

ESTTA Tracking number: **ESTTA135814**

Filing date: **04/17/2007**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Bugatchi Uomo Apparel, Inc.
Granted to Date of previous extension	05/05/2007
Address	1377 Clint Moore Road, Suite 200 Boca Raton, FL 33487 UNITED STATES

Attorney information	Adam D. Resnick Arent Fox LLP 1050 Connecticut Avenue, NW Washington, DC 20036 UNITED STATES resnick.adam@arentfox.com, walker.christina@arentfox.com, tmdocket@arentfox.com
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Applicant Information

Application No	78849382	Publication date	03/06/2007
Opposition Filing Date	04/17/2007	Opposition Period Ends	05/05/2007
Applicants	Revah, Marco 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES Revah, Solomon 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 1989/03/01 First Use In Commerce: 1989/03/01 All goods and services in the class are opposed, namely: Belts; Blazers; Boxer shorts; Briefs; Cardigans; Dress shirts; Footwear; Gloves; Golf shirts; Headwear; Jackets; Jeans; Jogging suits; Knit shirts; Men's socks; Neckties; Pajamas; Pants; Polo shirts; Sandals; Shirts; Shoes; Socks; Sports shirts; Suits; Sweat pants; Sweat shirts; Sweaters; Swim wear; T-shirts; Tops; Trousers; Turtlenecks; Undershirts; Underwear; Vests
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Applicant Information

Application No	78849344	Publication date	03/13/2007
Opposition Filing Date	04/17/2007	Opposition Period Ends	

Applicants	Revah, Marco 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES Revah, Solomon 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES
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Goods/Services Affected by Opposition

Class 025. First Use: 1989/03/01 First Use In Commerce: 1989/03/01 All goods and services in the class are opposed, namely: Belts; Blazers; Boxer shorts; Briefs; Cardigans; Dress shirts; Footwear; Gloves; Golf shirts; Headwear; Jackets; Jeans; Jogging suits; Knit shirts; Men's socks; Neckties; Pajamas; Pants; Polo shirts; Sandals; Shirts; Shoes; Socks; Sports shirts; Suits; Sweat pants; Sweat shirts; Sweaters; Swim wear; T-shirts; Tops; Trousers; Turtlenecks; Undershirts; Underwear; Vests
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Applicant Information

Application No	78849360	Publication date	03/13/2007
Opposition Filing Date	04/17/2007	Opposition Period Ends	
Applicants	Revah, Marco 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES Revah, Solomon 6663 Newport Lake Circle Boca Raton, FL 33496 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 1989/03/01 First Use In Commerce: 1989/03/01 All goods and services in the class are opposed, namely: Belts; Blazers; Boxer shorts; Briefs; Cardigans; Dress shirts; Footwear; Gloves; Golf shirts; Headwear; Jackets; Jeans; Jogging suits; Knit shirts; Men's socks; Neckties; Pajamas; Pants; Polo shirts; Sandals; Shirts; Shoes; Socks; Sports shirts; Suits; Sweat pants; Sweat shirts; Sweaters; Swim wear; T-shirts; Tops; Trousers; Turtlenecks; Undershirts; Underwear; Vests
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Attachments	Notice_of_Opposition_.pdf (18 pages)(559191 bytes)
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Signature	/Adam D. Resnick/
Name	Adam D. Resnick
Date	04/17/2007

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

In re Application Ser. Nos. 78/849,382, 78/849,344, and 78/849,360 for the marks BUGATCHI UOMO & Design, BUGATCHI, and BUGATCHI UOMO.

BUGATCHI UOMO APPAREL, INC.,)	
)	
Opposer,)	
)	
v.)	Opp. No. _____
)	
MARCO REVAH and SOLOMON REVAH,)	
)	
Joint Applicants.)	
_____)	

NOTICE OF OPPOSITION

Opposer Bugatchi Uomo Apparel, Inc. (“Opposer”), a corporation of Florida, having its principal place of business at 1377 Clint Moore Road, Suite 200, Boca Raton, Florida, believes that it will be damaged by the registration of the marks shown in Application Serial Nos. 78/849,382, 78/849,344, and 78/849,360, and hereby opposes the same under the provisions of Section 13 of the Trademark Act of 1946, 15 U.S.C. §1063.

