

**To:** Ten-In-One Productions, Inc. ([bsinger@dglaw.com](mailto:bsinger@dglaw.com))  
**Subject:** U.S. TRADEMARK APPLICATION NO. 85633957 - GOTHAM BURLESQUE - 25964-0001-0  
**Sent:** 9/23/2012 6:32:18 PM  
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[Attachment - 4](#)  
[Attachment - 5](#)

**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)  
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

**APPLICATION SERIAL NO.** 85633957

**MARK:** GOTHAM BURLESQUE

**\*85633957\***

**CORRESPONDENT ADDRESS:**

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**APPLICANT:** Ten-In-One Productions, Inc.

**CORRESPONDENT'S REFERENCE/DOCKET NO :**  
25964-0001-0

**CORRESPONDENT E-MAIL ADDRESS:**  
[bsinger@dglaw.com](mailto:bsinger@dglaw.com)

**OFFICE ACTION**

**STRICT DEADLINE TO RESPOND TO THIS LETTER**

TO AVOID ABANDONMENT OF APPLICANT'S TRADEMARK APPLICATION, THE USPTO MUST RECEIVE APPLICANT'S COMPLETE RESPONSE TO THIS LETTER **WITHIN 6 MONTHS** OF THE ISSUE/MAILING DATE BELOW.

**ISSUE/MAILING DATE:** 9/23/2012

The referenced application has been reviewed by the assigned trademark examining attorney. Applicant must respond timely and completely to the issues below. 15 U.S.C. §1062(b); 37 C.F.R. §§2.62(a), 2.65(a); TMEP §§711, 718.03.

**NO CONFLICTING MARKS NOTED**

The trademark examining attorney has searched the Office's database of registered and pending marks and has found no conflicting marks that would bar registration under Trademark Act Section 2(d). TMEP §704.02; *see* 15 U.S.C. §1052(d).

**TRADEMARK ACT SECTION 2(e)(2) REFUSAL**

Registration is refused because the applied-for mark is primarily geographically descriptive of the origin of applicant's services. Trademark Act Section 2(e)(2), 15 U.S.C. §1052(e)(2); *see* TMEP §§1210, 1210.01(a).

A mark is primarily geographically descriptive when the following is demonstrated:

- (1) The primary significance of the mark is a generally known geographic place or location;
- (2) The services for which applicant seeks registration originate in the geographic place identified in the mark; and
- (3) Purchasers would be likely to make a services-place association; that is, purchasers would be likely to believe that the services originate in the geographic place identified in the mark.

TMEP §1210.01(a); *see In re Societe Generale des Eaux Minerales de Vittel S.A.*, 824 F.2d 957, 959, 3 USPQ2d 1450, 1452 (Fed. Cir. 1987); *In re Joint-Stock Co. "Baik,"* 80 USPQ2d 1305, 1309 (TTAB 2006).

Here, the applicant seeks registration of GOTHAM BURLESQUE, in standard characters. "Gotham" is a nick name for New York City. (*See* attached excerpt from the *Yahoo Education* website). Commonly used nicknames for geographic locations are generally treated as equivalent to the proper geographic name of the place identified. TMEP §1210.02(a); *see, e.g., In re Carolina Apparel*, 48 USPQ2d 1542, 1543 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services where evidence showed that "Carolina" is used to indicate either the state of North Carolina or South Carolina); *In re Charles S. Loeb Pipes, Inc.*, 190 USPQ 238, 245 (TTAB 1976) (holding OLD DOMINION is "the accepted nickname for the State of Virginia").

Moreover, the applicant's website indicates that the applicant shows are provided in New York City. When there is no genuine issue that the geographical significance of a term is its primary significance, and the geographical place is neither obscure nor remote, a public association of the services with the place is presumed if an applicant's services originate in the place named in the mark. TMEP §1210.04; *see, e.g., In re Cal. Pizza Kitchen Inc.*, 10 USPQ2d 1704, 1706 (TTAB 1988) (holding CALIFORNIA PIZZA KITCHEN primarily geographically descriptive of restaurant services rendered in California); *In re Handler Fenton Ws., Inc.*, 214 USPQ 848, 849-50 (TTAB 1982) (holding DENVER WESTERNS primarily geographically descriptive of western-style shirts originating in Denver).

