

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: Universal City Studios LLC and Amblin')
Entertainment, Inc.)
)
Mark: GENERATION JURASSIC) Kim T. Moninghoff
) Examining Attorney
Serial No.: 88/883143) Law Office 113
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Int'l Class: 35)
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Filing Date: April 22, 2020)
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APPLICANTS' RESPONSE TO THE OFFICE ACTION

INTRODUCTION

On June 1, 2020, the Examining Attorney issued an Office Action on this application refusing registration of Applicants' mark GENERATION JURASSIC for Class 35 services under § 1, 2, 3, and 45 of the Trademark Act on the grounds that the Applicants' own several registrations for marks that include the term JURASSIC for goods and services consisting of and relating to motion picture films, and thus, the applied-for services in this application appear to be marketing, promotion and advertising of the applicants' own motion picture franchise.

In this response, Applicant respectfully traverses the refusal of registration under § 1, 2, 3, and 45.

ARGUMENT TRAVERSING REFUSAL OF REGISTRATION

Applicants have applied for registration of the mark GENERATION JURASSIC in standard character form for:

Entertainment marketing services, namely, marketing, promotion and advertising for a motion picture franchise, in Class 35.

The Examining Attorney states that the applicants own several registrations for marks that include the term JURASSIC for goods and services consisting of and relating to motion picture films and attached a representative sample. Thus, the Examining Attorney states that the applied-for services in this application appear to be marketing, promotion and advertising of the applicants' own motion picture franchise, not the marketing, promotion and advertising of other parties' motion picture franchises.

The Examining Attorney reviewed the application using the following criteria to determine whether the services are registrable:

- (1) A service is a real activity, not an idea, concept, process, or system.
- (2) A service is performed primarily for the benefit of someone other than the applicant.
- (3) A service is an activity that is sufficiently separate and qualitatively different from an applicant's principal activity, i.e., it cannot be an activity that is merely incidental or necessary to an applicant's larger business.

Using these criteria, the Examining Attorney states the applicants' marketing, promotion and advertising activities are not registrable services because they are not sufficiently separate and qualitatively different from an applicants' principal activity of providing motion picture films and because they will be performed primarily for the benefit of the applicants. Applicant respectfully disagrees.

The Applicants' mark GENERATION JURASSIC will be used as a marketing campaign by licensees, who are mass market third-party online and in-store retailers, for the promotion and advertising of a wide variety of consumer products related to a franchise property derived from a motion picture series. The campaign will be promoted via marketing materials, such as in-store signage, digital spots, social media accounts, and online branded pages. To provide you with some a representative example, please see the Exhibit A, attached hereto. This is the page on Target's website that is dedicated to our DreamWorks Trolls World Tour. You will see that there is merchandise, but also activities, crafts and links to content. This is a Target initiative for the property. It is clearly not only to increase sales of the motion picture films, but rather to increase the interest in the property generally and the merchandise in particular. In this case the page was branded Trolls, which is not the film title.

Another prior example of a similar use was the use of the tagline TRUE COLORS by Target and the hardware store True Value also for Applicant's Trolls property. See Exhibit B U.S. Serial No. 86906420, abandoned following publication. You can see Target's execution of these advertisements in these videos. <https://vimeo.com/231033307> and <https://vimeo.com/231033217>. In the brick and mortar stores, this marketing translated into end caps and signage featuring the tagline TRUE COLORS throughout the stores. This tagline was also used by True Value as shown in the in-store signage here:



The use and execution of this tagline was controlled by the third party retailer and not Applicant.

GENERATION JURASSIC would be used in a similar manner. It is branding for a third party's page, but not for a particular film or television title. This is merely call to mind the entire film and television franchise, which is not limited to the Jurassic Park films or the Jurassic World films, but also the television series and specials, including Jurassic World Double Trouble and Jurassic World Camp Cretaceous and also the amusement park attractions, including Jurassic World The Ride and Jurassic Park River Adventure. Third party retailers will be using this name to market this overall execution to drive revenue to their own retailer and not to the Applicant.

The Applicants' proposed use satisfies the first criterion by which the Examining Attorney used to determine whether the services are registrable because the service is a real activity of marketing, promotion, and advertising. The second criterion is also satisfied because as the service is performed primarily for the benefit of the Applicants' licensees, who are third-party retailers. Finally, the third criterion is satisfied because the service is sufficiently separate from the applicant's principal activities, which are entertainment services, namely, the production and distribution of motion picture films.

CONCLUSION

For all of the foregoing reasons, Applicant respectfully requests that the Examining Attorney withdraw the refusal of registration under § 1, 2, 3, and 45 of the Trademark Act and approve the application for publication for opposition.

Respectfully submitted,

Dated: November 24, 2020

/Monique Cheng Joe/

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