

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION**

In Re Applicant: Delvecchio, Jr., Paul	:	
	:	Trademark Law Office: 116
Serial No.: 77929416	:	
	:	Trademark Examining
Date: May 21, 2011	:	Attorney:
	:	
Mark: DJ PAULY D	:	Cynthia Sloan

RESPONSE TO OFFICE ACTION

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

Dear Sir:

This paper is submitted in response to the Office Action dated November 26, 2010.

Kindly note that the Applicant will not press prosecution of the following amendments to the identification of goods and 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**.

Applicant may pursue registration of the subject mark for said goods and services in a subsequent application and therefore this is done without prejudice.

The remaining identification of services previously filed, with the within Application and for which Applicant continues to seek registration, is as follows:

Entertainment services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music; **International Class 41**.

Kindly add thereto, by amending the above-identified application as follows:

Add the following identification of goods and services:

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. **International Class 41**.

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*. **International Class 41**.

REMARKS

I. Section 2(d) Refusal – Likelihood of Confusion

The Office has refused registration of Applicant’s trademark based upon Section 2(d), as a result of the pending reference for Application Serial No.77463093, DJ PAULIE’S WORLDWIDE COUNTDOWN, cited in the initial Office Action dated May 14, 2010, maturing into a registration (U.S. Registration No. 3850538).

The Office further states that “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 [DJ PAULIE], is CONTINUED.”

In his Response to Office Action dated November 10, 2010, Applicant incorporated his Arguments “in support of registration of his mark” regarding Registration No. 3735703 and also asserted them in support of said mark on the issue of the potential conflict between it and the mark claimed under said Application Serial No. 77463093.

Applicant therein also expressly reserved his rights to supplement same if a later refusal under Section 2(d) issued.

I. Likelihood of Confusion

The test for likelihood of confusion is set forth in *In re Application of E. I. Dupont Denemours & Co*, 476 F.2d 1357, 1361 (C.C.P.A. 1973), in which the Court enunciated the factors relevant to determining likelihood of confusion as follows:

“In testing for likelihood of confusion under Sec. 2(d), therefore, the following, when of record, must be considered:

- (1) The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- (2) The similarity or dissimilarity of and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- (3) The similarity or dissimilarity of established, likely-to-continue trade channels.
- (4) The conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing.

- (5) The fame of the prior mark (sales, advertising, length of use).
- (6) The number and nature of similar marks in use on similar goods.
- (7) The nature and extent of any actual confusion.
- (8) The length of time during and conditions under which there has been concurrent use without evidence of actual confusion.
- (9) The variety of goods on which a mark is or is not used (house mark, “family” mark, product mark).
- (10) The market interface between applicant and the owner of a prior mark:
 - (a) a mere “consent” to register or use.
 - (b) agreement provisions designed to preclude confusion, i.e. limitations on continued use of the marks by each party.
 - (c) assignment of mark, application, registration and good will of the related business.
 - (d) laches and estoppel attributable to owner of prior mark and indicative of lack of confusion.
- (11) The extent to which applicant has a right to exclude others from use of its mark on its goods.
- (12) The extent of potential confusion, i.e., whether de minimis or substantial.
- (13) Any other established fact probative of the effect of use.”

TMEP §1207.01 states as follows:

“In ex parte examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in du Pont may be considered only if relevant evidence is contained in the record.

In *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (C.C.P.A. 1973), the Court of Customs and Patent Appeals discussed the factors relevant to a determination of likelihood of confusion. In ex parte examination, the issue of likelihood of confusion typically revolves around the similarity or dissimilarity of the marks and the relatedness of the goods or services. The other factors listed in *du Pont* may be considered only if relevant evidence is contained in the record. See *In re Majestic Distilling Co.*, 315 F.3d 1311, 1315, 65 USPQ2d 1201, 1204 (Fed. Cir. 2003) (“Not all of the DuPont factors may be relevant or of equal weight in a given case, and ‘any one of the factors may control a particular case,’” quoting *In re Dixie Restaurants, Inc.*, 105 F.3d 1405, 1406-07, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997)); *In re National Novice Hockey League, Inc.*, 222 USPQ 638, 640 (TTAB 1984). In an ex parte case, the following factors are usually the most relevant:

- The similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.
- The relatedness of the goods or services as described in an application or registration or in connection with which a prior mark is in use.
- The similarity or dissimilarity of established, likely-to-continue trade channels.
- The conditions under which and buyers to whom sales are made, i.e., “impulse” vs. careful, sophisticated purchasing.
- The number and nature of similar marks in use on similar goods.
- A valid consent agreement between the applicant and the owner of the previously registered mark.”

Although ex parte examination usually focuses on “the similarity or dissimilarity of the marks and the relatedness of the goods or services”, the other du Pont factors, “when of record, must be considered”. *In re Application of E. I. Dupont Denemours & Co*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). (*emphasis added*)

“The facts in each case vary and the weight to be given each factor may be different in light of the varying circumstances ...” TMEP §1207.01(a)(iv).

The following factors are respectfully submitted as the relevant du Pont Factors to consider in determining whether there is a likelihood of confusion between the Applicant’s mark and the cited registration.

1. The Similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.

a. Dissimilarity of the Marks - Appearance

As the Office states in TMEP §1207.01(b),

“The test of likelihood of confusion is not whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar that there is a likelihood of confusion as to the source of the goods or services.” (*emphasis added*)

The Office, on page 4 of the Office Action, states that

“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.’”

