

ESTTA Tracking number: **ESTTA340384**

Filing date: **04/01/2010**

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	Serendipity 3, Inc.		
Entity	Corporation	Citizenship	New York
Address	225 East 60th Street New York, NY 10022 UNITED STATES		

Attorney information	Kieran G. Doyle Cowan, Liebowitz & Latman 1133 Avenue fo the Americas New York, NY 10036 UNITED STATES kgd@cll.com,trademark@cll.com Phone:(212) 790-9261		
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Applicant Information

Application No	77767817	Publication date	03/23/2010
Opposition Filing Date	04/01/2010	Opposition Period Ends	04/22/2010
Applicant	PRIMONATO ENTERPRISES, LTD. 1 ROSECLIFF DRIVE PITTSBURGH, PA 15209 UNITED STATES		

Goods/Services Affected by Opposition

Class 043. All goods and services in the class are opposed, namely: Restaurant and bar services
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3285027	Application Date	11/17/2006
Registration Date	08/28/2007	Foreign Priority Date	NONE
Word Mark	SERENDIPITY 3		

Design Mark	<h1>SERENDIPITY 3</h1>
Description of Mark	NONE
Goods/Services	Class 003. First use: First Use: 1999/12/31 First Use In Commerce: 1999/12/31 Bubble bath, skin moisturizers, non-medicated foot cream, perfume, hair shampoo, hair conditioner and lip balm Class 004. First use: First Use: 2006/06/30 First Use In Commerce: 2006/06/30 Scented candles

U.S. Registration No.	1051353	Application Date	11/07/1975
Registration Date	10/26/1976	Foreign Priority Date	NONE
Word Mark	SERENDIPITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1960/00/00 First Use In Commerce: 1960/00/00 WOMEN'S AND GIRLS' CLOTHING-NAMELY, [PAJAMAS, DRESSES,] JACKETS, [BATHING SUITS AND BIKINIS, ROBES,] BLOUSES, HATS, CAPES, SWEATERS, T-SHIRTS, [SLACKS, CULLOTTES,] APRONS, AND SWEAT SHIRTS; AND MEN'S AND BOYS' CLOTHING-NAMELY, SHIRTS, [TROUSERS, BATHING SUITS,] JACKETS, [COATS, TIES,] SCARVES, [SHOES, KAFTANS, AND ROBES]		

U.S. Registration No.	1238663	Application Date	03/19/1982
Registration Date	05/17/1983	Foreign Priority Date	NONE
Word Mark	SERENDIPITY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 030. First use: First Use: 1954/09/00 First Use In Commerce: 1954/09/00 Frozen Confections for Consumption On or Off the Premises		

U.S. Registration No.	1578314	Application Date	04/24/1989
Registration Date	01/16/1990	Foreign Priority Date	NONE
Word Mark	SERENDIPITY 3		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 042. First use: First Use: 1954/09/00 First Use In Commerce: 1973/11/05 RESTAURANT SERVICES

U.S. Registration No.	1580753	Application Date	04/24/1989
Registration Date	01/30/1990	Foreign Priority Date	NONE
Word Mark	SERENDIPITY 3		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 1954/09/00 First Use In Commerce: 1954/12/00 RETAIL STORE SERVICES IN THE FIELD OF FOOD, CLOTHING, CHINA, GLASSWARE AND NOVELTY ITEMS		

U.S. Registration No.	804598	Application Date	03/09/1965
Registration Date	03/01/1966	Foreign Priority Date	NONE
Word Mark	SERENDIPITY 3		
Design Mark	serendipity 3		
Description of Mark	NONE		
Goods/Services	Class U022 (International Class 028). First use: First Use: 1963/11/15 First Use In Commerce: 1963/11/15 CHILDREN'S PUZZLES, BOARD GAMES, CARD GAMES, RAG DOLLS, AND WOODEN WALKING TOYS		

Attachments	77046322#TMSN.jpeg (1 page)(bytes) 72213720#TMSN.gif (1 page)(bytes) SERENDIPITYBISTRONOO.PDF (28 pages)(592502 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Kieran G. Doyle/
Name	Kieran G. Doyle
Date	04/01/2010

Ref. No. 16422-000

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

In re Application Serial No.: 77/767,817

Filed: June 26, 2006

Trademark: SERENDIPITY HIP AMERICAN CUISINE BISTRO & Design

Published in the Official Gazette: March 23, 2010

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SERENDIPITY 3, INC.,

Opposer,

Opposition No.

v.

NOTICE OF OPPOSITION

PRIMONATO ENTERPRISES LTD.,

Applicant.

