ESTTA Tracking number: **ESTTA611922**
Filing date: **06/24/2014**

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

Proceeding	91209365
Party	Defendant SILC S.P.A.
Correspondence Address	ANGELO NOTARO NOTARO MICHALOS & ZACCARIA PC 100 DUTCH HILL RD ORANGEBURG, NY 10962-2197 UNITED STATES anotaro@notaromichalos.com
Submission	Withdrawal Of Application
Filer's Name	Angelo Notaro
Filer's e-mail	anotaro@notaromichalos.com
Signature	/G124-400-AN/
Date	06/24/2014
Attachments	Notice Of Opposition.pdf(872684 bytes)

ESTTA Tracking number: **ESTTA522273**
Filing date: **02/19/2013**

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 party opposes registration of the indicated application.

Opposer Information

Name	IES Enterprises, Inc.
Granted to Date of previous extension	02/17/2013
Address	300 Park Avenue New York, NY 10022 UNITED STATES

Attorney information	Leo Kittay Fross Zelnick Lehrman & Zissu, P.C. 866 U.N. Plaza New York, NY 10017 UNITED STATES ddonahue@fzlz.com, lkittay@fzlz.com Phone:212-813-5900

Applicant Information

Application No	85405118	Publication date	08/21/2012
Opposition Filing Date	02/19/2013	Opposition Period Ends	02/17/2013
International Registration No.	NONE	International Registration Date	NONE
Applicant	SILC S.P.A. Strada Provinciale 35, Km. 4 ,Trescore Cremasco (Cremona), 26017 ITALY		

Goods/Services Affected by Opposition

Class 003. All goods and services in the class are opposed, namely: Non-medicated diaper rash napkins, namely, baby wipes; non-medicated diaper rash ointments and lotions
Class 005. All goods and services in the class are opposed, namely: Medicated diaper rash napkins, namely, medicated pre-moistened wipes; incontinence garments; incontinence pads; sanitary napkins; medicated diaper rash ointments and lotions; sanitary pads; infant formula and adult diapers

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.	1457886	Application Date	12/27/1983
Registration Date	09/22/1987	Foreign Priority Date	NONE
Word Mark	SOFTSOAP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1977/11/03 First Use In Commerce: 1977/11/03 LIQUID HAND SOAP IN A PUMP-TYPE DISPENSER		

U.S. Registration No.	2098824	Application Date	03/18/1996
Registration Date	09/23/1997	Foreign Priority Date	NONE
Word Mark	SOFTSOAP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: First Use: 1975/10/00 First Use In Commerce: 1975/10/00 personal care products, namely, liquid skin soap		

Attachments	Notice of Opposition (SOFFISOF) w- exhibit (F1175282).PDF (19 pages)(546445 bytes)

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	/Leo Kittay/
Name	Leo Kittay
Date	02/19/2013

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

In the Matter of Serial No. 85/405,118
Filing Date: August 23, 2011
Published in the *Official Gazette*: August 21, 2012

IES ENTERPRISES, INC., Opposer, v. SILC S.P.A., Applicant.	Opposition No. _____

NOTICE OF OPPOSITION

Opposer IES Enterprises, Inc. ("Opposer"), a corporation existing and operating under the laws of Massachusetts, with a place of business at 300 Park Avenue, New York, New York 10022, believes that it will be damaged by registration of the mark SOFFISOF applied for in Application Serial No. 85/405,118 for all identified goods in International Classes 3 and 5 (the "Opposed Classes") and hereby opposes same. As grounds for the opposition, Opposer, through its attorneys, Fross Zelnick Lehrman & Zissu, P.C., alleges as follows:

1. Four more than four decades Opposer and its predecessors in interest (collectively, "Opposer") have used, and Opposer is currently using, the SOFTSOAP mark and various SOFTSOAP-inclusive marks (collectively, "Opposer's Mark") in connection with personal care products, including, without limitation, body and skin cleansers.

2. As a result of its reputation, use, substantial sales success, and extensive advertising, the SOFTSOAP mark has become and is exclusively identified with Opposer and Opposer's goods and is among the most famous marks for personal care products in the United

States. As such, the SOFTSOAP Mark represents enormous goodwill and is an extremely valuable asset of Opposer.

