

DMK-LEM-MAR-ALL

24

PLEASE ACKNOWLEDGE RECEIPT OF THE FOLLOWING:

Applicant: Disney Enterprises, Inc.
Serial Number: 78/911,856
Filing Date: June 20, 2006
Mark: PETER PAN

1. Notice of Appeal (applies to parent and child applications)
2. Filing fee of \$100 for Notice of Appeal
3. Request to Suspend Appeal and Remand for Further Examination (applies to parent and child applications)
4. Request to Divide (applies to child application)
5. Request for Reconsideration - Parent Application
6. Request for Reconsideration - Child Application (with Exhibits A and B)
7. Amendment to Allege Use and Specimen (Exhibit A)
8. Declaration Under Section 2(f) (Exhibit B)
9. Filing fee of \$475 for divisional (child) application and filing fee of \$100 for Amendment to Allege Use



Date: **June 19, 2008**

06182.3559/Melinda Robertson

MD 1125

Due Date: June 19, 2008

DMK-LEM-6/20/08

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Date: **June 19, 2008**

06182.3559/Melinda Robertson

MD 1125

Due Date: June 19, 2008

Finnegan Henderson Farabow, Garrett & Dunner, LLP

PTO Account

VENDOR NUMBER: 10339
VENDOR NAME: Commissioner of Patents & Trademarks

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1059307	06182.355900000	06-19-08	Notice of Appeal PTO Fee	100.00
1059307	06182.355900000	06-19-08	Trademark Amendment to Allege Use	100.00
1059307	06182.355900000	06-19-08	Trademark Request to Divide Fee	475.00

Memo: melinda robertson

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DAVID M. KELLY
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June 19, 2008

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

U.S. Trademark Application No. 78/911,856
Mark: PETER PAN
Applicant: Disney Enterprises, Inc.
Attorney Docket: 06182.3559

Sir:

We enclose the following papers for filing in the U.S. Patent and Trademark Office in connection with this application:

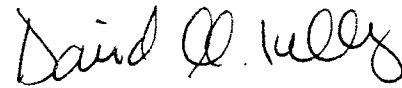
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Commissioner for Trademarks
Page 2

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GARRETT &
DUNNER ^{LLP}

If the filing fee is found to be insufficient for any reason, please charge the deficiency to Deposit Account No. 06-0916.

Respectfully submitted,

A handwritten signature in black ink that reads "David M. Kelly". The signature is written in a cursive style with a large, looped "D" and "K".

David M. Kelly

DMK/MRT/rack
Enclosures as stated

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Disney Enterprises, Inc.
Serial Number: 78/911,856
Filing Date: June 20, 2006
Mark: PETER PAN

Examining Atty: Dezmona J. Mizelle-Howard, Esq.
Law Office: 110

Commissioner for Trademarks
P.O. Box 1451
Alexandria, Virginia 22313-1451

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examining Attorney dated December 19, 2007, refusing registration of the above-identified mark.

Applicant respectfully notes that it has concurrently filed a Request to Divide this application. This Appeal applies to both the resulting parent and child applications.

The required appeal fee of \$100 is enclosed. If the fee is found to be insufficient for any reason, please charge the deficiency to Deposit Account No. 06-0916.

Respectfully submitted,

Disney Enterprises, Inc.

Date: June 19, 2008

By: David M. Kelly

David M. Kelly

Linda K. McLeod

Attorneys for Applicant

Finnegan, Henderson, Farabow,

Garrett & Dunner, L.L.P.

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**REQUEST TO SUSPEND APPEAL AND
REMAND APPLICATION FOR FURTHER EXAMINATION**

Pursuant to Rule 2.142(d) of the Trademark Rules of Practice, Applicant respectfully requests that the appeal proceedings in connection with the above-identified application be suspended and that the application be remanded to the Examining Attorney for further examination.


Applicant respectfully notes that it has concurrently filed a Request to Divide this application. The Request to Suspend Appeal and Remand Application for Further Examination applies to both the resulting parent and child applications.

Applicant is filing Request for Reconsiderations and a Notice of Appeal concurrently herewith.

Respectfully submitted,

Disney Enterprises, Inc.

Dated: June 19, 2008

By: 

David M. Kelly
Linda K. McLeod
Attorneys for Applicant
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Law Office: 110

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REQUEST TO DIVIDE

Applicant requests that the following goods be divided out of the above-identified application and that a second application be created that is identical in all respects to the above-identified application but for the goods to which it pertains and its serial number:

Pre-recorded audio cassettes, audio discs, and compact discs and laser video discs featuring music, stories, games, and activities for children; pre-recorded CD-ROMs featuring music, stories, games, and activities for children; computer software; pre-recorded DVDs, digital video discs, and digital versatile discs featuring animated and live action entertainment, motion picture films, television shows, stories, games, music, and activities for children; motion picture films; pre-recorded video cassettes featuring animated and live action entertainment, motion picture films, television shows, stories, and music

Applicant encloses the divisional application processing fee of \$100. Applicant also encloses an application filing fee of \$375.

If the enclosed fees are found to be insufficient for any reason, please charge the deficiency to Deposit Account No. 06-0916.

Applicant is also filing an Amendment to Allege Use and a Request for Reconsideration After Final Office Action concurrently herewith.

Respectfully submitted,

Disney Enterprises, Inc.

Dated: June 19, 2008

By: David M. Kelly
David M. Kelly
Linda K. McLeod
Attorneys for Applicant
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Garrett & Dunner, L.L.P.
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Law Office: 110

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REQUEST FOR RECONSIDERATION - PARENT APPLICATION

Applicant submits the following amendments and remarks in response to the Office Action dated December 19, 2007.

