

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:)	
WebGroup Czech Republic, A.S.)	Trademark Examining Attorney
)	Anna C. Burdecki
Serial No.: 79285885)	
)	
Filed: December 5, 2019)	Law Office: 108
)	
Mark: XVIDEOS)	

RESPONSE TO OFFICE ACTION

This Response pertains to the Office Action dated May 27, 2020, with a mailing date of June 29, 2020. The Office Action raised the following issues:

- Partial Section 2(e)(1) Refusal – Merely Descriptive (Class 41 Only)
- Section 2(f) Suggested as to Class 41 Services (Advisory)
- Request to Divide Class 41 Services (Advisory)
- Amendment to Identification of Goods and Services Required

Merely descriptive refusal

The Examining Attorney issued a partial Section 2(e)(1) refusal, pertaining to Class 41 only. The Examining Attorney also issued a Section 2(f) advisory, stating that Applicant may amend the application to assert a claim of acquired distinctiveness as to Class 41 services under Trademark Act Section 2(f) based on ownership of active U.S. Registration Nos. 4341707 and 5198416. Accordingly, Applicant is asserting a Section 2(f) claim as follows: **“The mark has become distinctive of the Class 41 services as evidenced by the ownership of active U.S. Registration No. 4341707 and No. 5198416 on the Principal Register for the same mark for sufficiently similar services.”**

Amendment to Identification of Goods/Services

The Examining Attorney advised that the identification of goods/services must be amended. Applicant requests amendment of the goods/services to read as follows:

Class 3: Beauty care cosmetics; *cosmetic* soaps; perfumery; essential oils; ~~*cosmetic massage gels, fluids and oils for enhancing sexual stimulation*~~ **non-medicated stimulating cosmetic massage gels, fluids and oils for personal use on and care of intimate parts of the body**

NOTE: Regarding Class 3, Reg. 5849099 DUREX & Design covers “non-medicated cleansing preparations for personal use on and care of intimate parts of the body” in Class 3, and Reg. 6209832 BB BLESSED BODY SKINCARE ESSENTIALS & Design covers “ Non-medicated stimulating lotions for the skin” in Class 3. Accordingly, Applicant believes that the phrase “non-medicated

stimulating cosmetic massage gels, fluids and oils for personal use on and care of intimate parts of the body” can be deemed acceptable within Class 3.

Class 5: Pharmaceutical preparations **for the treatment of sexual dysfunction; Pharmaceutical preparations for enhancing sexual performance**; disinfectants; health care products **NAMELY, medicinal herbal preparations, medicinal oils, medicinal tea**; potency-enhancing preparations **being pharmaceutical preparations for enhancing sexual arousal**; potency-enhancing **DIETARY, Vitamin and nutritional** supplements; **household** deodorants; medical sexual aids **being pharmaceutical preparations for enhancing sexual arousal**; lubricant gel **being gels for use as personal lubricant**; orgasm creams; orgasm sprays **and** orgasm gels **being topical preparations for enhancing sexual arousal**; aphrodisiacs **in the nature of sexual stimulant gels, sprays, and creams**; personal sexual lubricating oils **being personal sexual lubricants**; **contraceptive preparations in the nature of** creams and suppositories; **pharmaceutical** preparations for **increasing** physical **sexual** invigoration and for increasing **sexual** potency

Class 10: Vibro-massagers **being massage apparatus**; hygienic rubber goods **being contraceptive apparatus**; condoms; **adult** sexual **stimulation** aids **for** increasing sexual stimulation, **namely, artificial penises, penis enlargers, vibrators, benwa balls, artificial vaginas**; massage apparatus for beauty care; mechanical **contraceptive apparatus**; erotic articles for immediate application to the body **being adult sexual stimulation aids, namely**, functioning representations of human body parts and sex organs, **Love-bullets bullet-shaped vibrators**, dildos, **and** penis rings.

Class 18: Leather and imitation leather; whips

Class 25: Clothing, **namely, lingerie, hosiery, stockings, garters, brassieres, panties, shirts, jackets, pants, shorts, skirts, dresses, slippers, footwear, hats, socks**; sexy underwear; intimate wear, **namely, hosiery, stockings, garters, brassieres, panties, shirts, jackets, pants, shorts, skirts, dresses, slippers, footwear, hats, socks**; clothing of lacquer, leather and imitations of leather, **namely, lingerie, hosiery, stockings, garters, brassieres, panties, shirts, jackets, pants, shorts, skirts, dresses, slippers, footwear, hats, socks**; footwear for women; men's shoes; headgear **being headwear**; bodysuits; ladies' underwear; men's underwear

Class 41: Entertainment services, namely, providing a web site featuring photographic, audio, video and prose presentations featuring adult-oriented content

Conclusion

Applicant believes that all outstanding issues have been addressed, and respectfully request approval of the application for publication.

Dated: December 22, 2020

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