The dominant part of Registrant’s mark is either PAULIE or PAULIE’S. The dominant part of Applicant’s mark, however, is PAULY D, not PAULY.

The Office recognizes and affirms in TMEP §1207.01 that

“The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used (citations omitted). **It follows from that principle that likelihood of confusion cannot be predicated on dissection of a mark, that is, on only part of a mark** (footnote omitted). On the other hand, in articulating reasons for reaching a conclusion on the issue of confusion, there is nothing improper in stating that, for rational reasons, more or less weight has been given to a particular feature of a mark, provided the ultimate conclusion rests on consideration of the marks in their entireties (footnote omitted). Indeed, this type of analysis appears to be unavoidable. In re National Data Corp., 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985).” (*emphasis added*)

PAULY D represents a pseudonym, stage name and/or nickname for Applicant, composed of his first name and the first initial of his last name. They are interconnected. The mark PAULY D must therefore be read in its entirety in determining whether there is a likelihood of confusion between it and Registrant’s Mark. A finding thereof “cannot be predicated on dissection of a mark, that is, on only part of a mark”. *Id.*

Furthermore, DJ PAULY D is a *double entendre*, i.e., a word or expression capable of two interpretations. It is an incongruous expression, which has the characteristic of a coined fanciful mark when taken as a whole.

2 McCarthy on Trademarks and Unfair Competition §11:19 defines a “*double entendre*” as: A mark that connotes two meanings - one possibly descriptive, and the other suggestive of some other association - can be called suggestive, as the mark is not “merely” descriptive. In *Blisscraft of Hollywood v. United Plastics Co.*, 294 F. 2d 694, the court concluded that the mark was an “incongruous expression” and has the “characteristic of a coined of fanciful mark” (holding that the mark POLY PITCHER on polyethylene pitchers both connotes a description of the plastic ingredient of the product and also is reminiscent or suggestive of Molly Pitcher of Revolutionary time.)

The Trademark Trial and Appeal Board has held that a designation will be treated as a *double entendre* only if both meanings are readily apparent from the mark itself, apart from any associated trade dress or advertising. TMEP §1213.05(c). “A mark is not a *double entendre* if the second meaning is grasped by purchasers only when the mark is used with “other indicia”, even if the other indicia are not merely descriptive.” *Id.*

Similarly, the mark SUGAR & SPICE for bakery products not only suggests ingredients, but stimulates an association with the nursery rhyme “Sugar and Spice and Everything Nice. ...” *In re Colonial Stores, Inc.*, 55 C.C.P.A. 1049, 394 F.2d 549 (Cust. & Pat.App. 1968). In holding that this use was not a merely descriptive one, the court emphasized that the mark had a “reminiscent, suggestive, or associative connotation” with a nondescriptive idea. *Id.*

The combination of two or more descriptive elements as a composite mark may result in a composite mark which is nondescriptive. The commercial impression of a composite mark may be arbitrary or suggestive even though its separate parts are descriptive. The composite may be more than the mere sum of its parts. In trademark law, the whole is often greater than the sum of its parts.

Although one cannot obtain a registration for common words, for they are descriptive or generic, when they are used in combination, they can become a valid trademark. The mark SUGAR & SPICE on bakery products is composed of two words “Sugar” and “Spice,” each of which alone, were admitted to be descriptive of the product. It was held that the combination of these two descriptive terms resulted in a composite mark which could not be said to be merely descriptive. The combination of the two words “Mouse” and “Seed” into the composite mark MOUSE SEED for rodent exterminators was held to result in a nondescriptive, merely suggestive mark. *W. G. Reardon Laboratories, Inc. v. B & B Exterminators, Inc.*, 71 F.2d 515 (4th Cir. 1934).

When a descriptive term is added to a generic name, the resulting combination can be registrable when it acquires secondary meaning. For example, the combination WASHINGTON SPEAKERS BUREAU for a lecture agency in Washington, D.C. was found to be a descriptive combination: “[T]he addition of ‘Washington’ to the phrase

‘Speaker's Bureau’ converts the generic name to a descriptive mark.” Washington Speakers Bureau v. Leading Authorities, 49 F. Supp.2d 496 (E.D.VA. 1999).

A composite of highly descriptive terms may well result in a composite that is just as descriptive as its component parts. An example is ORIGINAL BLEND for cat food, which was held to be a merely descriptive composite just as descriptive as its individual parts. General Foods Corp. v. Ralston Purina Co., 220 USPQ 990 (TTAB 1984). Similarly, the Eleventh Circuit held that the combination of the words “invest” and “corporation” into INVESTACORP for investment brokerage services resulted in a descriptive composite. Investacorp, Inc. v. Arabian Inv. Banking Corp., 931 F.2d 1519, 1521 (11th Cir. 1999).

The Trademark Trial and Appeal Board has said that when two or more words have been used to form a phrase or term that directly conveys information about the goods or services, each individual word does not have to be analyzed for descriptiveness. See In re Shiva Corp., 48 USPQ2d 1957 (TTAB 1998). In that case, the Board held that the mark TARIFF MANAGEMENT for computer programs for area networks was descriptive of a feature of a computer program that allows the user to minimize its telephone charges by selecting the least extensive carrier. Thus, it was not necessary to analyze the words “tariff” and “management” individually.