As grounds for opposition, Opposer alleges the following:

1. Opposer is the owner of all right, title and interest in and to the famous marks BUGATCHI, BUGATCHI UOMO, and BUGATCHI UOMO & Design, which have been used extensively on and in connection with a variety of clothing and related accessories (“Opposer’s Goods”). Opposer’s use of its BUGATCHI Marks has long been extensive and exclusive in connection with Opposer’s Goods, and Opposer has expended substantial sums in advertising and promoting its BUGATCHI Marks over many years, such that Opposer’s BUGATCHI Marks have become so well-known in connection with Opposer and Opposer’s Goods as to be famous.

As such, Opposer has exclusive right, title, and interest in and to its famous BUGATCHI Marks, and such marks are entitled to broad protection.

2. Opposer's exclusive rights in its famous BUGATCHI Marks have been recognized by the United States Patent and Trademark Office, which issued to Opposer U.S. Registration Nos. 1,297,668 and 1,812,202 (both registrations have since been cancelled as a result of the inadvertent failure to file a renewal), as well as pending U.S. Application Serial Nos. 78/853,589, 77/045,276, 77/045,301, and 77/045,309 (the "BUGATCHI Marks"). Copies of the registration and application information from the web site of the United States Patent and Trademark Office are attached hereto as Exhibit A.

3. Opposer's continuous use of its famous BUGATCHI Marks in interstate commerce in connection with the advertising, promotion and sale of Opposer's Goods long predates the filing dates of Applicant's Application Serial Nos. 78/849,382, 78/849,344, and 78/849,360, as well as any use that Applicant may claim.

4. As a result of the substantial expenditures in advertising and promotion of Opposer's famous BUGATCHI Marks in connection with the sale of Opposer's Goods, and the substantial distribution of such goods under Opposer's famous BUGATCHI Marks throughout the United States, made over many years, the fame of Opposer's BUGATCHI Marks long predates the filing dates of Application Serial Nos. 78/849,382, 78/849,344, and 78/849,360, as well as any use that Applicant may claim.

5. Notwithstanding Opposer's prior established rights in and to its famous BUGATCHI Marks, Applicant filed applications with the United States Patent and Trademark Office to register the marks BUGATCHI UOMO & Design (Ser. No. 78/849,382), BUGATCHI (Ser. No. 78/849,344), and BUGATCHI UOMO (Ser. No. 78/849,360) for "Belts; Blazers;

Boxer shorts; Briefs; Cardigans; Dress shirts; Footwear; Gloves; Golf shirts; Headwear; Jackets; Jeans; Jogging suits; Knit shirts; Men's socks; Neckties; Pajamas; Pants; Polo shirts; Sandals; Shirts; Shoes; Socks; Sports shirts; Suits; Sweat pants; Sweat shirts; Sweaters; Swim wear; T-shirts; Tops; Trousers; Turtlenecks; Undershirts; Underwear; Vests,” in International Class 25.

6. Upon information and belief, Applicant made no use of its alleged marks prior to the filing date of its applications.

7. Upon information and belief, Applicant knew or had reason to know of Opposer’s prior rights in the BUGATCHI Marks when Applicant filed its applications.

Count I - Likelihood of Confusion - §2(d)

8. The marks which Applicant seeks to register are identical to or so closely resemble Opposer’s BUGATCHI Marks that the use and registration thereof is likely to cause confusion, mistake and/or deception as to the source or origin of Applicant’s goods, in violation of Section 2(d) of the Trademark Act, and will injure and damage Opposer and the goodwill and reputation symbolized by Opposer’s BUGATCHI Marks.

9. The goods of Opposer and Applicant are identical or so closely related that the public is likely to be confused, to be deceived and to assume erroneously that Applicant’s goods are goods offered by Opposer, or that Applicant is in some way connected with, sponsored by, or affiliated with Opposer, all to Opposer’s irreparable damage.

10. Likelihood of confusion is enhanced because Opposer’s BUGATCHI Marks are strong, famous, well-known and entitled to a broad scope of protection.

11. Likelihood of confusion is enhanced by the fact that Opposer's Goods and Applicant's goods will likely be sold through the same trade channels to the same classes of prospective purchasers.

12. Likelihood of confusion is enhanced by the fact that the parties advertise their goods in the same or similar types of media.

