

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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August 24, 2021

Opposition No. 91264247

*Spark Therapeutics, Inc.*

*v.*

*Memorial Health Services*

**Winston Folmar, Interlocutory Attorney:**

**STIPULATED EXTENSION OF TIME TO RESPOND TO MOTION**

On June 28, 2021, the Board granted a prior stipulated motion to extend Opposer's time to respond to Applicant's pending motion for relief from entry of default judgment, filed November 6, 2020. 20 TTABVUE. The granted motion extended the deadline for Opposer to respond until July 25, 2021. *Id.*

On July 26, 2021, Opposer filed another stipulated motion for a subsequent 30-day extension of Opposer's time to respond.<sup>1</sup> 21 TTABVUE. Accordingly, the request to extend is hereby **granted**.

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<sup>1</sup> Although the motion was filed after the July 25, 2021 deadline, the time to respond may be extended upon stipulation by the parties. See Trademark Rule 2.120(a)(3), 37 C.F.R. § 2.120(a)(3).

**MOTION TO AMEND INVOLVED APPLICATION**

On August 23, 2021, Applicant filed a proposed amendment to the recitation of services for Applicant’s involved application Serial No. 88644801, with Opposer’s consent.<sup>2</sup> 22 TTABVUE.

By the proposed amendment, Applicant seeks to amend the recitation of services as follows (additions displayed in **bold** and deletions in ~~strikethrough~~):

From: ~~Healthcare; Providing healthcare information; Providing personalized healthcare and medical information in the nature of employer based healthcare programs;~~ Providing personalized

To: Providing personalized **member, insurance, and** employer based healthcare programs, **wherein members, insureds, and employees are matched with a nurse care coordinator to discuss healthcare needs.**

A proposed amendment to any application or registration which is the subject of an inter partes proceeding must comply with all applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (“TBMP”) §§ 514.01 and 605.03(b) (June 2021). 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 and 1402.07 (July 2021).

The amendment from “providing personalized healthcare and medical information in the nature of employer based healthcare programs” to “providing member,

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<sup>2</sup> The Board notes Applicant’s request to suspend the proceedings while the present motion is pending. However, because the present order decides Applicant’s motion to amend, the request for suspension is considered moot and will be given no consideration.

insurance, and employer based healthcare programs,” despite the inclusion of the remaining wording that clarifies the “member, insurance and employer based healthcare programs,” is interpreted as broadening the scope of the services and is not permitted. Moreover, the inclusion of “member [and] insurance” broadens the possible scope of services to include several more services outside the current International Class 44 services. Accordingly, the motion to amend is denied without prejudice.

The present recitation of services, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of any future amendment.<sup>3</sup> *See* Trademark Rule 2.71(a); TMEP § 1402.07(d).

Because the filing of the proposed amendment indicates that the parties are making efforts to settle this matter, proceedings remain **suspended**, and the parties are allowed until **TWENTY DAYS from the date of this order** to either file a revised motion to amend Applicant’s application<sup>4</sup> or Opposer’s response to Applicant’s pending motion to set aside default judgment, failing which the Board will resume proceedings by deciding Applicant’s motion and reset dates as appropriate.

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<sup>3</sup> In the event that the parties submit further amendments, the proposal should highlight the additions and/or deletions from the current description of record.

<sup>4</sup> In the event that Applicant’s revised motion to amend will resolve the dispute, the parties are reminded that the best practice is to include Opposer’s withdrawal of the notice of opposition contingent upon entry of the amendment to the involved application. *See* TBMP § 605.03(b).