“Telescoping” or combining without a space two individually descriptive words together may or may not result in a non-descriptive composite, depending upon the impact of the resulting composite. For example, while BIASTEEL was held not to be a descriptive composite. The Firestone Tire & Rubber Company v. The Goodyear Tire & Rubber Company, 186 USPQ 557 (TTAB 1975), FIRSTIER was held to be a descriptive composite. In re Omaha National Corporation, 819 F.2d 1117 (Fed. Cir.1987).

Therefore, DJ PAULY D is a *double entendre*. The expression DJ is generic and the marks PAULIE or PAULIE’s and PAULY D are different in spelling, appearance, sound, connotation and commercial impression. The marks DJ PAULIE or DJ PAULIE’s and DJ PAULY D, when viewed in their entireties, are different as to appearance, sound, connotation and commercial impression.

“To determine whether two marks are similar, we view the marks as a whole. See Estate of Beckwith, Inc. v. Comm'r of Patents, 252 U.S. 538, 545-546, 40 S.Ct. 414, 64 L.Ed. 705 (1920) (“The commercial impression of a trademark is derived from it as a whole, not from its elements separated and considered in detail.”); see also Scandia Down Corp. v. Euroquilt, Inc., 772 F.2d 1423, 1431 (7th Cir. 1985). We must compare the marks “in light of what happens in the marketplace and not merely by looking at the two marks side-by-side.” Sullivan v. CBS Corp., 385 F.3d 772, 777 (7th Cir. 2004) (quoting Ty, Inc. v. The Jones Group, Inc., 237 F.3d 891, 898 (7th Cir. 2001)); see also Meridian Mut. Ins. Co. v. Meridian Ins. Group, Inc., 128 F.3d 1111, 1115 (7th Cir. 1997.)”

Autozone, Inc. v. Strick, 543 F.3d 923, 929-930 (7th Cir. 2008) (*emphasis added*)

PAULY D represents the first name and first initial of Applicant. Registrant has a different first initial of his last name (PAUL L).

The Office, on page 4 of the Office Action, states

“Also, the addition of the initial “D” does not create a distinct commercial impression.”

Since PAULY D represents the first name (nickname) and first initial of the Applicant, the Office is incorrect. It is not viewing the marks “as a whole”, nor is it doing so in determining the commercial impression of the Applicant’s trademark. Autozone, Inc. v. Strick at 930.

The Office “must compare the marks ‘in light of what happens in the marketplace and not merely by looking at the two marks side-by-side.’” *Id.*

In relevant trade channels, DJ PAULY D is equated with the Applicant, Paul Delvecchio, whose pseudonym, stage name and/or nickname is Pauly D, just as the registered trademark Madonna is equated with that registrant, Madonna Ciccone, whose pseudonym, stage name and/or nickname is Madonna. Therefore, the functional equivalent to Applicant’s Mark thereof is dissimilar to Registrant’s mark.

The Applicant also asserts his right to use his own name as a mark and that the mark for which he seeks registration is consistent with DJ PAULY D(elvecchio). The attachment of the first initial D to the mark DJ PAULY is significant and is clearly intended as an honest usage of the mark to prevent any confusion with any other marks and to signify the underlying name Delvecchio.

As a result, it has a “distinct commercial impression”. Cf. In re Chemical Dynamics, Inc., 839 F.2d 1569 (Fed. Cir. 1988).

b. Dissimilarity of the Marks – Sound

To begin, clearly Registrants’ marks DJ PAULIE and DJ PAULIE’S WORLDWIDE COUNTDOWN have a different overall sound in relation to Applicant’s mark DJ PAULY D.

1) DJ PAULIE v. DJ PAULY D

The issue is whether the marks taken as a whole are so similar in sound in relation to one another that it would create a likelihood of confusion. There are hundreds of U.S. registrations in the present class that incorporate DJ with an additional element, which have no issue with differentiating one another. Therefore a slight or different element

attached to the portion DJ is all that is necessary to differentiate. See *The Seven-UP Company v. Tropicana Products*, 148 USPQ 604 (for SUN-UP v. SEVEN UP), as quoted below:

“The meaning of words in trademarks is often an important consideration in determining whether likelihood of confusion exists; where words have well known and understood, widely differing meanings, small difference in spelling or appearance may be sufficient to distinguish them and avoid finding of confusing similarity.”

In this particular case, DJ PAULIE as a mark as whole has four syllables with an emphasis or accent on PAUL more so than IE. DJ PAULIE has two additional letters after PAUL, i.e., IE, which have a distinct sound.

DJ PAULY D taken as whole has five syllables with a stronger emphasis or accent on the final consonant D through a rhythmic or melodic pattern which is fluid to a consumer such as occurs in the final beat in a song. Clearly, DJ PAULIE does not contain a final consonant D sound with an emphasis thereon which is a critical and integrated portion of the overall mark DJ PAULY D. Also, the emphasis or accent on PAUL in DJ PAULIE as opposed to the D in DJ PAULY D also provides a differentiating and significant quality between the two marks. It should be clear that the sound of IE after PAUL for DJ PAULIE is completely different from the sound of Y D after PAUL for DJ PAULY D. Based upon these differences, there is no similarity in the sound of the marks DJ PAULIE and DJ PAULY D and therefore there is no likelihood of confusion between them.

