

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

MT

Mailed: March 24, 2014

Opposition No. 91212456

Bayer Healthcare LLC

v.

Acharan S Narula

Elizabeth A. Dunn, Attorney:

On October 12, 2013, applicant filed a proposed amendment to its application Serial No. 85907678, with opposer's consent.

MOTION TO AMEND IS DENIED

The amendment fails to indicate proof of service on opposer, as required by Trademark Rule 2.119. By its proposed amendment, applicant seeks to change its mark from BRONCALEVE to Bronca•Wise. Amendments to the application made during an inter partes proceeding must comply with the same rules and statutory provisions applied during ex parte examination. Trademark Rule 2.133; Vaughn Russell Candy Co. v. Cookies In Bloom, Inc., 47 USPQ2d 1635, 1636 (TTAB 1998). Thus, an amendment to the mark may only be accepted

if it does not comprise a material alteration of the mark. See Trademark Rule 2.72 ("In an application based on use in commerce under section 1(a) of the Act, the applicant may amend the description or drawing of the mark only if (1) The specimens originally filed, or substitute specimens filed under § 2.59(a), support the proposed amendment; and (2) The proposed amendment does not materially alter the mark. The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the description or drawing of the mark filed with the original application.").

The test for determining whether an amendment is a material alteration 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.

In re Hacot-Colombier, 105 F.3d 616, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). In the instant case, the proposed amendment is a material alteration of the mark which impermissibly

changes the mark to create a different commercial impression.

TIME TO ANSWER RESET

Applicant is allowed until THIRTY DAYS from the mailing date of this order to file an answer to the notice of opposition.

REQUIREMENTS FOR THE ANSWER

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 averment, the pleader shall specify so much of it as is true and material and shall deny only the remainder.

The notice of opposition filed by opposer herein consists of eleven 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 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.

REQUIREMENT FOR PROOF OF SERVICE

As noted earlier in this order, 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 written statement indicating the date and manner in which such service was made.

LEGAL REPRESENTATION STRONGLY RECOMMENDED

It should also be noted that while Patent and Trademark Rule 10.14 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. 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).

DATES RESET

Applicant is allowed until THIRTY DAYS from the mailing date of this order to file his answer. Dates are reset:

Deadline for Discovery Conference	5/19/2014
Discovery Opens	5/19/2014
Initial Disclosures Due	6/18/2014
Expert Disclosures Due	10/16/2014
Discovery Closes	11/15/2014
Plaintiff's Pretrial Disclosures	12/30/2014
Plaintiff's 30-day Trial Period Ends	2/13/2015
Defendant's Pretrial Disclosures	2/28/2015
Defendant's 30-day Trial Period Ends	4/14/2015
Plaintiff's Rebuttal Disclosures	4/29/2015
Plaintiff's 15-day Rebuttal Period Ends	5/29/2015

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.

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.