

copyright and trademark blog by New York and New Jersey attorney Ronald Coleman

LIKELIHOOD OF CONFUSION®

ron coleman's blog on trademark, copyright, internet law and free speech



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The question of LIKELIHOOD OF CONFUSION is the signal **test** to determine if a trademark infringement claim is valid. This blog is about trademark law, copyright law, free speech (mostly as it relates to the Internet) and legal issues related to blogging.



As for me, I'm Ron Coleman, a **trademark lawyer** in New York. More precisely, I'm a **commercial litigator**, business attorney and "IP maven" with a special interest in copyright and trademark infringement involving the Internet-- including advising clients

how to avoid them. I am also a **writer** and notional general counsel of the largely notional **Media Bloggers Association**. My firm, **Goetz Fitzpatrick LLP**, has offices in New York and New Jersey. I'm also a contributor to a few other blogs, including **Dean's World**.

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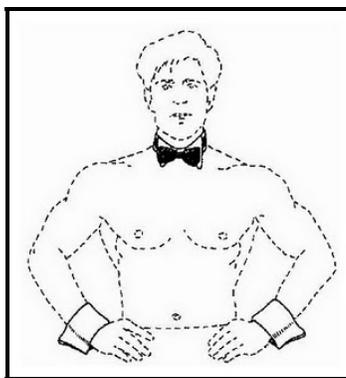
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Tackiness not grounds for refusal to register

December 1st, 2008 by [Ron Coleman](#) | [Print](#)

Otherwise, why would **John Welch** be reporting this appeal?:

“ **December 4, 2008 – 10 AM: In re Chippendales USA, LLC, Serial No. 78666598** [Refusal to register the apparel configuration shown below for "adult entertainment services, namely exotic dancing for women in the nature of live performances" on the ground that the design is not inherently distinctive].



Frankly we would have relied on tackiness for the refusal if we were the PTO, because when we see this classy outfit we think "Chippendales" every time. "Inherently distinctive?" I'd say!

Then again, that's how we worked our way through law school, so we're biased. (UPDATE: Marty raises an eyebrow — obviously doesn't remember what **LIKELIHOOD OF CONFUSION®** himself used to look like.)

More interesting is the concept of apparel configurations as the subject matter of a trademark. Indeed, as the **applicant's brief** by friend **Stephen Feingold** (of our former firm **Day Pitney** — didn't realize he'd handled my favorite **Yiddish IP case!**) makes clear, that question is indeed a matter of first impression.

As the brief explains, TMEP 1301.02(c) provides for registration of a "three-dimensional costume design . . . for entertainment services." In other words, clothes worn as a costume, not as "apparel" per se, are clearly amenable to protection as a trademark. The question appears to be whether a "configuration" of apparel such as that in the illustration constitutes a "costume" — i.e., whether the concept of using a costume to portray a particular character (Mickey Mouse, the San Diego Chicken) can be extended to a situation where, here, there is a concept, but not an identifiable, specific persona meant to be evoked.

To prove that it does, Chippendale's creatively secured the services of **Rachel Shteir**, the director of DePaul University's theater school and a leading historian of American burlesque theater. She testifies that the Chippendale's costumes are associated with "iconic characters," larger-than-life, recognized "types" that target audiences have no hesitation identifying. That, Chippendale's argues, is exactly the case here, and that is why the outfit is inherently distinctive.

We like the argument, though Chippendale's goes on to suggest that the actual legal ground for registration here should be a more technical one, but applying Shteir's analysis — namely the enunciation of a new, post-**Samara** test for inherent distinctiveness of costumes that allows for

FRIEND.

The term of art *maven* is used to mean "wise guy" here and is not meant to suggest that I have certified or other "expertise" in any particular field of legal practice. But try me.

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analysis of the target audience's receptiveness to recognition of such icons by the use of recognized costumes.

Very nicely tailored!

UPDATE: Ryan Giles takes **adds a few stitches**.

UPDATE: Oh this item is really threading its way across the IP Blawgosphere! **Rebecca Tushnet**:

“ If the fact that the torso wearing the collar and bow tie is unclothed is not part of the mark, then any man in an outfit with cuffs and a bow tie is copying the Chippendale's mark. One might respond that lack of confusion will generally avoid infringement, but is that really how we want to think about it? ”

Ironically I didn't want to think about hardly any of this!

