

ESTTA Tracking number: **ESTTA165679**

Filing date: **09/28/2007**

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	Gilmar S.p.A.
Granted to Date of previous extension	09/30/2007
Address	723-725, via Malpasso I-47842 San Giovanni in Marignano, 47842 ITALY

Correspondence information	Dennis H. Cavanaugh Attorney D H Cavanaugh Associates 555 Fifth Avenue, 17th Floor New York, NY 10017 UNITED STATES dhc@dhcavanaugh.net Phone:212-856-7210
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**Applicant Information**

Application No	78861879	Publication date	04/03/2007
Opposition Filing Date	09/28/2007	Opposition Period Ends	09/30/2007
Applicant	CBI Distributing Corp. 2400 West Central Road Hoffman Estates, IL 60195 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 035. All goods and services in the class are opposed, namely: Retail and online store services dealing primarily in clothing, clothing accessories, hair goods, jewelry, cosmetics, hand bags and leather goods, furnishings in the nature of room accessories, picture frames, inflatable furniture, pillows, key chains, room accessories, stationery items
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**Grounds for Opposition**

Priority and likelihood of confusion	Trademark Act section 2(d)
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**Marks Cited by Opposer as Basis for Opposition**

U.S. Registration No.	1269297	Application Date	06/22/1982
Registration Date	03/06/1984	Foreign Priority Date	NONE

Word Mark	ICEBERG
Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1976/06/00 First Use In Commerce: 1976/12/27 T-Shirts, Skirts, Trousers, Shirts, Jackets, and Blazers

U.S. Registration No.	1850734	Application Date	06/08/1987
Registration Date	08/23/1994	Foreign Priority Date	01/21/1987
Word Mark	ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: CLOTHING; NAMELY, MEN'S, WOMEN'S[ AND CHILDREN'S] SUITS, COATS, [HATS, BLOUSES,] CAPS, SHIRTS, T-SHIRTS, BELTS, VESTS, SCARVES, SKIRTS, TIES, SHORTS, [KNICKERS,] BATHING SUITS, DRESSES, JACKETS, SWEATERS, [JOGGING SUITS AND LOUNGEWEAR, OVERALLS,] JEANS, [NIGHT GOWNS,] PAJAMAS, [SOCKS, STOCKINGS,] KERCHIEFS, UNDERWEAR, SHOES, [BOOTS AND SLIPPERS]		

U.S. Registration No.	1477299	Application Date	11/14/1986
Registration Date	02/23/1988	Foreign Priority Date	06/13/1986
Word Mark	ICEBERG JEANS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: PERFUMERY, NAMELY PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS Class 018. First use: LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS AND UMBRELLAS Class 025. First use: MEN'S AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MEN'S AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS		

U.S. Registration No.	2222782	Application Date	01/16/1998
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Registration Date	02/09/1999	Foreign Priority Date	NONE
Word Mark	IJ ICEBERG JEANS		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: First Use: 1994/08/04 First Use In Commerce: 1994/08/04 HANDBAGS, WALLETS</p> <p>Class 025. First use: First Use: 1994/08/04 First Use In Commerce: 1994/08/04 clothing, namely, sweaters, t-shirts, sweat shirts, pants, skirts, knit skirts, jackets, gilets, knit gilets, sport jackets, leather jackets, shorts, blousons, dresses, coats, leather pants, knit scarves, belts, gloves, shoes, cardigans, bodies</p>		

U.S. Registration No.	1477298	Application Date	11/14/1986
Registration Date	02/23/1988	Foreign Priority Date	07/24/1986
Word Mark	ICEBERG SPORT ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 003. First use: PERFUMERY, NAMELY PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS</p> <p>Class 018. First use: LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS AND UMBRELLAS</p> <p>Class 025. First use: MENS' AND WOMENS' CLOTHING, NAMELY, JACKETS, BELTS, NECKWEAR, SWEATERS, SUITS, SHIRTS, BLOUSES, SKIRTS, DRESSES, HOSIERY, SCARVES, SHAWLS, MENS' AND WOMENS' BLAZERS, COATS, JACKETS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS</p>		

U.S. Registration No.	3029399	Application Date	05/27/2004
Registration Date	12/13/2005	Foreign Priority Date	05/05/2004
Word Mark	ICE B		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 018. First use: Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief</p>		

	cases, purses, belts, card holders, key rings, keychains, umbrellas, attach&eacute; cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks Class 025. First use: Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers
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U.S. Registration No.	3029400	Application Date	05/27/2004
Registration Date	12/13/2005	Foreign Priority Date	05/05/2004
Word Mark	ICE B ICEBERG		
Design Mark			
Description of Mark	The trademark consists of a dark rectangular device, containing, in the middle, the word ICE written in light fancy characters and the letter B in a fancy character with darker background; in a lower position there is the word ICEBERG in smaller characters with light background written repeatedly and without interruption.		
Goods/Services	Class 018. First use: Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attach&egrave; cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks Class 025. First use: Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers		

