

THIS DISPOSITION IS NOT CITABLE AS  
PRECEDENT OF THE TTAB

DEC 9, 97

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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Elvis Presley Enterprises, Inc.

v.

Paul M. Driscoll

*d.b.a.*

Paul Driscoll Magical

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Opposition No. 97,601  
to application Serial No. 74/524,586  
filed on May 13, 1994

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W. Mack Webner of Sughrue, Mion, Zinn, MacPeak & Seas for  
opposer

John S. Egbert of Harrison & Egbert for applicant

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Before Seeherman, Hanak and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Elvis Presley Enterprises, Inc. filed its opposition to  
the application of Paul M. Driscoll, *d.b.a.* Paul Driscoll  
Magical, to register the mark VELVIS for "entertainment in  
the nature of magic and comedy shows."<sup>1</sup>

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<sup>1</sup> Application Serial No. 74/524,586, filed May 13, 1994, in  
International Class 41, based upon an allegation of a bona fide  
intention to use the mark in commerce in connection with the identified  
services.

As grounds for opposition, opposer asserts that applicant's mark, when applied to applicant's services, so resembles opposer's previously used and registered word and design marks, ELVIS and ELVIS PRESLEY, as indicated below, as to be likely to cause confusion under Section 2(d) of the Trademark Act.

Opposer asserts, further, that it is a corporation created by the Estate and Trust of Elvis A. Presley, who is deceased; that it is the owner of the publicity rights in the name, likeness and image of Elvis Presley and the owner of the marks ELVIS and ELVIS PRESLEY; that Elvis Presley was a singer, movie actor, night club entertainer and concert performer who was and remains internationally famous as an entertainer, with one of the most recognized names in the United States; and that the first name ELVIS has come to mean only Elvis Presley when used on or in connection with entertainment services.

Opposer's pleaded registrations are for the marks, ELVIS,<sup>2</sup> ELVIS PRESLEY,<sup>3</sup> and the design marks shown below:

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<sup>2</sup> Issued originally to the Estate of Elvis Presley are **Registration No. 1,265,579**, issued January 31, 1984, for "**prerecorded audio magnetic tapes and phonograph albums**" in International Class 9; and **Registration No. 1,267,105**, issued February 14, 1984, for "**prints and publications - namely, posters and record album jackets**" in International Class 16; . The record in each of these registrations shows that opposer is the owner, by assignment from the original registrant, of the registration. Issued originally to opposer are **Registration No. 1,327,990**, issued April 2, 1985, for "**metal key rings with attached tags**" in International Class 6; and **Registration No. 1,329,269**, issued April 9, 1985, for "**plastic, stainless steel and/or sterling silver collector's spoons**" in International Class 8. Sections 8 and 15 affidavits have been filed and accepted and acknowledged, respectively, in all of these registrations.

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<sup>3</sup> **Registration No. 1,329,791**, issued April 9, 1985, for "**dolls**" in International Class 28 [Sections 8 and 15 affidavits accepted and acknowledged, respectively]; **Registration No. 1,340,617**, issued June 11, 1985, for "**musical instruments - namely, guitars**" in International Class 15 [Sections 8 and 15 affidavits accepted and acknowledged, respectively]; **Registration No. 1,342,551**, issued June 18, 1985, for "**printed matter - namely, photo albums, post cards, note pads; and printed publications - namely, paper doll books, coloring books, and coin books**" in International Class 16 [Sections 8 and 15 affidavits accepted and acknowledged, respectively]; **Registration No. 1,674,265**, issued February 4, 1992, for "**beverageware; namely, carafes, mugs, shot glasses, and tumblers**" in International Class 21; **Registration No. 1,677,532**, issued March 3, 1992, for "**jewelry**" in International Class 14; **Registration No. 1,677,561**, issued March 3, 1992, for "**prints and publications; namely, posters**" in International Class 16; **Registration No. 1,677,378**, issued March 3, 1992, for "**magnetic tapes and phonograph records**" in Class 9; and **Registration No. 1,692,862**, issued June 9, 1992, for "**clocks and watches**" in International Class 14. Opposer has also pleaded Registration No. 1,597,045, issued May 22, 1990, for "perfume" in International Class 3. However, as PTO records indicate that this registration has been canceled under Section 8, we do not consider this registration as part of the basis for opposer's claims herein.

<sup>4</sup> Registration No. 1,229,590, issued March 8, 1983, to the Estate of Elvis Presley, for "jewelry" in International Class 14. The record shows that opposer is the owner, by assignment from the original registrant, of this registration. Sections 8 and 15 affidavits accepted and acknowledged, respectively. The registration certificate includes the statement "The image or likeness shown on the drawing is that of Elvis Presley, a deceased individual."

<sup>5</sup> Registration No. 1,732,372, issued November 17, 1992, for "cologne" in International Class 3. The registration certificate includes the statement "The mark consists of a stylized representation of the name 'ELVIS'."



