

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

GMM/tdc

January 30, 2019

Opposition No. 91244607

A.V.M. Software, Inc.

v.

Peatalk Corporation

By the Trademark Trial and Appeal Board:

On December 11, 2018, Applicant filed a proposed amendment to its involved application Serial No. 87766020, with Opposer's written consent.

By the proposed amendment, Applicant seeks to delete the services in International Class 38 in their entirety and amend the identification of services in International Classes 9 and 42 as follows:

- International Class 9

From:

Equipment for receiving, processing, and transmitting voice, video, data and information ~~via telecommunications and wireless signals, satellite and computers~~, namely, wireless digital media receivers, receiver integrated circuit modules, FM modulators, wireless transmitters, multiplexers, audio and video decoders, data processors, integrated circuits, set-top boxes primarily comprised of a receiver and circuitry, ~~computer operating hardware and software for use in the aforementioned goods~~, satellite dishes, satellite earth stations, and very small aperture

terminals (VSAT); ~~Computer software for administration of computer networks;~~ Network routers; Wireless routers

To:

Equipment for receiving, processing, and transmitting voice, video, data and information, namely, wireless digital media receivers, receiver integrated circuit modules, FM modulators, wireless transmitters, multiplexers, audio and video decoders, data processors, integrated circuits, set-top boxes primarily comprised of a receiver and circuitry, satellite dishes, satellite earth stations, and very small aperture terminals (VSAT); Network routers; Wireless routers

- International Class 42

From:

Computer software consultation, and integration of computer systems and networks; design of fixed and mobile satellite, ~~wireless and computer communication networks for others;~~ consulting services in connection with designing fixed and mobile satellite, ~~wireless and computer communication networks for others;~~ and testing, analysis, and evaluation of the goods and services of others to determine conformity with certification standards; ~~providing non-downloadable virtual network telecommunications software for application sharing, presentation broadcasts, web page sharing, polling and instant messaging; and providing web-based non-downloadable software which transparently converts audio and video material from one user application to another~~

To:

Computer software consultation, and integration of computer systems and networks; design of fixed and mobile satellite, consulting services in connection with designing fixed and mobile satellite, testing, analysis, and evaluation of the goods and services of others to determine conformity with certification standards

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by Trademark Rule 2.135. *See* TBMP § 605.03(b). In view thereof, Application Serial No. 87766020 stands **abandoned** as to the opposed services in International Class 38.

Regarding the amendment of the identification of goods in International Class 9, the amendment is limiting in nature as required by Trademark Rule 2.71(a), and Opposer consents to entry of the amendment. Accordingly, the amendment is **approved** and **entered** as to Class 9. *See* Trademark Rule 2.133(a).

However, the proposed amendment of the identification of services in International Class 42 is **not approved** the reasons stated below.

The deletion of the wording “providing non-downloadable virtual network telecommunications software for application sharing, presentation broadcasts, web page sharing, polling and instant messaging; and providing web-based non-downloadable software which transparently converts audio and video material from one user application to another” at the end of the identification is limiting, and therefore acceptable.

However, the following proposed amendments in Class 42 are not acceptable because they would impermissibly broaden the scope of the services.

from “design of fixed and mobile satellite, wireless and computer communication networks for others” **to** “design of fixed and mobile satellite”; and

from “consulting services in connection with designing fixed and mobile satellite, wireless and computer communication networks for others” **to** “consulting services in connection with designing fixed and mobile satellite”

An application may be amended to clarify or limit identification of services, but not to broaden the identification. Trademark Rule 2.71(a). In each of the above instances, in the current identification (i.e., the pre-amendment identification), the wording “fixed and mobile satellite” modifies “communications networks for others.” That is, the application identifies “design of fixed and mobile satellite communication ... networks for others” and “design of ... wireless and computer communication networks for others”; and similarly identifies “consulting services in connection with designing fixed and mobile satellite ... communication networks for others” and “consulting services in connection with designing ... wireless and computer communication networks for others.” Deletion of the wording “communication networks for others,” as part of the broader deletion of “wireless and computer communication networks for others,” would result in the services being identified as design and consulting relating to satellites (both fixed and mobile), as opposed to design and consulting relating to satellite communication networks. Design and design consultation services relating to fixed and mobile satellites is beyond the scope of the current identification of services.

Accordingly, the proposed motion to amend is **denied without prejudice** as to Class 42.

Because the record indicates that the parties are negotiating for settlement, proceedings are **suspended for thirty days** from the mailing date of this order to allow Applicant to file a new motion to amend the identification of services in Class 42 that complies with all applicable authorities. The current (i.e., pre-amendment) identification of services in Class 42 will control when determining whether a future

amendment of the Class 42 services is acceptable. Any future amendment should continue to reflect Opposer's consent thereto.¹

If no new motion is filed during the suspension period, the Board will resume proceedings and reset Applicant's time to file an answer, and the case will move forward with respect to the application as partially amended herein.²

¹ If any future amendment of the subject Class 42 services would resolve the dispute between the parties, then with the amendment Opposer may concurrently file a withdrawal of the opposition, contingent upon the Board's acceptance and entry of the amendment. Such a contingent withdrawal could be filed separately, or as part of the amendment.

² The Board notes the appearance of Lisa Hemphill of the law firm of Foley & Lardner LLP, as counsel for Applicant.