

To amend to Section 1(b), applicant must submit the following statement, verified with an affidavit or signed declaration under 37 C.F.R. §2.20: **“Applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods or services listed in the application as of the filing date of the application.”** 37 C.F.R. §2.34(a)(2); TMEP §806.01(b); *see* 15 U.S.C. §1051(b); 37 C.F.R. §§2.35(b)(1), 2.193(e)(1).

Response Guidelines

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

Applicant must respond to the requirement(s) set forth below.

Unnecessary Section 2(f) Claim

Applicant claims that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f).

However, this claim is unnecessary because the mark appears to be inherently distinctive. *See* 15 U.S.C. §1052(f); TMEP §1212.02(d).

Applicant can withdraw the claim of acquired distinctiveness by instructing the trademark examining attorney to delete it from the application record. *See* TMEP §1212.02(d). If applicant does not withdraw the claim, it will remain in the application record and be printed on the registration certificate.

Name of an Individual

Applicant must clarify whether the name or signature in the applied-for mark identifies a particular living individual. Written consent is required for registration of a name, including a pseudonym, stage name or nickname, or signature, if the name or signature identifies a specific living individual. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §813; *see* TMEP §§1206 *et seq.*

If the name or signature shown in the mark identifies a particular living individual, then applicant must submit the following:

- (1) A written consent, personally signed by the individual whose name or signature appears in the mark, authorizing applicant to register the name, pseudonym, stage name, nickname or signature as a trademark and/or service mark with the USPTO; and
- (2) A statement that “PAULY D identifies a living individual whose consent is of record.” If the name represents that of a pseudonym, stage name or nickname, applicant must include a statement that “PAULY D identifies the <pseudonym/stage name/nickname> of Paul Delvecchio, Jr., a living individual whose consent is of record.”

See TMEP §§813, 813.01(a), 1206.04(a).

However, if the name or signature in the mark does not identify a living individual, then applicant must submit a statement that “PAULY D does not identify a living individual.” TMEP §813.01(b).

/Cynthia Sloan/
Examining Attorney
Law Office 116
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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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

APPLICATION SERIAL NO. 77929416

MARK: DJ PAULY D

77929416

CORRESPONDENT ADDRESS:

HENRY V. BOEZI III
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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:

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OFFICE ACTION

EXHIBIT W

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

THIS IS A FINAL ACTION.

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 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 May 21, 2011.

FINAL Refusal – Section 2(d) – Likelihood of Confusion

For the reasons set forth below, the refusal under Trademark Act Section 2(d) is now made FINAL with respect to U.S. Registration No(s). 3735703 and 3850538. *See* 15 U.S.C. §1052(d); 37 C.F.R. §2.64(a). In addition, the following requirement is now made FINAL: Requirement for an amendment to the identification of services. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*; 37 C.F.R. §2.64(a).

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 is DJ PAULY D and the registered marks are DJ PAULIE and DJ PAULIE'S WORLDWIDE COUNTDOWN.

Applicant argues that likelihood of confusion cannot be predicated on dissection of a mark. Applicant is correct in that the marks are compared in their entireties under a Trademark Act Section 2(d) analysis. See TMEP §1207.01(b). Additionally, applicant analyzes the marks according to the numbers of syllables, rhythmic or melodic patterns, and number of letters. Nevertheless, one feature of a mark may be recognized as more significant in creating a commercial impression. Greater weight is given to that dominant feature in determining whether there is a likelihood of confusion. *In re Nat'l Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985); *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 189 USPQ 693 (C.C.P.A. 1976); *In re J.M. Originals Inc.*, 6 USPQ2d 1393 (TTAB 1987); see TMEP §1207.01(b)(viii), (c)(ii). In the present case, the names DJ PAULY, DJ PAULIE and DJ PAULIE'S are the dominant features of the marks and are given greater weight in determining the likelihood of confusion.

Applicant argues that the ending of the registered mark in U.S. Registration No. 3850538 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").

