

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EY/WDJ/GCP

February 27, 2023

Opposition No. 91266044

Joma Sport, S.A.

v.

Maxbike, Inc.

By the Trademark Trial and Appeal Board:

On February 23, 2023, Applicant filed a proposed amendment to its application Serial No. 88842657, with Opposer's written consent, and Opposer's withdrawal of the opposition, with Applicant's written consent, contingent upon entry of the amendment.¹

By the proposed amendment, Applicant seeks to amend the recitation of services in International Class 35² as follows (proposed deletions are shown in strikethrough):

From: Wholesale and retail store services featuring ~~Bicycle frames, Bicycle frames and bicycle handlebar grips, Bicycle parts, namely, tubes and connectors for bicycle frames, Bicycles, Electric bicycles, Electric vehicles, namely, self-propelled electric vehicle, Frames for bicycles, Mobility scooters, Mopeds, Push scooters, Sleighs for transport purposes, Snowmobiles, Two wheeled trolleys, Folding bicycles, Folding electric bicycles, Motorized bicycles, Motorized mobility scooters, Motorized personal mobility scooters, Mountain bicycles, Self-propelled electric vehicle, Touring bicycles; On line wholesale and retail store services featuring Bicycle frames, Bicycle frames and bicycle handlebar~~

¹ Applicant's change of correspondence address filed on December 5, 2022 is noted.

² The goods in opposed International Class 9 are not affected by the amendment.

~~grips, Bicycle parts, namely, tubes and connectors for bicycle frames, Bicycles, Electric bicycles, Electric vehicles, namely, self propelled electric vehicle, Frames for bicycles, Mobility scooters, Mopeds, Push scooters, Sleighs for transport purposes, Snowmobiles, Two wheeled trolleys, Folding bicycles, Folding electric bicycles, Motorized bicycles, Motorized mobility scooters, Motorized personal mobility scooters, Mountain bicycles, Self propelled electric vehicle, Touring bicycles; On-line wholesale and retail store services featuring controllers, LCD displays, batteries, battery chargers for vehicles~~

To: Wholesale and retail store services featuring Electric bicycles, Electric vehicles, namely, self-propelled electric vehicle, On-line wholesale and retail store services featuring controllers, LCD displays, batteries, battery chargers for 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* TBMP §§ 514.01 and 605.03(b). 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.

Proper punctuation in identifications is necessary to delineate explicitly each product or service within a list and to avoid ambiguity. Commas, semicolons, and apostrophes are the only punctuation that should be used in an identification of goods and/or services. TMEP § 1402.01(a). In general, **commas** should be used in an identification (1) to separate a series of related items identified within a particular category of goods or services, (2) before and after “namely,” and (3) between each item in a list of goods or services following “namely” (e.g., personal care products, namely, body lotion, bar soap, shampoo). *Id.* **Semicolons** generally should be used to separate

a series of distinct categories of goods or services within an international class (e.g., personal care products, namely, body lotion; deodorizers for pets; glass cleaners). *Id.*

In the present case, the discrete entries “Wholesale and retail store services featuring Electric bicycles, Electric vehicles, namely, self-propelled electric vehicle” and “On-line wholesale and retail store services featuring controllers, LCD displays, batteries, battery chargers for vehicles” are separated by a comma rather than a semicolon. The proposed amended wording therefore creates ambiguity and as a result is indefinite. The proposed amended wording is otherwise acceptable, as it is limiting in nature, as required by Trademark Rule 2.71(a).

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

In view of these findings, the motion to amend is denied without prejudice. The present identification of services for International Class 35, 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), 37 C.F.R. § 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 **15 days from the mailing 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.