

ESTTA Tracking number: **ESTTA234003**

Filing date: **09/02/2008**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

### Notice of Opposition

Notice is hereby given that the following parties oppose registration of the indicated application.

#### Opposers Information

Name	Gilmar S.p.A.
Granted to Date of previous extension	09/03/2008
Address	723-725, Via Malpasso San Giovanni in Marignano I, I-47842 ITALY

Name	Seminvest Investments B.V.		
Entity	Corporation	Citizenship	Netherlands
Address	139 Baronielaan PD Breda, 4818 NETHERLANDS		

Attorney information	Dennis H. Cavanaugh D H Cavanaugh Associates 555 Fifth Avenue, 17th Floor New York, NY 10017 UNITED STATES dhc@dhcavanaugh.net
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#### Applicant Information

Application No	77343617	Publication date	05/06/2008
Opposition Filing Date	09/02/2008	Opposition Period Ends	09/03/2008
Applicant	New Line Productions, Inc. 888 Seventh Avenue New York, NY 10106 UNITED STATES		

#### Goods/Services Affected by Opposition

<p><b>Class 018.</b> All goods and services in the class are opposed, namely: Trunks, suitcases and traveling bags; goods made from leather and imitations of leather, namely, athletic bags, baby backpacks, backpacks, beach bags, book bags, diaper bags, duffel bags, gym bags, tote bags, fanny packs, knapsacks, waist packs, shopping bags, pocketbooks, handbags, shoulder bags, cosmetic bags sold empty, attach&amp;eacute; cases, brief-cases, brief-case type portfolios, wallets, billfolds, key cases, coin cases, namely, coin purses, sport bags; umbrellas, sun umbrellas, parasols, small leather and plastic goods, namely, credit card cases, vanity cases sold empty and walking sticks</p>
<p><b>Class 021.</b> All goods and services in the class are opposed, namely: glass, ceramic and earthenware goods, namely, beverage glassware, coffee mugs, mugs, jugs, bowls, plates, coasters, coffee cups and</p>

cups; demitasee sets consisting of cups and saucers; sugar and creamer sets; infant cups; cookie jars; ceramic, glass and china figurines; non-electric coffee pots not of precious metal; wastepaper baskets; ice buckets; plastic buckets; shower caddies; tea caddies; cake molds; scrapers for household purposes, and cake servers; canteens; champagne buckets; plastic coasters, cocktail shakers; thermal insulated containers for food or beverages; cookie cutters, cork screws; corn cob holders; plastic water bottles sold empty; vacuum bottles; decanters; drinking flasks; gardening gloves; rubber household gloves; dinnerware; namely, paper plates and paper cups; brushes, namely, hair brushes, tooth brushes, clothes brushes; kitchen utensils, namely, rolling pins, spatulas, turners, whisks, and kitchen containers, soap containers, household food containers and lunch boxes; plastic cups and plates

### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	1269297	Application Date	06/22/1982
Registration Date	03/06/1984	Foreign Priority Date	NONE
Word Mark	ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1976/06/00 First Use In Commerce: 1976/12/27 T-Shirts, Skirts, Trousers, Shirts, Jackets, and Blazers		

U.S. Registration No.	1850734	Application Date	06/08/1987
Registration Date	08/23/1994	Foreign Priority Date	01/21/1987
Word Mark	ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: CLOTHING; NAMELY, MEN'S, WOMEN'S[ AND CHILDREN'S] SUITS, COATS, [HATS, BLOUSES,] CAPS, SHIRTS, T-SHIRTS, BELTS, VESTS, SCARVES, SKIRTS, TIES, SHORTS, [KNICKERS,] BATHING SUITS, DRESSES, JACKETS, SWEATERS, [JOGGING SUITS AND LOUNGEWEAR, OVERALLS,] JEANS, [NIGHT GOWNS,] PAJAMAS, [SOCKS, STOCKINGS,] KERCHIEFS, UNDERWEAR, SHOES, [BOOTS AND SLIPPERS]		

