Attorney Docket No. 6182.10499

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Marvel Characters, Inc.
Serial Number: 88419777
Filing Date: May 7, 2019
Mark: TOY BIZ

Examining Atty.: Carrie Young, Esq.
Law Office: 117

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

RESPONSE TO OFFICE ACTION

Marvel Characters, Inc. ("Applicant") submits the following amendments and remarks in response to the Office Action dated July 20, 2019 (the "Office Action".)

AMENDMENTS

Please amend the description of goods as follows ("Applicant's Amended Goods"):

> Apparatus for recording, transmission, processing, and reproduction of sound, images, or data; digital media, namely, pre-recorded downloadable audio and video recordings, CDs, DVDs, high definition digital discs, mp3 files and mp4 files featuring live-action entertainment, animated entertainment, music and stories; audio books featuring fiction or audio books featuring non-fiction; downloadable ringtones featuring music and other sounds, via a global computer network and wireless communication devices; audio and visual recordings featuring live-action entertainment, animated entertainment, music, stories, and games; musical recordings; downloadable electronic publications in the nature of comic books, comic magazines and stories in illustrated form; downloadable computer game software; downloadable mobile applications for viewing, playing, and purchasing animated entertainment and electronic games; downloadable video game software; computer software for the administration of learning activities; encoded electronic chip cards containing music, stories,

dramatic performances, non-dramatic performances, and learning activities; computer hardware and computer peripheral devices; mouse pads; wrist and arm rests for use with computers; calculators; cell phone battery chargers; electronic personal organizers; cameras; digital cameras; optical, digital versatile, and compact disc players and recorders for audio, video, and computer data; radios; audio speakers; digital photo frames; headphones; earphones; ear buds; walkie-talkies; telephones; headsets for cellular telephones; adapters for cellular telephones in the nature of power adapters; batteries for cellular telephones; cell phone cases; face plates for cellular telephones; eyeglasses; sunglasses; eyeglass and sunglass cases; binoculars; decorative magnets; graduated rulers; microphones; protective covers and cases for tablet computers; radio frequency authentication device in the nature of identification tag readers and radio frequency transmitter; smart watches; fitted plastic films known as skins for covering and protecting electronic apparatus, namely, mobile phones, portable music players, mobile computers, and tablet computers; video projectors; video projector with wireless connection capability for use with wireless communication devices; karaoke machines; bicycle helmets; flotation vests; protective face masks not for medical purposes; protective helmets for sports; snorkels; swimming goggles; swim masks

DISCLAIMER REQUIREMENT

The Examining Attorney has required a disclaimer of "toy" apart from the mark as shown on the ground that it is merely descriptive and unregistrable under Trademark Act Section 6, 15 U.S.C. §1056(a). *See* TMEP §§1213, 1213.03(a).

A term is merely descriptive and requires a disclaimer "if it *immediately* describes an ingredient, quality, characteristic or feature thereof or if it directly conveys information regarding the nature, function, purpose or use of the goods or services." *In re Intelligent Instrumentation Inc.*, 40 USPQ2d 1792, 1792 (TTAB 1996) (emphasis added); *see also In re Bright-Crest, Ltd.*, 204 USPQ 591, 593 (TTAB 1979); *In re Abcor Dev. Corp.*, 588 F.2d 811, 200 USPQ 215 (CCPA 1978); TMEP § 1213 *et seq*. The Federal Circuit in *In re Driven Innovations, Inc*. 115 USPQ2d 1261 (TTAB 2015) also made clear that "if the mental leap between the word and the [good's] attributes is *not almost instantaneous*, this strongly indicates suggestiveness, not direct descriptiveness." *See also Nautilus*

Grp., Inc. v. ICON Health & Fitness, Inc., 372 F.3d 1330, 1340 (Fed. Cir. 2012). Similarly, a term that suggests a number of things but falls short of describing the goods with any "degree of particularity" is suggestive, and not merely descriptive. *See In re TMS Corp. of Americas*, 200 USPQ 57, 59 (TTAB 1978).

According to the Examining Attorney, "evidence from an online dictionary shows this wording ["toy"] means 'something that provides amusement.'" The Examining Attorney contends that term "toy" merely informs consumers that the Applicant provides goods, such as its game software, microphones and mobile applications, that are provided for amusement.

In reviewing the Examining Attorney's evidence, however, the first definition of "toy" is "an object for a child to play with" and other entries define the term as "an object designed to be played with," and "an object, often a small representation of something familiar, as an animal or person, for children to play with; plaything." Instead of relying on these primary and commonly understood definitions, the Examining Attorney argues that her vague dictionary meaning "something that provides amusement" is applicable in this case. Applicant submits that the Examining Attorney's secondary definition is itself too vague and indefinite in relation to Applicant's Amended Goods. Indeed, "something that provides amusement" could vaguely relate any number of products ranging from magazines to skis and bubble bath to DVDs, but none of those products, like Applicant's Amended Goods, have anything even remotely to do with toys.

In this case, "toy" does not *immediately* and *instantaneously* describe all of Applicant's Amended Goods. For example, Applicant's "batteries for cellular telephones; cell phone cases; face plates for cellular telephones," "encoded electronic

chip cards containing music, stories, dramatic performances, non-dramatic performances, and learning activities; computer hardware and computer peripheral devices; mouse pads; wrist and arm rests for use with computers; calculators; cell phone battery chargers; electronic personal organizers," "apparatus for recording, transmission, processing, and reproduction of sound, images, or data; digital media, namely, pre-recorded downloadable audio and video recordings, CDs, DVDs, high definition digital discs, mp3 files and mp4 files featuring live-action entertainment, animated entertainment, music and stories; audio books featuring fiction or audio books featuring non-fiction; downloadable ringtones featuring music and other sounds, via a global computer network and wireless communication devices," and many other items listed in Applicant's Amended Goods in Class 9, are not "playthings" in the nature of toys.

Although Applicant contests the Examining Attorney's disclaimer requirement as wrong, vague, and overbroad as applied to all of Applicant's Amended Goods in Class 9, Applicant has agreed to enter a partial disclaimer of the word "TOY" as to "games" as stated below:

No claim is made to the exclusive right to TOY apart from the mark as shown as to: **"**downloadable computer game software; downloadable mobile applications for viewing, playing, and purchasing electronic games; downloadable video game software."

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the application be approved for publication.