3. Opposer owns numerous federal registrations for Opposer's Mark, including, without limitation, U.S. Reg. No. 1,457,886 for "liquid hand soap in a pump-type dispenser" in International Class 3, based on first use in November 1977, and U.S. Reg. No. 2,098,824 for "personal care products, namely, liquid skin soap" in International Class 3 based on first use in October 1975 (collectively, "Opposer's Registrations"). True and correct copies of printouts from the TSDR database of the United States Patent and Trademark Office showing the current status and title of Opposer's Registrations are attached hereto as **Exhibit A**.

4. Opposer's Registrations are valid, subsisting, in full force and effect and incontestable pursuant to Section 15 of the Lanham Act, 15 U.S.C. § 1065. Opposer's Registrations thereby serve as *conclusive* evidence of Opposer's exclusive right to use Opposer's Mark in connection with the goods identified in the subject registrations pursuant to Section 33(b) of the Lanham Act, 15 U.S.C. § 1115(b).

5. Upon information and belief, Applicant SILC S.P.A. ("Applicant") has a place of business at Strada Provinciale 35, Km. 4, Trescore Cremasco (Cremona) Italy 26017.

6. On August 23, 2011, Applicant filed Application Serial number 85/405,118 (the "Application") seeking to register the mark SOFFISOF ("Applicant's Mark") for various identified goods in the Opposed Classes, among other identified goods in other International Classes, based on its ownership of a foreign registration for the mark under Section 44(e) of the Trademark Act, 15 U.S.C. § 1126(e).

7. Upon information and belief; Applicant has not begun use of Applicant's Mark in United States commerce.

8. The filing date of the Application and Applicant's date of first use (if any) of Applicant's Mark in United States commerce are long after Opposer's first use of Opposer's Mark in United States commerce, long after the priority dates of Opposer's Registrations, and long after Opposer's Mark became distinctive and famous in the United States.

9. Applicant's Mark is highly similar to Opposer's Mark in sight, sound and commercial impression.

10. Applicant's Mark so resembles Opposer's Mark as to be likely, when applied to Applicant's goods in the Opposed Classes, to cause confusion or to cause mistake or to deceive, in violation of 15 U.S.C. § 1052(d).

11. Registration of Applicant's Mark for Applicant's goods in the Opposed Classes would be inconsistent with Opposer's exclusive right to use Opposer's Mark and would substantially damage Opposer's investment and goodwill in Opposer's Mark.

12. Applicant's use and registration of Applicant's Mark for Applicant's goods in the Opposed Classes is likely to dilute the distinctive quality of Opposer's Mark.

13. Any use or registration by Applicant of Applicant's Mark for Applicant's goods in the Opposed Classes would violate Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

14. By reason of the foregoing, Opposer will be injured by registration of Applicant's Mark for goods in the Opposed Classes.

WHEREFORE, Opposer respectfully prays that this opposition be sustained and that the Application be denied for goods in the Opposed Classes.

Dated: New York, New York
February 19, 2013

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: _____
David Donahue
Leo Kittay

Attorneys for Opposer
866 United Nations Plaza
New York, New York 10017
(212) 813-5900

{F1174247.3 }

EXHIBIT A

Generated on:	This page was generated by TSDR on 2013-02-19 15:12:21 EST
Mark:	SOFTSOAP

US Serial Number:	73458195	**Application Filing Date:**	Dec. 27, 1983
US Registration Number:	1457886	**Registration Date:**	Sep. 22, 1987

Register:	Principal
Mark Type:	Trademark
Status:	The registration has been renewed.
Status Date:	Oct. 13, 2007
Publication Date:	Jun. 30, 1987

Mark Information

Mark Literal Elements:	SOFTSOAP
Standard Character Claim:	No
Mark Drawing Type:	1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)
Acquired Distinctiveness Claim:	In whole

Goods and Services

Note:
The following symbols indicate that the registrant/owner has amended the goods/services:

- • Brackets [..] indicate deleted goods/services;
- • Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- • Asterisks *..* identify additional (new) wording in the goods/services.

