

ESTTA Tracking number: **ESTTA240103**

Filing date: **10/01/2008**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

| | |
|---------------------------------------|--|
| Name | SeanP.Combs |
| Granted to Date of previous extension | 10/01/2008 |
| Address | c/o Bad Boy Entertainment, Inc. 1710 Broadway New York, NY 10019 UNITED STATES |

| | |
|----------------------|---|
| Attorney information | Robert A. Becker Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES rbecker@frosszelnick.com Phone:212-813-5900 |
|----------------------|---|

Applicant Information

| | | | |
|------------------------|--|------------------------|------------|
| Application No | 78615932 | Publication date | 06/03/2008 |
| Opposition Filing Date | 10/01/2008 | Opposition Period Ends | 10/01/2008 |
| Applicant | PACIFIC RIM MARKETING INC 1051 Leslie St La Habra, CA 90631 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 009. First Use: 2005/04/06 First Use In Commerce: 2005/04/06 All goods and services in the class are opposed, namely: Headphones and cases specially adapted for MP3 players, cell phones and video disc players |
|---|

Grounds for Opposition

| | |
|--------------------------------------|-----------------------------|
| False suggestion of a connection | Trademark Act section 2(a) |
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| Dilution | Trademark Act section 43(c) |

Mark Cited by Opposer as Basis for Opposition

| | | | |
|-----------------------|------------|-----------------------|------------|
| U.S. Registration No. | 3109611 | Application Date | 06/06/2001 |
| Registration Date | 06/27/2006 | Foreign Priority Date | NONE |
| Word Mark | P.DIDDY | | |

| | |
|---------------------|---|
| Design Mark | |
| Description of Mark | NONE |
| Goods/Services | <p>Class 009. First use: First Use: 2001/07/10 First Use In Commerce: 2001/07/10 musical sound recordings; video recordings featuring music and musical based entertainment; downloadable musical sound recordings</p> <p>Class 016. First use: First Use: 2002/00/00 First Use In Commerce: 2002/00/00 posters</p> <p>Class 025. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 t-shirts</p> <p>Class 038. First use: First Use: 2003/00/00 First Use In Commerce: 2003/00/00 streaming of audio and visual recordings featuring music and musical based entertainment over a global computer network</p> <p>Class 041. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 entertainment services, namely live musical performances; providing a website on a global computer network featuring information on entertainment, a musical performer and producer and his musical performances, biography, productions, sound and video recordings, appearances, concerts, other recording artists, and the like</p> <p>Class 042. First use: First Use: 2001/00/00 First Use In Commerce: 2001/00/00 providing a web site of information about fashion and popular culture</p> |

| | |
|-------------|--|
| Attachments | 76268455#TMSN.gif (1 page)(bytes) Notice of Opposition (F0354780).PDF (11 pages)(215027 bytes) |
|-------------|--|

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

| | |
|-----------|------------------|
| Signature | /Robert Becker/ |
| Name | Robert A. Becker |
| Date | 10/01/2008 |

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

In re Application Ser. No. 78/615,932
Published June 3, 2008
Opposer's Reference: PFD USA TC-07/05683

-----X
Sean Puffy Combs, :
: :
Opposer, : :
: :
- against - : :
: :
Pacific Rim Marketing Inc., : :
: :
Applicant. : :
-----X

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Sean Puffy Combs, an individual with an address c/o Bad Boy Entertainment, Inc., 1710 Broadway, New York, New York 10019, believes that he will be damaged by registration of the mark IDDIDDY, which is the subject of Application Ser. No. 78/615,932, published in the Official Gazette of June 3, 2008, and hereby opposes same.

As grounds for the opposition, Opposer alleges as follows:

FACTS COMMON TO ALL CLAIMS

1. Opposer is an entertainer, producer, and entrepreneur who has been known worldwide under the name P.DIDDY since at least as early as 2001.
2. Opposer is the owner of all common law rights in the mark P.DIDDY for musical sound recordings, video recordings featuring music, downloadable musical sound recordings, posters, t-shirts, live musical performances, providing a website featuring information on entertainment, sound and video recordings, concerts, fashion, and popular culture, and related

goods and services. Opposer began using the P.DIDDY mark for such goods and services at least as early as 2001. Opposer has never abandoned this mark.

