

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

vb

Mailed: April 4, 2012

Opposition No. 91204026

Free Spirit Publishing Inc.

v.

Robert L. Styles

**M. Catherine Faint,  
Interlocutory Attorney:**

On March 28, 2012, applicant filed a proposed amendment to its application Serial No. 85293572 with opposer's consent.<sup>1</sup>

By the proposed amendment, applicant seeks to amend the description of its mark from:

**"The mark consists of the word "A Bully Free World."**

to:

**"The mark consists of the word "A World Without Bullying".**

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<sup>1</sup> Applicant's March 28<sup>th</sup> filing fails to indicate proof of service on opposer as required by Trademark Rule 2.119. In order to expedite this matter, opposer is directed to the following URL where it may view a copy of the filing:  
<http://ttabvueint.uspto.gov/ttabvue/v?pno=91204026&pty=OPP&eno=9>

Strict compliance with Trademark Rule 2.119 is required by applicant in all future papers filed with the Board.

Trademark Rule 2.72 prohibits any amendment of the mark in an application under § 1 of the Trademark Act that materially alters the mark on the drawing filed with the original application. A material alteration exists if the old and new formats do not create the same general commercial impression. See J. Thomas McCarthy, 3 *McCarthy on Trademarks and Unfair Competition* §§ 19:58:50 and 19:133 (WESTLAW Update 2011).

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) (emphasis in original), quoting *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740, 743-44 (TTAB 1983); see also TMEP § 807.14 (8<sup>th</sup> ed. 2011).

By its amendment, applicant seeks to delete the word "FREE" add the word "WITHOUT" that was not there previously, change the word "BULLY" to "BULLYING" and rearrange the entire phrase. The amendments would require an additional

search of the mark during examination. Such an addition creates the impression of a new mark, and is a material alteration.

Accordingly, applicant's motion to amend the drawing is denied without prejudice. These proceedings are suspended, and the parties are allowed **SIXTY DAYS** from the mailing date of this order to submit an amended drawing that conforms with the rules, or otherwise continue their settlement negotiations.

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