IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Mark:	**GENERATION JURASSIC**	)	Examining Attorney:
		)	Kim Teresa Moninghoff,
Applicants:	Universal City Studios LLC and Amblin' Entertainment, Inc.	)	Law Office 113
Serial No.:	88/883,143	)	
Filed:	April 22, 2020	)	
Class:	35	)	

RESPONSE TO OFFICE ACTION

The Examining Attorney issued a first, non-final Office Action (the "First Office Action") against Serial No. 88/883,143 (the "Application") on June 1, 2020. Applicants Universal City Studios LLC and Amblin' Entertainment, Inc. ("Applicants") timely filed a response to this First Office Action on November 24, 2020 (the "First Response"). Applicants now respond to the Examining Attorney's second, non-final Office Action dated December 16, 2020 (the "Second Office Action") issued against the Application.

OBJECTION: EVIDENCE NOT OF RECORD

With their First Response, Applicants cited two hyperlinks to audio-visual evidence that supported their arguments against the Examining Attorney's initial refusal to register. In the Second Office Action, the Examining Attorney has objected to this audio-visual evidence on the grounds that Applicants did not comply with T.M.E.P. § 710.01(b) for making this type of evidence of record. Respectfully, Applicants request that the Examining Attorney consider the

audio-visual evidence annexed as **Exhibit A** with this Response as complying with T.M.E.P. § 710.01(b).[1]

REQUEST FOR INFORMATION

The Examining Attorney has requested that Applicants respond to the following requests for information:

1. *"Do the applicants plan to license the mark to multiple (more than one independent) retailers?"*

Answer: Yes.

2. *"Will the uses of the mark be controlled by each of those retailers (licensees)?"*

Answer: No. Applicants will control the nature and quality of the marketing, advertising, and promotion services rendered by their licensees under the GENERATION JURASSIC mark. In the First Response, Applicants had explained that "the use and execution of [the GENERATION JURASSIC mark] was controlled by the third[-]party retailer and not Applicant[s]." To be clear, this referred only to the fact that these licensees would be responsible for actually executing the marketing campaign in their own in-person and online marketplaces. As the owners of the GENERATION JURASSIC mark, Applicants will exercise adequate control over the nature and quality of these services rendered by their licensees.

ARGUMENT

In the Second Office Action, the Examining Attorney has refused to register the mark GENERATION JURASSIC (the "Mark") in the Application on the following two grounds: (1) the services claimed in the Application do not constitute "registrable services" under Sections 1, 2, 3, and 45 of the United States Trademark Act, 15 U.S.C. §§ 1051-1053, 1127; and (2) the Mark does not function as a service mark under Sections 1, 2, 3, and 45 of the United States Trademark Act, 15 U.S.C. §§ 1051-1053, 1127. Respectfully, Applicants disagree with the Examining Attorney and submit the following arguments and evidence in support of registration of the Mark on the

[1] We note that the Examining Attorney has asserted that they Applicant has filed this application in Class 41. We respectfully note that this mark is applied for in Class 35.

Principal Register.

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I. THE MARKETING, PROMOTION, AND ADVERTISING ACTIVITIES CLAIMED IN THE APPLICATION ARE REGISTRABLE SERVICES UNDER THE TRADEMARK ACT.

While the Trademark Act does not define exactly what constitutes a "service," the Federal Circuit and the Trademark Trial and Appeal Board (the "Board") have interpreted this term broadly. *In re Advert. & Mktg. Dev., Inc.*, 821 F.2d 614, 618 (Fed. Cir. 1987); *In Re Forbes Inc.*, 31 U.S.P.Q.2d 1315 (T.T.A.B. 1994); T.M.E.P. § 1301. As the Examining Attorney has recognized, the following criteria is applied to determine if an activity is a registrable service under the Trademark Act:

"(1) [A] service must be a real activity;

(2) [A] service must be performed to the order of, or for the benefit of, someone other than the applicant; and

(3) [T]he activity performed must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service." T.M.E.P. § 1301.01(a) (citing *In re Canadian Pac. Ltd.*, 754 F.2d 992, 224 U.S.P.Q. 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 U.S.P.Q. 89 (T.T.A.B. 1984); *In re Integrated Res., Inc.*, 218 U.S.P.Q. 829 (T.T.A.B. 1983); *In re Landmark Commc'ns, Inc.*, 204 U.S.P.Q. 692 (T.T.A.B. 1979)). Here, the services described in the Application satisfy all three requirements.

