

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Delta Air Lines, Inc.)
Serial No. 86328420)
Mark:)



REQUEST TO AMEND MARK

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313

Sir:

REMARKS

I. AMENDING THE MARK

Applicant respectfully requests that the instant application be amended so as to decrease the spacing separating the two triangular elements within the mark. Thus, instead of the design



as originally applied, the mark will appear as two triangular shapes closer to one

another: [Image of the logo with reduced spacing]. The new drawing page and the specimens filed in connection with this

statement of use reflects this minor and immaterial alteration of the mark. Having been approved for publication and awaiting registration, applicable legal standards reflect:

“A registrant may apply ... for amendment of a registration... If the amendment involves a change in the mark itself...such amendment to a registration cannot involve changes that materially alter the character of the mark...

Deleting or changing a feature of a registered mark is permitted only if ...that elimination or change will not materially alter the essential commercial impression of the mark...”

McCarthy on Trademarks and Unfair Competition, at § 19:133, *citing*, Lanham Act §7(e), 15 U.S.C.A. §1057(e); T.M.R.P. 2.173; T.M.R.P. 2.73(a) (“An amendment ... must not materially alter the character of the mark.”). *See also*, In re Holland American Wafer Co., 737 F.2d 1015 (Fed. Cir. 1984); Ex parte Black & Decker Mfg. Co., 136 U.S.P.Q. 379 (Comm'r Pat. 1963); In re Pamex Foods, Inc., 209 U.S.P.Q. 275 (Comm'r Pat. 1980); *See* T.M.E.P. §1607.02; Ex parte Petersen & Pegau Baking Co., 100 U.S.P.Q. 20 (Comm'r Pat. 1953); *See In re John LaBatt, Ltd.*, 26 U.S.P.Q.2d 1077 (Comm'r Pat. 1992); T.M.R.P. 2.176, 2.146; *See* §§21:5–21:9. T.M.R.P. §2.72(a), (T.M.E.P. 807.14(a) applying the same standard to use-based applications (“It is the responsibility of the examining attorney to consider any proposed amendment of the mark on the drawing by applying the material alteration test... If the amendment would change the essence of the mark, the examining attorney must reject the amendment under the material alteration test.”); In re Pierce Foods Corp., 230 U.S.P.Q. 307 (T.T.A.B. 1986); In re Finlay Fine Jewelry Corp., 41 U.S.P.Q.2d 1152 (T.T.A.B. 1996); In re Vienna Sausage Mfg. Co., 16 U.S.P.Q.2d 2044 (T.T.A.B. 1990).

One instructive case is In re Finlay, *supra*, where the mark NY JEWELRY OUTLET was allowed to be amended to NEW YORK JEWELRY OUTLET. In reversing the Examining Attorney’s refusal to grant the amendment, the TTAB reasoned that NY was a common acronym for NEW YORK and that expanding out NY to NEW YORK would not change the commercial impression created by the mark:

“Applying the test enunciated above, we find that the proposed amendment to the drawing is not a material alteration of the mark. We agree with the applicant that ‘NY’ is clearly an abbreviation for ‘New

York' and, thus, while visually different, 'NY' and 'New York' are interchangeable as the two terms have the identical meaning or connotation... Additionally, the Examining Attorney concludes that NY and NEW YORK are visually and phonetically different. While this is literally true, it does not account for the fact that NY is an abbreviation of NEW YORK, i.e., it is a recognized shortened form of the same term. We conclude that the commercial impression of the original mark, NY JEWELRY OUTLET, is not changed by the amendment of the mark to NEW YORK JEWELRY OUTLET and, thus, the amended mark is not a material alteration of the original mark.

Decision: The refusal to register on the ground that the specimens do not evidence use of the mark in the application is reversed.”

Also on point is In re DeWitt International Corp., 21 USPQ2d 1620, 1623 (Comm. PT 1991) where the mark DE WITT (in the singular) was not deemed to be a material alteration from DE WITT'S (the possessive form), as it did not significantly alter the term's meaning or impression.



