

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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am/KGC/wbc

October 5, 2021

Opposition No. 91255656

*UnitedHealth Group Incorporated*

*v.*

*Blue Cross and Blue Shield Association*

**Wendy Boldt Cohen, Interlocutory Attorney:**

Proceedings have been suspended pending disposition of a civil action between the parties, which Opposer indicates was dismissed on June 16, 2021. 10 TTABVUE 2.

On June 30, 2021, Applicant filed a proposed amendment to application Serial No. 88286385, with Opposer's consent, and Opposer's withdrawal with prejudice of the opposition, contingent upon entry of the amendment. 11 TTABVUE.

By the proposed amendment, Applicant seeks to amend the drawing of the mark from



to



Applicant also seeks to amend the mark description as follows:

from

The mark consists of a suitcase with the letters “HPN” superimposed upon it.

to

The mark consists of a suitcase with the term “HPN” superimposed upon it and “Blue” appearing above “HPN” in the suitcase design.

A proposed amendment to any application which is the subject of an inter partes proceeding is governed by Trademark Rule 2.133, and must also comply with all applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. *See* TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE §§ 514.01 and 605.03(b) (2021). An applicant may amend the drawing of the mark only if the proposed amendment does not materially alter the mark. *See* Trademark Rules 2.72(a)(2) and (b)(2). The Office will determine whether a proposed amendment materially alters a mark by comparing the proposed amendment with the drawing of the mark filed with the original application. *Id.* The controlling question is always whether the old and new forms of the mark create essentially the same commercial impression. *See Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, S.L.U.*, 797 F.3d 1363, 116 USPQ2d 1129, 1132 n.1 (Fed. Cir. 2015).

The proposed amendment is unacceptable inasmuch as it materially alters the mark. Specifically, the proposed amendment materially alters the mark because it includes the added wording BLUE, which appears to be distinctive in the context of the identified services. Accordingly, the Board cannot accept or enter the proposed amendment.

In view of these findings, the motion to amend is denied without prejudice. The present drawing, that is, the drawing prior to the filing of the motion to amend, remains operative for purposes of future amendment.

Inasmuch as the filing of the proposed amendment indicates to the Board that the parties are making efforts to settle this matter, proceedings are suspended, and the parties are allowed until thirty days from the date of this order to file a revised motion to amend, failing which the Board will resume proceedings and reset dates, and the opposition will go forward on the present application.