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This entry was posted on Monday, December 1st, 2008 at 4:25 pm and is filed under **Brand Management and Branding, Trademark Law**. You can follow any responses to this entry through the **RSS 2.0** feed. You can **leave a response**, or **trackback** from your own site. Tagged as: **Costumes, Distinctiveness, PTO Practice, Trademark Law**

8 Responses to "Tackiness not grounds for refusal to register"

1. **J Welch** Says:

December 1st, 2008 at 6:09 pm



The TMEP is not the law, and so Applicant's heavy reliance on the TMEP may or may not bear fruit.

The PTO concedes that the configuration is "packaging" rather than "product" configuration, and therefore that the configuration may be inherently distinctive. However, the PTO argues that, under the Seabrook test, the design is not inherently distinctive.

Perhaps the Chippendale "uniform" has acquired distinctiveness (at least in Ron's eyes), but is it inherently distinctive? That is the question.

JLW

2. **Ron Coleman** Says:

December 2nd, 2008 at 12:25 am



Well, "J," they are definitely pushing for a new rule of law — not a rejection of previous standards but an elaboration of an existing basic principle, recognizing trademark in costumes but extending it to this concept of iconic imagery.

My problem is that to escape mere acquired distinctiveness as you suggest they would, it seems, have to show that the "icon" was there before their use of the trademark. After all, the burlesque theater analogy seems to imply a shared cultural recognition of the character being conjured up by the costume.

Perhaps, therefore, in order to succeed and to demonstrate inherent distinctiveness they need to show something that it is not obvious to me in the record: That the icon they are relying on, the "Chippendale Man," predates the use in commerce or at least the period during which secondary meaning in the source begins to adhere?

Yet if they do that, are they opening themselves up to a mere descriptiveness problem, if other users can show either that the imagery is not only allusive to the Chippendale Man but the Male Stripper Man in general, and that this icon began to coalesce culturally within this target audience before secondary meaning was achieved by the applicant? (There does not seem to be a problem here of a challenge by another would-be user, though I did not look hard at the docket.)

I hope the above is not too ridiculous. It is actually an analytical approach suggested to me by one of the Chippendale boys after the early show tonight, but he'd already done two shifts, so it might not have been his best abstract doctrinal work.



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UPDATE: I think Ryan Giles focuses on this issue on [his post](#).

3. **Tim** Says:

December 3rd, 2008 at 10:16 pm



Can one of you help me...I'm a confused Trademark student.

If they already have protection under 2(f) – and I visited the website, they have a section about their trademark policies that's quite impressive...anyway, I'm confused as to why a company who already has protection for this particular trademark using acquired distinctiveness (or as I learned it secondary meaning) would attempt to do it again, ever, but especially when it's a difficult road?

I am positive I am either forgetting something I already learned and just haven't studied again...or am missing something completely obvious...any help would be much appreciated.

4. **J Welch** Says:

December 4th, 2008 at 2:12 pm



Good question, Tim, particularly in light of the fact that the 2(f) registration is now incontestable. Perhaps by obtaining a new registration based on inherent distinctiveness, Chip won't have to worry about a challenge to its first registration based on fraud — e.g., a claim that its original 2f evidence was, shall we say, dubious. [I am not implying that its evidence was tainted, but just trying to come up with a rationale.]

As to the term "secondary meaning," I think that phrase best applies to word marks, since words have "meaning." The phrase does not fit quite so well for a mark like the Chippendales "costume." Also, the statute speaks in terms of acquired distinctiveness, not secondary meaning.

J

5. **Ryan** Says:

December 5th, 2008 at 2:27 am



There is a school of thought that sees a Section 2(f) registration as tantamount to an substantive admission that the mark is still fundamentally "descriptive" of the goods and services—and thus, ultimately prone to attack on the basis that the evidence submitted to show acquired distinctiveness was inadequate (similar to John's thoughts). See *Aromaticque, Inc. v. Gold Seal*, 28 F.3d 863, 869, 31 U.S.P.Q.2d 1481 (8th Cir. 1994) ("The submission of evidence under Section 2(f) to show secondary meaning, in either ex parte proceedings (such as an application to register a trademark) or subsequent oppositions, amounts to a concession that the mark sought to be registered is not inherently distinctive."); *Yamaha Int'l Corp. v. Hoshino Gakki Co., Ltd.*, 840 F.2d 1572, 1580, 6 U.S.P.Q.2d 1001 (Fed. Cir. 1988) ("[S]eeking registration under Section 2(f) is not unlike an affirmative defense to a showing by the opposer (or a concession by the applicant) that the applicant otherwise is not entitled to a trademark for one of the reasons listed under Section 2(e)."); *Westchester Media Co. L.P. v. PRL USA Holdings, Inc.*, 103 F. Supp. 2d 935 (S.D. Tex. 1999) (a registration issued for goods or services under sec. 2(f) a concession that the mark is not inherently distinctive).