U.S. Registration No.	1595934	Application Date	02/19/1988
Registration Date	05/15/1990	Foreign Priority Date	09/21/1987
Word Mark	AISBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 003. First use: [ PERFUMERY, NAMELY, PERFUME, COLOGNE, SKIN LOTION, TOILET SOAPS, BATH OILS, BUBBLE BATH, FACIAL SCRUBS, BATH GEL, INCENSE, MAKEUP, LIPSTICK, LIP GLOSS, MASCARA, NIGHT CREAM, FACIAL POWDER AND BEAUTY CREAMS AND HAIR LOTIONS ] Class 018. First use: [ LUGGAGE, NAMELY, ATTACHE CASES, GARMENT BAGS, SUITCASES, BRIEFCASES, ATHLETIC BAGS, DUFFEL BAGS, HAT BOXES FOR TRAVEL, OVERNIGHT CASES, VANITY CASES, TRAVELING BAGS, TRUNKS, SHOULDER BAGS, KEY CASES, PURSES, HANDBAGS, WALLETS, UMBRELLAS, SHOULDER BELTS ]		

	Class 025. First use: MEN'S AND WOMEN'S CLOTHING, NAMELY, JACKETS, [ BELTS, NECKWEAR, ] SWEATERS, [ SUITS, ] SHIRTS, BLOUSES, SKIRTS, DRESSES, [ HOSIERY, SCARVES, SHAWLS, MEN'S AND WOMEN'S BLAZERS, COATS, ] JACKETS, [ JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, SPORTS COATS, HATS, CAPS, GLOVES, KERCHIEFS, SHOES, BOOTS, AND SLIPPERS ]
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U.S. Registration No.	2518973	Application Date	03/17/1998
Registration Date	12/18/2001	Foreign Priority Date	02/09/1998
Word Mark	HISTORY ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: Luggage, trunks, traveling bags, purses, [and key holding wallets] of leather Class 025. First use: 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		

U.S. Registration No.	2909353	Application Date	08/01/1997
Registration Date	12/14/2004	Foreign Priority Date	NONE
Word Mark	SPORT ICE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 1988/09/09 First Use In Commerce: 1989/02/09 handbags, backpacks, fanny packs, tote bags, cosmetic cases sold empty Class 025. First use: First Use: 1988/09/09 First Use In Commerce: 1989/02/01 pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes		

U.S. Application No.	78188022	Application Date	11/22/2002
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	ICE ICE BABY ICEBERG		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 2005/09/26 First Use In Commerce: 2005/09/26 SHOULDER BAGS, PURSES, HANDBAGS, WALLETS Class 025. First use: First Use: 2005/09/26 First Use In Commerce: 2005/09/26 JACKETS, BELTS, NECKTIES, SKIRTS, BLOUSES, SHIRTS, DRESSES,		

	HOSIERY, SCARVES, SHAWLS, COATS, JEANS, JOGGING SUITS, LOUNGEWEAR, PANTSUITS, RAINWEAR, SHORTS, SLACKS, SOCKS, HATS, CAPS, SHOES, BOOTS
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Attachments	73630331#TMSN.gif ( 1 page )( bytes ) 75419252#TMSN.gif ( 1 page )( bytes ) 73630330#TMSN.gif ( 1 page )( bytes ) 79004920#TMSN.jpeg ( 1 page )( bytes ) 79004921#TMSN.jpeg ( 1 page )( bytes ) 73712278#TMSN.gif ( 1 page )( bytes ) 75451595#TMSN.gif ( 1 page )( bytes ) 75334594#TMSN.gif ( 1 page )( bytes ) Gilmar ICING ICE Notice of Opposition.pdf ( 9 pages )(25308 bytes )
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Signature	/Dennis H. Cavanaugh/
Name	Dennis H. Cavanaugh
Date	09/28/2007

## 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 78/861,879 in International Class 35 and opposes the same. As grounds for the opposition it is alleged that:

1. The applicant, CBI Distributing Corporation (“Applicant”) is, upon information and belief, a corporation organized and existing under the laws of the State of Delaware, with a place of business located at 2400 West Central Road, Hoffman Estates, Illinois, 60195.

