To:	Delvecchio, Jr., Paul (HVBoeziIII@aol.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 77929322 - DJ PAULY D - N/A
Sent:	6/9/2011 8:41:21 AM
Sent As:	ECOM116@USPTO.GOV
Attachments:	

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77929322

MARK: DJ PAULY D

77929322

CORRESPONDENT ADDRESS:
HENRY V. BOEZI III
LAW OFFICE OF HENRY V. BOEZI III
67 CEDAR ST STE 105
PROVIDENCE, RI 02903-1042

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/trademarks/teas/response_forms.jsp

APPLICANT: Delvecchio, Jr., Paul

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:
HVBoeziIII@aol.com

OFFICE ACTION

STRICT DEADLINE TO RESPOND TO THIS LETTER

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

ISSUE/MAILING DATE: 6/9/2011

TEAS PLUS APPLICANTS MUST SUBMIT DOCUMENTS ELECTRONICALLY OR SUBMIT FEE: Applicants who filed their application online using the reduced-fee TEAS Plus application must continue to submit certain documents online using TEAS, including responses to Office actions. *See* 37 C.F.R. §2.23(a)(1). For a complete list of these documents, see TMEP §819.02(b). In addition, such applicants must accept correspondence from the Office via e-mail throughout the examination process and must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where

EXHIBIT V

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all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

This Office action addresses a new examination issue; therefore, an appeal to the Trademark Trial and Appeal Board is considered premature. *See* 37 C.F.R. §2.141(a); TMEP §714.03. Applicant must respond on the merits directly to the trademark examining attorney.

This Office action is in response to applicant's communication filed on May 21, 2011.

Amendment Would Exceed Scope of Services in Original Application

The proposed amendment to the identification cannot be accepted because it refers to services that are not within the scope of the identification that was set forth in the application at the time of filing. *See* 37 C.F.R. §2.71(a).

The amendment identifies the following services: " entertainment services, namely live appearances by a celebrity musician; entertainment services, namely personal appearance by a celebrity musician; entertainment services, namely live music concerts by a celebrity; entertainment services, namely playing, scratching, manipulating, composing, mixing recorded music, sound equipment, selection and arrangement of musical programs; entertainment services, namely live appearances by a professional entertainer; entertainment services in the nature of live performances by a musical artist; entertainment services in the nature of live musical performances by a performer or group; entertainment in the nature of live musical performances by a turntablist or a musical ensemble; entertainment in the nature of live musical performances by a turntablist; entertainment in the nature of live musical performances by a musical artist who uses a turntable as a musical instrument; entertainment in the nature of live musical performances by a musical artist who uses a mixer, software, and a turntable as a musical instrument; music composition of music for others; music production services; music production services in the nature of music re-mixing; music publishing; mixing and scratching of audio recordings using a turntable as a musical instrument, live performance of turntablism including scratching with turntables, sounds, loops, vocals from a cd, vinyl record or any electronic source; music production services by manipulating sounds and creating music using phonograph or digital turntables and a dj mixer, musician who uses a turntable as a musical instrument to produce unique sounds and not reproduced, audio recording and production."

Identifications can be amended only to clarify or limit the goods and/or services; adding to or broadening the scope of the goods and/or services is not permitted. *Id.*; *see* TMEP §§1402.06 *et seq.*, 1402.07. Therefore, this wording should be deleted from the identification.

Section 2(d) Refusal

Applicant's arguments have been considered and found unpersuasive. The examining attorney will address applicant's arguments fully upon receipt of a response to this Office action.
The refusal under Section 2(d) based on U.S. Registration Nos. 3735703 and 3850538 is maintained and continued.