For:	LIQUID HAND SOAP IN A PUMP-TYPE DISPENSER		
International Class:	003 - Primary Class	**U.S Class:**	052
Class Status:	ACTIVE		

Basis:	1(a)		
First Use:	Nov. 03, 1977	**Use in Commerce:**	Nov. 03, 1977

Basis Information (Case Level)

Filed Use:	Yes	**Currently Use:**	Yes	**Amended Use:**	No
Filed ITU:	No	**Currently ITU:**	No	**Amended ITU:**	No
Filed 44D:	No	**Currently 44D:**	No	**Amended 44D:**	No
Filed 44E:	No	**Currently 44E:**	No	**Amended 44E:**	No
Filed 66A:	No	**Currently 66A:**	No		
Filed No Basis:	No	**Currently No Basis:**	No		

Current Owner(s) Information

Owner Name:	IES ENTERPRISES, INC.		
Owner Address:	300 PARK AVENUE NEW YORK, NEW YORK 10022 UNITED STATES		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS

Attorney/Correspondence Information

Attorney of Record

Attorney Name:	Felicia G. Traub

Correspondent

Correspondent Name/Address:	Felicia G. Traub IES Enterprises, Inc. 300 Park Avenue New York, NEW YORK 10022 UNITED STATES		
Phone:	(212) 310-3272	**Fax:**	(212) 310-3406
Correspondent e-mail:	Felicia_Traub@colpal.com	**Correspondent e-mail Authorized:**	Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 13, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	70132
Oct. 13, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 04, 2007	ASSIGNED TO PARALEGAL	70132
Sep. 21, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Sep. 21, 2007	TEAS SECTION 8 & 9 RECEIVED	
Mar. 28, 2007	CASE FILE IN TICRS	
Aug. 27, 1993	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Jan. 11, 1993	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Sep. 22, 1987	REGISTERED-PRINCIPAL REGISTER	
Jun. 30, 1987	PUBLISHED FOR OPPOSITION	
Jun. 02, 1987	NOTICE OF PUBLICATION	
May 29, 1987	NOTICE OF PUBLICATION	
Apr. 24, 1987	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 09, 1987	EXPARTE APPEAL TERMINATED	458195
Apr. 09, 1987	EX PARTE APPEAL-REFUSAL REVERSED	458195
May 29, 1986	CONTINUATION OF FINAL REFUSAL MAILED	
May 20, 1986	JURISDICTION RESTORED TO EXAMINING ATTORNEY	
Feb. 06, 1986	EXAMINERS STATEMENT MAILED	
Aug. 29, 1985	CONTINUATION OF FINAL REFUSAL MAILED	
Jun. 19, 1985	JURISDICTION RESTORED TO EXAMINING ATTORNEY	
Apr. 12, 1985	EX PARTE APPEAL-INSTITUTED	458195
Sep. 28, 1984	FINAL REFUSAL MAILED	
May 29, 1984	CORRESPONDENCE RECEIVED IN LAW OFFICE	

Feb. 23, 1984	NON-FINAL ACTION MAILED
Jan. 13, 1984	ASSIGNED TO EXAMINER

Maintenance Filings or Post Registration Information

Affidavit of Continued Use:	Section 8 - Accepted
Affidavit of Incontestability:	Section 15 - Accepted
Renewal Date:	Sep. 22, 2007

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION **Date in Location:** Oct. 13, 2007

Assignment Abstract of Title Information

Summary

Total Assignments: 5 **Registrant:** MINNETONKA, INC.

Assignment 1 of 5

Conveyance:	SECURITY INTEREST		
Reel/Frame:	0587/0521	**Pages:**	2
Date Recorded:	Dec. 23, 1987		
Supporting Documents:	No Supporting Documents		

Assignor

Name:	MINNETONKA, INC.	**Execution Date:**	Dec. 22, 1987
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MINNESOTA

Assignee

Name:	FIRST NATIONAL BANK OF SAINT PAUL, THE		
Legal Entity Type:	A NATIONAL BANKING	**State or Country Where**	No Place Where Organized

	ASSOCIATION	**Organized:**	Found
Address:	332 MINNESOTA ST. SAINT PAUL, MINNESOTA 55101		

Correspondent

Correspondent Name:	FREDRIKSON & BYRON
Correspondent Address:	1100 INTERNATIONAL CENTRE 900 SECOND AVE., SOUTH MINNEAPOLIS, MN 55402-3397

Domestic Representative - Not Found

Assignment 2 of 5

Conveyance:	MERGER AGREEMENT, EFFECTIVE AS OF DECEMBER 23, 1987 MINNESOTA		
Reel/Frame:	0614/0001	**Pages:**	9
Date Recorded:	Aug. 24, 1988		
Supporting Documents:	No Supporting Documents		

Assignor

Name:	COLGATE SOFT SHOE, INC.	**Execution Date:**	Dec. 23, 1987
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	DELAWARE