2) DJ PAULIE’S WORLDWIDE COUNTDOWN v. DJ PAULY D

Again, the issue is whether the marks taken as a whole are similar in sound in relation to one another such that it would create a likelihood of confusion.

To begin, all arguments made in paragraph (1) above are incorporated herein. In addition, DJ PAULIE’S WORLDWIDE COUNTDOWN has added an apostrophe s to PAULIE plus the words WORLDWIDE and COUNTDOWN, which are missing and do not in any way sound similar to the mark DJ PAULY D or even D taken alone. Therefore, it is clear that the sound of DJ PAULIE’S WORLDWIDE COUNTDOWN is very different from the mark DJ PAULY D. As a result, there is no likelihood of confusion.

c. Dissimilarity of the Marks – Appearance

To begin, it is clear that Registrant’s marks DJ PAULIE or DJ PAULIE’S WORLDWIDE COUNTDOWN are different in appearance.

1) DJ PAULIE v. DJ PAULY D

Again, the issue here is whether the marks as a whole are so similar in appearance that it would create a likelihood of confusion. DJ is a common element to both but it should be recognized that DJ in front of a name or nickname is a way of referring to persons in this particular industry, as evidenced by the hundreds of registrations incorporating the portion DJ.

Also, the following marks were held not be confusingly similar:

AMI v. BAMI

Basic American Medical, Inc. v. American Medical International, Inc., 649 F. Supp. 885, 1 U.S.P.Q.2d 1217 (S.D. Ind. 1986) (no likelihood of confusion was found between these acronyms, the court finding that when referring to AMI orally, it was spelled out, as with IBM or AT&T, whereas the BAMI acronym is pronounced “Bammy,” as in Alabammy).

B.V.D. v. B.A.D

B.V.D. Licensing Corp. v. Body Action Design, Inc., 846 F. 2d 727, 6 U.S.P.Q. 2d 1719 (Fed. Cir. 1988) (No likelihood of confusion was found where both marks were used on clothing. Consumers will likely react to the junior user's mark as the common word “bad,” not as a simulation or suggestion of the well-known mark B.V.D.).

CLF v. CLF

Church of the Larger Fellowship of Unitarian Universalist v. Conservation Law Foundation, Inc., 221 U.S.P.Q. 869 (D. Mass. 1983) (no likelihood of confusion where the parties coexisted in the same city for 15 years with negligible actual confusion).

NEC v. NECS

NEC Electronics v. New England Circuit Sales, Inc., 722 F. Supp. 861, 13 U.S.P.Q.2d 1058 (D. Mass. 1989) (No likelihood of confusion was found where plaintiff NEC is a well-known manufacturer of electronic components, including computer chips, and defendant NECS is an independent broker of computer chips selling to sophisticated purchasers “unlikely to confuse” the two. Summary judgment granted - no infringement).

Also, there are a number of cases where it has been held that there was no likelihood of confusion between marks which were similar in part:

ALTIRA ALTRIA

Altira Group LLC v. Philip Morris Companies Inc., 207 F. Supp. 2d 1193, 63 U.S.P.Q.2d 1438 (D. Colo. 2002) (preliminary injunction denied).

BOSTON TEA PARTY BOSTON SEA PARTY

Jacobs v. International Multifoods Corp., 668 F.2d 1234, 212 U.S.P.Q. 641 (C.C.P.A. 1982).

BOWFLEX BODY FLEX

Nautilus Group, Inc. v. Savvier, Inc., 427 F. Supp. 2d 990, 79 U.S.P.Q.2d 1850 (W.D. Wash. 2006) (There is a crowded market of marks in the exercise industry using the word “flex.” No likelihood of confusion between senior BOWFLEX exercise machines and junior BODY FLEX exercise bar.)

CAREFIRST FIRST CARE

Carefirst of Maryland, Inc. v. First Care, P.C., 350 F. Supp. 2d 714, 73 U.S.P.Q.2d 1833 (E.D. Va. 2004), aff'd CareFirst of Maryland, Inc. v. First Care, P.C., 434 F.3d 263, 77 U.S.P.Q.2d 1577 (4th Cir. 2006) (Summary judgment of no likelihood of confusion between senior CAREFIRST for health insurance versus junior FIRST CARE for physicians' group medical office.)

CHAIRWORKS CHAIRMAN

Chairworks Taiwan, Ltd. v. Bannister, 13 U.S.P.Q.2d 2070, 1989 WL 205730 (M.D.N.C. 1989) (both for chairs; preliminary injunction denied).

CREAM OF WHEAT CREAMY WHEAT

Nabisco Brands, Inc. v. Quaker Oats Co., 547 F. Supp. 692, 216 U.S.P.Q. 770 (D.N.J. 1982) (both for breakfast cereals; defendant used the word “creamy” in a descriptive sense to denote a soft and smooth product; preliminary injunction denied).

DIGIRAY DIGIRAD

In re Digirad Corp., 45 U.S.P.Q.2d 1841, 1998 WL 104305 (T.T.A.B. 1998) (no likelihood of confusion between DIGIRAY for electronic X-ray system and DIGIRAD for radiation sensors, because “DIGI” is commonly used for digital equipment and knowledgeable buyers will be very aware of the different connotation of RAY (for X-ray) and RAD (a measure of radiation)).

