

Club Sports International Inc.

v.

Leisure Sports, Inc.

Cancellation No. 21,607
On Petition to the Commissioner
Filed: September 6, 1996

Decision

Leisure Sports, Inc. (Petitioner/Respondent/Registrant) has petitioned the Commissioner to reverse an interlocutory order of the Trademark Trial and Appeal Board ("Board") denying amendment of the mark in U.S. Registration No. 1,658,540. Trademark Rule 2.146 provides authority for the requested review.

FACTS

On February 22, 1993, Club Sports International, Inc. filed a petition to cancel U.S. Registration No. 1,658,540. The above-referenced cancelling proceeding was established, and over the course of the following years, trial dates were set, and several motions to extend the testimonial periods were filed and granted.

On January 24, 1996, Petitioner file a motion to amend U.S. Registration No. 1,658,540 and to suspend proceedings before the Board. On April 18, 1996, the Board issued an order denying Petitioner's motion to amend its registration but granting the motion to suspend proceedings. On April 29, 1996, Petitioner file a motion to certify order for immediate appeal and to stay proceedings pending disposition of motion and appeal. In response to Petitioner's April 29, 1996 motion, on August 1, 1996, the Board issued a second interlocutory order suspending proceedings for 30 days and permitting the Petitioner time to file a petition to the Commissioner. This petition followed.

ANALYSIS

The Board order of April 18, 1996, denying Petitioner's motion to amend its registration, states that:

Inasmuch as the proposed amendment materially alters the character of respondent's mark, contrary to the provisions of Trademark Rule 2.173, the motion to amend registration is denied.

Pursuant to Trademark Rule 2.146(a)(3), the Commissioner has authority to reverse an interlocutory order issued by the Trademark Trial and Appeal Board in an *inter partes* proceeding. However, the Commissioner will exercise this authority only upon a showing of clear error or abuse of discretion. *In re Societe Des Produits Nestle S.A.*, 17 USPQ2d 1093 (Comm'r Pats. 1990); *Riko Enterprises, Inc. v. Lindsley*, 198 USPQ 480 (Comm'r Pats. 1977).

The circumstances presented in this case do not demonstrate either clear error or abuse of discretion by the Board. Trademark Rule 2.173(a) prohibits amendment of the mark in a registration if such amendment would alter materially the character of the mark. As noted by the Board in its April 18, 1996 order, Petitioner's proposed amendment to the registration would entirely delete four intersecting circles prominently placed within the interior of a clover-leaf border. The Board advised Petitioner that:

The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. If one mark is sufficiently different from another mark as to require republication, it would be tantamount to a new mark and appropriate for a new application (citation omitted).

The Board also noted that another test used to determine material alteration to a mark is whether or not the examining attorney would have to conduct a new search of the register to discover potentially similar marks. In this case, the Board determined that an examining attorney would originally have searched for designs involving interlocking circles. The deletion of the interlocking circles would necessitate a new search for marks with clover leaf or cross designs.

DECISION

The Board has provided reasonable and adequate justification for its order denying Petitioner's motion to amend U.S. Registration No. 1,658,540. Accordingly, the petition is denied. The cancellation file will be returned to the Trademark Trial and Appeal Board for resumption of the cancellation proceeding.

Philip G. Hampton, II
Assistant Commissioner
for Trademarks

Date:

Attorney for Petitioner/Respondent/Registrant:

John A. Hughes, Esq.
TOWNSEND and TOWNSEND and CREW LLP
Two Embarcadero Center
8th Floor
San Francisco, California 94111-3834

Attorney for Petitioner:

Timothy Atkinson, Esq.
Reinhart, Boerner, Van Deuren,
Norris & Rieselbach
1700 Lincoln Street
Suite 3725
Denver, Colorado 80203