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

Proceeding	77392514
Applicant	ORION FOOD SYSTEMS, L.L.C.
Applied for Mark	HOT STUFF PIZZA
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Submission	Appeal Brief
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Serial No. 77392514

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

Serial No. 77392514

Applicant: Orion Food Systems LLC

Filing Date: 02/08/2008

Mark: HOT STUFF PIZZA

APPLICANT'S APPEAL BRIEF

Orion Food Systems LLC ("Applicant") appeals the U.S. Patent and Trademark Office's ("the Office") refusal to register the trademark HOT STUFF PIZZA and Design.

THE PROPOSED AMENDMENT TO THE REGISTERED MARK IS NOT A MATERIAL ALTERATION OF THE MARK AND SHOULD BE ACCEPTED UNDER SECTION 7(E) OF THE TRADEMARK ACT

Section 7(e) of the Trademark Act prohibits an amendment that materially alters the character of the mark. "Material alteration" is the standard for evaluating amendments to marks at all relevant stages of processing, both during examination of the application and after registration. See 37 C.F.R. §§2.72 and 2.173(a); TMEP §§807.14 *et seq.*

In determining whether a proposed amendment is a material alteration of a registered mark, the USPTO will compare the proposed amendment to the mark *as originally filed*. See TMEP §807.13. The general test of whether an alteration is material is whether, if the mark in an application for registration had been published, the change would require republication in order to present the mark fairly for purposes of opposition. See TMEP §807.14.


An amendment of a mark is acceptable if the modified mark contains the essence of the original mark (*i.e.*, the mark as originally registered), and the mark as amended creates essentially the same impression as the original mark. *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm'r Pats. 1996); See TMEP §807.14. For example, in marks consisting of word(s) combined with a design, if the word is the essence of the mark and the design is merely background embellishment or display that is not integrated into the mark in any significant way, the removal or change of the design will not be a material alteration of the mark. *See Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pats. 1953).

In this case, Registrant has requested an amendment of the mark



and this amendment has been rejected by the Trademark Office on the basis that the amendment constitutes a material alteration of the registered mark. When applying the general material alteration test noted above, this amendment would not require republication of the mark. The dominant portion of the mark is the term HOT STUFF PIZZA. The term HOT STUFF PIZZA is spelled the same way in both the original mark and the amended mark and remains presented in the same format, with the wording HOT STUFF appearing over the word PIZZA on a curve with the same relationship between words. Additionally, both marks show the HOT STUFF in all-caps and the word Pizza in initial-cap lettering. The font has remained the same with a distinct font for “pizza”. The USPTO has previously held changes in font style as nonmaterial alterations. See accepted changes to UMAX mark, *In re Unmax Data System, Inc.*, 40 U.S.P.Q.2d 1539 (Comm'r Pat. & TM 1996) (amendment of registered mark from

UMAX to **UMAX** held not to be a material alteration); *See also* accepted changes to PETER PAN mark, *Ex parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pat. &

TM 1953) (amendment from  to **Peter Pan** held not to be a material alteration).

Additionally, in compound marks consisting of words combined with a design such as the mark at issue, if the word is the essence of the mark and the design is merely background embellishment or display that is not integrated into the mark in any significant way, the removal or change of the design will not be a material alteration of the mark. In this case, the change is to the depiction of the pizza slice. In this regard, it remains a triangular pizza slice in the background of the mark. Changing triangular pizza slice in the background of a mark from a partially shaded to mostly shaded background would not require a new search of the mark. Therefore, the amendments made to the mark are permissible because the changed elements (shading) are not integral features of the mark that materially alter the essential commercial impression of the mark.

For the foregoing reasons, Applicant requests that Registrant's Section 7 Amendment be accepted.

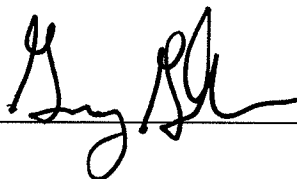
Respectfully Submitted,

Orion Food Systems LLC

By its Attorney,

Date:

5-18-2012



A handwritten signature in black ink, appearing to read 'Gregory C. Golla', is written over a horizontal line.

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