

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

----- X
ERMENEGILDO ZEGNA CORPORATION, :

Plaintiff, :

- against - :

56TH STREET MENSWEAR, INC., :

Defendant. :

COMPLAINT

Jury Trial Demanded

SEP 29 2006

U.S.D.C. S.D. N.Y.
CASHIERS

----- X
Plaintiff ERMENEGILDO ZEGNA CORPORATION ("EZCo" or "Plaintiff"),
by and through its undersigned counsel, as and for its complaint against defendant 56th Street
Menswear, Inc. ("Menswear" or "Defendant") alleges as follows:

NATURE OF ACTION

1. This is an action for counterfeiting, trademark infringement, dilution, and unfair competition in violation of the Lanham Act, as amended, 15 U.S.C. § 1051 et seq., and for dilution, false advertising and unfair competition in violation of New York State law.

2. This action relates to sales of counterfeit goods that infringe Plaintiff's registered trademarks ERMENEGILDO ZEGNA[®] (U.S. Reg. Nos. 1,077,923, 1,232,830 and 0612666, *inter alia*); and ZEGNA[®] (U.S. Reg. No. 1,258,643, *inter alia*, and many others (collectively, the "Zegna Marks"), due to Defendant's unauthorized uses of the Zegna Marks in connection with suits it offers for sale, in connection with misleading sales practices regarding those suits, and in connection with mislabeling those suits. Plaintiff seeks a permanent injunction; an accounting; a Court order requiring Defendant to destroy, or produce for

destruction, all counterfeit Zegna Mark goods; damages in an amount to be determined at trial and, in the alternative, statutory damages pursuant to 15 U.S.C. §1117.

PRELIMINARY STATEMENT

3. The Ermenegildo Zegna Group, which includes EZCo and more than a dozen other affiliated Ermenegildo Zegna entities, has been in the business of manufacturing and designing fine apparel and goods for nearly a century. The Zegna Marks are recognized as signifiers of top-of-the-line clothing, fabric and accessories originating with EZCo and its affiliates. Goods bearing Zegna Marks are recognized for their stylish design and durability. Over EZCo's long life, its trademarks have built up significant good will, in part because genuine Zegna Mark goods are reliably high quality goods.

4. In an effort to trade on the goodwill that Plaintiff has developed in the Zegna Marks, Menswear has traded in counterfeit suits that bear a Zegna Mark but are not genuine and do not originate with Plaintiff or any of its affiliates. Moreover, although those suits bore labels indicating that it was the mills of EZCo or an affiliate that had produced the fabric used in the suits, the fabric was not genuine.

THE PARTIES

5. Plaintiff EZCo is a corporation incorporated under the laws of the State of New York, and having its principal place of business at 100 West Forest Avenue, Unit A, Englewood, New Jersey 07631-4033.

6. Upon information and belief, Defendant Menswear is a corporation incorporated under the laws of the State of New York with its principal place of business at 54 West 56th Street, New York, New York.

JURISDICTION AND VENUE

7. This Court has jurisdiction over this action under 15 U.S.C. §§ 1121(a), 28 U.S.C. §§ 1331; and 1338(a) because this action involves Lanham Act claims.

8. This Court has jurisdiction over Defendant's trademark dilution and unfair competition claims under 28 U.S.C. § 1338 (b) in that said claims are joined with a substantial and related claim under the Lanham Act. This court has supplemental jurisdiction over Defendant's state law claims under 28 U.S.C. § 1367(a).

9. Venue is proper in this judicial district under 28 U.S.C. § 1391(b) and (c) because upon information and belief, a substantial number of the events giving rise to the claims occurred in this judicial district, in that Defendant operates its business within this District, as well as sells and distributes infringing goods and services here.

FACTS

The Zegna Marks

10. The Ermenegildo Zegna Group is comprised of EZCo and its many affiliates. It is a leader in high-end, high quality goods, especially suits, knitwear, fabrics, accessories, sportswear, perfume and eyewear. It produces more than two million yards of fabric, 500,000 sleeve units, almost 1.5 million sportswear items, and 1.7 million accessories annually. The Ermenegildo Zegna Group has more than 5,000 employees worldwide. It earned approximately \$787 million in 2004, ninety percent from clothing and accessories and ten percent from textiles. In 2005, its return increased by 12.5%, totaling approximately \$885 million. More than eighty-six percent (86%) of its sales are exports.

