

MARK: Area

APPLICANT: Area Non-Profit, Inc.

SERIAL NO: 87554747

FILING DATE: August 3, 2017

ATTENTION: Marc J. Leipzig  
Trademark Examining Attorney  
Law Office 118

**RESPONSE TO OFFICE ACTION OF NOVEMBER 6, 2017**

The Examining Attorney has requested a clarification in the recitation of services in the above-referenced application. Applicant adopts the following wording:

**Entertainment and educational services, namely, provision of dance instruction and provision of career development workshops to amateur dancers.**

The Examining Attorney has refused registration on the asserted basis of a likelihood of confusion with the mark in U.S. Registration No. 4452386 (the "Prior Registered Mark"). The cited registration is for "Area Event", a design mark consisting of the words "Area Event" in black and three red wavy lines on top of the lettering for, inter alia, "[c]onsultation in the field of special event planning for social entertainment purposes; disc jockey services; entertainment in the nature of live performances by disc jockeys; entertainment in the nature of visual and audio performances by disc jockeys and electronic dance music artists; entertainment services in the nature of live musical performances; entertainment services in the nature of presenting live musical performances; entertainment, namely, live music concerts; live performances by a musical group; organization of exhibitions for musical entertainment; providing a website featuring information in the field of music and entertainment; providing a website for entertainment purposes featuring photographs and video about disc jockeys, electronic dance music artists, and music events and festivals; special event planning for social entertainment purposes" (International Class 041). Applicant's registration is for the word mark "Area". As initially applied for, Applicant's registration was for "Entertainment and educational

services, namely, provision of dance and performing arts instruction, educational programs and resources for amateur and professional artistic development, community outreach and arranging performing arts presentations” (International Class 041). Applicant has now clarified that the services recitation should read: Entertainment and educational services, namely, provision of dance instruction and provision of career development workshops to amateur dancers.

The Examining Attorney states that the Prior Registered Mark is confusingly similar to the Applicant’s mark given the “similarity of the marks, similarity and nature of the goods and/or services, and similarity of the trade channels of the goods and/or services”. However, the differences in the Prior Registered Marks and Applicant’s mark as well as in the goods and/or services renders confusion unlikely.

First, the Prior Registered Marks and Applicant’s mark are very different in appearance, sound, connotation and commercial impression. Applicant’s mark (a word mark) contains none of the design elements of the Prior Registered Mark. The only similarity in the marks is the use of the word “Area”. Under *In re E.I. d Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (C.C.P.A. 1973), marks must be compared “in their entireties as to appearance, sound, connotation and commercial impression.” Although Applicant’s mark and the Prior Registered Mark contain the word “Area”, the Prior Registered Mark contains the additional wording “Event” which creates a significant distinction between Applicant’s mark and the Prior Registered Mark as it provides important additional information regarding the types of services provided by the owner of the Prior Registered Mark, and serves the function of distinguishing it from other “Area” marks (upon last search, conducted January 19, 2018, there were over 500 “live” applications or registrations containing the word “area”, see Exhibit 1 for a true and correct printout of results of a TESS search). The Examining Attorney asserted that the additional wording does not obviate the similarity between Applicant’s mark and the Prior Registered Mark. However, when comparing marks for a likelihood of confusion analysis, “[a]ll relevant facts

pertaining to appearance, sound, and connotation must be considered before similarity as to one or more of those factors may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000). Thus, this significant difference cannot merely be considered irrelevant.

It should further be noted that additional elements in marks may be sufficient to avoid a likelihood of confusion 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 diluted. See, e.g., *Citigroup Inc. v. Capital City Bank Group, Inc.* 637 F.3d 1344, 1356, 98 USPQ2d 1253, 1261 (Fed. Cir. 2011) (affirming TTAB holding that contemporaneous use of applicant’s CAPITAL CITY BANK marks for banking and financial services, and opposer’s CITIBANK marks for banking and financial services, is not likely to cause confusion based, in part, on findings that the phrase “City Bank” is frequently used in the banking industry). Similarly, and as evidenced by the large number of applications/registrations listed on Exhibit 1 that contain the word “Area”, this word is frequently used in connection with entertainment goods and services and is thus entitled to a narrow scope of protection. “Evidence of widespread third party use, in a particular field, of marks containing a certain shared term is competent to suggest that purchasers have been conditioned to look to the other elements of the marks as a means of distinguishing the source of goods or services in the field.” *In re Broadway Chicken, Inc.*, 38 USPQ2d 1559, 1565-66 (TTAB 1996). Thus, given the widespread use of the word “Area” in brands, consumers will look to the distinctive elements (the presence or absence of additional word “Event”, along with the presence or absence of design elements) in order to distinguish between service sources.

