UNITED STATES PATENT AND TRADEMARK OFFICE
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Hayes/LTS

April 13, 2020

Opposition No. 91240892

Fidelity National Information Services, Inc.

v.

Locus, LP

Lawrence T. Stanley, Interlocutory Attorney:

On March 26, 2020, Opposer filed Applicant's proposed amendments to its application Serial No. 86778181, and withdrawal of the opposition without prejudice, contingent upon entry of the proposed amendments. The written consent of both parties is noted.

By the proposed amendments Applicant seeks to delete International Classes 36 and 41 in their entireties, and amend the identification of goods and services in International Classes 9, 16, 35 and 42, as follows (deletions in strikethrough; additions in bold):

Class 9

From: Computer software ~~for accessing, analyzing, classifying, comparing, managing, manipulating, organizing, researching, and studying economic data, biological data, and logical data models; computer software for interactive mapping and economic and biological data profiling~~

To: Computer **database** software **using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system**

Class 16

From: ~~Printed matter, namely, books, white papers, reports, and pamphlets of economic data, biological data, and logical data models;~~ printed indices of economic and biological data~~; printed instructional and teaching material in the fields of economics, biology, and logical data models~~

To: Printed indices of economic and biological data

Class 35

From: ~~Data processing services;~~ providing an on-line searchable computer database ~~featuring data in the field of economics; providing an on-line searchable computer database based on logical data models in the field of economics; office functions; market analysis services, namely, insurance market analysis and real estate market analysis; industrial analysis and research services in the field of economic data~~

To: Providing an on-line searchable computer database **using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system**

Class 42:

From: Technological services, namely, software-as-a-service (SaaS) services featuring software ~~for accessing, analyzing, classifying, comparing, managing, manipulating, organizing, researching, and studying economic data, biological data, and logical data models; technological services, namely, software-as-a-service (SaaS) services featuring software for use in interactive mapping of economic data and biological data using logical data models; technological services, namely, platform as a service (PAAS) featuring computer software platforms for accessing, analyzing, classifying, comparing, managing, manipulating, organizing, researching, modeling, and studying economic data and biological data; industrial analysis and research services in the field of biological data;~~ providing an on-line searchable computer database

~~featuring data in the field of biology; providing an on-line searchable computer database based on logical data models in the field of biology~~

To: Technological services, namely, software-as-a-service (SaaS) services featuring **database** software **using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system**; providing an on-line searchable computer database **using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system**

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) (2019). 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 (Oct. 2018).

The deletion of Classes 36 and 41, proposed amendments in Classes 9 and 16, and the first proposed amendment in Class 42[1] are limiting in nature and thus acceptable. However, the amendment in Class 35 and second proposed amendment in Class 42 related to "providing an on-line searchable computer database" are unacceptable

[1] The first proposed amendment in Class 42 reads (new information in bold) "Technological services, namely, software-as-a-service (SaaS) services featuring **database** software **using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system**."

inasmuch as they render the identifications indefinite and identify services that are not within the scope of the present identifications, as set forth below.

In Class 35, the original identification is limited to on-line searchable computer databases "featuring data in the field of economies" and "based on logical data models in the field of economies". On-line searchable databases are classified by subject matter. *See* TMEP § 1402.11(a)(ix). The amended identification "[p]roviding an on-line searchable computer database using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system," does not specify the subject matter of the database, but rather, specifies the manner in which it functions. In view thereof, as worded, the amended identification is indefinite and beyond the scope of the original identification because it is not clear that the database is limited to the field of economies.

In Class 42, the original identification is limited to on-line searchable computer databases "featuring data in the field of biology" and "based on logical data models in the field of biology". The amended entry "providing an on-line searchable computer database using logical data models and unique functional identifiers represented in a functional coordinate system, wherein the identifiers tag defined economic activities with markers identifying roles in an economic system related to input and output processes in the economic system" is identical to the entry in Class 35 and also indefinite because it specifies the functionality rather than the subject matter of the

database, and beyond the scope of the original identification because it is not limited to the field of biology.

Therefore, the Board cannot accept the proposed amendments and will not enter the amendments.

In view of these findings, the motion to amend is **denied without prejudice**. The present identification of goods and services, 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.

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