-----X

Commissioner for Trademarks
BOX TTAB FEE
P.O. Box 1451
Alexandria, VA 22313-1451

Opposer Serendipity 3, Inc., a New York corporation, with offices at 225 East 60th Street, New York, New York 10022, believes that it will be damaged by registration of the mark SERENDIPITY HIP AMERICAN CUISINE BISTRO & DESIGN for “restaurant and bar services” in Class 43 (the “SERENDIPITY BISTRO Mark”) in application Serial No. 77/767,817, and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Since at least as early as 1954, Opposer, itself and through its licensees, has used and continues to use the and trademark SERENDIPITY, either alone or in combination with other words or designs (“Opposer’s SERENDIPITY Marks”), in connection with restaurant

services and food and beverage items.

2. Opposer owns United States Registration Nos. 3,285,027, 1,051,353, 1,238,663, 1,578,314, 1,580,753 and 804,598 for some of Opposer's SERENDIPITY Marks. Printouts from the USPTO database showing the title and status of these registrations are attached hereto as Exhibit A.

3. Opposer has acquired valuable rights in Opposer's SERENDIPITY Marks in connection with a variety of restaurant, food and beverage-related goods and services. Opposer's SERENDIPITY Marks symbolize valuable goodwill which rightfully belongs to Opposer.

4. Commencing prior to any first use or application date that can be relied upon by Applicant, Opposer and its licensees have promoted and advertised the offering of services and sale of goods bearing Applicant's SERENDIPITY Marks, and have sold such goods and offered such services in commerce.

5. On June 26, 2006, Primonato Enterprises, Ltd. filed an intent to use application to register the SERENDIPITY BISTRO Mark for "restaurant and bar services" in Class 43.

6. The services covered by Application No. 77/767,817 are identical or closely related to the goods and services on which Opposer has used Opposer's SERENDIPITY Marks.

7. Applicant's SERENDIPITY BISTRO Mark so resembles Opposer's SERENDIPITY Marks so as to be likely, when used in connection with Applicant's services, to cause confusions, to cause mistake and to deceive the trade and the public, because the public is

Ref. No. 16422-00

likely to believe that Applicant's services have their origin with Opposer and/or that such services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's SERENDIPITY BISTRO Mark.

8. Opposer would be further injured by the granting of such registration because it may tend to damage Opposer's valuable goodwill and reputation for excellence and high quality in Opposer's SERENDIPITY Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's SERENDIPITY BISTRO Mark and prays that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Kieran G. Doyle (member of the Bar of the State of New York) and the firm of Cowan, Liebowitz & Latman, 1133 Avenue of the Americas, New York, New York 10036.

Please address all communications to Kieran G. Doyle, Esq. at the above address.

Dated: New York, New York
April 1, 2010

Respectfully submitted,
COWAN, LIEBOWITZ & LATMAN, P.C.
Attorneys for Opposer

By: /Kieran G. Doyle/
Kieran G. Doyle
1133 Avenue of the Americas
New York, New York 10036
Tel: (212) 790-9200

Ref. No. 16422-00

CERTIFICATE OF SERVICE

I hereby certify that, on April 1, 2010, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Michael J. Hudock, III, Michael J. Hudock & Associates, P.C., 12 Huston Road, Oakmont, PA 15139-1996.

/Kieran G. Doyle/

Kieran G. Doyle

Ref. No. 16422-00

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 2010-04-01 15:39:47 ET

Serial Number: 77046322 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 3285027

Mark

SERENDIPITY 3

(words only): SERENDIPITY 3

Standard Character claim: Yes

Current Status: Registered.

Date of Status: 2007-08-28

Filing Date: 2006-11-17

Transformed into a National Application: No

Registration Date: 2007-08-28

Register: Principal

Law Office Assigned: LAW OFFICE 103

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: 650 -Publication And Issue Section

Date In Location: 2007-08-28

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

1. Serendipity 3, Inc.

Address:

Serendipity 3, Inc.
225 East 60th Street

New York, NY 10022
United States
Legal Entity Type: Corporation
State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 003

Class Status: Active

Bubble bath, skin moisturizers, non-medicated foot cream, perfume, hair shampoo, hair conditioner and lip balm

Basis: 1(a)

First Use Date: 1999-12-31

First Use in Commerce Date: 1999-12-31

International Class: 004

Class Status: Active

Scented candles

Basis: 1(a)

First Use Date: 2006-06-30

First Use in Commerce Date: 2006-06-30

ADDITIONAL INFORMATION

Prior Registration Number(s):

804598

1578314

1580753

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.

