

### Amendment to Mark

The Examining Attorney has refused registration on the grounds that the proposed amendment to the mark constitutes a material alteration. Applicant respectfully disagrees for the following reasons.

According to Section 807.14 of the TMEP, the test for determining whether an amendment is a material alteration is as follows:

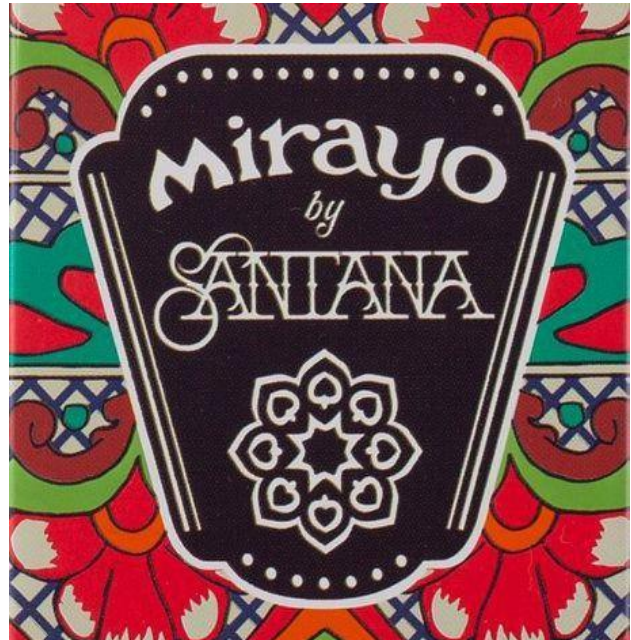
The modified mark must contain what is the essence of the original mark, and the new form must create the impression of being essentially the same mark. The general test of whether an alteration is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition.

Viewing the two marks side by side, there can be little question that the modified mark contains the essence of the original mark, and by the same token, creates the exact same commercial impression as the original. The dominant portion of both marks is the wording MIRAYO BY SANTANA, with a mandala design against a colorful background, and the nature of the mark is not changed by the proposed amendment.

*Original*



*Amended*



Another factor to consider is whether the amended mark would require a further search. *In re Pierce Foods Corp.*, 230 USPQ 307, 308-09 (TTAB 1986). With respect to these two marks, Applicant submits that the two marks are likely to be searched in an identical manner and therefore, no further search would be required.

Finally, Applicant submits this case is very similar to *In re Hot Stuff Foods, LLC*, Serial No. 77/392,514 (March 8, 2013). In that case, the TTAB overruled the Examining Attorney's finding that the amended mark shown below was a material alteration of the original despite the removal of many of the design elements.

Original



Amended



The Board concluded that the two marks created the same commercial impression, specifically the wording HOT STUFF PIZZA superimposed on top of a slice of pizza. While several lines and circular designs had been deleted, and the original drawing showed a "thinner crusted pie with various toppings on it," the Board concluded that the modified mark contains the essence of the original and therefore overturned the refusal to register.

While each case must be decided on its own facts, Applicant respectfully submits that the differences between its amended drawing and the original is far less substantial than that in the Hot Stuff Foods case.