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

Mailed: August 2, 2011

Opposition No. 91200695

Shure Incorporated

v.

Abimael Sequinot, Pedro Oviedo, Anthony Echeverria, and Steve Akins

George C. Pologeorgis,
Interlocutory Attorney:

Applicants have filed a use-based application seeking to register the mark SOUL-SA PRODUCTIONS and design, as displayed below, for "audio recording and production; Entertainment services, namely, providing a web site featuring photographic, video and prose presentations featuring musical entertainment; Entertainment, namely, live performances by a musical band; Song writing services" in International Class 41:

On July 14, 2011, opposer, Shure Incorporated, filed a notice of opposition to registration of applicants' mark on the grounds of priority and likelihood of confusion, as well as dilution. With regard to its likelihood of confusion claim, opposer alleges that applicants' mark, when used on the identified services, so resembles opposer's pleaded registered mark, as pictured below, used in association with "microphones," as to be likely to cause confusion, mistake or to deceive.

On July 28, 2011, applicants filed with the Board a communication which consists solely of an ESTTA filing cover sheet, which identifies the filing as a motion to amend the application, as well as a drawing page containing an image as displayed below:

It appears that applicants are seeking to amend the drawing of their involved mark through their July 28, 2011 filing. First, the Board notes that applicants' July 28, 2011 filing does not demonstrate proof of service of the same upon opposer's counsel, as required by Trademark Rule 2.119.[1] Second, applicants' filing does not comport with the Board's rules regarding motions. Every motion filed with the Board must embody or be accompanied by a brief. TBMP § 502.(b) (3d ed. 2011). Applicants' filing does neither. Here, applicants have merely filed what appears to be an unconsented proposed amendment of the drawing of their involved mark without any motion or brief in support thereof and only identifying what they appear to be seeking on the ESTTA cover filing sheet. Accordingly, inasmuch as applicants' filing does not comply with Board rules, it will be given no further consideration.

Even if the Board were to construe applicants' July 28, 2011 filing as a properly filed motion to amend the drawing of their involved mark, the motion would nonetheless be denied for the reasons set forth below..

First, the Board generally will defer determination of a timely filed (i.e., pretrial) unconsented motion to amend in substance, as is the case here, until final decision, or until the case is decided upon summary judgment. TBMP § 514.03 (3d ed. 2011) and cases cited therein.

[1] In order to expedite matters, a copy of applicants' July 28, 2011 filing is forwarded to opposer's counsel with a copy of this order.

Second, an amendment to the drawing of a mark may not be made if it materially alters the character of the mark. *See* Trademark Rule 2.72(a)(2). The general test of whether an alteration of the mark 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. See *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983).

As a general rule, the addition (or substitution) of any element, which would require a further search, would constitute a material alteration. See *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). However, deletion of matter from the mark can also result in a material alteration. See *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Com'r Pat. & Trademarks 1993).

Here, applicants apparently seek to amend the drawing of their mark by substituting the microphone design element displayed in the mark with an intertwining mirror image of a musical treble clef. Such a substitution of a design element would constitute a material alteration of the mark because the musical treble clef constitutes distinctive matter which would require a further search and republication after alteration. Accordingly, applicant's proposed mark, even if properly

submitted for the Board's consideration and even if consented to by opposer, is unacceptable.[2]

In view of the foregoing and as noted above, applicants' filing made on July 28, 2011 will be given no further consideration.

Applicants' answer to the notice of opposition remains due by **August 23, 2011**. Trial dates remain as set forth in the Board's July 14, 2011 institution order.

[2] The Board notes that the inclusion of the TM symbol in the proposed drawing is not a registrable component. *See* TMEP § 807.14(a)