



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

BLUE COAT SYSTEMS, INC.,

Opposer

v.

INTERSTATE CORRPACK, LLC,

Applicant

Opposition No. 91228339
App. Serial Number 86/754,569

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

**INTERSTATE CORRPACK, LLC. MOTION UNDER 37 CFR 2.133 TO
AMEND THE PENDING APPLICATION IN OPPOSITION OR IN THE
ALTERNATIVE TO REMAND THE APPLICATION TO THE
EXAMINING ATTORNEY FOR AMENDMENT**

Applicant, Interstate Corrpac LLC (hereinafter referred to as “Applicant”) moves that the Board in the above identified opposition proceedings, amend the identification of goods in the 86754569 trademark application filed September 11, 2015.

FACTUAL BACKGROUND

The present opposition is currently in discovery, and settlement negotiations between the parties in this opposition are ongoing. As a result of these discussions



Opposer has noted its concern with the present identification of goods as set forth in the 86754569 trademark application and has consented to the purposed amendment of the identification of goods in the 86754569 application. The present 86754569 trademark application for the mark BLUECOAT is not the subject of other inter partes proceedings.

ARGUMENT

The present identification of goods for Applicant's '569 trademark application is: –RECYCLABLE AND REPULPABLE MOISTURE RESISTANT PAPER LINER BOARD, CORRUGATED BOARD AND BOXES FOR INDUSTRIAL AND COMMERCIAL USE–.

The proposed amendment requested by Applicant and consented to by Opposer is: –RECYCLABLE AND REPULPABLE MOISTURE RESISTANT PAPER LINER BOARD, CORRUGATED BOARD AND BOXES FOR INDUSTRIAL AND COMMERCIAL USE, **EXCLUDING BOXES FOR COMPUTER HARDWARE EQUIPMENT**–.

No portions of the original identification of goods have been struck out as there are no changes to the original language and the additional limiting language has been underlined and set forth in bold type so that the Board can clearly see the proposed amendment requested by Applicant. It is hoped that this submission will

assist the Board personnel in entry of the amendment should the motion be granted. The use of EXCLUDING language to narrow the identification of goods is an accepted practice in the Trademark Office.

There are three trademark and service mark registrations for BLUE COAT listed in Opposer's Notice of Opposition. These three registrations and their identification of goods and services are merely set forth in this motion for the Board's convenience to review, if it so desires. The marks are: (1) U.S. Trademark Registration Number 2,887,537 registered on September 21, 2004 for "computer hardware, computer peripherals and computer software (009) for computer, network and internet security applications, content screening and filtering, virus protection, access control, authorization management, web usage monitoring and network bandwidth protection" in International Class 009; (2) U.S. Service Mark Registration Number 3,953,936 registered on May 3, 2011 for "educational services (041), namely, arranging and providing online workshops and training courses, lectures and seminars in the field of computers, technology, software and computer networks and distribution of course materials in connection therewith; online educational publications, namely, user manuals in the fields of computers, technology, software and computer networks; technical support services (042), namely, online telephone, email and in person troubleshooting for problems with computers, computer software and hardware and computer networks; maintenance,

installation and updating of computer software for others; consulting services for others in the field of computer network design, connectivity, management and security; providing an online computer database in the field of computer software installation and maintenance; providing an online computer database in the fields of computer software and hardware design” in International Classes 041 and 042; and (3) U.S. Trademark Registration Number 4,599,832 registered on September 9, 2014 for “computer hardware; computer software (009) for computer, network, and internet security applications, content screening and filtering, virus protection, computer and network access control and authorization management, web usage monitoring, and network bandwidth optimization and protection; Business consulting services (035) in the field of computer, network and internet security, virus protection, network bandwidth optimization and protection; educational services (041), namely, conducting arranging and providing online workshops, and training courses, lectures, workshops and seminars in the field of computers, technology, software, networks, security and bandwidth optimization and distribution of educational materials in connection therewith; On-line journals, namely, blogs featuring articles and commentary on computer, network and internet security, and bandwidth optimization; computer software installation and maintenance; Consulting services (042) in the fields of selection, implementation and use of computer hardware and software systems for others; Technical support

services, namely, troubleshooting in the nature of diagnosing computer hardware and software problems; Technical support, namely, monitoring technological functions of computer network systems” in International Class Numbers 009, 035, 041 and 042.

