

ESTTA Tracking number: **ESTTA315503**

Filing date: **11/05/2009**

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

Proceeding	91191309
Party	Plaintiff David K. Aberizk
Correspondence Address	David Aberizk President, ICI Integrated Consultants, Inc. 1016 First Street Coronado, CA 92118-1335 UNITED STATES daberizk@icpoc.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Barry F. Soalt
Filer's e-mail	docketing@procopio.com, bfs@procopio.com, glj@procopio.com
Signature	/bfs/
Date	11/05/2009
Attachments	glj amended nop.pdf (6 pages)(110677 bytes)

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

In the Matter of Trademark: ICI ICI SERVICES
Serial No.: 77/592,570
File Date: October 14, 2008
Published: July 21, 2009

David K. Aberizk,)	Opposition No. 91191309
)	
Opposer,)	
)	AMENDED NOTICE OF OPPOSITION
vs.)	
)	
ICI Services, LLC,)	
)	
Applicant.)	
)	
)	
)	

**VIA ELECTRONIC SYSTEM FOR
TRADEMARK TRIALS AND APPEAL (ESTTA)**

AMENDED NOTICE OF OPPOSITION

Opposer, David K. Aberizk, an individual, and U.S. Citizen with an address of 1016 First Street, Coronado, California 92118-1335 (“Opposer”) by and through his attorneys, hereby submits this Amended Notice of Opposition opposing registration of the mark ICI ICI SERVICES (Stylized), Serial No. 77/592,570, filed by ICI Services, LLC, a Virginia limited liability company (“Applicant”), with an address of 3800 Fettle Park Drive, Suite 202, Dumfries, VA 22025. The opposed mark was published on July 21, 2009, and Opposer requests that registration of this application be refused.

The Notice of Opposition was filed on August 1, 2009 against the aforesaid pending application in each class of services sought, namely, classes 35, 39, 40 and 42. Leave to file this Amended Notice of Opposition was granted by the Trademark Trial and Appeal Board on October 16, 2009.

The Opposer believes that he will be damaged by registration of the mark shown in the above-identified application, and hereby opposes the same.

As grounds in support of its opposition, Opposer asserts as follows:

1. On October 14, 2008, Applicant filed a use-based service mark application to register the mark ICI ICI SERVICES (Stylized) in International Class 35 for business organization and management consulting services; logistics management services in the field of supply chain management; transportation logistics, namely, arranging the transportation of goods for others; Industrial asset management services, namely, auctioning, liquidating, deploying, disposing and remarketing industrial assets of others; personnel relocation services; business services, namely, facilities management of technical operations; procurement, namely, purchasing hazardous materials and automotive spare parts for others; database management; information and data compiling and analyzing relating to business management; supply chain management services; International Class 39 for warehousing services; distribution services, namely, delivery of mail, technical periodicals, safety information, hazardous materials, automotive spare parts, military spare parts and supplies; packaging articles for transportation; shipping of goods; International Class 40 for decontamination of hazardous materials; and International Class 42 for naval architectural design and marine engineering services; computer compatibility services, namely, data mapping; consulting services in the field of environmental assessment, compliance and planning; testing or research on prevention of pollution; engineering

services for building and property condition assessment, facility management, repair and restoration, building instrumentation and monitoring, and environmental consulting; land use planning services; evaluation and testing of real estate for the presence of hazardous material; database development services; information technology consultation. This aforementioned application was published for opposition July 21, 2009. The date of first use recited in each class of services is June, 2006.

2. Opposer owns the Registered service mark for ICI INTEGRATED CONSULTANTS INCORPORATED, Registration No. 3,107,760, for technical consultation in the field of electrical, mechanical and nuclear engineering, in International Class 42, reciting a date of first use of June 1, 1999. Opposer's registration issued June 20, 2006, prior to the filing date of the complained of application.

3. Opposer's use, filing date, and registration of ICI INTEGRATED CONSULTANTS INCORPORATED in the aforesaid registration occurred long prior to Applicant's first use date and/or filing date in any application for registration of its ICI ICI SERVICES mark, and therefore, Opposer's priority in both use and registration predates any use or constructive use/filing date in Application Serial No. 77/592,570.

