

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

EJW/vw

Mailed: October 2, 2013

Opposition No. 91210283

Blue Cross and Blue Shield
Association

v.

Jerry R. Carnahan Insurance
Agency, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On July 22, 2013, opposer filed the parties' stipulated proposed amendments to applicant's involved application Serial No. 85643431, and its withdrawal of the opposition without prejudice, contingent upon entry of the amendments.

By the proposed stipulated amendments, applicant seeks to (1) modify the drawing, (2) amend the description of the mark, and (3) include a description that excludes the color blue from the mark, as shown below:

Proposed Amendments

- Drawing

With regard to the drawing, applicant seeks to amend the drawing, as follows:

Original Trademark



Amended Trademark



The Board finds that the submitted, amended drawing is acceptable insofar as it does not materially alter the original mark sought to be registered. Additionally, applicant has provided a substitute drawing. Accordingly, the amended drawing would be accepted and entered. See Trademark Rules 2.72 and 2.133(a).

- Description of the Mark

Additionally, with regard to the description of the mark, applicant seeks to amend the description of the mark, as follows:

From:

"The mark consists of a shield in various shades of blue with black and gray outlining. In the center of the shield is a white circle outlined in black and with a light blue letter "C" around the circle. Inside the circle is a black lowercase "i". The entire shield is centered between the words "Smart" and "Guard" which are in black. The wording "CARNAHAN INSURANCE" appears in black above the shield,"

To:

"Color is not claimed as a feature of the mark. The mark consists of a shield. In the center of the shield is a circle with the letter "C" around the circle. Inside the circle is a lowercase "i". The entire shield is centered between the words "Smart" and "Guard." The wording "CARNAHAN INSURANCE" appears above the shield".

The Board finds that the submitted, amended description of mark is acceptable because it does not materially alter the mark sought to be registered. Accordingly, the amended description of mark would be accepted and entered. See Trademark Rules 2.72 and 2.133(a).

- Excluded Color

Applicant seeks to amend the application to include a statement excluding the color blue from the mark, as follows:

From:

"The color(s) black, white, blue, light blue and gray is/are claimed as a feature of the mark,"

To:

"The application and any resulting registration exclude the color blue (or any color with the commercial impression of the color blue) within or as part of the shield portion of the mark".

The proposed amendment is denied because it seeks to add a restrictive statement to the application (and resulting certificate of registration), namely, how the mark does not and will not appear.¹

¹ Although none of these decisions are citable precedents, the Board rejected similar proposed amendments in *Blue Cross and Blue Shield Association v. UHS of Delaware, Inc.*, Opposition No. 91193105 (September 6, 2011); *Johnson & Johnson v. Advantageous MD, LLC*, Opposition No. 91192960 (TTAB, February 10, 2011), *recon. denied* (TTAB, August 2, 2011); *Johnson & Johnson v. Electric Aquagenics Unlimited, Inc.*, Opposition No. 91179307 (TTAB, February 18, 2010); *Johnson & Johnson v. Aplus Medical Supplies Corp.*, Opposition No. 91185987 (TTAB, February 2, 2010); *Johnson & Johnson v. Aplus Medical Supplies Corp.*, Cancellation No. 92049861 (TTAB, February 1, 2010); and *Johnson & Johnson v. CHRISTUS Health*, Opposition No. 91186819 (TTAB, November 24, 2008), *recon. denied* (TTAB, April 13, 2009).

A proposed amendment to any application which is the subject of an *inter partes* proceeding must comply with all other applicable rules and statutory provisions. See generally TBMP § 514.01 (3d ed. rev. 2 2013) and cases cited therein. The Trademark Rules related to descriptions of a mark provide *only* that *if* the mark contains color, the applicant must name the color(s) and describe where the color(s) appear on the mark. Trademark Rule 2.52(b)(1), 37 C.F.R. § 2.52(b)(1). There is no provision for stating what the mark does not comprise. Similarly, USPTO trademark examination practice which implements Trademark Rules 2.52(b)(1) and 2.52(b)(5), does not permit the description of a mark to include information other than a clear and accurate statement of significant aspects of the applied-for mark as shown on the drawing page. See TMEP § 808.02 (April 2013). Thus, when "the applicant has not made a color claim, the description of the mark should not mention color(s), because reference to color in the description of a non-color mark creates a misleading impression." TMEP *Id.* at §§ 807.07 and 808.02 (emphasis added). *Cf.* TMEP *Id.* at § 808.01(a) ("a statement that a term has no meaning should not be entered as a description of the mark").

Here, the proposed description of the mark does not state accurately how the mark will appear. Moreover, the amended drawing of the mark in the opposed application does

not include color; therefore, a statement referencing color is not appropriate. See Trademark Rule 2.52(b)(1), 37 C.F.R. § 2.52(b)(1). In that regard, it is noted that applicant seeks to add the following statement to the application, *i.e.*, "Color is not claimed as a feature of the mark" (see *supra*).

In view of the foregoing, the parties are allowed until **THIRTY DAYS** from the mailing date of this order to inform the Board how they wish to proceed. For example, under these circumstances, the parties may, if appropriate, agree that the first two amendments should be entered and approved, but withdraw the request for the proposed limiting description in view of applicant's statement "on the record" that the color blue is excluded from the application and any resulting registration. In any case, the negative description of the mark may not be printed on the registration certificate.

If no word is heard from the parties, this proceeding will be resumed and the foregoing amendments will be given no further consideration. See Trademark Rule 2.106(c), 37 C.F.R. § 2.106(c).

Proceedings are otherwise **SUSPENDED**.