A. The Applied-For Services Constitute "a Real Activity" and Are Not Merely An Idea, Concept, Process, or System.

First, in order for an activity to be a registrable service within the Trademark Act, it "must be a real activity" as opposed to a mere idea, concept, system, process, or method.

T.M.E.P. § 1301.01(a)(i). Here, Applicants will license their GENERATION JURASSIC mark to be used by mass-market, third-party online, and in-store retailers (the "Licensees") to promote and advertise a wide variety of consumer products using Applicants' intangible property derived from the entire JURASSIC PARK and JURASSIC WORLD franchise.

Importantly, the Board already has acknowledged that licensing intangible property to others for use in connection with the marketing of licensees' goods is a registrable service analogous to the leasing or renting of tangible property. T.M.E.P. § 1301.01(a)(ii) ("Licensing intangible property has been recognized as a separate service, analogous to leasing or renting tangible property, that primarily benefits the licensee.") (citing *In re Universal Press Syndicate*, 229 U.S.P.Q. 638 (T.T.A.B. 1986)). In *Universal Press Syndicate*, the Board held that applications for applicant's licensing activities—namely, making available the use of the CATHY cartoon character in connection with marketing the goods of its licensees—, rendered the mark registrable because the activity conferred a "real" benefit on the licensees and was not merely incidental to applicant's larger magazine and newspaper cartoon-strip business based on the CATHY cartoon character. *Id*.

The services in the Application are no different. Here, Applicants will make available the use of the GENERATION JURASSIC mark to their Licensees in connection with the marketing of the goods of its Licensees based on the JURASSIC PARK and JURASSIC WORLD film franchise. Just like the licensing of the CATHY comic-strip character, Applicants' licensing of its GENERATION JURASSIC mark is a "real" service, conferring a "real" benefit on Applicants' Licensees, and is not "merely incidental" to the media franchise based on Applicants' motion-picture films under the JURASSIC marks. The fact that the applied-for

services will be rendered in connection with a motion-picture franchise does not render them any less "real."

Nevertheless, the Examining Attorney has rejected the Application because it does not broadly specify the services as "just marketing, promotion, and advertising; [rather, these services] are specifically limited to 'a motion picture franchise,' and the franchise is owned by the [A]pplicants." Under this rationale, the Examining Attorney would effectively preclude registration of all marketing, promotion, and advertising services if validly rendered by a licensee under the trademark owner's mark. In addition, under such rationale, the Applicant would be penalized for providing additional specificity on its intended use. It is respectfully submitted that the Examining Attorney's analysis is unsupported, and such position is not in line with either public policy or TMEP practice. In fact, there are several examples of other well-known entertainment franchise marks that have registered for similar marketing, promotion, and advertising services, as evidenced by the following non-exhaustive, representative examples:

Registered Mark	Registration Details	Services in Cl. 35
MARVEL	Reg. No.: 3,602,026 Reg. Date: April 7, 2009	Cl 35: advertising and promoting the goods and services of others in association with comic-book characters
SUPERMAN	Reg. No.: 1,216,976 Reg. Date: November 16, 1982	Cl 35: advertising and promotional services—namely, creating advertising for others incorporating comic-strip materials
INCREDIBLE HULK	Reg. No.: 1,286,338 Reg. Date: July 17, 1984	Cl 35: advertising the goods and services of others in association with comic-strip characters
POKEMON	Reg. No.: 4,071,285 Reg. Date: December 13, 2011	Cl 35: providing incentive-award programs for customers through the distribution of prizes, awards, and promotional items, all for the purpose of promoting and rewarding loyalty

	Reg. No.: 1,308,279 (cancelled on non-use grounds) Reg. Date: December 4, 1984	Cl 35: rendering advertising and marketing assistance in promoting the sale of resilient surface coverings for the floor covering distributor trade
CATHY REMEMBERS	Reg. No.: 1,403,379 (cancelled on non-use grounds) Reg. Date: July 29, 1986	Cl 35: cartoon-character licensing services
	Reg. No.: 1,404,325 (cancelled on non-use grounds) Reg. Date: August 5, 1986	Cl 35: cartoon-character licensing services

Annexed hereto as **Exhibit B** are true and correct copies of each of these registrations issued by the U.S.P.T.O. Applicants are no different than the owners of these registered marks, and their services are no different than the services listed in these registrations. In light of the foregoing, the applied-for services constitute a real and registrable activity.