History

11. The young entrepreneur Ermenegildo Zegna founded his company in 1910 in Trivero, Italy, a small town in the Biella Alps. From the beginning, Mr. Zegna's aim was creating superb fabrics for use in clothing. He made his mark by carefully selecting outstanding raw materials from their markets of origin, creating innovative fabrics and designs, and closely monitoring the production process and the brand's promotion.

12. The business passed from Ermenegildo Zegna to his sons. It remains a family business, presently managed by the fourth generation.

13. Within the United States, EZCo and its predecessors have used and promoted the Zegna Marks for more than sixty years, continuing without interruption to the present time. The Zegna Marks have been used and promoted in the United States in connection with clothing, clothing accessories, jewelry, sunglasses, eau de toilette and retail stores.

14. There is an Ermenegildo Zegna boutique at the prominent address 663 Fifth Avenue, in Mid-Town New York City. Worldwide, there are over 180 fully owned boutiques throughout Europe and in Russia, Japan, China, South America and the Middle East.

15. Goods sold under the Zegna Marks include a sporty diffusion line as well as marks for highly refined designs and made-to-measure clothing. In general, they are renowned for their quality and attract discriminating customers; most Zegna suits are priced in the \$2,000 to \$3,000 range.

16. Publicity of the Zegna Marks has included broadcasting to approximately 90 million 2006 Superbowl viewers the onscreen credit "ABC Sports Announcers Wardrobe Provided by Ermenegildo Zegna." During the game's broadcast, the

two announcers John Madden and Al Michaels wore ZEGNA suits, as they had throughout the season of Monday Night Football. Tom Brady, the defending Superbowl winner who introduced the 2006 game with its coin toss also wore ZEGNA apparel throughout the game.

17. Advertising of the Zegna Marks has included a magazine advertising campaign featuring the Oscar-winning actor Adrien Brody. Mr. Brody has repeatedly made public appearances in ZEGNA attire, including at the Golden Globes and the Council of Fashion Designers of America Awards. Celebrated actors at the 2003 Emmy Awards, such as Sean Hayes and the male cast of the comedy series Friends, appeared in ZEGNA suits.

18. Due in part to such publicity and celebrity appearances, the Zegna Marks have received extensive unsolicited media coverage.

19. In December 2000, the Ermenegildo Zegna Foundation was established. Its mission is to promote environmental, cultural, social and scientific initiatives in conjunction with not-for-profit organizations. The Foundation's efforts range from Muscular Dystrophy Research to teaching weaving to Hindi women who reside in remote areas in India.

Trademarks

20. On August 20, 1974, ERMENEGILDO ZEGNA® was registered on the Principal Register in the United States Patent and Trademark Office ("PTO") as U.S. Trademark Registration No. 1,077,923 ("Mark 1") in connection with suits, coats, neckties and scarves. The registration is incontestable under 15 U.S.C. § 1065. A copy of the U.S. Patent and Trademark Office's Trademark Electronic Search System (TESS) record for Mark 1 is annexed hereto as Exhibit A. By its predecessors, Plaintiff began using Mark 1 in commerce in 1938. Since then, that Mark 1 has extensively and continuously been used in connection with suits, coats, neckties and scarves.

21. On March 29, 1983, ERMENEGILDO ZEGNA[®] was registered on the Principal Register in the PTO as U.S. Trademark Registration No. 1,232,830 ("Mark 2") in connection with a wide range of apparel, from shoes and belts to formal shirts and bathing suits. The registration is incontestable under 15 U.S.C. § 1065. A copy of the TESS record for Mark 2 is annexed hereto as Exhibit B. By its predecessors, Plaintiff began using Mark 2 in commerce in 1938. Since then, that Mark 2 has extensively and continuously been used in connection with apparel and accessories.

22. On September 20, 1955, ERMENEGILDO ZEGNA[®] was registered on the Principal Register in the PTO as U.S. Trademark Registration No. 612,666 ("Mark 3") in connection with fabrics of wool, hair, vegetable hair, silk, rayon, jute, hemp, flax and cotton. The registration is incontestable under 15 U.S.C. § 1065. A copy of the TESS record for Mark 3 is annexed hereto as Exhibit C. By its predecessors, Plaintiff began using Mark 3 in commerce in 1955. Since then, Mark 3 has extensively and continuously been used in connection with fabrics.

