ESTTA Tracking number: **ESTTA287973**

Filing date: **06/04/2009**

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

Proceeding	91172045
Party	Defendant Lightspeed Entertainment, LLC
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Date	06/04/2009
Attachments	Amendment to application.pdf (7 pages)(165013 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE U.S. TRADEMARK TRIAL AND APPEAL BOARD

Applicant	:	Lightspeed Entertainment, LLC
Ser. No.	:	78/614,307
App. Date	:	April 21, 2005
Mark	:	MONSTER CONTROL (word mark)

AMENDMENT TO APPLICATION

Trademark Assistance Center
Madison East, Concourse Level Room C 55
600 Dulany Street
Alexandria, VA 22314

I hereby certify that this correspondence is being filed electronically with the Trademark Trial and Appeal Board via the ESSTA webserver on on June 4, 2009.

Brian P. Kinder, Esq.
California Bar No. 212,332

6/4/09
Date

Dear Sir:

Pursuant to a settlement agreement between the parties to Opposition Proceeding No. 91172045, Applicant hereby requests that the amendments set out in detail below be entered in respect to the above-captioned application. Upon entry of these amendments, the parties will file a stipulated dismissal of Opposition Proceeding No. 91172045.

A. Disclaimer

Applicant requests that the following disclaimer be entered as if fully set forth in the application: "Without waiving common law rights thereto, no claim is made to the exclusive right to use the term "MONSTER" apart from the mark as shown."

B. Description of Services

Applicant requests that the description of services set forth in the above-captioned application be amended to read as follows:

> "motion picture films featuring animated characters in the action adventure genre; pre-recorded video tapes and discs featuring animated characters in the action adventure genre; and computer games, games and software featuring animated characters in the action adventure genre."

C. Amendment of Mark from Standard Character to Stylized

As originally filed, the drawing for the above-captioned mark depicted the mark in a standard character or word mark format. Applicant requests that the drawing be amended to depict the mark in the stylized format shown in "REVISED DRAWING" attached hereto. As the Examining Attorney will note, the mark retains the primary element of the mark, namely, the wording MONSTER CONTROL, but adopts a stylization to the lettering. Accordingly, and as discussed more fully below, Applicant respectfully submits that the requested amendment does not materially alter the overall commercial impression of the mark and is therefore permissible.

The test for material alteration is whether the mark, as modified, "contain[s] what is the essence of the original mark" and whether the new form "create[s] the impression of being essentially the same mark." *Visa Int'l Service Assoc. v. Life-Code Systems, Inc.*, 220 U.S.P.Q. 740, 743-44 (T.T.A.B. 1983). As the Examining Attorney will note, the only difference between the original mark and the mark as modified is the stylization of the lettering. Apart from the foregoing, the primary essence of the mark is retained. As the following visual comparison of the marks reveals, the requested amendment results in a mark that conveys an identical meaning

and commercial impression, retains "the essence of the original mark" and is "essentially the same mark."

MONSTER CONTROL

The immediate request is also consistent with prior cases that have held similar requests to be non-material alterations. By way of example, in *Visa International Service Assn. v. Life-Code Systems*, 220 U.S.P.Q. 740, 743-44 (T.T.A.B. 1983), the Board held that where the mark as modified "contain[ed] what is the essence of the original mark, and the new form ... create[d] the impression of being essentially the same mark..." the amendment would be allowed. Just as in the *Visa* case, the instant request seeks to amend the mark to a form which is "the essence of the original mark. . . ." *Id.* As depicted below, *Visa* inverted the triangle within the circle, inverted the direction of the plane and re-located the wording "OMNI-VISA." Similarly, the instant Applicant seeks only to alter the stylistic elements of the mark, and otherwise depicts the primary significance of the mark in the same manner. Applicant respectfully submits that such an amendment is clearly within the confines of the *Visa* case.

Applicant also submits that the Trademark Trial and Appeal Board (T.T.A.B.) has indicated that minor changes of an inconsequential nature do not change the overall commercial impression of the mark, and, thus, do not constitute a material alteration. *See In re Larios*, 35 U.S.P.Q.2d 1214 (T.T.A.B. 1995). By way of example, in the *Larios* decision, the Board allowed the applicant to amend the stylized design from GRAN VINO MALAGRA LARIOS to VINO DE MALAGRA LARIOS. This supports Applicant's position that the requested amendment should be approved, since the instant amendment seeks only to make changes to the stylization of the lettering which also do not change the overall commercial presentation of the mark.

Applicant respectfully submits that the requested amendment is proper as proposed. Applicant's proposed change falls within the minor changes which do not alter the overall commercial impression of the mark as approved by the Trademark Trial and Appeal Board in *Visa International Service Association* and *In re Larios*.

CONCLUSION

Based upon the foregoing, Applicant respectfully submits, the Examining Attorney has both the discretion and the authority to grant the requested amendment. The courts and the Board have indicated that the mark seen in the application and that seen in the drawing as amended present the same commercial impression and are essentially the same mark because no prominent matter is being added or deleted. Thus, given the inconsequential nature of the change and the fact that the mark is nearly identical, Applicant respectfully requests the Examining Attorney exercise discretion and grant the requested amendment.

Applicant also requests that the disclaimer be entered and the description of services be modified as set out above. Upon entry of the foregoing, the parties to Opposition Proceeding No. 91172045 will enter a stipulated dismissal.

Respectfully submitted,

Brian P. Kinder
California Bar No. 212,332

AMENDMENT TO APPLICATION
MARK: MONSTER CONTROL
SERIAL NO. 78/614,307

REVISED DRAWING

CERTIFICATE OF SERVICE

I certify that on June 4, 2009, the foregoing AMENDMENT TO APPLICATION is being emailed and deposited with the United States Postal Service by postage prepaid, first-class mail, addressed to:

Scott Allen, Esq.
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6/4/09
Dated

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