Although a disclaimed portion of a mark certainly cannot be ignored, and the marks must be compared in their entireties, one feature of a mark may be more significant in creating a commercial impression. Disclaimed matter is typically less significant or less dominant when comparing marks. See *In re Dixie Rests., Inc.*, 105 F.3d 1405, 1407, 41 USPQ2d 1531, 1533-34 (Fed. Cir. 1997); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1060, 224 USPQ 749, 752 (Fed. Cir. 1985); TMEP §1207.01(b)(viii), (c)(ii). Applicant has disclaimed DJ and registrant has disclaimed DJ and WORLDWIDE COUNTDOWN. This leaves the nearly identical names PAULY, PAULIE and PAULIE'S, which are highly significant in creating a commercial impression.

Applicant argues that the dominant portion of its mark is PAULY D; however, 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 Toshiba Med. Sys. Corp.*, 91 USPQ2d 1266 (TTAB 2009)

(TITAN and VANTAGE TITAN); *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); TMEP §1207.01(b)(iii). In the present case, applicant has merely added the letter D to registrant's mark in U.S. Registration No. 3735703.

Consumers are generally more inclined to focus on the first word, prefix or syllable in any trademark or service mark. See *Palm Bay Imps., Inc. v. Veuve Clicquot Ponsardin Maison Fondée En 1772*, 396 F.3d 1369, 1372, 73 USPQ2d 1689, 1692 (Fed. Cir. 2005); see also *Mattel Inc. v. Funline Merch. Co.*, 81 USPQ2d 1372, 1374-75 (TTAB 2006); *Presto Prods., Inc. v. Nice-Pak Prods., Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988) ("it is often the first part of a mark which is most likely to be impressed upon the mind of a purchaser and remembered" when making purchasing decisions). Here, the marks begin with the wording DJ PAULY and DJ PAULIE and DJ PAULIE'S. This wording sounds the same and is most likely to be impressed upon the minds of potential purchasers.

Applicant contends that DJ PAULY D is a "double entendre." A "double entendre" is an expression that has a double connotation or significance as applied to the goods and/or services. TMEP §1213.05(c); see *In re Colonial Stores Inc.*, 394 F.2d 549, 552-53, 157 USPQ 382, 384-85 (C.C.P.A. 1968) (finding SUGAR & SPICE a double entendre and not descriptive for bakery products because it evokes the nursery rhyme "sugar and spice and everything nice").

A mark that comprises a "double entendre" will not be refused registration as *merely descriptive* [emphasis added] if one of its meanings is not merely descriptive in relation to the goods and/or services. TMEP §1213.05(c). However, in the present case, the issue is likelihood of confusion rather than descriptiveness; therefore, applicant's argument is unfounded.

The question is not whether people will confuse the marks, but whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b). For that reason, the test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison. The question is whether the marks create the same overall impression. See *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329-30, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000); *Visual Info. Inst., Inc. v. Vicon Indus. Inc.*, 209 USPQ 179, 189 (TTAB 1980). The focus is on the recollection of the average purchaser who normally retains a general rather than specific impression of trademarks. *Chemetron Corp. v. Morris Coupling & Clamp Co.*, 203 USPQ 537, 540-41 (TTAB 1979); *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106, 108 (TTAB 1975); TMEP §1207.01(b).

Applicant argues that PAULY D represents the "first name and first initial of applicant" and that "registrant has a different first initial of his last name (PAUL L). This argument is irrelevant because registrant's mark does not include the letter "L." Likewise, applicant states that DJ PAULY D represents applicant Paul Delvecchio. Applicant's mark does not include his surname.

Applicant discusses several cases involving third-party registrations. Third-party registrations are entitled to little weight on the question of likelihood of confusion because they are "not evidence of what happens in the market place or that customers are familiar with them." *AMF Inc. v. Am. Leisure Prods., Inc.*, 474 F.2d 1403, 1406, 177 USPQ 268, 269 (C.C.P.A. 1973); see *In re Melville Corp.*, 18 USPQ2d 1386, 1388 (TTAB 1991); TMEP §1207.01(d)(iii). Moreover, the existence on the register of other seemingly similar marks does not provide a basis for registrability for the applied-for mark. *AMF*, 474 F.2d at 1406, 177 USPQ at 269; *In re Total Quality Group, Inc.*, 51 USPQ2d 1474, 1477 (TTAB 1999).