B. The Applied-For Services Benefit Someone Other Than Applicants.

Second, a real activity is a registrable "service" if it benefits someone other than the applicant. T.M.E.P. § 1301.01(a). As explained *supra*, this includes a licensee of an applicant's services. *Id.* § 1301.01(a)(ii) ("Licensing intangible property has been recognized as a separate service . . . that primarily benefits the *licensee*.") (emphasis added) (citing *In re Universal Press Syndicate*, 229 U.S.P.Q. 638).

It is respectfully submitted that the Examining Attorney appears to have conflated the issue of a licensee's use inuring to the benefit of the applicant, for purposes of determining ownership rights in a mark, with the economic benefits *resulting from* such use, and the fact that those will often inure primarily to the licensee. *See* §§ 1201.03, 1201.03(e) ("Ownership rights in a . . . service mark may be acquired and maintained through the use of the mark by a controlled licensee . . . [T]he key to ownership is the nature and extent of the control by the applicant over

the goods or services to which the mark is applied.") The issue of whether a licensee's use may inure to the applicant through sufficient control is inapposite to whether services "benefit" someone other than the Applicants, namely, the Licensees, which they primarily benefit, as the Board held in *In Re Universal Press Syndicate*.

The Examining Attorney cited two cases to support her position, but each of these cases instead further supports Applicants' position regarding the relationship between a trademark owner and a licensee. *See Turner v. HMH Publ'g Co.*, 380 F.2d 224, 229, 154 U.S.P.Q. 330, 334 (5th Cir. 1967), *cert. denied*, 389 U.S. 1006, 156 U.S.P.Q. 720 (1967) (holding plaintiffs' PLAYBOY registration valid because there was sufficient evidence of control displayed over the nature and quality of licensees' night-club operations); *Cent. Fid. Banks, Inc. v. First Bankers Corp. of Fla.*, 225 U.S.P.Q. 438, 440 (T.T.A.B. 1984) (holding petitioner had standing and ownership rights in THE TIME MACHINE mark for banking services through its control over its subsidiaries' use). While this issue is germane to showing how Licensees' use functions as a service mark for Applicants *infra*, it is the wrong issue to be applying here.

Applicants' marketing, advertising, and promotion services clearly benefit Licensees as well as third-party manufacturers whose goods are offered under the GENERATION JURASSIC mark in the Licensees' online and brick and mortar retail stores. Specifically, Licensees will use the GENERATION JURASSIC mark on their retail store signage, digital spots, social media, and other branded webpages to promote their retail stores and a wide variety of consumer products using intellectual property tied to the JURASSIC PARK and JURASSIC WORLD film and television franchise. A representative example of Licensees' intended use can be seen in Exhibit A to Applicants' First Response. This exhibit shows Target using the TROLLS WORLD TOUR mark on its online store to promote a diverse range of consumer products under

the Trolls theme, such as LEGO Trolls, Trolls-themed Band-Aids, a Trolls-themed toothbrush by Colgate, a Trolls-themed coloring book by Crayola, Trolls-themed Play-Doh, etc. This campaign would clearly benefit Target and the various manufacturers offering goods through Target's online and physical stores, not Applicants. Furthermore, the aforementioned use is essentially identical to the specimen submitted by DC Comics in support of their SUPERMAN registration, Reg. No. 1216976, which was accepted. This specimen showed a screenshot of the zazzle.com e-commerce platform using the SUPERMAN mark on the banner of an online store offering Superman branded merchandise. *See* DC Comics' SUPERMAN specimen in support of its advertising and promotional services incorporating comic strip materials annexed hereto as **Exhibit C**.