/Cynthia Sloan/
Examining Attorney
Law Office 116
Telephone 571.272.9219
Cynthia.Sloan@uspto.gov (Informal queries only)

TO RESPOND TO THIS LETTER: Go to http://www.uspto.gov/trademarks/teas/response_forms.jsp. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned trademark examining attorney. **E-mail communications will not be accepted as responses to Office actions; therefore, do not respond to this Office action by e-mail.**

All informal e-mail communications relevant to this application will be placed in the official application record.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

PERIODICALLY CHECK THE STATUS OF THE APPLICATION: To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at http://tarr.uspto.gov/. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see http://www.uspto.gov/trademarks/process/status/.

TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS: Use the TEAS form at http://www.uspto.gov/teas/eTEASpageE.htm.

To:	Delvecchio, Jr., Paul (HVBoeziIII@aol.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 77929322 - DJ PAULY D - N/A
Sent:	11/24/2010 2:22:42 PM
Sent As:	ECOM116@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3

UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION

APPLICATION SERIAL NO. 77929322

MARK: DJ PAULY D

77929322

CORRESPONDENT ADDRESS:
HENRY V. BOEZI III
LAW OFFICE OF HENRY V. BOEZI III
67 CEDAR ST STE 105
PROVIDENCE, RI 02903-1042

CLICK HERE TO RESPOND TO THIS LETTER:
http://www.uspto.gov/teas/eTEASpageD.htm

APPLICANT: Delvecchio, Jr., Paul

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A
CORRESPONDENT E-MAIL ADDRESS:
HVBoeziIII@aol.com

OFFICE ACTION

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ISSUE/MAILING DATE: 11/24/2010

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must maintain a valid e-mail address. 37 C.F.R. §2.23(a)(2); TMEP §§819, 819.02(a). TEAS Plus applicants who do not meet these requirements must submit an additional fee of $50 per international class of goods and/or services. 37 C.F.R. §2.6(a)(1)(iv); TMEP §819.04. In appropriate situations and where all issues can be resolved by amendment, responding by telephone to authorize an examiner's amendment will not incur this additional fee.

This Office action is in response to applicant's communication filed on November 12, 2010.

The following requirements have been satisfied: Section 2(f) claim statement, clarification of name of individual and substitute specimens. TMEP §§713.02, 714.04.

The refusal based on Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127, use as a trade name, is WITHDRAWN.

The refusal based on Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.*, likelihood of confusion with U.S. Registration No. 3735703, is CONTINUED.

Applicant's arguments have been considered and found unpersuasive. The examining attorney will address applicant's arguments fully upon receipt of a response to the following refusal.

Pending Reference Has Matured Into a Registration

On May 14, 2010, the examining attorney advised applicant about prior pending Application Serial No. 77463093. The referenced prior-pending application has since registered. Therefore, registration is refused as follows.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3850538. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: Similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.* , 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In the present case, applicant's mark, DJ PAULY D, is similar to the registered mark, DJ PAULIE'S WORLDWIDE COUNTDOWN, in sound, appearance and connotation. Overall, the marks have the same commercial impression.

The dominant portions of the marks are essentially phonetic equivalents and thus sound similar. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv).

The ending of the dominant portion of the registered mark includes an apostrophe and letter "S." This additional matter has little, if any, trademark significance and does not otherwise affect the overall similarity of the marks in terms of commercial impression. *See In re Binion*, 93 USPQ2d 1531, 1534 (TTAB 2009) (noting that "[t]he absence of the possessive form in applicant's mark . . . has little, if any, significance for consumers in distinguishing it from the cited mark"); *In re Curtice-Burns, Inc.*, 231 USPQ 990, 992 (TTAB 1986) (finding the marks McKENZIE'S and McKENZIE "virtually identical in commercial impression"); *Winn's Stores, Inc. v. Hi-Lo, Inc.* , 203 USPQ 140, 143 (TTAB 1979) (noting that "little if any trademark significance can be attributed to the apostrophe and the letter 's' in opposer's mark").