Applicant asserts his “right to use his own name as a mark.” This issue here is whether the marks will confuse people into believing that the goods and/or services they identify come from the same source. *In re West Point-Pepperell, Inc.*, 468 F.2d 200, 201, 175 USPQ 558, 558-59 (C.C.P.A. 1972); TMEP §1207.01(b).

Comparison of the Services

Applicant’s goods/services consist of “entertainment services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music; entertainment in the nature of live performances by a disc jockey; entertainment services, namely, personal appearances by a reality TV star; entertainment services, namely, the provision of continuing segments featuring a television personality delivered by means of a reality TV show.”

Registrant’s services consist of “entertainment in the nature of disc jockey services.” The parties have identical services, i.e., disc jockey services. Applicant’s other services are directly related to registrant’s services because the services are the type sold to consumers seeking musical entertainment.

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).

The trademark examining attorney has attached evidence from the USPTO’s X-Search database consisting of a number of third-party marks registered for use in connection with the same or similar goods and/or services as those of both applicant and registrant in this case. This evidence shows that the goods and/or services listed therein, namely, applicant’s disc jockey, musical performances and television entertainment and registrant’s disc jockey services, are of a kind that may emanate from a single source under a single mark. *See In re Davey Prods. Pty Ltd.*, 92 USPQ2d 1198, 1203 (TTAB 2009); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

Also attached are websites from the GOOGLE® search engine showing that disc jockeys are also television personalities. Consumers who encounter the respective services under very similar marks are likely to mistakenly believe that the services emanate from a common origin.

Applicant argues that its activities are geographically separate from those of registrant; however, applicant seeks a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation’s Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of applicant’s and registrant’s activities is not relevant to a likelihood of confusion determination.

Applicant argues that sophisticated purchasers can distinguish between the services offered by the subject parties. However, the fact that purchasers are sophisticated or knowledgeable in a particular field does not necessarily mean that they are sophisticated or knowledgeable in the field of trademarks or immune from source confusion. TMEP §1207.01(d)(vii); *see In re Cynosure, Inc.*, 90 USPQ2d 1644 (TTAB 2009); *In re Decombe*, 9 USPQ2d 1812 (TTAB 1988); *In re Pellerin Milnor Corp.*, 221 USPQ 558 (TTAB 1983).

Applicant has submitted a list of registrations for “PAUL.” However, the mere submission of a list of registrations does not make such registrations part of the record. *In re Promo Ink*, 78 USPQ2d 1301, 1304 (TTAB 2006); TBMP §1208.02; TMEP §710.03.

To make third-party registrations part of the record, an applicant must submit copies of the actual registrations or printouts of the registrations from the USPTO’s database. *In re Ruffin Gaming LLC*, 66 USPQ2d 1924, 1925 n.3 (TTAB 2002); *In re Carolina Apparel*, 48 USPQ2d 1542, 1543 n.2 (TTAB 1998); TBMP §1208.02; TMEP §710.03.

Applicant asserts his claim under Section 2(f). Here, the issue is whether there is a likelihood of confusion rather than whether the proposed mark is descriptive under Section 2(e)(1) where a claim of acquired distinctiveness could overcome a descriptiveness refusal.

Applicant attempts to differentiate the parties’ services by arguing that registrant’s services are based on “disc jockey services” and that applicant’s services are “turntablism,” “mixing, creating, and composing unique music for a live performance by using a turntable as a musical instrument...” and “club music.” In a likelihood of confusion analysis, the comparison of the parties’ goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *In re Dakin’s Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267-68, 62 USPQ2d 1001, 1004-05 (Fed. Cir. 2002); *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); TMEP §1207.01(a)(iii). See the attached evidence showing that disc jockeys engage in “turntablism.”