U.S. Registration No.	1477299	Application Date	11/14/1986
Registration Date	02/23/1988	Foreign Priority Date	06/13/1986
Word Mark	ICEBERG JEANS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use:		

	<p>PERFUMERY, NAMELY PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS</p> <p>Class 018. First use: LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS AND UMBRELLAS</p> <p>Class 025. First use: MEN'S AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MENS' AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS</p>
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U.S. Registration No.	2222782	Application Date	01/16/1998
Registration Date	02/09/1999	Foreign Priority Date	NONE
Word Mark	IJ ICEBERG JEANS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 1994/08/04 First Use In Commerce: 1994/08/04 HANDBAGS, WALLETS</p> <p>Class 025. First use: First Use: 1994/08/04 First Use In Commerce: 1994/08/04 clothing, namely, sweaters, t-shirts, sweat shirts, pants, skirts, knit skirts, jackets, gilets, knit gilets, sport jackets, leather jackets, shorts, blousons, dresses, coats, leather pants, knit scarves, belts, gloves, shoes, cardigans, bodies</p>		

U.S. Registration No.	1477298	Application Date	11/14/1986
Registration Date	02/23/1988	Foreign Priority Date	07/24/1986
Word Mark	ICEBERG SPORT ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: PERFUMERY, NAMELY PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS</p> <p>Class 018. First use: LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS AND UMBRELLAS</p>		

	<p>Class 025. First use:  MENS' AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MENS' AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS</p>
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U.S. Registration No.	3029399	Application Date	05/27/2004
Registration Date	12/13/2005	Foreign Priority Date	05/05/2004
Word Mark	ICE B		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use:  Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attach&amp;eacute; cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks</p> <p>Class 025. First use:  Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers</p>		

U.S. Registration No.	3029400	Application Date	05/27/2004
Registration Date	12/13/2005	Foreign Priority Date	05/05/2004
Word Mark	ICE B ICEBERG		
Design Mark			
Description of Mark	<p>The trademark consists of a dark rectangular device, containing, in the middle, the word ICE written in light fancy characters and the letter B in a fancy character with darker background; in a lower position there is the word ICEBERG in smaller characters with light background written repeatedly and without interruption.</p>		
Goods/Services	<p>Class 018. First use:  Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attach&amp;egrave; cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks</p> <p>Class 025. First use:  Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers</p>		

U.S. Registration No.	1595934	Application Date	02/19/1988
Registration Date	05/15/1990	Foreign Priority Date	09/21/1987
Word Mark	AISBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use:  [ PERFUMERY, NAMELY, PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS AND HAIR LOTIONS ]</p> <p>Class 018. First use:  [ LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS, UMBRELLAS, SHOULDER BELTS ]</p> <p>Class 025. First use:  MEN'S AND WOMEN'S CLOTHING, NAMELY, JACKETS, [ BELTS, NECKWEAR, ] SWEATERS, [ SUITS, ] SHIRTS, BLOUSES, SKIRTS, DRESSES, [ HOSIERY, SCARVES, SHAWLS, MEN'S AND WOMEN'S BLAZERS, COATS, ] JACKETS, [ JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS ]</p>		

U.S. Registration No.	2518973	Application Date	03/17/1998
Registration Date	12/18/2001	Foreign Priority Date	02/09/1998
Word Mark	HISTORY ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use:  Luggage, trunks, traveling bags, purses, [and key holding wallets] of leather</p> <p>Class 025. First use:  Men's and women's clothing, namely, jackets, belts,[ neckties,] sweaters, suits, shirts, blouses, skirts, dresses,[ hosiery,] scarves, [shawls,] men's and women's blazers, coats, jeans, jogging suits, [loungewear,] pantsuits, rainwear, shorts, [slacks, socks, ]sport coats, hats, caps, gloves, kerchiefs, shoes, boots and slippers</p>		

U.S. Registration No.	2909353	Application Date	08/01/1997
Registration Date	12/14/2004	Foreign Priority Date	NONE
Word Mark	SPORT ICE		
Design Mark			
Description of Mark	NONE		

