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Subject: U.S. TRADEMARK APPLICATION NO. 77392514 - HOT STUFF PIZZA -
11503.289US0 - EXAMINER BRIEF

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UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)

APPLICATION SERIAL NO. 77392514

MARK: HOT STUFF PIZZA



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APPLICANT: ORION FOOD SYSTEMS, L.L.C.

CORRESPONDENT'S REFERENCE/DOCKET NO:

11503.289US0

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EXAMINING ATTORNEY'S APPEAL BRIEF

The application was refused on the ground that the proposed amendment to the original drawing is a material alteration of the original drawing submitted with the application as originally filed. The proposed amendment to the drawing was filed as part of the Statement of Use for the proposed mark HOT STUFF PIZZA in stylized form with a design. The trademark examining attorney respectfully requests that the Board affirm the refusal on the aforementioned grounds.

STATEMENT OF FACTS

On February 13, 2008, Applicant filed an Intent to Use application to register HOT STUFF PIZZA in stylized form with a design on the Principal Register for “franchising services, offering technical assistance in the establishment and operation of restaurants, carry-out food shops, and food kiosks; food kiosk services in Class 35,

restaurant services and carry-out food shop services in Class 43, and Food products; pizza; egg rolls, bread sticks and bakery goods in Class 30. The Examining Attorney approved the Intent to Use application on October 22, 2008. On February 2, 2011, a Statement of Use was filed. The Applicant filed an amendment to the drawing in the Statement of Use on February 2, 2011. The Examining Attorney issued an Office Action on February 23, 2011 denying the Applicant's request to amend the drawing of the mark based on the fact that the proposed mark is a material alteration of the original mark filed in the application. The Applicant argued that the proposed amendment is not a material alteration; however, the Examining Attorney was not persuaded and issued a final refusal on September 19, 2011. Applicant filed a brief on April 27, 2012 and jurisdiction was thereafter restored to the examining attorney.

The sole issue before the Board on appeal is whether amendment of the HOT STUFF design mark constitutes an unacceptable material alteration.

ARGUMENT

AMENDMENT OF THE HOT STUFF WORD MARK WITH DESIGN OF A SLICE OF PIZZA WITH MISCELLANEOUS DESIGNS TO A SLICE OF PIZZA WITH NO DESIGN CONSTITUTES AN UNACCEPTABLE MATERIAL ALTERATION.

An amendment to a mark will not be accepted if the change would materially alter the mark in the initial application. 37 C.F.R. §2.72; *In re Who? Vision Sys., Inc.*, 57 USPQ2d 1211 (TTAB 2000) (holding proposed amendment of TACILESENSE to TACTILESENSE to be material alteration); *In re CTB Inc.*, 52 USPQ2d 1471 (TTAB 1999) (holding proposed amendment of TURBO and design to typed word TURBO to be material alteration); TMEP §807.14. For example, if republication of the amended mark

would be necessary in order to provide proper notice of the mark to third parties for opposition purposes, then the mark has been materially altered and the amendment is not permitted. *In re Who? Vision Sys. Inc.*, 57 USPQ2d at 1218. “The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark.” *In re Hacot-Columbier*, 105 F.3d 616, 620, 41 USPQ2d 1523, 1526 (Fed. Cir. 1997) (quoting *Visa Int’l Serv. Ass’n v. Life Code Sys., Inc.*, 220 USPQ 740, 743 (TTAB 1983)); see *In re Nationwide Indus. Inc.*, 6 USPQ2d 1882, 1885 (TTAB 1988); TMEP §807.14.

The Office determines whether a proposed amendment materially alters a mark by comparing the proposed amended mark with the mark in the drawing filed with the original application. TMEP §807.14(d). In the present case, the proposed amendment to the mark is refused because it would result in a material alteration of the mark depicted in the original application. TMEP §807.17; see 37 C.F.R. §2.72. Specifically, the proposed amendment would materially alter the mark in the initial application because it attempts to delete design elements on the slice of pizza.

A. THE SLICE OF PIZZA WITH NOTHING ON IT IS NOT EQUIVALENT TO A PIECE OF PIZZA WITH CIRCLES AND OTHER DESIGNS THAT APPEAR TO INDICATE VARIOUS TOPPINGS.

The Applicant argues that the amendment is acceptable if the modified mark contains the essence of the original mark and the mark as amended creates essentially the same impression as the original mark. See *In re Umax Data System Inc.*, U.S. Patent and Trademark Office Commissioner of Patents and Trademarks, 40 USPQ2d 1539 (1996).

