

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

DUNN
Mailed: March 14, 2006

Opposition No. 91161375

BFS Diversified Products,
LLC

v.

Kimberton Enterprises, Inc.

Elizabeth A. Dunn, Attorney:

On January 18, 2006, applicant filed a proposed amendment, with opposer's consent, to its application Serial No. 76513202.

By its proposed amendment, applicant seeks to change the wording RUBBERKOTE to HENRY RUBBERKOTE, and such an amendment may only be accepted if it does not comprise a material alteration of the mark. The test for determining whether an amendment is a material alteration is as follows:

The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for

purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark appropriate for a new application.

In re Hacot-Colombier, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983). In the instant case, the proposed amendment adds a separate arbitrary term, and thus impermissibly changes the mark to create a different commercial impression. Accordingly, applicant's proposed amendment to its mark is a material alteration of the mark, and the proposed amendment is denied.

In the event that there is no word from either party concerning the progress of their negotiations, upon conclusion of the suspension period, proceedings shall resume without further notice or order from the Board, upon the schedule set out below.

Applicant is allowed THIRTY DAYS from resumption in which to answer the notice of opposition. The parties are allowed the same THIRTY DAYS in which to serve responses to any outstanding discovery requests. Trial dates, including the close of discovery, are reset as follows:

Proceedings resume:	July 5, 2006
Discovery period to close:	October 3, 2006
Thirty-day testimony period for party in position of plaintiff to close:	January 1, 2007
Thirty-day testimony period for party in position of defendant to close:	March 2, 2007
Fifteen-day rebuttal testimony period to close:	April 16, 2007

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.

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed.
