

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

dmd

Mailed: January 22, 2015

Opposition No. 91216342

Boston Red Sox Baseball Club Limited
Partnership

v.

Brandon Merritt Charitable
Foundation, The

Cheryl S. Goodman, Administrative Trademark Judge:

On December 8, 2014, applicant filed a proposed amendment to its application Serial No. 85770458, with opposer's consent.

By the proposed amendment applicant seeks to amend its mark as shown below.



From.

To:



As published, color is not claimed as a feature of the mark and the mark is described as follows:

The mark consists of the wording "B THE DIFFERENCE" beneath a stylized turtle with a stylized letter "B" in the center of its shell.

Under Trademark Rule 2.72, a mark may not be amended if the proposed amendment materially alters the mark. Trademark Rule 2.72 further provides that “[t]he 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.” Trademark Rule 2.72(b)(2). 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, the differences are stark as the ‘B THE DIFFERENCE’ wording has been deleted. As such, the Board finds that the proposed mark is sufficiently different from the original so as to require republication. Thus, the proposed amendment constitutes a material alteration and applicant’s motion to amend the involved application is denied.

Should applicant elect to abandon its application, applicant must do so pursuant to Trademark Rule 2.135:

After the commencement of an opposition, concurrent use, or interference proceeding, if the applicant files a written abandonment of the application or of the mark without the written consent of every adverse party to the proceeding,

judgment shall be entered against the applicant. The written consent of an adverse party may be signed by the adverse party or by the adverse party's attorney or other authorized representative.

An abandonment of an opposed application should be filed with the Board and should bear at the top of its first page the application serial number, and the opposition number and title. The Board encourages the use of ESTTA (Electronic System for Trademark Trials and Appeals), the Board's electronic filing system, for filing an abandonment of an opposed application.¹

Use of the TEAS system is not appropriate for filing an abandonment of an opposed application.

Dates remain as set in the Board's December 17, 2014 order.

¹ ESTTA operates in real time and provides confirmation that the filing has been received via a tracking number. For assistance in using ESTTA, call 571-272-8500.