23. On August 30, 1983, ZEGNA[®] was registered on the Principal Register in the United States PTO as U.S. Trademark Registration No. 1,258,643 ("Mark 4") in connection with a wide range of apparel, from shoes and belts to formal shirts and bathing suits. The registration is incontestable under 15 U.S.C. § 1065. A copy of the U.S. Patent and Trademark Office's TESS record for Mark 4 is annexed hereto as Exhibit D. Plaintiff began using Mark 4 in commerce in 1982. Since then, EZCo has extensively and continuously used Mark 4 in connection with apparel and accessories.

24. On November 4, 2005, 2005, Z[®] was registered on the Principal Register in the PTO as U.S. Trademark Registration No. 78,747,178 ("Mark 5") in connection with

footwear and belts. The registration is incontestable under 15 U.S.C. § 1065. A copy of the TESS record for Mark 5 is annexed hereto as Exhibit E. By its predecessors, Plaintiff began using Mark 5 in commerce in 2004. Since then, Mark 5 has extensively and continuously been used in connection with footwear and belts.

25. In order to protect the Zegna Marks and their goodwill, EZCo consistently polices and protects the Marks, including by regularly sending cease and desist letters upon becoming aware of the misuse of any Zegna Mark. It has filed its registrations with the U.S. Customs Service. It has successfully challenged many unauthorized uses, convincing the party responsible for the misuse to cease use.

26. In sum, EZCo ensures that any use of the Zegna Marks is in connection with genuine goods as those alone reflect the high quality and style standards that have built the brand and its goodwill.

27. Plaintiff has used the Zegna Marks to identify its goods and to distinguish them from those made and sold by others, by, among other things, prominently displaying the Marks on genuine EZCo goods and the tags, labels and the containers associated with them. Also, Plaintiff has prominently displayed the Marks on its storefronts, at its website, at events it sponsors, in print advertising and in its letterheads, bills and direct mail advertising. Through EZCo's extensive promotional efforts, the Zegna Marks have become famous and widely known as exclusively associated with EZCo and its products.

DEFENDANT'S INFRINGING USE OF THE ZEGNA MARKS

28. Menswear operates a menswear store located at 54 West 56th Street, New York, New York.

29. In or about February, 2006, EZCo became aware that suits identified as "Tessuto Lanificio Ermenegildo Zegna" were being promoted and sold at Menswear's store. In fact Menswear advertises on the sidewalk directly in front of its store that it offers "Zegna" suits for sale. A copy of a picture of Menswear's advertisement as of August 30, 2006 is annexed hereto as Exhibit F.

30. However, the goods offered for sale by Menswear and identified as EZCo products in connection with Zegna Marks are neither manufactured nor designed by EZCo or any other entity in the Ermenegildo Zegna Group. Nor are they made with genuine Tessuto Ermenegildo Zegna fabric. Indeed, a label inside the suit identified the suit as "Taslimant Collezioni" a trade name which is not used, and never has been used by EZCo or the Ermenegildo Zegna Group. Nevertheless, these goods bear the Tessuto Ermenegildo Zegna garment labels indicating they are made with such fabric and bearing the Ermenegildo Zegna design and word trademark of a ribbon and seal (see, e.g. Exhibit C, U.S.Reg. No. 612,666).

31. Upon purchasing and inspecting one of the suits offered for sale by Menswear in connection with the Zegna Marks, Plaintiff discovered that the suit was not designed and manufactured by EZCo for sale under Zegna Marks.

32. Moreover, despite the presence of a label purporting to indicate that the suit purchased from Menswear was manufactured with genuine Tessuto Ermenegildo Zegna fabric and bearing the Zegna Mark ribbon and seal design (see, e.g., Exhibit C, U.S. Reg. No. 612,666), Plaintiff has confirmed that the fabric is not genuine Tessuto Ermenegildo Zegna fabric.

33. In sum, the suit purchased by Plaintiff from Menswear is counterfeit, bearing Zegna Mark labels affixed to fabric which was not manufactured by EZCo.

34. Menswear knew the suits were counterfeit or was willfully blind to their being counterfeit. Despite advertising on its leaflets and in its store windows that Menswear offered Ermenegildo Zegna suits for sale, when confronted with the accusation that the suits were not true Ermenegildo Zegna suits, Menswear's own sales staff admitted the counterfeit labeling of the suits as Tessuto Ermenegildo Zegna, but indicated that the suits were made with Tessuto Ermenegildo Zegna fabric - an equally false claim.

35. Indeed, based on pricing alone - Plaintiff purchased the suit from Menswear for \$542.06 - Menswear should have been aware that the garment was counterfeit. Genuine Zegna suits retail for approximately \$2,500.