In this case, the identification set forth in the cited registration uses broad wording to describe registrant’s goods and/or services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant’s more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See Citigroup Inc. v. Capital City Bank Grp., Inc.*, ___ F.3d ___, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii).

The overriding concern is not only to prevent buyer confusion as to the source of the goods and/or services, but to protect the registrant from adverse commercial impact due to use of a similar mark by a newcomer. *See In re Shell Oil Co.*, 992 F.2d 1204, 1208, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993). Therefore, any doubt regarding a likelihood of confusion determination is resolved in favor of the registrant. TMEP §1207.01(d)(i); *see Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Hyper Shoppes (Ohio), Inc.*, 837 F.2d 463, 464-65, 6 USPQ2d 1025, 1025 (Fed. Cir. 1988).

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, namely, personal appearances by an entertainer, television personality, television celebrity, and musician; entertainment services, namely, live, televised and movie appearances by a professional entertainer; entertainment, namely, television show production; television and cable television show production; entertainment in the nature of on-going television and cable television programs featuring music, comedy, drama, fashion shows, exhibitions, competitions and spoken word; entertainment services, namely, providing on-going television and cable television programs featuring music, comedy, drama, fashion shows, exhibitions, competitions and spoken word; entertainment in the nature of on-going television and cable television reality based shows and programs.” This wording is beyond the scope of the original wording because personal appearances, televised and movie appearances, television and cable television show production, ongoing television and cable television programs, television reality based shows and programs is not within the scope of live performances by an individual or the provision of continuing segments featuring a television personality delivered by means of a reality TV show.”

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.

Applicant may adopt the following identification of services, if accurate:

Entertainment services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music; entertainment in the nature of live performances by a disc jockey; entertainment services, namely, personal appearances by a reality TV star; entertainment services, namely, the provision of continuing segments featuring a television personality delivered by means of a reality TV show, in **International Class 41**.

See TMEP §1402.01.

An applicant may amend an identification of services only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

In view of the foregoing, the refusal to register under Section 2(d) of the Trademark Act is continued and made final.

Response Guidelines – Final Action

If applicant does not respond within six months of the date of issuance of this final Office action, the application will be abandoned. 15 U.S.C. §1062(b); 37 C.F.R. §2.65(a). Applicant may respond to this final Office action by:

- (1) Submitting a response that fully satisfies all outstanding requirements, if feasible; and/or
- (2) Filing an appeal to the Trademark Trial and Appeal Board, with an appeal fee of \$100 per class.

37 C.F.R. §§2.6(a)(18), 2.64(a); TBMP ch. 1200; TMEP §714.04.

In certain rare circumstances, a petition to the Director may be filed pursuant to 37 C.F.R. §2.63(b)(2) to review a final Office action that is limited to procedural issues. 37 C.F.R. §2.64(a); TMEP §714.04; *see* 37 C.F.R. §2.146(b); TBMP §1201.05; TMEP §1704 (explaining petitionable matters). The petition fee is \$100. 37 C.F.R. §2.6(a)(15).

/Cynthia Sloan/
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Law Office 116
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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. 77929416 - DJ PAULY D - N/A
Sent: 11/26/2010 2:05:40 PM
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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

APPLICATION SERIAL NO. 77929416

MARK: DJ PAULY D

77929416

CORRESPONDENT ADDRESS:

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APPLICANT: Delvecchio, Jr., Paul

**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

N/A

CORRESPONDENT E-MAIL ADDRESS:
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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: 11/26/2010

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 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. TMEP §§713.02, 714.04.

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.

