

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Disney Enterprises, Inc.
Serial Number: 90372871
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 24, 2021.

AMENDMENT

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

Action skill games; action figures; board games; card games; children's multiple activity toys; badminton sets; balloons; basketballs; bath toys; baseball bats; baseballs; beach balls; bean bags; bean bag dolls; bobblehead dolls; bowling balls; bubble making wand and solution sets; chess sets; toy imitation cosmetics; Christmas stockings; Christmas tree ornaments and decorations; collectable toy figures; crib mobiles; crib toys; disc toss toys; dolls; doll clothing; doll accessories; doll playsets; electric action toys; equipment sold as a unit for playing card games; fishing tackle; fishing rods; footballs; golf balls; golf gloves; golf ball markers; hand-held units for playing electronic games for use with or without an external display screen or monitor; hockey pucks; hockey sticks; infant toys; inflatable toys; inflatable pool toys; jigsaw puzzles; jump ropes; kites; magic tricks; marbles; manipulative games; mechanical toys; music box toys; musical toys; parlor games; party favors in the nature of small toys; paper party favors; paper party hats; party games; playing cards; plush toys; puppets; roller skates; role playing toys in the nature of play sets for children to imitate fantasy characters; rubber balls; skateboards; snow boards; snow globes; soccer balls; spinning tops; squeeze toys; stuffed

toys; table tennis balls; table tennis paddles and rackets; table tennis tables; talking toys; target games; teddy bears; tennis balls; tennis rackets; toy action figures and accessories therefor; toy boats; toy bucket and shovel sets in the nature of sand toys; toy building blocks; toy mobiles; toy vehicles; toy scooters; toy cars; toy figures; toy banks; toy vehicles in the nature of trucks; toy watches; toy weapons; toy building structures and toy vehicle tracks; video game machines for use with televisions; volley balls; wind-up toys; yo-yos; toy trains and parts and accessories therefor; toy aircraft; fitted plastic films known as skins for covering and protecting electronic game playing apparatus, namely, video game consoles, and hand-held video game units

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

REFUSAL

The Examining Attorney refused Applicant's LIGHTYEAR mark ("Applicant's LIGHTYEAR Mark") based on a partial likelihood of confusion with U.S. Reg. No. 6165982 for LIGHTYEAR in Class 8 for "folding knives" (the "Cited LIGHTYEAR Mark"). The Examining Attorney notes that "the 'sporting articles' in the application and 'folding knives' in the registration are identical or legally identical... Therefore, it is presumed that the channels of trade and class(es) of purchasers are the same for these goods... Thus, applicant's and registrant's goods are related."

The Examining Attorney advised, however, that Applicant could delete the goods to which the refusal pertains from the application to overcome the partial 2(d) refusal. Applicant has deleted the term "sporting articles (except clothing)" and clarified the specific types of "sporting goods" in Applicant's Amended Goods. "Folding knives" are not included in Applicant's Amended Goods. Accordingly, Applicant requests withdrawal of the partial 2(d) refusal.

CONCLUSION

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