

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

DUNN

Mailed: July 3, 2013

Opposition No. 91210133

Junwei He

v.

Qiang Zhang

Elizabeth A. Dunn, Attorney (571-272-4267):

On June 13, 2013, applicant acting pro se used a Trademarks form to file a "voluntary amendment" to his application Serial No. 85159636. The filing lacks proof of service upon opposer, which is addressed later in this order.

AMENDMENT DENIED

Once an application has been opposed, the applicant no longer may take unilateral action.¹ If doing so would not be futile, the Board's usual procedure would be to defer consideration of the amendment made without the consent of

¹ Pursuant to Trademark Rule 2.133(a), "[a]n application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board."

opposer until final decision, or until the case is decided upon summary judgment. *See Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1219 (TTAB 1990); and TBMP §514.03 (2013). However, because applicant seeks to broaden its present identification of goods with a completely different recitation of services, the amendment is impermissible and there is no need to defer consideration.

A proposed amendment to any application which is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions. TBMP § 514 (2013). Trademark Rule 2.71(a) provides that "The applicant may amend the application to clarify or limit, but not to broaden, the identification of goods and/or services." Here, applicant seeks to amend its application from:

Bean jam buns; Bread and buns; Buns; Chinese steamed dumplings (shumai, cooked); Chinese stuffed dumplings (gyoza, cooked); Cream buns; Dumplings; Fish dumplings; Flour for making dumplings of glutinous rice; Honey buns; Jam buns; Rice dumplings dressed with sweet bean jam (ankoro); Shrimp dumplings; Steamed buns stuffed with minced meat (niku-manjuh); Sweet dumplings (dango)

to:

Restaurant services Restaurant and cafe services
Restaurant and catering services Restaurant and
hotel services Restaurant reservation services
Restaurant services featuring Restaurant
services, including sitdown service of food and

take-out restaurant services Restaurant services, namely, providing of food and beverages for consumption on and off the premises Restaurants featuring home delivery Salad bars [restaurant services] Self-service restaurants Take-out restaurant services Travel agency services, namely, making reservations and bookings for restaurants and meals Consulting in the field of restaurant menu development Delicatessen services [restaurants] Fast-food restaurant services Frozen yogurt shop services in the nature of a restaurant Ice cream shop services in the nature of a restaurant Making reservations and bookings for restaurants and meals Mobile restaurant services Providing information and advice on hotels and restaurants to tourists and business travelers Providing on-line reviews of restaurants and hotels Providing progressive dinner events where participants sample meals and drinks at a series of restaurants Providing reviews of restaurants Providing reviews of restaurants and bars Reservation of restaurants

Because the proposed amendment impermissibly broadens the listed goods to include completely different services, the amendment is DENIED. See Trademark Manual of Examining Procedure § 1402.07(c) (8th ed., rev. 2013) ("TMEP") ("An applicant may not amend a definite identification of goods to specify services.").

PROOF OF SERVICE REQUIRED ON ALL FILINGS

Every filing made in an opposition proceeding must include proof that a copy of the filing was served upon the other side. Shown below is a suggested format for a certificate of service:

I hereby certify that a true and complete copy of the foregoing (insert title of submission, such as answer) has been served on opposer by

overnight courier on (insert date of mailing), via (insert name of courier used) to:

NICHOLAS WELLS
WELLS IP LAW LLC
299 S MAIN STREET, SUITE 1300
SALT LAKE CITY, UT 84111

The certificate must be signed and dated by applicant.²

Applicant is advised that from this point forward, all filings must include proof of service.

APPLICANT'S TIME TO FILE AN ANSWER TO THE NOTICE OF OPPOSITION RESET

The Board's April 9, 2013 institution and trial order required applicant to file an answer to the notice of opposition by May 19, 2013. In view of applicant's filing of its proposed amendment, the Board finds good cause to reopen applicant's time to answer.

Applicant is ordered to file an answer to the notice of opposition within THIRTY DAYS of the mailing date of

² Pursuant to Trademark Rule 2.119(a), "Every paper filed in the United States Patent and Trademark Office in inter partes cases, including notices of appeal, must be served upon the other parties. Proof of such service must be made before the paper will be considered by the Office. A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service."

The Board notes that the service option listed in Trademark Rule 2.119(b) involving mail applies only to parties located in the United States. Electronic service is available by agreement of the parties and may not be used without a prior communication in which the receiving party specifically consents to electronic service.

this order which complies with Rule 8(b) of the Federal Rules of Civil Procedure, made applicable to this proceeding by Trademark Rule 2.116(a). Fed. R. Civ. P. 8(b) provides, in part:

A party shall state in short and plain terms the party's defenses to each claim asserted and shall admit or deny the averments upon which the adverse party relies. If a party is without knowledge or information sufficient to form a belief as to the truth of an averment, the party shall so state and this has the effect of a denial. Denials shall fairly meet the substance of the averments denied. When a pleader intends in good faith to deny only a part or a qualification of an averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

The notice of opposition herein consists of twenty-two 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 petition to cancel by 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.

LEGAL REPRESENTATION STRONGLY ENCOURAGED

While U.S. Patent and Trademark Office Rule 11.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board 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.

Because the Board is an administrative tribunal, its rules and procedures necessarily differ in some respects from those prevailing in the Federal district courts. Like a civil trial, mandatory disclosures and a discovery period precede the trial.³ However, unlike a civil trial, the Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board, and the written transcripts thereof, together with any exhibits thereto, are then submitted to the Board. No paper, document, or exhibit, will be considered as evidence in the case unless it has been introduced in evidence in

³ Through the use of the various discovery devices (i.e., discovery depositions, interrogatories, requests for production of documents and things, and requests for admission) available to litigants in *inter partes* proceedings before the Board; a party may ascertain the facts underlying its adversary's case. TBMP §401. The conduct of discovery in Board *inter partes* proceedings is governed by Trademark Rule 2.120.

accordance with the applicable rules. See Trademark Rule 2.123(1).

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. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 n.2 (TTAB 2006). Applicant should refer to the online resources with information on Board proceedings listed in the Board's institution and trial order.

Dates are reset below:

Time to Answer	7/31/2013
Deadline for Discovery Conference	8/30/2013
Discovery Opens	8/30/2013
Initial Disclosures Due	9/29/2013
Expert Disclosures Due	1/27/2014
Discovery Closes	2/26/2014
1Plaintiff's Pretrial Disclosures	4/12/2014
Plaintiff's 30-day Trial Period Ends	5/27/2014
Defendant's Pretrial Disclosures	6/11/2014
Defendant's 30-day Trial Period Ends	7/26/2014
Plaintiff's Rebuttal Disclosures	8/10/2014
Plaintiff's 15-day Rebuttal Period Ends	9/9/2014

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.

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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.