

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**PETITION FOR DIRECTOR REVIEW**

Original Mark:



Amended Mark:



Registration No.: 5775653

Registrant: 1-800 Contacts, Inc.

---



The Original Mark registered on June 11, 2019. On September 3, 2019, Registrant filed a Section 7 Amendment requesting the mark be amended. The Amended Mark was refused on November 26, 2019. After Registrant filed arguments against the refusal, the request to amend the mark was again denied on January 15, 2020. Registrant respectfully requests a review of the denial to amend its registration to the Amended Mark.

**I. The Amended Mark is a Not Material Alteration of the Original Mark.**

The Trademark Specialist claims, “the proposed amendment to the mark would materially alter the character of the mark and thus cannot be accepted.” A registered mark can be amended only if the change does not alter the character and commercial impression of the mark, i.e., the change creates essentially the same impression as the original mark. See *In re Umax Data System, Inc.*, 40 USPQ2d 1539 (Comm’r Pats. 1996); TMEP § 807.14. Deleting or changing a feature of the mark is permitted if that feature is not an integral feature of the mark.

The Amended Mark does not alter the character and commercial impression of the mark and creates essentially the same impression as the Original Mark. The Amended Mark maintains the Original Mark’s overall shape, concept, and likeness. Both the Original Mark and the Amended Mark are comprised of an eyeball, eyelid, and pupil with legs and arms, and nothing else. The minor changes between the Original Mark and the Amended Mark are negligible color changes (the Amended Mark stays within the same color family as the Original Mark) and minor design changes that simplify the Amended Mark. None of these amendments change any integral features of the mark, nor does the Amended Mark create a new or different commercial impression, thus the Amended Mark is not a material alteration of the Original Mark.

The Trademark Trial and Appeal Board (TTAB) has ruled as to what constitutes a material alteration. In *In re Hot Stuff Foods, LLC*, Serial No. 77392514 (March 8, 2013) [not precedential], the TTAB ruled that the amended mark was not a material alteration of the original mark:

Serial No. 77392514’s original mark:	Serial No. 77392514’s amended mark:
	

The TTAB ruled that the two above marks create the same commercial impression. The TTAB said, “The amended drawing which includes a simple representation of a slice of pizza does not represent a substantial and, thus, material change to the original drawing. ... The modified mark contains the *essence of the original mark*, and the new form of the mark creates the impression of being essentially the same mark as the mark in the original drawing” (emphasis

added). Both marks are in essence the same: both marks contain the same wording in generally the same style, overlaid on a vertical slice of pizza. The only discernable difference is the amount of detail; the amended mark is a much simpler, less stylized version.

Much like *In re Hot Stuff Foods, LLC*, the Amended Mark is not a substantial or material change to the Original Mark, maintains the essence of the Original Mark, and is merely a simplified version of the Original Mark. With a reduction in the eyelid, a smaller pupil, and minor gradation in color scheme, the Amended Mark is merely a simpler, less stylized version of the Original Mark. The Amended Mark is not a materially altered version of the Original Mark as it maintains the same commercial impression as the Original Mark.

Therefore, Registrant respectfully requests the Director accept the amendment to the Amended Mark.