2. On or about April 14, 2006, Applicant filed the above-referenced trademark application to register the mark ICING ICE for “Retail and online store services dealing primarily in clothing, clothing accessories, hair goods, jewelry, cosmetics, hand bags and leather goods, furnishings in the nature of room accessories, picture frames, inflatable furniture, pillows, key chains, room accessories, stationery items” in International Class 35 under Section 1(b).

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 the late 1990s, Gilmar introduced a line of colorful and stylish jeanswear labeled “ICE JEANS” to appeal to young and demanding consumers sensitive to the latest trends in fashion and design.

6. Opposer adopted and has been using the marks ICE, ICEBERG, ICE J, ICE JEANS, IJ JEANS ICEBERG, ICE HISTORY and SPORT ICE (the “ICE Marks”) in interstate commerce since long prior to April 14, 2006, the date of Applicant’s filing, as trademarks to identify its items of wearing apparel and other goods. Opposer continues to use the ICE Marks 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 ICE Marks.

7. Gilmar is the owner of the following registrations on the Principal Register of the U.S. Patent and Trademark Office:

a. Registration No. 1,269,297 for ICEBERG, issued March 6, 1984, for “T-shirts, skirts, trousers, shirts, jackets and blazers” in Class 25, which registration is valid and subsisting and has never been abandoned;

b. Registration No. 1,850,734 for ICE, issued August 23, 1994, for “clothing, namely, men’s and women’s suits, coats, caps, shirts, T-shirts, belts, vests, scarves, skirts, ties, shorts, bathing suits, dresses, jackets, sweaters, jeans, pajamas, kerchiefs, underwear, shoes” in Class 25, which registration is valid and subsisting and has never been abandoned;

c. Registration No. 1,477,299 for ICEBERG JEANS and Design, issued February 23, 1988, for “men's and women’s clothing, namely, jackets, belts, neckwear, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men’s and women’s blazers, coats, jackets, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sports coats, hats, caps, gloves, kerchiefs, shoes, boots, and



slippers” in Class 25, which registration is valid and subsisting and has never been abandoned;

d. Registration No. 2,222,782 for IJ ICEBERG JEANS, issued February 9, 1999, for “handbags, Wallets” in Class 18 and for “clothing, namely, sweaters, t-shirts, sweat shirts, pants, skirts, knit skirts, jackets, gilets, knit gilets, sport jackets, leather jackets, shorts, blousons, dresses, coats, leather pants, knit scarves, belts, gloves, shoes, cardigans, bodies” in Class 25, which registration is valid and subsisting and has never been abandoned;

e. Registration No. 1,477,298 for ICEBERG SPORT ICE, issued February 23, 1988 in International Classification No. 25 for “men’s and women’s clothing, namely, jackets, belts, neckwear, sweaters, suits, shirts, blouses, skirts, dresses, hosiery, scarves, shawls, men’s and women’s blazers, coats, jackets, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sports coats, hats, caps, gloves, kerchiefs, shoes, boots, and slippers” in Class 25, which registration is valid and subsisting and has never been abandoned;

f. Registration No. 3,029,399, for ICE B, issued December 13, 2005, for “Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attaché cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks” in Class 18 and for “Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests,

tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers” in Class 25;

g. Registration No. 3,029,400, for ICE B ICEBERG, issued December 13, 2005, for “Leather and imitations of leather, and goods made of these materials and not included in other classes, namely, bags, travel bags, wallets, hand bags, brief cases, purses, belts, card holders, key rings, keychains, umbrellas, attachè cases, garment bags, suitcases, athletics bags, duffle bags, overnight cases, vanity cases, key cases, shoulder bags, and trunks” in Class 18 and for “Clothing, namely, skirts, dresses, suits, pants, jeans, blazers, jackets, coats, rainwear, sport coats, t-shirts, sweaters, sweat shirts, blouses, hosiery, gilets, vests, tops, shorts, bathing suits, jogging suits, loungewear, pantsuits, shawls, foulards, scarves, gloves, socks, belts, ties, hats, caps, shoes, boots and slippers” in Class 25; and

h. Registration No. 1,595,934 for AISBERG, issued May 15, 1990 for “men's and women's clothing, namely, jackets, sweaters, shirts, blouses, skirts, dresses, jackets” in Class 25, which registration is valid and subsisting and has never been abandoned.

8. Gilmar is also the owner of the following additional registrations on the Principal Register of the U.S. Patent and Trademark Office:

a. 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, and for “Luggage, trunks, traveling bags, purses, [and key holding wallets] of leather” in Class 18, which registration is valid and subsisting and has never been abandoned; and

b. Registration No. 2,909,353 for SPORT ICE and Design, issued December 14, 2004, for “handbags, backpacks, fanny packs, tote bags, cosmetic cases sold empty” in Class 18 and for “pants, shirts, shorts, jackets, sweatshirts, sweaters, T-shirts, blouses, sweatsuits, rainwear, coats, dresses, vests, knit tops, leotards, robes” in Class 25, which registration is valid and subsisting and has never been abandoned.