The fact that the services may also theoretically increase sales of Applicants' motion-picture films or other goods and services associated with the Applicants' marks is not dispositive of whether the applied-for services constitute a registrable activity. *In Re Congoleum Corp.*, 222 U.S.P.Q. 452, *4 (T.T.A.B. May 29, 1984) ("Applicant's activity of awarding prizes to retailers certainly has as one of its goals an increase in sales of its own flooring products. That fact alone does not lead inexorably to the conclusion that the activity engaged in under applicant's mark is not a service to distributors[.]"); *see also* T.M.E.P. § 1301 ("Titles and other distinctive features of radio or television programs "may be registered as service marks notwithstanding that they, or the programs, may advertise the goods of the sponsor.").

In *In re Congoleum Corporation*, the Examining Attorney initially refused registration of THE WONDERFUL WORLD OF CONGOLEUM mark for "rendering advertising and marketing assistance in promoting the sale of resilient surface coverings for the floor covering distributor trade" on the basis that the services were nothing more than a promotional scheme to

promote the sale of applicant's own flooring products. 222 U.S.P.Q. 452, *1 (T.T.A.B. May 29, 1984). In this case, the applicant's services took the form of a program that awarded retailers with points they could exchange for prizes if they purchased applicant's products or those of other manufacturers through applicant's distributors. *Id*. On appeal, the Board concluded that it seemed "obvious" that retailers might become consumers for products sold by both applicant and other manufacturers by participating in the program. *In re Congoleum*, at *4. Thus, the Board held that a benefit had been conferred on applicant's distributors, which was not within the normal scope of applicant's business of selling flooring products. *Id.*

The case presented here is even stronger. Applicants' services primarily benefit the sales of Licensees' goods and third-party manufacturers involved in the GENERATION JURASSIC marketing campaign, not Applicants' viewership or ticket sales for its films or amusement parks, as demonstrated *supra*.

Because the applied-for services primarily benefit Applicants' Licensees and other manufacturers offering goods under the GENERATION JURASSIC mark, the Application covers real and registrable services.

C. The Applied-For Services Are Separate and Qualitatively Different From Applicants' Principal Activity of Producing and Distributing Motion-Picture Films.

Third, a registrable service "must be qualitatively different from anything necessarily done in connection with the sale of the applicant's goods or the performance of another service." T.M.E.P. § 1301.01(a) (citing *In re Canadian Pac. Ltd.*, 754 F.2d 992, 224 U.S.P.Q. 971 (Fed. Cir. 1985); *In re Betz Paperchem, Inc.*, 222 U.S.P.Q. 89 (T.T.A.B. 1984); *In re Integrated Res., Inc.*, 218 U.S.P.Q. 829 (T.T.A.B. 1983); *In re Landmark Commc'ns, Inc.*, 204 U.S.P.Q. 692 (T.T.A.B. 1979)).

As explained, Applicants' GENERATION JURASSIC mark that will be used by their Licensees to increase the Licensees' sales of merchandise goods is a "qualitatively different and separate" service than that of Applicants' movie production and distribution service. Moreover, movie production and distribution is a business category that is well-known for generating substantial revenue for consumer product companies. Even if it were arguably considered ancillary to the movie production and distribution field, this would not "in itself mean that it is not a separately registrable service." T.M.E.P. § 1301.01(a)(iii). The distinction between movie production and distribution services and Applicants' applied-for services is supported by the registration of third-party marks like MARVEL, POKEMON, SUPERMAN, and INCREDIBLE HULK for similar advertising and promotion services based on intangible property associated with other film or cartoon-based franchises. *See* **Exhibit B**.

Further, Applicants' GENERATION JURASSIC mark is different from Applicants' JURASSIC WORLD, 

(JURASSIC WORLD Stylized & Design), JURASSIC PARK, and JURASSIC WORLD: FALLEN KINGDOM marks used in connection with its principal products and services, which also weighs in favor of establishing that an activity is a separate and registrable service. T.M.E.P. § 1301.01(a)(iii); *In Re Universal Press Syndicate*, 229 U.S.P.Q. 638, *2 (acknowledging the difference between the applied-for CATHY REMEMBERS mark for cartoon-character licensing services from applicant's CATHY mark for a cartoon character). GENERATION JURASSIC, as the name implies, is intended to evoke Applicants' entire JURASSIC PARK and JURASSIC WORLD franchise, including its many film and television series and specials and related amusement-park attractions. And it is

precisely this inclusive meaning that Applicants intend to align with its marketing campaign to promote a wide variety of consumer products, activities, crafts, and more.

