

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

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Mailed: March 27, 2012

Opposition No. 91202393

Diageo North America, Inc.

v.

Spirits Of The USA LLC

Jennifer Krisp, Interlocutory Attorney:

Proposed Amendment

On March 16, 2012 applicant filed a consented motion to amend its application, and proposed amendment to its application Serial No. 77181194, with opposer's consent.<sup>1</sup>

By the proposed amendment applicant seeks to amend the mark from **PELICAN BAY RUM** to **PELICAN RUM**.

An amendment to the mark will only be accepted if it does not constitute a material alteration of the published mark. Amendments may not be made to the drawing of the mark if the character of the mark is materially altered. See Trademark

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<sup>1</sup> Applicant's unexecuted filings of February 13, 2012 have been given no consideration, in view of the finding herein with respect to the unacceptability of the proposed amendment to the opposed application.

Neither the February 13, 2012, March 3, 2012 or March 16, 2012 filings include proof of service of a copy thereof on counsel for opposer, as required by Trademark Rule 2.119(a), and as further discussed below.

Rule 2.72; TMEP Section 1215.08. The test for determining whether an amendment is a material alteration, as provided for in TMEP Section 807.14, 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.

Deletion of matter from the mark can result in a material alteration. See TMEP Section 807.14(a); *In re Dillard Department Stores, Inc.*, 33 USPQ2d 1052 (Comm'r Pats. 1993).

Here, the proposed amendment is a material alteration of the mark which impermissibly changes the mark to create a different commercial impression. The wording "Pelican Bay" and "Pelican" do not have the same meaning or connotation, and thus the proposed amendment significantly alters the commercial impression of the mark.

Accordingly, applicant's consented motion to amend and proposed amendment to its mark set forth therein, are denied.<sup>2</sup>

#### Applicant's Answer

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<sup>2</sup> In the event that the parties intend to settle this proceeding by way of an acceptable amendment to the opposed application, they may file a motion seeking such amendment for the Board's consideration, as appropriate.

Applicant filed a communication on March 3, 2012. It is presumed that this communication is intended as an answer to the notice of opposition. A reading of this informal "answer" reveals, however, that it is argumentative and more in the nature of a brief on the case than a responsive pleading to the notice of opposition. Moreover, it does not comply with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable this proceeding by Trademark Rule 2.116(a).

Fed. R. Civ. P. 8(b) provides, in part:

**(b) DEFENSES; ADMISSIONS AND DENIALS.**

**(1) *In General.* In responding to a pleading, a party must:**

**(A) state in short and plain terms its defenses to each claim asserted against it; and**

**(B) admit or deny the allegations asserted against it by an opposing party.**

The notice of opposition filed by opposer herein consists of 15 paragraphs setting forth the basis of opposer's claim of damage. In accordance with Fed. R. Civ. P. 8(b) it is incumbent on applicant to answer the notice of opposition by specifically admitting or denying the allegations contained in each paragraph. If applicant is without sufficient knowledge or information on which to form a belief as to the truth of any one of the allegations, it should so state and this will have the effect of a denial.

In view of the foregoing, applicant is allowed until May 4, 2012 in which to file an answer herein which complies with Fed. R. Civ. P. 8.

Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. Consequently, copies of all papers which applicant may subsequently file in this proceeding, including its answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service.

It should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney.

It is recommended that applicant obtain a copy of the latest edition of Title 37 of the Code of Federal Regulations, which includes the Trademark Rules of Practice. These rules may be viewed at the USPTO's trademarks page:

<http://www.uspto.gov/main/trademarks.htm>. The Board's main webpage (<http://www.uspto.gov/web/offices/dcom/ttab/>) includes information on amendments to the Trademark Rules applicable to Board proceedings, on Alternative Dispute Resolution (ADR), Frequently Asked Questions about Board proceedings, and a web link to the Board's manual of procedure (the TBMP).

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel. *See McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

Time to answer, conferencing, disclosure, discovery and trial dates are reset as follows:

Time to Answer	5/4/2012
Deadline for Discovery Conference	6/3/2012
Discovery Opens	6/3/2012
Initial Disclosures Due	7/3/2012
Expert Disclosures Due	10/31/2012
Discovery Closes	11/30/2012
Plaintiff's Pretrial Disclosures	1/14/2013
Plaintiff's 30-day Trial Period Ends	2/28/2013
Defendant's Pretrial Disclosures	3/15/2013
Defendant's 30-day Trial Period Ends	4/29/2013
Plaintiff's Rebuttal Disclosures	5/14/2013
Plaintiff's 15-day Rebuttal Period Ends	6/13/2013

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing after briefing is not required but will be scheduled upon request of any party, as provided by Trademark Rule 2.129.