When both the literal and design elements of Applicant’s Mark and the Prior Registered Mark are considered in their entireties, as required, as opposed to based on a dissection the marks, the dissimilarity of the marks is clear (especially given the dilution of the wording common to the marks and

its weakness as a source-designator). To the average consumer retaining a general impression of the marks, the degree of similarity between the marks does not give rise to likely confusion.

Additionally, the differences in the services further mitigate against any likelihood of confusion, as do differences in the trade channels between Applicant's Mark and the Prior Registered Mark. It is very important to note that the Examining Attorney found a problematic similarity because "applicant and registrant each provide types of entertainment services featuring dance and/or other performing arts-related performances." This is not the case. The source of confusion may be the use of the phrase "electronic dance music" (often abbreviated as "EDM") in the services description for the Prior Registered Mark. Contrary to the Examining Attorney's assumption, this is not a reference to dance or performing arts. Rather, this is a reference to a specific genre of music performed by disc jockeys using electronic and digitally produced layering of beats. RICHARD JAMES BURGESS, *THE HISTORY OF MUSIC PRODUCTION* (2014), 114. In essence, and as confirmed by the Area Event website (see Exhibit 2), the Prior Registered Mark is for a company that engages in event production and marketing for electronic dance music and disc jockeys. Their consumers are disc jockeys, electronic dance music festivals, casinos, nightclubs and other venues for the presentation of electronic dance music. Applicant's Mark is for the provision of dance instruction and career development for dancers, with consumers being amateur dancers. The consuming public for electronic dance music and associated services is distinct from the consuming public comprised of amateur dancers, and as such the channels for marketing and trade to these two consumer populations are also distinct. Thus, the services of Applicant and the services in the Prior Registered Marks are not sufficiently related to find a likelihood of confusion.

In summary, the differences between the marks in appearance, sound, connotation and commercial impression, as well as differences in the services and channels of trade, render confusion between Applicant's mark and the Prior Registered Marks highly unlikely.

Accordingly, Applicant respectfully requests the Examining Attorney to pass this mark to publication.

Respectfully submitted,

By: /s/ Liz Wheeler  
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## **EXHIBIT 1**



United States Patent and Trademark Office

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### 513 Records(s) found (This page: 1 ~ 100)

 (area)[BI] and (live)[LD] 

Current Search: S3: (area)[BI] and (live)[LD] docs: 513 occ: 1214

	Serial Number	Reg. Number	Word Mark	Check Status	Live/Dead
1	<a href="#">87638510</a>		TLTF AREA 51	TSDR	LIVE
2	<a href="#">87637442</a>		BASECAMP WARTBURG THE RESUPPLY POINT FOR YOUR ADVENTURE STOP BY. RESUPPLY. GET BACK OUT THERE. A TENNESSEE DOWNTOWN COMMUNITY WWW.BASECAMPWARTBURG.COM FROZEN HEAD STATE PARK · OBED WILD & SCENIC RIVER · LONE MOUNTAIN STATE FOREST · CUMBERLAND TRAIL STATE PARK · CATOOSA WILDLIFE MANAGEMENT AREA · BIG SOUTH FORK · HISTORIC RUGBY	TSDR	LIVE
3	<a href="#">87505190</a>		PIMA: PEOPLE, PLACES, PARTIES IN MY AREA	TSDR	LIVE
4	<a href="#">87752282</a>		AREA 51 PHARMS	TSDR	LIVE
5	<a href="#">87752175</a>		AREA 51 PHARMS	TSDR	LIVE
6	<a href="#">87751322</a>		AREA 33	TSDR	LIVE
7	<a href="#">87626734</a>		AREAMASTER	TSDR	LIVE
8	<a href="#">87750419</a>		AREA 51 PHARMS	TSDR	LIVE
9	<a href="#">87750133</a>		BAY AREA BIN SUPPORT	TSDR	LIVE
10	<a href="#">87635780</a>		BACL BAY AREA COMPLIANCE LABS CORP.	TSDR	LIVE
11	<a href="#">87749029</a>		AREA 51 PHARMS	TSDR	LIVE
12	<a href="#">87735165</a>		AREA 51	TSDR	LIVE
13	<a href="#">87633533</a>		NATURAL AREA RUGS	TSDR	LIVE
14	<a href="#">87168231</a>		AREA LOCAL	TSDR	LIVE
15	<a href="#">87724355</a>		PROBLEM AREAS	TSDR	LIVE
16	<a href="#">87731420</a>		AREA HEALERS	TSDR	LIVE
17	<a href="#">87649910</a>		AREA 18	TSDR	LIVE
18	<a href="#">87324480</a>		BAY AREA ROOTED BAR	TSDR	LIVE
19	<a href="#">87436457</a>		AREACODEDOCTORS	TSDR	LIVE
20	<a href="#">87625970</a>		BAY AREA GREEK PICNIC	TSDR	LIVE
21	<a href="#">87726942</a>		AREA ZOOM	TSDR	LIVE
22	<a href="#">87577439</a>		GRAY AREA GA	TSDR	LIVE
23	<a href="#">87591862</a>		AREA 21	TSDR	LIVE
24	<a href="#">87587844</a>		AREA G SILICON VALLEY	TSDR	LIVE

