

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

am/wbc

Mailed: February 2, 2015

Opposition No. 91217630

Sturgis Motorcycle Rally, Inc.

v.

Hansen, Gary St. Martin

By the Trademark Trial and Appeal Board:

On November 21, 2014, applicant filed a renewed motion to amend its application; opposer contests the motion.¹ The Board has considered the parties' submissions and presumes the parties' familiarity with the factual bases for the motion, and does not recount them here except as necessary to explain the Board's decision.

By way of its motion, applicant seeks to amend its recitation of services by deleting "Custom imprinting of T-shirts; Custom imprinting of bumper sticker with decorative designs; Custom imprinting of slogan with messages; Imprinting

¹ Opposer, in its December 12, 2014 response to the motion, indicates it does not oppose the deletion of International Class 40 but does not consent to the addition of the proposed International Class 1.

Applicant filed a reply on January 9, 2015. A reply brief, if filed, shall be filed within 15 days (20 days if service was made by first class mail) from the date of service of the brief in response and will not be extended. *See* Trademark Rule 2.119(c), 2.127; *See McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013); *Ron Caldwell Jewelry, Inc. v. Clothestime Clothes, Inc.*, 63 USPQ2d 2009, 2010 (TTAB 2002); TBMP § 502.02 (2014). Because the reply was filed after 20 days after service of Opposer's December 12, 2014 response, it will receive no consideration.

messages on T-shirts; Imprinting messages on wearing apparel and mugs; Imprinting of decorative designs on T-shirts; Silk screen printing; T-shirt embroidering services” in International Class 40 and replacing that language with “bentonite” in International Class 1.

A proposed amendment, as noted in the Board’s November 19, 2014 order, to any application or registration which is the subject of an inter partes proceeding must also comply with all other applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP §§ 514.01 and 605.03(b) (2014). In particular, while an applicant may amend to clarify or limit the identification, **adding to or broadening the scope of the identification is not permitted** (emphasis added). *See* Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

Opposer argues that Applicant’s amendment is tantamount to an abandonment of its application and therefore, judgment should be entered against Applicant pursuant to Trademark Rule 2.135.

Having considered the parties’ arguments and submissions (except as otherwise noted), the Board finds that Applicant’s motion, is not an abandonment of its application, but an impermissible amendment. Specifically, Applicant seeks to amend its application to replace the current recitation of services with “bentonite.” “Bentonite” is beyond the scope of Applicant’s current recitation of services related to imprinting and embroidery services.

Inasmuch as “bentonite” is beyond the original scope of services, the motion to amend is **denied** without prejudice. The present recitation of services remains operative. *See* Trademark Rule 2.71(a); TMEP § 1402.07(d).

The parties’ submissions indicate that they are making efforts to settle this matter. In view thereof, proceedings remain suspended and the parties are allowed until **twenty days** from the mailing of this order to file a revised motion to amend, failing which the Board will resume proceedings and reset dates, as necessary, and the opposition will go forward on the present application.