AMENDMENT

In the concurrently filed Request to Divide, Applicant has divided some of the goods out of Application No. 78/911,856. The following goods remain in this "parent" application:

Audio cassette recorders; audio cassette players; audio speakers; binoculars; calculators; camcorders; cameras; CD-ROM drives (as part of the computer); CD-ROM writers (as part of the computer); cellular telephones; cellular telephone accessories, namely, headsets, earpieces, batteries and converters; cellular telephone cases; face plates for cellular telephones; compact disc players; compact disc recorders; compact discs; computers; computer hardware; computer keyboards; computer monitors; computer mouse; computer disc drives; cordless telephones; digital cameras; DVD players; DVD recorders; digital versatile discs; digital video discs; electronic personal organizers; eyeglasses; headphones; karaoke machines; microphones; MP3 players; modems (as part of a computer); pagers; personal stereos; personal digital assistants; printers; radios; sunglasses; telephones; television sets; video cameras; video cassette recorders; video cassette players; videophones; computer game programs; computer game cartridges

and discs; video game cartridges; video game discs; walkie-talkies; decorative magnets; eyeglass cases; mouse pads; wrist and arm rests for use with computers

REMARKS

1. The Mark PETER PAN is Not Merely Descriptive for the Goods Remaining in the Parent Application

The Examining Attorney has finally refused registration of Applicant's mark only as to certain of Applicant's Class 9 goods that have a "subject matter," on the grounds that when used in connection with these types of goods, the mark describes the subject matter of a creative work in the public domain. The Examining Attorney has noted that for certain other types of Class 9 goods, such as those covered by the third-party registrations listed in Applicant's October 4, 2007 response to office action, registration of such marks is appropriate because the goods themselves do not have a subject matter. The Examining Attorney noted "gaming devices, binoculars, computer game software, [and] casino gaming devices" as specific examples of Class 9 goods covered by the listed third-party registrations that do not have a subject matter, and for which these public domain creative work marks are not merely descriptive.

Accordingly, Applicant has divided the goods that do have a subject matter out of this application (such as audiovisual recordings) into a "child" application, leaving only those items which do not contain a subject matter in this "parent" application. As to the amended list of non-subject matter goods in this parent application, Applicant respectfully submits that the mark is not merely descriptive for these goods, and requests that the application be approved for publication.

Respectfully submitted,

Disney Enterprises, Inc.

Dated: June 18, 2008

By: David M. Kelly

David M. Kelly
Linda K. McLeod
Attorney for Applicant

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Examining Atty: Dezmona J. Mizelle-Howard, Esq.
Law Office: 110

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REQUEST FOR RECONSIDERATION - CHILD APPLICATION

Applicant submits the following amendments and remarks in response to the Office Action dated December 19, 2007.

AMENDMENTS

In the concurrently filed **Request to Divide**, Applicant has divided some of the goods out of Application No. 78/911,856. The following goods have been divided into the "child" application:

Pre-recorded audio cassettes, audio discs, and compact discs and laser video discs featuring music, stories, games, and activities for children; pre-recorded CD-ROMs featuring music, stories, games, and activities for children; computer software; pre-recorded DVDs, digital video discs, and digital versatile discs featuring animated and live action entertainment, motion picture films, and television shows, stories, games, music, and activities for children; motion picture films; pre-recorded video cassettes featuring animated and live action entertainment, motion picture films, television shows, stories, and music

This response pertains to the goods that have been divided into the child application.

Applicant also requests that this **list of goods be amended** to read as follows:

Pre-recorded audio discs, and compact discs featuring music; pre-recorded DVDs, digital video discs, and digital versatile discs featuring animated entertainment, motion picture films, and music

Applicant submits an **Amendment to Allege** Use together with an appropriate specimen as Exhibit A.

Finally, Applicant requests that the child application be amended to seek registration of the mark under **Section 2(f)** based on a claim of acquired distinctiveness. Applicant submits a duly executed Declaration under Section 2(f) (Exhibit B).

REMARKS

1. The Mark PETER PAN Has Become Distinctive as to the Class 9 Products Divided Into the Child Application

The Examining Attorney has finally refused registration of Applicant's mark only as to certain of Applicant's Class 9 goods that have a "subject matter," on the grounds that when used in connection with these types of goods, the mark describes the subject matter of a creative work in the public domain. Applicant has divided these goods out of the application, and has amended the list as noted above.

As for the amended goods, the mark PETER PAN has become distinctive of Applicant's goods through its exclusive and continuous use of this mark in commerce for more than five years. Specifically, Applicant has offered audio discs in connection with the PETER PAN mark for at least ten years, since as early as 1998, and it has offered DVDs under the mark for a period of at least five years, from 1999 to present. As noted above, Applicant has amended the application to seek registration of the mark under Section 2(f) based on a claim of acquired distinctiveness. In that regard, Applicant submits a Declaration stating that the Applicant believes that the mark PETER

PAN has become distinctive, as applied to the Applicant's goods, by reason of substantially exclusive and continuous use thereof as a mark by the Applicant in commerce for more than five years since at least 1999 (and longer for some of the goods). Applicant submits that this Declaration is sufficient to establish acquired distinctiveness in the mark sought to be registered.

Accordingly, Applicant requests that the refusal to register the list of amended goods covered by this "child" application on the ground that the mark is merely descriptive be withdrawn and Applicant's claim of acquired distinctiveness under Section 2(f) entered into the record.

Respectfully submitted,

Disney Enterprises, Inc.

Dated: June 18, 2008

By: David M. Kelly
David M. Kelly
Linda K. McLeod
Attorney for Applicant

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