



DISC JOCKEY'S IP CLAIM IS A 'SHORE' THING

CONNECTICUT'S DJ PAULIE SAYS MTV STAR MISUSING HIS TRADEMARKED NAME

By **CHRISTIAN NOLAN**

Anyone familiar with MTV's popular "Jersey Shore" probably knows all about cast member Pauly D. The so-called reality television series follows around nine fake-tanned, hair-gelled Italian-Americans along Jersey Shore.

Pauly D, or Paul Delvecchio Jr., a disc jockey in Rhode Island prior to joining the cast, has used his stardom from the television show to boost his DJ career.

Now he's known nationally as DJ Pauly D and has traveled to dance clubs around the country as a guest celebrity DJ and has even been hired by Palms Casino Resort in Las Vegas. MTV is working on a spin-off series that will follow Delvecchio around to his various DJ gigs.

Meanwhile, back in South Windsor, Conn., there's a middle-aged, balding DJ with no tan to speak of named DJ Paulie, whose real name is Paul Lis. He might have played music at your wedding or even your kid's school dance.

Lis says people confuse his name with that of the MTV star and it's killed a business he built from the ground up over the past 30 years. Why? Because the MTV show is controversial, to say the least, with many critics noting the frequent drug use and casual sex engaged in by cast members.

Believing he's the original DJ Paulie, Connecticut's Lis has filed a federal lawsuit in U.S. District Court in Connecticut against Delvecchio, MTV-owner Viacom, the Vegas casino and pretty much anyone else who has promoted Delvecchio as DJ Pauly D.

Lis is seeking \$4 million in damages in his trademark infringement lawsuit.

"From our perspective, this truly is a David versus Goliath situation," said Lis's

lawyer, José Rojas, of the Rojas Law Firm in Hartford. "A lot of time and effort and investment have been put into developing his name and it's just sort of been taken away from him."

To some, Lis's case may seem like that of a small-time DJ trying to score money from a celebrity. But according to lawyers specializing in intellectual property law, Lis actually has a strong claim.

What bolsters his case, they say, is that Lis had his name formally trademarked and registered by the U.S. Patent and Trademark Office before MTV ever created the "Jersey Shore" series. "I think it sounds like the DJ in Connecticut has a beef, a legitimate beef," said Curt Krechevsky, chair of Cantor Colburn's Trademark and Copyright Department. "It'd be one thing if Mr. Lis had been operating as DJ Paulie but did nothing to formalize his trademark rights.

"Even if you took the view he was a New Englander regional person," continued Krechevsky, "the fact he went and got this registration, that's what gives him the right to sock someone [nationally] from doing the same thing and he went and did that."

No. 1 Hits

According to his attorney, Lis has gone by DJ Paulie since 1973, using the moniker for his own DJ business as well as in on-air positions at various radio stations. Besides consistent work in the Hartford area, Lis has been a feature DJ on a radio station in Miami.

Attorney Rojas said his client became well known in the music business for re-mixing already released songs with a dance beat. This work led him to produce two No. 1 hits in the United Kingdom.

Hoping to make his name more global, Rojas said Lis invested \$2 million since 2001



CURT KRECHEVSKY

to promote his business, DJ Paulie Broadcasting, with the majority of that funding going towards his DJPaulie.com web site, which features streaming audio. He also planned to have an Internet radio station.

"The Internet radio station he was developing was clearly targeting a national audience and the Google-ability was enormous," said Rojas. "Once you get a certain amount of hits you start getting national interest from advertisers. He was right there."

Now, according to the lawsuit, his web site is difficult to find, as DJ Pauly D has saturated the Google hits.

"MTV networks or its agents placed content on the Internet with metatags and/or other Internet searchable indicia intentionally utilizing the spelling of DJ Paulie to capture and direct all traffic to their new star performer DJ Pauly and/or DJ Pauly D," read the complaint.

Rojas said his client tried to engage Viacom in a discussion over the alleged trademark infringement but was rebuffed.

Meanwhile, "Jersey Shore's" Delvecchio has attempted to trademark his own nickname, DJ Pauly D, but has so far been denied by the trademark office because it's too similar to the Connecticut DJ's name. Rojas claims the TV star keeps changing the description of what he does – calling himself an entertainer or reality star, instead of a DJ – in hopes of getting the trademark.

In the meantime, Delvecchio has continued to use the DJ Pauly D name. Delvecchio's lawyer, Henry V. Boezi III, of Rhode Island, said he has appealed the trademark office's refusal to grant the application. "I don't see how there's any likelihood of confusion between the two [names]," said Boezi. "It's as simple as that."

Boezi said he would likely be part of a legal team that will defend Lis's lawsuit against Delvecchio. "You know how people have nicknames," said Boezi. "For example, if someone calls me Henry B. and it's happened a few times in my life, when you see Henry B, you think Henry Boezi. You hear Madonna, you think Madonna Ciccone....You hear Pauly D, you think Paul Delvecchio.

"Trademarks should be viewed as a whole," Boezi continued. "DJ Pauly D is so intertwined with him and represents a sort of nickname."

'Confusingly Close'

Trademark experts in Connecticut, however, do think people could easily mix up the two Paul DJ names.

"They're still confusing," said Marina F. Cunningham, managing partner at McCormick, Paulding & Huber LLP, who specializes in IP law. "I think it would confuse the public as to the origin of the service. They




DUELING DJs

Paul Lis	REAL NAME	Paul DelVecchio
DJ Paulie	DJ NAME	DJ Pauly D
South Windsor, Conn.	HOME BASE	Rhode Island
1973	NAME USED SINCE	2009
Yes	TRADEMARKED?	No
At weddings, school dances	PERFORMANCES	On MTV's "Jersey Shore"
Re-mixing dance hits, Internet radio	SIDE BUSINESS	DJ at Las Vegas casino

sound almost the same and look almost the same. [The defense] could say it's a slightly different mark, but I would say they're confusingly close."

Krechevsky, the Cantor Colburn lawyer in Hartford, agrees.

"I think it's a tough argument to try to say these two marks are so different that people wouldn't be confused," said Krechevsky. "That letter 'D' at the end [of the MTV stars' nickname] doesn't have as much distinguishable difference as Delvecchio's lawyers would like to claim."

Both Cunningham and Krechevsky referred to the lawsuit as a case of "reverse confusion," which means the original DJ has a federal trademark registration, giving him the rights in the name "but the Jersey

Shore guy has gotten a lot more famous even without a trademark registration," said Cunningham.

Cunningham, though, said she questions the extent of the damages sought by the original DJ Paulie. "I can't imagine the damages are that huge," said Cunningham of the \$4 million claim.

"If the case goes forward to trial, he'll have to put in the proof that he put up that much money," said Krechevsky. "He's obviously claiming there's a lot of money at stake here."

Cunningham said that most IP lawsuits settle rather than go to trial and thinks ultimately this case will to. In the meantime, attorney Rojas said he expects MTV to "come with all their Goliath attributes" in their defense. ■