Applicants, through its Licensees, also use the GENERATION JURASSIC mark solely in connection with the applied-for marketing, promotion, and advertising services, which confirms that such services are separate from Applicants' principal activity. *In Re Congoleum Corp.*, 222 U.S.P.Q. 452, *4 (T.T.A.B. May 29, 1984). Finally, Applicants' services confer a benefit to others that is unrelated to Applicants' motion picture films by increasing sales for Licensees' and third-party retail goods which further supports the distinct nature of the respective services. *See id.*

In light of the foregoing, Applicants' services are registrable because they are sufficiently separate and qualitatively different from its principal business.

II. THE GENERATION JURASSIC MARK FUNCTIONS AS A SERVICE MARK FOR APPLICANTS.

The Examining Attorney has also refused registration of the Application on the basis that the GENERATION JURASSIC mark allegedly "identifies a promotional campaign that applicants license to their customers for use in their business" and thus the mark does not function as a service mark for Applicants' advertising services. As explained above, a licensee's use of a mark for determining ownership rights is distinct from whether a licensee benefits or gains from such use. Whether Licensee's use of the Mark may inure to the benefit of Applicants falls squarely within the former, because ownership rights in a service mark may be acquired through use of a mark by a controlled licensee. T.M.E.P. § 1201.03(e).

The Examining Attorney cited *In re Advertising & Marketing Development, Inc.*, 821 F.2d 614, 2 U.S.P.Q.2d 2010 (Fed. Cir. 1987) and *In re Admark, Inc.*, 214 U.S.P.Q. 302 (T.T.A.B. 1982) in support of the proposition that the applied-for services cannot function as a service mark for

Applicants. These two decisions, however, are entirely distinguishable. In the former case, A & M created the campaign THE NOW GENERATION and licensed it to banks and automobile dealers for the purpose of advertising their own financial services and automobiles. *In re Advertising & Marketing Development, Inc.*, at 615. In *In re Admark, Inc.*, the licensees did not use the mark THE ROAD AUTHORITY for the recited advertising agency services, but for retail store services. 214 U.S.P.Q. 302 (T.T.A.B. Apr. 1, 1982).

The licensees in each of these cases did not use the marks licensed to them for the applied-for promotion services, but rather, to promote the *subject* of the relevant promotion and advertising services. Because the licensees were not using the licensed marks for the applied-for advertising or promotion services, their use did not inure to the benefit of the applicant/licensor. *See In re Admark, Inc.*, 214 U.S.P.Q. 302, *3 (T.T.A.B. Apr. 1, 1982) (related company use "is involved where a party other than the applicant is using the mark *in connection with the goods or services recited* in the application . . . Here, the licensees are not using the mark "THE ROAD AUTHORITY" in connection with the recited advertising agency services . . . The issue of related company use is, thus, not presented."); T.M.E.P. § 1201.03. Applicants' Licensees, by contrast, use the GENERATION JURASSIC mark to market, promote, and advertise a wide variety of consumer products under the theme of Applicants' Jurassic Park and Jurassic World franchise. Furthermore, Applicants have confirmed in their response to the Examining Attorney's Request for Information that they control the nature and quality of the services used by these Licensees. Therefore, use by these Licensees may inure to the benefit of Applicants such that the Mark may be registered to Applicants as a valid service mark. *In re Admark, Inc.*, 214 U.S.P.Q. at *3; T.M.E.P. § 1201.03(e).

The Application should be granted registration because the Mark identifies Applicants'

services and functions as a service mark for the Applicants by virtue of Licensees' use of the applied-for services.

CONCLUSION

Based on the foregoing, Applicants respectfully request that the Examining Attorney withdraw her refusals to register the Mark and publish the Mark for registration on the Principal Register.

Respectfully submitted,

Dated: June 11, 2021

/*Monique Cheng Joe*/
Monique Cheng Joe
Senior Vice President, Head of Brands and Content
Intellectual Property
NBCUniversal Media, LLC
100 Universal City Plaza, 1280/6
Universal City, CA 91608
monique.joe@nbcuni.com
(818) 777-2698