



**Chippendales' collar and cuffs mark fails to get an encore**  
**United States - Silverberg Goldman & Bikoff**  
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Examination/opposition  
 Trade dress  
 National procedures

In *In Re Chippendales USA Inc* (Case 7866598, March 25 2009), in a divided, precedential opinion, the Trademark Trial and Appeal Board (TTAB) has affirmed a decision of the US Patent and Trademark Office (USPTO) in which the latter had denied Chippendales USA Inc's application to register its collar, bow tie and cuffs attire as a trademark.

On July 8 2005 Chippendales filed an application with the USPTO to register the collar and cuffs mark for "adult entertainment services, namely exotic dancing for women". Chippendales had previously obtained a registration for the trademark (Registration 2694613) based on a claim of acquired distinctiveness under Section 2(f) of the Lanham Act; that registration is incontestable. However, the examining attorney rejected the latest application for lack of inherent distinctiveness. Chippendales appealed to the TTAB.

The TTAB applied the relevant factors from *Seabrook Foods v Bar-Well Foods Inc* (568 F2d 1342 (CCPA 1977)). It did not address the commonality or uniqueness of the actual shape or design of the trade dress itself, but focused on whether use of the collar and cuffs mark was novel in the adult entertainment industry when it was introduced in 1979. The TTAB found that the collar and cuffs mark was not iconic, likening it to other items of clothing typically worn by adult entertainers. The TTAB emphasized the popular use of costumes in the adult entertainment industry, pointing to multiple sales outlets for provocative costumes, including one that features the components of the collar and cuffs mark.

The TTAB also rejected the argument that the mark was novel at the time it was introduced, citing evidence supplied by Chippendales' expert witness, Dr Rachel Shteir, which suggested that the mark had been inspired by the Playboy 'bunny' outfit.

The crux of Shteir's testimony (ie, that the services marketed by Chippendales were revolutionary at the time they were introduced and that the mark immediately achieved an iconic status) was rejected by the TTAB. As the majority noted, Shteir was not an expert in trademark law. At best, her testimony might be used to show acquired distinctiveness. The TTAB held that "the focus of the service at its inception was the bodies of the performers, not the particulars of their minimal attire".

The dissent disagreed with the majority's assessment, holding that the mark was both iconic and a source indicator. The dissent was persuaded by Chippendales' argument that the mark was novel at the time it was introduced, because the service that Chippendales offered (ie, adult entertainment marketed to women) was novel and innovative at that time. The dissent also reasoned that the availability of revealing costumes on the market was not relevant to clothing worn in the adult entertainment industry.

The dissent also disagreed with the majority's rejection of Shteir's testimony. It found her testimony as to the novelty of the mark, the mark's use at Chippendales' establishments and subsequent copies of the mark used by competitors to be persuasive evidence of the mark's inherent distinctiveness. The dissent pointed to newspaper articles from 1979 in which the components of the collar and cuffs mark were described as a trademark and declarations submitted by Chippendales attesting to the market presence of the mark.

The dissent also noted that the examining attorney presented no evidence that clothing items similar to the components of the mark had been used in the adult entertainment field. Use of common items of clothing or costumes in the adult entertainment industry was irrelevant to whether the mark was inherently distinctive. The dissent added that the fact that ordinary waiters wear collars and cuffs was also irrelevant. Finally, the dissent criticized the majority for holding that the mark might have been taken from the Playboy bunny, especially when the service at issue - adult entertainment marketed to men - was different.

Nevertheless, the majority held that the mark was not inherently distinctive, rejecting the argument that it was innovative, iconic and capable of source identification.

The TTAB thus continues to hold the bar high for registration of trade dress and other non-traditional marks. In this case, historical and cultural significance was insufficient to meet the high burden required to show inherent distinctiveness in an application to register trade dress.

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