

Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
SERIAL NUMBER	77699210
LAW OFFICE ASSIGNED	LAW OFFICE 101
MARK SECTION (no change)	
OWNER SECTION (current)	
NAME	Maidenform, Inc.
STREET	Third Floor - Legal Department 485 Route 1 South, Building F
CITY	Iselin
STATE	New Jersey
ZIP/POSTAL CODE	08830
COUNTRY	United States
OWNER SECTION (proposed)	
NAME	Maidenform, Inc.
INTERNAL ADDRESS	Third Floor - Legal Department
STREET	485 Route 1 South, Building F
CITY	Iselin
STATE	New Jersey
ZIP/POSTAL CODE	08830
COUNTRY	United States
LEGAL ENTITY SECTION (current)	
TYPE	corporation
STATE/COUNTRY	

OF INCORPORATION	New Jersey
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LEGAL ENTITY SECTION (proposed)

TYPE	corporation
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STATE/COUNTRY OF INCORPORATION	New York
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ARGUMENT(S)

REMARKS

The final Office Action refused registration on the basis that the word MINIMIZER in the mark is merely descriptive and must be disclaimed. Specifically, in response to Applicant's position that the mark is a registrable slogan that should not be broken up for purposes of requiring a disclaimer, the Office Action contends that "if an unregistrable slogan is a component of a registrable mark, then the examining attorney should require that the slogan be disclaimed." TMEP § 1213.05(b). Applicant respectfully disagrees.

The language above from Section 1213.05(b) of the Trademark Manual of Examining Procedure ("TMEP") is inapplicable here because the word MINIMIZER is not an unregistrable slogan that forms a component of a registrable mark. Rather, the entire mark at issue is the slogan. All the words in ONE MARVELOUS MINIMIZER form an easily-remembered and catchy phrase that will be used in advertising Applicant's goods. Because the entire mark is a registrable slogan, it should be considered a unitary mark and not broken up for purposes of requiring a disclaimer. TMEP § 1213.05(b).

In the alternative, a disclaimer of MINIMIZER is not appropriate under Section 1212.04 of the TMEP because this portion of the mark has become distinctive of Applicant's goods as evidenced by Applicant's ownership of U.S. Registration No. 1071869 on the Principal Register for the same mark for the same or related goods. See TARR printout of Registration No. 1071869 for MINIMIZER for "brassieres" on the Principal Register, issued in 1997 and

last renewed in 2007, attached as Exhibit A. Therefore, in the alternative, Applicant requests that the mark be approved for publication with a Section 2(f) claim in part as to the MINIMIZER portion of the mark.

With the above, Applicant respectfully requests that the mark be approved for publication without disclaimer because it is a unitary registrable slogan. In the alternative, Application requests that the mark be approved for publication with a Section 2(f) claim of acquired distinctiveness as to MINIMIZER. Applicant has filed a Notice of Appeal and requests that the appeal be suspended awaiting a decision by the Examiner.

EVIDENCE SECTION

EVIDENCE FILE NAME(S)	
ORIGINAL PDF FILE	<u>evi 631381729-114618119 . ONE MARVELOUS MINIMIZER ROA Exhibit A F0614084 .PDJ</u>
CONVERTED PDF FILE(S) (4 pages)	<u>\\TICRS\EXPORT10\IMAGEOUT10\776\992\77699210\xml1\RFR0002.JPG</u>
	<u>\\TICRS\EXPORT10\IMAGEOUT10\776\992\77699210\xml1\RFR0003.JPG</u>
	<u>\\TICRS\EXPORT10\IMAGEOUT10\776\992\77699210\xml1\RFR0004.JPG</u>
	<u>\\TICRS\EXPORT10\IMAGEOUT10\776\992\77699210\xml1\RFR0005.JPG</u>
DESCRIPTION OF EVIDENCE FILE	TARR printout of Registration No. 1,071,869 for MINIMIZER

SIGNATURE SECTION

RESPONSE SIGNATURE	/kl/
SIGNATORY'S NAME	Karen Lim
SIGNATORY'S POSITION	Attorney of record, New York State bar member
DATE SIGNED	04/21/2010
AUTHORIZED SIGNATORY	YES
CONCURRENT APPEAL NOTICE FILED	NO

FILING INFORMATION SECTION

SUBMIT DATE	Wed Apr 21 12:22:41 EDT 2010
TEAS STAMP	USPTO/RFR-63.138.172.9-20 100421122241212343-776992 10-46087def6d2fc35f494ff3 abb6daed7-N/A-N/A-2010042 1114618119229

PTO Form 1500 (Rev. 3/2007)
OMB No. 0601-0050 (EPA 4/30/2008)

**Request for Reconsideration after Final Action
To the Commissioner for Trademarks:**

Application serial no. **77699210** has been amended as follows:

ARGUMENT(S)

In response to the substantive refusal(s), please note the following:

REMARKS

The final Office Action refused registration on the basis that the word MINIMIZER in the mark is merely descriptive and must be disclaimed. Specifically, in response to Applicant's position that the mark is a registrable slogan that should not be broken up for purposes of requiring a disclaimer, the Office Action contends that "if an unregistrable slogan is a component of a registrable mark, then the examining attorney should require that the slogan be disclaimed." TMEP § 1213.05(b). Applicant respectfully disagrees.

The language above from Section 1213.05(b) of the Trademark Manual of Examining Procedure ("TMEP") is inapplicable here because the word MINIMIZER is not an unregistrable slogan that forms a component of a registrable mark. Rather, the entire mark at issue is the slogan. All the words in ONE MARVELOUS MINIMIZER form an easily-remembered and catchy phrase that will be used in advertising Applicant's goods. Because

the entire mark is a registrable slogan, it should be considered a unitary mark and not broken up for purposes of requiring a disclaimer. TMEP § 1213.05(b).