3. Opposer is the owner of Reg. No. 3,109,611 for the mark P.DIDDY for “musical sound recordings; video recordings featuring music and musical based entertainment; downloadable musical sound recordings” in Class 9, based on a first use in commerce date of July 10, 2001, “posters” in Class 16, based on a first use in commerce date of 2002, “t-shirts” in Class 25, based on a first use in commerce date of 2001, “streaming of audio and visual recordings featuring music and musical based entertainment over a global computer network” in Class 38, based on a first use in commerce date of 2003, “entertainment services, namely live musical performances; providing a website on a global computer network featuring information on entertainment, a musical performer and producer and his musical performances, biography, productions, sound and video recordings, appearances, concerts, other recording artists, and the like” in Class 41, based on a first use in commerce date of 2001, and “providing a web site of information about fashion and popular culture” in Class 42, based on a first use in commerce date of 2001. The mark was registered on June 27, 2006, based on an application filed on June 6, 2001. A TARR printout relating to this registration is attached as Exhibit A. This registration is valid and subsisting.

4. On April 25, 2005, Applicant filed application Ser. No. 78/615,932 to register IDIDDY for “Headphones and cases specially adapted for MP3 players, cell phones and video disc players” in Class 9, based on an alleged first use in commerce date of April 6, 2005.

COUNT ONE

5. Opposer repeats and realleges the allegations set forth in ¶¶ 1-4.

6. The mark IDIDDY sought to be registered by Applicant for the above goods is so similar to Opposer's mark P.DIDDY for the goods and services set forth in Reg. No. 3,109,611 as to be likely to cause confusion or to cause mistake or to deceive. Applicant's IDIDDY mark differs from Opposer's P.DIDDY mark by one letter. The goods listed in the subject application, like the goods and services listed in Reg. No. 3,109,611, relate to music and videos. More specifically, Opposer's Reg. No. 3,109,611 covers "downloadable musical sound recordings" in Class 9, while the subject application covers items in Class 9 that are "specially adapted for" devices that play downloadable musical sound recordings. Thus, the goods listed in the subject application are related to the goods and services in Opposer's registration.

7. Use of the mark sought to be registered by Applicant is likely to cause confusion or to cause mistake or to deceive the purchasing public by reason of Opposer's mark, by creating the mistaken belief that Applicant's goods are approved, endorsed, or sponsored by Opposer, or that Opposer is the source of Applicant's goods, or that the goods of Applicant are in some other way associated with Opposer, all to Opposer's grave injury and harm.

COUNT TWO

8. Opposer repeats and realleges the allegations set forth in ¶¶ 1-7.

9. The mark IDIDDY sought to be registered by Applicant for the above goods is so similar to Opposer's mark P.DIDDY for the goods and services set forth in ¶ 2, *supra*, as to be likely to cause confusion or to cause mistake or to deceive. Applicant's IDIDDY mark differs from Opposer's P.DIDDY mark by one letter. The goods listed in the subject application, like the goods and services set forth in ¶ 2, *supra*, relate to music and videos. More specifically, Opposer uses his mark for downloadable musical sound recordings, while the subject application covers items that are "specially adapted for" devices that play downloadable musical sound

recordings. Thus, the goods listed in the subject application are related to the goods and services for which Opposer has common law rights in the P.DIDDY mark.

10. Use of the mark sought to be registered by Applicant is likely to cause confusion or to cause mistake or to deceive the purchasing public by reason of Opposer's mark, by creating the mistaken belief that Applicant's goods are approved, endorsed, or sponsored by Opposer, or that Opposer is the source of Applicant's goods, or that the goods of Applicant are in some other way associated with Opposer, all to Opposer's grave injury and harm.

COUNT THREE

11. Opposer repeats and realleges the allegations set forth in ¶¶ 1-10.

12. Opposer is an individual known by the name P.DIDDY, and the use of IDIDDY by Applicant will falsely suggest a connection with Opposer, in violation of Section 2(a) of the Lanham Act, 15 U.S.C. § 1052(a). By reason of the foregoing, Opposer will be damaged by the registration of IDIDDY.

COUNT FOUR

13. Opposer repeats and realleges the allegations set forth in ¶¶ 1-12.

14. Long before any use of or alleged rights of Applicant in the mark hereby opposed, the P.DIDDY mark became famous and distinctive of Opposer's goods and services.

15. Upon information and belief, Applicant adopted and applied to register IDIDDY with full knowledge of Opposer's prior use of, and the fame of, Opposer's P.DIDDY mark. Applicant was also on constructive notice of Opposer's exclusive rights in P.DIDDY by virtue of Opposer's federal trademark registration therefor.

16. The use of IDIDDY by Applicant will cause dilution of the distinctive quality of the famous P.DIDDY mark, in violation of Section 43(c) of the Lanham Act, 15 U.S.C.

§ 1125(c)(1), an independent and additional ground for opposing the subject application pursuant to Section 13(a) of the Lanham Act, 15 U.S.C. § 1063(a). By reason of the foregoing, Opposer will be damaged by the registration of the subject mark.

