

## Request for Reconsideration after Final Action

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	79137115
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 116
<b>MARK SECTION (no change)</b>	
<b>ARGUMENT(S)</b>	
<p>Dear Ms. Lawrence,</p> <p>On behalf of the Applicant (Kre Akhenaton), we respectfully submit the following in response to the final Office Action dated December 19, 2014.</p> <p><b><u>LIKELIHOOD OF CONFUSION AS TO CLASS 25</u></b></p> <p>The Examining Attorney has maintained and continued the refusal with respect to the goods in Class 25, alleging a likelihood of confusion with U.S. Registration No. 2363860 for the mark THIERRY MUGLER (stylized), U.S. Registration No. 4423456 for the mark MUGLER (stylized), both in the name of Thierry Mugler S.A.S., and alleging a likelihood of confusion with U.S. Registration No. 4196435 for the mark MUGLER FOLLIES in the name of Manfred Thierry Mugler (individual).</p> <p>While the Applicant respectfully maintains that there is no likelihood of confusion between the Applicant's mark and the marks in the cited registrations, the Applicant has deleted Class 25 from its Application.</p> <p><b><u>LIKELIHOOD OF CONFUSION AS TO CLASS 41</u></b></p> <p><b>Cited Registration No. 4196435 for the mark MUGLER FOLLIES</b></p> <p>The Examining Attorney has maintained and continued the refusal with respect to Class 41, alleging a likelihood of confusion with Registration No. 4196435 for the mark MUGLER FOLLIES in the name of Manfred Thierry Mugler (individual).</p> <p>In its Office Action response dated November 29, 2014, the Applicant submitted a consent agreement made between the Applicant and the cited registrant, Manfred Thierry Mugler. The Examining Attorney did not accept the agreement in order to overcome the refusal because the agreement was not dated. The Applicant herewith respectfully re-submits a dated consent agreement made between the Applicant and the cited registrant, Manfred Thierry Mugler.</p>	

In accordance with Section 1207.01(d)(viii) of the TMEP, the Applicant respectfully requests that the Examining Attorney give substantial weight to the Consent Agreement and remove the citation to Registration No. 4196435.

**Cited Registration No. 2363860 for the mark THIERRY MUGLER and Registration No. 4423456 for the mark MUGLER**

The Examining Attorney has maintained and continued the refusal with respect to Class 41, alleging a likelihood of confusion with U.S. Registration No. 2363860 for the mark THIERRY MUGLER (stylized) and U.S. Registration No. 4423456 for the mark MUGLER (stylized), both in the name of Thierry Mugler S.A.S.

While the Applicant respectfully maintains that there is no likelihood of confusion between the Applicant's mark and the marks in the cited registrations, as set forth in its Office Action response dated April 24, 2014, the Applicant herewith submits a Coexistence Agreement between the Applicant and the cited registrant, Thierry Mugler S.A.S.

As evidenced in the agreement, the cited registrant consents to the Applicant's use and registration of the applied-for mark in relation to the services listed in Class 41 of the application, as amended in this Office Action response. Furthermore, the agreement shows the parties' belief that there is no likelihood of confusion between the marks when used in relation to the respective goods and services. The agreement stipulates that the parties will undertake to avoid confusion by limiting the use of their respective marks to particular goods and services in substantially different product categories and trade channels. Finally, the agreement provides that the parties will work cooperatively to take steps to eliminate or minimize confusion in the unlikely event that evidence of known or suspected confusion arises.

In accordance with Section 1207.01(d)(viii) of the TMEP, the Applicant respectfully requests that the Examining Attorney give substantial weight to the Coexistence Agreement, remove the citations to Registration Nos. 2363860 and 4423456, and approve the application for publication.

**EVIDENCE SECTION**

**EVIDENCE FILE NAME(S)**

<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3810612-20150619153221225527_.ed - Coexistence_agreement_MUGLERETTS - Thierry_Mugler_S.A.S.pdf</a>
<b>CONVERTED PDF FILE(S) (8 pages)</b>	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0002.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0003.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0004.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0005.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0006.JPG</a>
	<a href="#">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0007.JPG</a>

