

ESTTA Tracking number: **ESTTA287473**

Filing date: **06/03/2009**

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	Milano Series International Products, Ltd.
Granted to Date of previous extension	06/03/2009
Address	453 North MacQuesten Parkway Mt. Vernon, NY 10552 UNITED STATES

Attorney information	Roberta S. Bren Oblon, Spivak, McClelland, Maier & Neustadt, P.C. 1940 Duke Street Alexandria, VA 22314 UNITED STATES tmdocket@oblon.com, ndyson@oblon.com Phone:703-413-3000
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**Applicant Information**

Application No	77571320	Publication date	02/03/2009
Opposition Filing Date	06/03/2009	Opposition Period Ends	06/03/2009
Applicant	Ferguson Enterprises, Inc. 12500 Jefferson Ave. Newport News, VA 236024314 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 021. All goods and services in the class are opposed, namely: Bathroom accessories, namely, towel bars, towel rings, toilet tissue holders, toothbrush holders, cup holders, soap dishes and soap dispensers
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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.	1900675	Application Date	05/27/1994
Registration Date	06/20/1995	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of	NONE		

Mark	
Goods/Services	Class 020. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 picture frames Class 021. First use: First Use: 1990/00/00 First Use In Commerce: 1990/00/00 candlesticks not of precious metal

U.S. Registration No.	1457327	Application Date	02/06/1987
Registration Date	09/15/1987	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 011. First use: First Use: 1986/11/09 First Use In Commerce: 1986/11/13 PORTABLE OUTDOOR SHOWERS		

U.S. Registration No.	1478357	Application Date	09/19/1986
Registration Date	03/01/1988	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 PORTABLE CALCULATORS Class 018. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 LUGGAGE AND DUFFEL BAGS Class 020. First use: First Use: 1982/02/00 First Use In Commerce: 1982/02/00 [ OUTDOOR FURNITURE, CUSHIONS AND REPLACEMENT CANVASSES FOR OUTDOOR FURNITURE ]		

U.S. Registration No.	1367656	Application Date	08/16/1984
Registration Date	10/29/1985	Foreign Priority Date	NONE
Word Mark	MILANO SERIES		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 1981/09/01 First Use In Commerce: 1981/09/01 FILE CABINETS AND OFFICE FURNITURE		

Attachments	MILANO-OPPOSITION.pdf ( 6 pages )(182821 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	/Roberta S. Bren/nmd/
Name	Roberta S. Bren
Date	06/03/2009

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

_____	)	
MILANO SERIES INTERNATIONAL	)	
PRODUCTS, LTD.,	)	
	)	
Opposer,	)	Opposition No.: _____
	)	Appln. Serial No. 77/571320
v.	)	Mark: MILANO
	)	
FERGUSON ENTERPRISES, INC.	)	
	)	
Applicant.	)	
_____	)	

The Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

**NOTICE OF OPPOSITION**

In the matter of the application for registration of the mark MILANO for bathroom accessories, namely towel bars, towel rings, toilet tissue holders, toothbrush holders, cup holders, soap dishes and soap dispensers, in International Class 21, Application Serial No. 77/571320, filed September 16, 2008, which was published in the Official Gazette of the United States Patent and Trademark Office on February 3, 2009.

Milano Series International Products, Ltd. is a corporation organized and existing under the laws of the State of New York with a place of business at 453 North MacQuesten Parkway, Mount Vernon, NY 10552, and believes that it would be damaged by registration of the mark shown in Serial No. 77/571,314, and hereby opposes same.

As grounds for opposition it is alleged that:

1. Since prior to September 16, 2008, Opposer has been, and Opposer is now, engaged in the marketing, shipment and sale of household, stationery and personal items under the mark MILANO SERIES (“Opposer’s Mark”).

2. Opposer’s products sold under Opposer’s Mark includes, but are not limited to picture frames, hampers, trays, containers, jewelry cases and cosmetic cases.

3. Opposer is the owner of and will rely herein, upon the following Federal trademark registrations:

<u>MARK</u>	<u>REGISTRATION NO.</u>	<u>ISSUED</u>
MILANO SERIES	1,900,675	June 20, 1995
MILANO SERIES	1,457,327	Sept. 15, 1987
MILANO SERIES	1,478,357	March 1, 1988
MILANO SERIES	1,367,656	Oct. 29, 1985

Said registrations of Opposer are valid and subsisting and have achieved incontestable status, and are conclusive evidence of Opposer’s exclusive right to use the marks in commerce on the goods specified in said registrations. Commencing long prior to Applicant’s filing date, Opposer, through its predecessor, has used, and Opposer is now using, Opposer’s Mark in connection with Opposer’s goods distributed and sold by Opposer in commerce.

4. Since the initial use of the MILANO SERIES mark, Opposer and its predecessor have for many years advertised and promoted goods under the MILANO SERIES mark. Opposer and its predecessor have used, advertised, promoted and offered Opposer’s goods bearing Opposer’s Mark to the relevant purchasing public in commerce, with the result that Opposer’s customers and potential purchasers know and recognize Opposer’s Mark and associate same with Opposer

and/or goods sold by Opposer. Opposer has built goodwill in connection with the sales of products under Opposer's Mark.

