

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
General Email: TTABInfo@uspto.gov

JMW/wbc

February 15, 2019

Opposition No. 91240071

American Airlines, Inc.

v.

Continental Exchange Solutions, Inc.

Wendy Boldt Cohen, Interlocutory Attorney:

On August 20, 2018, Applicant filed a proposed amendment to its application Serial No. 87388249, with Opposer's consent.¹

By the proposed amendment, Applicant seeks to amend the identification of goods in International Classes 9 and 35 as follows:²

International Class 9

Magnetically encoded cards used for electronic funds transfer services, electronic payments, electronic processing and transmission of bill payment data, money order services, check cashing services, pay day loan services, direct deposit of funds into customers' bank accounts, prepaid debit cards, domestic and international transmission of money, telephone card services and travelers' cheques, namely, loyalty rewards cards used to administer a customer loyalty program which provides incentives in the form of free or discounted fees on financial transactions, cash back and point redemption for goods and speeds up the order process on

¹ Opposer's Notice of Appearance and corrected Notice of Appearance, both filed September 25, 2018, are noted and entered. Opposer's motion to suspend for settlement filed November 12, 2018 is noted. In view of the Board's order herein, the motion to suspend is moot.

² Stricken language indicates the proposed deletion and underlined language indicates the proposed amendment to the application. The identification of goods in International Class 36, also involved in this proceeding remains unchanged.

financial transactions; ~~loyalty cards, namely, magnetically encoded loyalty cards~~

The amendment is limiting in nature, as required by Trademark Rule 2.71(a). Because Opposer consents thereto, the amendment is approved and entered. *See* Trademark Rule 2.133(a).

International Class 35

“Administration of a ~~customer loyalty~~ program which provides free or discounted financial transactions, cash back, and point redemption for goods.”

A proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must also comply with all other applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP §§ 514.01 and 605.03(b). In particular, 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 International Class 35 is unacceptable in part inasmuch as it identifies goods that are not within the scope of the present identification. Specifically, the deletion of the wording “customer loyalty” in the proposed amendment is beyond the scope of the present identification because it broadens the services.

Therefore, the Board cannot accept the proposed amendment to International Class 35 and will not enter the amendment.

In view of these findings, the motion to amend International Class 35 is denied without prejudice. The present identification of goods, that is, the identification prior

to the filing of the motion to amend, remains operative for purposes of future amendment. *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 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.

Proceedings are otherwise suspended.