36. Thus, even if the fabric had been genuine, Menswear still improperly and wrongfully sold the suits as manufactured and designed by EZCo.

37. Upon information and belief, Menswear made reference to the Zegna Marks and displayed the image of the Tessuto Ermenegildo Zegna garment label for the purpose of confusing members of the public into believing their infringing merchandise was genuine ZEGNA clothing.

38. On or about March 15, 2006, counsel for EZCo wrote a letter to Menswear notifying it of EZCo's rights to the Zegna Marks and that its acts constituted infringement. In the letter it was also demanded that Menswear immediately cease and desist all sales of any suit or other clothing under the designation "E. Zegna" and "Tessuto Ermenegildo Zegna" or any other related "Zegna" designation at the Menswear stores or through any other outlet. A copy of that letter is attached hereto as Exhibit G.

39. When Menswear failed to respond, on or about March 28, 2006, counsel for EZCo wrote another letter to Menswear, which was mailed and hand delivered to Menswear, reiterating the demands. A copy of that letter is attached hereto as Exhibit H.

40. Defendant has never had any legitimate basis to use the Zegna Marks.

41. When Defendant began to use the Zegna Marks, it had constructive notice of the trademarks as a result of Plaintiff's registration and as a result of Plaintiff's extensive advertising and promotion of the Zegna Marks.

42. In any event, Menswear also had actual notice that the Zegna Marks are registered trademarks since at least as early as March 15, 2006, when Plaintiffs sent their initial cease and desist letter to Menswear. Despite this letter, Menswear continues to infringe the Zegna Marks.

43. Defendant's use of Zegna Marks is likely to cause confusion. Its use of the Zegna Marks constitutes trademark infringement and unfair competition in violation of federal and state law.

44. Upon information and belief, Defendant's uses of the Zegna Marks have caused actual confusion.

FIRST CAUSE OF ACTION

(Trademark Infringement Under Section 32 of the Lanham Act, 15 U.S.C. § 1114)

45. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 49, inclusive, set forth above, as if the same were set forth fully herein.

46. Defendant, without consent of Plaintiff, has used in interstate commerce designations confusingly similar to Plaintiff's registered Zegna Marks on or in connection with

the sale, offering for sale, distribution and/or advertising of Defendant's goods and services. Such use has caused and is likely to cause confusion, or to cause mistake, or to deceive.

47. The aforesaid acts of Defendant constitute trademark infringement in violation of Section 32(1) of the Lanham Act, 15 U.S.C. § 1114.

48. Upon information and belief, Defendant's infringement was intentional, willful and in bad faith.

49. EZCo lacks an adequate remedy at law and will suffer irreparable harm unless a permanent injunction is issued enjoining Defendant's continued infringement of the Zegna Marks.

50. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial.

SECOND CAUSE OF ACTION

(Unfair Competition and False Designation of Origin Under Section 43 of the Lanham Act, 15 U.S.C. § 1125)

51. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 55, inclusive, set forth above, as if the same were set forth fully herein.

52. Defendant's use of the Zegna Marks and name in interstate commerce, in connection with its fabrics and garments without EZCo's permission, has and is likely to cause confusion and mistake and is likely to deceive the public as to EZCo's affiliation, connection, association, sponsorship and/or approval of Defendant's goods and services.

53. Defendant's acts of using the Zegna Marks in interstate commerce, without EZCo's permission, constitute unfair competition, passing off, and false designation of origin under Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

54. Upon information and belief, Defendant's acts trading on the reputation and goodwill associated with the Zegna Marks were intentional, willful and in bad faith.

55. EZCo lacks an adequate remedy at law and will suffer irreparable harm unless a permanent injunction is issued enjoining Defendant's continued unfair competition, passing off, and false designation of origin with respect to the Zegna Marks.

56. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial.

THIRD CAUSE OF ACTION

(Dilution Under Section 43 of the Lanham Act, 15 U.S.C. § 1125)

57. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 61 inclusive, set forth above, as if fully set forth herein.

58. Plaintiff's Zegna Marks are distinctive and famous marks. The Zegna Marks are inherently strong and distinctive; have long been used in connection with fabric, suits and other garments, as well as other goods; have long been the featured subject of extensive advertising and promotion; have been used and advertised throughout the United States; are widely recognized by consumers and those in the trade; are in substantially exclusive use; and are federally registered, as alleged above.