	<a href="\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0008.JPG">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0008.JPG</a>
	<a href="\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0009.JPG">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0009.JPG</a>
<b>ORIGINAL PDF FILE</b>	<a href="#">evi_3810612-20150619153221225527_.uted_-_Consent_agreement_MUGLERETTS_-_Manfred_Thierry_Mugler.pdf</a>
<b>CONVERTED PDF FILE(S)</b> (2 pages)	<a href="\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0010.JPG">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0010.JPG</a>
	<a href="\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0011.JPG">\\TICRS\EXPORT16\IMAGEOUT16\791\371\79137115\xml17\RFR0011.JPG</a>
<b>DESCRIPTION OF EVIDENCE FILE</b>	Coexistence Agreement between the Applicant and the owner of cited Registration Nos. 2363860 and 4423456 (Signed on behalf of the Applicant by Nadine Leblanc, Director of Kre Akhenaton; and signed on behalf of the cited Registrant by Philip Shearer, President of Thierry Mugler S.A.S.); and Consent Agreement between the Applicant and the owner of cited Registration No. 4196435(Signed on behalf of the Applicant by Nadine Leblanc, Director of Kre Akhenaton; and signed by Manfred Thierry Mugler, in his individual capacity as owner of the cited registration).
<b>GOODS AND/OR SERVICES SECTION (025)(class deleted)</b>	
<b>GOODS AND/OR SERVICES SECTION (035)(current)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>DESCRIPTION</b>	
Advertising services; organization of exhibitions for commercial and advertising purposes; online retail store services featuring props used for theatrical performances, talent agency services, namely, business management of performing artists; all the aforesaid services in connection with entertainment activities or activities relating to shows	
<b>GOODS AND/OR SERVICES SECTION (035)(proposed)</b>	
<b>INTERNATIONAL CLASS</b>	035
<b>TRACKED TEXT DESCRIPTION</b>	
<del>Advertising services; Advertising; organization of exhibitions for commercial and advertising purposes; online retail store services featuring props used for theatrical performances, talent agency services, namely, business management of performing artists; promoting the goods of others by preparing and placing advertisements in electronic communication media featuring props for shows; all the aforesaid services in connection with entertainment activities or activities relating to shows; artistic director services, namely business management of performing artists; retail store services featuring show costumes, namely masquerade costumes for cabaret, variety theatre and musical performances; accessories for cabaret, variety theatre, musical comedy performances, namely bandanas, Ascots, mantillas, pelisses, turbans, all the aforesaid goods in connection with entertainment activities or activities relating to shows none of the foregoing show costumes intended for use outside the theatre; props for theatrical performances; all the aforesaid services in connection with entertainment activities or activities relating to shows.</del>	

**FINAL DESCRIPTION**

Advertising; organization of exhibitions for commercial and advertising purposes; promoting the goods of others by preparing and placing advertisements in electronic communication media featuring props for shows; artistic director services, namely business management of performing artists; retail store services featuring show costumes, namely masquerade costumes for cabaret, variety theatre and musical performances; accessories for cabaret, variety theatre, musical comedy performances, namely bandanas, Ascots, mantillas, pelisses, turbans, all the aforesaid goods in connection with entertainment activities or activities relating to shows none of the foregoing show costumes intended for use outside the theatre; props for theatrical performances; all the aforesaid services in connection with entertainment activities or activities relating to shows.

**GOODS AND/OR SERVICES SECTION (041)(current)****INTERNATIONAL CLASS**

041

**DESCRIPTION**

Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances ; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment programs. production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body

movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances; educational services, namely, providing of dance internships and dance training courses. all the aforesaid services in connection with entertainment activities or activities relating to shows

**GOODS AND/OR SERVICES SECTION (041)(proposed)**

**INTERNATIONAL CLASS**

041

**DESCRIPTION**

Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances ; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment programs. production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances; educational services, namely, providing of dance internships and dance training courses.

all the aforesaid services in connection with entertainment activities or activities relating to shows

**SIGNATURE SECTION**

**RESPONSE  
SIGNATURE**

/MA/

**SIGNATORY'S NAME**

Matthew D. Asbell

**SIGNATORY'S  
POSITION**

Attorney of Record, New York bar member

**DATE SIGNED**

06/19/2015

**AUTHORIZED  
SIGNATORY**

YES

**CONCURRENT  
APPEAL NOTICE  
FILED**

YES

**FILING INFORMATION SECTION**

**SUBMIT DATE**

Fri Jun 19 15:46:11 EDT 2015

**TEAS STAMP**

USPTO/RFR-38.106.1.2-2015  
0619154611529614-79137115  
-53056eea0e9932addbcca2c7  
fbb1b96d197924460b9fc5340  
84e7f4619db561b7-N/A-N/A-  
20150619153221225527

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

Application serial no. **79137115** has been amended as follows:

**ARGUMENT(S)**

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

Dear Ms. Lawrence,

On behalf of the Applicant (Kre Akhenaton), we respectfully submit the following in response to the final Office Action dated December 19, 2014.

