

ESTTA Tracking number: **ESTTA325588**

Filing date: **01/06/2010**

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	Columbia Consultants LLC
Granted to Date of previous extension	01/06/2010
Address	453 West 17th Street New York, NY 10011 UNITED STATES

Name	Richard Akiva Inc.
Granted to Date of previous extension	01/06/2010
Address	453 West 17th Street New York, NY 10011 UNITED STATES

Attorney information	Keith Sklar McCue, Sussmane & Zapfel, P.C. 521 Fifth Avenue 28th Floor New York, NY 10175 UNITED STATES ksklar@mszpc.com
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Applicant Information

Application No	77729119	Publication date	09/08/2009
Opposition Filing Date	01/06/2010	Opposition Period Ends	01/06/2010
Applicants	Filice, Maria Del Pilar 810 N. Maple Street Prospect Heights, IL 60070 UNITED STATES Malacsina, Tamas 810 N. Maple Street Prospect Heights, IL 60070 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. All goods and services in the class are opposed, namely: Bras; Coats; Dresses; Lingerie; Panties; Pants; Shoes; Socks

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3485936	Application Date	06/13/2007
Registration Date	08/12/2008	Foreign Priority Date	NONE
Word Mark	1 OAK		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 2007/09/15 First Use In Commerce: 2007/12/13 night club services Class 043. First use: First Use: 2007/09/15 First Use In Commerce: 2007/12/13 Restaurant, bar and cocktail lounge services		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	1 OAK ONE OF A KIND		
Goods/Services	Nightclub Services Restaurant, Bar and Cocktail Lounge Services Clothing and Apparel		

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark			
Goods/Services	Nightclub Services Restaurant, Bar, Cocktail Lounge Services Lounge Services Clothing and Apparel		
U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Design Mark	
Goods/Services	Nightclub Services Restaurant Bar and Cocktail Lounge Services Clothing and Apparel

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ONE OF A KIND		
Goods/Services	Nightclub Services Bar, Restaurant Services, Cocktail Lounge Services Clothing and Apparel		

Attachments	77205233#TMSN.jpeg (1 page)(bytes) ShieldBlack (big).JPG 1oaklogo2.jpg Notice of Opposition - 100K One of a Kind executed.pdf (7 pages)(168121 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	/Keith Sklar/
Name	Keith Sklar
Date	01/06/2010

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

In the matter of Trademark Application Serial No. 77/729119
 Filed: May 5, 2009
 For the Mark: **100K ONE OF A KIND** *stylized*
 Published in the Official Gazette on September 8, 2009

RICHARD AKIVA, INC. and COLUMBIA CONSULTANTS, LLC	X	
	:	
	:	
Opposers,	:	
	:	Serial No. 77/729119
v.	:	
	:	Opposition No: _____
TAMAS MALACSINA and MARIA DEL PILAR FILICE	:	
	:	
	:	
Applicants.	X	

United States Patent and Trademark Office
 Trademark Trial and Appeal Board
 BOX TTAB
 2900 Crystal Drive
 P.O. Box 1451
 Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

In the matter of pending application Serial No. 77/729119, filed May 5, 2009, jointly by Tamas Malacsina and Maria Del Pilar Filice (“Applicants”), published in the Official Gazette on September 8, 2009, for the mark 100K ONE OF A KIND *stylized*, Richard Akiva, Inc. and Columbia Consultants, LLC (“Opposers”) state that Opposers believe they will be damaged by the registration of the above mark, have a real interest in the outcome of the proceeding and hereby give notice of their opposition to the above application for registration on the following grounds:

OPPOSERS, THEIR MARK AND RELATED GOOD WILL

1. Opposer Columbia Consultants LLC is a limited liability company organized and existing under the laws of the State of Florida, having an address at 453 West 17th Street, New York, New York 10011.

2. Opposer Richard Akiva, Inc. is a New York Corporation having an address at 453 West 17th Street, New York, New York 10011.

3. On June 13, 2007, Opposers filed an application for registration on the Principal Register and currently own Registration No. 3,485,936 for the mark 1OAK ("1OAK Mark) covering "*night club services*" (Class 41) and "*Restaurant, bar and cocktail lounge services*" (Class 43) ("Registration").

4. Since on or about 2007, Opposers have licensed the 1OAK Mark to their affiliate 17th Street Entertainment II, LLC and have actively and continuously used the 1OAK Mark as well as marks comprised in whole or in part of the word 1OAK and One of a Kind, such as "1 OAK ONE OF A KIND" (collectively "1OAK ONE OF A KIND Marks") in commerce in connection with Restaurant, Bar, Cocktail, Lounge and nightclub services in New York including several logos that are comprised of one or both marks.

5. Opposers and their affiliates have submitted foreign applications for the 1OAK Mark and the mark ONE OF A KIND as well as marks comprised in whole or in part of the word 1OAK and/or One of a Kind, such as "1 OAK ONE OF A KIND" in commerce in connection with Restaurant, Bar, Cocktail, Lounge and nightclub services in countries including Australia, Dubai, Brazil, Canada, the European Union, Hong Kong, India, Japan, Russia and Singapore.

