

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Disney Enterprises, Inc.
Serial Number: 88297986
Filing Date: February 12, 2019
Mark: DISNEY

Examining Atty.: Matthew Scott Tully
Law Office: 105

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

RESPONSE TO OFFICE ACTION

Disney Enterprises, Inc. ("Applicant") submits the following amendments and remarks in response to the Office Action dated March 7, 2019.

AMENDMENTS

Please replace the current identification of services with the following (as amended, "Applicant's Amended Services"):

Retail store services and on-line retail store services featuring clothing, headwear, footwear, jewelry, toys, dolls, games, figurines, sporting goods, electronics, videos, books, music, frames, furniture, bed linen, bath linen, household linen, jewelry, watches, stationery, tableware, personal care items, hair accessories, holiday decorations, gift items and souvenirs, collectibles, costumes, post cards, bags, backpacks, luggage, luggage tags, mobile device cases and covers, cameras, computer software, computer games, school supplies, housewares, infant seats and carriers, infantwear, artwork, CDs, DVDs, and sunglasses

Please amend the application to include the following Section 2(f) claims:

The mark has become distinctive of the services as evidenced by the ownership on the Principal Register for the same mark for sufficiently similar goods/services of active U.S. Registration Nos. 1162727, 2888282, 3088198, 3235413, 3328006, 3328009, 3340426, 3410201, 3432510, 3490082, 4208634, 4063531, and 4042815.

The mark has become distinctive of the services through Applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

REMARKS

As requested, the Applicant has clarified the description of services and amended the application to include a declaration under Section 2(f).

SURNAME REFUSAL

The Examining Attorney has initially refused registration of Applicant's mark DISNEY ("Applicant's Mark") under Section 2(e)(4), 15 U.S.C. § 1052(e)(4), on the ground that the mark is primarily merely a surname. In support of his refusal, the Examining Attorney submitted listings from www.lexis.com and other sources concerning the word DISNEY. (Office Action, p. 3.) Applicant submits that its DISNEY mark has acquired distinctiveness under Section 2(f) and is thus registrable on the Principal Register.

Applicant's mark has acquired distinctiveness under Section 2(f) by virtue of its ownership of active U.S. Registration Nos. 1162727, 2888282, 3088198, 3235413, 3328006, 3328009, 3340426, 3410201, 3432510, 3490082, 4208634, 4063531, and 4042815, all of which are for the same mark DISNEY and cover goods closely related to Applicant's services. Additionally, as noted in Applicant's Declaration Under Section 2(f), Applicant's DISNEY mark has been in use for retail store services since 1987, and the DISNEY mark has become distinctive of the services through Applicant's substantially exclusive and continuous use of the mark in commerce that the U.S. Congress may lawfully regulate for at least the five years immediately before the date of this statement.

Accordingly, Applicant requests that the surname refusal be withdrawn.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw his refusal of registration and allow the application to proceed to publication on the Principal Register under Section 2(f).