ESTTA Tracking number: **ESTTA314048**

Filing date: **10/28/2009**

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

Proceeding	92051487
Party	Plaintiff Mr. Sean Combs
Correspondence Address	Robert A. Becker Fross Zelnick Lehrman & Zissu, P.C. 866 United Nations Plaza New York, NY 10017 UNITED STATES rbecker@frosszelnick.com
Submission	Other Motions/Papers
Filer's Name	Robert A. Becker
Filer's e-mail	rbecker@frosszelnick.com
Signature	/Robert Becker/
Date	10/28/2009
Attachments	PETITION FOR CANCELLATION - SEAN COMBS (F0535012).PDF (16 pages)(1658642 bytes)

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

In re Registration No. 3,061,732
Registered February 28, 2006
Petitioner's Reference: PFD USA TC 09/05992

Sean Combs,	:	
	:	
Petitioner,	:	
	:	Cancellation No. 92051487
- against -	:	
	:	
Harold G. Atkinson, Jr.,	:	
	:	
Registrant.	:	

PETITION FOR CANCELLATION

Petitioner, a U.S. citizen with an address c/o Bad Boy Entertainment, Inc., 1710 Broadway, 4th Floor, New York, NY 10019, believes he will be damaged by the continued registration of Reg. No. 3,061,732 for the mark DIRTY MONEY RECORDS, and hereby petitions to cancel the same.

As grounds therefor, Petitioner alleges as follows:

1. On June 3, 2009, Petitioner filed application Ser. No. 77/751,393 ("Petitioner's Application") for the mark DIDDY-DIRTY MONEY. A printout of this application from the TARR database is attached hereto as Exhibit A.

2. In an office action dated September 4, 2009, the examiner for Petitioner's Application cited the subject registration as a bar to registration. A copy of that office action is attached as Exhibit B.

3. Upon information and belief, Registrant has discontinued use of the mark shown in the subject registration in connection with the services covered by the subject registration.

4. Upon information and belief, Registrant intends not to resume use of the mark shown in the subject registration in connection with the services covered by the subject registration.

5. Therefore, Registrant has abandoned the mark shown in the subject registration.

6. By reason of the foregoing, Petitioner will be damaged by the continued registration of the mark shown in the subject registration.

WHEREFORE, Petitioner respectfully requests that its Petition for Cancellation be sustained and that Reg. No. 3,061,732 be cancelled.

Dated: New York, New York
September 22, 2009

Respectfully submitted,

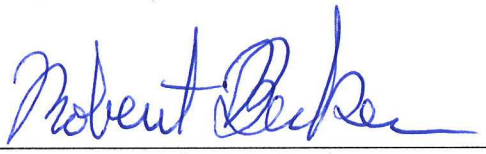
FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: _____
Robert A. Becker
Attorneys for Petitioner
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

CERTIFICATE OF SERVICE

I hereby certify that on this 28th day of October, 2009, I caused a copy of the PETITION FOR CANCELLATION to be served by prepaid, first-class mail upon Registrant at the addresses below:

Harold G. Atkinson, Jr.
P.O. Box 200663
Carterville, GA 30120



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 2009-09-21 14:05:04 ET

Serial Number: 77751393 Assignment Information Trademark Document Retrieval

Registration Number: (NOT AVAILABLE)

Mark

DIDDY-DIRTY MONEY

(words only): DIDDY-DIRTY MONEY

Standard Character claim: Yes

Current Status: A non-final action has been mailed. This is a letter from the examining attorney requesting additional information and/or making an initial refusal. However, no final determination as to the registrability of the mark has been made.

Date of Status: 2009-09-04

Filing Date: 2009-06-03

Transformed into a National Application: No

Registration Date: (DATE NOT AVAILABLE)

Register: Principal

Law Office Assigned: LAW OFFICE 109

Attorney Assigned:
RAUEN JAMES A

Current Location: L9X -TMEG Law Office 109 - Examining Attorney Assigned

Date In Location: 2009-09-03

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

1. Sean Combs

Address:

Sean Combs
c/o Bad Boy Entertainment, Inc. 1710 Broadway, 4th Floor
New York, NY 10019
United States
Legal Entity Type: Individual
Country of Citizenship: United States

