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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91270249
Party	Defendant Bluebird Bio, Inc.
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Date	09/28/2021
Attachments	Applicants Motion to Amend Identification of Services and Memorandum in Support.pdf(224962 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Spark Therapeutics, Inc.,

Opposer,

v.

bluebird bio, Inc.,

Applicant.

Cancellation No.: 91/270,249

Serial No.: 79/301,139

Mark: I AM THE SPARK

APPLICANT'S MOTION TO AMEND IDENTIFICATION OF SERVICES AND
MEMORANDUM IN SUPPORT

Pursuant to 37 C.F.R. § 2.133, Applicant bluebird bio, Inc. ("Applicant"), respectfully requests that the Trademark Trial and Appeal Board ("the Board") amend the identification of goods in International Classes 35 and 41 of its U.S. Application Ser. No. 79/301,139, as follows:

International Class 35

Current: Promotional activities relating to awareness of disease states; advertising in the form of public advocacy to promote disease state awareness; organising advertising programs and initiatives to promote disease state awareness; provision of information, consultancy and advice relating to the aforesaid

Proposed (mark-up): Promotional activities relating to awareness of ~~disease states~~ sickle cell disease; advertising in the form of public advocacy to promote ~~disease state~~ awareness of sickle cell disease; organising advertising programs and initiatives to promote ~~disease state~~ awareness of sickle cell disease; ~~provision of information, consultancy and advice relating to the aforesaid~~

Proposed (clean): Promotional activities relating to awareness of sickle cell disease; advertising in the form of public advocacy to promote awareness of sickle cell disease; organising advertising

programs and initiatives to promote awareness of sickle cell disease

International Class 41

Current: Educational activities and service related to gene therapy, namely, classes, workshops and/or seminars in the fields of diseases and disease states; organisation of conferences, seminars, symposiums, workshops, and in-person educational forums relating to diseases and disease states; providing prerecorded audio, visual, and audio-visual educational programs, not downloadable, via video-on-demand services, that relate to diseases and disease states

Proposed (mark-up): ~~Educational activities and service related to gene therapy, namely, classes, workshops and/or seminars in the fields of diseases and disease states;~~ organisation of conferences, seminars, symposiums, workshops, and in-person educational forums relating to ~~diseases and disease states~~ sickle cell disease; providing prerecorded audio, visual, and audio-visual educational programs, not downloadable, via video-on-demand services, that relate to ~~diseases and disease states~~ sickle cell disease

Proposed (clean): organisation of conferences, seminars, symposiums, workshops, and in-person educational forums relating to sickle cell disease; providing prerecorded audio, visual, and audio-visual educational programs, not downloadable, via video-on-demand services, that relate to sickle cell disease

37 C.F.R. § 2.133(a) provides, “[a]n application subject to an opposition may not be amended in substance nor may a registration subject to a cancellation be amended or disclaimed in part, 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.” Applicant hereby seeks leave to amend its application as set forth above.

ARGUMENT

The proposed amendment is timely as it is brought in advance of trial. *See Drive Trademark Holdings LP v. Inofin*, 83 USPQ2d 1433, 1435 (TTAB 2007).

The proposed amendment is limiting in nature as required by Trademark Rule 2.71(a). The amendments to classes 35 and 41 limit “disease states” to “sickle cell disease.” The amendment to class 35 strikes “provision of information, consultancy and advice relating to the aforesaid.” The amendment to class 41 strikes “Educational activities and service related to gene therapy, namely, classes, workshops and/or seminars in the fields of diseases and disease states.”

The proposed amendment serves to change the nature and character of the services and/or restrict their channels of trade and customers so as to introduce a substantially different issue for trial. Limiting the services from “relating to diseases and disease states” to “relating to sickle cell disease” narrows the category of people who are affected, as “sickle cell disease” is much narrower than “disease and disease states.” The United States Centers for Disease Control and Prevention estimates that sickle cell disease affects approximately 100,000 Americans. Sickle cell disease also predominantly affects African Americans, as evidenced by the CDC estimate that sickle cell disease occurs among about 1 out of every 365 Black or African-American births. See Exhibit A. The amendment to the services in classes 35 and 41 significantly restricts the target audience and therefore changes the nature of the services and/or restricts their channels of trade and customers.

As the application is not based on use in commerce, there are no specimens of record, and accordingly applicant is not required to prove use of the mark with the remaining services prior to the relevant date as determined by the applicant’s filing basis. *Johnson & Johnson v. Stryker*, 109 USPQ2d 1077 (TTAB 2013).

Dated: September 28, 2021

Respectfully submitted,

/Christopher K. Albert/

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CERTIFICATE OF SERVICE

I certify that a true and correct copy of the foregoing document was served on Opposer, Spark Therapeutics, Inc., through its attorneys of record via email to:

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Dated: September 28, 2021

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EXHIBIT A

Data & Statistics on Sickle Cell Disease

Sickle cell disease (SCD) affects millions of people throughout the world and is particularly common among those whose ancestors came from sub-Saharan Africa; Spanish-speaking regions in the Western Hemisphere (South America, the Caribbean, and Central America); Saudi Arabia; India; and Mediterranean countries such as Turkey, Greece, and Italy.

Did you know?

Sickle cell disease occurs more often among people from parts of the world where malaria is or was common. It is believed that people who carry the sickle cell trait are less likely to have severe forms of malaria.

In the United States

The exact number of people living with SCD in the U.S. is unknown. Working with partners, the CDC supports [projects](#) to learn about the number of people living with SCD to better understand how the disease impacts their health.

It is estimated that:

- SCD affects approximately 100,000 Americans.
- SCD occurs among about 1 out of every 365 Black or African-American births.
- SCD occurs among about 1 out of every 16,300 Hispanic-American births.
- About 1 in 13 Black or African-American babies is born with sickle cell trait (SCT).

Comprehensive Care

- People with SCD have less access to comprehensive team care than people with genetic disorders such as hemophilia and cystic fibrosis. [\[Read article\]](#)

Mortality

- Sickle cell-related death among Black or African-American children younger than 4 years of age fell by 42% from 1999 through 2002. This drop coincided with the introduction in 2000 of a vaccine that protects against invasive pneumococcal disease. [\[Read summary\]](#)
- Relative to the rate for the period 1983 through 1986, the SCD mortality rate for the period 1999 through 2002 decreased by:
 - 68% at age 0 through 3 years;
 - 39% at age 4 through 9 years; and
 - 24% at age 10 through 14 years. [\[Read summary\]](#)
- Mortality Among Children with Sickle Cell Disease Identified by Newborn Screening During 1990-1994 — California, Illinois, and New York:
 - Among the children with Hb SS disease, 1% died as a result of SCD-related causes during the first 3 years of life.
 - In California and Illinois, by the end of 1995, the cumulative mortality rate was 1.5 per 100 Black or African-American children with SCD. The equivalent cumulative mortality rate for all Black or African-American infants born during this period in California and Illinois was 2.0 per 100 Black or African-American newborns. [\[Read article\]](#)