Amendment to Identification of Goods/Services Unacceptable

The proposed amendment to the identification cannot be accepted because it refers to goods and/or 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 goods and/or services:

Musical sound recordings; series of recorded compact discs, CD-ROMS, DVDS, DVD-ROMS, video tapes, cassette tapes, or video and audio digital musical media featuring music or musical performances; downloadable musical audio or video recordings featuring music and musical performances; downloadable musical sound recordings; musical sound recordings; audio or visual recordings featuring music or musical performances; records, cassettes, compact discs, CD-ROMs, DVDs, DVD-ROMs, video tapes, laser discs, video discs or digital media featuring music or musical performances; multimedia software featuring music and musical performances; wallpaper, browser skins, desktop icons and other multi-media materials in the nature of downloadable music and videos, in **International Class 9**.

Entertainment in the nature of visual and audio performances and musical shows; Entertainment in the nature of acoustic and/or electronically based live musical band integrated with turntablist; Music

production services namely, the production and integration of acoustic and/or electronic band and/or turntablist; Entertainment namely, live performances by a musical band; Entertainment services, namely, providing a web site featuring musical performances, musical videos, related film clips, photographs, and other multimedia materials; Entertainment, namely, live music concerts; Entertainment, namely, live performances by musical bands; Music composition and transcription for others; Music publishing services; Music transcription for others; Planning arrangement of showing movies, shows, plays or musical performances; Presentation of musical performance; Publication of musical texts; Theatrical and musical floor shows provided at discotheques and nightclubs, in **International Class 41**.

Bar, Hotel, and Restaurant services, in **International Class 43**.

This wording is beyond the scope of the original wording because musical sound recordings, downloadable musical audio or video recordings, downloadable musical sound recordings, musical sound recordings, audio or visual recordings featuring music and other media are goods which are not within the scope of entertainment services in the nature of live performances or continuing performances by an individual. In addition, bar, hotel and restaurant services are not within the scope of entertainment services.

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.

The wording “entertainment services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music” is acceptable as amended.

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 services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music."

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

Applicant's goods are related to registrant's goods because the goods/services are the type sold to consumers seeking musical entertainment featuring recorded music. The goods/services are sold through the same trade channels. Accordingly, the goods/services would be sold to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the goods originate from the same source.

In a likelihood of confusion analysis, the comparison of the parties' goods and/or services is based on the goods and/or services as they are identified in the application and registration, without limitations or restrictions that are not reflected therein. *Hewlett-Packard Co. v. Packard Press Inc.*, 281 F.3d 1261, 1267, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002); *In re Dakin's Miniatures, Inc.*, 59 USPQ2d 1593, 1595 (TTAB 1999); *see* TMEP §1207.01(a)(iii).

In this case, the identification set forth in the cited registration uses broad wording to describe registrant's goods and/or services and does not contain any limitations as to nature, type, channels of trade or classes of purchasers. Therefore, it is presumed that the registration encompasses all goods and/or services of the type described, including those in applicant's more specific identification, that the goods and/or services move in all normal channels of trade, and that they are available to all potential customers. *See In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638-39 (TTAB 2009); *In re Jump Designs LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006); *In re Elbaum*, 211 USPQ 639, 640 (TTAB 1981); TMEP §1207.01(a)(iii). See the attached printouts of websites from a www.google.com search showing that scratching, manipulating and mixing are common activities of disc jockeys.

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/
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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

Attachment - 36

Attachment - 37

Attachment - 38

Attachment - 39

Attachment - 40

Attachment - 41

Attachment - 42

Attachment - 43

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/929416

MARK: DJ PAULY D

77929416

CORRESPONDENT ADDRESS:

HENRY V. BOEZI III
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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

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. 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. Responding by telephone to authorize an examiner's amendment will not incur this additional fee.

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).

Applicant’s services consist of “Entertainment in the nature of live performances by Paul Delvecchio, Jr. a/k/a DJ Pauly D; entertainment services, namely, personal appearances by a Reality TV Star; entertainment services, namely, the provision of continuing performances featuring Paul Delvecchio, Jr. a/k/a DJ Pauly D delivered by means of a reality TV show.” Registrant’s services consist of “entertainment services in the nature of disc jockey services.”