KOA A-OK

Kampgrounds of America, Inc. v. North Delaware A-OK Campground, Inc., 415 F. Supp. 1288, 190 U.S.P.Q. 437 (D. Del. 1976), aff'd without op., 556 F.2d 566 (3d Cir. 1977).

MISS U.S.A. MISS ASIA U.S.A.

Miss Universe, L.P., LLLP v. Villegas, 672 F. Supp. 2d 575, 93 U.S.P.Q.2d 1652 (S.D. N.Y. 2009) (No likelihood of confusion in MISS U.S.A. versus MISS ASIA U.S.A., both for beauty pageants).

PARENTS PARENTS DIGEST

Gruner + Jahr USA Publishing v. Meredith Corp., 991 F.2d 1072, 26 U.S.P.Q.2d 1583 (2d Cir. 1993).

TEEN TEEN PEOPLE

Time, Inc. v. Petersen Pub. Co. L.L.C., 173 F.3d 113, 50 U.S.P.Q.2d 1474 (2d Cir. 1999) (both for magazines aimed at teenagers, the junior user being the publisher of PEOPLE magazine).

TIC TAC TOE TIC TAC

In re Ferrero, 479 F.2d 1395, 178 U.S.P.Q. 167 (C.C.P.A. 1973).

VARGAS VARGA GIRL

In re Hearst Corp., 982 F.2d 493, 25 U.S.P.Q.2d 1238 (Fed. Cir. 1992) (both for calendars with pictures by the artist Alberto Vargas; “When GIRL is given fair weight, along with VARGA, confusion with VARGAS becomes less likely.”).

Therefore, it should only take a small difference in appearance between the remaining portions of the mark to overcome any likelihood of confusion. In comparing the name portions of the marks, i.e., PAULIE v. PAULY, it is clear that Registrant’s mark is spelled with PAUL and then “IE” whereas the Applicant is spelled with PAUL and then a ”Y D”. Clearly, “IE” and “Y D” are completely different in appearance to the average consumer. Specifically, I and Y are different in appearance and E and D are different in appearance. Therefore, by having two additional letters after PAUL which are completely different in appearance (IE v. Y D), the marks DJ PAULIE and DJ PAULY D, as a whole, are completely different in appearance and there is no likelihood of confusion between them.

d. Confusingly similar Marks That Contain Additional Matter

The general rule concerning similar marks that contain additional matter, namely, that “likelihood of confusion is not avoided between otherwise confusingly similar marks merely by adding or deleting a house mark or matter that is descriptive or suggestive of the named goods or services”, does not apply in this matter. TMEP §1207.01(b)(iii).

The Applicant has not added or deleted a house mark. The letter “D” (after PAULY) in his mark, represents the first initial of his last name.

Likewise, the Applicant has not added or deleted matter that is descriptive or suggestive of the named goods or services.

In TMEP §1207.01(b)(iii), the Office states that

“Sometimes, the rule is expressed in terms of the dominance of the common term. Therefore, if the dominant portion of both marks is the same, then confusion may be likely notwithstanding peripheral differences.” *Id.*

As stated previously, the dominant part of Registrant’s mark is PAULIE or PAULIE’S, but the dominant part of Applicant’s mark is PAULY D, not PAULY. Therefore, the dominant parts of the marks are not the same.

The Office recognizes exceptions to the general rule concerning additional matter.

“Exceptions to the above-stated general rule regarding additions or deletions to marks may arise if: (1) the marks in their entireties convey significantly different commercial impressions; or (2) the matter common to the marks is not likely to be perceived by purchasers as distinguishing source because it is merely descriptive or diluted.” *Id.*

When viewed in their entirety, the Applicant’s mark and the Registrant’s mark convey significantly different commercial impressions.

As stated, PAULY D represents a pseudonym, stage name and/or nickname for Applicant, composed of his first name and the first initial of his last name. They are interconnected. The mark PAULY D must therefore be read in its entirety in determining whether there is a likelihood of confusion between it and Registrant’s Mark. When that is done, DJ PAULY D is equated with the Applicant, Paul Delvecchio, whose pseudonym, stage name and/or nickname is Pauly D.

Similarly, the matter common to the marks (PAUL) is not likely to be perceived by purchasers as distinguishing source because as a first name, “it is merely diluted.”

Even if the letter “D” is considered to be adding matter that is descriptive or suggestive, since it is the first initial of the last name of Applicant, it (the letter “D”) operates as an indicator of source in Applicant’s mark, even though it may have diminished importance in most other marks. Therefore, Applicant’s mark conveys a different commercial impression than Registrant’s mark. Shen Mfg. Co. v. The Ritz Hotel, Ltd., 393 F.3d 1238, 1245 (Fed. Cir. 2004).

2. The similarity or dissimilarity of and nature of the goods or services as described in an application or registration or in connection with which a prior mark is in use.

The services listed for the mark DJ PAULIE and DJ PAULIE’s WorldWide Countdown (U.S. Trademark Reg. Nos. 3735703 and 3850538) respectively are listed as the following:

“Entertainment services in the nature of disc jockey services.”

The clear focus of the language above is on the term “disc jockey”, which is defined as follows:

“An announcer who presents and comments on popular recorded music, especially on the radio.” (American Heritage Dictionary of the English Language)” (See Exhibit 1 attached).

The key element here is that the announcer is providing previously recorded music that is usually requested or controlled by the listening audience, such as a bride and groom selecting prerecorded songs for a wedding.

