

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

Mailed: August 31, 2012

Opposition No. 91197507

Blue Cross and Blue Shield  
Association

v.

Franads LLC

**Robert H. Coggins,  
Interlocutory Attorney:**

Motion to Amend

This case comes up on applicant's consented motion (filed June 26, 2012) to amend subject application Serial No. 77721117. By way of the motion, applicant seeks to delete the color claim statement and to amend the description of the mark to:

The mark consists of word "FRAN" in upper-case letters, followed by the word "Health" with upper-case "H" and lower-case "ealth". A cross is running through the letter "N". The mark is not and will not contain or be used in the color blue (or any colorable imitation thereof).

It is noted that the current drawing of the mark is in color and contains black, medium blue, and light blue. When an applicant has submitted a color drawing the applicant must claim color as a feature of the mark. Trademark Rule 2.52(b)(1). See TMEP § 807.07(a)(i). In view thereof, applicant may not delete the color claim statement (and may

not otherwise state either that no claim is made to color or that color is not a feature of the mark). *Id.* As to the description, inasmuch as the current drawing of the mark is in color, and color must be claimed as a feature of the mark, the proposed amendment is unacceptable because the description must describe where color appears on the mark. See TMEP § 807.07(a)(ii). The proposed amended description is not an accurate description of the current mark because it does not state where color appears on the mark. Moreover, where the mark is in color and color is a claimed as a feature of the mark, the specimen must show use of the color. TMEP § 904.02(c)(ii). The specimen currently of record is in color and shows the mark in blue; however, the proposed amended description inaccurately states that the mark is not and will not contain or be used in the color blue. Accordingly, applicant's motion is denied.

In view of the nature of the proposed amendment, which shows that the parties are attempting to settle the dispute in the opposition, the Board notes that if the parties agree and the Board approves, applicant may, if the amendment would not constitute a material alteration, amend to a black-and-white drawing with a statement that color is not claimed as a feature of the mark. TMEP § 807.07(a)(i). However, if applicant were to submit a black-and-white drawing, applicant should note that the currently proposed amended description would be unacceptable for two reasons. Firstly, with a black-and-white drawing applicant would be

required to delete any color claim; and, when there is no color claim, the description of the mark should not mention color. TMEP §§ 807.07 and 808.02 state that "[g]enerally, if the applicant has not made a color claim, the description of the mark should not mention color, because a reference to color in the description of a non-colored mark creates a misleading impression." Therefore, any description of a prospective black-and-white mark (where there is no color claim) should not mention color -even a negative color statement- because a reference to color in the description of a non-colored mark would create a misleading impression. Secondly, the specimen of record was submitted in color and shows the mark with a blue cross design, but the description proposed in the amendment, with its negative color statement, states that the mark does not contain blue. The description and specimen would not match and this would create an ambiguity in the application.

It is noted that the appropriate place for the parties to spell out any terms of use of applicant's mark is in a settlement agreement executed between the parties but not in the trademark application itself.

#### Schedule

Dates remain as set.

#### Certificate of Service

Applicant's motion states that a copy of the motion "is being sent to" counsel for opposer. This statement is not sufficient to meet the service requirements of Trademark

Rule 2.119. Copies of all papers which applicant may subsequently file in this proceeding must be accompanied by a signed statement indicating the date and manner in which service was made. The statement should take the form of a "certificate of Service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon [insert name of party served] by forwarding said copy, via first class mail [or insert other appropriate means], postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. See TBMP § 113 (3d ed. rev. 2012).