

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

Mailed: April 7, 2006

Opposition No. 91164559

Bayer HealthCare LLC

v.

PeriodonTx Laboratories,  
Inc.

**David Mermelstein, Attorney:**

On March 27, 2005, applicant filed - with the consent of opposer<sup>1</sup> - a motion to amend the mark in the subject application. Applicant seeks to amend its mark from **BREATHSTX** to **Breath's>>Tx**. In the alternative, applicant seeks to amend the mark as above and also to amend its application to assert a Trademark Act § 1(b) filing basis.<sup>2</sup>

Applicant's amendment is refused because it would materially alter the mark as applied for.

Applicant's proposed amendment adds a non-literal element to the mark ">>", changing the visual appearance of

---

<sup>1</sup> This application is also subject to Opposition No. 91163107, filed by Discus Dental Impressions, Inc. Applicant has submitted the consent of both Bayer (opposer in this case) and Discus to the amendment.

<sup>2</sup> Although applicant does not discuss the reason for its alternative motion, we presume that applicant proposed its § 1(b) amendment in the event that the amended mark was deemed not to be a substantially exact representation of the mark as used on the specimens of record. See Trademark Rule 2.51(a); 2.72(a)(1). As will be seen, however, we need not reach this question.

**Opposition No. 91164559**

the mark. Such elements in the drawing would normally be searched during examination and the amendment here would require a new search. Moreover, the amendment would alter the connotation and pronunciation of the applied-for mark. Applicant's current would likely be pronounced as "breath sticks," while the amended mark would likely be pronounced "breath's ticks." On the whole, applicant's proposed amendment would materially alter the character of the mark, and would require a new search and republication. As such, the amendment is not permissible. *In re Hacot-Colombier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997). *See also*, TMEP § 807.14 (and authorities cited therein).

Proceedings remain suspended pursuant to the Board's order of March 27, 2006.

.oOo.