

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

September 28, 2021

Opposition No. 91264247

Spark Therapeutics, Inc.

v.

Memorial Health Services

Winston Folmar, Interlocutory Attorney:

On September 13, 2021, Applicant filed an amended stipulated motion to amend its involved application Serial No. 88644801. 24 TTABVUE.

By the proposed amendment, Applicant seeks to amend the recitation of services as follows: (additions are 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 healthcare programs;

TO: Providing personalized healthcare programs **wherein patients 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 “employer based healthcare programs” to “healthcare programs,” despite the inclusion of the remaining wording that clarifies, namely, “wherein patients are matched with a nurse care coordinator to discuss healthcare needs,” is interpreted as broadening the scope of the services and is not permitted. 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.¹ *See* Trademark Rule 2.71(a); TMEP § 1402.07(d).

Because the filing of the second proposed amendment indicates that the parties are making efforts to settle this matter, proceedings remain **suspended**, and the parties are allowed until **SIXTY DAYS from the date of this order** to either file a revised motion to amend Applicant’s application² 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.

¹ In the event that the parties submit further amendments, the proposal should highlight the additions and/or deletions from the current description of record.

² Applicant has indicated that it has not yet gained consent for an amendment to the recitation of services from Fitness Integration LLC, a third party opposer in a separate proceeding, namely, Opposition No. 91264255. Accordingly, in order for any amendment to be approved, the record must demonstrate that the opposer in each proceeding against Application Serial No. 88644801 has provided the required consent to the recitation.