

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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MW/VV

February 8, 2021

Opposition No. 91264230

Genesco Brands LLC

v.

FAST IP, LLC

By the Trademark Trial and Appeal Board:

On January 27, 2021, Applicant filed the parties' stipulation with Applicant's proposed amendment to its involved application Serial No. 88734027, and Opposer's withdrawal without prejudice of the opposition, contingent upon entry of the amendment. 12 TTABVUE.

By the proposed amendment, Applicant seeks to amend the identification of goods and service in International Classes 25 and 35 of the subject application as follows:¹

International Class 25

From: Footwear, namely, athleisure shoes, sneakers, sandals, casual shoes, dress shoes

To: Footwear, namely, athleisure shoes, sneakers, sandals, casual shoes, dress shoes, **all the foregoing incorporating hands-free footwear technologies.**

¹ Proposed additions to the identification of goods and services set forth in bold font.

International Class 35

From: Marketing, advertising and promoting public awareness of technology relating to footwear

To: Marketing, advertising and promoting public awareness of technology relating to **hands-free** footwear.

A proposed amendment to any application or registration which is the subject of an *inter partes* proceeding must also comply with all other applicable rules and statutory provisions, including Trademark Rules 2.71-2.75. See TBMP §§ 514.01 and 605.03(b). In particular, while an applicant may amend to clarify or limit the identification, adding to or broadening the scope of the identification is not permitted. See Trademark Rule 2.71(a); TMEP §§1402.06 *et seq.*, 1402.07.

In addition, under the guidelines of the TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP), it is inappropriate to use a registered mark to identify a kind of product or a service because the mark indicates origin and cannot be used to define goods or services that originate in another party other than the registrant. TMEP § 1402.09 (October 2018); *see also Camloc Fastener Corp. v. Grant*, 119 USPQ 264, 265 n.1 (TTAB 1958).

Here, the proposed amendment cannot be accepted because Applicant uses the term “hands free” to identify footwear. The wording HANDS FREE SHOES (“shoes” disclaimed) is a registered mark of a third party for “footwear” in International Class 25.²

² Registration No. 5471619 registered on the Supplemental Register on March 26, 2018. The registration includes a disclaimer of “shoes” apart from the mark.

In view of these findings, the motion to amend is **denied** without prejudice. The present identification of goods/services, that is, the identification prior to the filing of the motion to amend, remains operative for purposes of future amendment. *See* Trademark Rule 2.71(a); TMEP §1402.07(d).

However, 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.