

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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mt/apb

Mailed: March 23, 2016

Opposition No. 91221061

*General Nutrition Investment Company*

*v.*

*8724709 Canada Inc.*

**By the Trademark Trial and Appeal Board:**

On January 14, 2016, Applicant filed a “voluntary amendment” to its **Application Serial No. 86151084** with the Trademark Examining Operation through TEAS. However, an application that is the subject of a Board *inter partes* proceeding may not be amended in substance, except with the consent of the other party and the approval of the Board, or upon motion granted by the Board. *See* Trademark Rule 2.133(a). Thus, a request to amend an application involved in a Board proceeding should be filed in the Board proceeding file and not in the application file.

Additionally, Applicant should note that every paper filed in the USPTO in *inter partes* cases must be served on the other party and be accompanied by proof of service. *See* Trademark Rule 2.119(a). The amendment does not indicate that it was served on Opposer. Nevertheless, in the interest of moving this matter forward, the Board has considered the filing.

By the proposed amendment, Applicant seeks to amend the identification of goods in International Class 5 **from** “Medicated skin care preparations; acne treatment preparations; pharmaceutical preparations for skin care, skin treatment, skin protection and skin health restoration; medicated skin preparations” **to** “Medicated skin care preparations for topical application to the skin, sold through medical and esthetic clinics; acne treatment preparations for topical application to the skin, sold through medical and esthetic clinics; and sun screen preparations for topical application to the skin, sold through medical and esthetic clinics.” Applicant also seeks to delete **International Class 3** in its entirety.

A deletion of an entire class in a multiple-class application during an opposition proceeding is treated as an abandonment of that class under Trademark Rule 2.135. Rule 2.135 provides that if, in an *inter partes* proceeding, the applicant files an abandonment without the written consent of every adverse party to the proceeding, judgment shall be entered against applicant. Thus, applicant’s amendment to delete International Class 3 from the application operates as an abandonment of the application as to that class.

In addition, although the proposed amendment of the application in International Class 5 is limiting in nature, and therefore in compliance with Trademark Rule 2.71(a), Opposer has not consented thereto. Where an unconsented motion to amend an application is filed in an *inter partes* proceeding before trial, the Board generally will defer determination until final decision.

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In view thereof, Applicant is allowed thirty days, to provide Opposer's consent to the proposed amendment. Proceedings are otherwise SUSPENDED.