

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

February 15, 2019

Opposition No. 91242787

*U.S. News & World Report, Inc. and
U.S. News & World Report, L.P.*

v.

Henry Madison Research Inc.

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

On October 5, 2018, Applicant filed the parties' stipulated proposed amendment to subject application Serial No. 87746253, and Opposer's withdrawal without prejudice of the opposition contingent upon entry of the amendment, specifically, to amend the involved mark from standard character form to a particular stylized form. By the proposed amendment, Applicant seeks to amend the mark as published, namely, U.S. & WORLD EARLY WARNING REPORT, to the following:¹

U.S. & World **Early Warning Report**

¹ On February 15, 2019, the parties' counsel confirmed by telephone conference with the assigned Interlocutory Attorney that the substitute mark does not include the black line shown below said mark on the motion to amend.

The Board finds that the proposed amendment to the applied-for mark does not materially alter the mark as published. *See* Trademark Rule 2.72(a)(2). However, for the following reasons, the Board is not able to approve the proposed amendment.

1. **The specimen of use filed with the application does not support the proposed amendment.** *See* Trademark Rules 2.51(a) and 2.72(a)(1); *see also* TMEP § 807.13(a) (Oct. 2018) (“the mark in an application under §1(a) of the Trademark Act can be amended if the specimen supports the amendment and the amendment does not materially alter the mark”). Specifically, the mark shown in the motion to amend is not a substantially exact representation of the mark used in connection with the goods, shown immediately below, and Applicant did not submit a substitute specimen of use.

Mark shown on specimen of use of record:

*U.S. & World
Early Warning Report*

Proposed mark:

U.S. & World **Early Warning Report**

In view thereof, Applicant must submit (i) an amended drawing page showing the mark shown in the specimen of use submitted with the application, or (ii) a substitute specimen of use showing use of the mark as proposed to be amended. Second, if Applicant submits a substitute specimen of use, in order to retain the Section 1(a) basis of the application and to avoid republication of the mark (because of a change

in filing basis) and in support of any substitute specimen of use, Applicant must submit a verification or declaration under Trademark Rule 2.20,² which sets forth (i) the amended date of use anywhere and date of first use in commerce³ of the amended mark with the identified goods, as necessary, and (ii) a statement that the substitute specimen of use is in use in commerce and was in use in commerce **prior to the filing date of the application**. Specifically, the declaration must set forth any amended dates of use and must state that “the substitute specimen is in use in commerce and was in use in commerce at least as early as the application filing date.” *See* Trademark Rules 2.59(a) and 2.72(a)(1), 37 C.F.R. §§ 2.59(a) and 2.72(a)(1); and TMEP §§ 903.04 and 904.05.

Alternatively, if Applicant cannot provide an acceptable substitute specimen of showing use of the amended mark, which specimen was used before the filing date of the application and which can be supported by an affidavit or declaration of use in commerce as described above, Applicant may amend the filing basis for the involved application to Section 1(b) of the Trademark Act (“intent to use”). *See* Trademark Rules 2.35(b)(2) and 2.133(a), 37 C.F.R. §§ 2.35(b)(2) and 2.133(a); *see also* Trademark Rules 2.59(b) and 2.72(b), 37 C.F.R. §§ 2.59(b) and 2.72(b); TMEP §§ 806.03 *et seq.* regarding amendments to the basis. Should Applicant amend the application to one

² The affidavit or declaration must be signed by someone properly authorized to sign on behalf of the applicant under Trademark Rule 2.33(a), 37 C.F.R. § 2.33(a). *See* TMEP §§ 611.03(a) and 903.04.

³ In an application under Section 1(a) of the Act, applicant may not amend the application to specify a date of use that is later than the filing date of the application. Trademark Rule 2.71(c), 37 C.F.R. § 2.71(c)(1).

that seeks registration under Section 1(b), Applicant must submit a verified statement that it has a *bona fide* intention to use the mark in commerce on or in connection with the identified goods, **and** that Applicant had a *bona fide* intention to use the mark in commerce on or in connection with the goods as of the filing date of the application. *See* 15 U.S.C. § 1051(b)(3)(B); Trademark Rules 2.34(a)(2) and 2.35(b)(3), 37 C.F.R. §§ 2.34(a)(2) and 2.35(b)(3). Applicant is also advised that if it amends the application to seek registration under Section 1(b) of the Trademark Act, the application must be republished.⁴

2. Applicant did not provide a **separate drawing page** for the amended mark. While a mark embedded in a document may sometimes be acceptable, the mark embedded in Applicant's motion is not acceptable because it is not presented in a clear resolution and will not reproduce clearly.

3. Applicant did not submit a **description of the mark** as required under Trademark Rules 2.37 and 2.52(b)(5). Additionally, the mark set forth in the motion to amend appears to be shown in the color "blue." The application must be amended to include a description of the mark and, if applicable, a statement that color is (or is not) a feature of the mark. *See* Trademark Rule 2.52(b)(1); TMEP § 807.07.

In view of the foregoing, the proposed amendment to the applied-for mark is **denied without prejudice**. Applicant is allowed until **THIRTY (30) DAYS** from

⁴ Once the application is properly amended to seek registration under Section 1(b) (and the amendment to the mark is allowed), this proceeding will be terminated without prejudice to Opposer and the mark will be republished. In general, if no other party opposes Applicant's republished application comprising the amended mark, a notice of allowance may issue, Applicant may ultimately file a statement of use, and the application may proceed to registration.

the mailing date of this order in which to submit (1) a separate drawing of the proposed amended mark or a separate drawing of the mark shown in the specimen of record; (2) a description of the mark (with or without reference to the color blue); (3) a color statement, if applicable; and (4) if the proposed mark is retained, a substitute specimen of use, which was in use prior to the filing date of the application, along with a declaration in support of the substitute specimen of use. Alternatively to (4), Applicant must submit an amendment to seek registration under Section 1(b) of the Trademark Act and a proper declaration in support thereof.

In view of the foregoing, consideration of the withdrawal of the opposition is **DEFERRED**.

Proceedings are otherwise **SUSPENDED**.

