

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

RA

Mailed: March 4, 2014

Opposition No. 91213240

The Lamar Company, L.L.C.

v.

Hasselbald Sàrl

**M. Catherine Faint,
Interlocutory Attorney:**

On January 6, 2014, applicant filed a proposed amendment to its application Serial No. 79119494, with opposer's consent. It has come to the Board's attention that ESTTA, the Board's electronic system, granted applicant's January 7, 2014 motion to suspend, before an opportunity arose for consideration of the amendment filed by applicant on January 6, 2014. The motion is **denied** without prejudice.

Notwithstanding opposer's consent thereto, the proposed amendment must also comply with all applicable rules and statutory provisions. These include Trademark Rules 2.71 to 2.75. Thus, for example, the Board will not approve a proposed amendment which involves an addition to the identification of goods, or which materially alters the character of the subject mark. See Trademark Rules 2.71(b), 2.72, 2.173(a) and 2.173(b); and *Aries Systems Corp. v. World*

Book Inc., 26 USPQ2d 1926 (TTAB 1993). See also Louise E. Rooney, TIPS FROM THE TTAB: Rule 2.133 Today, 81 Trademark Rep. 408 (1991).

Trademark Act Section 7(c), 15 U.S.C. § 1057(c), provides that the filing of any application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration.

Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register.

While an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. § 2.71(a); TMEP §§ 804.09 and 804.09(a).

Applicant's proposed amendment of the recitation of services in International class 35 only (the only class opposed) seeks to change the identification to:

Commercial information and advice for consumers in the field of photography and cameras; wholesale and retail store services of photographic cameras, business advice and guidance relating to the purchase of photographic cameras, including photographic cameras for moving images and for all other kinds of image, video cameras, electronic cameras, movie cameras and photographic cameras, lighting, information on the sale of photographic cameras, business advice and guidance relating to the purchase of photographic cameras, including photographic cameras for moving images and for all other kinds of image, video cameras, electronic cameras, movie cameras and photographic cameras, lighting; organization of exhibitions for commercial purposes in the field of photography and cameras; **publication of texts** in the field of photography and cameras; Writing of publicity texts in the field of photography and cameras; presentation of goods on

communication media, for retail purposes, namely, cameras, digital cameras and cameras lenses.

The proposed amendment is unacceptable because it expands the scope of the original recitation of services. Specifically, deleting the word "advertising" near the end of the recitation of services from "publication of advertising texts in the field of photography and cameras" to "publication of texts in the field of photography and cameras," broadens the scope of the services. For this reason, the proposed amendment is **denied without prejudice**. See Trademark Rules 2.71(a) and 2.133(a), 37 C.F.R. §§ 2.71(a) and 2.133(a). See also TMEP § 1402.01 (5th ed. 2007).

Because it is evident that the parties are attempting to reach a settlement to this proceeding, applicant is allowed until **THIRTY DAYS** from the mailing date of this order to submit an acceptable amendment, failing which the proposed amendment will be given no further consideration.

Proceedings are otherwise **SUSPENDED**.