**LIKELIHOOD OF CONFUSION AS TO CLASS 25**

The Examining Attorney has maintained and continued the refusal with respect to the goods in Class 25, alleging a likelihood of confusion with U.S. Registration No. 2363860 for the mark THIERRY MUGLER (stylized), U.S. Registration No. 4423456 for the mark MUGLER (stylized), both in the name of Thierry Mugler S.A.S., and alleging a likelihood of confusion with U.S. Registration No. 4196435 for the mark MUGLER FOLLIES in the name of Manfred Thierry Mugler (individual).

While the Applicant respectfully maintains that there is no likelihood of confusion between the Applicant's mark and the marks in the cited registrations, the Applicant has deleted Class 25 from its Application.

#### **LIKELIHOOD OF CONFUSION AS TO CLASS 41**

##### **Cited Registration No. 4196435 for the mark MUGLER FOLLIES**

The Examining Attorney has maintained and continued the refusal with respect to Class 41, alleging a likelihood of confusion with Registration No. 4196435 for the mark MUGLER FOLLIES in the name of Manfred Thierry Mugler (individual).

In its Office Action response dated November 29, 2014, the Applicant submitted a consent agreement made between the Applicant and the cited registrant, Manfred Thierry Mugler. The Examining Attorney did not accept the agreement in order to overcome the refusal because the agreement was not dated. The Applicant herewith respectfully re-submits a dated consent agreement made between the Applicant and the cited registrant, Manfred Thierry Mugler.

In accordance with Section 1207.01(d)(viii) of the TMEP, the Applicant respectfully requests that the Examining Attorney give substantial weight to the Consent Agreement and remove the citation to Registration No. 4196435.

##### **Cited Registration No. 2363860 for the mark THIERRY MUGLER and Registration No. 4423456 for the mark MUGLER**

The Examining Attorney has maintained and continued the refusal with respect to Class 41, alleging a likelihood of confusion with U.S. Registration No. 2363860 for the mark THIERRY MUGLER (stylized) and U.S. Registration No. 4423456 for the mark MUGLER (stylized), both in the name of Thierry Mugler S.A.S.

While the Applicant respectfully maintains that there is no likelihood of confusion between the Applicant's mark and the marks in the cited registrations, as set forth in its Office Action response dated April 24, 2014, the Applicant herewith submits a Coexistence Agreement between the Applicant and the cited registrant, Thierry Mugler S.A.S.

As evidenced in the agreement, the cited registrant consents to the Applicant's use and registration of the applied-for mark in relation to the services listed in Class 41 of the application, as amended in this Office Action response. Furthermore, the agreement shows the parties' belief that there is no likelihood of confusion between the marks when used in relation to the respective goods and services. The agreement stipulates that the parties will undertake to avoid confusion by limiting the use of their respective marks to particular goods and services in substantially different product categories and trade channels. Finally, the agreement provides that the parties will work cooperatively to take steps to eliminate or minimize confusion in the unlikely event that evidence of known or suspected confusion arises.

In accordance with Section 1207.01(d)(viii) of the TMEP, the Applicant respectfully requests that the Examining Attorney give substantial weight to the Coexistence Agreement, remove the citations to Registration Nos. 2363860 and 4423456, and approve the application for publication.

---

## **EVIDENCE**

Evidence in the nature of Coexistence Agreement between the Applicant and the owner of cited Registration Nos. 2363860 and 4423456 (Signed on behalf of the Applicant by Nadine Leblanc, Director of Kre Akhenaton; and signed on behalf of the cited Registrant by Philip Shearer, President of Thierry Mugler S.A.S.); and Consent Agreement between the Applicant and the owner of cited Registration No. 4196435(Signed on behalf of the Applicant by Nadine Leblanc, Director of Kre Akhenaton; and signed by Manfred Thierry Mugler, in his individual capacity as owner of the cited registration). has been attached.