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Applicant, in its answer, denied the salient allegations of the likelihood of confusion claim and asserted that applicant's mark is not confusingly similar to opposer's marks; that applicant's services would not be considered to be under the sponsorship of or related to opposer; and that applicant's services are provided in different channels of trade from opposer's goods.

*The Record*

The record consists of the pleadings; the file of the involved application; opposer's first request for admissions,<sup>6</sup> made of record by opposer's notice of reliance; and the testimony deposition of Carol Butler, opposer's worldwide director of licensing, with accompanying exhibits. Applicant took no testimony and submitted no evidence. Only opposer filed a brief on the case.

*The Parties*

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<sup>6</sup> Opposer's requested admissions are deemed to be admitted by applicant since applicant neither responded to opposer's request nor objected thereto within thirty days after the date of service of opposer's request for admissions. See, FRCP 36(a) and *Trademark Trial and Appeal Board Manual of Procedure (TBMP)*, Section 411.01.

Through the testimony of Carol Butler, opposer's worldwide director of licensing, opposer has established that it was created by the estate and trust of Elvis Presley, the deceased entertainer, and had assigned to it the exclusive rights to the name, image and likeness of Elvis Presley for the purpose of licensing and conducting business using Mr. Presley's name, likeness and image. Ms. Butler testified that Elvis Presley was a singer; that more of his recordings have been sold than of any other singer<sup>7</sup>; and that, in addition to having been a singer, Elvis Presley was a performer, as he made several motion pictures and performed live on stage. Ms. Butler stated that opposer licenses the manufacture of a variety of products upon which its pleaded marks appear and which it sells at Graceland; that opposer has licensed its pleaded marks in connection with entertainment services; that when opposer licenses the use of its pleaded marks in connection with goods and services, it seeks to obtain a royalty for such use; and that opposer has not licensed or otherwise approved of applicant's use of the applied-for mark.

As indicated herein, applicant is deemed to have admitted, in pertinent part, that he offers entertainment services in which he dresses in clothing and adopts

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<sup>7</sup> Further, we believe that Elvis Presley's reputation as an entertainer is so widespread in the United States that we may take notice of that fact.

mannerisms imitative of Elvis Presley and makes reference therein to Elvis Presley; that he adopted the name VELVIS, which is not his name or the name of any family member, to identify his stage persona and that he intends for his stage persona and his name to suggest the persona and name of Elvis Presley; and that members of applicant's audiences have, in fact, commented that the name VELVIS and applicant's performance are reminiscent of Elvis Presley.

*Analysis*

Inasmuch as certified copies of opposer's registrations are of record, there is no issue with respect to opposer's priority in relation to the goods identified therein. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). While opposer has testified that it licenses use of the pleaded marks in connection with entertainment services, opposer has presented no evidence with respect to its priority of use in connection with such services and no conclusion can be drawn in connection therewith.

Our determination of likelihood of confusion under Section 2(d) must be based on an analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. *In re E.I. duPont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

Turning, first, to the marks, we find that applicant's mark, VELVIS, is visually similar to a opposer's mark, ELVIS, with only the initial letter, "V," distinguishing the two marks; that VELVIS is phonetically similar to ELVIS and, in fact, rhymes with ELVIS; that the connotation of VELVIS is of a minor variation of the name, ELVIS; and that the commercial impressions of the two marks are significantly similar. In view of the evidence that the renowned entertainer, Elvis Presley, is often referred to, simply, as Elvis, we find that the commercial impressions of applicant's mark, VELVIS, and opposer's mark, ELVIS PRESLEY, are, likewise, significantly similar.

With respect to the goods and services of the parties, the record establishes that opposer's business is, essentially, promoting the persona and name of Elvis Presley as a singer and entertainer through the marketing of his name and likeness in connection with a variety of goods and services. In this regard, opposer's pleaded marks are registered for a wide variety of goods. Further, opposer's mark ELVIS is registered for "prerecorded audio magnetic tapes and phonograph albums" and its mark ELVIS PRESLEY is registered for "magnetic tapes and phonograph records." The goods identified in these two registrations encompass live performances so recorded, which would include singing and comedy performances. Thus, we find that applicant's

entertainment services are closely related to the goods identified in these two registrations owned by opposer. We find, further, that in view of the breadth of goods in connection with which opposer's marks ELVIS and ELVIS PRESLEY are registered, along with the evidence that opposer licenses the use of its marks in connection with entertainment services, when applicant's mark is used in connection with the services herein, confusion as to the source or sponsorship of applicant's services is likely.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of opposer's marks ELVIS and ELVIS PRESLEY and applicant's mark VELVIS, their contemporaneous use on the goods and services involved in this case is likely to cause confusion as to the source or sponsorship of such goods and services.

*Decision:* The opposition is sustained.

E. J. Seeherman

E. W. Hanak

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board