That's why some trademark practitioners who file Section 2(f) declarations will add something on the record that the submission of the declaration is not intended to be an admission or concession that the mark is descriptive. See *In re E.S. Robbins Corp.*, 30 U.S.P.Q.2d 1540 (T.T.A.B. 1992) (An amendment to an application that adds an alternative claim of acquired distinctiveness under Section 2(f) is not an admission that a mark lacks inherent distinctiveness, provided the amendment makes it clear that the applicant maintains that the mark is inherently distinctive and benefits of Section 2(f) are claimed "without prejudice.").

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Of course, as I think the Chippendales brief noted somewhere during prosecution, the TMEP does not view a Section 2(f) declaration as a substantive concession, but rather a procedural one. See TMEP 1212.02(b) "Section 2(f) Claim Is, for Procedural Purposes, a Concession that Matter Is Not Inherently Distinctive":

"For procedural purposes, a claim of distinctiveness under sec. 2(f), whether made in the application as filed or in a subsequent amendment, may be construed as conceding that the matter to which it pertains is not inherently distinctive (and thus not registrable on the Principal Register absent proof of acquired distinctiveness). . . . However, claiming distinctiveness in the alternative is not an admission that the proposed mark is not inherently distinctive. TMEP sec. 1212.02(c)."

6. **Ron Coleman** Says:
 December 5th, 2008 at 2:38 am



Just telling you guys I *don't* pay commenters!

Except compliments, I guess. Thanks for classing up the joint with all your trademark learnin'!

7. **ReibLaw Blog » Blog Archive » Registrability of Chippendales Bow-Tie and Cuffs?** Says:

December 6th, 2008 at 12:11 pm

[...] If Ron Coleman says that he worked his way through Law School as a Chippendales dancer, who am I doubt him. The story (and commentary) continues here. [...]

8. **Steve Feingold** Says:
 December 7th, 2008 at 2:11 am



Tim, there are actually two answers to your question. First, as I explained at length in the LasVegasTrademarkLawyer blog, with respect to the registration under 2(f) that is now incontestable, we made that argument back in 2001 in the alternative based on the provision in the TMEP that says that in the case where the examiner finds that the mark can proceed to publication under 2(f) but rejects the claim of inherent distinctiveness he should issue a final refusal so that the applicant can decide whether to appeal or accept the 2(f).

The examiner here failed to do that; something we only realized when the certificate arrived (I've since learned that the publication notice never indicates 2(f) on it). Well, at that time we had just commenced an action against a slot machine called Chickendales that had dancing chickens wearing the cuffs and collar. So we were not going to request that the PTO vacate the registration and remand back to examination. We simply refiled — who ever thought it would take this long to get to the appeal?

Second, and probably more to the question you are asking, several times over the last few years when we have written to an infringer providing goods or services not within the ambit of the recitation, the response has been that the 2(f) notation means that we have no rights outside of that area without proving secondary meaning in a new market place. I strongly disagree with that argument if the infringement is happening in an area of related commerce but when you are dealing with a non-trademark lawyer who is responding because he is friends with the infringer (as often happens when you are going after small companies that just "can't believe that in America you can stop me from doing that") being right is just not enough to avoid undue expense.

PS

And just for the record, until John raised the theoretical possibility that we were concerned about some type of fraud challenge, I had never even considered that idea. I have had times when I have been asked to consider what to do about a registration that was perhaps subject to a fraud challenge but thankfully never for a client where I filed the application (as I have for each application filed for Chippendales since 2000).

