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

Mailed: April 15, 2008

Opposition No. 91181678

Varsity Brands, Inc.

v.

Exist, Inc

Brian D. Brown, Interlocutory Attorney

This case comes before the Board for consideration of applicant's communication submitted on March 12, 2008 and captioned as "Notice of Intent to File Disclaimer" in application Serial No. 77048490. In the submission, applicant indicates that it intends to disclaim the wording VARSITY APPAREL apart from its mark. On March 27, 2008, however, opposer submitted a response to applicant's "notice," expressing its opposition to entry of the disclaimer.¹

Assuming that by the proposed amendment applicant seeks to add a disclaimer to the application and in light of opposer's objection thereto, the Board has decided to treat

¹ It does not appear that applicant's submission, e-mailed to counsel for opposer on March 12, 2008, was properly served. Under Trademark Rule 2.119(c), service by electronic transmission may only occur "when mutually agreed upon by the parties." However, there appears to have been no agreement between the parties on the manner of service. Therefore, applicant is reminded that strict compliance with Trademark Rule 2.119 and all other pertinent rules is required for all future submissions filed with the Board.

applicant's communication as a contested matter and defers entry of the disclaimer for the following reason.

An application which is the subject of a Board inter partes proceeding may not be amended in substance, except with the consent of the other party or parties and the approval of the Board, or except upon motion granted by the Board. See *Giant Food Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626 (TTAB 1986). In this case, applicant has unilaterally filed its paper, and according to the record, opposer has not consented to the amendment orally or in writing. In fact, in its March 27, 2008 filing, opposer expressed its opposition to the disclaimer and requested that the Board deny entry of the disclaimer.

Insofar as the amendment was submitted without opposer's consent, the Board hereby defers determination of applicant's proposed disclaimer until final decision or until the case is decided upon summary judgment. See Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 514.03 and cases cited therein (2nd ed. rev. 2004).

Dates, including the close of discovery, remain as set in the Board's institution order.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint

of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>