Goods/Services	Class 018. First use: First Use: 1988/09/09 First Use In Commerce: 1989/02/09 handbags, backpacks, fanny packs, tote bags, cosmetic cases sold empty Class 025. First use: First Use: 1988/09/09 First Use In Commerce: 1989/02/01 pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes
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U.S. Registration No.	3303328	Application Date	11/22/2002
Registration Date	10/02/2007	Foreign Priority Date	NONE
Word Mark	ICE ICE BABY ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2005/09/26 First Use In Commerce: 2005/09/26 SHOULDER BAGS, PURSES, HANDBAGS, WALLETS Class 025. First use: First Use: 2005/09/26 First Use In Commerce: 2005/09/26 JACKETS, BELTS, NECKTIES, SKIRTS, BLOUSES, SHIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, COATS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, HATS, CAPS, SHOES, BOOTS		

U.S. Registration No.	2320783	Application Date	09/11/1998
Registration Date	02/22/2000	Foreign Priority Date	NONE
Word Mark	ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 020. First use: [[[ FURNITURE,]] MIRRORS, [[ PICTURE FRAMES,]] PLASTIC AND WOOD BOXES, JEWELRY BOXES NOT OF METAL, CHAIR PADS, [[ FITTED FABRIC FURNITURE COVERS,]] SEAT CUSHIONS, [[ NON-ELECTRIC FANS FOR PERSONAL USE, FIRE SCREENS FOR DOMESTIC USE, FURNITURE PARTS, DECORATIVE MOBILES, SOFT SCULPTURE ]] WALL DECORATIONS] *MIRRORS, PICTURE FRAMES, PLASTIC AND WOOD BOXES, JEWELRY BOXES NOT OF METAL, DETACHABLE CHAIR PADS FOR DECORATIVE HOME USE, DETACHABLE FITTED FABRIC FURNITURE COVERS FOR DECORATIVE HOME USE, DETACHABLE SEAT CUSHIONS FOR DECORATIVE HOME USE, NON-ELECTRIC FANS FOR PERSONAL USE, FIRE SCREENS FOR DOMESTIC USE, DECORATIVE MOBILES, SOFT SCULPTURE WALL DECORATIONS*</p> <p>Class 021. First use: [ HOUSEHOLD OR KITCHEN UTENSILS AND CONTAINERS, NAMELY, TRASH CANS, BREAD BOXES, WINE BUCKETS, PLASTIC BUCKETS; BRUSHES FOR CLOTHES; COSMETIC BRUSHES, NAMELY, EYEBROW, HAIR, NAIL AND SHAVING; ARTICLES FOR CLEANING PURPOSES, NAMELY, BROOMS, NON-ELECTRIC CARPET SWEEPERS, STEEL WOOL FOR CLEANING; PRESSED GLASS, POLISHED PLATE GLASS, ] DRINKING GLASSES; PORCELAIN, NAMELY, PORCELAIN EGGS</p> <p>Class 034. First use: [ TOBACCO, MATCHES, SMOKER'S ARTICLES, NAMELY, PIPES, CIGARS,</p>		

CIGARETTES, CIGARETTE PAPERS, ] GAS LIGHTERS AND ASHTRAYS NOT OF PRECIOUS METAL			
U.S. Registration No.	1813742	Application Date	03/19/1991
Registration Date	12/28/1993	Foreign Priority Date	09/20/1990
Word Mark	ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 020. First use: furniture, mirrors, picture frames, plastic and wood boxes, jewelry boxes not of metal, chair pads, fitted fabric furniture covers, seat cushions, non-electric fans for personal use, fire screens for personal use, furniture parts, decorative mobiles, soft sculpture wall decorations</p> <p>Class 021. First use: household or kitchen utensils and containers; namely, [ trash cans, ] salad bowls, [ bread boxes, wine buckets, plastic buckets; combs; sponges; brushes for clothes, cosmetics, eyebrow, hair, nail and shaving; articles for cleaning purposes; namely, brooms, non-electric carpet sweepers; steel wool for cleaning, pressed glass, polished plate glass, ] glassware; namely, glass beverage ware, glass bowls, [ drinking glasses; porcelain; namely, porcelain eggs, ] earthenware; namely, dinnerware</p> <p>Class 034. First use: tobacco, matches, smoker's articles; namely, pipes, cigars, cigarettes, cigarette papers, gas lighters and ashtrays not of precious metal</p>		