Assignee

Name:	MINNETONKA, INC.		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MINNESOTA
Address:	No Assignee Address Found		

Correspondent

Correspondent Name:	FABYANSKE, SVOBODA, ET AL.
Correspondent Address:	1300 MINNESOTA WORLD TRADE CENTER THIRTY EAST SEVENTH STREET SAINT PAUL, MN 55101

Domestic Representative - Not Found

Assignment 3 of 5

Conveyance:	ASSIGNS THE ENTIRE INTEREST AND THE GOODWILL		
Reel/Frame:	0599/0592	**Pages:**	1
Date Recorded:	Apr. 18, 1988		
Supporting Documents:	No Supporting Documents		

Assignor

Name:	MINNETONKA, INC.	**Execution Date:**	Apr. 07, 1988
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MINNESOTA

Assignee

Name:	SOFTSOAP ENTERPRISES, INC.		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	DELAWARE
Address:	BOX 1-A MINNEAPOLIS, MINNESOTA 55353		

Correspondent

Correspondent Name:	MERCHANT, GOULD, ET AL.
Correspondent Address:	1600 MIDWEST PLAZA BUILDING 801 NICOLLET MALL MINNEAPOLIS, MN 55402

Domestic Representative - Not Found

Assignment 4 of 5

Conveyance:	RELEASE BY SECURED PARTY		
Reel/Frame:	0864/0871	**Pages:**	4
Date Recorded:	May 11, 1992		
Supporting Documents:	No Supporting Documents		

Assignor

Name:	FIRST BANK NATIONAL ASSOCIATION	**Execution Date:**	Dec. 31, 1990
Legal Entity Type:	A NATIONAL BANKING ASSOCIATION	**State or Country Where Organized:**	No Place Where Organized Found

Assignee

Name:	SOFTSOAP ENTERPRISES, INC.		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	No Place Where Organized Found
Address:	No Assignee Address Found		

Correspondent

Correspondent Name:	MERCHANT & GOULD
Correspondent Address:	3100 NORWEST CENTER 90 SOUTH SEVENTH STREET MINNEAPOLIS, MN 55402-4131

Domestic Representative - Not Found

Assignment 5 of 5

Conveyance:	CHANGE OF NAME		
Reel/Frame:	3162/0569	**Pages:**	6
Date Recorded:	Sep. 21, 2005		
Supporting Documents:	assignment-tm-3162-0569.pdf		

Assignor

Name:	SOFTSOAP ENTERPRISES, INC.	**Execution Date:**	Feb. 28, 2005
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS

Assignee

Name:	IES ENTERPRISES, INC.		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS
Address:	300 PARK AVENUE NEW YORK, NEW YORK 10022		

Correspondent

Correspondent Name:	FELICIA G. TRAUB
Correspondent Address:	300 PARK AVENUE NEW YORK, NY 10022

Domestic Representative - Not Found

Generated on:	This page was generated by TSDR on 2013-02-19 15:12:58 EST		
Mark:	SOFTSOAP		
US Serial Number:	75074732	**Application Filing Date:**	Mar. 18, 1996
US Registration Number:	2098824	**Registration Date:**	Sep. 23, 1997
Register:	Principal		
Mark Type:	Trademark		
Status:	The registration has been renewed.		
Status Date:	Oct. 13, 2007		
Publication Date:	Jul. 01, 1997		

Mark Information

Mark Literal Elements:	SOFTSOAP
Standard Character Claim:	No
Mark Drawing Type:	1 - TYPESET WORD(S) /LETTER(S) /NUMBER(S)
Acquired Distinctiveness Claim:	In whole

Related Properties Information

Claimed Ownership of US Registrations:	1457886,1792109,and others

Goods and Services

Note:
The following symbols indicate that the registrant/owner has amended the goods/services:

- • Brackets [..] indicate deleted goods/services;
- • Double parenthesis ((..)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- • Asterisks *..* identify additional (new) wording in the goods/services.