59. Plaintiff's trademarks and service marks are distinctive and famous within the meaning of 15 U.S.C. §1125(c).

60. Defendant's acts were commenced and committed well after the Zegna Marks became famous. Indeed, upon information and belief, Defendant's acts were commenced and committed with the express intention of capitalizing on the Zegna Marks' fame.

61. In connection with goods that Defendant used and transported in United States interstate commerce, Defendant has made commercial use of the Zegna Marks owned by Plaintiff. Defendant's acts are in violation of Lanham Act § 43(c) in that they have caused dilution of the distinctive quality of Plaintiff's famous Zegna Marks, all to the irreparable injury and damage of Plaintiff.

62. Defendant's acts have lessened the capacity of Plaintiff's famous Zegna Marks to identify and distinguish Plaintiff's goods. Defendant's acts have blurred the unique association that has heretofore existed between Plaintiff's Zegna Marks and goods made by Plaintiff.

63. Upon information and belief, Defendant willfully intended to trade on Plaintiff's reputation and to dilute the famous Zegna Marks.

64. EZCo lacks an adequate remedy at law and will suffer irreparable harm unless a permanent injunction is issued enjoining Defendant's continued dilution of the Zegna Marks.

65. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial.

FOURTH CAUSE OF ACTION

(Injury to Business Reputation and Dilution Under New York General Business Law Section 360-l)

66. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 70, inclusive, set forth above, as if fully set forth herein.

67. Defendant's use of the Zegna Marks, without Plaintiff's permission, has caused and is likely to continue to cause injury to Plaintiff's business reputation and has and is likely to dilute the distinctive quality of the Zegna Marks.

68. Defendant's acts of using the Zegna Marks are likely to injure the business reputation of EZCo and to dilute the distinctive quality of the Zegna Marks in violation of New York General Business Law Section 360-1.

69. EZCo lacks an adequate remedy at law and will suffer irreparable harm unless a permanent injunction is issued enjoining Defendant's use of the Zegna Marks.

70. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial. EZCo is also entitled to (i) costs, and (ii) reasonable attorney's fees.

FIFTH CAUSE OF ACTION

(False Advertising under New York Law)

71. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 75, inclusive, set forth above, as if the same were set forth fully herein.

72. By the aforesaid acts, Defendant misleadingly advertised its goods, in that Defendant made false statements, using words, designs, devices, sounds or combinations thereof that were materially misleading with respect to those goods.

73. The aforesaid acts of Defendant constitute false advertising in the conduct of business, trade or commerce, or in the furnishing of any service in the State of New York, in violation of New York General Business Law § 350-e(3).

74. The aforesaid acts of Defendant have caused, and are continuing to cause, great and irreparable harm to EZCo. Unless permanently restrained by this Court, this irreparable injury will continue.

75. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial.

SIXTH CAUSE OF ACTION

(Unfair Competition under New York Law)

76. Plaintiff repeats and realleges each and every allegation pleaded in paragraphs 1 through 80, inclusive, set forth above, as if the same were set forth fully herein.

77. Defendant's acts of using the Zegna Marks, without Plaintiff's permission, constitute unfair competition, passing off, and false designation of origin under the common law of the State of New York.

78. EZCo lacks an adequate remedy at law and will suffer irreparable harm unless a permanent injunction is issued enjoining Defendant's continued unfair competition, passing off, and false designation of origin with respect to the Zegna Marks.

79. EZCo has been injured by Defendant's actions and is entitled to damages in an amount to be determined at trial. EZCo is also entitled to punitive damages in an amount to be determined at trial.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff prays, that the Court:

a. Permanently enjoin Defendant and all persons acting in concert with it, from using any Zegna Mark, and from using any other confusingly similar name and from passing off or otherwise representing to the public that their products are in any way sponsored by, created by, endorsed by, emanate from or are affiliated with Plaintiff;

b. Issue an Order requiring Defendant to account to Plaintiff for any and all profits derived by Defendant from sale of goods connected with the Zegna Marks and for all damages sustained by Plaintiff by reason of said acts of infringement and unfair competition complained of herein;

c. Issue an Order requiring Defendant to destroy, or produce for destruction, all counterfeit Zegna Mark goods;

d. Award Plaintiff treble damages or Defendant's profits, whichever is greater, plus prejudgment interest on that amount; and reasonable attorney's fees; or, in the alternative,

e. Award statutory damages pursuant to 15 U.S.C. § 1117 of \$1,000,000 per counterfeit mark; and

f. Award such other and further relief as the Court deems just and proper.

