
To: Chippendales USA, Inc. (nytrademark@daypitney.com)
Subject: TRADEMARK APPLICATION NO. 78666598 - 404069
Sent: 2/4/2008 9:58:01 AM
Sent As: ECOM108@USPTO.GOV
Attachments:

UNITED STATES PATENT AND TRADEMARK OFFICE**SERIAL NO:** 78/666598**MARK:****CORRESPONDENT ADDRESS:**

Stephen W. Feingold
Day Pitney LLP
7 Times Square
New York NY 10036

GENERAL TRADEMARK INFORMATION:
<http://www.uspto.gov/main/trademarks.htm>

APPLICANT: Chippendales USA, Inc.**CORRESPONDENT'S REFERENCE/DOCKET
NO:**

404069

CORRESPONDENT E-MAIL ADDRESS:
nytrademark@daypitney.com**REQUEST FOR RECONSIDERATION GRANTED IN PART/DENIED IN PART****ISSUE/MAILING DATE: 2/4/2008**

The Office has reassigned this application to the undersigned trademark examining attorney.

Applicant is requesting reconsideration of a final refusal issued/mailed September 5, 2007.

The under-signed has amended the applicant's name to read properly as requested. The under-signed accepts the applicant's amended recitation of services and thereby *withdraws* the refusal regarding the duplicate registrations. This should render the Petition to the Director moot.

However, the underlying substantive issue as to whether the proposed mark is inherently distinctive remains. Even though technically not at issue in this reconsideration request, the examining attorney must deny the request for reconsideration and adhere to the final action as written since no new facts or reasons have been presented that are significant and compelling with regard to that particular point at issue.

After a brief conversation with counsel, Applicant has also submitted a second reconsideration request

on January 31, 2008, requesting reconsideration of a final refusal issued/mailed September 5, 2007. The examining attorney has no objection to the admission of the documentation submitted therein. This evidence consists of the proof of Notice of Allowance for copending application 78956349. The examining attorney, does however, question the relevance of this evidence. Please see TMEP 1202.02(e) that states in part as follows:

Distinctiveness and Product Packaging

If the mark comprises product packaging trade dress for goods or services, the examining attorney must determine whether the mark is inherently distinctive. *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 54 USPQ2d 1065 (2000); *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 23 USPQ2d 1081 (1992). This requires consideration of the context in which the mark is used and the impression it would make on purchasers. Generally, no refusal based on lack of inherent distinctiveness will be issued in an intent-to-use application until the applicant has submitted specimen(s) with an amendment to allege use or a statement of use. However, if appropriate, the examining attorney has discretion to issue this refusal before a specimen is submitted.

The issue of functionality for 78956349 is not ripe for review at this time. Applicant was warned of this in an Office Action dated 12/1/06 that stated in relevant part as follows:

Possible Refusal for Nondistinctive Trade Dress– ITU Application (Informational)

In view of the nature of the proposed mark, applicant is advised however that, upon the trademark examining attorney's consideration of an amendment to allege use or statement of use, registration may be refused under Trademark Act Sections 1, 3 and 45, 15 U.S.C. §§1051, 1053 and 1127, on the ground that the proposed mark is nondistinctive trade dress.

Accordingly, applicant's request for reconsideration is therefore *granted in part and denied in part*. The time for appeal runs from the date the final action was issued/mailed. 37 C.F.R. Section 2.64(b); TMEP Section 715.03(c). Since applicant has already filed a timely notice of appeal, the application will be forwarded to the Trademark Trial and Appeal Board (TTAB).

Please contact the under-signed if anything written above is unclear and/or needs further clarification.

/srb/
Steven R. Berk
Senior Supervisory Attorney
Law Office 108
571-272-9246

STATUS CHECK: Check the status of the application at least once every six months from the initial filing date using the USPTO Trademark Applications and Registrations Retrieval (TARR) online system at <http://tarr.uspto.gov>. When conducting an online status check, print and maintain a copy of the complete TARR screen. If the status of your application has not changed for more than six months, please contact the assigned examining attorney.

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IMPORTANT NOTICE
USPTO OFFICE ACTION HAS ISSUED ON 2/4/2008 FOR
APPLICATION SERIAL NO. 78666598

Please follow the instructions below to continue the prosecution of your application:

VIEW OFFICE ACTION: Click on this link http://tportal.uspto.gov/external/portal/tow?DDA=Y&serial_number=78666598&doc_type=REC&mail_date=20080204 (or copy and paste this URL into the address field of your browser), or visit <http://tportal.uspto.gov/external/portal/tow> and enter the application serial number to **access** the Office action.

PLEASE NOTE: The Office action may not be immediately available but will be viewable within 24 hours of this notification.

RESPONSE MAY BE REQUIRED: You should carefully review the Office action to determine (1) if a response is required; (2) how to respond; and (3) the applicable **response time period**. Your response deadline will be calculated from **2/4/2008**.

Do NOT hit "Reply" to this e-mail notification, or otherwise attempt to e-mail your response, as the USPTO does NOT accept e-mailed responses. Instead, the USPTO recommends that you respond online using the Trademark Electronic Application System response form at <http://www.uspto.gov/teas/eTEASpageD.htm>.

HELP: For *technical* assistance in accessing the Office action, please e-mail TDR@uspto.gov. Please contact the assigned examining attorney with questions about the Office action.

WARNING

- 1. The USPTO will NOT send a separate e-mail with the Office action attached.**
- 2. Failure to file any required response by the applicable deadline will result in the ABANDONMENT of your application.**