4. Opposer has used the mark ICI as a common law service mark in connection with its business for engineering services and technical consultation in the field of electrical, mechanical and nuclear engineering, long prior to any use by Applicant of ICI ICI SERVICES as set forth in its application serial No. 77/592,570. All such use of ICI as a mark by Opposer for the aforesaid services has been continuous through the present date. ICI is also the acronym for Opposer's trade name, as well as the dominant component of its Reg. No. 3,107,760.

5. Opposer's marks, ICI and ICI INTEGRATED CONSULTANTS

INCORPORATED are similar to and each carries the same or similar commercial impression as Applicant's mark, ICI ICI SERVICES or ICI SERVICES. Opposer's services offered under its ICI and ICI INTEGRATED CONSULTANTS INCORPORATED marks include engineering services, technical services, and technical consultation in the field of electrical, mechanical and nuclear engineering services, are closely related to Applicant's services, as recited in its Application Serial No. 77,592,570.

6. Opposer's marks, ICI and ICI INTEGRATED CONSULTANTS

INCORPORATED, used on and in connection with Opposer's aforesaid services, are similar to and carry the same commercial impression as Applicant's ICI SERVICES mark, as set forth in its application Serial No. 77/592,570.

7. Upon information and belief, Opposer's services, and Applicant's services under the respective marks both travel in the same or similar channels of trade, in overlapping geographic areas, and are directed to the same classes of customers.

8. Opposer has spent substantial time, effort and money to promote its services under its ICI and ICI INTEGRATED CONSULTANTS INCORPORATED marks and trade name, and these marks have attained substantial goodwill in the marketplace.

9. Purchasers familiar with Opposer's services are likely to believe that Applicant's services are sponsored by, authorized by, endorsed by, affiliated with or otherwise approved by Opposer, because the ICI dominant element of the mark is confusingly similar to Opposer's ICI common law rights and Opposer's Registration No. 3,10 7,760 for the ICI INTEGRATED CONSULTANTS INCORPORATED marks and trade name.

10. Registration of Applicant's mark shown in the opposed application will result in damage to Opposer under the provisions of § 2(d) of the Lanham Act, 15 U.S.C. § 1502(d) and § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c), pursuant to the allegations stated above.

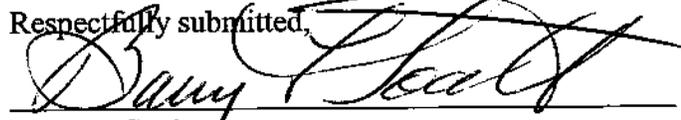
11. If the application is permitted to register, the registration would presumptively entitle Applicant to *prima facie* exclusive ownership and rights to the ICI ICI SERVICES mark. Such registration would cause confusion among consumers as to the separate and distinct sources of Applicant's services and Opposer's services and the relationship of Opposer to Applicant, thereby damaging Opposer's goodwill in Opposer's mark, diminishing the value thereof, and resulting in irreparable harm to Opposer's business and reputation, all to the detriment of Opposer who has expended considerable sums and effort in promoting Opposer's mark.

WHEREFORE, Opposer prays that this Opposition is sustained and that registration of U.S. Trademark Application Serial No. 77/592,570 be denied.

Please charge any necessary fee regarding this Opposition to the Deposit Account 502075 of Procopio Cory Hargreaves & Savitch LLP, and credit any overpayment to such deposit account.

Dated: November 5, 2009

Respectfully submitted,



Barry F. Soalt
Attorney for Opposer,
David K. Aberizk

Procopio, Cory, Hargreaves & Savitch LLP
530 B Street, Suite 2100
San Diego, CA 92101
Tel: (619) 238-1900
Fax: (619) 235-0398
docketing@procopio.com
Our docket no. 117006-2

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing **OPPOSER'S AMENDED NOTICE OF OPPOSITION** is being mailed on November 5, 2009, by First Class Mail to Applicant as follows:

Thomas F. Bergert
Williams Mullen, P.C.
321 E. Main Street, Suite 400
Charlottesville, VA 22902

Dated: November 5, 2009

By: 
Geena L. Jackson