The word "burlesque" is defined as a "variety show characterized by broad ribald comedy, dancing, and striptease." *American Heritage Dictionary of the English Language*, (4<sup>th</sup> ed. 2012). The applicant is providing a variety show that is likely either burlesque in nature or features burlesque style performances. Accordingly, the word "BURLESQUE" in the mark is generic for the services. The addition of generic or highly descriptive wording to a geographic word or term does not diminish that geographic word or term's primary geographic significance. TMEP §1210.02(c)(ii); *see, e.g., In re JT Tobacconists*, 59 USPQ2d 1080 (TTAB 2001) (holding MINNESOTA CIGAR COMPANY primarily geographically descriptive of cigars); *In re Carolina Apparel*, 48 USPQ2d 1542 (TTAB 1998) (holding CAROLINA APPAREL primarily geographically descriptive of retail clothing store services); *In re Chalk's Int'l Airlines Inc.*, 21 USPQ2d 1637 (TTAB 1991) (holding PARADISE ISLAND AIRLINES primarily geographically descriptive of the transportation of passengers and goods by air).

#### ***Seeking Registration On The Supplemental Register:***

The applied-for mark has been refused registration on the Principal Register. Applicant may respond to the refusal by submitting evidence and arguments in support of registration and/or by amending the application to seek registration on the Supplemental Register. *See* 15 U.S.C. §1091; 37 C.F.R. §§2.47, 2.75(a); TMEP §§801.02(b), 816. Amending to the Supplemental Register does not preclude applicant from submitting evidence and arguments against the refusal(s). TMEP §816.04.

Although registration on the Supplemental Register does not afford all the benefits of registration on the Principal Register, it does provide the following advantages:

- The registrant may use the registration symbol ®;
- The registration is protected against registration of a confusingly similar mark under Trademark Act Section 2(d);
- The registrant may bring suit for infringement in federal court; and
- The registration may serve as the basis for a filing in a foreign country under the Paris Convention and other international agreements.

*See* 15 U.S.C. §§1052(d), 1091, 1094; TMEP §815.

#### ***Disclaimer Of Generic Wording Required:***

Applicant is advised that, if the application is amended to seek registration on the Principal Register under Trademark Act Section 2(f) or on the Supplemental Register, applicant must disclaim "BURLESQUE" because such wording appears to be generic in the context of applicant's services. *See* 15 U.S.C. §1056(a); *In re Wella Corp.*, 565 F.2d 143, 196 USPQ 7 (C.C.P.A. 1977); *In re Creative Goldsmiths of Wash., Inc.*, 229 USPQ 766 (TTAB 1986); TMEP §1213.03(b).

The following is the standardized format for a disclaimer:

No claim is made to the exclusive right to use “BURLESQUE” apart from the mark as shown.

TMEP §1213.08(a)(i).

### **IDENTIFICATION OF SERVICES**

The identification of services is indefinite and must be clarified. *See* TMEP §1402.01. Specifically, the applicant must clarify the nature of the “visual and audio performances” and the means by which the “musical, dance and variety shows” are provided.

The applicant may adopt the following identification, if accurate:

“entertainment services, namely, providing live visual and audio performances in the nature of musical, dance, and variety shows,” in International Class 41.

**Additions Not Allowed:** An applicant may amend an identification of services only to clarify or limit the services; adding to or broadening the scope of the services is not permitted. 37 C.F.R. §2.71(a); *see* TMEP §§1402.06 *et seq.*, 1402.07 *et seq.*

**On-line Acceptable Identification of Goods and Services Manual:** For the applicant’s reference the examining attorney provides the following address for the identification of goods and services manual on the United States Patent and Trademark Office’s web site:

**<http://tess2.uspto.gov/netahtml/tidm.html>**

The applicant may wish to consult the on-line identification manual for a listing of acceptable common names of goods and services. While the list is not exhaustive, the manual should give the applicant direction regarding proper international classification and information and specificity required in the applicant’s identification of goods and/or services.

### **QUESTIONS REGARDING OUTSTANDING REFUSALS OR REQUIREMENTS**

If applicant has questions regarding this Office action, please telephone or e-mail the assigned trademark examining attorney. All relevant e-mail communications will be placed in the official application record; however, an e-mail communication will not be accepted as a response to this Office action and will not extend the deadline for filing a proper response. *See* 37 C.F.R. §2.191; TMEP §§304.01-.02, 709.04-.05.

Further, although the trademark examining attorney may provide additional explanation pertaining to the refusal(s) and/or requirement(s) in this Office action, the trademark examining attorney may not provide legal advice or statements about applicant’s rights. *See* TMEP §§705.02, 709.06.