Attachments	73630331#TMSN.gif ( 1 page )( bytes ) 75419252#TMSN.gif ( 1 page )( bytes ) 73630330#TMSN.gif ( 1 page )( bytes ) 79004920#TMSN.jpeg ( 1 page )( bytes ) 79004921#TMSN.jpeg ( 1 page )( bytes ) 73712278#TMSN.gif ( 1 page )( bytes ) 75451595#TMSN.gif ( 1 page )( bytes ) 75334594#TMSN.gif ( 1 page )( bytes ) 75561989#TMSN.gif ( 1 page )( bytes ) ICE BEAR(Classes 18, 21) Opposition.pdf ( 11 pages )(40828 bytes )
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### Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Dennis H. Cavanaugh/
Name	Dennis H. Cavanaugh
Date	09/02/2008

## NOTICE OF OPPOSITION

Pursuant to Trademark Rule 2.102, Gilmar S.p.A., an Italian corporation having an office and place of business at Via Malpasso 723/725, 47842 San Giovanni in Marignano, Rimini, Italy (“Gilmar”), and Seminvest Investments B.V., a Netherlands corporation having an office and place of business at Baronielaan 139, 4818 PD Breda, Netherlands (“Seminvest”) (collectively “Opposer”), believe that they are and will be damaged by registration of the mark shown in Serial Number 77/343,617 in International Classes 18 and 21 oppose the same. As grounds for the opposition it is alleged that:

1. The applicant, New Line Productions, Inc. (“Applicant”) is, upon information and belief, a California corporation with a place of business at 888 7<sup>th</sup> Avenue, New York, New York 10019.

2. On or about December 4, 2007, Applicant filed the above-referenced trademark application to register the mark ICE BEAR for “Trunks, suitcases and traveling bags; goods made from leather and imitations of leather, namely, athletic bags, baby backpacks, backpacks, beach bags, book bags, diaper bags, duffel bags, gym bags, tote bags, fanny packs, knapsacks, waist packs, shopping bags, pocketbooks, handbags, shoulder bags, cosmetic bags sold empty, attaché cases, brief-cases, brief-case type portfolios, wallets, billfolds, key cases, coin cases, namely, coin purses, sport bags; umbrellas, sun umbrellas, parasols, small leather and plastic goods, namely, credit card cases, vanity cases sold empty and walking sticks” in International Class 18 and for “glass, ceramic and earthenware goods, namely, beverage glassware, coffee mugs, mugs, jugs, bowls, plates, coasters, coffee cups and cups; demitasee sets consisting of cups and saucers; sugar and creamer sets; infant cups; cookie jars; ceramic, glass and china

figurines; non-electric coffee pots not of precious metal; wastepaper baskets; ice buckets; plastic buckets; shower caddies; tea caddies; cake molds; scrapers for household purposes, and cake servers; canteens; champagne buckets; plastic coasters, cocktail shakers; thermal insulated containers for food or beverages; cookie cutters, cork screws; corn cob holders; plastic water bottles sold empty; vacuum bottles; decanters; drinking flasks; gardening gloves; rubber household gloves; dinnerware; namely, paper plates and paper cups; brushes, namely, hair brushes, tooth brushes, clothes brushes; kitchen utensils, namely, rolling pins, spatulas, turners, whisks, and kitchen containers, soap containers, household food containers and lunch boxes; plastic cups and plates” in International Class 21 under Section 1(b).

3. Gilmar is a leading Italian fashion company with a strong tradition dating back to the 1960s of creating collections of international prêt-a-porter apparel and jeanswear.

4. In the mid-1970s, Gilmar introduced a new collection of knitwear and sportswear labeled “ICEBERG.” This collection was later enriched with more varied lines of clothing labeled “ICE” alone or with various other formatives.

