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

MCF

Mailed: December 8, 2015

Opposition No. 91221256

Form & Matter LLC

v.

Matter and Form Inc.

By the Trademark Trial and Appeal Board:

On October 23, 2015, applicant filed a motion to "amend" its application Serial No. 86295070 seeking to delete the services in Classes 35 and 42, the only services opposed by the notice of opposition, and leaving only goods in Class 9. In response, Opposer argues Applicant did not obtain written consent to the proposed abandonment, and thus judgment should be entered against Applicant as to the services in Classes 35 and 42. In reply, Applicant argues that judgment in Opposer's favor at this point can only be entered on a motion for summary judgment.

In an opposition to an application having multiple classes, if the applicant files a request to amend the application to delete an opposed class in its entirety, the request for amendment is, in effect, an abandonment of the application with respect to that class, and is governed by Trademark Rule 2.135. A request for abandonment or withdrawal may not be subsequently withdrawn. Trademark Rule 2.68. *See also* TBMP § 602.01 (2015).

Trademark 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.[1]

In view thereof, and because Opposer's written consent to the abandonment of services in Classes 35 and 42 is not of record, judgment is hereby entered against applicant, the opposition is sustained and registration to applicant is refused as to Classes 35 and 42 only. The opposition is hereby dismissed with prejudice.

The application will proceed to issuance of a notice of allowance in regard to Class 9 only.

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[1] The Board notes Opposer has alleged grounds of priority and likelihood of confusion and that the signer of the application was not authorized to sign the application. Applicant's alleged failure to comply with Trademark Rules 2.33(a) or 2.193 is an ex parte matter that is not a proper ground for opposition. *See, e.g., Flash & Partners S.P.A. v. I.E. Mfg. LLC*, 95 USPQ2d 1813, 1816-17 (TTAB 2010)(examing attorney's determination regarding amended drawing is ex parte matter and does not raise issue of lack of bona fide intent); *Century 21 Real Estate Corp. v. Century Life of Am.*, 10 USPQ2d 2034, 2035 (TTAB 1989)(examining attorney's determination regarding sufficiency of specimens is ex parte matter that cannot form basis of claim); and TBMP § 309.03(c) [Note 2] (2015). To the extent Opposer sought to allege dilution as a ground, Opposer has not properly pleaded such a claim as it requires an allegation as to when the claimant's mark became famous, which does not appear in the notice of opposition. *See Trek Bicycle Corp. v. StyleTrek Ltd.*, 64 USPQ2d 1540, 1542 (TTAB 2001); *see also Demon Int'l v. Lynch*, 86 USPQ2d 1058, 1059-60 (TTAB 2008) (dismissing dilution claim as improperly pled because it did not include allegation that opposer's mark is famous). As such, priority and likelihood of confusion is the only valid ground in the notice of opposition on which judgment may be entered.