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 is tantamount to a new mark appropriate for a new application. *In re Wine Society of America Inc.* , [12 USPQ2d 1139](#) (TTAB 1989); *In re Nationwide Industries Inc.* , [6 USPQ2d 1882](#) (TTAB 1988); *In re Pierce Foods Corp.*, [230 USPQ 307](#) (TTAB 1986), *Visa International Service Association v. Life-Code Systems, Inc.* , [220 USPQ 740](#) (TTAB 1983); *In re E.M. Townsend & Co.* , [143 USPQ 318](#) (Comm'r Pats. 1964). See *In re Umax Data System Inc.*, at page 1541. The marks in *In re Umax Data System, Inc.* case are very different from the proposed amendment in the subject application where the amendment was allowed. In that case, the proposed mark was merely a change in the stylization of the word mark. In this case, the Applicant amends the mark from a triangular shape with miscellaneous designs, likely indicating toppings on the triangular shape that appears to be a slice of pizza to a plain triangular shape or pizza slice with nothing else on it. The applicant argues that the USPTO previously held changes in font style as nonmaterial alterations; however, this is not a change in font style. This is a change in the elements of the design portion of the mark creating the impression of a slice of pizza with toppings versus a plain piece of pizza. The applicant further argues that in compound marks consisting of words combined with a design, that the design is merely a background embellishment that could be removed or amended without any material alteration. The applicant suggests that the removal or change in the depiction of pizza slice would not be a material alteration is a dangerous proposition. This argument suggests that the applicant could delete the slice of pizza and it would not create a different commercial impression. The Examining Attorney strongly disagrees with this proposition. The design in the subject application is much different from the

deletion of the oval background in the *Ex Parte Petersen & Pegau Baking Co.*, 100 USPQ 20 (Comm'r Pat & TM 1953) case as suggested by the Applicant. In this case, the rectangular design identifies a suggestive component of the mark in that the goods and services are for food and restaurant services that likely include pizza.

B. A PLAIN SLICE OF PIZZA DOES NOT CREATE THE SAME COMMERCIAL IMPRESSION AS THE SLICE OF PIZZA WITH DESIGN ELEMENTS.

The applicant argues that the proposed mark is a compound mark consisting of words combined with a design and the design is merely background embellishment or display that is not integrated into the mark in any significant way. See p.3 of Applicant's brief. The Applicant further argues that the change is merely a change from a partially shaded to a mostly shaded background; however, shading is not the issue. The proposed amended drawing is not merely showing a different amount of shading, but rather additional elements on the slice of pizza. An analysis of the mark as a plain slice of pizza is very different from the analysis of a mark with various elements, appearing to be toppings. The Applicant argues that changing the triangular pizza slice would not require a new search. See p. 3 of Brief. As a general rule, the addition of any element that would require a further search will constitute a material alteration. *In re Pierce Foods Corp.*, 230 USPQ 307 (TTAB 1986). However, while the question of whether a new search would be required is a factor to be considered in deciding whether an amendment would materially alter a mark, it is not necessarily the determining factor. *In re Who? Vision Systems, Inc.*, 57 USPQ2d 1211 (TTAB 2000); *In re Vienna Sausage Mfg. Co.*, 16 USPQ2d 2044 (TTAB 1990).

A search of a mark with a plain slice of pizza or a triangular shape may be very different from a search of a mark containing a slice of pizza with toppings. Even if the search would be similar, an analysis of the evidence may be very different. The applicant did not provide any evidence to support their proposition that the marks create the same commercial impression.

For the reasons above, the proposed amendment to the mark is an unacceptable material alteration and therefore, is rejected. The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. 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 appropriate for a new application. See TMEP Section 807.14. In this case, the Examining Attorney finds that the modified mark would have to be republished, therefore, making it tantamount to a new mark, which creates an unacceptable modification.

CONCLUSION

For the foregoing reasons, refusal on the grounds that amendment to the proposed mark is unacceptable as a material alteration of the original application as filed on February 8, 2008 within the meaning of Section 7 of the Trademark Act. See 37 C.F.R. Sections 2.72 and 2.173(a); TMEP Sections 808.14 et seq. The trademark examining attorney respectfully requests that the Board affirm the refusal to register the mark.

Respectfully submitted,

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