GOODS AND/OR SERVICES

International Class: 009
Class Status: Active
series of musical sound recordings; downloadable musical sound recordings; audio-visual recordings featuring music and musical performances; downloadable audio-visual recordings featuring music and musical performances; downloadable ringtones and graphics via a global computer network and wireless devices
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 016
Class Status: Active
printed materials including posters, stickers, song books, sheet music; tour pamphlets featuring information on a music group and its performances; school and desk supplies including writing instruments, file folders and notebooks
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 025
Class Status: Active
Clothing including t-shirts, hooded sweatshirts, jackets, sweatshirts; headwear
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 038
Class Status: Active
streaming of audio material and video material on the internet; providing online chatrooms and electronic bulletin boards for transmission of messages among users concerning a band, its recordings and other activities
Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

International Class: 041
Class Status: Active
entertainment services including live and televised appearances and performances by a music group; internet services including providing a website and/or online profile pages featuring music, videos, and entertainment information on a musical group and its tours, recordings, appearances, photographs, biographies and other entertainment information

Basis: 1(b)
First Use Date: (DATE NOT AVAILABLE)
First Use in Commerce Date: (DATE NOT AVAILABLE)

ADDITIONAL INFORMATION

Prior Registration Number(s):
3109611

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.

2009-09-04 - Non-final action mailed

2009-09-03 - Non-Final Action Written

2009-09-02 - Assigned To Examiner

2009-06-09 - New Application Office Supplied Data Entered In Tram

2009-06-06 - New Application Entered In Tram

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

EXHIBIT B

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 77/751393

MARK: DIDDY-DIRTY MONEY

CORRESPONDENT ADDRESS:
LAWRENCE E. APOLZON
FROSS ZELNICK LEHRMAN & ZISSU, P.C.
866 UNITED NATIONS PLZ
NEW YORK, NY 10017-1822

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

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

APPLICANT: Sean Combs

CORRESPONDENT'S REFERENCE/DOCKET NO:
PFD 0903728
CORRESPONDENT E-MAIL ADDRESS:

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: SEP - 4 2009

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.

Refusal to Register

Registration of the applied-for mark is refused because of a likelihood of confusion with the marks in U.S. Registration Nos. 2814750 and 3061732. Trademark Act Section 2(d), 15 U.S.C. §1052(d); *see* TMEP §§1207.01 *et seq.* See the enclosed registrations.

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.*

Taking into account the relevant *du Pont* factors, a likelihood of confusion determination in this case involves a two-part analysis. The marks are compared for similarities in their appearance, sound, connotation and commercial impression. TMEP §§1207.01, 1207.01(b). The goods and/or services are compared to determine whether they are similar or commercially related or travel in the same trade channels. *See Herbko Int'l, Inc. v. Kappa Books, Inc.*, 308 F.3d 1156, 1164-65, 64 USPQ2d 1375, 1380 (Fed. Cir. 2002); *Han Beauty, Inc. v. Alberto-Culver Co.*, 236 F.3d 1333, 1336, 57 USPQ2d 1557, 1559 (Fed. Cir. 2001); TMEP §§1207.01, 1207.01(a)(vi).

The applicant's mark, DIDDY-DIRTY MONEY, is similar to each of the registered marks, DIRTY MONEY and DIRTY MONEY RECORDS, respectively, in that the dominant element in each mark is DIRTY MONEY. 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.2d 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).

The applicant's goods include clothing identical to the goods in the first cited registration. The applicant's goods and services include musical sound recordings, sheet music, streaming of audio material, and performances by a musical group, all of which are closely related to the services in the second cited registration, "audio recording and production services; music production 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, they need only be related in some manner, 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).

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

If applicant responds to the refusal, applicant must also respond to the requirement(s) set forth below.

Identification of Goods/Services

International Class 16

The identification of goods is indefinite and must be clarified because it includes the open-ended wording "including" twice. *See* TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "namely" each time it appears.

International Class 25

The identification of goods is indefinite and must be clarified because it includes the open-ended wording "including." *See* TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "namely."

International Class 41

The identification of services is indefinite and must be clarified because it includes the open-ended wording "including" twice. *See* TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "namely" each time it appears.

The identification of services is indefinite and must be clarified because it includes the open-ended wording "and/or." *See* TMEP §§1402.01, 1402.03(a). The identification must be specific and all-inclusive. Therefore, this wording should be deleted and replaced with "and."

General Information

The identification of goods/services for International Class 9 and International Class 38 are acceptable as filed.

Identifications of goods and services can be amended only to clarify or limit the goods and services; adding to or broadening the scope of the goods and 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 goods or services that are not within the scope of those set forth in the present identification.

