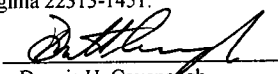


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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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Applicant: Nothingham, George P. :
Mark: HISTORIES INK : Opposition No.:
Ser. No.: 78/245,408 :
Filed: May 3, 2003 :
Published: September 14, 2004 :
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CERTIFICATE OF EXPRESS MAILING 37 C.F.R. 1.10
I hereby certify that the attached paper or fee is being deposited with
the U.S. Postal Service as Express Mail, No. EV 341 971 578 US, postage pre-paid, on
1/12/05, addressed to the Commissioner for Trademarks,
P.O. Box 1451, Alexandria, Virginia 22313-1451.

Dennis H. Cavanaugh

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

Pursuant to Trademark Rule 2.102, Gilmar S.p.A., a Italian corporation having an office and place of business at Via Malpasso 723/725, 47842 San Giovanni in Marignano, Rimini, Italy ("Gilmar" or "Opposer") believes that it is and will be damaged by registration of the mark shown in Serial Number 78/245,408 in International Class 25 and opposes the same. As grounds for the opposition it is alleged that:

1. The applicant, George P. Nottingham ("Applicant") is, upon information and belief, an individual, with offices located at 8140 93rd Lane, South Boynton Beach, Florida 33437.

01/18/2005 KIBBONS 00000075 78245408
01 FC:6402 300.00 OP

00020570.1 G007151.0012



01-13-2005

2. On or about May 3, 2003, Applicant filed the above-referenced trademark application to register the mark HISTORIESINK for "Clothing and apparel, namely, shirts, imprinted T-shirts, sweat shirts, jackets, and headgear, namely, hats" in International Class 25, under Section 1(b) based upon an intent-to-use in commerce.

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 designer clothing labeled "ICE" alone or with various other formatives.

5. In 1998, Gilmar introduced a line of men's and women's sportswear labeled "HISTORY ICEBERG."

6. Opposer adopted and has been using the mark HISTORY ICEBERG (the "HISTORY ICEBERG Mark") in interstate commerce since long prior to May 3, 2003, the date of Applicant's filing, as a trademark to identify its items of wearing apparel and other goods. Opposer continues to use the HISTORY ICEBERG Mark 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 HISTORY ICEBERG Mark.

7. Gilmar is the owner of the following registration on the Principal Register of the U.S. Patent and Trademark Office: 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, which registration is valid and subsisting and has never been abandoned.

8. A copy of the TESS printout of the registration pleaded in paragraph 7 above, indicating the current status thereof, is attached hereto and incorporated herein as Exhibit A.

9. The ICEBERG collection of knitwear and sportswear and the HISTORY ICEBERG lines of clothing and accessories (including clothing and accessories sold, advertised and promoted under marks including ICE ICEBERG, ICE J, ICE HISTORY ICEBERG, and ICE HISTORY) have been extensively promoted through print advertising in major fashion magazines such as *Vogue*, *Esquire* and *Marie Claire*, as well as selected publicity events, sponsorships and outdoor and co-op advertising. By virtue of said promotional activities and extensive sales, the goods sold under these marks 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.

10. Applicant’s filing date of May 3, 2003 is subsequent to both Opposer’s date of first use of its HISTORY ICEBERG Mark, and the date of its registration thereof. Thus, priority is not at issue.

11. Applicant’s mark HISTORIESINK is confusingly similar in sight, sound and meaning to Opposer’s HISTORY ICEBERG Mark. Consequently, Applicant’s mark so closely resembles Opposer’s HISTORY ICEBERG Mark as to be likely to be confused with and

mistaken for Opposer's HISTORY ICEBERG Mark. As a result, there is a significant likelihood of confusion between Applicant's mark and Opposer's HISTORY ICEBERG Mark.

12. Applicant's goods are identical to and closely related to those of Opposer, thus increasing the likelihood of confusion that may result from registration and use of Applicant's mark.