13. Likelihood of confusion in this case is enhanced by the fame of Opposer's BUGATCHI Marks and by the fact that consumers will associate Applicant's alleged marks with goods sold, approved or endorsed by Opposer.

14. Applicant is not affiliated or connected with, or endorsed or sponsored by, Opposer, nor has Opposer approved any of the goods offered or sold, or intended to be sold by Applicant under its alleged marks.

Count II - Likelihood of Deception/False Suggestion of Connection - Section 2(a)

15. Because Applicant's alleged marks are identical to or so closely resemble Opposer's BUGATCHI Marks, Applicant's alleged marks are likely to cause deception in violation of Section 2(a) of the Trademark Act, in that the marks misdescribe the nature or origin of the goods, and purchasers are likely to believe that the misdescription actually describes the nature or origin of the goods, which is likely to materially alter purchasers' decisions to acquire Applicant's goods.

16. Applicant's alleged marks are identical to or so closely resemble Opposer's BUGATCHI Marks that they falsely suggest a connection with Opposer in violation of Section 2(a) of the Trademark Act, because Applicant's alleged marks point uniquely to Opposer, and

purchasers will assume that goods offered under Applicant's alleged marks are connected with Opposer.

17. When Applicant's alleged marks are used in connection with the goods of the type described in its applications, said marks will cause purchasers to mistakenly assume that Opposer is endorsing, attempting to promote, or encouraging the sale of Applicant's goods by permitting Opposer's BUGATCHI Marks to be used in connection with such goods.

18. Applicant's alleged marks are deceptive in that they falsely suggest a connection with, or approval by, Opposer.

19. Use and registration of Applicant's alleged marks will deprive Opposer of the ability to protect its reputation, persona and goodwill.

Count III – Applications Are Void

20. On March 29, 2006, Applicant filed use-based trademark applications with the United States Patent and Trademark Office to register the marks BUGATCHI UOMO & Design (Ser. No. 78/849,382), BUGATCHI (Ser. No. 78/849,344), and BUGATCHI UOMO (Ser. No. 78/849,360) for "Belts; Blazers; Boxer shorts; Briefs; Cardigans; Dress shirts; Footwear; Gloves; Golf shirts; Headwear; Jackets; Jeans; Jogging suits; Knit shirts; Men's socks; Neckties; Pajamas; Pants; Polo shirts; Sandals; Shirts; Shoes; Socks; Sports shirts; Suits; Sweat pants; Sweat shirts; Sweaters; Swim wear; T-shirts; Tops; Trousers; Turtlenecks; Undershirts; Underwear; Vests," in International Class 25 ("Applicant's Applications").

21. Applicant filed Applicant's Applications as joint applicants between Marco Revah and Solomon Revah.

22. Applicant's Applications are void because Solomon Revah, one of the alleged joint applicants, did not provide his consent to the filing of the applications and, thus, Applicant did not own the applications on the application filing date.

23. As Applicant's Applications were not verified by all of the alleged applicants, as joint applicants, Applicant's Applications are void.

24. Upon information and belief, Applicant's Applications were signed by Scott J. Fields, Applicant's attorney of record, who was not authorized to sign on behalf of Applicant Solomon Revah.

Count IV - Fraud

25. Upon information and belief, Applicant made no lawful use of the alleged marks recited in Applicant's Applications prior to the application filing date.

26. Upon information and belief, to date Applicant has made no lawful use in commerce of the alleged marks recited in Applicant's Applications.

27. Upon information and belief, the specimens submitted by Applicant with Applicant's Applications do not demonstrate use of the alleged marks in commerce.

28. Upon information and belief, in an attempt to secure registration of its alleged marks, Applicant knowingly alleged fraudulent first use dates and provided fraudulent specimens of use to the United States Patent and Trademark Office.

29. Upon information and belief, Applicant withheld material information with a deliberate intent to deceive and to induce the United States Patent and Trademark Office to issue registrations to which Applicant was not entitled.

30. Upon information and belief, the United States Patent and Trademark Office relied on the absence of the material information withheld by Applicant, including fraudulent first use dates, fraudulent specimens, and the unauthorized Applicant name as alleged joint applicants and, but for the withholding of this material information, the United States Patent and

Trademark Office would not have approved Application Serial Nos. 78/849,382, 78/849,344, and 78/849,360 for publication.