### **Original PDF file:**

[evi\\_3810612-20150619153221225527\\_.ed - Coexistence agreement MUGLERETTS - Thierry Mugler S.A.S.pdf](#)

**Converted PDF file(s)** ( 8 pages)

[Evidence-1](#)

[Evidence-2](#)

[Evidence-3](#)

[Evidence-4](#)

[Evidence-5](#)

[Evidence-6](#)

[Evidence-7](#)

[Evidence-8](#)

### **Original PDF file:**

[evi\\_3810612-20150619153221225527\\_.uted - Consent agreement MUGLERETTS - Manfred Thierry Mugler.pdf](#)

**Converted PDF file(s)** ( 2 pages)

[Evidence-1](#)

[Evidence-2](#)

## **CLASSIFICATION AND LISTING OF GOODS/SERVICES**

### **Applicant hereby deletes the following class of goods/services from the application.**

Class 025 for Theater costumes used for cabaret, variety theater and musical performances; accessories for cabaret, variety theater, musical comedy performances, namely, bandanas, berets, furs, fur coats, coats, gloves, stocking suspenders, garters, necklets in the nature of boas, hosiery, caps, belts, shawls, headgear in the nature of hats, footwear, head coverings in the nature of head scarves, headgear for wear in the nature of hats, ties, sashes for wear, scarves, top hats, Ascots, mantillas, pelisses, turbans, cap peaks, hat veils; all the aforesaid goods in connection with entertainment activities or activities relating to shows

### **Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 035 for Advertising services; organization of exhibitions for commercial and advertising purposes; online retail store services featuring props used for theatrical performances, talent agency services, namely, business management of performing artists; all the aforesaid services in connection with entertainment activities or activities relating to shows

Original Filing Basis:

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:**

**Tracked Text Description:** ~~Advertising services; Advertising~~; organization of exhibitions for commercial and advertising purposes; ~~online retail store services featuring props used for theatrical performances; talent agency services, namely, business management of performing artists; promoting the goods of others by preparing and placing advertisements in electronic communication media featuring props for shows; all the aforesaid services in connection with entertainment activities or activities relating to shows;~~ artistic director services, namely business management of performing artists; retail store services featuring show costumes, namely masquerade costumes for cabaret, variety theatre and musical performances; accessories for cabaret, variety theatre, musical comedy performances, namely bandanas, Ascots, mantillas, pelisses, turbans, all the aforesaid goods in connection with entertainment activities or activities relating to shows none of the foregoing show costumes intended for use outside the theatre; props for theatrical performances; all the aforesaid services in connection with entertainment activities or activities relating to shows.

Class 035 for Advertising; organization of exhibitions for commercial and advertising purposes; promoting the goods of others by preparing and placing advertisements in electronic communication media featuring props for shows; artistic director services, namely business management of performing artists; retail store services featuring show costumes, namely masquerade costumes for cabaret, variety theatre and musical performances; accessories for cabaret, variety theatre, musical comedy performances, namely bandanas, Ascots, mantillas, pelisses, turbans, all the aforesaid goods in connection with entertainment activities or activities relating to shows none of the foregoing show costumes intended for use outside the theatre; props for theatrical performances; all the aforesaid services in connection with entertainment activities or activities relating to shows.

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Applicant proposes to amend the following class of goods/services in the application:**

**Current:** Class 041 for Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances ; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment

programs. production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances; educational services, namely, providing of dance internships and dance training courses. all the aforesaid services in connection with entertainment activities or activities relating to shows

Original Filing Basis:

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

**Proposed:** Class 041 for Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances ; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment programs. production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information

regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances; educational services, namely, providing of dance internships and dance training courses. all the aforesaid services in connection with entertainment activities or activities relating to shows

**Filing Basis Section 66(a)** , Request for Extension of Protection to the United States. Section 66(a) of the Trademark Act, 15 U.S.C. §1141f.

## **SIGNATURE(S)**

### **Request for Reconsideration Signature**

Signature: /MA/ Date: 06/19/2015

Signatory's Name: Matthew D. Asbell

Signatory's Position: Attorney of Record, New York 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 filing a Notice of Appeal in conjunction with this Request for Reconsideration.

Serial Number: 79137115

Internet Transmission Date: Fri Jun 19 15:46:11 EDT 2015

TEAS Stamp: USPTO/RFR-38.106.1.2-2015061915461152961

4-79137115-53056eea0e9932addbcca2c7fbb1b

96d197924460b9fc534084e7f4619db561b7-N/A

-N/A-20150619153221225527

**COEXISTENCE AGREEMENT**

This Coexistence Agreement is made as of the 15 day of June, 2015 ("Effective Date"), between KRE AKHENATON SARL, a French limited liability company having its principal place of business at 266 Avenue DAUMESNIL - 75012 Paris (France) ("**Applicant**") and Thierry Mugler S.A.S., a French joint stock company having its principal place of business at 49, Avenue de l'Opéra - 75002 Paris (France) ("**Registrant**"). Registrant and Applicant may hereafter be referred to individually as a "Party" and collectively as "the Parties".

