

ESTTA Tracking number: **ESTTA383099**

Filing date: **12/10/2010**

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

Proceeding	91196926
Party	Defendant Dorfman-Pacific Co.
Correspondence Address	MICHAEL JAMES CRONEN ZIMMERMAN & CRONEN LLP 1330 BROADWAY, SUITE 710 OAKLAND, CA 94612-2506 UNITED STATES mcronen@zimpatent.com
Submission	Answer and Counterclaim
Filer's Name	Michael James Cronen, Esq.
Filer's e-mail	mcronen@zimpatent.com
Signature	/s/Michael James Cronen, Esq.
Date	12/10/2010
Attachments	DORFMANPleadAmendAnswerTTABCapelli-FINAL-12-09-2010.pdf (9 pages) (71188 bytes)

Registrations Subject to the filing

Registration No	3248875	Registration date	06/05/2007
Registrant	GMA Accessories, Inc. 1 East 33rd Street New York, NY 10016 UNITED STATES		

Goods/Services Subject to the filing

<p>Class 025. First Use: 1991/12/01 First Use In Commerce: 1991/12/18 All goods and services in the class are requested, namely: Bandanas; Bathrobes; Beach footwear; Beachwear; Belts; Berets; Blazers; Blouses; Body suits; Boots; Clothing, namely, knee warmers; Clothing, namely, wrap-arounds; Coats; Cravats; Ear muffs; Earbands; Embossed soles and heels of rubber or of plastic materials; Fabric belts; Fleece pullovers; Flip flops; Footwear; Foul weather gear; Fur cloaks; Fur coats and jackets; Fur jackets; Fur muffs; Galoshes; Gloves; Gowns; Hoods; Hosiery; Housecoats; Infant and toddler one piece clothing; Infant sleepers; Infants' shoes and boots; Infants' trousers; Infantwear; Jackets; Jerseys; Jogging pants; Knee-high stockings; Lace boots; Ladies' boots; Leather belts; Leather shoes; Leg shapers; Leg warmers; Leggings; Leotards; Light-reflecting jackets; Lingerie; Long sleeved vests; Loungewear; Men's socks; Mittens; Moccasins; Mufflers; Neck bands; Neck gaiters; Neckchiefs; Neckwear; Night gowns; Night shirts; Nightdresses; Nighties; Nightwear; One piece garment for infants and toddlers; Open-necked shirts; Pajamas; Parkas; Pullovers; Rain boots; Rain coats; Rain jackets; Rain suits; Rainproof jackets; Rainwear; Riding boots; Robes; Rubber shoes; Rubbers; Sashes; Scarves; Shawls; Shirts; Shoes; Short-sleeved shirts; Sleep shirts; Sleeping garments; Sleepwear; Sleeved or sleeveless jackets; Slippers; Socks and stockings; Suede jackets; Tank tops; Tights; V-neck sweaters; Vests; Wind coats; Wind resistant jackets; Women's shoes; Woollen socks; Wraps</p>
--

Registration No	3241182	Registration date	05/15/2007
Registrant	GMA Accessories, Inc. 1 East 33rd Street New York, NY 10016 UNITED STATES		

Goods/Services Subject to the filing

Class 014. First Use: 1993/02/01 First Use In Commerce: 1993/04/22

All goods and services in the class are requested, namely: Bracelets; Chokers; Clocks; Costume jewelry; Earrings; Gemstones; Gold and its alloys; Jewel chains; Jewelry; Jewelry chains; Jewelry for the head; Neck chains; Necklaces; Ornamental pins; Picture frames of precious metal; Precious gemstones; Rings being jewelry; Semi-precious gemstones; Silver and its alloys; Watches

Registration No	3258734	Registration date	07/03/2007
Registrant	GMA Accessories, Inc. 1 East 33rd Street New York, NY 10016 UNITED STATES		

Goods/Services Subject to the filing

Class 003. First Use: 1996/11/01 First Use In Commerce: 1997/01/31

All goods and services in the class are requested, namely: Blush; Blush pencils; Body creams; Body emulsions; Body lotions; Body powder; Bubble bath; Cologne; Compacts containing make-up; Cotton for cosmetic purposes; Eau de cologne; Eau de perfume; Eau de toilette; Eye lotions; Eye make-up; Eye pencils; Eye shadows; Face and body creams; Face and body glitter; Facial cleansers; Facial creams; Facial make-up; Facial washes; False nails; Foam bath; Lip balm; Lip gloss; Lipstick; Lipstick cases; Lipstick holders; Make-up; Mouthwashes; Nail care preparations; Nail glitter; Nail polish; Perfumes; Skin creams; Skin lotions; Teeth cleaning lotions; Tooth cleaning preparations; Tooth polish; Toothpaste

Registration No	3322312	Registration date	10/30/2007
Registrant	GMA Accessories, Inc. 1 East 33rd Street New York, NY 10016 UNITED STATES		

Goods/Services Subject to the filing

Class 026. First Use: 1991/12/01 First Use In Commerce: 1991/12/18

All goods and services in the class are requested, namely: Barrettes; Basket clasps; Belt buckles not of precious metal; Belt clasps; Bobbin lace; Bobby pins; Bonnet pins; Brooches; Eyelets; Fabric tissue box covers; Hair accessories, namely, claw clips; Hair accessories, namely, snap clips; Hair accessories, namely, twisters; Hair bands; Hair bows; Hair buckles; Hair clips; Hair curl clips; Hair ornaments; Hair pins; Hair ribbons; Hair scrunchies; Hat ornaments not of precious metal; Lace; Ornamental ribbons made of textiles; Ponytail holders

