

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

Winter/mt

Mailed: December 17, 2009

Opposition No. 91192567

The Republic of Colombia and
Federacion Nacional de
Cafeteros de Colombia

v.

Counter Culture Coffee, Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On November 19, 2009, applicant filed a proposed amendment to its application Serial No. 77699604, with opposer's written consent thereto.

By the proposed amendment, applicant seeks to change the mark **from:** "LA GOLONDRINA CAFÉ DE COLOMBIA PRODUCED EXCLUSIVELY FOR COUNTER CULTURE COFFEE (and flying swallow design)" **to:** "LA GOLONDRINA (and flying swallow design)."¹ In support of the proposed amendment, applicant has provided a

¹ The Board notes that the proposed amendment did not include proof of service upon opposing counsel as required by Trademark Rule 2.119(a), 37 C.F.R. § 2.119(a). Nonetheless, in view of opposers' consent to the proposed amendment and to expedite this proceeding, *a copy of applicant's submission will be forwarded to opposer's counsel with a copy of this order.*

Applicant is reminded of its obligation to send a service copy of any paper filed in an *inter partes* proceeding to the adverse party, and to include proof of service when the paper is filed with the Board. *Id.* See also TBMP § 113 (2d ed. rev. 2004). Strict compliance with Trademark Rule 2.119, 37 C.F.R. § 2.119,

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revised drawing page and, further, explains that the purpose of the proposed amendment is to alleviate opposers' concern that the designation COLOMBIA in applicant's mark is "virtually identical to the COLOMBIAN certification mark" owned by opposers.

The amendment to the involved application is denied because the proposed removal of the wording, which is comprised in part applicant's registered mark "COUNTER CULTURE COFFEE," would constitute an impermissible material alteration of the mark under Trademark Rule 2.72, 37 C.F.R. § 2.72. *See, e.g., In re Wine Society of America Inc.*, 12 USPQ2d 1139 (TTAB 1989) (proposed amendment to replace typed drawing of "THE WINE SOCIETY OF AMERICA" with a special form drawing including those words with a crown design and a banner design bearing the words "IN VINO VERITAS" held to be a material alteration); *In re Nationwide Industries Inc.*, 6 USPQ2d 1882 (TTAB 1988) (addition of house mark "SNAP" to product mark "RUST BUSTER" held a material alteration); *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986) (addition of house mark "PIERCE" to "CHIK'N-BAKE" held a material alteration). *See also Trademark Manual of Examining Procedure* (TMEP) § 807.14 (6th ed. 2009).²

is required by applicant in all future papers filed with the Board.

² Additionally, even if the proposed amendment were acceptable, because the involved application is based on Section 1(a) (use of the mark), the application (as amended) must include a specimen

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Trial dates remain as set forth in the Board's order mailed December 9, 2009.



that shows use of the mark as shown in the revised drawing. Applicant has not submitted a new specimen of use supported by an affidavit or declaration stating that the mark has been in use in commerce with the described goods since the filing date of the application and amending the dates of first use (if applicable), nor has applicant sought to amend the application to seek registration under Section 1(b) of the Trademark Act. See Trademark Rules 2.20, 2.35(b)(3), 2.59(a) and 2.72(a)(1), 37 C.F.R. §§ 2.20, 2.35(b)(3), 2.59(a) and 2.72(a)(1); and TMEP §§ 806.03, 903.04 and 904.05 (6th ed. 2009).