

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of THE SAUL ZAENTZ COMPANY

Serial No. 85815802 for GREEN DRAGON

**RESPONSE**

This is in response to the Office Action dated February 7, 2017, wherein the PTO declined to accept the specimen of use on the grounds that the specimen did not show the mark as sought to be registered. Applicant requests reconsideration of the refusal.

Applicant seeks registration of the mark GREEN DRAGON. The mark shown in the drawing is a substantially exact representation of the mark as used in the specimen of use. The mark in the specimen submitted by Applicant is shown as GREEN DRAGON followed by the descriptive word "Inn." The mark GREEN DRAGON and the descriptive word "Inn" are separated by the "TM" symbol. Thus, it is clear from the specimen that this descriptive word is not part of the mark. The Office contends that the mark in the specimen is allegedly not an exact representation of the mark in the drawing because it contains the word "Inn." However, many specimens contain words other than the mark sought to be registered. The specimen of record should be accepted because the word "Inn" is not part of the mark because this word is physically separated from the mark GREEN DRAGON by the "TM" symbol. Thus, the mark GREEN DRAGON stands out and creates a commercial impression that is separate and distinct from any other element appearing on the specimen.

The PTO further states that the appearance of the word "inn" changes the overall impression because "inn" is not descriptive in connection with the services listed in the application, namely, "promoting tourism in North America and New Zealand." However, the essence of restaurants, hotels, or similar establishments is to promote tourism, as hospitality and

tourism are inseparable. According to the Merriam Webster online dictionary, the word “tourism” can mean the “practice of travelling for recreation,” the “guidance or management of tourists,” the “promotion or encouragement of touring,” and “the accommodation of tourists.” See Exhibit A. Hotels or restaurants promotes these activities by definition. For instance, these types of businesses promote many tourism-related services, including accommodations, venues for various events, food services and sightseeing. In order to promote tourism, they use signs, leaflets, brochures, TV or print advertising, websites and social media.

In addition, as shown in the specimen, GREEN DRAGON is in itself a tourist attraction as it is part of the movie set tour for Hobbiton, the Hobbit village, featured in Peter Jackson’s films, *The Lord of the Rings* and *The Hobbit* Trilogies.

Thus, the word “Inn” is merely descriptive and devoid of any source identifying character. See, e.g., *In Re Raychem Corporation*, 12 USPQ2d 1399 (TTAB 1989) (Applicant was seeking registration of the mark TINEL-LOCK, while the specimen showed the mark as TRO6AI-TINEL-LOCK-RING – even though all the words on the specimen had the same font size and were linked by hyphens, the Board reversed the refusal to register the mark on the ground that the generic term RING and the model number TRO6AI did not have any source identifying function. Thus, the fact that they were not included in the drawing was not a mutilation of the mark.) In the case at issue, the word “Inn” is not only descriptive and devoid of any source identifying meaning, but it is also physically separated from the mark GREEN DRAGON by the “TM” symbol. The word “Inn” is therefore not part of the mark. Because the mark on the drawing is a substantially exact representation of the mark as shown on the specimen, the refusal should be withdrawn and the specimen of use accepted.

Applicant was also asked to submit a substitute specimen showing use of the mark in commerce with respect to the services in Class 35 in the application. The Office refused to accept the specimen originally submitted by the Applicant on the ground that said specimen allegedly shows use of the mark in connection with a bar or restaurant called the “GREEN DRAGON INN” and fails to demonstrate use of the mark in connection with the services listed in the application. For the same reasons explained in the previous section, Applicant respectfully contends that the specimen originally submitted should be accepted and asks the Office to reconsider the refusal. Applicant is applying to register its mark for “promoting tourism in North America and New Zealand.” Applicant submitted a website printout as a specimen for its services in Class 35. As explained above, this printout clearly shows the mark GREEN DRAGON used in connection with the services identified as “promoting tourism in North America and New Zealand.” Thus, the specimen should be accepted as evidence of use.

### **CONCLUSION**

In light of the foregoing, the refusal to accept the specimen should be withdrawn and Applicant’s application should be granted registration as soon as possible.