

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

Mailed: May 22, 2012

Opposition No. 91204026

Free Spirit Publishing Inc.

v.

Robert L. Styles

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

On May 8, 2012, applicant filed a proposed amendment to its application Serial No. 85293572, referring to a settlement agreement between the parties.<sup>1</sup> A copy of the settlement agreement, signed by both parties, was not provided to the Board.

By the proposed amendment, applicant seeks to amend the mark from "A Bully Free World" to "A World Free Of Bullying".

Applicant also proposed to amend the identification of goods from "Rubber or silicon wristbands in the nature of a bracelet" to "Wrist-bands".

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<sup>1</sup> Although applicant indicates that "a copy of this letter has been forwarded via e-mail to Plaintiff's attorney, the 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=6>.

For the same reasons noted in the Board's prior order of April 4, 2012, the proposed amendment to the drawing is unacceptable.

Likewise the proposed amendment to the identification of goods would be unacceptable as it broadens the identification currently in place. Trademark Act Section 7(c), 15 U.S.C. § 1057(c), provides that the filing of any application for registration on the Principal Register establishes constructive use and nationwide priority contingent on issuance of the registration. Therefore, the identification of goods and services in an application defines the scope of those rights established by the filing of an application for the Principal Register. While an application may be amended to clarify or limit the identification, additions to the identification are not permitted. 37 C.F.R. § 2.71(a); TMEP §§ 804.09 and 804.09(a).

Accordingly, applicant's motion to amend is denied.

In the alternative, applicant requested that its application Serial No. 85293572 be abandoned. It is not clear from applicant's motion whether this abandonment is with opposer's consent, and opposer's written consent was not submitted with the withdrawal of the application.

In view thereof, applicant is allowed **THIRTY DAYS** from the mailing date of this order to provide opposer's written

consent, failing which judgment with prejudice will be entered against applicant, the opposition will be sustained and the application will be abandoned.

Proceedings otherwise remain suspended.

**NATURE OF BOARD PROCEEDINGS**

Applicant is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

**REQUIREMENT FOR SERVICE OF PAPERS**

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every

paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding, including applicant's answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. See also TBMP §113 (2d ed. rev. 2004).

**OPTION OF E-MAIL SERVICE**

The parties may agree to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic transmission when mutually agreed upon by the parties.").<sup>2</sup> Should the parties decide to continue using traditional service options, the parties may consider agreeing at least to courtesy email notification when any paper is served.

**THE BOARD'S STANDARDIZED PROTECTIVE ORDER IS IN PLACE**

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may substitute a stipulated protective agreement (signed by both parties). However, the Board will not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

**REPRESENTATION**

The Board notes applicant is representing himself. Applicant may do so. However, it should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to

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<sup>2</sup> The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First Class Mail) is not available for email service.

secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure.

**ELECTRONIC RESOURCES**

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, [www.uspto.gov](http://www.uspto.gov). The TTAB homepage provides electronic access to the Board's standardized protective order, a chart of the new rules and the text of the new rules (effective August 31, 2007 and November 1, 2007), and answers to frequently asked questions. Other useful databases include the ESTTA filing system<sup>3</sup> for Board filings and TTABVUE for status and prosecution history.

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<sup>3</sup> Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

**Certificate of Mailing**

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

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

The Board's records are public records. Thus, applicant may use the TTABVUE database to view other cases to get an idea of the course of Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

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The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.  
The certificate of mailing must be signed and dated.