For:	personal care products, namely, liquid skin soap		
International Class:	003 - Primary Class	**U.S Class:**	001, 004, 006, 050, 051, 052
Class Status:	ACTIVE		
Basis:	1(a)		
First Use:	Oct. 1975	**Use in Commerce:**	Oct. 1975

Basis Information (Case Level)

Filed Use:	No	**Currently Use:**	Yes	**Amended Use:**	No
Filed ITU:	Yes	**Currently ITU:**	No	**Amended ITU:**	No
Filed 44D:	No	**Currently 44D:**	No	**Amended 44D:**	No
Filed 44E:	No	**Currently 44E:**	No	**Amended 44E:**	No
Filed 66A:	No	**Currently 66A:**	No		
Filed No Basis:	No	**Currently No Basis:**	No		

Current Owner(s) Information

Owner Name:	IES ENTERPRISES, INC.		
Owner Address:	300 PARK AVENUE NEW YORK, NEW YORK 10022 UNITED STATES		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Felicia G. Traub

Correspondent

Correspondent Name/Address:
Felicia G. Traub
IES ENTERPRISES, INC.
300 PARK AVENUE
NEW YORK, NEW YORK 10022
UNITED STATES

Phone:	(212) 310-3272	**Fax:**	(212) 310-3406
Correspondent e-mail:	Felicia_Traub@colpal.com	**Correspondent e-mail Authorized:**	Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Oct. 13, 2007	REGISTERED AND RENEWED (FIRST RENEWAL - 10 YRS)	70132
Oct. 13, 2007	REGISTERED - SEC. 8 (10-YR) ACCEPTED/SEC. 9 GRANTED	
Oct. 04, 2007	ASSIGNED TO PARALEGAL	70132
Sep. 21, 2007	REGISTERED - COMBINED SECTION 8 (10-YR) & SEC. 9 FILED	
Sep. 21, 2007	TEAS SECTION 8 & 9 RECEIVED	
Feb. 26, 2007	CASE FILE IN TICRS	
May 22, 2003	REGISTERED - SEC. 8 (6-YR) ACCEPTED & SEC. 15 ACK.	
Feb. 11, 2003	REGISTERED - SEC. 8 (6-YR) & SEC. 15 FILED	
Feb. 11, 2003	TEAS SECTION 8 & 15 RECEIVED	
Sep. 23, 1997	REGISTERED-PRINCIPAL REGISTER	
Jul. 01, 1997	PUBLISHED FOR OPPOSITION	
May 30, 1997	NOTICE OF PUBLICATION	
Apr. 30, 1997	APPROVED FOR PUB - PRINCIPAL REGISTER	
Apr. 30, 1997	USE AMENDMENT ACCEPTED	
Mar. 13, 1997	CORRESPONDENCE RECEIVED IN LAW OFFICE	
Apr. 16, 1997	AMENDMENT TO USE PROCESSING COMPLETE	
Mar. 13, 1997	USE AMENDMENT FILED	
Sep. 17, 1996	NON-FINAL ACTION MAILED	
Aug. 29, 1996	ASSIGNED TO EXAMINER	69196

Maintenance Filings or Post Registration Information

Affidavit of Continued Use:	Section 8 - Accepted
Affidavit of Incontestability:	Section 15 - Accepted
Renewal Date:	Sep. 23, 2007

TM Staff and Location Information

TM Staff Information - None

File Location

Current Location: POST REGISTRATION **Date in Location:** Oct. 13, 2007

Assignment Abstract of Title Information

Summary

Total Assignments:	1	**Registrant:**	SOFTSOAP ENTERPRISES, INC.

Assignment 1 of 1

Conveyance:	CHANGE OF NAME		
Reel/Frame:	3162/0569	**Pages:**	6
Date Recorded:	Sep. 21, 2005		
Supporting Documents:	assignment-tm-3162-0569.pdf		

Assignor

Name:	SOFTSOAP ENTERPRISES, INC.	**Execution Date:**	Feb. 28, 2005
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS

Assignee

Name:	IES ENTERPRISES, INC.		
Legal Entity Type:	CORPORATION	**State or Country Where Organized:**	MASSACHUSETTS
Address:	300 PARK AVENUE NEW YORK, NEW YORK 10022		

Correspondent

Correspondent Name:	FELICIA G. TRAUB
Correspondent Address:	300 PARK AVENUE NEW YORK, NY 10022

Domestic Representative - Not Found

CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the Notice of Opposition to be served by prepaid, first-class mail on this 19th day of February, 2013, upon Applicant's attorney of record at the following address:

ANGELO NOTARO
NOTARO, MICHALOS & ZACCARIA P.C.
100 DUTCH HILL RD
ORANGEBURG, NEW YORK 10962-2197

Leo Kittay