ESTTA Tracking number: **ESTTA467043**
Filing date: **04/13/2012**

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

Proceeding	91204599
Party	Plaintiff Gilda A. Solis and Stillman de Mexico S.A. de C.V.
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Submission	Motion to Amend Pleading/Amended Pleading
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Date	04/13/2012
Attachments	AMENDED NOTICE OF OPPOSITION.pdf (6 pages)(1171916 bytes)

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

In the matter of Trademark Application
Serial No. 85092438 for the mark: STILLMAN'S
Published in the Official Gazette on October 11, 2011

Gilda A. Solis, an individual and Stillman de México S.A. de C.V. Joint Opposers, v. Shamim Akhter, partnership DBA Shamim Akhter Applicant.	Opposition No. 91204599

AMENDED NOTICE OF OPPOSITION

Gilda A. Solis, ("Solis"), an individual having an address of Calle San Pedro No. 9, Colonia La Joya, Tlalpan CP, Mexico DF, 14090, Mexico and Stillman de México, S.A. de C.V. ("Stillman de Mexico"), a corporation organized under the laws of Mexico with its principal place of business at Calle San Pedro No. 0, Colonia La Joya, Tlalpan CP, Mexico DF, 14090 Mexico, (collectively referred to as "Joint Opposers") believe that they will be damaged by the registration of the mark STILLMAN'S ("Applicant's STILLMAN'S Mark") as applied for in Application Serial No. 85092438 (the "Application") by Applicant, Shamim Akhter, a partnership DBA Shamim Akhter organized under the laws of Pakistan comprising of Ms. Noor Jehan Begum, Citizen of Pakistan, S.M. Akhtar, citizen of Pakistan, S.M. Shahid, Citizen of Pakistan, and S.M.

Zahid, Citizen of Pakistan, with an address of 143-East Street No. 18, Phase-I, Defence Housing Authority, Karachi, Pakistan ("Applicant") and hereby opposes the same for registration.

As grounds for the Opposition, Joint Opposers allege as follows:

1. Opposer Solis through her exclusive Licensee, Opposer Stillman de Mexico is now and has been for a number of years engaged in, among other things, the business of manufacturing, distributing, marketing and selling facial cream products under the Trademark Stillman's (the "Stillman's Trademark").

2. Opposer Solis and/or her predecessor-in-interest The Stillman Company, Inc. ("The Stillman Company") adopted and began using the Stillman's Trademark at least as early as 1967 which is long prior to the filing date of Applicant's Application. Opposer Solis' Stillman's Trademark has been used continuously used in the United States since that time, and through extensive sales, advertising and promotion Opposer Solis' Stillman's Trademark has come to represent substantial goodwill now owned by Opposer Solis. As a result, the public have come to attribute strong secondary meaning to the Stillman's Trademark.

3. Opposer Solis' predecessor-in-interest, The Stillman Company long prior to the filing date of Applicant's STILLMAN'S Mark continuously and extensively used the trade name The Stillman Company in commerce in connection with the marketing and selling of facial cream products under the Stillman's Trademark in the United States.

4. Opposer Stillman de Mexico long prior to the filing date of Applicant's STILLMAN'S Mark continuously and extensively used the trade name Stillman de

Mexico in commerce in connection with the manufacturing, marketing and selling of facial cream products under the Stillman's Trademark in the United States.

5. On October 11, 2011, Applicant filed the Application under Section 44(e) of the Trademark Act. The goods listed in the Application as published in the Official Gazette on October 11, 2011, are "bleaching preparations and other substances for laundry use, namely, laundry detergents, cleaning, polishing, scouring and abrasive preparations, soaps, perfumery, essential oils, cosmetics, hair lotions and dentifrices" in International Class 3.

6. Joint Opposers obtained an extension of time to oppose the Applicant's Application until April 8, 2012.

7. On or about December 26, 1972, Opposer Solis' predecessor-in-interest The Stillman Company and M/S. Shamim Akhtar ("SHAMIM AKHTAR") entered into a written "Manufacturing-Sales Agreement Appointment of Agent" (the "1972 Agreement"). The 1972 Agreement enumerates, among other things, the manner(s) in which the parties can use the word mark Stillman's in connection with the manufacture and selling of freckle cream and bleach cream under the STILLMAN'S Mark which are products related to Opposer Solis' Stillman's Trademark for facial cream. A copy of the 1972 Agreement is attached hereto as Exhibit 1.