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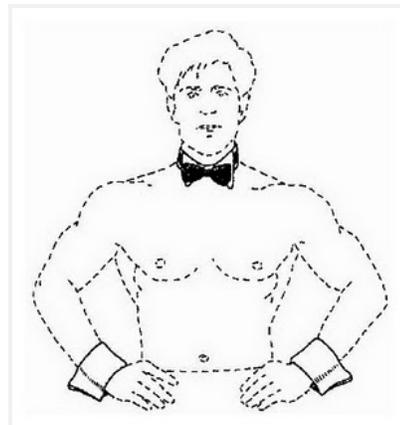
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Chippendales shimmyes up to the Circuit

December 1st, 2008 by [Ron Coleman](#) | [Print](#)

Hot (if unlike LIKELIHOOD OF CONFUSION® you go for that sort of thing) off the presses — **here's the appellate brief** in the Chippendale's appeal of the Trademark Trial and Appeal Board's affirmation of *In re Chippendales USA, LLC*, in which the PTO refused to register the "apparel configuration" shown at right for "adult" "entertainment" "services," on the ground that the design is not inherently distinctive. I first rounded up reaction to the case, and offered my own thoughts, **here**. Scroll down to the comments at that post and see what real trademark lawyers — I don't mean my own bad self — really sound like when they're mixing it up on esoteric (that's esoteric, not "exotic") doctrine.



I haven't read the new brief, by **Stephen Feingold** (now at Kilpatrick Stockton) and **Michelle Graham**, but it does appear that I was onto something perhaps when I wrote, in a **comment**,

Well, they are definitely pushing for a new rule of law — not a rejection of previous standards but an elaboration of an existing basic principle, recognizing trademark in costumes but extending it to this concept of iconic imagery.

Chippendales does, in fact, ask the Federal Circuit to declare that not only did the TTAB fail properly to apply the test for inherent distinctiveness set out in *Seabrook Foods, Inc. v. Bar-Well Foods, Ltd.*, 568 F.2d 1342 (C.C.P.A 1977), but that it probably should be **chucked all together**:

The repeated failure to utilize the thirty-year-old Seabrook standard in the above inquiry demonstrates that the standard is so elusive when applied to costumes, as a practical matter, that the examiners making this decision often use every possible excuse to avoid the question altogether. When such determinations are made, they are based on a highly subjective view of the non-traditional mark causing tremendous inconsistency and unpredictability. Even if the current standard were evenly applied, it is appropriate for this Court to consider the impact of Wal-Mart Stores v. Samara Bros., 529 U.S. 205 (2000) on this issue.

The Supreme Court in Wal-Mart made clear that the focus of the inherent distinctiveness determination should not be the particulars of the design, but rather on the context in which consumers come into contact with the mark. Wal-Mart, 529 U.S. at 212-13. The Supreme Court expressly rejected the Seabrook test for evaluating whether product configurations were inherently distinctive noting in part that the test was simply too difficult to apply. Id. at 213. While Wal-Mart did not address the usefulness of the Seabrook test for determining whether a particular trade dress was inherently distinctive, this case is a compelling example of just how elusive that test is, at least when applied to non-traditional trade dress. But even if the test were not elusive, it looks to factors that do not accurately predict when a consumer is predisposed to perceive that a particular designation is an indicator of source.

Heavy stuff — considering. If you go for that kind of thing.

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One Response to "Chippendales shimmies up to the Circuit"

1. **Ron Coleman** Says:
October 22nd, 2009 at 11:10 am

Chippendales shimmies up to the Fed. Cir. — brief in cuffs-n-collar TM case urges new law <http://bit.ly/1xuOry> LIKELIHOOD OF CONFUSION®

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Chippendales cuffs-and-collar TM "distinctiveness" claim goes "gently" into that dark night

October 3rd, 2010 by [Ron Coleman](#) | [Print](#)

Reuters reports on a high-class trademark story I've been following since my own dancing days:

"The male erotic dancer company Chippendales stumbled on Friday when an appeals court ruled that it could not trademark [sic] the bow tie and shirt cuffs that the men wear. The US Court of Appeals for the Federal Circuit said in a ruling which included a sketch of a fit gentleman shown from the waist up wearing only a bow tie and shirt cuffs that the US Patent and Trademark Office was correct in refusing to trademark [sic] the Cuffs and Collar costume."

"A fit gentleman"? Fit? Yes, certainly. But "gentleman"?