When the present proposed amendment of identification of goods has been consented to by the other party (Opposer), and the proposed amendment does not materially alter the mark, and the proposed amendment is in accordance with the applicable rules and statutory provisions, the request will ordinarily be approved by the Board. *Giant Food Inc. V. Standard Terry Mills, Inc.*, 231 USPQ 626, 631 (TTAB 1986). (TTABMP 514.01; 514.02). The purposed amendment to the identification of goods of the application does not materially alter the character of the subject mark and does not broaden or expand the identification or scope of the goods. The Board, in its discretion, may grant a motion to amend an application which is the subject of an inter partes proceeding, even if the other party does not consent thereto. In the event that the Board should decide to remand the decision for amendment or request additional input from the original Examining Trademark Attorney, an amendment has been attached to this Motion for such submission.

CONCLUSION

It is respectfully submitted that this Board should find that the noted proposed amendment to the application should be entered and add the language

EXCLUDING BOXES FOR COMPUTER HARDWARE EQUIPMENT to the identification of goods .

WHEREFORE, Applicant prays that the Trademark Trial and Appeal Board grant Applicant's Motion Under 37 CFR 2.133 to Amend the Pending Application in Opposition changing the identification of goods by adding the EXCLUDING language or in the Alternative to Remand the Application to the Examining Attorney for Amendment and the proposed amendment entered.

Respectfully submitted,

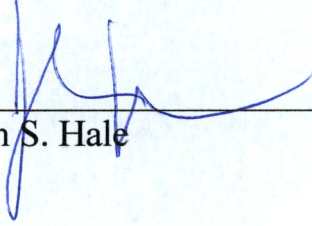


John S. Hale
GIPPLE & HALE
6718 Whittier Avenue, Suite 200
McLean, Virginia 22101
703-448-1770 x301
gipple.hale@verizon.net
Counsel for Applicant

CERTIFICATE OF MAILING

I hereby certify that a true copy of the foregoing was deposited with the United States Postal Service, first class, postage prepaid, this 14th day of October, 2016 in an envelope addressed to:

Rochelle D. Alpert, Esq.
MORGAN, LEWIS & BOCKIUS, LLP
One Market
Spear Street Tower
San Francisco, California 94105-1596



John S. Hale

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Trademark Application of	:	
	:	
INTERSTATE CORRPACK LLC	:	
	:	Examining Attorney B.BROWN
Serial Number: 86/754569	:	
	:	Law Office 116
Filed: September 11, 2015	:	
	:	
For: BLUECOAT	:	

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

Sir:

AMENDMENT

Please amend the Identification of Goods in the present application as allowed and published from its present form namely: --RECYCLABLE AND REPULPABLE MOISTURE RESISTANT PAPER LINER BOARD, CORRUGATED BOARD AND BOXES FOR INDUSTRIAL AND COMMERCIAL USE—to read as follows: --RECYCLABLE AND REPULPABLE MOISTURE RESISTANT PAPER LINER BOARD, CORRUGATED BOARD AND BOXES FOR INDUSTRIAL AND COMMERCIAL USE EXCLUDING BOXES FOR COMPUTER HARDWARE EQUIPMENT--

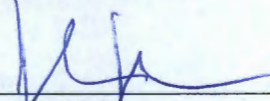
REMARKS

The present application is currently the subject of an Opposition Proceeding before the Trademark Trial and Appeal Board. The parties are currently in settlement discussions. The Opposer has indicated that it has no objection to the purposed amended identification of goods adding the EXCLUDING language as underlined above. Applicant has filed this Amendment together with a Motion to Amend to the Trademark Trial and Appeal Board.

This amendment is narrower in scope than the present identification of goods in that it specifically excludes certain goods originally covered by the prior identification of goods and does not widen nor present any new goods into the present identification of goods. It is respectfully requested that the application be favorably reconsidered, amended and allowed without the need for publication.

Respectfully submitted,

GIPPLE & HALE



John S. Hale

Registration No. 25,209

(703) 448-1770
6718 Whittier Avenue, Suite 200
McLean, Virginia 22101
Attorney Ref.: TMB-7865