For assistance with identifying and classifying goods and/or services in trademark applications, please see the online searchable *Manual of Acceptable Identifications of Goods and Services* at http://tess2.uspto.gov/netahtml/tidm.html. *See* TMEP §1402.04.

Application Unsigned

The application was not signed and verified, both of which are application requirements. 15 U.S.C. §§1051(b), 1126(d)-(e); 37 C.F.R. §§2.33, 2.34(a)(2)-(4). Therefore, applicant must verify, in a signed affidavit or declaration under 37 C.F.R. §§2.20, 2.33, the statements specified further

below. 15 U.S.C. §§1051(b)(3), 1126(d), (e); 37 C.F.R. §2.33(b)(2), (c); TMEP §§804.02, 806.01(b)-(d).

If applicant responds to this Office action online via the Trademark Electronic Application System (TEAS), applicant may satisfy this requirement by answering "yes" to the TEAS response form wizard question relating to submitting a "signed declaration," and properly signing the declaration appearing towards the end of the TEAS response form by either (1) entering in the signature block any combination of letters, numbers, spaces and/or punctuation marks that the filer has adopted as a signature, placed between two forward slash (/) symbols (e.g., /john doe/); (2) e-mailing the completed form from within TEAS to a second party for his/her electronic signature, which will then be automatically returned to the original preparer for submission with the response form; or (3) attaching a jpg or pdf image of a declaration under 37 C.F.R. §2.20 (see statements and declaration paragraphs below), together with a pen-and-ink signature. *See* 37 C.F.R. §§2.33(d), 2.193(c)(1)(iii); TMEP §804.05. For each method, applicant must either personally sign or manually enter his/her electronic signature and provide the date of "signing." TMEP §804.05; *see* TMEP §804.01(b). Applicant should also set forth the signatory's name and position beneath the signature. *See* TMEP §§712 *et seq.*, 804.05.

If applicant responds to this Office action on paper, via regular mail, applicant may satisfy this requirement by providing the following statements and declaration at the end of the response, personally signed and dated. See 37 C.F.R. §§2.20, 2.33; TMEP §§804.02, 804.05, 806.01(b)-(d).

STATEMENTS: He/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be entitled to use the mark in commerce; that applicant has had a bona fide intention to use the mark in commerce on or in connection with the goods and/or services listed in the application as of the application filing date; that the facts set forth in the application are true and correct; that to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive.

DECLARATION: The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

_____
(Signature)

_____
(Print or Type Name and Position)

_____
(Date)

/James A. Rauen/
Trademark Examining Attorney
Law Office 109
571-272-9211

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.

Print: Sep 3, 2009 **76497838**

TYPED DRAWING

Serial Number
76497838

Status
REGISTERED

Word Mark
DIRTY MONEY

Standard Character Mark
No

Registration Number
2814750

Date Registered
2004/02/17

Type of Mark
TRADEMARK

Register
PRINCIPAL

Mark Drawing Code
(1) TYPED DRAWING

Owner
ALL SURFACE ENTERTAINMENT INC. CORPORATION NEW YORK 151 First ave. suite #01 New York NEW YORK 10003

Goods/Services
Class Status -- ACTIVE. IC 025. US 022 039. G & S: men's and women's clothing namely, t-shirts, sweatshirt, hats, headwear, jackets, jeans, and pants. First Use: 1994/10/10. First Use In Commerce: 1994/10/10.

Filing Date
2003/03/17

Examining Attorney
BLOHM, LINDA E.

Print: Sep 3, 2009 **76607033**

DESIGN MARK

Serial Number
76607033

Status
REGISTERED

Word Mark
DIRTY MONEY RECORDS

Standard Character Mark
No

Registration Number
3061732

Date Registered
2006/02/28

Type of Mark
SERVICE MARK

Register
PRINCIPAL

Mark Drawing Code
(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM

Owner
Atkinson, Harold G., Jr. INDIVIDUAL UNITED STATES 2698 Tritt Springs Trace Marietta GEORGIA 30062

Goods/Services
Class Status -- ACTIVE. IC 041. US 100 101 107. G & S: Audio recording and production services; Music production services. First Use: 2003/04/00. First Use In Commerce: 2004/04/00.

Disclaimer Statement
NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "RECORDS" APART FROM THE MARK AS SHOWN.

Filing Date
2004/08/16

Examining Attorney
ERVIN, INGA

Attorney of Record
Richard L. Morris, Jr.

DIRTY MONEY RECORDS