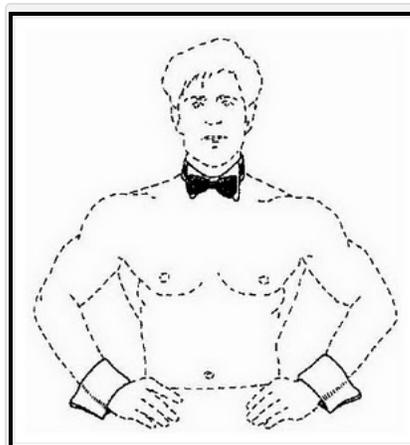


Well, "gentleman" has long ceased to mean "gentleman," after all. I hear radio actualities where the cop says, "Then the gentleman proceeded to pistol-whip the granny and proceeded down toity-fifth street where he encountered the officers and was apprehended."

And then, of course, there's the "gentleman's club," inside of which the one thing you are not likely to encounter is, I can only speculate, a gentleman. There are **websites like that too**, I hear.

But more on that sort of thing shortly.

Yes, of course this "fit" bloke is a "gentleman": Didn't you read what the story said? Look what he's wearing:



Not an inherently distinctive trademark. Not that there's anything wrong with that.

A bow tie! And detachable collar and French cuffs! Sure, the collar and cuffs are attached to nothing but air, but still — what could be more gentlemanly than that?

Which is all very well and good... but evidently not enough to constitute protectible **inherent distinctiveness** [[see below re this correction -- RDC](#)]. Sliding in half a day ahead of me, **Patently-O** explains **why** (and provides a [link to the opinion, here](#)):

//

FRIEND.

The term of art **maven** is used to mean "wise guy" here and is not meant to suggest that I have certified or other "expertise" in any particular field of legal practice. But try me.

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“ In particular, the Board noted that strippers often wear revealing would-be professional costumes such as a stethoscope, utility belt, or chaps with a ten-gallon hat. In this case, the Chippendales Cuffs & Collar costume appears directly derived from a Playboy Bunny costume [which also features a bow tie, detachable collar and French cuffs attached to nothing]. Based on these facts, the Board held that the Chippendales outfit failed the test for inherently distinctive trade dress outlined in Seabrook (CCPA 1977).

On appeal, the Federal Circuit first looked to determine whether the costume is part of the product design or only product packaging. That distinction is legally important because of the Supreme Court ruling in *Wal-Mart v. Samara Bros* (2000) that product design is never inherently distinctive. Here, the court held that the costume is product packaging — with the product being “adult entertainment services.” . . .

Here, the Appellate Court rejected the Board’s implicit holding that no costume on an adult entertainer could be inherently distinctive. However, the Appellate Court agreed with the Board that the Cuffs & Collar costume was a “mere refinement” of the well-known Playboy Bunny costume. As a result, the Cuffs & Collar costume failed the third Seabrook element and therefore lacks inherent distinctiveness.

Well, if “gentleman” doesn’t mean what it once did, don’t get me started on “adult” . . .

Either way, though, getting aced out by the Bunnies — that’s got to hurt. I do feel somewhat vindicated by the ruling rejecting the proposition that “no costume on an adult entertainer could be inherently distinctive.” Because I think I said something like that in my original post on this topic, or the comments to it.

Either way, it appears that the Chippendales boys are going to have to dance their way into the sunset, and the hearts of middle-aged women everywhere, without the coveted circle-R prestige that comes with “inherent distinctiveness.” Sorry . . . gentlemen.

UPDATE: Speaking of gentlemen — see [Welch at the TTABlog](#) on this story, and the comments here.

Then see the gentlemen below!!



Now that is class!

9 retweet

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10 Responses to “Chippendales cuffs-and-collar TM “distinctiveness” claim goes “gently” into that dark night”

1. **Steve Feingold** Says: October 4th, 2010 at 9:36 am



Ron, Unfortunately, many bloggers and the press are ignoring the fact that Chippendales does own a registration for the Cuffs and Collar under 2(f) based on acquired distinctiveness. The Federal Circuit’s opinion is limited to the question of whether the Cuffs and Collar unifor is inherently distinctivce. While Chippendales is disappointed by the decision, we will continue to enforce our



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rights as we have for many years relying on our incontestable registration for this trade dress.

One other note of interest to the Trademark Bar. The Federal Circuit held it could take judicial notice of a registration not otherwise in the Record. I believe that this is a position that many have argued to the TTAB without success in the past.