8. Applicant, on information and belief, is the successor-in-interest of SHAMIM AKHTAR and is bound by the contractual restrictions under the 1972 Agreement.

9. On October 12, 2010, Opposer Solis filed Application Serial No. 85150670 for "Stillman's" in International Class 003 for facial cream ("Opposer Solis' Application").

10. The Examining Attorney in an Office Action dated July 18, 2011, cited Applicant's Application as a potential bar to the registration of Opposer Solis' Application.

11. The Examining Attorney in a second Office Action dated July 18, 2011, issued a Suspension Notice which continued and maintained the potential bar to the registration of Opposer Solis' Application based on Applicant's prior filed Application.

12. Applicant's STILLMAN'S Mark so resembles Opposer Solis' prior common law rights in the Stillman's Trademark as to be likely when used on or in connection with Applicant's goods identified in the Application, to cause confusion, mistake or deception by causing the public to believe that the goods offered in association with Applicant's STILLMAN'S Mark emanate from Joint Opposers, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with consequent damages to Joint Opposers and the public.

13. Applicant's STILLMAN'S Mark so resembles Joint Opposers' respective prior common law rights in The Stillman Company and Stillman de Mexico trade names as to be likely when used on or in connection with Applicant's goods identified in the Application, to cause confusion, mistake or deception by causing the public to believe that the goods offered in association with Applicant's STILLMAN'S Mark emanate from Joint Opposers, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d), with consequent damages to Joint Opposers and the public.

14. Applicant's registration of the STILLMAN'S Mark will further interfere with Opposer Solis' registration of the Stillman's Trademark and the use of the Stillman's Trademark by Joint Opposers, and will seriously damage Joint Opposers.

15. Applicant, on information and belief, did not have a bona fide intent to use the STILLMAN'S Mark in connection with the goods identified in the Application as of the filing date of the Application under Section 1(b) of the Trademark Act, 15 U.S.C. § 1052(b).

16. Applicant's use and attempted registration of Applicant's STILLMAN'S Mark in the United States as the successor-in-interest to SHAMIM AKHTAR violates the terms of the 1972 Agreement breaching Applicant's obligations thereunder. Pursuant to the 1972 Agreement, SHAMIM AKHTAR agreed among other things, "[t]hat STILLMAN agrees to appoint SHAMIM AKHTAR as its exclusive agent for Pakistan to manufacture and sell Stillman's Freckle Cream and Stillman's Bleach Cream in that country only…". 1972 Agreement, Paragraph 3. Further, the parties agreed "[t]hat this agreement is binding on all heirs and assigns of STILLMAN and SHAMIM AKHTAR"; "[t]his agreement shall be automatically renewed without further signing each year thereafter"; and "[t]his agreement may be cancelled by written notice by either party to the other for good cause or violation of this Agreement". 1972 Agreement, Paragraphs 9 and 10. Joint Opposers, on information and belief, are not aware of any cancellation of the 1972 Agreement by either Applicant or Opposer Solis. As such, Opposer Solis will be further damaged by the registration of Applicant's STILLMAN'S Mark because the registration will be in violation of Opposer Solis' contractual rights under the 1972 Agreement.

WHEREFORE, Joint Opposers respectfully request that this Opposition be sustained and that Applicant's Application Serial No. 85092438 be denied registration.

Respectfully submitted,

Dated: April 13, 2012

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CERTIFICATE OF TRANSMISSION AND SERVICE

I hereby certify that the foregoing AMENDED NOTICE OF OPPOSITION is being electronically filed with the United States Patent and Trademark Office on April 13, 2012, and a true and complete copy of the foregoing AMENDED NOTICE OF OPPOSITION has been served on Harold L. Novick, Attorney of record for Applicant by mailing said copy on April 13, 2012, via First Class Mail, postage prepaid to:

Harold L. Novick, Esq.
H&A INTELLECTUAL PROPERTY LAW PLLC
2847 Duke Street
Alexandria, VA 22314

Date: April 13, 2012

Edouard V. Rosa