

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

MW/Am

Mailed: April 18, 2016

Opposition No. 91225007

NeverWet LLC

v.

Neil Delves and Kevin Giufre

Michael Webster, Interlocutory Attorney:

On March 23, 2016, Applicant filed a proposed amendment to its application Serial No. 86376134, with Opposer's consent.

By the proposed amendment Applicant seeks to amend the identification of goods as follows:¹

From:

Waterproofing of basements; Waterproofing of basements to prepare them to be finished

To:

Waterproofing of basements; Waterproofing of basements to prepare them to be finished; all of the foregoing limited to professional service involving the construction and installation of internal and external draining systems

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

¹ Underlined wording represents proposed wording to be added to the identification of services.

statutory provisions, including Trademark Rules 2.71-2.75. *See* TBMP §§ 514.01 and 605.03(b). 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. *See* Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

The proposed amendment is unacceptable inasmuch as the wording identifies a materially different service from the original service as opposed to limiting the original services. Specifically, the wording “professional service involving the construction and installation of internal and external draining systems” in the proposed amendment is beyond the scope of the present identification because it identifies the construction and installation of pipes and training systems. However, the wording “waterproofing of basements” is limited to a service involving “the application of some kind of layer or coating to a surface.”² Consequently, Applicant’s proposed amended wording materially changes the nature of the service from the application of a surface coating to the construction or installation of a product.

Therefore, the Board cannot accept the proposed amendment to the identification of services and WILL NOT ENTER the amendment.

Applicant also seeks to amend the description of the mark as follows:

From:

NEVERWET BASEMENT WATERPROOFING

² *See* the “Notes” for the service “basement waterproofing” in the Acceptable Identification of Goods and Services Manual Next Generation on the USPTO’s website at: <https://tmidm.uspto.gov/id-master-list-public.html>.

The mark consists of the word "NEVERWET" above "BASEMENT WATERPROOFING". "NEVERWET" is in all caps and outlined in a thick, black line with a white fill for "NEVER" and a light blue fill for "WET" with a black-lined red strike-out line crossing from the top left of "WET" down to the bottom right. Above "WET" is a stylized roof with a thick black outline, a chimney outline on the right and a white fill. "BASEMENT WATERPROOFING" is in a smaller, red text with a capital "B"

To:

NEVER WET BASEMENT WATERPROOFING

The mark consists of the words "NEVER WET" above "BASEMENT WATERPROOFING". "NEVER WET" is in all-caps and outlined in a thick, black line with a white fill for "NEVER" and a light blue fill for "WET" with a blacklined red strike-out line crossing from the top left of "WET" down to the bottom right. Above "WET" is a stylized roof with a thick black outline, a chimney outline on the right and a white fill. "BASEMENT WATERPROOFING" is in a smaller, red text with a capital "B".

Inasmuch as the proposed change to the description of the mark does not constitute an impermissible material alteration to the mark, it is approved and ENTERED. *See* Trademark Rule 2.133(a).

In view of the findings above, the motion to amend the identification of services is **DENIED** without prejudice. The present identification of services, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of future amendment. *See* Trademark Rule 2.71(a); TMEP §1402.07(d). The motion to amend the description of the mark is **GRANTED**.

Inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are **SUSPENDED**, and the parties are allowed until THIRTY (30) DAYS from the mailing date of this order to file a revised motion to amend, failing which the Board will resume

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proceedings and reset dates, and the opposition will go forward on the present identification.

If no response is filed, proceedings will be resumed and dates reset, as appropriate.

Proceedings are otherwise SUSPENDED.