5. Opposer will also rely herein on its common law rights in and to its MILANO SERIES trademark and trade name used on personal and household items not identified in the Federal trademark registrations.

6. Opposer has sold bathroom accessories under the mark MILANO SERIES.

7. Opposer currently sells trays under the mark MILANO SERIES that are promoted for use in bathrooms with other bathroom accessories.

8. Opposer continues to provide samples and discuss the sale of MILANO SERIES bathroom accessories with customers.

9. Applicant seeks to register the mark MILANO for bathroom accessories, namely towel bars, towel rings, toilet tissue holders, toothbrush holders, cup holders, soap dishes and soap dispensers (hereinafter "Applicant's goods").

10. Upon information and belief, Applicant did not make any use in interstate commerce or commerce with the United States of its mark, MILANO on or in connection with Applicant's goods prior to September 16, 2008.

11. Upon information and belief, Applicant's goods, as identified in the application, under the trademark MILANO, are or will be distributed in and through the same channels of commerce and/or sold and/or rendered to the same classes of purchasers of Opposer's products under Opposer's MILANO SERIES mark.

12. Applicant's mark MILANO is confusingly similar in sound, appearance, meaning and commercial impression to Opposer's MILANO SERIES mark.

13. Opposer believes and alleges that consumers are likely to believe that MILANO identifies goods which originate with Opposer.

14. Applicant's use and registration of the mark MILANO will enable Applicant to trade upon and utilize the goodwill established by Opposer in Opposer's Mark.

15. Opposer believes and alleges that Applicant's trademark when applied to Applicant's goods is likely to cause confusion or mistake or to deceive and will deceive and mislead the purchasing public into believing that Applicant is licensed or controlled by Opposer or that Applicant is a subsidiary of or in some way related to Opposer. Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d).

16. Opposer, upon information and belief, avers that it will be damaged by the registration by Applicant of the MILANO trademark, as set forth in Applicant's Application Serial No. 77/571320, in that the mark is confusingly similar to Opposer's MILANO SERIES Mark and common law rights and will be used in connection with goods closely related to the goods offered by Opposer.

WHEREFORE, this Opposer, Milano Series International Products, Ltd., believes and avers that it is being and will continue to be damaged by registration of the MILANO trademark as aforesaid, and prays that said Application Serial No. 77/571,320 be rejected, that no registration be issued thereon to Applicant, and that this Opposition be sustained in favor of Opposer.

#### **POWER OF ATTORNEY**

The undersigned hereby appoints Roberta S. Bren, and the following attorneys of the law firm of OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., as its attorneys with full powers of substitution and revocation, to file and prosecute this opposition.

Norman F. Oblon  
Marvin J. Spivak  
Gregory J. Maier  
Arthur I. Neustadt  
David J. Kera  
Jeffrey H. Kaufman  
Brian D. Anderson  
Roberta S. Bren  
Jonathan Hudis  
Jordan S. Weinstein

Kathleen Cooney-Porter\*  
Beth A. Chapman\*  
Jeffrey S. Molinoff\*  
Christopher I. Donahue  
Kyoko Imai  
David H. Aleskow\*  
Kelley Clements Keller  
Richard D. Kelly  
James D. Hamilton  
Eckhard H. Kuesters

Robert T. Pous  
Charles L. Gholz  
Jean-Paul Lavalleye  
Stephen G. Baxter  
Richard L. Treanor  
Steven P. Weihrouch  
Richard L. Chinn

Members of the Bar of Virginia (except as indicated)

\* Member of the Bar of the District of Columbia


\*\* Member of Bar other than Virginia

Please address all correspondence to **Roberta S. Bren** at OBLON, SPIVAK, McCLELLAND, MAIER & NEUSTADT, P.C., 1940 Duke Street, Alexandria, Virginia 22314.

We enclose our credit card payment form in the amount of \$300.00 for the required filing fee for this Opposition. In the event any variance exists between the amount enclosed and the Patent and Trademark Office charges, please charge or credit the difference to our Deposit Account No. 50-2014.

Respectfully submitted,

MILANO SERIES INTERNATIONAL  
PRODUCTS, LTD.

By:   
Roberta S. Bren  
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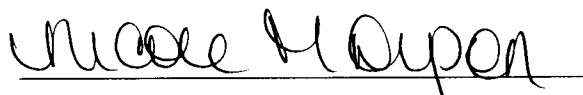
Date: June 3, 2009

RSB/nmd {1081950\_1.DOC}

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing NOTICE OF OPPOSITION was served on counsel for Applicant, this 3<sup>rd</sup> day of June, 2009, by sending same via First Class mail, postage prepaid, to:

Mary F. Love, Esq.  
Law Office of Mary F. Love  
3509 Connecticut Avenue NW PMB 130  
Washington, D.C. 2008-2400

A handwritten signature in black ink, appearing to read "Nicole M. Dyson", is written over a horizontal line.

Nicole M. Dyson