31. Registration of Applicant's Applications should be denied because approval was obtained by fraud.

32. By reason of all of the foregoing, Opposer will be damaged by registration of Applicant's alleged marks and requests that registration to all be refused.

WHEREFORE, Opposer prays that this opposition be sustained and that registration be denied as to Application Serial Nos. 78/849,382, 78/849,344, and 78/849,360.

BUGATCHI UOMO APPAREL, INC.

By 

Charles M. Marmelstein
Adam D. Resnick
Arent Fox LLP
1050 Connecticut Avenue, N.W.
Washington, D.C. 20036
(202) 857-6000

Date:

4/17/07

Attorneys for Opposer

EXHIBIT A

Int. Cl.: 25

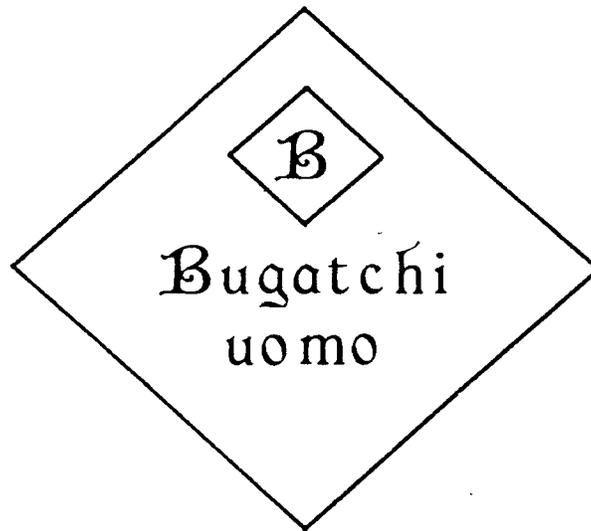
Prior U.S. Cl.: 39

Reg. No. 1,297,668

United States Patent and Trademark Office

Registered Sep. 25, 1984

TRADEMARK
Principal Register



Macdan Inc. (Canada corporation)
Suite 1207
5800 St. Denis
Montreal, Quebec, Canada H2S 3L5

For: MEN'S WEARING APPAREL—NAME-
LY, SHIRTS, T-SHIRTS, SWEATSHIRTS, JACK-
ETS AND SWEATERS, in CLASS 25 (U.S. Cl. 39).

First use Mar. 1982; in commerce Mar. 1982.

No claim is made to the exclusive right to use the
word "Uomo", apart from the mark as shown.

The word "Uomo" translated from the Italian
language means "Man".

Ser. No. 394,140, filed Sep. 29, 1982.

STEWART J. BELLUS, Examining Attorney

Int. Cl.: 25

Prior U.S. Cl.: 39

United States Patent and Trademark Office

Corrected

Reg. No. 1,812,202

Registered Dec. 21, 1993

OG Date Jan. 3, 1995

TRADEMARK
PRINCIPAL REGISTER



Bugatchi

U O M O

M.J. APPAREL, INC. (NEW YORK CORPORATION)
TRANSBORDER BUILDING
ROUTE 11 AND INTERSTATE 87
CHAMPLAIN, NY 12919, ASSIGNEE OF
MACDAN, INC. (CANADA CORPORATION)
MONTREAL, QUEBEC,
CANADA

OWNER OF U.S. REG. NO. 1,297,668.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "UOMO", APART FROM THE MARK AS SHOWN.

THE ENGLISH TRANSLATION OF THE WORD "UOMO" IN THE MARK IS "MAN".

FOR: MEN'S WEARING APPAREL; NAMELY, SHIRTS, T-SHIRTS, SWEATSHIRTS, JACKETS AND SWEATERS; MEN'S, WOMEN'S AND CHILDREN'S CLOTHING; NAMELY, JACKETS, PANTS, SUITS, SWEATERS, SHIRTS, VESTS, JUMPSUITS, SHORTS, T-SHIRTS, COATS, SKIRTS, DRESSES, BLOUSES, SWEATSHIRTS, SPORTSHIRTS, TANK TOPS, JEANS; ACCESSORIES; NAMELY, BELTS, SOCKS, SCARVES, TIES, IN CLASS 25 (U.S. CL. 39).

FIRST USE 3-0-1989; IN COMMERCE 3-0-1989.

SER. NO. 74-212,752, FILED 10-16-1991.

In testimony whereof I have hereunto set my hand and caused the seal of The Patent and Trademark Office to be affixed on Jan. 3, 1995.

