

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Vv/wbc

Mailed: May 6, 2016

Cancellation No. 92059833

Avid Airline Products of Rhode Island, Inc.

v.

Avid Technology, Inc.

By the Trademark Trial and Appeal Board:

On February 16, 2016, Registrant filed a motion to amend its Registration No. 3905003, in accordance with the parties' settlement agreement. In response to the Board's March 25, 2016 order, on March 28, 2016, Petitioner filed a motion to withdraw the petition to cancel the subject Registration, and Registrant filed a motion to correct the approved amendment to Registration No. 3905003.

The proposed amendment filed March 28, 2016 seeks to amend the identification of goods in Class 9 from:¹

Apparatus for recording, transmission or reproduction of sound and images; Cables and fibres for the transmission of sounds and images; Computer peripherals; Computer programs for editing images, sound and video; Computer software for processing digital music files; Computer software for use in relation to digital animation and special effects of images; Computer storage devices, namely, computer memory

¹ Respondent included in its motion to amend a description of goods for Class 9 that includes the language "computer hardware" in the beginning of the identification of goods. The Board notes, however, that the current identification of goods does not contain this language.

Respondent's error was not noted in the Board's February 25, 2015 or March 17, 2016 orders. This order vacates the Board's February 25, 2016 and March 17, 2016 orders.

hardware and hard drives; Loudspeakers; Microphones; Amplifiers; Headphones * for the professionals and consumer media industry *; Music-composition software; Sound mixers

To:

Computer hardware; apparatus for recording, transmission or reproduction of images, sound and video; cables and fibres for the transmission of images, sound and video; computer peripherals; computer software for editing images, sound and video; computer software for processing digital music files; computer software for use in relation to digital animation and special effects of images; computer storage devices, namely, hard disk drives, solid state drives, and computer storage systems comprised of one or more computer hard drives; loudspeakers; microphones; amplifiers; headphones **for the professional and consumer media industry**; music-composition software; and sound mixers

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 a party may amend to clarify or limit an 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.

The proposed amendment is unacceptable inasmuch as it broadens the scope of the goods of the present identification. Specifically, “computer hardware” listed in the proposed amendment is broader in scope than in the original identification.²

Therefore, the Board cannot accept and will not enter the amendment.³

² Conversely, an amendment that seeks to clarify or limit the goods, *e.g.*, “computer hardware, namely ...” would likely be acceptable.

³ Consideration of the motion to withdraw the petition to cancel filed March 28, 2016 is deferred. *See* 22 TTABVue.

In view of these findings, the motion to amend filed March 28, 2016 is denied without prejudice. The present identification of goods, that is, the identification prior to the filing of the motions to amend, remains operative for purposes of future amendment. *See* Trademark Rule 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 thirty 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 cancellation will go forward on the present application.