

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wbc

Mailed: May 8, 2015

Opposition No. 91217630

Sturgis Motorcycle Rally, Inc.

v.

Hansen, Gary St. Martin

By the Trademark Trial and Appeal Board:

On May 5, 2015 the Board convened a telephone conference between the parties. Participating in the call were Applicant, Gary St. Martin Hansen, Opposer's attorneys Jason Sneed and Gina Iacona, and Board interlocutory attorney Wendy Boldt Cohen. This case comes now before the Board on Applicant's revised motion to amend its application filed in response to the Board's February 2, 2015 order; Opposer contests the motion.¹

The Board has considered the parties' submissions² 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.

¹ Opposer, in its March 10, 2015 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 15.

² Applicant filed its reply to the motion to amend on May 1, 2015. A reply brief, if filed, including a reply brief for a summary judgment motion, shall be filed within 15 days from the date of service of the brief in response to the motion (20 days if 37 CFR § 2.119(c) applies). The time for filing a reply brief will not be extended, even

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 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 “musical instruments: mechanical pianos and their accessories; musical boxes; and electrical and electronic musical instruments” in International Class 15.

As discussed with Applicant and as explained in the Board’s February 2, 2015 order, a proposed amendment 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.

upon the parties’ consent. *See* Trademark Rule 2.127(a) and 2.127(e)(1); *McDonald's Corp. v. Cambridge Overseas Development Inc.*, 106 USPQ2d 1339, 1340 (TTAB 2013). Insofar as Applicant’s reply was filed well over twenty days after Opposer’s response, Applicant’s reply will be given no consideration.

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.³ Specifically, Applicant seeks to amend its application to replace the current recitation of services with "musical instruments: mechanical pianos and their accessories; musical boxes; and electrical and electronic musical instruments." "Musical instruments: mechanical pianos and their accessories; musical boxes; and electrical and electronic musical instruments" is beyond the scope of Applicant's current recitation of services related to imprinting and embroidery services.

Inasmuch as the proposed amendment is beyond the original scope of services, the motion to amend is **denied** without prejudice. The present recitation of services remains operative.⁴ See Trademark Rule 2.71(a); TMEP § 1402.07(d).

From this point forward, and for the duration of the proceeding, the parties must obtain permission from the Board prior to filing any unconsented motion to amend Applicant's registration and/or Opposer's application. Additionally, during the call, the parties indicated that they plan to discuss settlement options

³ Indeed, Applicant argues that the instant motion "is [n]ot an [a]bandonment of [t]he Applicant's [a]pplication." *Motion to Amend*, ¶4.

⁴ Applicant is reminded that should he submit a suitable motion to amend, an unconsented motion to amend in substance is generally deferred until final decision or until the case is decided upon summary judgment. See *Enbridge Inc. v. Excelerate Energy L.P.*, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009). However, if the proposed amendment limits the identification of goods or services and the applicant consents to the entry of judgment on the question of, for example, a likelihood of confusion with the goods or services to be deleted, it may be approved, even where an opposer objects. See *Johnson & Johnson v. Stryker Corp.*, 109 USPQ2d 1077, 1080 (TTAB 2013).

and therefore, the Board suspends proceedings further until June 6, 2015, subject to the right of either party to request resumption at any time. *See* Trademark Rule 2.117(c).

If there is no word from either party concerning the progress of their negotiations, proceedings shall resume on June 7, 2015,⁵ without further notice or order from the Board, upon the schedule set out below:

Discovery Opens	6/7/2015
Initial Disclosures Due	7/7/2015
Expert Disclosures Due	11/4/2015
Discovery Closes	12/4/2015
Plaintiff's Pretrial Disclosures	1/18/2016
Plaintiff's 30-day Trial Period Ends	3/3/2016
Defendant's Pretrial Disclosures	3/18/2016
Defendant's 30-day Trial Period Ends	5/2/2016
Plaintiff's Rebuttal Disclosures	5/17/2016
Plaintiff's 15-day Rebuttal Period Ends	6/16/2016

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

⁵ The Board treats the filing of the motion to amend filed October 1, 2014 as tolling the dates herein. However, during the conference call, the parties indicated that the required discovery conference between the parties has already taken place. In view thereof, the Board does not reset the deadline for the discovery conference.