evidence and deposition transcripts. Trademark Rules 2.122, 2.123, and 2.125.
- For proceedings **filed on or after January 14, 2017**, in addition to the changes set forth above, the Board's notice of institution constitutes service of complaints. Trademark Rules 2.105(a) and 2.113(a).

This is only a summary of the significant content of the Final Rule. All parties involved in or contemplating filing a Board proceeding, regardless of the date of commencement of the proceeding, should read the entire Final Rule.