WHEREFORE, Opposer respectfully requests that its opposition be sustained and the application to register the mark IDIDDY, Ser. No. 78/615,932, be denied.

Dated: New York, New York
October 1, 2008

Respectfully submitted,

**FROSS ZELNICK LEHRMAN
& ZISSU, P.C.**


By: 

Robert A. Becker

Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the NOTICE OF OPPOSITION to be served by prepaid, first-class mail on this 1st day of October, 2008, upon applicant, Pacific Rim Marketing Inc., at 1051 Leslie Street, La Habra, CA 90631, and at 1306 Via Tornasol, Aptos, CA 95003-5654.

A handwritten signature in cursive script that reads "Robert Becker". The signature is written in black ink and is positioned above a horizontal line.

Robert A. Becker

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2008-10-01 15:14:04 ET

Serial Number: 76268455 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3109611

Mark (words only): P.DIDDY

Standard Character claim: No

Current Status: Registered.

Date of Status: 2006-06-27

Filing Date: 2001-06-06

Transformed into a National Application: No

Registration Date: 2006-06-27

Register: Principal

Law Office Assigned: LAW OFFICE 106

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 650 -Publication And Issue Section

Date In Location: 2006-05-19

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. Combs, Sean Puffy

Address:

Combs, Sean Puffy
c/o Bad Boy Entertainment 1540 Broadway, 30th Fl.
New York, NY 10036
United States

Legal Entity Type: Individual

Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 009

Class Status: Active

musical sound recordings; video recordings featuring music and musical based entertainment;
downloadable musical sound recordings

Basis: 1(a)

First Use Date: 2001-07-10

First Use in Commerce Date: 2001-07-10

International Class: 016

Class Status: Active

posters

Basis: 1(a)

First Use Date: 2002-00-00

First Use in Commerce Date: 2002-00-00

International Class: 025

Class Status: Active

t-shirts

Basis: 1(a)

First Use Date: 2001-00-00

First Use in Commerce Date: 2001-00-00

International Class: 038

Class Status: Active

streaming of audio and visual recordings featuring music and musical based entertainment over a global
computer network

Basis: 1(a)

First Use Date: 2003-00-00

First Use in Commerce Date: 2003-00-00

International Class: 041

Class Status: Active

entertainment services, namely live musical performances; providing a website on a global computer
network featuring information on entertainment, a musical performer and producer and his musical
performances, biography, productions, sound and video recordings, appearances, concerts, other
recording artists, and the like

Basis: 1(a)

First Use Date: 2001-00-00

First Use in Commerce Date: 2001-00-00

International Class: 042

Class Status: Active

providing a web site of information about fashion and popular culture

Basis: 1(a)

First Use Date: 2001-00-00

First Use in Commerce Date: 2001-00-00

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2006-06-27 - Registered - Principal Register
- 2006-05-17 - Law Office Registration Review Completed
- 2006-03-17 - Assigned To LIE
- 2006-03-15 - Allowed for Registration - Principal Register (SOU accepted)
- 2006-03-03 - Assigned To Examiner
- 2006-03-02 - Statement of use processing complete
- 2006-02-10 - Amendment to Use filed
- 2006-02-10 - TEAS Statement of Use Received
- 2005-08-19 - Extension 5 granted
- 2005-08-08 - Extension 5 filed
- 2005-08-08 - PAPER RECEIVED
- 2005-04-01 - Extension 4 granted
- 2005-02-11 - Extension 4 filed
- 2005-02-14 - PAPER RECEIVED
- 2004-10-19 - Assigned To Examiner
- 2004-09-01 - Extension 3 granted
- 2004-08-11 - Extension 3 filed
- 2004-08-13 - PAPER RECEIVED
- 2004-08-09 - Case File In TICRS
- 2004-04-26 - Assigned To Examiner
- 2004-02-27 - Extension 2 granted

2004-02-11 - Extension 2 filed
2004-02-13 - PAPER RECEIVED
2003-09-05 - Extension 1 granted
2003-08-11 - Extension 1 filed
2003-08-13 - PAPER RECEIVED
2003-02-11 - Notice of allowance - mailed
2002-11-19 - Published for opposition
2002-10-30 - Notice of publication
2002-06-28 - Approved for Pub - Principal Register (Initial exam)
2002-06-05 - Communication received from applicant
2002-06-05 - PAPER RECEIVED
2002-05-01 - Letter of suspension mailed
2002-02-25 - Communication received from applicant
2001-08-30 - Non-final action mailed
2001-08-24 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record
Lawrence E. Apolzon

Correspondent
LAWRENCE E. APOLZON
FROSS ZELNICK LEHRMAN & ZISSU P C
866 UNITED NATIONS PLZ
NEW YORK NY 10017-1822
Phone Number: 212-813-5900