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**All informal e-mail communications relevant to this application will be placed in the official application record.**

**WHO MUST SIGN THE RESPONSE:** It must be personally signed by an individual applicant or someone with legal authority to bind an applicant (i.e., a corporate officer, a general partner, all joint applicants). If an applicant is represented by an attorney, the attorney must sign the response.

**PERIODICALLY CHECK THE STATUS OF THE APPLICATION:** To ensure that applicant does not miss crucial deadlines or official notices, check the status of the application every three to four months using Trademark Applications and Registrations Retrieval (TARR) at <http://tarr.uspto.gov/>. Please keep a copy of the complete TARR screen. If TARR shows no change for more than six months, call 1-800-786-9199. For more information on checking status, see <http://www.uspto.gov/trademarks/process/status/>.

**TO UPDATE CORRESPONDENCE/E-MAIL ADDRESS:** Use the TEAS form at <http://www.uspto.gov/teas/eTEASpageE.htm>.

TEN-IN-ONE PRODUCTIONS PRESENTS

# GOTHAM BURLESQUE

*"Gypsy Rose Lee would be proud"*

—New York Magazine

*"Wonderfully theatrical  
and sometimes to the  
point of insanity."*

*Just the way we like it!"*

—NY Daily News

*Do they bump it?  
You bet!*

—NY Post

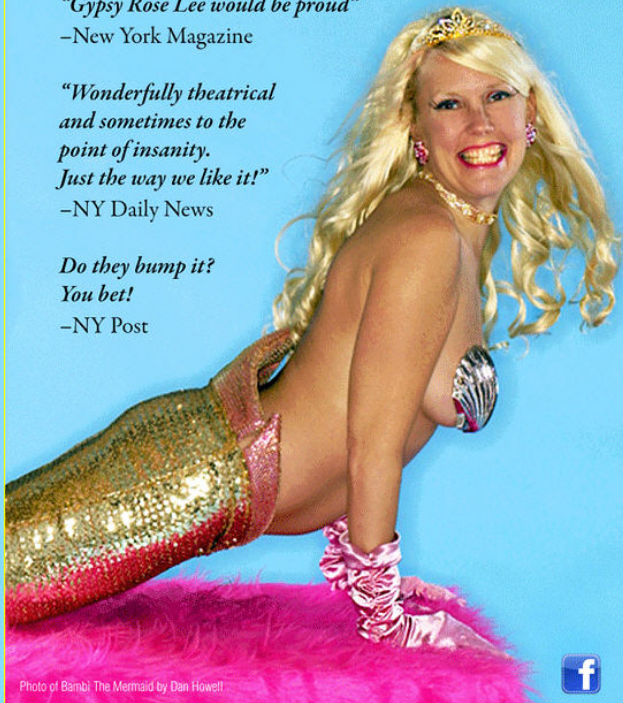


Photo of Bambi The Mermaid by Dan Howell

## CONEY ISLAND IN NEW YORK CITY SPECTACULAR!

SATURDAY OCTOBER 6TH, 10:00 PM

TRIAD THEATER, NYC

158 West 72nd Street, between Columbus & Amsterdam Avenues

### A DOZEN GREAT ACTS!

**MISS HARVEST MOON**

"The Sultry Siren of Burlesque"

**EKATERINA**

Contortionist

**NASTY CANASTA**

"The Girl with the 44DD Brain"

**JUSTINA FLASH**

Hula Hoop Artist

**TIGGER!**

The first ever Mr. Exotic World

**THE GREAT THROWDINI**

Holder of 36 World's Records!

**BAMBI THE MERMAID**

"Queen of Coney Island"

**THE GREAT FREDINI**

Coney Island Sword Swallower

**SCOTT BAKER**

"The Twisted Shockmeister"

**GRACE GOTHAM**

"Humor's Favorite Temptress"

**CHERRY LA VOIX**

Burlesque Star

**JULIET JESKE**

Comedian, Singer, New Yorker

Hosted by **SHELLY WATSON**

DANGRRR DOLL, Stage Kitten DAVID BISHOP, Stage Manager

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THE MAINE ATTRACTION  
SAT, NOVEMBER 3RD

### PRESS

Gotham Burlesque  
featured in:  
The New York Times  
New York Magazine  
Time Out NY

### BURLESQUE-A-PADES

FRIDAY NIGHTS AT 10:00  
STARTING FRIDAY, OCT. 12TH



STARRING  
**ANGIE  
PONTANI**  
SOHO  
PLAYHOUSE  
NYC



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