5. Opposer adopted and has been using the marks ICE, ICEBERG, ICEBERG JEANS, ICE J, ICE B, ICE JEANS, IJ JEANS ICEBERG, ICE HISTORY, HISTORY ICEBERG and SPORT ICE (the “ICE Marks”) in interstate commerce since long prior to December 4, 2007, the date of Applicant’s filing, as trademarks to identify its items of wearing apparel and other goods. Opposer continues to use the ICE Marks to identify its various items of wearing apparel and other goods and such use has never been abandoned. As a result, Gilmar has developed significant common law and statutory rights in the ICE Marks.

6. Gilmar is the owner of the following registrations on the Principal Register of the

U.S. Patent and Trademark Office:

- a. Registration No. 1,269,297 for ICEBERG, issued March 6, 1984, for "T-shirts, skirts, trousers, shirts, jackets and blazers" in Class 25, which registration is valid and subsisting and has never been abandoned;
- b. Registration No. 1,850,734 for ICE, issued August 23, 1994, for "clothing, namely, men's and women's suits, coats, caps, shirts, T-shirts, belts, vests, scarves, skirts, ties, shorts, bathing suits, dresses, jackets, sweaters, jeans, pajamas, kerchiefs, underwear, shoes" in Class 25, which registration is valid and subsisting and has never been abandoned;
- c. Registration No. 1,477,299 for ICEBERG JEANS and Design, issued February 23, 1988, for "men's and women's clothing, namely, jackets, belts, neckwear, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men's and women's blazers, coats, jackets, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sports coats, hats, caps, gloves, kerchiefs, shoes, boots, and slippers" in Class 25, which registration is valid and subsisting and has never been abandoned;
- d. Registration No. 2,222,782 for IJ ICEBERG JEANS, issued February 9, 1999, for "handbags, Wallets" in Class 18 and for "clothing, namely, sweaters, t-shirts, sweat shirts, pants, skirts, knit skirts, jackets, gilets, knit gilets, sport jackets, leather jackets, shorts, blousons, dresses, coats, leather pants, knit scarves, belts, gloves, shoes, cardigans, bodies" in Class 25, which registration is valid and subsisting and has never been abandoned;

e. Registration No. 1,477,298 for ICEBERG SPORT ICE, issued February 23, 1988 in International Classification No. 25 for “men’s and women’s clothing, namely, jackets, belts, neckwear, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men’s and women’s blazers, coats, jackets, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sports coats, hats, caps, gloves, kerchiefs, shoes, boots, and slippers” in Class 25, which registration is valid and subsisting and has never been abandoned;

f. Registration No. 3,029,399, for ICE B, issued December 13, 2005, for “Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attaché cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks” in Class 18 and for “Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers” in Class 25;

g. Registration No. 3,029,400, for ICE B ICEBERG, issued December 13, 2005, for “Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attachè cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks” in Class 18 and for “Clothing, namely, skirts, dresses, suits, pants,

jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers” in Class 25;

h. Registration No. 1,595,934 for AISBERG, issued May 15, 1990 for “men's and women's clothing, namely, jackets, sweaters, shirts, blouses, skirts, dresses, jackets” in Class 25, which registration is valid and subsisting and has never been abandoned;

i. Registration No. 2,518,973 for HISTORY ICEBERG, issued December 18, 2001, for “men's and women's clothing, namely, jackets, belts, neckties, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men's and women's blazers, coats, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sport coats, hats, caps, gloves, kerchiefs, shoes, boots and slippers” in Class 25, and for “Luggage, trunks, traveling bags, purses, [and key holding wallets] of leather” in Class 18, which registration is valid and subsisting and has never been abandoned;

j. Registration No. 2,909,353 for SPORT ICE and Design, issued December 14, 2004, for “handbags, backpacks, fanny packs, tote bags, cosmetic cases sold empty” in Class 18 and for “pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes” in Class 25, which registration is valid and subsisting and has never been abandoned; and

k. Registration No. 3,303,328 for ICE ICE BABY ICEBERG, issued October 2, 2007, for “shoulder bags, purses, handbags, wallets” in Class 18 and for

“jackets, belts, neckties, skirts, blouses, shirts, dresses, hosiery, scarves, shawls, coats, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, hats, caps, shoes, boots” in Class 25, which registration is valid and subsisting and has never been abandoned.

