

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

In re Application of	)	
	)	
4420 West Sunset Drive LLC	)	Examining Attorney:
	)	
Filing Date: April 16, 2019	)	Alexandra E. El-Bayeh
	)	Law Office 124
Mark: GOLD-DIGGERS	)	
	)	
Serial No.: 88/388,158	)	
	)	
Office Action dated: June 26, 2019	)	

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**RESPONSE TO OFFICE ACTION**

Applicant, 4420 West Sunset Drive LLC, respectfully requests reconsideration of the refusal of the above-captioned application set forth in the Office Action dated June 26, 2019. Applicant’s mark was refused registration on the basis that, when used in connection with Applicant’s services, the mark is purportedly sufficiently similar to four previously registered marks as to be likely to confuse, to cause mistake or to deceive consumers.

Applicant respectfully contends that the significant differences between the marks themselves and/or the relevant services (as amended per Applicant’s request below) are sufficient to avoid any prospect of consumer confusion. For these reasons, Applicant believes that its mark is eligible for registration and requests that the mark be allowed to proceed to publication on the Principal Register.

**I. Amendment to Identification of Class 41 Services**

Applicant requests that the identification of services in Class 41 be amended as follows:

Recording studio services; entertainment services, namely, presentation of live music and DJ performances **by third parties, none of the foregoing to include presentation of performances in the nature of musical revues**

**II. The Marks Differ in Appearance, Sound, Connotation and Commercial Impression.**

A primary factor in determining whether a likelihood of confusion exists is a comparison of the marks themselves. *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973). This factor involves examination of “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression.” *Id.*; TMEP § 1207.01(b).

The Office Action cites four registered marks: Reg. Nos. 4773127, 3252186 and 3760355 for THE GOLDDIGGERS (the “Dean Martin Golddiggers Mark”) and Reg. No. 3551269 for GOLD DIGGERS DRINK DANCE DOWNTOWN & Design (the “Nightclub Mark”). Applicant respectfully suggests that there are sufficient distinctions between Applicant’s mark and the cited marks to avoid confusion.

Applicant uses its GOLD-DIGGERS mark in connection with a combination recording studio and hotel facility that also features a bar and, on occasion, live music performances. Applicant’s mark is a recasting of the familiar term “gold digger,” which invokes the trope of someone who engages in romantic relationships for money rather than love. Applicant uses the same terms, but in the context of music-centered services. Applicant’s consumers, who are largely musicians and producers, music industry figures, and also music fans, are more likely to understand GOLD-DIGGERS in the context of the long-standing connotation of “gold” in the

music industry, e.g., a major hit record.<sup>1</sup> Thus, the connotation and commercial impression of Applicant’s mark is not a direct reference to the commonly understood meaning of a “gold digger,” but a clever recontextualizing of the terms to invoke recording music in a studio in the hope of achieving an elusive hit.

As the specimens provided for the relevant applications show, the Dean Martin Golddiggers Mark refers to a female singing and dancing troupe that appeared on the Dean Martin Variety Show in the 1960s and ‘70s. *See also* Ex. A hereto. In this context, the Dean Martin Golddiggers Mark plainly connotes a playful reference to the standard meaning of “gold diggers.” In addition, the mark includes the article “The,” which actually creates a meaningful distinction in that it makes it clear that the mark refers to a specific group of people, and not to a place. This further distinguishes it from Applicant’s mark.

The Nightclub Mark is even more distinct. It contains the additional terms DRINK, DANCE and DOWNTOWN, as well as a prominent design element as depicted below.



The registration is owned by GNLV, LLC, a Las Vegas entity that operates under the Golden Nugget casino brand. The undated specimen shows the mark positioned on a wall at the velvet-roped entrance to a nightclub, presumably at a casino. In this context, the “GOLD

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<sup>1</sup> The Recording Industry Association of America began awarding gold records in 1958 to artists who achieved \$1 million in retail sales of a particular record. In 1976, a gold record was redefined as a record that achieved sales of 500,000 units for albums or one million units for singles. See [https://en.wikipedia.org/wiki/Music\\_recording\\_certification](https://en.wikipedia.org/wiki/Music_recording_certification).

DIGGERS” portion of the mark clearly refers to the usual understanding of romantic relationships based on money. The “male” and “female” signs replacing the “O” and “I” emphasize this connotation. The commercial impression of the Nightclub Mark is that of a place where singles go to meet and perhaps “strike it rich” in romance as they would hope to at the adjoining casino.

In addition to the difference in connotation and commercial impression, the Nightclub Mark is distinguished in terms of appearance by the design elements (the male/female symbols and the three balloons) and in terms of sound by the three additional terms. The Nightclub Mark is therefore different from Applicant’s mark across all of the relevant variables in analyzing likelihood of confusion.

For these reasons, Applicant respectfully contends that its mark is sufficiently distinct from both the Dean Martin Golddiggers Mark and the Nightclub Mark, and that this factor weighs against a likelihood of confusion and in favor of Applicant’s mark proceeding to registration.

### **III. Applicant’s Services Are Distinguishable from The Goods and Services Covered by the Dean Martin Golddiggers Registrations.**

In light of the differences between the marks themselves, Applicant submits that its services, as amended above, are sufficiently distinguishable from those covered by the registrations for the Dean Martin Golddiggers mark to make confusion unlikely.

The Office Action cites the “broad wording” of the Class 41 services in Applicant’s original application, which “presumably encompasses ... registrant’s more narrow” services involving presentation of live and television show performances in the nature of musical revues. Applicant requests to amend its Class 41 services to specify and clarify that live musical performances will be delivered by third parties and will not involve musical revues. With respect

to Reg. No. 4773127 for the Dean Martin Golddiggers Mark, the Office Action notes that “the same entity commonly provides compact discs featuring music, and provided live musical performances, and markets the goods and services under the same mark.” Applicant’s amended identification clarifies that its services involve presentation of musical performances by third parties, which is different from the common circumstance cited in the Office Action in which artists both perform live and offer compact discs. Accordingly, with respect to the registrations covering the Dean Martin Golddiggers Mark, Applicant respectfully contends that its services are not so closely related to the covered goods and services as to favor likelihood of confusion, given the different connotations of the respective marks.

**IV. Conclusion**

In light of the differences between Applicant’s mark and the cited marks in terms of appearance, sound, connotation and commercial impression, as well as the differences in the relevant goods and services with regard to the Dean Martin Golddiggers Mark, Applicant respectfully contends that confusion is not likely between its mark and the cited marks. Applicant therefore believes that its mark is eligible for registration and requests that its application be allowed to proceed to publication on the Principal Register.

Respectfully submitted,

/Andrew S. Fraker/  
One of the Attorneys for Applicant

Dated: December 20, 2019

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