2007-08-28 - Registered - Principal Register

2007-06-12 - Published for opposition

2007-05-23 - Notice of publication

2007-04-13 - Law Office Publication Review Completed

2007-04-13 - Assigned To LIE

2007-03-23 - Examiner's amendment mailed

2007-03-23 - Approved for Pub - Principal Register (Initial exam)

2007-03-23 - Examiner's Amendment Entered

2007-03-23 - Examiners Amendment -Written

2007-03-21 - Assigned To Examiner

2006-11-23 - Notice Of Pseudo Mark Mailed

2006-11-22 - New Application Entered In Tram

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Kieran G. Doyle

Correspondent

KIERAN G. DOYLE

COWAN, LIEBOWITZ & LATMAN, P.C.

1133 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-6710

Phone Number: 212-790-9200

Fax Number: 212-575-0671



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Assignments on the Web > Trademark Query

No assignment has been recorded at the USPTO

For Registration Number: 3285027

If you have any comments or questions concerning the data displayed, contact PRD / Assignments at 571-272-3350.
Web interface last modified: October 18, 2008 v.2.0.2

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Serial Number: 73068298 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1051353

Mark (words only): SERENDIPITY

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2007-01-26

Filing Date: 1975-11-07

Transformed into a National Application: No

Registration Date: 1976-10-26

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: 2007-11-05

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

1. SERENDIPITY 3, INC.

Address:

SERENDIPITY 3, INC.
225 E. 60TH ST.
NEW YORK, NY 10022
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 025

Class Status: Active

WOMEN'S AND GIRLS' CLOTHING-NAMELY, JACKETS, BLOUSES, HATS, CAPES, SWEATERS, T-SHIRTS, APRONS, AND SWEAT SHIRTS; AND MEN'S AND BOYS' CLOTHING-NAMELY, SHIRTS, JACKETS, SCARVES

Basis: 1(a)

First Use Date: 1960-00-00

First Use in Commerce Date: 1960-00-00

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.

2007-11-05 - Case File In TICRS

2007-01-26 - Second renewal 10 year

2007-01-26 - Section 8 (10-year) accepted/ Section 9 granted

2006-12-21 - Assigned To Paralegal

2006-10-23 - Combined Section 8 (10-year)/Section 9 filed

2006-10-23 - PAPER RECEIVED

1996-06-20 - First renewal 10 year

1996-05-01 - Section 9 filed/check record for Section 8

1982-05-17 - Section 8 (6-year) accepted & Section 15 acknowledged

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

DAVID GOLDBERG

Correspondent

DAVID GOLDBERG

COWAN, LIEBOWITZ & LATMAN, P.C.

1133 AVENUE OF THE AMERICAS

NEW YORK, NY 10036-6799



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Serial Number: 73355398 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1238663

Mark (words only): SERENDIPITY

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2003-08-15

Filing Date: 1982-03-19

Transformed into a National Application: No

Registration Date: 1983-05-17

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: 2008-04-21

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

1. Serendipity 3, Inc.

Address:

Serendipity 3, Inc.
225 E. 60th St.
New York, NY 10022
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 030

Class Status: Active

Frozen Confections for Consumption On or Off the Premises

Basis: 1(a)

First Use Date: 1954-09-00

First Use in Commerce Date: 1954-09-00

ADDITIONAL INFORMATION

Prior Registration Number(s):

1049077

1049078

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.

2008-04-21 - Case File In TICRS

2003-08-15 - First renewal 10 year

2003-08-15 - Section 8 (10-year) accepted/ Section 9 granted

2003-05-19 - Combined Section 8 (10-year)/Section 9 filed

2003-05-19 - PAPER RECEIVED

1988-10-22 - Section 8 (6-year) accepted & Section 15 acknowledged

1988-09-12 - Section 8 (6-year) and Section 15 Filed

1983-05-17 - Registered - Principal Register

1983-02-22 - Published for opposition

1983-05-17 - Registered - Principal Register

1983-01-18 - Notice of publication

1983-01-10 - Approved for Pub - Principal Register (Initial exam)

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

KIERAN G. DOYLE

Correspondent

KIERAN G. DOYLE
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-6799



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Serial Number: 73795216 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1578314

Mark (words only): SERENDIPITY 3

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2000-08-11

Filing Date: 1989-04-24

Transformed into a National Application: No

Registration Date: 1990-01-16

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: 2008-12-19

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

1. SERENDIPITY 3, INC.

Address:

SERENDIPITY 3, INC.
225 EAST 60TH STREET
NEW YORK, NY 10022
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

RESTAURANT SERVICES

Basis: 1(a)**First Use Date:** 1954-09-00**First Use in Commerce Date:** 1973-11-05

ADDITIONAL INFORMATION

Prior Registration Number(s):

1149077

1149078

1238663

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.