2. **Erik Pelton** Says:

October 4th, 2010 at 9:52 pm



Steve,

I also found the "judicial notice" aspect quite interesting. I hope the TTAB will follow; it has always seemed logical to me that the Board should be able to take judicial notice of official publicly available government records from its own agency.

3. **John L. Welch** Says:

October 5th, 2010 at 2:44 pm



It is amazing how the main stream press whooped it us about Chippendales not be able to "trademark" its costume. Does anyone out there have a clue?

As to the judicial notice point, what difference does it make whether the Playboy outfit was registered or not? Lots of marks are registered but are in minimal use. The key is how well known the bunny outfit is/was, not whether there are registrations. Taking judicial notice that registrations exist proves nothing.

4. **Michael Feigin, Patent Attorney** Says:

October 6th, 2010 at 9:57 am



Steve, are you the Attorney for Chippendales?

5. **Mito Uwodzenie** Says:

October 6th, 2010 at 1:33 pm



Heh, i think in gentleman's club "gentelmen" not only seating and make very intelligent discussion 😊

For this day, gentelmen doesn't mean the same what 50 years ago.

I have ask, gentelman is because he is wear like gentelman, or because he has got behavior gentelman...

6. **Ron Coleman** Says:

October 7th, 2010 at 9:29 am



Well, the mainstream press can be excused for being sloppy about trademark law (I suppose — I haven't excused them myself), but your humble blogger can't for just parroting what they wrote. My apologies to you and your client, Steve, and to anyone else who was misled on the point. Given my track record, however, I do not concede that any reliance on bloggy representations here (as opposed to the kind I am paid to make or which are otherwise governed by professional ethics) is ever reasonable.

A non-sloppy (i.e., reliable) blogger is Dennis Crouch, who explained the obvious procedural question that was the basis of my own confusion — namely, how, if you've got an incontestible registration, could this issue even have been before the TTAB? — in the post I linked to above:

"This case arose in 2005 when Chippendales requested a new registration for the same mark based upon its inherent distinctiveness. (The company wanted to strengthen its mark.) The Trademark Trial and Appeal Board ruled against Chippendales — finding that the mark was not inherently distinctive."

Ron Coleman on Copywrong
NY Patent Attorney on Copywrong
Michael J. Feigin, Patent Attorney on Clever is as clever shifts fees
Ron Coleman on SUPER BOWL® time!!
Brett on SUPER BOWL® time!!

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Patiently explained here.

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So there you go. Chippendale's does, indeed, have an incontestible registration. Just not the one that was up on appeal.

At least as interesting for non-specialists, by the way, is this inquiry — and the subsequent responses — in an earlier comment string on this blog:

“ Can one of you help me...I'm a confused trademark student.
*If they already have protection under 2(f) ["acquired distinctiveness"] – and I visited the website, they have a section about their trademark policies that's quite impressive...anyway, I'm confused as to why a company who already has protection for this particular trademark using acquired distinctiveness (or as I learned it secondary meaning) would attempt to [seek registration of the mark as inherently distinctive] again, ever, but especially when it's a difficult road?

I am positive I am either forgetting something I already learned and just haven't studied again...or am missing something completely obvious... any help would be much appreciated.*

See here for the whole post, and the comments...

Agreed too on the “judicial notice” point, which also has in the past been discussed here.

7. **Nils Montan** Says:
October 7th, 2010 at 9:47 am



I am worried about too many male members of the distinguished trademark bar spending so much time in male strip clubs. Gentlemen, there are a lot of nice clubs out there where women remove their clothing too. Let's give equal time to the ladies.

Does anyone know of any trademark cases involving female strip clubs?

8. **Ron Coleman** Says:
October 7th, 2010 at 9:59 am



Nils, I am sure someone does, but a gentleman would not say.

9. **Peter S. Sloane** Says:
October 7th, 2010 at 2:00 pm



If the Chippendales registration has already become incontestable, why did it bother to spend the time and presumably money to pursue the appeal on the inherent distinctiveness issue? Whatever benefit it would have gained from claiming inherent distinctiveness does not seem worth the expense of litigation.

10. **James H** Says:
October 7th, 2010 at 6:46 pm



Your video reminded me that we will soon see a unique line of crackers released in Moscow. It will feature the likeness of the Prime Minister. They will be called “Putin on the Ritz.”

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