

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

am

Mailed: June 4, 2009

Opposition No. 91183857

PREMIUM DENIM, LLC

v.

HAMILTON, PAIGE

Frances S. Wolfson, Interlocutory Attorney:

On May 11, 2009 applicant filed a motion to divide and a proposed amendment to its application Serial No. 77159559. Opposer filed a response to applicant's motion, objecting to division and the amendment.¹

Applicant's application presently covers classes 9, 18 and 25. Applicant seeks to divide the application into two applications: one covering all goods in class 9 and some of the goods in class 18 (specifically, "men's and women's accessories, namely, handbags, purses, pocketbooks,

¹ Although applicant's time to file a reply brief has not yet passed, the Board exercises its inherent authority to schedule the disposition of cases on its docket by deciding the motions at this time. See *Carrini Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000); *Luemme Inc. v. D.B. Plus Inc.*, 53 USPQ2d 1758 (TTAB 1999).

wallets, wristlets, tote bags, beach bags, travel bags, cosmetic bags sold empty, coin purses, luggage, backpacks, messenger bags.)” The other application would cover the remaining goods in class 18 (specifically, “suitcases, garment bags for travel, pet carriers, and umbrellas”) and all of the goods in class 25.

In addition, applicant seeks to amend the filing basis of the application covering class 25 and “suitcases, garment bags for travel, pet carriers, and umbrellas” from Section 1(a) to Section 1(b) of the Trademark Act. The identification of goods of that application would change pursuant to the amendment by deleting “jeans” from the goods in class 25.

Amendment Without Consent

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 and the approval of the Board, or except upon motion granted by the Board. See Trademark Rule 2.133.

The Board generally will defer determination of a pre-trial unconsented motion to amend, in substance, an application which is the subject of a Board inter partes proceeding until final decision, or until the case is

decided upon summary judgment. See TBMP § 514.03 and authorities cited in that section.

However, the Board, in its discretion, may grant a motion to amend an application which is the subject of an inter partes proceeding, even if the other party does not consent thereto. See TBMP § 514.03 (2d ed. rev. 2004).

Motion to Divide

The motion to divide is granted. Division is a ministerial function that does not affect either parties' rights in the opposition. Moreover, it is not considered a substantive amendment. Accordingly, decision on the motion to divide need not be deferred. See Trademark Rule 2.133(a).

Motion to Amend Filing Basis

Likewise, amendment of the application to change its filing basis is not considered an amendment in substance.

Any proposed amendment, however, must also comply with all applicable rules and statutory provisions. See TBMP § 514.01 (2d. rev. 2004). In an application under Section 1(b) of the Act, the applicant must verify that it has a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application. If the verification is not filed with the initial application, it must allege that the applicant had

a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application. See Trademark Rule 2.34(a)(2).

Applicant did not submit a verification either with its initial application or in connection with its request to amend its application. Accordingly, decision on the request to amend the filing basis is hereby deferred and applicant is allowed until TWENTY DAYS from the mailing date of this order to file the requisite statement, failing which the proposed amendment will be denied.

Motion to Delete "Jeans"

The motion to delete "jeans" from the identification of goods in the class 25 application is substantive in nature.

Accordingly, decision on applicant's motion to amend the application to delete "jeans" is hereby deferred until final hearing or motion for summary judgment. See Trademark Rule 2.133(a).

Trial Schedule

Applicant's request to divide having been granted, the application file is hereby forwarded to the Intent to Use Branch of the Office for action on the request to divide.

Proceedings are otherwise herein suspended. Although notification of the division of the application is normally made through Office channels, upon completion thereof, the interested party should so notify the Board so that proceedings herein may be resumed.

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