**Preamble:**

Whereas, Registrant is the owner of the U.S. Trademark Registration No. 2363860 for the trademark **THIERRY MUGLER (stylized)**, which covers certain goods in Class 25 (detailed in Exhibit A), and U.S. Trademark Registration No. 4423456 for the trademark **MUGLER (stylized)**, which covers certain goods in Classes 3, 9, 14, 18, and 25 (detailed in Exhibit B), ("**Registrant's Trademarks**");

Whereas, on July 5, 2013, Applicant filed an application to register the trademark **MUGLERETTS (Applicant's Trademark)** with the United States Patent and Trademark Office ("USPTO") in relation to certain goods and services in Classes 25, 35, and 41 (U.S. Application No. 79137115) (the "**Application**") (detailed in Exhibit C);

Whereas, Applicant has agreed to delete Class 25 from the Application;

Whereas, Registrant is a fashion and perfume company;

Whereas, Applicant is a company that primarily conducts its business in relation to audiovisual and show creation and production;

Whereas, the USPTO has refused registration of Applicant's Trademark in Classes 25 and 41 under Section 2(d) of the Trademark Act (15 USC §1052(d)), alleging that there is a likelihood of confusion between Applicant's Trademark and Registrant's Trademarks;

Whereas, the Parties agree that the marks can coexist in U.S. commerce without causing mistake or a likelihood of consumer confusion, subject to the Parties adherence to the terms and conditions of this Agreement, and the Parties are desirous of resolving this matter amicably, and wish to avoid possible misunderstanding, conflict, and controversy between themselves and to protect the public from possible confusion, mistake, or deception; and

**NOW THEREFORE, in consideration of the mutual agreements hereinafter set forth, and for other good and valuable consideration, the receipt and adequacy of which is hereby acknowledged, the Parties hereby agree as follows:**

1. Applicant and Registrant acknowledge and declare that Applicant's Class 41 services (as amended in paragraph 6, below), when provided in connection with Applicant's Trademark, are sufficiently different from the goods covered by the Registrant's Trademarks, as are the corresponding channels of trade for each Party's respective goods and/or services.

*M* *4*

2. Said conclusion is supported by the different nature of the Parties' respective products and services, as evidenced by Applicant's list of services in Class 41, which is limited to the field of "entertainment activities or activities relating to shows." In this respect, Applicant and Registrant confirm that Applicant's Trademark will be solely registered and used in relation to the field of entertainment or show performances, which is markedly different from the Registrant's core business of high-end, designer-labelled fashion apparel and perfumes.
3. The Parties acknowledge and declare that concurrent use of the Registrant's Trademarks in relation to its products in Classes 9 and 25, and Applicant's Trademark in relation to its services in Classes 35 and 41, is unlikely to create confusion or mistake among consumers as to the source, origin, or sponsorship of the Parties' respective products and services.
4. The Parties agree to use their respective Trademarks in a manner that avoids confusion and will cooperate in taking reasonable actions to avoid confusion. In particular, the Parties agree to cooperate with one another in good faith in the unlikely event of any instances of actual consumer confusion arising as the result of the Parties' use of their respective marks, and to take such steps as may be reasonably necessary to eliminate or minimize confusion.
5. Registrant expressly consents to the use and registration of Applicant's Trademark only for its Class 35 services and the services in class 41, as amended, namely:

**Class 35:** Advertising; organization of exhibitions for commercial and advertising purposes; promoting the goods of others by preparing and placing advertisements in electronic communication media featuring props for shows; artistic director services, namely business management of performing artists; retail store services featuring show costumes, namely masquerade costumes for cabaret, variety theatre and musical performances; accessories for cabaret, variety theatre, musical comedy performances, namely bandanas, Ascots, mantillas, pelisses, turbans, all the aforesaid goods in connection with entertainment activities or activities relating to shows none of the foregoing show costumes intended for use outside the theatre; props for theatrical performances; all the aforesaid services in connection with entertainment activities or activities relating to shows.