With respect to the alteration of a mark that combines both word and design elements, which is far more substantial than the change sought here, the leading case of Ex Parte Petersen, 100 U.S.P.Q. 20 (Com'r Pat. & Trademarks 1953) (cited in the McCarthy treatise, *supra*) provides very clear guidance. In *Petersen*, the Examiner's decision was overturned for refusing to allow amendment of a registered mark "...consisting of the words 'Peter Pan' enclosed with a fluted oval design and designs of two leaves near the perimeter of the oval", where the amended mark "shows 'Peter Pan', in a type somewhat different, but not materially so, from that appearing in the registration, enclosed within a stylized form of a rectangle, and the leaves do not appear." In reversing the examiner, the Commissioner reasoned that:

“Obviously, the dominant, and perhaps the only truly distinctive, feature of the registered mark is the words 'Peter Pan'. There can be no doubt that the word feature is still in use. The design is considered to be mere background and not in any sense an integral part of the trade mark. A number of trade marks are being used today with a background display different from that shown in the registration....For obvious reasons, it is desirable to amend such registrations...eliminating abandoned matter *which is not an integral part of the*

mark and the elimination of which will not alter materially the character of the mark, in order that the registration records accurately reflect the existing situation as to the mark actually in use.”

Thus the mark in Petersen was allowed to be amended despite alterations in three separate elements: (i) the lettering style of the words “Peter Pan” (ii) the shape of design enclosing those words (from an oval to a rectangle) and (iii) the removal of leaves in the original design. These changes are clearly far more significant than those presented in the instant request, yet they were found to be immaterial and permissible alterations.

Similarly, in Paris Glove of Canada, Ltd. v. SBC/Sporto Corp., 84 U.S.P.Q.2d 1856, 2007 WL 2422997 (T.T.A.B. 2007) the TTAB ruled that the use of a two word mark written in a semi-circle was not a material alteration of the same words displayed as two words on two lines.

In applying the above principles to the instant request, we can see that simply slightly decreasing the space between the two black triangular shapes to change  to  is completely immaterial. The two-triangle-shaped Delta logo is well recognized by Applicant’s customers. Such minor change does not in any way alter the meaning, connotation or overall commercial impression of the mark. No new elements are being added. The commercial impressions created by these two versions of the mark are virtually identical, as both versions of the mark retain the dominant and distinct two triangle-shaped elements and arrangement. The proposed amendment simply does not rise to the level of a material alteration. As such, it is a minor, immaterial and permissible alteration. Indeed, the cases cited above make clear that alterations are routinely allowed even where they are far more material than what applicant is requesting here.

It should also be noted that the rules allowing for amendment of marks have become liberalized to such a point that:

“While at one time the Commissioner would reverse a refusal of the PTO to amend a...[mark] only if there had been a ‘clear error or abuse of discretion,’ the standard of review was changed such that the Commissioner will review the refusal to determine ‘whether it was a correct’ decision.”

McCarthy, Id., citing, In re Umax Data System, Inc., 40 U.S.P.Q.2d 1539 (Comm'r Pat. & TM 1996) [sic] (“[T]he Commissioner believes that a Registrant whose amendment has been refused is entitled to the same standard of review that is available to an Applicant who seeks to amend a mark in an application. Henceforth, . . . the Commissioner will review the decision to determine whether it was a correct one.”).

In Umax, the PTO permitted the alteration of the mark as shown below:



Mark as Registered



Proposed Amended Mark

As can be seen here, the change in the font style of a mark that consists of a word in stylized lettering, is considered a minor and permissible alteration. Here, the alteration sought by Applicant is even less significant.

II. SPECIMENS OF USE AND NEW DRAWING PAGE

Submitted herewith and accompanying this request are specimens in support of the above amendment.

IV. Conclusion

Based on the foregoing, Applicant respectfully requests that its registration be amended as requested herein.

Dated: January 8, 2018

Respectfully submitted,

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