1. Registration No. 2,320,783 for ICEBERG, issued February 22, 2000, for “Furniture, mirrors, picture frames, plastic and wood boxes, jewelry boxes not of metal, chair pads, fitted fabric furniture covers, seat cushions, non-electric fans for personal use, fire screens for domestic use, furniture parts, decorative mobiles, soft sculpture wall decorations, mirrors, picture frames, plastic and wood boxes, jewelry boxes not of metal, detachable chair pads for decorative home use, detachable fitted fabric furniture covers for decorative home use, detachable seat cushions for decorative home use, non-electric fans for personal use, fire screens for domestic use, decorative mobiles, soft sculpture wall decorations” in International Class 20, for “Household or kitchen utensils and containers, namely, trash cans, bread boxes, wine buckets, plastic buckets; brushes for clothes; cosmetic brushes, namely, eyebrow, hair, nail and shaving; articles for cleaning purposes, namely, brooms, non-electric carpet sweepers, steel wool for cleaning; pressed glass, polished plate glass, drinking glasses; porcelain, namely, porcelain eggs” in Class 21, and for “Tobacco, matches, smoker’s articles, namely, pipes, cigars, cigarettes, cigarette papers, gas lighters and ashtrays not of precious metal” in International Class 34, which registration is valid and subsisting and has never been abandoned.

7. In addition to its use of its ICE Marks on clothing products, Opposer has also used and developed significant consumer recognition in one or more of the ICE Marks for various products closely related to clothing, such as cosmetics and fragrances, eyeglasses and sunglasses,

and bags, purses and small leather goods.

8. Seminest is the owner of the following incontestable registration on the Principal Register of the U.S. Patent and Trademark Office: Registration No. 1,813,742 for ICEBERG issued December 28, 1993, for "household or kitchen utensils and containers; namely, trash cans, salad bowls, bread boxes, wine buckets, plastic buckets; combs; sponges; brushes for clothes, cosmetics, eyebrow, hair, nail and shaving; articles for cleaning purposes; namely, brooms, non-electric carpet sweepers; steel wool for cleaning, pressed glass, polished plate glass, glassware; namely, glass beverage ware, glass bowls, drinking glasses; porcelain; namely, porcelain eggs, earthenware; namely, dinnerware" in Class 21, which registration is valid and subsisting and has never been abandoned.

9. Gilmar is the exclusive U.S. licensee of Seminest with respect to use of the mark ICEBERG on Class 21 goods.

10. Products sold, advertised and promoted under and in connection with the ICE Marks have been extensively promoted through print advertising in major fashion and lifestyle magazines distributed in the United States, as well as through selected publicity events, sponsorships and outdoor and co-op advertising. By virtue of said promotional activities and extensive sales, Opposer's products are widely and favorably known throughout the United States, and have become known by the relevant purchasing public as emanating from or being associated with Gilmar.

11. Also as a result of said extensive promotional activities, Opposer's ICE Marks constitute a family of "ICE" marks. "ICE" is the distinctive common element in all of Opposer's ICE Marks. The relevant purchasing public of the Opposer's goods associates the distinctive

common element ICE with Opposer. Opposer has promoted its ICE Marks and the goods sold under them jointly so as to reinforce the public's association of the common ICE element with a single source of origin for Opposer's goods.

12. Opposer has invested substantial time, effort and money in using and promoting its ICE Marks and the goods bearing them. Through such prior use, promotion and advertising, Petitioner has built up a valuable and protectable goodwill associated therewith.

13. Opposer has diligently and successfully acted to enforce its trademark rights alleged herein against third parties.

14. Applicant's filing date of December 4, 2007 is subsequent to many of Opposer's dates of first use of its ICE Marks, and the dates of its registrations thereof. Thus, priority is not at issue.