25	87369333		AREA 52	TSDR	LIVE
26	87369323		AREA 52	TSDR	LIVE
27	87369310		AREA 52	TSDR	LIVE
28	87006043	5370828	SMART    SONOMA~MARIN AREA RAIL TRANSIT	TSDR	LIVE
29	87585888		BAY AREA CLASSICS	TSDR	LIVE
30	87442100		AREA	TSDR	LIVE
31	87606356		AREA TWO	TSDR	LIVE
32	87613064		BABY LOADING AREA PLEASE LEAVE ENOUGH ROOM	TSDR	LIVE
33	87715912		PORTAGE AREA REGIONAL TRANSPORTATION AUTHORITY	TSDR	LIVE
34	87715832		PORTAGE AREA RTA	TSDR	LIVE
35	87290455		BAY AREA KIDS DENTIST	TSDR	LIVE
36	87714026		PARTA	TSDR	LIVE
37	87610692		BASA BAY AREA SURGICAL ARTS	TSDR	LIVE
38	87610685		BAY AREA SURGICAL ARTS	TSDR	LIVE
39	87491337		BAY AREA MOBILE NOTARY, INC ETHICAL SERVICES YOU CAN TRUST	TSDR	LIVE
40	87425124	5358850	BL BAY AREA LEGAL AID	TSDR	LIVE
41	87232806		BAYAREA NEWSGROUP	TSDR	LIVE
42	87705553		SEAACA DEDICATED TO QUALITY ANIMAL CARE & CONTROL	TSDR	LIVE
43	87600119		AREA 51 FISHING	TSDR	LIVE
44	87479320		CHICAGO AREA SAIL RACING ASSOCIATION CASRA	TSDR	LIVE
45	87442013	5354657	VAAA VAAACARES	TSDR	LIVE
46	87238693	5353487	AREADOCKS	TSDR	LIVE
47	87370806		AREA	TSDR	LIVE
48	87591412		BAY AREA GREEK PICNIC	TSDR	LIVE
49	87265201	5241264	COOL AREA	TSDR	LIVE
50	87587138		AREA CODE YOUTH GAMES	TSDR	LIVE
51	87464878		AREA PRINTING	TSDR	LIVE
52	87540254		ONEBAYAREA	TSDR	LIVE
53	87521907		WE APPLY GRAY MATTER TO SOLVE YOUR GRAY AREAS.	TSDR	LIVE
54	87159046		AREA 120	TSDR	LIVE
55	87526780		THE BAY AREA'S HALLOWEEN TRADITION	TSDR	LIVE
56	87975544	5335578	CLASI	TSDR	LIVE
57	87237280	5333180	TECH BAY AREA ADVOCATES	TSDR	LIVE
58	87207199	5336790	CENTERPIECE VERSATILE AREA RUG	TSDR	LIVE
59	87562057		BAY AREA PREMIER PROPERTIES	TSDR	LIVE
60	87668021		OBA	TSDR	LIVE
61	87667101		BAY AREA MISSFITS	TSDR	LIVE
62	87235420		AREA 15	TSDR	LIVE
63	87662084		T-AREA	TSDR	LIVE
64	87554770		AREA	TSDR	LIVE
65	87554747		AREA	TSDR	LIVE
66	87369676		AREA 51	TSDR	LIVE
67	87654263		BAY AREA SOCIAL MEDIA	TSDR	LIVE
68	87650895		BAY AREA TRACK CLUB	TSDR	LIVE
69	87232791		BAYAREA NEWSGROUP	TSDR	LIVE
70	87128282		GAY AREA	TSDR	LIVE



