

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WF/VV

August 31, 2020

Opposition No. 91256372

The Chamberlain Group, Inc.

v.

Spigen Korea Co., Ltd.

Winston Folmar, Interlocutory Attorney:

I. MOTION TO AMEND APPLICATION

On July 9, 2020, Applicant filed a proposed amendment to its involved application Serial No. 88625635, with Opposer's consent. 4 TTABVUE.

By the proposed amendment, Applicant seeks to amend the identification of goods in International Class 9 of the subject application by adding a limitation clause as follows (addition in **bold**):

Batteries; Battery boxes; Battery cases; Battery chargers for use with telephones; Battery packs; Carrying cases, holders, protective cases and stands featuring power supply connectors, adaptors, speakers and battery charging devices, specially adapted for use with handheld digital electronic devices, namely, cell phones, MP3 players, personal digital assistants, smartphone, tablet PC, smartwatch; Charging appliances for rechargeable equipment; Dry cells and batteries; Electric plugs; Electric storage batteries; Electrical cells and batteries; electrical power supplies; Electrical sockets; Electrical storage batteries; housings for rechargeable electric batteries; Lithium ion batteries; Mobile phone cases featuring rechargeable batteries;

Nickel-cadmium storage batteries; Power charging stations, namely, chargers for cell phone batteries; Power strips; Power switches; Protective cases for rechargeable electric batteries; Rechargeable batteries; Renewable battery system to provide backup power; Solar batteries; Solar panels for the production of electricity; USB hubs; **all of the aforesaid goods and services excluding remote control systems to control doors, door locks, gates, cameras, and lights and lighting systems from vehicles.**

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* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 514.01 (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); Trademark Manual of Examining Procedure (“TMEP”) §§1402.06 *et seq.*, 1402.07 (Oct. 2018). Moreover, an applicant may not add exclusionary language that falls outside the scope of the terms identified or that is otherwise qualitatively different from the goods and services as identified. TMEP § 1402.06(a).

The proposed amendment, as written, is not acceptable inasmuch as it is unclear and excludes goods that are not within the scope of the current identification. In other words, the amended identification is not logically within the scope of the current goods description. Therefore, the Board cannot accept the proposed word in the motion to amend and will not enter the amendment.

In view of these findings, the motion to amend 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(s). *See* Trademark Rule 2.71(a); TMEP §1402.07(d).

Turning to Opposer's withdrawal of the opposition and despite not mentioning that the withdrawal of the opposition was contingent upon acceptance of the motion, the motion states that it was pursuant to a settlement agreement. 5 TTABVUE 2. to amend, amend the application states that the amendment was pursuant to a settlement agreement. 6 TTABVUE 2. Accordingly, withdrawal of the opposition is **deferred**, proceedings are **suspended**, and the parties are allowed until **THIRTY DAYS from the date of this order** to file a revised motion to amend the application, which includes the withdrawal of the notice of opposition contingent upon entry of the motion to amend, failing which the Board will dismiss the opposition without prejudice in accordance with Opposer's August 3, 2020 filing.

II. **BAR MEMBERSHIP INFORMATION**

The record shows that Applicant and Opposer are represented by an attorney. Effective August 3, 2019, the USPTO amended its rules to require all practitioners qualified under § 11.14(a) to be an active member in good standing and to provide the name of a state in which she or he is an active member in good standing; the date of admission to the bar of the named state; and the bar license number, if one is issued by the named state. 37 C.F.R. § 2.17(b)(3).

Accordingly, both Applicant's and Opposer's counsel are allowed **thirty days from the mailing date of this order** to provide the information above using the

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Change of Address form in ESTTA. The bar information entered on the ESTTA Change of Address form will be masked from TTABVUE.

If either or both counsels fail to comply with this order, the Board may issue an order to show cause in order for one or both counsel to verify her or his bar membership to continue her/his appearance before the Board.

Proceedings are otherwise **suspended**.