6. The 1OAK ONE OF A KIND Marks have become recognized by the public as one of its industry's top luxury brands and have proven to be extremely popular as evidenced by many dignitaries, athletes, musicians, celebrities and other individuals of notoriety who avail themselves of Opposers' services as well as the substantial press and notoriety garnered in national publications such as *MSNBC.com*, *Fox News.com*, *People*, *US Weekly*, *Men's Vogue*, *USA Today.com*, *Life & Style*, *OK!*, *New York Magazine*, *New York Post*, *New York Daily News*, *The New York Times*, and *The New Yorker* as well as international publications including *Vogue China*, *Vogue India* and *Vogue Japan* and other foreign publications. Accordingly, the 1OAK ONE OF A KIND Marks are extremely valuable to Opposers. The 1OAK ONE OF A KIND Marks have been featured as part of a story line on the hit television show *Gossip Girl* broadcast nationally on the CW television network and have been mentioned in a song recorded by a major recording artist. The 1OAK ONE OF A KIND Marks have also been featured in segments on the television magazine show *Entertainment Tonight* and on *E! News* on E! Entertainment Television. Opposers have invested substantial resources in connection with the market research, promotion, development, use and registration of the 1OAK Marks and related marks, its goods and the goodwill associated therewith and considers the marks to constitute one of their primary assets.

7. Opposers and their affiliate currently distribute certain clothing and apparel bearing the 1OAK ONE OF A KIND Marks. Such apparel is popular with celebrities and other opinion makers and individuals.

8. Opposers have common law and registered rights in the 1OAK ONE OF A KIND Marks and have developed valuable goodwill with respect to the marks.

APPLICANTS' CONFUSINGLY SIMILAR MARK

9. Upon information and belief, Applicants are individuals having an address at 810 N. Maple Street, Prospect Heights, Illinois 60070.

10. On May 5, 2009, Applicants filed U.S. trademark application number 77/729119 for 100K ONE OF A KIND stylized with PTO, on an intent-to-use basis in class 25 for "Bras; Coats; Dresses; Lingerie; Panties; Pants; Shoes; Socks" (the "Application").

11. Upon information and belief, Applicants have not used the mark 100K ONE OF A KIND ("100K Mark") for any goods and services.

12. Applicants' nonuse of the 100K Mark in commerce proves that there has never been any goodwill derived from use of the mark by the Applicants with respect to the goods contained in the Application.

13. The 100K Mark is confusingly and deceptively similar to Opposers' 1OAK ONE OF A KIND Marks and its registration and use by Applicants on the goods described in the Application is likely to cause confusion, deception and mistake as to the origin to Applicants goods and/or services bearing the 100K Mark. The 100K Mark, is stylized so that the "100K" is comprised of two overlapping zeros, making the 100K Mark appear substantially similar in appearance to the 1OAK in 1OAK ONE OF A KIND Marks.

14. If Applicants are permitted to use and register the 100K Mark, Opposers would be damaged and injured. Confusion or deception would result in damage to the Opposers. Persons familiar with Opposers' 1OAK ONE OF A KIND Marks would be likely to buy Applicants' goods under the mistaken impression that Applicants' goods

originate with or are otherwise, licensed, endorsed, authorized, affiliated or otherwise associated with Opposers.

15. Furthermore, any defect, objection or fault found with Applicants' goods marketed under the 100K Mark would necessarily reflect upon and seriously injure the reputation and goodwill which Opposers have established for its services under the 1OAK ONE OF KIND Marks.

APPLICANT'S DILUTION OF OPPOSER'S MARK

16. Opposers reallege paragraphs 1 through 15 as if restated in full herein.

17. Through the investment by Opposers of time, money and effort over years through marketing and promotional activity in the United States and abroad, and through notoriety and comment through the local, national and international media in connection with goods and services offered by Opposers under the 1OAK ONE OF A KIND Marks, Opposers marks are "famous" within the meaning of 15 U.S.C. § 1125(c) and is therefore entitled to protection against dilution of their distinctive quality.

18. Applicants did not file its application for the 100K Mark until long after the 1OAK ONE OF A KIND Marks became famous in connection with Opposer's services. Applicants willfully adopted the 100K mark with knowledge of Opposer's exclusive federal, state and common law rights in and to the 1OAK ONE OF A KIND Marks.

19. The grant of a registration to Applicants for the 100K Mark as sought in Application Serial No. 77/729119 should be denied based on the grounds of dilution pursuant to 15 U.S.C. §§ 1125(c) and 1063(a).

20. By reason of the foregoing, Opposers will be gravely damaged by the registration of the 100K Mark by Applicants.

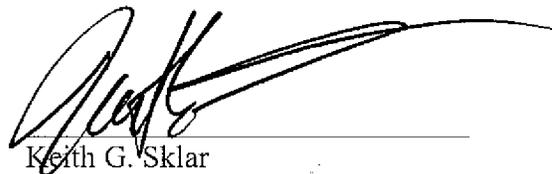
WHEREFORE, Opposers respectfully request that this Notice of Opposition be sustained and the registration of the 100K Mark in the Application by Applicants be refused.

Opposers hereby appoint Kenneth Sussmane, Keith G. Sklar and the law firm of McCue Sussmane & Zapfel, P.C. and all attorneys associated with said firm to prosecute the above opposition with full power of substitution and revocation and to transact all business in the Patent and Trademark Office in connection therewith; correspondence address McCue Sussmane & Zapfel, P.C., 521 Fifth Avenue, 28th floor, New York, New York 10175, telephone (212) 931-5500; facsimile (212) 931-5508.

Dated January 6, 2010

Respectfully submitted,

McCue Sussmane & Zapfel, P.C.



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Attorneys for Opposers

Columbia Consultants, LLC

Richard Akiva, Inc.

Certificate of Service

It is hereby certified, that I am over the age of eighteen years old and not a party to this action, and that on January 6, 2010, I caused a copy of the foregoing Notice of Opposition to be served upon the Applicants at the below addresses by placing it in a sealed envelope with postage thereon fully prepaid, in the United States mail:

Tamas Malacsina
810 N. Maple Street,
Prospect Heights, Illinois 60070

Maria Del Pilar Filice
810 N. Maple Street,
Prospect Heights, Illinois 60070

Date: January 6, 2009



Keith G. Sklar