Dated: New York, New York
September 27, 2006

SATTERLEE STEPHENS BURKE & BURKE LLP

By: 

Mark Lerner (ML-4858)

Michael H. Gibson (MG-2952)

230 Park Avenue

New York, New York 10169

(212) 818-9200

Attorneys for Plaintiff Ermenegildo Zegna Corporation



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Typed Drawing

Word Mark	ERMENEGILDO ZEGNA
Goods and Services	IC 025. US 039. G & S: SUITS, COATS, NECKTIES, AND SCARVES. FIRST USE: 19370000. FIRST USE IN COMMERCE: 19380000
Mark Drawing Code	(1) TYPED DRAWING
Design Search Code	
Serial Number	73030059
Filing Date	August 20, 1974
Current Filing Basis	1A
Original Filing Basis	1A
Registration Number	1077923
Registration Date	November 22, 1977
Owner	(REGISTRANT) LANIFICIO ERMENEGILDO ZEGNA & FIGLI S.N.C. PARTNERSHIP ITALY VIA ROMA 20 TRIVERO (VERCELLI) ITALY (LAST LISTED OWNER) ERMENEGILDO ZEGNA CORPORATION ASSIGNEE OF NEW YORK 100 WEST FOREST AVENUE, UNIT A ENGLEWOOD NEW JERSEY 076314033
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	KENNETH R GLASER
Prior Registrations	0553019;0941547;AND OTHERS
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15.
Renewal	1ST RENEWAL 19970930
Live/Dead Indicator	LIVE



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Typed Drawing

Word Mark	ERMENEGILDO ZEGNA
Goods and Services	IC 025. US 039. G & S: Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, Long and Short Woven and Knit Underwear, Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, Boxer Shorts, Waistbands, Gloves, Balaklava, Jumpsuits, Skirts and Blouses. FIRST USE: 19370000. FIRST USE IN COMMERCE: 19380000
Mark Drawing Code	(1) TYPED DRAWING
Design Search Code	
Serial Number	73307737
Filing Date	April 27, 1981
Current Filing Basis	1A
Original Filing Basis	1A
Published for Opposition	January 4, 1983
Registration Number	1232830
Registration Date	March 29, 1983
Owner	(REGISTRANT) ERMENEGILDO ZEGNA CORPORATION CORPORATION NEW YORK 100 W FOREST AVE UNIT A ENGLEWOOD NEW JERSEY 07631
Attorney of Record	JOHN M CONE
Type of Mark	TRADEMARK
Register	PRINCIPAL
Affidavit Text	SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20030307.
Renewal	1ST RENEWAL 20030307
Other Data	"Ermenegildo Zegna" is derived from the name of the now deceased founder and owner of applicant's parent company in Italy.
Live/Dead Indicator	LIVE



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Word Mark	ERMENEGILDO ZEGNA
Goods and Services	IC 024. US 042. G & S: FABRICS OF WOOL, HAIR, VEGETABLE HAIR, SILK, RAYON, JUTE, HEMP, FLAX, COTTON
Mark Drawing Code	(3) DESIGN PLUS WORDS, LETTERS, AND/OR NUMBERS
Design Search Code	23.05.01 - Helmets, armor 24.01.02 - Shields or crests with figurative elements contained therein or superimposed thereon 24.05.01 - Circular or elliptical seals; Seals, circular or elliptical 24.07.07 - Prize ribbons; Ribbons, prize 26.01.07 - Circles with a decorative border, including scalloped, ruffled and zig-zag edges 26.01.28 - Circles with irregular circumferences; Miscellaneous circular designs with an irregular circumference
Serial Number	71657146
Filing Date	November 30, 1953
Current Filing Basis	44E
Original Filing Basis	44E
Registration Number	0612666
Registration Date	September 20, 1955
Owner	(REGISTRANT) LANIFICIO ERMENEGILDO ZEGNA & FIGLI PARTNERSHIP ITALY VIA ROMA 20 TRIVERO (VERCELLI) ITALY (LAST LISTED OWNER) ERMENEGILDO ZEGNA CORPORATION CORPORATION ASSIGNEE OF NEW YORK Unit A 100 West Forest Avenue ENGLEWOOD NEW JERSEY 07631
Assignment Recorded	ASSIGNMENT RECORDED
Attorney of Record	JOHN M. CONE
Prior	0553019;0553020

Registrations**Type of Mark**

TRADEMARK

Register

PRINCIPAL

Affidavit Text

SECTION 8(10-YR) 20050613.

