

**To:** Zuffa, LLC ([TRADEMARKS2-LASVEGAS@LRLAW.COM](mailto:TRADEMARKS2-LASVEGAS@LRLAW.COM))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 77636476 - 69144-06007  
**Sent:** 9/15/2010 10:46:36 AM  
**Sent As:** ECOM101@USPTO.GOV  
**Attachments:**

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77636476

MARK:

**\*77636476\***

CORRESPONDENT ADDRESS:

JENNIFER K. CRAFT  
LEWIS AND ROCA LLP  
3993 HOWARD HUGHES PKWY STE 600  
LAS VEGAS, NV 89169-5996

CLICK HERE TO RESPOND TO THIS LETTER:  
<http://www.uspto.gov/teas/eTEASpageD.htm>

APPLICANT: Zuffa, LLC

CORRESPONDENT'S REFERENCE/DOCKET NO :

69144-06007

CORRESPONDENT E-MAIL ADDRESS:

TRADEMARKS2-LASVEGAS@LRLAW.COM

**NON-FINAL OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: **9/15/2010**

This Office action is in response to applicant's communication filed on August 24, 2010.

**1. Advisory – Requirements Maintained and Continued:**

The following requirements are maintained and continued: (1) Does Not Function as a Trademark; (2) Mark Differs on Drawing and Specimen. TMEP §§713.02, 714.04. Please see below for an additional requirement made in response to applicant's August 24, 2010 incoming communication.

**2. Requirement – Drawing Amendment Not Accepted – Material Alteration:**

Applicant has requested that the drawing of the mark be amended. The original drawing shows the mark as a two dimensional octagon; the amended drawing shows the mark as a three dimensional configuration of the goods.

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 republication of the amended mark would be necessary in order to provide proper notice of the mark to third parties. The original drawing submitted by the applicant in no way indicated that the mark is a three dimensional configuration of the applicant's goods and would not provide notice to third parties of the applicant's amended mark. As the modified mark does not create the impression of being essentially the same mark and is a material alteration, the drawing amendment is not accepted.

The applicant argues, "The only difference between the original drawing and the new drawing is the broken lines depicting features not claimed by the Applicant as being part of the Mark. The broken lines were added merely to indicate placement of the Mark on products. Since the only added elements are features not being claimed by the Applicant, they should not be deemed as a material alteration of the Mark, since the Mark is not actually being altered. The Mark remains the same. In fact, applicants are sometimes required by the USPTO to submit new drawings that include broken lines, which by the very nature of such requests means that new drawings with broken lines are acceptable. *See*, 37 C.F.R. §2.52(b)(4) ("[T]he applicant may be required to submit a drawing that shows the placement of the Mark by surrounding the Mark with a proportionately accurate broken-line representation of the particular goods, packaging, or advertising on which the Mark appears.") Accordingly, the Applicant believes that the new drawing does not materially alter the Mark, or alters the Mark at all, and therefore, should be acceptable." This argument, however, is not persuasive. Specifically, as stated above, the original drawing shows the mark as a two dimensional octagon, and was described by the applicant as "an octagon". However, the amended drawing is a three dimensional configuration of the goods themselves. The original drawing submitted by the applicant would not give subsequent filers notice of the applicant's amended three dimensional configuration mark, and is therefore considered a material alteration and the drawing amendment is not accepted.

Accordingly, the proposed amendment will not be entered and thus, the previously acceptable drawing of the mark will remain operative. Applicant must respond by arguing in favor of the proposed amendment and/or withdrawing the proposed amendment. *See* TMEP §§714.03, 714.05(a), 807.17.

### **3. Advisory – TEAS Plus Applicants:**

**TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE:** Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, *see* TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of \$50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

### **4. Advisory – Assistance:**

If applicant has questions about its application or needs assistance in responding to this Office action, please telephone the assigned trademark examining attorney directly at the number below.

/Colleen Dombrow/  
Trademark Attorney  
Law Office 101  
Direct Dial: (571) 272-8262  
Facsimile: (571) 273-9101

**TO RESPOND TO THIS LETTER:** Use the Trademark Electronic Application System (TEAS) response form at <http://teasroa.uspto.gov/roa/>. Please wait 48-72 hours from the issue/mailling date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail [TEAS@uspto.gov](mailto:TEAS@uspto.gov).

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, *see* <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

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**IMPORTANT NOTICE REGARDING YOUR  
U.S. TRADEMARK APPLICATION**

**USPTO OFFICE ACTION HAS ISSUED ON 9/15/2010 FOR  
SERIAL NO. 77636476**

Please follow the instructions below to continue the prosecution of your application:

**TO READ OFFICE ACTION:** Click on this [link](#) or go to <http://portal.uspto.gov/external/portal/tow> and enter the application serial number to [access](#) the Office action.

**PLEASE NOTE:** The Office action may not be immediately available but will be viewable within 24 hours of this e-mail notification.

**RESPONSE IS REQUIRED:** You should carefully review the Office action to determine (1) how to respond; and (2) the applicable [response time period](#). Your response deadline will be calculated from **9/15/2010** (or sooner if specified in the office action).

**Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System [Response Form](#).**

**HELP:** For *technical* assistance in accessing the Office action, please e-mail [TDR@uspto.gov](mailto:TDR@uspto.gov). Please contact the assigned examining attorney with questions about the Office action.

**WARNING**

**Failure to file the required response by the applicable deadline will result in the [ABANDONMENT](#) of your application.**