15. Applicant's mark ICE BEAR is confusingly similar in sight, sound and meaning to Opposer's ICE Marks. Applicant's mark is virtually identical to Opposer's ICE Marks. Consequently, Applicant's mark so closely resembles Opposer's ICE Marks as to be likely to be confused with and mistaken for Opposer's ICE Marks. As a result, there is a significant likelihood of confusion between Applicant's mark and Opposer's ICE Marks.

16. The addition of the term "BEAR" to the Applicant's mark does not avoid a likelihood of confusion because "ICE" is clearly the dominant portion of said mark, and "ICE" is identical to the federally registered trademark ICE owned and used by Gilmar pleaded above.

17. The goods covered by this application will be perceived by consumers as closely related to the clothing and fashion products marketed by Applicant and which are or will be the subject of other pending oppositions. Such clothing and fashion products of Applicant are

closely related and identical to those of Opposer. Thus, a likelihood of confusion may result from registration and use of Applicant's mark. In addition, one or more of Applicant's goods covered by this application are closely related and/or identical to those of Opposer, thus increasing the likelihood of confusion that may result from registration and use of Applicant's mark.

18. Neither Gilmar nor Seminvest is affiliated in any manner with Applicant and they have not authorized Applicant's use or application to register ICE or ICE BEAR.

19. Registration of Applicant's mark is likely to cause the public to be confused, misled or deceived, and to falsely believe that Applicant's goods are affiliated, associated, approved, sponsored, licensed or authorized by Opposer or others authorized or licensed by Opposer to use the ICE Marks. Persons familiar with Opposer's ICE Marks are likely to purchase Applicant's goods believing they are marketed by, affiliated with or endorsed by Opposer, when in fact they are not.

20. Registration of Applicant's mark is likely to cause harm and damage to Opposer and its marks by causing confusion, mistake and/or deception as to the respective rights of the parties and as to the source of the goods marketed and provided under the Applicant's mark, and by constituting a cloud on Opposer's prior established rights in its ICE Marks. Such registration would give Applicant at least a prima facie right to use Applicant's mark, thereby causing continuing serious and irreparable harm to Opposer's rights in its ICE Marks, its business and to the goodwill of such business symbolized by Opposer's ICE Marks. Registration of Applicant's mark will also tend to reduce the distinctiveness, value and goodwill of Opposer's ICE Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of the

Applicant's mark in Classes 18 and 21, Application Serial No. 77/343,617, and opposes registration thereof on the grounds set forth above. Opposer further prays that Application Serial No. 77/343,617 be rejected, and that registration of Applicant's mark therein sought for the goods specified therein in Classes 18 and 21 be denied and refused.

The \$600 fee for two opposers required under § 2.6(a)(17) is being submitted concurrently herewith.

Dated: New York, New York  
September 2, 2008

Respectfully submitted,

GILMAR S.p.A.  
SEMINVEST INVESTMENTS B.V.

/Dennis H. Cavanaugh/

By: \_\_\_\_\_

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Attorneys for Opposers

CERTIFICATE OF SERVICE

DENNIS H. CAVANAUGH, declares that:

1. I am counsel for the Opposer in the captioned action, and that on the execution date which appears below, a true copy of the foregoing was served on Applicant's designated representative for correspondence, by causing the same to be placed in an official depository under the exclusive care and custody of the United States Postal Service, first class mail, postage prepaid, addressed as follows:

Erin S. Hennessy, Esq.  
Time Warner, Inc.  
14<sup>th</sup> Floor  
One Time Warner Center  
New York, NY 10019

2. Pursuant to 28 U.S.C. Sect. 1746, I declare under penalty of perjury that all of the foregoing is true and correct.

Executed on September 2, 2008

/Dennis H. Cavanaugh/  
By \_\_\_\_\_  
Dennis H. Cavanaugh

CERTIFICATE OF MAILING UNDER 37 C.F.R. 1.8

I hereby certify that on September 2, 2008, this correspondence is being filed electronically with the U.S. Patent and Trademark Office.

/Dennis H. Cavanaugh/  
\_\_\_\_\_  
Dennis H. Cavanaugh