UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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KGC/DMD

November 2, 2021

Opposition No. 91271212

TomTom International B.V.

v.

Taco Bell IP Holder, LLC

By the Trademark Trial and Appeal Board:

On September 2, 2021, Applicant filed a motion to divide the goods and services in Classes 29, 30, and 43 from the opposed application, thus, requesting that only the goods in Class 9 remain in the original (parent) application, i.e., application Serial No. 90144967.[1] 5 TTABVUE. In support of its motion, Applicant also submitted the required fee for the requested division. *See* Trademark Rule 2.6(a)(19). Opposer did not file a response thereto.

An application which is the subject of an inter partes proceeding before the Board may be divided into two (or more) separate applications upon motion granted by the Board and payment of the required fee. *See* Trademark Rules 2.6(a)(19) and 2.87. Thus, in general, the Board views division of an application as a ministerial function

[1] Registration of the involved mark in connection with the goods and services in Classes 29, 30, and 43 was not opposed.
Also, Applicant's change of correspondence address is noted. 4 TTABVUE.

that does not affect either party's rights; that is, division is not considered to be a substantive amendment. *See* Trademark Rule 2.133(a). Thus, an applicant may file a motion to divide requesting that an unopposed class of goods or services be "divided out," and every other party to a proceeding will be allowed an opportunity to file a brief in opposition to a motion to divide. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE § 516 (2021); *see also Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1436 (2007) (motion to divide out three classes granted because the opposition was limited to one of four classes and applicant agreed to pay the fee required for division of the application).

Here, Applicant's motion to divide was filed in an opposition in which only one of four classes of goods is opposed. In addition, Applicant has paid the required fee. In view of the foregoing, Applicant's motion to divide the three unopposed classes of goods and services from application Serial No. 90144967 is **granted** in accordance with Trademark Rules 2.87 and 2.133 as well as being conceded. Trademark Rule 2.127(a). Accordingly, Applicant's request will be forwarded to the ITU/Divisional Unit for processing, which will include charging the deposit account referenced in the motion (5 TTABVUE 2) for the requisite fee.

Dates remain as set forth in the Board's institution order at 2 TTABVUE 3.