

I. Refusal Based on Likelihood of Confusion

Pursuant to Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), the Examining Attorney has refused registration of the subject mark based on prior registrations for (1) DCP ENTERTAINMENT and Design, Registration No. 5,539,366 and (2) DCP ENTERTAINMENT, Registration No. 5,488,540, both covering “Business consulting services relating to the development, creation, marketing and distribution of films, television shows, online videos, podcasts and radio programming” in Class 35 and “Entertainment services in the nature of the development, creation, production, post-production and distribution of films, television shows, online videos, podcasts and radio programming” in Class 41 in the name of Christopher Colbert. Applicant respectfully asserts that there is no likelihood of confusion between the cited mark and Applicant’s mark in practice if such marks were to co-exist.

In re E.I. du Pont de Nemours & Co., 476 F. 2d 1357 (1973), sets forth the factors in determining likelihood of confusion under §2(d) of the Lanham Act. The first factor under the likelihood of confusion test is whether there is a similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. When determining likelihood of confusion, the similarity or dissimilarity of marks in their entireties as to appearance, sound, connotation, and commercial impression, must be considered.” *See Massey Junior College, Inc. v. Fashion Institute of Technology*, 492 F.2d. 1399, 181 U.S.P.Q. 272 (CCPA 1974).

The common element between Applicant’s mark and the cited mark is the acronym DCP. While the mere addition or deletion of a word from a mark is not necessarily sufficient to overcome a likelihood of confusion, such a concession can be made where the marks in their entireties convey significantly different commercial impressions. In this instance, the addition of

the words ENTERTAINMENT and the use of a distinctive design element create a discernible commercial impression separate and apart from DCP alone. Simply by virtue of the additional terminology and design elements in Registrant's marks, the appearance of the cited marks is markedly different from Applicant's mark. Similarity of the marks in one regard will not automatically result in a finding of likelihood of confusion even where the goods or services are identical or closely related. Marks are perceived in their entireties, and all components given appropriate weight. *Opryland USA, Inc. v. Great Am. Music Show, Inc.*, 970 F.2d 847.

Applicant's simple acronym, constituting merely the addition of the letter "P" to its established DC mark (see prior Registration Nos. 4,577,397, 3,685,452 and 1,493,611, all claimed herein), "dcp" as a whole referring to "dick clark productions." As such, the commercial impression a perspective customer would have upon encountering the marks of the parties is entirely different, as Registrant's DCP acronym refers to a "process," namely "Digital Cinema Packages," a specific term of art referring to a collection of digital files used to store and convey audio, image, and data streams, whereas Applicant's mark refers to itself, a television and film production company. Indeed, Applicant has no connection nor does it engage in Digital Cinema Packages, as does the cited Registrant. To this end, Applicant has amended its recitation of services to reflect this fact. As such, the Applicant's mark and Registrant's marks have completely different commercial impressions as would be perceived by the relevant purchasing public.

Moreover, as noted by the Examiner, **Registrant has disclaimed its exclusive rights to use DCP in Registration No. 5,539,366 and Registration No. 5,488,540 rests on the Supplemental Register.** TMEP Section 1210 states "Typically, disclaimed matter will not be regarded as the dominant, or most significant, feature of a mark." Given the fact that the Registrant in the instant case has disclaimed its exclusive rights to this language, coupled with

the fact that Registrant has not made any showing that such language, as used in its mark, has acquired secondary meaning or is eligible for protection under Section 2(f) of the Act, Applicant should not be denied its right to register a mark incorporating an acronym with a completely discernible and non-descriptive meaning. In fact, Registrant's use of the DCP acronym, as an established term of art in its industry, is not just merely descriptive but generic and incapable of serving as an indicator of source, as opposed to Applicant's mark and the context in which it exists, namely as a mere extension of an established acronym identifying Applicant itself. Consumer confusion is, therefore, highly unlikely.

Considering the foregoing, it is respectfully submitted that the consumer purchasing Applicant's services or the services in the cited registration, is not likely to confuse Applicant's mark with the marks of the cited party, but rather identify Applicant's mark with Applicant and Applicant's services. In view of the above, Applicant respectfully requests that the Examining Attorney reconsider the potential refusal to register based on the marks in the cited registrations.