Renewal

3RD RENEWAL 20050613

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LIVE

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Exhibit D



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Word Mark	Z
Goods and Services	IC 025. US 022 039. G & S: footwear, belts. FIRST USE: 20041100. FIRST USE IN COMMERCE: 20041100
Mark Drawing Code	(5) WORDS, LETTERS, AND/OR NUMBERS IN STYLIZED FORM
Design Search Code	
Serial Number	78747178
Filing Date	November 4, 2005
Current Filing Basis	1A
Original Filing Basis	1A
Owner	(APPLICANT) Eremengildo Zegna Corporation CORPORATION NEW YORK 100 West Forest Avenue Unit A Englewood NEW JERSEY 07631
Attorney of Record	John M. Cone
Type of Mark	TRADEMARK
Register	PRINCIPAL
Live/Dead Indicator	LIVE

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Typed Drawing

Word Mark ZEGNA
Goods and Services IC 025. US 022 039. G & S: Shoes, Belts, Hats, Ties, Scarves, Robes, Suits, Sports Jackets, Topcoats, Overcoats, Raincoats, Leather Coats and Jackets, Car Coats, Slacks, Vests, Knit and Woven Shirts, Formal and Sport Shirts, Bathing Suits, Short Pants, Sweaters, Socks, Quilted Jackets and Coats, Long Pants, [Long and Short Woven and Knit Underwear,] Athletic Shorts, Sleeveless and Sleeved Knit and Woven Shirts, [Boxer Shorts, Waistbands,] Gloves, Balaklava, [Jumpsuits, Skirts and Blouses]. FIRST USE: 19820616. FIRST USE IN COMMERCE: 19820616
Mark Drawing Code (1) TYPED DRAWING
Design Search Code
Serial Number 73390738
Filing Date September 28, 1982
Current Filing Basis 1A
Original Filing Basis 1A
Published for Opposition August 30, 1983
Registration Number 1258643
Registration Date November 22, 1983
Owner (REGISTRANT) Ermenegildo Zegna Corporation CORPORATION NEW YORK 100 WEST FOREST AVENUE, UNIT A ENGLEWOOD NEW JERSEY 07631
Attorney of Record JOHN M. CONE
Type of Mark TRADEMARK
Register PRINCIPAL
Affidavit Text SECT 15. SECT 8 (6-YR). SECTION 8(10-YR) 20040214.
Renewal 1ST RENEWAL 20040214
Live/Dead Indicator LIVE

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145

Designer
MENS WEAR

SALE

**UP
TO**

50% OFF

HUGO BOSS

DKNY

CALVIN KLEIN

RALPH LAUREN

VERSACE

ZEGNA

08/30/2006

SATTERLEE STEPHENS BURKE & BURKE LLP
230 PARK AVENUE
NEW YORK, NY 10169-0079
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SUMMIT, NJ 07901
(908) 277-2221

E-Mail: mlerner@ssbb.com
Direct Dial: (212) 404-8714

March 15, 2006

By FedEx

Ms. Louise DeMarco

56th Street Menswear, Inc.

~~307 W. 74th Street~~ 54 West 56th Street
~~New York, New York 10023~~ NY, NY 10019
(212) 957-1618

Re: Infringement of Ermenegildo Zegna Trademarks

Dear Ms. DeMarco:

We are counsel to Ermenegildo Zegna Corporation ("EZCO"), ZECO Trading SA, Consitex S.A., and Ermenegildo Zegna Holditalia SpA (collectively "Zegna"), owners of the registered trademarks ERMENEGILDO ZEGNA®, ZEGNA®, EZ ZEGNA®, the medallion design, and others (collectively the "Zegna Marks"). Zegna has used the Zegna Marks for over fifty years. The Zegna Marks are known worldwide and signify clothing, fabric and accessories originating with Zegna. The clothing is known for its high quality, style and durability. Zegna has built up substantial goodwill of great value in the marks due, in part, to the high quality of its goods.

It has come to our client's attention that the retail store operated by 56th Street Menswear, Inc. at 54 West 56th Street, New York, New York is selling suits labeled as "Tessuto Ermenegildo Zegna." Although a separate label inside the suit indicates "Taslimant Collezioni," a salesman at the store is selling these suits as Zegna suits and they are written up on receipts as Zegna suits. In general, the display of the "Tessuto Ermenegildo Zegna" on the sleeve label is intended to lead consumers to believe that the suit is a genuine Zegna brand suit, or is, at a minimum, made with Zegna brand fabric. Neither is the case. Our client was able to purchase and examine one of these suits and has determined that it is not a genuine ZEGNA® brand suit, nor is the fabric or even the "Tessuto Ermenegildo Zegna" label itself genuine.