Applicant’s goods are related to registrant’s goods because the goods/services are the type sold to consumers seeking entertainment by a performing artist. The goods/services are sold through the same trade channels. Accordingly, the goods/services would be sold to the same class of purchasers and encountered under circumstances leading one to mistakenly believe the goods originate from the same source.

Attached are copies of printouts from the USPTO X-Search database, which show third-party registrations of marks used in connection with the same or similar goods and/or services as those of applicant and registrant in this case. These printouts have probative value to the extent that they serve to suggest that the goods and/or services listed therein, namely, applicant’s live performances, personal appearances and television series and registrant’s disc jockey services, are of a kind that may emanate from a single source. *In re Infinity Broad. Corp. of Dallas*, 60 USPQ2d 1214, 1217-18 (TTAB 2001); *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783, 1785-86 (TTAB 1993); *In re Mucky Duck Mustard Co.*, 6 USPQ2d

1467, 1470 n.6 (TTAB 1988); TMEP §1207.01(d)(iii).

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.

Response Guidelines

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

Applicant must respond to the requirement(s) set forth below.

Unnecessary Section 2(f) Claim

Applicant claims that the applied-for mark has acquired distinctiveness under Trademark Act Section 2(f). However, this claim is unnecessary because the mark appears to be inherently distinctive. See 15 U.S.C. §1052(f); TMEP §1212.02(d).

Applicant can withdraw the claim of acquired distinctiveness by instructing the trademark examining attorney to delete it from the application record. See TMEP §1212.02(d). If applicant does not withdraw the claim, it will remain in the application record and be printed on the registration certificate.

Name of an Individual

Applicant must clarify whether the name or signature in the applied-for mark identifies a particular living individual. Written consent is required for registration of a name, including a pseudonym, stage name or nickname, or signature, if the name or signature identifies a specific living individual. Trademark Act Section 2(c), 15 U.S.C. §1052(c); TMEP §813; see TMEP §§1206 *et seq.*

If the name or signature shown in the mark identifies a particular living individual, then applicant must submit the following:

- (1) A written consent, personally signed by the individual whose name or signature appears in the mark, authorizing applicant to register the name, pseudonym, stage name, nickname or signature as a trademark and/or service mark with the USPTO; and
- (2) A statement that "PAULY D identifies a living individual whose consent is of record." If the name represents that of a pseudonym, stage name or nickname, applicant must include a statement

that “PAULY D identifies the <pseudonym/stage name/nickname> of Paul Delvecchio, Jr., a living individual whose consent is of record.”

See TMEP §§813, 813.01(a), 1206.04(a).

However, if the name or signature in the mark does not identify a living individual, then applicant must submit a statement that “PAULY D does not identify a living individual.” TMEP §813.01(b).

Identification of Services

The identification of services must be clarified. See TMEP §1402.01. Applicant must specify the common commercial or generic name for the services. If the services have no common commercial or generic name, applicant must describe the nature of the services as well as their main purpose, channels of trade, and the intended consumer(s).

Applicant may adopt the following identification, if accurate: Entertainment in the nature of live performances by a *disc jockey*; entertainment services, namely, personal appearances by a reality TV star; entertainment services, namely, the provision of continuing *segments* featuring a *television personality* delivered by means of a reality TV show.

Identifications of services can be amended only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); see TMEP §§1402.06 *et seq.*, 1402.07. Therefore, applicant may not amend the identification to include services that are not within the scope of the services set forth in the present identification.

/Cynthia Sloan/
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RESPOND TO THIS ACTION: Applicant should file a response to this Office action online using the form at <http://www.uspto.gov/teas/eTEASpageD.htm>, waiting 48-72 hours if applicant received notification of the Office action via e-mail. For *technical* assistance with the form, please e-mail TEAS@uspto.gov. For questions about the Office action itself, please contact the assigned examining attorney. **Do not respond to this Office action by e-mail; the USPTO does not accept e-mailed responses.**

If responding by paper mail, please include the following information: the application serial number, the mark, the filing date and the name, title/position, telephone number and e-mail address of the person signing the response. Please use the following address: Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system