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BUGATCHI
U O M O

Word Mark BUGATCHI U O M O
Goods and Services IC 025. US 022 039. G & S: CLOTHING NAMELY, PANTS, SUITS, SHIRTS, VESTS, SHORTS, T-SHIRTS, COATS, JACKETS, SWEATSHIRTS, SPORTSHIRTS, JEANS, BLAZERS, KNIT TOPS, TIES, HANDKERCHIEVES. FIRST USE: 20060100. FIRST USE IN COMMERCE: 20060100
Mark Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design 03.01.02 - Lion insignia (heraldic lion)
Search Code 05.15.02 - Laurel leaves or branches (borders or frames); Wreaths
Serial Number **78853589**
Filing Date April 4, 2006
Current Filing Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Bugatchi Uomo Apparel, Inc. CORPORATION FLORIDA 1377 Clint Moore Road Boca Raton FLORIDA 33487
Attorney of Record Charles M. Marmelstein
Description of Mark The mark consists of the words BUGATCHI UOMO in stylized characters along with a Lion design inside a semi-wreath.
Type of Mark TRADEMARK
Register PRINCIPAL

Live/Dead
Indicator LIVE

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BUGATCHI UOMO

Word Mark BUGATCHI UOMO
Goods and Services IC 025. US 022 039. G & S: CLOTHING NAMELY, PANTS, SUITS, SHIRTS, VESTS, SHORTS, COATS, T-SHIRTS, SWEATSHIRTS, SPORTSHIRTS, JEANS, BLAZERS, KNIT TOPS, TIES, HANDEKERCHIEVES, DRESS SHIRTS, GOLF SHIRTS, JOGGING SUITS, SWEATERS, SPORTS COATS, OUTERWEAR, ACTIVE WEAR. FIRST USE: 19970200. FIRST USE IN COMMERCE: 19970200
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Design Search Code
Serial Number 77045276
Filing Date November 16, 2006
Current Filing Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Bugatchi Uomo Apparel, Inc. CORPORATION FLORIDA 1377 Clint Moore Road, Suite 200 Boca Raton FLORIDA 33487
Attorney of Record Charles M. Marmelstein

Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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BUGATCHI

Word Mark BUGATCHI
Goods and Services IC 025. US 022 039. G & S: CLOTHING NAMELY, PANTS, SUITS, SHIRTS, VESTS, SHORTS, COATS, T-SHIRTS, SWEATSHIRTS, SPORTSHIRTS, JEANS, BLAZERS, KNIT TOPS, TIES, HANDKERCHIEVES, DRESS SHIRTS, GOLF SHIRTS, JOGGING SUITS, SWEATERS, SPORTS COATS, OUTERWEAR, ACTIVE WEAR. FIRST USE: 19970200. FIRST USE IN COMMERCE: 19970200
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Design Search Code
Serial Number 77045301
Filing Date November 16, 2006
Current Filing Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Bugatchi Uomo Apparel, Inc. CORPORATION FLORIDA 1377 Clint Moore Road, Suite 200 Boca Raton FLORIDA 33487
Attorney of Record Charles M. Marmelstein

Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

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BUGATCHI DONNA

Word Mark BUGATCHI DONNA
Goods and Services IC 025. US 022 039. G & S: WOMEN'S CLOTHING NAMELY, SHIRTS, KNITS, SWEATERS, DRESSES, SKIRTS, JOGGING SUITS, SWEATSHIRTS, GOLF KNITS, VESTS, SKORTS, T-SHIRTS, JEANS, JACKETS, BLAZERS, ACTIVE WEAR, SHORTS, BELTS, PANTS, OUTERWEAR, COATS. FIRST USE: 20060700. FIRST USE IN COMMERCE: 20060700
Standard Characters Claimed
Mark Drawing Code (4) STANDARD CHARACTER MARK
Design Search Code
Serial Number 77045309
Filing Date November 16, 2006
Current Filing Basis 1A
Original Filing Basis 1A
Owner (APPLICANT) Bugatchi Uomo Apparel, Inc. CORPORATION FLORIDA Suite 200 1377 Clint Moore Road Boca Raton FLORIDA 33487
Attorney of Record Charles M. Marmelstein
Type of Mark TRADEMARK

Register PRINCIPAL
Live/Dead Indicator LIVE

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