

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

VW

Mailed: August 15, 2014

Opposition No. 91215387

Nike, Inc.

v.

Naomi R. Melton, Chelsea R. Melton
and Adelaide S. Melton

Cheryl S. Goodman, Interlocutory Attorney:

On June 2, 2014, applicant filed a proposed amendment to its involved application Serial No. 85960046, with opposer's written consent.¹² By the proposed amendment, applicant seeks to amend the mark by replacing the drawing as follows:

From:



¹ Applicant's submission does not indicate proof of service of a copy of same on counsel for opposer, as required by Trademark Rule 2.119. In order to expedite this matter, opposer can view a copy of applicant's submission at:
<http://ttabvue.uspto.gov/ttabvue/v?pno=91215387&pty=OPP&eno=6>.

² Applicant's filing (filed May 19, 2014) of the parties' agreement is noted.

To:



Under Trademark Rule 2.72, a mark may not be amended if the proposed amendment materially alters the mark. The Federal Circuit described the test for determining whether an amendment is a material alteration 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, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983).

Here, applicant’s mark consists of a literal element and a design element. As the proposed image is completely different than the current image, it constitutes a material alteration. Accordingly, applicant’s motion to amend its mark is hereby **DENIED** and trial dates will be reset.

As a final matter, applicant filed its “answer” with the Board on April 18, 2014. On review thereof, the Board finds that applicant’s answer fails to include proof of service on the other party, as required by Trademark Rule 2.119(a). All future filings must include proof of service.

Copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. *See* TBMP § 113.03. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service, must be signed and dated, and should take the form of a certificate of service as follows:

I hereby certify that a true and complete copy of the foregoing (insert title of submission) has been served on (insert name of opposing counsel or party) by mailing said copy on (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: (name and address of opposing counsel or party).

Signature _____

Date _____

To expedite this matter, the parties are directed to the following link to TTABVUE where they may view a copy of the filing: <http://ttabvue.uspto.gov>.

Conferencing, disclosure, discovery and testimony dates are reset as follows:

Deadline for Discovery Conference	9/13/2014
Discovery Opens	9/13/2014
Initial Disclosures Due	10/13/2014
Expert Disclosures Due	2/10/2015
Discovery Closes	3/12/2015
Plaintiff's Pretrial Disclosures	4/26/2015
Plaintiff's 30-day Trial Period Ends	6/10/2015
Defendant's Pretrial Disclosures	6/25/2015
Defendant's 30-day Trial Period Ends	8/9/2015
Plaintiff's Rebuttal Disclosures	8/24/2015
Plaintiff's 15-day Rebuttal Period Ends	9/23/2015

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 taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.