

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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ajl/ky

February 8, 2024

Opposition No. 91275567

MX International Srl

v.

Magniberg Design AB

Ashlyn Lembree, Interlocutory Attorney:

On January 30, 2024, Applicant filed a revised proposed amendment to its application Serial No. 79303230, with Opposer's consent.¹

By the proposed amendment, Applicant seeks to amend the identification of goods in International Classes 20 and 24 as follows (additions are in bold; deletions are in strikethrough):²

¹ Applicant's submission is single-spaced. Trademark Rule 2.126(a)(1), 37 C.F.R. § 2.126(a)(1), requires that all electronic submissions made to the Trademark Trial and Appeal Board via ESTTA be double-spaced. Additionally, Applicant's proposed amendment failed to include a "redlined" copy of the full proposed amendment showing the proposed changes to the identification of goods. See Trademark Rule 2.74(a); see also TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 514.01 (2023). The Board, in exercising its discretion, accepts the submission. The Board may refuse to consider filings that do not meet the requirements of Trademark Rules 2.126(a)(1) 2.74(a) or any other applicable rule.

² Class 25 remains unchanged.

Class 20:

Prior Identification:

Furniture; furniture fittings, not of metal; statues, figurines, works of art, ornaments and decorations, namely, boxes and spheres, made of wood, wax, plaster or plastic, displays cases, display stands and signage in the nature of printed vinyl signs, inflatable plastic signs, non-metallic

Proposed Identification:

Furniture, **except beds, bedding (except linen), mattresses, pillows, fire resistant mattresses, foam mattresses, latex mattresses, air mattresses, beds incorporating inner sprung mattresses, armchair beds, bed chairs, sofa beds, furniture incorporating beds, bed fittings, not of metal, mattress fittings, not of metal, furniture being convertible into beds, bedroom furniture, mattress toppers, bed bases, wardrobes, bedside tables, dressers [furniture], back support cushions, leg support cushions, support seats and furniture fittings, not of metal;** ~~furniture fittings, not of metal;~~ statues, figurines, works of art, **and** ornaments and decorations, namely, boxes and spheres, made of wood, wax, plaster or plastic, displays cases, display stands and signage in the nature of printed vinyl signs, inflatable plastic signs, non-metallic.

Class 24:

Prior Identification:

Drapery; linens, namely linen fabric, bed linen; labels of textile; wall hangings of textile; unfitted coverings for furniture not of paper; streamers in the nature of pennants of textile; coated textiles, namely, Fabrics coated with thermoplastic coatings for use in manufacturing in a wide variety of industries; bunting of textile or plastic; fabrics for textile use; traced cloth for embroidery; linen lining fabric for shoes; lining fabric for shoes; textile used as lining for clothing; bath linen; kitchen and table linens not of paper; bed clothes in the nature of covers and bed blankets; glass cloths being towels; towels of textile

Proposed Identification:

Drapery; linens, namely linen fabric; labels of textile; bed linens, **namely, duvet covers, pillow covers, bed sheets except protective loose covers for mattresses and furniture, ticks [mattress covers];** wall hangings of textile; unfitted coverings for furniture not of paper; streamers in the nature of pennants of textile; coated textiles, namely, Fabrics coated with

thermoplastic coatings for use in manufacturing in a wide variety of industries; bunting of textile or plastic; fabrics for textile use; traced cloth for embroidery; linen lining fabric for shoes; lining fabric for shoes; textile used as lining for clothing; bath linen; kitchen and table linens not of paper; bed clothes in the nature of covers and bed; blankets; glass cloths being [towels]; towels of textile

A proposed amendment to any application or registration which is the subject of a Board proceeding must comply with all other applicable rules and statutory provisions, including Trademark Rules 2.32 and 2.71(a). *See also* TBMP §§ 514.01 and 605.03(b). Under §68(a)(1) of the Trademark Act, a request for extension of protection will be examined under the same standards as any other application for registration on the Principal Register. 15 U.S.C. §1141h(a)(1); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1904.02(a). In particular, an applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services. Trademark Rule 2.71(a). In addition, an identification that fails to identify the goods and services with specificity is indefinite, either because the nature of the goods or services is not clear, or because the wording is so broad that it may include goods or services in more than one class. *See* TMEP §§ 1402.01, 1402.06(a). Additionally, a proposed amendment to an application filed under Trademark Act Section 66(a), 15 U.S.C. § 1141f(a), must conform the identification of goods to any applicable partial ceasing of effect of the corresponding International Registration, as the ceased goods are no longer eligible for extension of protection. *See* TMEP § 1904.02(f)(iv).³

³ As noted in the Board's January 5, 2024 order, the International Bureau (IB) of the World Intellectual Property Organization notified the USPTO of a partial ceasing of effect of International Registration No. 1572988, which corresponds to involved Application Serial No. 79303230.

Although the proposed amendments to the identification of goods in International Class 20 are acceptable, the proposed amendments to the identification of goods in International Class 24 are not limiting in nature, as required by Trademark Rule 2.71(a). In particular, “unfitted coverings for furniture not of paper, streamers in the nature of pennants of textile” – which is a proposed amendment to “unfitted coverings for furniture not of paper; streamers in the nature of pennants of textile” – is indefinite in that it is unclear whether “streamers in the nature of pennants of textile” is a type of “unfitted coverings for furniture not of paper.” Additionally, amending “bed clothes in the nature of covers and bed blankets” to “bed clothes in the nature of covers and bed; blankets” broadens the identification of goods. Finally, amending “glass cloths being towels” to “glass cloths being [towels]” is unacceptable because it uses brackets. *See* TMEP 1402.12 (Generally, brackets should not be used in identifications; the Post Registration Section of the USPTO uses single square brackets to indicate that goods have been deleted from a registration.).

The amendment to Class 20 is limiting in nature, as required by Trademark Rule 2.71(a). Because Opposer consents thereto, the **amendment to Class 20 is approved** and entered. *See* Trademark Rule 2.133(a).

The **amendment to Class 24 is not approved**. Inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter and simultaneously conform the identifications as limited by the partial ceasing of effect, proceedings are **suspended**, and the parties are allowed

until **thirty days** from the date of this order to file a second revised motion to amend,⁴ failing which the Board may take appropriate action on the IB's notice of partial ceasing of effect. *See* 15 U.S.C. §1141j(a); *see also* 37 C.F.R. §7.30; TMEP § 1904.02(f)(iv).

Proceedings are otherwise suspended.

⁴ Any revised motion to amend should include a redline of proposed amendments and be double-spaced. *See* n.1, *supra*.