**Class 41:** "Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment programs; production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and

*conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances; educational services, namely, providing of dance internships and dance training courses; all the aforesaid services in connection with entertainment activities or activities relating to shows."*

6. This Agreement shall be binding upon and inure to the benefit of the Parties, and their respective licensees, successors, and assigns, and all others acting by, through, or with them.
7. This agreement shall remain in full force and effect so long as either of the Parties have not abandoned use of the respective Trademarks discussed in this Agreement, unless otherwise modified or terminated in a writing signed by both Parties.
8. This Agreement is governed by and shall be construed in accordance with the laws of the State of New York and the United States. This Agreement has effects only in the United States.
9. Each person signing this Agreement represents and warrants that s/he is duly authorized and has the legal capacity to execute and deliver this Agreement. Each Party represents and warrants to the other that the execution and delivery of the Agreement and the performance of such Party's obligations hereunder have been duly authorized and that the Agreement is a valid and legal agreement binding on such Party and enforceable in accordance with its terms.

**IN WITNESS WHEREOF**, the Parties hereby enter into this Agreement through its execution by their authorized representatives.

KRE AKHENATON (SARL)

*10 juin 2015*  
.....  
(location and date)

*M. Blam*  
.....  
(Signature)

.....

Thierry Mugler S.A.S.

*Paris, June 15th, 2015*  
.....  
(location and date)

.....  
(Signature)

*Thierry Mugler*  
.....

(Name of the signing person)

Nadine Ceballos

(position within the company)

Director of In-Store Activation

(Name of the signing person)

Philip Shearer

(position within the company)

CEO of CLARINS SA,  
itself President of Thierry Mugler

**EXHIBIT A**

U.S. Trademark Registration No. 2363860

**THIERRY MUGLER (stylized)**

US Serial Number:	<b>75561953</b>
Application Filing Date:	<b>Sep. 18, 1998</b>
US Registration Number:	<b>2363860</b>
Registration Date:	<b>Jul. 04, 2000</b>
Register:	Principal
Mark Type:	Trademark
Status:	The registration has been renewed.
Status Date:	<b>Jul. 28, 2010</b>
Publication Date:	<b>Apr. 11, 2000</b>

Foreign Registration Number:	<b>1569511</b>
Foreign Registration Date:	<b>Jun. 14, 1993</b>
Foreign Application/Registration Country:	<b>FRANCE</b>
Foreign Expiration Date:	<b>Apr. 13, 2002</b>

**Goods and services:**

<b><u>International Class(es):</u></b>	<b><u>025 - Primary Class</u></b>
U.S Class(es):	022, 039
<i>Clothing articles for [ men, ] women [ and children ], namely, [ tights, socks, underwear, braces/suspenders, singlets, ] t-shirts, sweatshirts, [ shirts, ] blouses, [ trousers, ] pants, [ knickers, shorts, ] skirts, dresses, jupe-culottes, [ pullovers, sweaters, cardigans, vests, ] waistcoats, gabardines, raincoats, anoraks, [ coats, ] cloaks, capes, overcoats, [ suits, jackets, ] waist-high jackets, [ dressing gowns, pajamas, scarves, ties, neckties, gloves, belts, ] jogging suits, swimming suits, bathing gowns, boots, shoes, sandals, slippers, hats, caps, berets, [ visors ]</i>	

Owner Name:	<b>THIERRY MUGLER S.A.S.</b>
Owner Address:	<b>49, AVENUE DE L'OPERA</b>
<b>PARIS 75002 FRANCE</b>	

Legal Entity Type:	JOINT STOCK COMPANY
State or Country Where Organized:	FRANCE

M 4

**EXHIBIT B**

U.S. Trademark Registration No. 4423456  
**MUGLER (stylized)**

US Serial Number: **79101099**  
Application Filing Date: **Jul. 04, 2011**  
US Registration Number: **4423456**  
Registration Date: **Oct. 29, 2013**  
Register: **Principal**  
Mark Type: **Trademark**  
Status: **Registered.**  
Status Date: **Oct. 29, 2013**  
Publication Date: **Aug. 13, 2013**

International Registration Number: **1086906**  
International Registration Date: **Jul. 04, 2011**  
Claimed Ownership of US Registrations: **1805718**

**Goods and services:**

**International Class(es):** **003 - Primary Class**

U.S Class(es): 001, 004, 006, 050, 051, 052

*Perfumes, scented waters, eaux de toilette, cologne, toiletry preparations, namely, body creams, cosmetic preparations for bath and shower, deodorants for personal use, scented skin soaps, perfumed talcum powder, scented cosmetic creams, scented cosmetic lotions, non-medical lotions and gels for skin care, perfumery, cosmetics, hair lotions*

