

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

mc

Mailed: April 4, 2012

Opposition No. 91195999

MasterCard International  
Incorporated

v.

CambridgeCommerce, Inc.

**M. Catherine Faint,  
Interlocutory Attorney:**

On February 22, 2012, applicant filed a proposed amendment to its application Serial No. 77858262, with opposer's written consent and opposer's withdrawal with prejudice of the opposition, contingent upon entry of the amendment.

By the proposed amendment applicant seeks to amend the application as indicated below:

- (1) by amending the mark **from**  **to** 
- (2) by deleting all references to Section 1(a) and relying on Section 1(b); and
- (3) by changing the services in bold **to** read as "electronic bill payment services, **excluding from all of the foregoing banking services, payment card, prepaid card,**

bank card, debit card, credit card, charge card, magnetic encoded card, telephone calling cards or stored value and/or prepaid card services, ATM services and products, money exchange services, letter of credit issuance services, electronic financial settlement services, company credit investigation services, magnetic data carriers, computer program for banking, and computer software for transmitting, displaying and storing financial transaction information for use in the financial services, and banking industries.”

Motions to Amend Basis and Identification of Goods

The motion to change the basis from Section 1(a) to rely on Section 1(b) and the motion to amend the identification of goods are clearly limiting in nature as required by Trademark Rule 2.71(a), and because opposer consents thereto, they are approved and entered. See Trademark Rule 2.133(a).

Motion to Amend Drawing

Trademark Rule 2.72 prohibits any amendment of the mark in an application under § 1 of the Trademark Act that materially alters the mark on the drawing filed with the original application. A material alteration exists if the old and new formats do not create the same general commercial impression. See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* §§ 19:58:50 and 19:133 (WESTLAW Update 2012).

The test for determining whether an amendment is a material alteration is as follows:

The *modified* mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

*In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (emphasis in original), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983); see also TMEP § 807.14 (8<sup>th</sup> ed. 2011).

By its amendment, applicant seeks to rotate the interlocking circles in the design element of its mark by 90 degrees. The rotation changes the commercial impression of the mark, such that it could be seen as the cardinal number "8." Such an addition creates the impression of a new mark, and is a material alteration.

Accordingly, applicant's motion to amend the drawing is denied without prejudice. These proceedings are suspended, and the parties are allowed **SIXTY DAYS** from the mailing date of this order to submit an amended drawing that conforms with the rules.

The Board notes that the parties filed a motion to suspend these proceedings via ESTTA, which motion was automatically granted March 12, 2012. As noted above, proceedings remain suspended.

In the event that there is no word from either party concerning any further amendments to the drawing, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out in the Board's suspension order of March 12, 2012, as copied below.

Expert Disclosure Due :	06/10/2012
Discovery Closes :	07/10/2012
Plaintiff's Pretrial Disclosures :	08/24/2012
Plaintiff's 30-day Trial Period Ends :	10/08/2012
Defendant's Pretrial Disclosures :	10/23/2012
Defendant's 30-day Trial Period Ends :	12/07/2012
Plaintiff's Rebuttal Disclosures :	12/22/2012
Plaintiff's 15-day Rebuttal Period Ends :	01/21/2013

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.