II. Refusal Based on Mere Descriptiveness

The Examining Attorney has also refused registration of the subject mark under Trademark Act Section 2(e)(1), 15 U.S.C. Section 1052(e)(1), on the ground that the mark merely describes a feature and characteristic of Applicant's services, predicated on the false notion that Applicant's acronym refers to "Digital Cinema Packages." Applicant respectfully requests that the Examining Attorney reconsider the refusal for the following reasons:

Applicant respectfully asserts that the mark DCP, as viewed within the context of the average consumer, especially those familiar with Dick Clark and the famous DC brand, will readily and certainly identify the new DCP mark as referring to "dick clark productions," the

longstanding name of Applicant, not the unrelated “Digital Cinema Packages” acronym referring to a term of art having nothing to do with Applicant or its activities.

TMEP Section 1209.01(b) dictates that:

the determination of whether or not a mark is merely descriptive must be made not in the abstract but, rather, in relation to the goods or services for which registration is sought; the context in which the mark is used, or intended to be used, in connection with those goods or services; and the possible significance which the mark would have, because of that context, to the average purchaser of the goods or services in the marketplace.

To be characterized as “merely descriptive,” a term must directly give some reasonably accurate or tolerably distinct knowledge of the characteristics of the product and/or services, and a substantial portion of the public must recognize it as such. *See Blisscraft of Hollywood v. United Plastics Co.*, 294 F.2d 694, 131 U.S.P.Q. 55 (2d Cir. 1961). Furthermore, a descriptive mark tells something about the goods or services whereas a suggestive mark requires imagination, thought, or perception to reach a conclusion as to the nature of the goods or services. (Quoting Judge Weinfeld in *Stix Products, Inc. v. United Merchants & Mfrs., Inc.*, 295 F. Supp. 479, 160 U.S.P.Q. 777 (S.D.N.Y. 1968)). (*See In re Shutts*, 217 U.S.P.Q. 363 (TTAB 1983) where the TTAB deemed the mark SNO-RAKE was suggestive, and not merely descriptive, for “a snow removal hand tool having a handle with a snow-removing head at one end . . .”)

If a consumer must exercise “mature thought or follow a multi-stage reasoning process” to determine attributes of the product or service, the term should be deemed suggestive, not descriptive. (*See In re Tennis in the Round, Inc.*, 199 U.S.P.Q. 496 (TTAB 1978) holding TENNIS IN THE ROUND not descriptive of tennis facilities.) (*See also Rodeo Collection, Ltd. v. West Seventh*, 812 F. 2d 1215, 2 U.S.P.Q.2d 1204, 1206 (9th Cir. 1987), holding that if a

purchaser of a product uses more than a slight amount of imagination to make an association with that products attributes, the mark is suggestive, not descriptive.)

In addition, if there is not an instantaneous mental leap between the mark and the product or service's characteristics, there is a strong indication that the term is not descriptive, but suggestive. (*See Public Service Co. of New Mexico v. Nexus Energy Software, Inc.*, 36 F.Supp.2d 436, 50 U.S.P.Q.2d 1317 (D. Mass. 1999), holding ENERGY PLACE was not merely descriptive of an Internet web site providing information on energy resources and *Equine Technologies, Inc. v. Equitechnology, Inc.*, 68 F.3d 54236 U.S.P.Q.2d 1659 (1st Cir 1995), holding that imagination was required to connect the mark EQUINE TECHNOLOGIES to horse hoof care products.)

Applying the above relevant case law, the mark DCP should be found not merely descriptive. In order for a term to be refused registration under Lanham Act §2(e)(1), it must be merely descriptive, that is, its primary and only significance must be one of descriptiveness. If it has other significant meanings and connotations, such mark should not be deemed merely descriptive. Surely the average consumer would not instantaneously mentally connect Applicant's mark to "Digital Cinema Packages," but rather, again, to Applicant itself. Indeed, the mark DCP, within the context of Applicant itself and its longstanding use of DC, is not merely descriptive, but is rather a direct reference to the entity seeking registration, the very benchmark of an indicator of source. Consumers viewing the mark DCP, will not immediately perceive, without forethought, deliberation or hesitation, that the services offered by Applicant are "Digital Cinema Packages" but rather refers to the famous production company. In this way, the mark boasts another significant meaning requiring consumers to reach other concepts or characteristics of the nature of the subject services than an established term of art having no

relation to Applicant itself. To this end, Applicant has amended its services to reflect that none of its activities relate to “Digital Cinema Packages.”

“If there is doubt on the question of mere descriptiveness, and we profess this case presents such a doubt, that doubt must be resolved in favor of Applicant.” *See In re Intelligent Medical Systems Inc.*, 5 USPQ2d 1674 (TTAB 1987) and cases cited therein.

Therefore, based on the arguments presented above, Applicant respectfully requests that the refusal to register under § 2(e)(1), that the mark is merely descriptive of a feature and characteristic of Applicant’s goods and/or services, be withdrawn.