In stark contrast, the Applicant is mixing, creating, and composing unique music for a live performance by using a turntable as a musical instrument, also known as “turntablism”. (See Exhibit 2 attached for explanation of turntablism.) The Applicant is getting paid as a musical artist to provide a unique form of music. (See also Exhibit 3 Berklee College of Music Course Details and Exhibit 4 – TurntableConcertoCarnegieHall attached.)

In summary, the Applicant composes his own music during the live performance through a variety of techniques while using the turntable as a musical instrument whereas the “disc jockey” is playing popular prerecorded music of other artists/third parties which is heavily controlled by the patrons listening to the music.

Therefore, the services recited in U.S. Trademark Reg. Nos. 3735703 and 3850538 registrations are completely different from the Applicant’s aforementioned remaining amended identification of services.

The Office states

“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.”

“Turntablism”, however, did not develop as an art form until the 1990’s, twenty years after the claimed date of first use in U.S. Trademark Reg. Nos. 3735703 (September 15, 1973), the date the Registrant alleges he began to offer “disc jockey services”.

“The appearance of turntablists and the birth of turntablism was prompted by one major factor - the disappearance of the DJ in hip hop groups, on records and in live shows at the turn of the 1990s. This disappearance has been widely documented in books and documentaries (such as *Black Noise* and *Scratch The Movie*), and was linked to the increased use of DAT tapes and other studio techniques that would ultimately push the DJ further away from the original hip hop equation of the MC as the vocalist and the DJ as the music provider alongside the producer. This push and disappearance of the DJ meant that the practices of the DJ, such as scratching, went back underground and were cultivated and built upon by a generation of people who grew up with hip hop, DJs and scratching. By the mid-90s the disappearance of the DJ in hip hop had created a sub-culture which would come to be known as turntablism and which focused entirely on the DJ utilising his turntables and a mixer to manipulate sounds and create music. By pushing the practice of DJing away, hip hop created the grounds for this sub-culture to evolve.

So by the mid to late 1990s the terms turntablism and turntablist had become established and accepted to define the practice and practitioner of using turntables and a mixer to create or manipulate sounds and music. This could be done by scratching a record or manipulating the rhythms on the record either by drumming, looping or beat juggling.”
<http://en.wikipedia.org/wiki/Turntablism>

“Turntablism” is associated with “Hip Hop”, which itself did not emerge as a genre of music until 1979. (“The first hip hop recording is widely regarded to be The Sugarhill Gang's "Rapper's Delight", from 1979.”) http://en.wikipedia.org/wiki/Hip_hop_music.

Once again, this date is after the Registrant’s date of first use in commerce in U.S. Trademark Reg. No. 3735703.

In addition, according to the website for DJ Paulie Broadcasting LLC, the entity under which the Registrant claims to operate and offer DJ services, found at <http://www.partyblast.com/profile/1598/dj-paulie-broadcasting-llc>, the scope of the services offered by Registrant is as follows:

“Weddings & Corporate Parties are our Speciality. (See Exhibit 5).

These services are completely different than those offered by the Applicant.

3. The Similarity or Dissimilarity of established, likely-to-continue Trade Channels.

TMEP §1207.01(a)(iii), in pertinent part, states as follows:

“The nature and scope of a party’s goods or services must be determined on the basis of the goods or services recited in the application or registration. (*citations omitted*)

If the cited registration describes goods or services broadly, and there is no limitation as to the nature, type, channels of trade, or class of purchasers, it is presumed that the registration encompasses all goods or services of the type described, that they move in all normal channels of trade, and that they are available to all classes of purchasers. See, e.g., *In re Thor Tech, Inc.*, 90 USPQ2d 1634, 1638 (TTAB 2009) (“We have no authority to read any restrictions or limitations into the registrant’s description of goods.”); *In re Jump Designs, LLC*, 80 USPQ2d 1370, 1374 (TTAB 2006). Therefore, if the cited registration has a broad identification of goods or services, an applicant does not avoid likelihood of confusion merely by more narrowly identifying its related goods.” (*emphasis added*)

Applicant submits that the scope of the applicable trade channels in which he provides his services is defined and characterized by “club music” and that the remaining identification of services in his application, i.e., “Entertainment services, namely, live performances by a musical performer playing, scratching, manipulating, composing, and mixing recorded music” International Class 041, incorporates same.

As a result, the presumption that the registration encompasses all the services listed in the description of services in the application, that they move in all normal channels of

trade and are available to all classes of purchasers does not apply. TMEP §1207.01(a)(iii).

Accordingly, since the services of the respective marks are offered to a different class of consumer, said services are not related and there is no likelihood of confusion between the Applicant's mark and the Registrant's mark.

Therefore, the Office's position that

“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.”

is incorrect.

The genre of music and age groups to which the respective services are geared, are vastly different. (See Exhibits 5 and 6 regarding the Registrant's Services and Exhibits 7 through 10 regarding the Applicant's Services). As stated in the review of Applicant's appearance at Fur Nightclub in Washington, D.C., Applicant's “music library spans nearly every genre of club music ... we were more impressed by his ability to mix in and out of top 40 and our style of house music. By doing this, he's able to introduce an entirely new demographic to quality dance music.” (See Exhibit 10 pp.2-3).