9. Gilmar is also the owner of pending application to register the following mark on the Principal Register of the U.S. Patent and Trademark Office:

a. Serial No. 78/188,022, for ICE ICE BABY ICEBERG, filed on November 22, 2002, for “shoulder bags, purses, handbags, wallets” in Class 18 and for “jackets, belts, neckties, suits, skirts, blouses, shirts, dresses, hosiery, scarves, shawls, men's and women's blazers, coats, jeans, jogging suits, loungewear, pantsuits, rainwear, shorts, slacks, socks, sport coats, hats, caps, shoes, boots and slippers” in Class 25.

10. In addition to its use of its ICE Marks on clothing products, Opposer has also used and developed significant consumer recognition in one or more of the ICE Marks for various products closely related to clothing, such as cosmetics and fragrances, eyeglasses and sunglasses, jewelry, and bags, purses and small leather goods.

11. The ICEBERG collection of knitwear and sportswear and the ICE and ICE JEANS 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 the latter 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.

12. Also as a result of said extensive promotional activities, the marks pleaded in paragraph 7, 8 and 9 constitute a family of “ICE” marks. “ICE” is the distinctive common element in all of Opposer’s ICE Marks. The relevant purchasing public of the Opposer’s goods associates the distinctive common element ICE with Opposer. Opposer has promoted its ICE Marks and the goods sold under them jointly so as to reinforce the public’s association of the common ICE element with a single source of origin for Opposer’s goods.

13. Gilmar has diligently and successfully acted to enforce its trademark rights alleged herein against third parties. For example, Gilmar has obtained judgments of the Trademark Trial and Appeal Board against the following applications: Ser. Nos. 74/719,295 for ICE LEGENDS; 74/493,984 for ICE CITY; 75/028,064 for ICE (Stylized); 75/776,295 for ICE B; 75/276,005 for ICEBURGH; 75/510,148 for ICEBOX; 76/040,746 for ICE AGE and Design; and 78/060,073 for ICE CUBE. Gilmar’s Exclusive U.S. licensee, Gilmar Divisione Industria, S.p.A., also obtained a consent judgment in the U.S. District Court for the Southern District of New York, Civil Action No. 03 CV 9244 (RCC) (RLE), in which the Court held that “[u]nauthorized use of any of the ICE Family Trademarks by Defendants, or any colorable imitation thereof, after the date of this Order, and except as provided for in this Order, will

constitute trademark infringement, the use of a false designation of origin, unfair competition and dilution of Gilmar's rights as against the infringing party."

14. Applicant's filing date of April 14, 2006 is subsequent to several of Opposer's dates of first use of its ICE Marks, and the dates of its registrations thereof. Thus, priority is not at issue.

15. Applicant's mark ICING ICE is confusingly similar in sight, sound and meaning to Opposer's ICE Marks. Applicant's mark is virtually identical to Opposer's ICE Marks. Consequently, Applicant's mark so closely resembles Opposer's ICE Marks as to be likely to be confused with and mistaken for Opposer's ICE Marks. As a result, there is a significant likelihood of confusion between Applicant's mark and Opposer's ICE Marks.

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

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

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

19. The addition of the term "ICING" to the Applicant's mark does not avoid a likelihood of confusion because "ICE" is clearly the dominant portion of said mark, and "ICE" is identical to the federally registered trademark ICE owned and used by Gilmar pleaded above.

20. 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 ICE Marks. Persons familiar with Opposer's ICE Marks are likely to patronize Applicant's retail and online stores believing they are affiliated with and/or endorsed by Opposer, when in fact they are not.

21. 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 ICE Marks. 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 ICE Marks, its business and to the goodwill of such business symbolized by Opposer's ICE Marks. Registration of Applicant's mark will also tend to reduce the distinctiveness, value and goodwill of Opposer's ICE Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of the Applicant's mark in Class 35, Application Serial No. 78/861,879, and opposes registration thereof on the grounds set forth above. Opposer further prays that Application Serial No. 78/861,879 be rejected, and that registration of Applicant's mark therein sought for the goods specified therein in Class 35 be denied and refused.

The \$300 fee for one class required under § 2.6(a)(17) is enclosed herewith.

Dated: New York, New York  
September 29, 2007

Respectfully submitted,

GILMAR S.p.A.

/Dennis H. Cavanaugh/

By: \_\_\_\_\_

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