

TTAB

TRADEMARK

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



05-14-2002

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

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GABRIELLE STUDIO, INC.,

Opposer,

v.

BCNY INTERNATIONAL INC.

Applicant.

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:
: Opposition No.: 151,239
: Mark: BCNY
: Application No.: 76/150,155
: Filed: October 19, 2001
: Published: Sept. 4, 2001

ANSWER TO NOTICE OF OPPOSITION

Applicant, BCNY International, Inc., answers the Notice of Opposition dated March 26, 2002 ("Notice of Opposition") as follows:

1. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 1 of the Notice of Opposition, and therefore denies same.

2. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 2 of the Notice of Opposition, and therefore denies same.

3. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 3 of the Notice of Opposition, and therefore denies same.

4. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 4 of the Notice of Opposition and therefore denies same and refers to the United States Patent and Trademark Office file histories for U.S.

TRADEMARK TRIAL AND APPEAL BOARD
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Trademark Registration Nos.: 1,554,808; 1,586,886; 1,649,910; 1,848,632; 1,949,229; and 2,470,110 for the contents thereof.

5. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 5 of the Notice of Opposition and therefore denies same and refers to the United States Patent and Trademark Office file histories for U.S.

Trademark Registration Nos.: 1,554,808; 1,586,886; 1,649,910; 1,848,632; 1,949,229; and 2,470,110 for the contents thereof.

6. Applicant admits the truth of the allegations in paragraph 6 of the Notice of Opposition.

7. Applicant admits the truth of the allegations in paragraph 7 of the Notice of Opposition.

8. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 8 of the Notice of Opposition and therefore denies same.

9. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 9 of the Notice of Opposition and therefore denies same.

10. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 10 of the Notice of Opposition and therefore denies same.

11. Applicant denies the allegations in paragraph 11 of the Notice of Opposition.

12. Applicant denies the allegations in paragraph 12 of the Notice of Opposition, except Applicant admits that it seeks to register BCNY (hereinafter, the "Mark") for "footwear".

13. Applicant denies the allegations in paragraph 13 of the Notice of Opposition.

14. Applicant denies the allegations in paragraph 14 of the Notice of Opposition.

15. Applicant denies knowledge or information sufficient to form a belief as to the truth of the allegations in paragraph 15 of the Notice of Opposition and therefore denies same, except Applicant admits that it claims April, 1992 as its date of first use and first use in commerce of the Mark.

16. Applicant denies the allegations in paragraph 16 of the Notice of Opposition.

17. Applicant denies the allegations in paragraph 17 of the Notice of Opposition.

18. Applicant denies the allegations in paragraph 18 of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE

19. The Notice of Opposition is barred by the doctrines of waiver, acquiescence and equitable estoppel.

SECOND AFFIRMATIVE DEFENSE

20. This Notice of Opposition is barred by the doctrine of laches.

THIRD AFFIRMATIVE DEFENSE

21. There is no likelihood of confusion because Opposer has at best narrow rights to enforce the trademark registrations asserted in the Notice of Opposition.

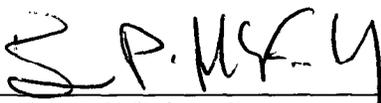
22. Opposer's rights in its asserted trademark registrations are extremely narrow because of numerous third party registrations including: **ENNY**, Reg. No. 1,251,723 in International Class 25 for "shoes, belts, boots and slippers"; **ESNY**, Reg. No. 1,732,120 in

International Class 25 for “footwear”; **MCNY**, Reg. No. 1,994,067 in International Class 25 for “knitted clothes, namely, sweaters, blouses, shirts, jackets, pants, hats and scarves”; **FTNY**, Reg. No. 2,019,556 in International Class 25 for “clothing for boys and girls and infants, namely, woven shirts, knitted shirts, sweaters, sweatshirts, sweat pants, sweat jackets, jogging suits, pants, overalls, slacks, shorts, jackets, coats, vests, socks, hosiery, swim suits, beachwear, belts and suspenders; girls' clothing, namely, blouses, skirts, jumpers and dresses; boys' clothing, namely, neckties”; **PTNY**, Reg. No. 1,940,992 in International Class 25 for “ladies' wearing apparel, namely blouses, skirts, rompers, jogging suits, pants, shorts, skirt sets consisting of skirt and blouses, pant sets consisting of pants and blouse and short sets consisting of shorts and blouse”; **HPNY**, Reg. No. 1,810,089 in International Class 25 for “socks and tights”; and **SPNY**, Application Serial No. 76/088,501 in International Class 25 for “hats, gloves, scarves and belts”.

WHEREFORE, Applicant requests that the Board deny the relief sought in the Notice of Opposition and grant Applicant such other and further relief as to the Board may seem proper.

Dated: New York, New York
May 13, 2002

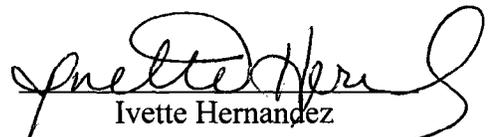
KANE KESSLER, P.C.

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CERTIFICATE OF SERVICE

This is to certify that on the 13th day of May, 2002, the undersigned served the foregoing ANSWER TO NOTICE OF OPPOSITION via U.S. First Class Mail, postage prepaid, on attorneys for Opposer as follows:

Jeffrey Epstein, Esq.
Cowan, Liebowitz & Latman, P.C.
1133 Avenue of the Americas
35th Floor
New York, NY 10036-6799


Ivette Hernandez


CERTIFICATE OF FILING BY EXPRESS MAIL

Opposition No.: 151,239

Application Serial No.: 76/150,155

Mark: BCNY INTERNATIONAL

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The undersigned hereby certifies that, pursuant to 37 CFR § 1.10, she is depositing this Answer to Notice of Opposition, and all enclosures referenced therein, with sufficient postage, as Express Mail (No. EL673543857US), with the United States Postal Service, on this 13th day of May, 2002, addressed to:

Box TTAB No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513


Ivette Hernandez