

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Name of Applicant: Thomas L. Kelly

Serial Number of Application: 78/460,516

Filing Date of Application: 09/09/05

TTAB

Docket No.

E-2411

Trademark: MARCONI BROADCASTING

International Class(es): 038

NOTICE OF APPEAL

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Trademark Examining Attorney refusing registration.

This Appeal is taken for:

all classes listed above  only the following classes: \_\_\_\_\_

The total number of classes associated with this Appeal are: 1

The prescribed appeal fee of \$100.00 is to be paid as follows:

A check in the amount of \$100.00 is attached.  
Any excess or insufficiency should be credited or debited to Deposit Account No.

Please charge Deposit Account No. \_\_\_\_\_ in the amount of \_\_\_\_\_

Payment by credit card. Form PTO-2038 is attached.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**



Signature

Dated: 07/24/06

John F. A. Earley III, Reg. No. 31,350  
Harding, Earley, Follmer & Frailey  
P.O. Box 750  
Valley Forge, PA 19482-0750  
Phone: (610) 935-2300  
Attorneys for Applicant



08/01/2006 KGIBBONS 00000023 78460516

01 FC:6403

100.00 0P

07-27-2006

U.S. Patent & TMO/TM Mail Rcpt Dt. #72

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Name of Applicant: **Thomas L. Kelly**

Docket No.

Serial Number of Application: **78/460,516****2411**Filing Date of Application: **09/09/05**

Trademark: **MARCONI BROADCASTING**  
**MARCONI BROADCASTING**

International Class(es): **038**

**NOTICE OF APPEAL**

**Certificate of Transmission by Facsimile\***

I certify that this document and authorization to charge deposit account is being facsimile transmitted to the United States Patent and Trademark Office, Trademark Trial and Appeal Board (Fax. No. \_\_\_\_\_ )  
on \_\_\_\_\_

(Date)

*Signature of Person Mailing Correspondence*

*Typed or Printed Name of Person Signing Certificate*

**Certificate of Mailing by First Class Mail**

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 "Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451" [37 CFR 1.8(a)] on \_\_\_\_\_

**7/24/06**

(Date)

*Signature of Person Mailing Correspondence*

*Typed or Printed Name of Person Mailing Correspondence*

\*This certificate may only be used if paying by deposit account.

**Certificate of Mailing by Express Mail**

I certify that this document and fee is being deposited on \_\_\_\_\_ with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. 1.10 and is addressed to, Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

*Signature of Person Mailing Correspondence*

*Typed or Printed Name of Person Mailing Correspondence*

*"Express Mail" Mailing Label Number*

Serial No. 78/460,516  
Response to Office Action dated January 23, 2006  
Response Date: July 24, 2006

E-2411

In re Matter of  
Thomas L. Kelly  
U.S. Trademark Application Serial No. 78/460,516  
Mark: MARCONI BROADCASTING

Attention: Robert H. Coggins  
Attorney Advisor  
Law Office 115

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

CERTIFICATE OF MAILING BY  
FIRST CLASS MAIL UNDER 37 CFR SECTION 1.8

I hereby certify that these papers are being deposited with the United States Postal Service with sufficient postage as First Class Mail under 37 CFR Section 1.8 on the date indicated hereon, and is addressed to the Commissioner for Trademarks, P.O. Box 1451, Alexandria, VA 22313-1451.

7/24/06  
Date

John F.A. Earley III  
John F.A. Earley III  
Reg. No. 31,350

AUTHORIZATION TO CHARGE DEPOSIT ACCOUNT

The Commissioner is hereby authorized to charge any additional fees which may be required by this paper and during this pendency of this application to Account 05-0208.

7/24/06  
Date

John F.A. Earley III  
John F.A. Earley III  
Reg. No. 31,350

RESPONSE

This is in response to the Office Action dated July 23, 2006. Reconsideration of the application is respectfully requested in view of the following comments:

- 1) Applicant appreciates the indication that the issues relating to the disclaimer, classification, and recitation of services have been resolved.
- 2) Applicant's mark MARCONI BROADCASTING is refused registration under 15 U.S.C. § 1052(d). Applicant respectfully traverses the refusal.

The Office Action states that "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." However, it is respectfully submitted that the applicant's mark is in fact being improperly dissected into components rather than being considered as a whole because the word "broadcasting" is apparently being given practically no weight, with the Office Action stating that "The disclaimed term BROADCASTING is generic for applicant's broadcasting services." A disclaimed element of a mark is relevant, especially in this case, to the assessment to similarity. See In re Shell Oil Co., 992 F.2d 1204, 1206 (Fed. Cir. 1993). As the Court of Appeals for the Federal Circuit stated in Shen Mfg. Co. v. Ritz Hotel, Ltd., 393 F.3d 1238 (Fed. Cir. 2004), "This is so because confusion is evaluated from the perspective of the purchasing public, which is not aware that certain words or phrases have been disclaimed. In re Nat'l, 753 F.2d 1059." In the pending application, the combination of "MARCONI" and "BROADCASTING", in view of applicant's entertainment services, creates a commercial impression that differs from that of registrant's mark, in view of registrant's goods/services.

The Official Action also suggests that applicant has asserted that the test of likelihood of confusion is whether the marks can be distinguished when subject to a side-by-side comparison. Applicant has not asserted that this is the test in determining likelihood of confusion. What applicant asserts is that the marks, when compared in their entireties, in view of the respective goods/services of the two marks, are not likely to lead to a likelihood of confusion. Applicant's mark, when taken in view of applicant's goods,

is suggestive of applicant's entertainment services, namely, radio broadcasting services. In contrast to this, the cited mark, when taken in view of the registrant's goods/services, creates an entirely different commercial impression, that is, one of Marconi, the Italian engineer and inventor.

In further support of applicant's position, applicant intends to supplement this response with a declaration, which is expected to be filed shortly.

3) Applicant's mark MARCONI BROADCASTING also is refused registration under 15 U.S.C. § 1052(e) (4). Applicant respectfully traverses this refusal.

Applicant's mark includes the term "Marconi", a term that identifies a historical person. Terms which identify historical persons have been found by the U.S. Patent and Trademark Office not to be primarily merely a surname. See TMEP at Section 1211.01(a)(4) and Lucien Piccard Watch Corp. v. Since 1898 Crescent Corp., 214 F.Supp. 329, 165 U.S.P.Q. 459 (S.D.N.Y. 1970), where "DA VINCI" was found not to be primarily merely a surname because it primarily connotes Leonardo Da Vinci, a historical person.

Moreover, as the Court of Appeals for the Federal Circuit stated in In re Hutchinson Technology, Inc., 852 F.2d 552, 7 U.S.P.Q.2d 1490 (Fed. Cir. 1988), the issue is "what the purchasing public would think when confronted with the mark as a whole." Here, as in Hutchinson Technology as well as in Lane Capital Management, Inc. v. Lane Capital Management, Inc., 15 F.Supp.2d 389 (S.D.N.Y. 1988), judgment aff'd 192 F.3d 337, 52 U.S.P.Q.2d 1094 (2d Cir. 1999), applicant's mark as a whole is not a

Serial No. 78/460,516

E-2411

Response to Office Action dated January 23, 2006

Response Date: July 24, 2006

surname and the consumer is not likely you mark as a whole as primarily merely a  
surname.

Respectfully submitted,

HARDING, EARLEY, FOLLMER & FRAILEY  
Attorneys for Applicant



---

John F.A. Earley III

Registration No. 31,350

P.O. Box 750

Valley Forge, PA 19482-0750

Telephone: 610-935-2300

Date: 7/24/06