In the alternative, a disclaimer of MINIMIZER is not appropriate under Section 1212.04 of the TMEP because this portion of the mark has become distinctive of Applicant's goods as evidenced by Applicant's ownership of U.S. Registration No. 1071869 on the Principal Register for the same mark for the same or related goods. See TARR printout of Registration No. 1071869 for MINIMIZER for "brassieres" on the Principal Register, issued in 1997 and last renewed in 2007, attached as Exhibit A. Therefore, in the alternative, Applicant requests that the mark be approved for publication with a Section 2(f) claim in part as to the MINIMIZER portion of the mark.

With the above, Applicant respectfully requests that the mark be approved for publication without disclaimer because it is a unitary registrable slogan. In the alternative, Application requests that the mark be approved for publication with a Section 2(f) claim of acquired distinctiveness as to MINIMIZER. Applicant has filed a Notice of Appeal and requests that the appeal be suspended awaiting a decision by the Examiner.

EVIDENCE

Evidence in the nature of TARR printout of Registration No. 1,071,869 for MINIMIZER has been attached.

Original PDF file:

evi 631381729-114618119 . ONE MARVELOUS MINIMIZER ROA Exhibit A F0614084 .PDF

Converted PDF file(s) (4 pages)

Evidence-1

Evidence-2

Evidence-3

Evidence-4

APPLICANT AND/OR ENTITY INFORMATION

Applicant proposes to amend the following:

Current: Maidenform, Inc., a corporation of New Jersey, having an address of
Third Floor - Legal Department 485 Route 1 South, Building F
Iselin, New Jersey 08830
United States

Proposed: Maidenform, Inc., a corporation of New York, having an address of
Third Floor - Legal Department
485 Route 1 South, Building F
Iselin, New Jersey 08830
United States

SIGNATURE(S)

Request for Reconsideration Signature

Signature: /kl/ Date: 04/21/2010

Signatory's Name: Karen Lim

Signatory's Position: Attorney of record, New York State bar member

The signatory has confirmed that he/she is an attorney who is a member in good standing of the bar of the highest court of a U.S. state, which includes the District of Columbia, Puerto Rico, and other federal territories and possessions; and he/she is currently the applicant's attorney or an associate thereof; and to the best of his/her knowledge, if prior to his/her appointment another U.S. attorney or a Canadian attorney/agent not currently associated with his/her company/firm previously represented the applicant in this matter: (1) the applicant has filed or is concurrently filing a signed revocation of or substitute power of attorney with the USPTO; (2) the USPTO has granted the request of the prior representative to withdraw; (3) the applicant has filed a power of attorney appointing him/her in this matter; or (4) the applicant's appointed U.S. attorney or Canadian attorney/agent has filed a power of attorney appointing him/her as an associate attorney in this matter.

The applicant is not filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 77699210

Internet Transmission Date: Wed Apr 21 12:22:41 EDT 2010

TEAS Stamp: USPTO/RFR-63.138.172.9-20100421122241212

343-77699210-46087def6d2fc35f494ff3abb6d

aed7-N/A-N/A-20100421114618119229

EXHIBIT A

Thank you for your request. Here are the latest results from the TARR web server.

This page was generated by the TARR system on 2010-04-21 11:47:04 ET

Serial Number: 73047805 Assignment Information Trademark Document Retrieval

Registration Number: 1071869

Mark (words only): MINIMIZER

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2007-09-13

Filing Date: 1975-03-26

Transformed into a National Application: No

Registration Date: 1977-08-23

Register: Principal

Law Office Assigned: (NOT AVAILABLE)

If you are the applicant or applicant's attorney and have questions about this file, please contact the Trademark Assistance Center at TrademarkAssistanceCenter@uspto.gov

Current Location: 40S -Scanning On Demand

Date In Location: 2007-11-20

LAST APPLICANT(S)/OWNER(S) OF RECORD

1. MAIDENFORM, INC.

Address:

MAIDENFORM, INC.
200 MADISON AVENUE
NEW YORK, NY 10016
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 025

Class Status: Active

BRASSIERES

Basis: 1(a)

First Use Date: 1975-03-21

First Use in Commerce Date: 1975-03-21

ADDITIONAL INFORMATION

(NOT AVAILABLE)

MADRID PROTOCOL INFORMATION

(NOT AVAILABLE)

PROSECUTION HISTORY

NOTE: To view any document referenced below, click on the link to "Trademark Document Retrieval" shown near the top of this page.

- 2007-11-20 - Case File In TICRS
- 2007-10-31 - Automatic Update Of Assignment Of Ownership
- 2007-09-13 - Second renewal 10 year
- 2007-09-13 - Section 8 (10-year) accepted/ Section 9 granted
- 2007-09-06 - Assigned To Paralegal
- 2007-08-20 - Combined Section 8 (10-year)/Section 9 filed
- 2007-08-20 - TEAS Section 8 & 9 Received
- 2007-07-18 - Assignment Of Ownership Not Updated Automatically
- 2007-06-27 - Assignment Of Ownership Not Updated Automatically
- 2006-09-09 - Review Of Correspondence Complete
- 2004-06-04 - PAPER RECEIVED
- 2004-05-13 - PAPER RECEIVED
- 1997-09-25 - First renewal 10 year
- 1997-09-03 - Post Registration action mailed - Section 9
- 1997-08-12 - Section 9 filed/check record for Section 8
- 1983-09-06 - Section 8 (6-year) accepted

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Jennifer Prioleau

Correspondent

Jennifer Prioleau
Maidenform, Inc.
200 Madison Ave.
NEW YORK NY 10016