The mere deletion of wording from a registered mark may not be sufficient to overcome a likelihood of confusion. *See In re Mighty Leaf Tea*, 601 F.3d 1342, 94 USPQ2d 1257 (Fed. Cir. 2010); *In re Optica Int'l* , 196 USPQ 775, 778 (TTAB 1977); TMEP §1207.01(b)(ii)-(iii). Applicant's mark does not create a distinct commercial impression because it contains the same common wording as registrant's mark, and there is no other wording to distinguish it from registrant's mark. In the present case, the deletion of the less dominant wording, WORLDWIDE COUNTDOWN, does not obviate the likelihood of confusion. Also, the addition of the initial "D" does not create a distinct commercial impression.

Comparison of the Goods/Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.* , 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

Applicant's services consist of "entertainment in the nature of disc jockey services." Registrant's services consist of "entertainment services in the nature of disc jockey services."

The parties' services are identical and are sold through the same trade channels. Accordingly, the

services would be sold to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the services originate from the same source.

Although applicant's mark has been refused registration, applicant may respond to the refusal(s) by submitting evidence and arguments in support of registration.

/Cynthia Sloan/
Examining Attorney
Law Office 116
Telephone 571.272.9219
Facsimile 571.273.9116

TO RESPOND TO THIS LETTER: Use the Trademark Electronic Application System (TEAS) response form at http://teasroa.uspto.gov/roa/. Please wait 48-72 hours from the issue/mailing date before using TEAS, to allow for necessary system updates of the application. For *technical* assistance with online forms, e-mail TEAS@uspto.gov.

WHO MUST SIGN THE RESPONSE: It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

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To:	Delvecchio, Jr., Paul (HVBoeziIII@aol.com)
Subject:	U.S. TRADEMARK APPLICATION NO. 77929322 - DJ PAULY D - N/A
Sent:	5/14/2010 3:31:10 PM
Sent As:	ECOM116@USPTO.GOV
Attachments:	Attachment - 1 Attachment - 2 Attachment - 3 Attachment - 4 Attachment - 5

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/929322

MARK: DJ PAULY D

77929322

CORRESPONDENT ADDRESS:
HENRY V. BOEZI III
LAW OFFICE OF HENRY V. BOEZI III
67 CEDAR ST STE 105
PROVIDENCE, RI 02903-1042

RESPOND TO THIS ACTION:
http://www.uspto.gov/teas/eTEASpageD.htm

GENERAL TRADEMARK INFORMATION:
http://www.uspto.gov/main/trademarks.htm

APPLICANT: Delvecchio, Jr., Paul

CORRESPONDENT'S REFERENCE/DOCKET NO:
N/A

CORRESPONDENT E-MAIL ADDRESS:
HVBoeziIII@aol.com

OFFICE ACTION

TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE ISSUE/MAILING DATE.

ISSUE/MAILING DATE: 5/14/2010

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The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issue(s) below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

SECTION 2(d) REFUSAL – LIKELIHOOD OF CONFUSION

Registration of the applied-for mark is refused because of a likelihood of confusion with the mark in U.S. Registration No. 3735703. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registration.

Trademark Act Section 2(d) bars registration of an applied-for mark that so resembles a registered mark that it is likely that a potential consumer would be confused or mistaken or deceived as to the source of the goods and/or services of the applicant and registrant. *See* 15 U.S.C. §1052(d). The court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973) listed the principal factors to be considered when determining whether there is a likelihood of confusion under Section 2(d). *See* TMEP §1207.01. However, not all of the factors are necessarily relevant or of equal weight, and any one factor may be dominant in a given case, depending upon the evidence of record. *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003); *see In re E. I. du Pont*, 476 F.2d at 1361-62, 177 USPQ at 567.