**International Class(es):** **009 - Primary Class**

U.S Class(es): 021, 023, 026, 036, 038

*Apparatus and instruments for recording, reproducing and/or transmitting sounds and/or virtual information or recordings, namely, computers, cellular telephones; sound and visual recordings featuring music; interactive sound and visual recordings featuring music; audio and visual recording media, namely, compact discs featuring music and fashion shows; downloadable publications provided online via a computer database, the Internet or any other communications network, including via wireless means, cable or satellite, namely, downloadable electronic publications in the nature of newsletters and magazines in the field of music and fashion; compact disks featuring music, DVDs featuring music and fashion shows; downloadable digital music provided via MP3 web sites on the Internet; downloadable telephone ring tones via the Internet and wireless devices; optical glasses; optical goods, namely, sunglasses, eyeglasses; cases for eyeglass*

**International Class(es):** **014 - Primary Class**

U.S Class(es): 002, 027, 028, 050

*Jewelry; jewelry items, precious stones; timepieces and chronometric instruments; precious metals and their alloys; jewelry cases; boxes of precious metal; novelty key rings of precious metals; jewelry cases of precious metal, bracelet; jewelry chains; cases and presentation cases for timepieces*

**International Class(es):** **018 - Primary Class**

U.S Class(es): 001, 002, 003, 022, 041

*Leather, imitation leather, leather and imitation leather goods, namely, key cases, attaché cases, wallets, purses not of precious metal, travel bags, handbags, backpacks, shopping bags, beach bags, garment bags for travel, animal skins, pelts and hides, trunks and suitcases, umbrellas, parasols and walking sticks, whips and saddlery*

**International Class(es):**

**025 - Primary Class**

U.S Class(es):

022, 039

*Men's and women's clothing, namely, shirts, dresses, skirts, pants, jackets; footwear; headgear, namely, hats, caps*

Owner Name:

**Thierry Mugler S.A.S.**

Owner Address:

**49, avenue de l'Opéra**

**F-75002 PARIS**

**FRANCE**

Legal Entity Type:

Société par actions simplifiée unipersonnelle

State or Country Where Organized:

FRANCE

*M 4*

**EXHIBIT C**

**U.S. Trademark Application No. 79137115**

**MUGLERETTS**

Mark Drawing Code (4) STANDARD CHARACTER MARK  
Serial Number **79137115**  
Filing Date **July 5, 2013**

International Registration Number **1178056**

Owner (APPLICANT) **KREAKHENATON LIMITED LIABILITY COMPANY**  
**FRANCE 76 boulevard de Picpus F-75012 PARIS France**

Attorney of Record Jeffrey M. Liebenson  
Priority Date **January 7, 2013**

**Goods and Services:**

**IC 025. US 022 039. G & S:**

*Theater costumes used for cabaret, variety theater and musical performances; accessories for cabaret, variety theater, musical comedy performances, namely, bandanas, berets, furs, fur coats, coats, gloves, stocking suspenders, garters, necklets in the nature of boas, hosiery, caps, belts, shawls, headgear in the nature of hats, footwear, head coverings in the nature of head scarves, headgear for wear in the nature of hats, ties, sashes for wear, scarves, top hats, Ascots, mantillas, pelisses, turbans, cap peaks, hat veils; all the aforesaid goods in connection with entertainment activities or activities relating to shows*

**IC 035. US 100 101 102. G & S:**

*Advertising services; organization of exhibitions for commercial and advertising purposes; online retail store services featuring props used for theatrical performances, talent agency services, namely, business management of performing artists; all the aforesaid services in connection with entertainment activities or activities relating to shows*

**IC 041. US 100 101 107. G & S:**

*Modeling for artists; entertainer services; ticket agency services for entertainment events; night clubs, discotheque services; movie studios; rental of movie projectors and accessories; circuses; comedy club services; organization and conducting of concerts; rental of show scenery; entertainment information; videotaping; organization of exhibitions for cultural purposes; production of films; rental of lighting apparatus for theatrical sets or television studios; orchestra services; organization of dancing events in the nature of balls; organization of cultural shows; photographic reporting; party planning for entertainment purposes; theater productions; booking of seats for shows; television show production; recording studio services; education services, namely, conducting classes, seminars, workshops in the field of film, action, dancing and singing performance; training in the area of film acting, dancing and singing performance; entertainment services, namely, presentation of live show performances, live musical comedy performances, and continuing radio and television shows featuring dance, music, theatrical, comedy and musical performances; organizing community sporting and cultural events; publication of texts, illustrations, books, journals, newspapers, periodicals and publications in the nature of photographic books, art books, art magazines, live shows information magazines; lending of books; rental of films and sound recordings; editing of radio and television programs; publication of*