Your sale of products bearing a "Tessuto Ermenegildo Zegna" label will lead to consumer confusion and constitutes counterfeiting and trademark infringement in a violation of the Lanham Act and state laws. Your continued sale of these goods in light of this notice will constitute evidence of willful infringement.


Ms. Louise DeMarco
March 15, 2006
Page 2

We therefore demand that you immediately cease all sales of any suit or other clothing under the designation "Tessuto Ermenegildo Zegna" or any other related "Zegna" designation at your stores. In addition, we demand that you deliver all the infringing stock that bears a label featuring a Zegna label to the undersigned and that you provide the undersigned with an accounting of all sales and profits received to date from the sale of goods under the Zegna Marks. Finally, we demand that you immediately provide to the undersigned all documents and information relating to the source(s) of the infringing/counterfeit suits or any other goods bearing the Zegna Marks.

If we do not receive the requested information and inventory by March 24, 2006, Zegna will not hesitate to take all steps necessary to protect its valuable intellectual property, including seeking actual and statutory damages under the Lanham Act.

In the interim, Zegna reserves all its rights in law and equity.

Very truly yours,



Mark Lerner

cc: Paolo Torello Viera
Paolo Orlandi
Albert A. Byer, Esq.

Exhibit H

SATTERLEE STEPHENS BURKE & BURKE LLP

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NEW YORK, NY 10169-0079

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E-Mail: mlerner@ssbb.com
Direct Dial: (212) 404-8714

March 28, 2006

By FedEx

Ms. Louise DeMarco
56th Street Menswear, Inc.
307 W. 74th Street
New York, NY 10023

56th Street Menswear, Inc.
54 West 56th Street
New York, NY 10019

Re: Infringement of Ermenegildo Zegna Trademarks

Dear Ms. DeMarco:

On March 15, 2006, we sent a letter regarding the infringement of Ermenegildo Zegna Corporation ("EZCO") trademarks through the sale of counterfeit suits. A copy of this letter is enclosed.

To date, we have received no reply to the letter. Moreover, we note that as of yesterday, we are advised that 56th St. Menswear is still displaying a sign promoting the sale of Zegna suits at the premises. An attempt to reach you or a manager of the store today by telephone was unsuccessful. I was advised that no managers were present, only salesmen.

As we noted in our earlier letter, 56th St. Menswear's sale of products bearing a "Tessuto Ermenegildo Zegna" label will lead to consumer confusion and constitutes counterfeiting and trademark infringement in a violation of the Lanham Act and state laws. Your continued sale of these goods following the initial notice constitutes evidence of willful infringement.

We therefore again demand that you immediately cease all sales of any suit or other clothing under the designation "Tessuto Ermenegildo Zegna" or any other related "Zegna" designation at your stores. In addition, we demand that you deliver all the infringing stock that bears a label featuring a Zegna label to the undersigned and that you provide the undersigned with an accounting of all sales and profits received to date from the sale of goods under the Zegna Marks. Finally, we demand that you immediately provide to the undersigned all

SATTERLEE STEPHENS BURKE & BURKE LLP

Ms. Louise DeMarco

March 28, 2006

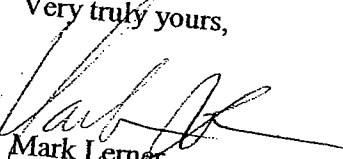
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documents and information relating to the source(s) of the infringing/counterfeit suits or any other goods bearing the Zegna Marks.

If we do not receive the requested information and inventory by March 31, 2006, Zegna will not hesitate to take all steps necessary to protect its valuable intellectual property, including seeking actual and statutory damages under the Lanham Act.

In the interim, Zegna reserves all its rights in law and equity.

Very truly yours,


Mark Lerner

Enclosure

cc: Paolo Torello Viera
Paolo Orlandi
Albert A. Byer, Esq.

Index No:

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

ERMENEGILDO ZEGNA CORPORATION,

Plaintiff,

- against -

56TH STREET MENSWEAR, INC.,

Defendant.

COMPLAINT

SATTERLEE STEPHENS BURKE & BURKE LLP

Attorneys for Plaintiff

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NEW YORK, NY 10169-0079
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