According to the website for DJ Paulie Broadcasting LLC, the entity under which the Registrant claims to operate and offer DJ services, found at <http://www.partyblast.com/profile/1598/dj-paulie-broadcasting-llc>, a portion of the home page thereof which is shown below, the Registrant only serves some cities and towns located in the State of Connecticut.

DJ Paulie Broadcasting LLC

Description: Weddings & Corporate Parties are our Speciality. Complete MC along with the areas largest music selection. Extras include Music Videos, Karaoke, Light Shows.

Location: Farmington, CT

Phone: [View Phone #](#)

Areas Served: [Hartford County](#), [Avon](#), [Berlin](#), [Bloomfield](#), [Bristol](#), [Broad Brook](#), [Burlington](#), [Canton](#), [Canton Center](#), [Collinsville](#), [East Berlin](#), [East Glastonbury](#), [East Granby](#), [East Hartford](#), [East Hartland](#), [East Windsor](#), [East Windsor Hill](#), [Enfield](#), [Farmington](#), [Forestville](#), [Glastonbury](#), [Granby](#), [Hartford](#), [Kensington](#), [Manchester](#), [Marion](#), [Marlborough](#), [Melrose](#), [Milldale](#),

[New Britain](#), [Newington](#), [North Canton](#), [North Granby](#), [Plainville](#), [Plantsville](#), [Poquonock](#), [Rocky Hill](#), [Simsbury](#), [South Glastonbury](#), [South Windsor](#), [Southington](#), [Suffield](#), [Tariffville](#), [Unionville](#), [Weatogue](#), [West Granby](#), [West Hartford](#), [West Hartland](#), [West Simsbury](#), [West Suffield](#), [Wethersfield](#), [Windsor](#), [Windsor Locks](#), [Windsorville](#)

The fact that Registrant only offers services in this limited area is further supported by statements made at the link to Registrant Paul Lis' youshook Facebook page (below), on which there is a video of a man reading that DJ PAULIE will no longer be traveling to Las Vegas or New Jersey to DJ. The reader also states and that DJ PAULIE will no longer be appearing on television and will only be appearing as a DJ locally.

There is no evidence that DJ Paulie will Bridge the Gap between the different trade channels because he is a static user in a limited geographic area for an on-campus radio station and possible weddings – nothing to do with nightclub events worldwide.

Having a Website and a local radio show do not automatically establish territory in RI or elsewhere. In relevant trade channels, DJ Pauly D = Paul Delvecchio, just as Madonna = Madonna Ciccone. The marks are associated with the respective entertainer.

The nature of DJ services offered by the Registrant, by definition, limits the geographic scope of prospective purchasers. For example, it is unlikely that a bride and groom will travel out of a small, limited geographic area to find a classic disc jockey that merely plays pre-recorded music personally selected by the bride and groom. Most wedding DJs are considered based upon their relationship with either the wedding venue or as part of a package offered by a company serving particular wedding venues which operate in a fairly defined geographic area.

The channels of trade and purchasers of the respective services for Applicant's mark and Registrant's mark are therefore different. *M2 Software, Inc. v. M2 Communications, Inc.*, 450 F.3d 1378, 1382 (Fed. Cir. 2006).

4. The conditions under which and buyers to whom sales are made, i.e. "impulse" vs. careful, sophisticated purchasing.

Sophisticated purchasers can distinguish between the services offered by DJ PAULIE and the services offered by DJ PAULY D. The genre of music and age groups to which the respective services are geared, are vastly different. (See Exhibits 5 and 6 regarding the Registrant's Services and Exhibits 7 through 10 regarding the Applicant's Services). The latter show and highlight the celebrity aspect in the services in Applicant's remaining identification of services in his application.

One further note, the vast differences in the pricing of the services offered by the Applicant and Registrant also demonstrate the differences in the purchasers of the respective services. It shows that sophisticated purchasers are buying services of the Applicant, DJ PAULY D and not the Registrant. It has been reported in the popular press that the Applicant is receiving personal appearance fees to perform for almost \$40,000

USD per event at some of the U.S. and world's hottest nightclubs and venues. In contrast, the Registrant, Paul Lis of Connecticut, aka DJ PAULIE is offering wedding dj services which, on average, can run between \$1000 USD per event which is 40 times less than the Applicant's fee. Clearly, there is no likelihood of confusion amongst a sophisticated person, possibly a nightclub manager, buying the services of the Applicant at \$40,000 plus per event versus a local wedding dj who is possibly making on average \$1000 USD per event or possibly less.

As stated in the review of Applicant's appearance at Fur Nightclub in Washington, D.C., Applicant's "music library spans nearly every genre of club music... we were more impressed by his ability to mix in and out of top 40 and our style of house music. By doing this, he's able to introduce an entirely new demographic to quality dance music." (See Exhibit 10 pp.2-3).

More importantly, connection of the services offered with the source of those services, is entirely dependent upon identification of the provider. The marks do not just state a name; they represent a person, a living entertainer. When the purchaser is only interested in the services from the specific person offering same, no mistake can be made that the services originate from the same source.

As noted in the referenced review (Exhibit 10 pp.2-3), Applicant's "music library spans nearly every genre of club music."

The channels of trade and the sophistication of the purchasers are presumed to be identical. ("[A]bsent restrictions in the application and registration, goods and services are presumed to travel in the same channels of trade to the same class of purchasers."). *Shen Mfg. Co. v. The Ritz Hotel, Ltd.*, 393 F.3d 1238, 1246 (Fed. Cir. 2004) quoting *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1268 (Fed. Cir. 2002).