In this case, the following factors are the most relevant: similarity of the marks, similarity of the goods and/or services, and similarity of trade channels of the goods and/or services. *See In re Opus One, Inc.*, 60 USPQ2d 1812 (TTAB 2001); *In re Dakin's Miniatures Inc.* , 59 USPQ2d 1593 (TTAB 1999); *In re Azteca Rest. Enters., Inc.*, 50 USPQ2d 1209 (TTAB 1999); TMEP §§1207.01 *et seq.*

Regarding the issue of likelihood of confusion, all circumstances surrounding the sale of the goods and/or services are considered. These circumstances include the marketing channels, the identity of the prospective purchasers, and the degree of similarity between the marks and between the goods and/or services. *See Indus. Nucleonics Corp. v. Hinde*, 475 F.2d 1197, 177 USPQ 386 (C.C.P.A. 1973); TMEP §1207.01. In comparing the marks, similarity in any one of the elements of sound, appearance or meaning may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d 1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b). In comparing the goods and/or services, it is necessary to show that they are related in some manner. *See On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086, 56 USPQ2d 1471, 1475 (Fed. Cir. 2000); TMEP §1207.01(a)(vi).

Comparison of the Marks

In a likelihood of confusion determination, the marks are compared for similarities in their appearance, sound, meaning or connotation and commercial impression. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973); TMEP §1207.01(b). Similarity in any one of these elements may be sufficient to find a likelihood of confusion. *In re White Swan Ltd.*, 8 USPQ2d

1534, 1535 (TTAB 1988); *In re Lamson Oil Co.*, 6 USPQ2d 1041, 1043 (TTAB 1987); *see* TMEP §1207.01(b).

In the present case, applicant's mark, DJ PAULY D, is similar to the registered mark, DJ PAULIE, in sound, appearance and connotation. Overall, the marks have the same commercial impression.

Applicant has merely added the initial "D" to registrant's mark. The mere addition of a term to a registered mark generally does not obviate the similarity between the marks nor does it overcome a likelihood of confusion under Trademark Act Section 2(d). *See In re Chatam Int'l Inc.* , 380 F.3d 1340, 71 USPQ2d 1944 (Fed. Cir. 2004) (GASPAR'S ALE and JOSE GASPAR GOLD); *Coca-Cola Bottling Co. v. Jos. E. Seagram & Sons, Inc.*, 526 F.2d 556, 188 USPQ 105 (C.C.P.A. 1975) (BENGAL and BENGAL LANCER); *Lilly Pulitzer, Inc. v. Lilli Ann Corp.*, 376 F.2d 324, 153 USPQ 406 (C.C.P.A. 1967) (THE LILLY and LILLI ANN); *In re El Torito Rests., Inc.*, 9 USPQ2d 2002 (TTAB 1988) (MACHO and MACHO COMBOS); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985) (CONFIRM and CONFIRMCELLS); *In re U.S. Shoe Corp.*, 229 USPQ 707 (TTAB 1985) (CAREER IMAGE and CREST CAREER IMAGES); *In re Riddle*, 225 USPQ 630 (TTAB 1985) (ACCUTUNE and RICHARD PETTY'S ACCU TUNE); *In re Cosvetic Labs., Inc.*, 202 USPQ 842 (TTAB 1979) (HEAD START and HEAD START COSVETIC); TMEP §1207.01(b)(iii).

In the present case, the dominant portion of the parties' marks, PAULY and PAULIE are identical in sound. Similarity in sound alone may be sufficient to support a finding of likelihood of confusion. *RE/MAX of Am., Inc. v. Realty Mart, Inc.*, 207 USPQ 960, 964 (TTAB 1980); *Molenaar, Inc. v. Happy Toys Inc.*, 188 USPQ 469, 471 (TTAB 1975); *see* TMEP §1207.01(b)(iv).