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

14. Gilmar is not affiliated in any manner with Applicant and it has not authorized Applicant's use or application to register HISTORIESINK.

15. 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 HISTORY ICEBERG Mark. Persons familiar with Opposer's HISTORY ICEBERG Mark are likely to purchase Applicant's goods believing they are marketed by, affiliated with or endorsed by Opposer, when in fact they are not.

16. 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 HISTORY ICEBERG Mark. 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 HISTORY ICEBERG Mark, its business and to the goodwill of such business symbolized by Opposer's HISTORY ICEBERG Mark. Registration of Applicant's mark will also tend to reduce the distinctiveness, value and goodwill of Opposer's HISTORY ICEBERG Mark.

WHEREFORE, Opposer believes that it will be damaged by registration of the Applicant's mark in Class 25, Application Serial No. 78/245,408, and opposes registration thereof on the grounds set forth above. Opposer further prays that Application Serial No. 78/245,408 be rejected, and that registration of Applicant's mark therein sought for the goods specified therein in Class 25 be denied and refused.

This Notice of Opposition is being filed in triplicate, and the \$300 fee for one class required under § 2.6(a)(17) is enclosed herewith.

Respectfully submitted,

GILMAR S.P.A.

Dated: 1/12/05

By: 

Dennis H. Cavanaugh, Esq.
PILIERO GOLDSTEIN

KOGAN & MITCHELL, LLP
10 East 53rd Street, 36th Floor
New York, New York 10022
(212) 478-8500

Attorneys for Opposer
Gilmar S.p.A.



UNITED STATES PATENT AND TRADEMARK OFFICE

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Word Mark HISTORY ICEBERG

Goods and Services IC 018. US 001 002 003 022 041. G & S: Luggage, trunks, traveling bags, purses, and key holding wallets of leather

IC 025. US 022 039. G & S: 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

Mark

Drawing Code (3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS

Design Search Code 261103

Serial Number 75451595

Filing Date March 17, 1998

Current Filing Basis 44E

Original Filing Basis 44D

Published for Opposition September 25, 2001
Registration Number 2518973
Registration Date December 18, 2001
Owner (REGISTRANT) Gilmar S.p.A. CORPORATION ITALY Via Malpasso 723/725
47842 S. Giovanni in Marignano Rimini ITALY
Attorney of Record G FRANKLIN ROTHWELL
Priority Date February 9, 1998
Prior Registrations 1269297;1473778;1477299;1622149;1700454;1813742;AND OTHERS
Type of Mark TRADEMARK
Register PRINCIPAL
Live/Dead Indicator LIVE

PTO HOME	TRADEMARK	TESS HOME	NEW USER	STRUCTURED	FREE FORM	BROWSE DIET	TOP	HELP	PREV LIST
CURR LIST	NEXT LIST	FIRST DOC	PREV DOC	NEXT DOC	LAST DOC				

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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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Alexandria, VA 22313-1451

**POWER OF ATTORNEY AND APPOINTMENT
OF DOMESTIC REPRESENTATIVE**

Opposer hereby appoints Dennis H. Cavanaugh, Esq. a member of the Bar of the State of New York, as its domestic representative and attorney to prosecute this opposition, to transact all business in the U.S. Patent and Trademark Office and/or Trademark Trial and Appeal Board in connection therewith, and to represent it in all proceedings and appeals that may arise in the U.S. Patent and Trademark Office or the courts concerning this Notice of Opposition. Please direct all communications in this matter to: Dennis H. Cavanaugh, Esq., Piliero Goldstein Kogan & Mitchell, LLP, 10 East 53rd Street, 36th Floor, New York, New York 10022, Telephone: (212) 478-8500, Fax: (212) 478-8584, Email: dcavanaugh@PGKM.com.

GILMAR S.p.A.

Date: 7/12/05

By: 

By Dennis H. Cavanaugh
Attorney