*M 4*

*books and texts not for advertising; organization of competitions in the field of education and entertainment, organization of games; organization of professional or amateur events for cultural or educational purposes; editing and production of television and radio news programs and of radio and television entertainment programs. production and rental of films and video cassettes; editing and recording of sound and images; recording studios for sound and image recording; videotaping, namely, sound and image recording services; educational services, namely, training workshops, colloquiums, conferences, forums, congresses, seminars and symposiums, in the field of film acting, dancing and singing performance; organization and conducting of exhibitions for cultural or educational purposes; copy editing and publishing of books, periodicals and texts not for advertising purposes; production and rental of sound and video recording; information services, namely, providing entertainment information services; cultural information regarding live shows and information about education; publication of electronic books and journals on-line; photography services; production of musical sound recording and production of audio and visual recording; radio and television entertainment, namely, a continuing program featuring live comedy shows and theatrical performances; studio services, namely, production of musical sound recording; production of radio or television programs; organization of dancing events featuring dance-related activities and activities relating to expression through body movement; services provided by authors, namely, writing of texts other than publicity texts, and choreography services for others; educational services, namely, conducting courses in the area of dance expression through body movement; educational services, namely, conducting training and courses featuring choreography and dance; dance schools; entertainment services, namely production, direction and presentation of theater plays featuring artistic acts, comic acts, choreography and/or dance, music and/or songs; dance club services; entertainment, namely, live dance performances and live multidisciplinary dance performances. educational services, namely, providing of dance internships and dance training courses. all the aforesaid services in connection with entertainment activities or activities relating to shows*

*ML 4*

## CONSENT AGREEMENT

This consent Agreement is made by and between Kre Akhenaton, a corporation organized under the laws of France with a registered office at 76, boulevard de Picpus, 75012 Paris, and Manfred Thierry MUGLER ("Mr. Mugler"), an individual having its address at Aklea – Turquoise société d'avocats, 71-73, avenue des Champs-Élysées 75008 Paris, France.

The parties agree as follows:

1. Kre Akhenaton has filed an application to obtain a U.S. Trademark Registration (Serial No. 79137115) for MUGLERETTS in International Classes 25, 35 and 41 ("Kre Akhenaton's Application"). Mr. Mugler's prior U.S. Trademark registration (No 4196435) MUGLER FOLLIES in International Class 41 (« Mr. Mugler's Registration») was cited against Kre Akhenaton's Application.

Authorized representative of Kre Akhenaton is Mrs Nadine LEBLANC.

2. Mr. Mugler is a world-renowned stylist, artistic director, photographer, creator and director. It is understood between the parties that Mr Mugler is the owner of the exclusive right to use the trademark MUGLER FOLLIES in relation to the services identified in Mr Mugler's Registration.

Mr Mugler acknowledges that Kre Akhenaton is the owner of the exclusive right to use the mark MUGLERETTS in relation to the services identified in Kre Akhenaton's Application. Kre Akhenaton agrees never to use the term MUGLER FOLLIES as a trademark, except with written authorization from Mr. Mugler.

The parties agree that there is no likelihood of confusion by the concurrent use of Kre Akhenaton's and Mr Mugler's respective marks.

3. Therefore, Mr. Mugler consents to Kre Akhenaton's use and registration of the mark MUGLERETTS in connection with the services listed in Kre Akhenaton's Application.

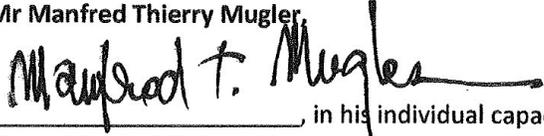
4. The parties agree to make their best efforts in order to prevent any possible future confusion and cooperate and take steps to avoid such confusion that may arise.

HTM

M

This Agreement in relation to the U.S. Trademark Registration (Serial No. 79137115) for MUGLERETTS is binding on the parties, their respective subsidiaries, affiliates, successors and assignees.

Mr Manfred Thierry Mugler,

  
\_\_\_\_\_, in his individual capacity

Name: Manfred Thierry Mugler

Kre Akhenaton,

  
\_\_\_\_\_, au authorized representative

Name: Nadine LEBLANC

Title: Director

Date 22 November 2014