Comparison of the Goods/Services

The goods and/or services of the parties need not be identical or directly competitive to find a likelihood of confusion. *See Safety-Kleen Corp. v. Dresser Indus., Inc.*, 518 F.2d 1399, 1404, 186 USPQ 476, 480 (C.C.P.A. 1975); TMEP §1207.01(a)(i). Rather, it is sufficient that the goods and/or services are related in some manner and/or the conditions surrounding their marketing are such that they would be encountered by the same purchasers under circumstances that would give rise to the mistaken belief that the goods and/or services come from a common source. *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1476 (TTAB 1999); TMEP §1207.01(a)(i); *see, e.g., On-line Careline Inc. v. Am. Online Inc.*, 229 F.3d 1080, 1086-87, 56 USPQ2d 1471, 1475-76 (Fed. Cir. 2000); *In re Martin's Famous Pastry Shoppe, Inc.* , 748 F.2d 1565, 1566-68, 223 USPQ 1289, 1290 (Fed. Cir. 1984).

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The parties' services are identical and are sold through the same trade channels. Accordingly, the services would be sold to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the services originate from the same source.

Prior Pending Application

The filing date of pending Application Serial No. 77463093 precedes applicant's filing date. See attached referenced application. If the mark in the referenced application registers, applicant's mark may be refused registration under Trademark Act Section 2(d) because of a likelihood of confusion between the two marks. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.83; TMEP §§1208 *et seq.* Therefore, upon receipt of

applicant's response to this Office action, action on this application may be suspended pending final disposition of the earlier-filed referenced application.

In response to this Office action, applicant may present arguments in support of registration by addressing the issue of the potential conflict between applicant's mark and the mark in the referenced application. Applicant's election not to submit arguments at this time in no way limits applicant's right to address this issue later if a refusal under Section 2(d) issues.

Applicant should note the following additional ground for refusal.

TRADE NAME - NOT A SERVICE MARK

Registration is refused because the applied-for mark, as used on the specimen of record, is used only as a trade name to identify applicant's business; it does not function as a service mark to identify and distinguish applicant's services from those of others and to indicate the source of applicant's services. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051-1053, 1127; *see In re Walker Process Equip. Inc.*, 233 F.2d 329, 110 USPQ 41 (C.C.P.A. 1956); TMEP §§904.07(b), 1301.02(a). Although a designation may function as both a trade name and a service mark, the Trademark Act does not provide for registration of matter that functions solely as a trade name. *In re Univar Corp.*, 20 USPQ2d 1865, 1866-67 (TTAB 1991); TMEP §1202.01.

The determination as to whether a trade name also functions as a service mark is based on the manner in which the applied-for mark is used on the specimen or any other evidence of use, as well as the probable impact of such use on purchasers. *See In re Univar Corp.*, 20 USPQ2d at 1867; *In re The Signal Cos.*, 228 USPQ 956, 957 (TTAB 1986); TMEP §1202.01. In this case, the specimen shows the applied-for mark used on a receipt appearing as part of an address which does not project a separate commercial impression.

Applicant may respond to this refusal by submitting the following:

(1) A substitute specimen showing proper service mark use for the services specified in the application; and

(2) The following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **"The substitute specimen was in use in commerce at least as early as the filing date of the application."** 37 C.F.R. §2.59(a); TMEP §904.05; *see* 37 C.F.R. §2.193(e)(1). If submitting a substitute specimen requires an amendment to the dates of use, applicant must also verify the amended dates. 37 C.F.R. §2.71(c); TMEP §904.05.

Examples of specimens for services are signs, photographs, brochures, website printouts or advertisements that show the mark used in the sale or advertising of the services. *See* TMEP §§1301.04 *et seq.*

If applicant cannot satisfy the above requirements, applicant may amend the application from a use in commerce basis under Trademark Act Section 1(a) to an intent to use basis under Section 1(b), and the refusal will be withdrawn. *See* TMEP §806.03(c). However, if applicant amends the basis to Section 1(b), registration will not be granted until applicant later amends the application back to use in commerce by filing an acceptable allegation of use with a proper specimen. *See* 15 U.S.C. §1051(c), (d); 37 C.F.R. §§2.76, 2.88; TMEP §1103. If the same specimen is submitted with an allegation of use, the same refusal will issue.