

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. : **78/666,598**
Applicant : **Chippendales USA, LLC**
Filed : **July 8, 2005**
Mark : **CUFFS & COLLAR Design**

Assistant Commissioner for Trademarks
2900 Crystal Drive
BOX RESPONSE NO FEE
Arlington, VA 22202-3513

REQUEST FOR RECONSIDERATION

Applicant hereby requests reconsideration of the Examining Attorney's final action dated September 5, 2007. This Request is based on the remarks set forth below.

I. Introduction:

The Examining Attorney has issued a final refusal to publish the referenced application Serial No. 78/666,598 (the "598 Application") based in part on the claim that it is identical to Applicant's Registration No. 2,694,613 (the "613 Registration"). The present recitation of goods and services in the '598 Application covers use of the CUFFS & COLLAR trade dress in connection with "adult entertainment services, namely exotic dancing for women." In its June 19, 2007 Response to a prior Office Action, the Applicant requested that the Examining Attorney inform the Applicant if limiting the recitation of goods and services to "adult entertainment services, namely exotic dancing for women in the nature of live performances" would render the

'598 Application no longer identical to the '613 Registration. June 19, 2007 Resp. at pp. 3-4.¹ In the Final Office Action of September 5, 2007, the Examining Attorney refused to respond to this request, stating that the "examining attorney does not view the aforementioned as amendments if the applicant wishes to amend or raise a new issue, it must do in an unconditional manner." Sept. 5, 2007 Office Action, pg. 3.² This Request follows.

II. Applicant Amends the Description of Goods and Services:

Applicant requests that the Examining Attorney amend the '598 Application so that the identification of goods and services reads "adult entertainment services, namely exotic dancing for women in the nature of live performances." Applicant submits that this amendment is proper under TMEP § 1402.06 as it does not seek to broaden the identification of goods and services but rather clarifies and limits the identification to "live performances." Applicant submits that this amendment renders the '598 Application non-identical to the '613 Registration under TMEP § 703. Specifically, Applicant notes that § 703 states unequivocally that "Applications/registrations with identifications that include some of the same goods or services, but also different goods or services, are not identical."

No Verification has been provided because the date of first use for these services is the same as the date of first use submitted in the initial application. In addition, no new specimen

¹ The Applicant also represented that, in the event that the Examining Attorney rejected both Applicant's renewed claim of inherent distinctiveness and the proposed amendment, that once the Mark was passed through to publication it would voluntarily abandon the '613 Registration.

² On November 7, 2007, Applicant filed a Petition to the Director asking for a determination that (1) the '598 Application and the '613 Registration are not identical and, (2) in the alternative, even if they are identical, the Examining Attorney should acknowledge that Applicant need not abandon the '613 Registration until such time as the '598 Application has been published for opposition. This Request is filed in the event that the Petition is denied.

has been provided as Applicant respectfully submits that the original specimen is acceptable under the proposed amended recitation of services.

III. Conclusion:

In view of the foregoing, Applicant respectfully requests that the Examining Attorney remove the objection that the '598 Application is identical to the '613 Registration. However, if for any reason the Examining Attorney does not grant this Request for Reconsideration, Applicant hereby appeals the final rejection. Attached as Exhibit 1 hereto is a copy of the Notice of Appeal which is being filed concurrently with the Trademark Trial and Appeal Board.

Respectfully submitted,

 / SWF /
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Dated: December 5, 2007

EXHIBIT 1



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

Application Serial No.	78666598
Applicant	Chippendales USA, Inc.

Notice of Appeal

Notice is hereby given that Chippendales USA, Inc. appeals to the Trademark Trial and Appeal Board the refusal to register the mark depicted in Application Serial No. 78666598.

Applicant has filed a request for reconsideration of the refusal to register, and requests suspension of the appeal pending consideration of the request by the Examining Attorney.

The refusal to register has been appealed as to the following class of goods/services:

- Class 041. First Use: 1979/01/01 First Use In Commerce: 1979/01/01
All goods and services in the class are appealed, namely: Adult entertainment services, namely exotic dancing for women

Respectfully submitted,
/swf/

12/05/2007

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