2008-12-19 - Case File In TICRS

2000-08-11 - First renewal 10 year

2000-08-11 - Section 8 (10-year) accepted/ Section 9 granted

2000-01-05 - Combined Section 8 (10-year)/Section 9 filed

1996-06-27 - Section 8 (6-year) accepted & Section 15 acknowledged

1996-01-02 - Section 8 (6-year) and Section 15 Filed

1990-01-16 - Registered - Principal Register

1989-10-24 - Published for opposition

1989-09-23 - Notice of publication

1989-08-08 - Approved for Pub - Principal Register (Initial exam)

1989-07-11 - Examiner's amendment mailed

1989-06-22 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

DAVID GOLDBERG

Correspondent

DAVID GOLDBERG
COWAN, LIEBOWITZ & LATMAN, P.C.
1133 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-6799



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For Registration Number: 1578314

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Serial Number: 73795199 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 1580753

Mark (words only): SERENDIPITY 3

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 2010-01-11

Filing Date: 1989-04-24

Transformed into a National Application: No

Registration Date: 1990-01-30

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: 540 -TMEO Law Office # 4

Date In Location: 2010-01-11

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

1. SERENDIPITY 3, INC.

Address:

SERENDIPITY 3, INC.
225 EAST 60TH STREET
NEW YORK, NY 10022
United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

International Class: 042

Class Status: Active

RETAIL STORE SERVICES IN THE FIELD OF FOOD, CLOTHING, CHINA, GLASSWARE AND NOVELTY ITEMS

Basis: 1(a)

First Use Date: 1954-09-00

First Use in Commerce Date: 1954-12-00

ADDITIONAL INFORMATION

Prior Registration Number(s):

801372

1051353

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.

2010-01-07 - Combined Section 8 (10-year)/Section 9 filed

2010-01-07 - Combined Section 8 (10-year)/Section 9 filed

2010-01-11 - Second renewal 10 year

2010-01-11 - Section 8 (10-year) accepted/ Section 9 granted

2010-01-07 - TEAS Section 8 & 9 Received

2008-12-17 - Case File In TICRS

2000-08-10 - First renewal 10 year

2000-08-10 - Section 8 (10-year) accepted/ Section 9 granted

2000-01-06 - Combined Section 8 (10-year)/Section 9 filed

1996-06-27 - Section 8 (6-year) accepted & Section 15 acknowledged

1996-01-02 - Section 8 (6-year) and Section 15 Filed

1990-01-30 - Registered - Principal Register

1989-11-07 - Published for opposition

1989-10-07 - Notice of publication

1989-08-22 - Approved for Pub - Principal Register (Initial exam)

1989-08-11 - Examiner's amendment mailed

1989-08-10 - Allowance/count withdrawn

1989-07-11 - Examiner's amendment mailed

1989-06-22 - Assigned To Examiner

ATTORNEY/CORRESPONDENT INFORMATION

Attorney of Record

Kieran G. Doyle

Correspondent

Kieran G. Doyle

Cowan, Liebowitz & Latman, PC
1133 AVENUE OF THE AMERICAS
NEW YORK NY 10036-6799



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No assignment has been recorded at the USPTO

For Serial Number: 73795199

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Serial Number: 72213720 [Assignment Information](#) [Trademark Document Retrieval](#)

Registration Number: 804598

Mark

serendipity 3

(words only): SERENDIPITY 3

Standard Character claim: No

Current Status: This registration has been renewed.

Date of Status: 1986-06-17

Filing Date: 1965-03-09

Transformed into a National Application: No

Registration Date: 1966-03-01

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: 2008-10-31

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

1. SERENDIPITY 3, INC.

Address:

SERENDIPITY 3, INC.
225 EAST 60TH STREET

NEW YORK, NY 10022

United States

Legal Entity Type: Corporation

State or Country of Incorporation: New York

GOODS AND/OR SERVICES

U.S. Class: 022 (International Class 028)

Class Status: Active

CHILDREN'S PUZZLES, BOARD GAMES, CARD GAMES, RAG DOLLS, AND WOODEN WALKING TOYS

Basis: 1(a)

First Use Date: 1963-11-15

First Use in Commerce Date: 1963-11-15

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.

2008-10-31 - Case File In TICRS

1986-03-01 - First renewal

1986-03-31 - Section 9 filed/check record for Section 8

ATTORNEY/CORRESPONDENT INFORMATION

Correspondent

WILLIAM T. HOUGH

POLACHEK, SAULSBURY & HOUGH

312 S. FINLEY

BASKING RIDGE, N.J. 07920



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For Serial Number: 72213720

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