71	87436723	5319061	BAY AREA CLASSICS CAR CLUB	TSDR	LIVE
72	87643730		AREA 51 SMOKE SHOP	TSDR	LIVE
73	87400628		[5 LAWS] OF PERSONAL CONSTRAINTS LAW 1//WE ALL HAVE PERSONAL CONSTRAINTS LAW 2//YOU CAN'T RISE ABOVE THE PERSONAL CONSTRAINTS YOU DON'T OR WON'T ADDRESS LAW 3// OUR PERSONAL CONSTRAINTS PLAY OUT IN EVERY AREA OF OUR LIVES LAW 4// PERSONAL CONSTRAINTS ARE ROLE SPECIFIC LAW 5// THOSE WITH THE FEWEST PERSONAL CONSTRAINTS ...WIN!	TSDR	LIVE
74	87309117		BACL C US	TSDR	LIVE
75	87158569	5313162	LIVEAREA PFS AGENCY	TSDR	LIVE
76	87158567	5313161	LIVEAREA PFS AGENCY	TSDR	LIVE
77	87117874	5312878	YAY AREA	TSDR	LIVE
78	87309061		BACL C	TSDR	LIVE
79	87527002		AREA REAL ESTATE ADVISORS	TSDR	LIVE
80	87293371		EVERY BED, EVERY DAY KNOX AREA RESCUE MINISTRIES RESTORING LIVES IN JESUS' NAME	TSDR	LIVE
81	87372190	5301318	BAM	TSDR	LIVE
82	87336529	5299976	STREET AND AREA LIGHTING CONFERENCE	TSDR	LIVE
83	87282944		AREA METHOD	TSDR	LIVE
84	87232822		BAYAREA NEWSGROUP	TSDR	LIVE
85	87514568		VP CATERING BAY AREA	TSDR	LIVE
86	87091944	5293984	AOL AREA 51	TSDR	LIVE
87	87496210		FO' FIFTEEN CAR CLUB BAY AREA CLASSICS MUSCLE	TSDR	LIVE
88	87495687		FO FIFTEEN BAY AREA CLASSIC CAR CLUB	TSDR	LIVE
89	87488076		BAY AREA VISUALS	TSDR	LIVE
90	87235864		AREA45 FITNESS	TSDR	LIVE
91	87430975		AREA561	TSDR	LIVE
92	87273942		INTERNATIONAL DRIVE RESORT AREA CHAMBER OF COMMERCE	TSDR	LIVE
93	87425588		BAE AREA	TSDR	LIVE
94	87336499	5281167	SALC	TSDR	LIVE
95	87250609	5279844	WORKAREA	TSDR	LIVE
96	87156812		CLASI	TSDR	LIVE
97	87473540		NATURAL AREA RUGS	TSDR	LIVE
98	87422465		DORA DOWNTOWN   OUTDOOR   REFRESHMENT  AREA TOLEDO	TSDR	LIVE
99	87262409		AREAS SAVOR YOUR WAY	TSDR	LIVE
100	87457656		BAY AREA MURAL FESTIVAL	TSDR	LIVE

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Events by

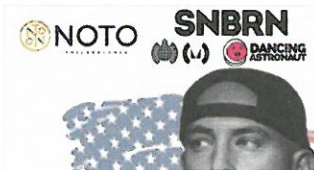


### Past Events

Take a look at invites from our past events



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Email

## About Us

Area Event is a full service event production and marketing company specializing in Electronic Dance Music. Collectively the Area Event team has over 30 years of industry experience. Area Event was born in the mid 1990s at the legendary Tunnel and Sound Factory nightclubs. Area Event has gone on to produce and present thousands of independent Electronic Dance Music shows and events across the United States. Highlights have included the launch of Tiësto's Kaleidoscope World Tour in 2009 and Swedish House Mafia's first ever New York City performance. Currently Area Event presents Brite Nites every Saturday night at the legendary Webster Hall in New York City, Electric Adventure a unique festival experience presented at Six Flags theme parks and Winter Galactic a unique themed New Year's Eve event in the heart of New York City. In addition Area Event's private label business has provided global support, management, marketing and production services for some of the world's biggest DJs, Festivals, Casinos and Nightclubs.