This presumption does not apply, however, since Applicant has above submitted that the scope of the applicable trade channels in which he provides his services is defined by "club music" and that the remaining identification of services in his application reflects same.

Sophisticated purchasers in trade channels defined by "club music" can easily distinguish between the services offered by DJ PAULIE or DJ PAULIE'S and the services offered by DJ PAULY D. (See Exhibit 10).

In TMEP §1207.01, the Office states that "[r]egarding 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)." (*emphasis added*)

As a result of the differences in the "prospective purchasers", there is no likelihood of confusion between Applicant's mark and Registrant's mark.

5. The Number and Nature of Similar Marks in use on Similar Goods.

There are other marks with the name PAUL that co-exist with Registrant's mark.

There are over 500 pending applications/registrations for PAUL, including almost 200 in Class 41 for services using PAUL or a variation thereof. They include PAUL NEWMAN (entertainer), SEAN PAUL (entertainer), PAUL MCCARTNEY (entertainer), PAULY SHORE (entertainer), PAUL LONDON (entertainer), PAULA DEEN (entertainer), PAULA ABDUL (entertainer) and PAUL JR. (entertainer). (See Search Results attached as Exhibit 11).

As a result, PAUL is a first name and therefore a very weak mark for any service. (See Exhibit 11).

6. The Length of Time during and conditions under which there has been Concurrent Use without evidence of Actual Confusion.

Applicant has been using the mark in good faith in a distinctive geographic or remote area. (See Exhibit 7).

His mark has co-existed with Registrant's mark in different geographic areas since as early as 1996 without any evidence of actual confusion.

The limited scope of the area in which the Registrant has operated is further supported by a link (below) to his youshook Facebook page, on which there is a video of a man reading that DJ Paulie will no longer be traveling to Las Vegas or New Jersey to DJ. The reader also states that DJ Paulie will no longer be appearing on television and will only be appearing as a DJ locally.

<http://www.facebook.com/home.php?#!/profile.php?id=100000745753013>

Note: (click on wall tab and scroll down to older posts arrow to find video box).

7. The extent of potential confusion, i.e., whether *de minimis* or substantial.

Given the completely different genre of music, audience age group and nature of the venues at which the DJ services are provided and all the other reasons herein asserted, the extent of potential confusion is virtually nonexistent.

8. Rule of Doubt in Favor of Applicant

The great variation in facts from case to case prevents the formulation of specific rules. Each case must be decided on its own merits. See *In re Ampco Foods, Inc.*, 227 USPQ 331 (TTAB 1985); *In re Venturi, Inc.*, 197 USPQ 714 (TTAB 1977). The "rule of doubt" operates in 2(d) cases in the applicant's favor. Any doubt about the likelihood of confusion of the applied-for mark is resolved in favor of, not against, publication of the

application for opposition. If an issue regarding likelihood of confusion truly exists, an opposition to the registration of the Applicant's Mark will be filed by a party in interest.

II. §2f Claim and Famous Status of DJ PAULY D mark

As noted by the Office in TMEP §1211.02(b)(vii), the assertion of a claim under Section §2(f) by an applicant is required for submitting evidence of the fame of the applicant's mark.

TMEP §1211.02(b)(vii)

“Evidence of the fame of a mark (e.g., evidence of consumer recognition of a mark, or expenditures made in promoting or advertising a mark) is not relevant unless registration is sought under §2(f). *In re McDonald's Corp.*, 230 USPQ 304, 307 (TTAB 1986) (Mc DONALD'S held primarily merely a surname in spite of strong secondary meaning, with the Board stating that “the word ‘primarily’ refers to the primary significance of the term, that is, the ordinary meaning of the word, and not to the term's strength as a trademark due to widespread advertising and promotion of the term as a mark to identify goods and/or services.”) *See also In re Industrie Pirelli Societa per Azioni*, 9 USPQ2d 1564 (TTAB 1988), *aff'd*, 883 F.2d 1026 (Fed. Cir. 1989); *In re Nelson Souto Major Piquet*, 5 USPQ2d 1367 (TTAB 1987).”

Applicant therefore asserts his claim under Section §2(f) and submits the evidence contained in Exhibits 7 through 10 and Exhibit 12 in support of his claim that his mark, DJ PAULY D is famous. Said Exhibit 12 shows that a **Google Search** of said mark performed on November 4, 2010 yields about 1,600,000 results.

Furthermore, the Applicant's mark, DJ PAULY D has national and international fame and thereby has acquired secondary meaning and distinctiveness. For example, the Applicant uses his mark DJ PAULY D to identify himself on the hit television series called JERSEY SHORE which is MTV's number one hit series of all time. MTV is broadcast in over 166 countries. Its recently finale show attracted 7.6 million viewers in the US alone. In addition, it has been reported in the popular press that DJ PAULY D will now have his own show, a spin-off show of JERSEY SHORE. It has been reported that the Applicant will be making over 100k per episode in the upcoming season of JERSEY SHORE, which is being filmed in Italy to cater to a domestic and international audience.

Conclusion

For the foregoing reasons, favorable reconsideration of the refusal and early passage of Applicant's mark to publication is respectfully requested.

Respectfully submitted,

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CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

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On: May 21, 2011

Henry V. Boezi III, Esquire