

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Disney Enterprises, Inc.
Serial Number: 90372850
Filing Date: December 10, 2020
Mark: LIGHTYEAR
Examining Atty: Matthew Tully, Esq.
Law Office: 105

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

RESPONSE TO OFFICE ACTION

Disney Enterprises, Inc. ("Applicant") submits the amendment and remarks in response to the Office Action dated March 25, 2021.

AMENDMENT

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

Paper; cardboard; address books; almanacs; appointment books; art prints; arts and craft paint kits; autograph books; baby books; baseball cards; binders; bookends; bookmarks; a series of fiction books; printed books, magazines, newsletters and periodicals, featuring stories, games and activities for children; bumper stickers; calendars; Christmas cards; chalk; children's activity books; coasters made of paper; coin albums; coloring books; printed children's coloring pages; comic books; printed comic strips; coupon books; crayons; decals; decorative paper centerpieces; diaries; drawing rulers; dry erase writing boards and writing surfaces; envelopes; erasers; foam stamps, namely, marking stamps and stamp pads; flash cards; gift wrapping paper; globes; greeting cards; guest books; general feature magazines; maps; memo pads; modeling clay; newspapers; notebooks; paintings; paper flags; paper cake decorations; paper gift cards; paper party decorations; paper napkins; paper party bags; paperweights; paper gift wrap bows; paper pennants; paper place mats; pen or pencil holders; pencil sharpeners; pen and pencil cases and boxes; photograph albums; photographs; photo-engravings; pictorial prints; picture books; plastic party goodie bags;

plastic name badges; plastic sandwich bags; portraits; postcards; posters; printed awards; printed certificates; printed invitations; printed menus; recipe books; rubber stamps; school supply kits containing various combinations of selected school supplies, namely, writing instruments, pens, pencils, mechanical pencils, erasers, markers, crayons, highlighter pens, folders, notebooks, paper, protractors, paper clips, pencil sharpeners, writing grips, glue and book marks; score cards; stamp albums; staplers; stationery; stickers; collectible trading cards; temporary tattoo transfers; writing implements; children's interactive educational books

As requested, Applicant has clarified the identification of goods to render it sufficiently definite for the purposes of registration.

REFUSALS

The Examining Attorney preliminarily refused Applicant’s LIGHTYEAR mark (“Applicant’s LIGHTYEAR Mark”) based on partial likelihoods of confusion with U.S. Reg. No. 3402856 for LIGHT YEARS in Class 18 and 25 (the “Cited LIGHT YEARS Mark”) and U.S. Reg. Nos. 4221000 for LIGHTYEAR in Class 9 and 41 and 5697806 for LIGHTYEAR for Classes 9, 16, 41 (the “Cited LIGHTYEAR Marks”) (collectively, the “Cited Marks”). The involved marks are shown in the chart below:

Mark	Reg. No. & Date	Goods/Services and Class(es)	Owner
LIGHT YEARS	3402856 March 25, 2008	Tote bags in Class 18 Class 25 omitted	Isenberg, Barbara
LIGHTYEAR	4221000 October 9, 2012	Children's educational music CDs and DVDs featuring children's performers singing songs for children, animated films featuring stories, myths, legends, and fairy tales; compact discs featuring music in many genres including pop, rap, rock, jazz, singer-songwriter, world music, and reggae; digital materials, namely, audio and video files featuring movies, documentaries, musical concerts, comedy concerts, and children's animated and live-	Lightyear Entertainment, L.P.

Mark	Reg. No. & Date	Goods/Services and Class(es)	Owner
		<p>action films; digital media, namely, pre-recorded DVDs, downloadable audio and video recordings, and CDs featuring and promoting musical content in a variety of genres, movies, documentaries, musical concerts, comedy concerts, and children's animated and live-action films; digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings, DVDs, and high definition digital discs featuring musical content in a variety of genres, movies, documentaries, musical concerts, comedy concerts, and children's animated and live-action films; digital media, namely, audio and video files featuring musical content in a variety of genres, movies, documentaries, musical concerts, comedy concerts, and children's animated and live-action films; pre-recorded CDs, video tapes, laser disks and DVDs featuring musical content in a variety of genres, movies, documentaries, musical concerts, comedy concerts, and children's animated and live-action films; pre-recorded DVDs featuring movies, documentaries, musical concerts, comedy concerts, and children's animated and live-action films in Class 9</p> <p>Production of DVDs featuring entertainment and educational programs including movies in the drama, comedy, science fiction, horror, and documentary genres, concerts featuring musical artists and comedy performers, and animated and live-action children's films featuring stories, myths, legends, and fairy tales; production of DVDs, videotapes and television programs featuring entertainment and educational programs including movies in the drama, comedy, science fiction, horror, and documentary genres, concerts featuring musical artists and comedy performers, and animated and live-action children's films featuring stories, myths, legends, and fairy tales in Class 41</p>	
LIGHTYEAR	5697806 March 12, 2019	Class 9 omitted Printed instructional, educational, and teaching materials <i>relating to human relations, effective</i>	Conrad Group Inc.

Mark	Reg. No. & Date	Goods/Services and Class(es)	Owner
		<p><i>communication, effective speaking and presentations, problem-solving, stress control, time management, personnel and customer relations, management, and development of self-confidence, leadership abilities, selling skills, vision and goal setting in Class 16</i></p> <p>Educational and instructional services, namely, providing live and online classes, courses, seminars, workshops, webcasts and podcasts <i>in the field of human relations, effective communication, effective speaking and presentations, problem-solving, stress control, time management, personnel and customer relations, management, and development of self-confidence, leadership abilities, selling skills, vision and goal setting in Class 41</i></p>	

The Examining Attorney identified the specific goods that relate to the partial 2(d) refusals, as follows:

- Applicant’s “shopping bags” and the “Tote bags” in Reg. No. 3402856
- Applicant’s “publications” and the electronic publications in Reg. No. 4221000
- Applicant’s “Paper and paper articles; cardboard and cardboard articles; printed matter; publications; books; photographs; ...office and school supplies; school supply kits;” and the printed materials in Reg. No. 5697806

For the following reasons, Applicant requests withdrawal of the partial 2(d) refusals.

I. Applicant’s Amended Goods Meet the Parameters in the Office Action

The Examining Attorney refused Applicant’s LIGHTYEAR Mark based on a partial likelihood of confusion with the Cited Marks. The Examining Attorney advised that the Applicant could delete the goods to which the refusal pertains from the application to overcome the partial 2(d) refusal. Applicant has deleted the terms “[plastic] shopping bags” and “publications” and provided more specificity as to the

paper articles, cardboard articles, printed matter, and school supplies. With respect to publications, Applicant has further clarified that such goods include “a series of fiction books; printed books, magazines, newsletters and periodicals, featuring stories, games and activities for children,” “children's activity books,” and “comic books; printed comic strips.” These subjects are unrelated to the “human relations, effective communication, effective speaking and presentations, problem-solving, stress control, time management, personnel and customer relations, management, and development of self-confidence, leadership abilities, selling skills, vision and goal setting” subject matter covered by Reg. No. 5697806. Moreover, Applicant notes that there are no electronic or other publications covered by the identification in Reg. No. 4221000. Accordingly, Applicant requests withdrawal of the partial 2(d) refusal because the conflicts have been eliminated by Applicant’s Amended Goods.

CONCLUSION

For the foregoing reasons, Applicant respectfully requests that the partial 2(d) refusals be withdrawn, and the application be approved for publication.