

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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EJW

Mailed: August 31, 2016

Opposition No. 91226857

Tao Licensing LLC

v.

POA Group LLC

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

By way of background, on May 19, 2016, Applicant filed a motion to amend the involved application with respect to the identification of services and its underlying filing basis. Noting that Opposer had not consented to the proposed amendments, the Board, in its order mailed June 6, 2016, deferred consideration of the proposed amendments, stating that they would not be considered until final decision or until summary judgment (11 TTABVUE 2).¹

This case now comes up for consideration of Applicant's second motion (filed June 24, 2016) to amend its application. The motion is fully briefed.

Applicant again seeks to amend the identification of services and to amend the basis of the involved application from Section 1(a) to Section 1(b) of the Trademark

¹ The Board notes that Opposer filed an opposition to Applicant's proposed amendment on the same date that the Board's June 6, 2016 order was mailed, and that Applicant filed a reply brief thereto. Inasmuch as Applicant has replaced its first motion with its second motion (filed June 24, 2016), Applicant's motion to amend filed on May 19, 2016, is moot, as are Opposer's first opposition and Applicant's reply brief thereto.

Act. In particular, Applicant seeks to amend its services by deleting the wording that has been lined through below and adding the wording shown in bold type font:

- ~~Advice in the running of establishments as franchises; Assistance in business management and product commercialization, within the framework of a franchise contract; Assistance in franchised commercial business management; Association services, namely, promoting diversity in the restaurant and hotel industries on behalf of employees, vendors, management, and owners; Business management advisory services relating to franchising; Franchise services, namely, offering business management assistance in the establishment and operation of restaurant; Franchising, namely, consultation and assistance in business management, organization and promotion; Franchising, namely, offering business management assistance in the establishment and/or operation of restaurant; Marketing advisory services in the field of restaurant; Marketing services in the field of restaurant; Offering business management assistance in the establishment and/or operation of restaurants; On-line business directories featuring restaurant; On-line ordering services in the field of restaurant take-out and delivery; Promotional services, namely, promoting the goods of others by means of providing online restaurant menus; Providing a website featuring the ratings, reviews and recommendations posted by consumers on restaurants, food and wine for commercial purposes; Providing on-line consumer information concerning the location of mobile restaurants; Restaurant franchising, namely, offering business management assistance in the establishment and/or operation of restaurants; Restaurant management for others (International Class 35).~~
- Franchising services, namely, providing financial information and advice regarding the establishment and/or operation of restaurants (International Class 36).
- Bar and restaurant services; ~~Cafeteria and restaurant services; Café and restaurant services; Café restaurants; Catering services; Consulting in the field of restaurant menu development; Delicatessen services; Doughnut shops in the nature of a restaurant; Fast food restaurant services; Fast food restaurants; Fast food restaurants and snackbars; Frozen yogurt shop services in the nature of a restaurant; Hotel and restaurant services; Hotel, bar and restaurant services; Hotel, motel, restaurant, bar and catering services; Hotel, restaurant and bar services; Hotel, restaurant and catering services; Ice cream shop services in the nature of a restaurant; Making reservations and bookings for restaurants and meals; Mobile restaurant services; Providing progressive dinner events where participants sample meals and drinks at a series of restaurants; Providing reviews of restaurants; Providing reviews of restaurants and bars; Provision of food and drink in restaurants; Reservation~~

~~of restaurants; Restaurant; Restaurant and bar information services; Restaurant and bar services; Restaurant and bar services, including restaurant carryout services; Restaurant and café services; Restaurant and catering services; Restaurant and hotel services; Restaurant information services; Restaurant reservation services; Restaurant services; Restaurant services featuring sandwiches; Restaurant services featuring Asian fusion fare; Restaurant services, including sit-down service of food and take-out restaurant services; Restaurant services, namely, providing of food and beverages for consumption on and off the premises; Restaurant, bar and catering services; Restaurants; Restaurants featuring home delivery; Salad bars; Self-service restaurants; Take-out restaurant services (International Class 43).~~

Applicant does not provide any basis for the Board to grant its motion.² Opposer, in response, argues that Applicant has not given a reason for its requested amendments, nor has it stated that it would accept judgment with respect to the deleted services. Opposer states emphatically that it does not consent to the proposed amendments, and requests that the Board deny Applicant's second motion to amend. In reply, Applicant requests that the Board defer consideration of its second motion to amend, rather than denying said motion.

- *Decision*

An application that is the subject of an opposition may not be amended in substance, except with the consent of the other party or parties and the approval of the Trademark Trial and Appeal Board, or upon motion granted by the Board. *See* Trademark Rule 2.133(a). Further, the Board generally defers determination of a pre-trial, unconsented motion to amend the involved application in substance until final decision or until the case is decided upon summary judgment. *See, e.g., Enbridge Inc.*

² Applicant explains that it has only modified its declaration; otherwise, its proposed amendments are identical to its first motion to amend.

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v. Excelerate Energy Ltd. Partnership, 92 USPQ2d 1537, 1539 n.3 (TTAB 2009) (motion to amend identification of goods and dates of use deferred until final hearing); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (motion to amend identification of goods deferred). *See* TBMP § 514.03 (2016). In view of the foregoing, entry of the proposed amendment is **deferred**.

Trial dates remain as set in the Board's order mailed on April 21, 2016.

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