Registration No	3241184	Registration date	05/15/2007
Registrant	GMA Accessories, Inc. 1 East 33rd Street New York, NY 10016 UNITED STATES		

Goods/Services Subject to the filing

Class 024. First Use: 1997/12/01 First Use In Commerce: 1998/02/09

All goods and services in the class are requested, namely: Bath linen; Bath sheets; Bath towels; Beach towels; Bed blankets; Bed linen; Bed sheets; Bed spreads; Blanket throws; Chenille fabric; Children's blankets; Children's towels; Cloth coasters; Cloth napkins for removing make-up; Comforters; Contoured mattress covers; Cotton base mixed fabrics; Cotton fabric; Covered rubber yarn fabrics; Crepe cloth; Crib bumpers; Crib canopies; Curtain fabric; Curtain loops of textile material; Curtains; Curtains made of textile fabrics; Diaper changing mats; Diaper changing pads not

of paper; Dining linens; Dish cloths; Draperies; Dust ruffles; Duvet covers; Duvets; Eiderdown covers; Eiderdowns; Fabric diaper stackers; Fabric flags; Fabric for boots and shoes; Fabric of imitation animal skin; Fabric table runners; Fabric table toppers; Fabric valances; Fabric window coverings and treatments, namely curtains, draperies, sheers, swags and valances; Face towels; Feather beds; Felt and non-woven textile fabrics; Fiberglass fabrics for textile use; Fireproof upholstery fabrics; Fitted toilet lid covers; Flannel; Flax fabrics; Frieze; Gauze fabric; Gift wrap of fabric; Hand towels; Hand-towels made of textile fabrics; Hemp base mixed fabrics; Hemp yarn fabrics; Household linen; Inorganic fiber mixed fabrics; Jeans fabric; Jersey fabrics for clothing; Jersey material; Jute fabrics; Kitchen linens; Kitchen towels; Knitted fabrics; Knitted fabrics of chemical-fiber yarn; Knitted fabrics of cotton yarn; Knitted fabrics of wool yarn; Labels of cloth; Lap rugs; Mixed fiber fabrics; Narrow woven fabrics; Net curtains; Nylon fabric; Oil cloths; Pillow cases; Pillow covers; Pillow shams; Pillowcases; Place mats of textile material; Polyester fabric; Pot holders; Puffs; Quilts; Ramie fabric; Rayon fabric; Receiving blankets; Regenerated fiber yarn fabrics; Rubberized cloths; Sackcloth; Sail cloth; Semi-synthetic fiber fabrics; Shams; Shower curtains; Silk-cotton mixed fabrics; Synthetic fiber fabrics; Table cloths not of paper; Table linen; Taffeta; Tapestries of textile; Terry towels; Textile fabric of animal skins imitations; Textile fabrics for home and commercial interiors; Textile fabrics for lingerie; Textile fabrics for the manufacture of clothing; Textile labels; Throws; Ticking fabric; Towel sets; Towels; Traced cloths for embroidery; Tricot quilts; Tulle; Unfitted fabric furniture covers; Upholstery fabrics; Velvet; Wash cloths; Washcloths; Washing gloves; Washing mitts; Window curtains; Wool base mixed fabrics; Wool yarn fabrics; Woolen fabric; Woollen blankets; Worsted fabrics; Woven fabrics; Zephyr fabric

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

GMA ACCESSORIES, INC.,)	
)	
Opposer,)	Opposition No.:91196926
)	
v.)	Application No.: 77/965,616
)	
DORFMAN-PACIFIC CO.,)	Mark: CAPPELLI STRAWORLD
)	
Applicant.)	

**ANSWER AND AMENDED
COUNTERCLAIM (With Fee)**

Applicant Dorfman-Pacific Co. hereby answers Opposer GMA Accessorites, Inc.’s Notice of Opposition as follows:

1. Applicant admits that Opposer alleges it is “current title owner” of certain “Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 1 of Opposer’s Notice of Opposition.
2. Applicant admits that Opposer alleges it is “current title owner” of certain “Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 2 of Opposer’s Notice of Opposition.
3. Applicant admits that Opposer alleges it is “current title owner” of certain “Registration” numbers, but Applicant otherwise denies the allegations contained in paragraph 3

of Opposer's Notice of Opposition.

4. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 4 of Opposer's Notice of Opposition.

5. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 5 of Opposer's Notice of Opposition.

6. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 6 of Opposer's Notice of Opposition.

7. Applicant admits that Opposer alleges it is "current title owner" of certain "Registration" numbers, but Applicant otherwise denies the allegations contained in paragraph 7 of Opposer's Notice of Opposition.

8. Denied.

9. Denied. It is unclear to Applicant which "mark" Opposer refers to in paragraph 9 of Opposer's Notice of Opposition, especially in view of Applicant's long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 9 of Opposer's Notice of Opposition as vague and ambiguous.

10. Denied.

11. Applicant lacks sufficient information to determine the truth or falsity of the allegations contained in paragraph 11 of the Notice of Opposition and, therefore, Applicant

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

12. Denied. It is unclear to Applicant what “senior user” Opposer refers to in paragraph 12 of Opposer’s Notice of Opposition, especially in view of Applicant’s long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 12 of Opposer’s Notice of Opposition as vague and ambiguous.

13. Denied. It is unclear to Applicant what “DORFMAN-PACIFIC’s date of first use” refers to in paragraph 13 of Opposer’s Notice of Opposition, especially in view of Applicant’s long-standing use and common law rights in and to its various marks and trade names, and Applicant therefore denies the allegations contained in paragraph 13 of Opposer’s Notice of Opposition as vague and ambiguous.

14. Denied.

15. Denied. *In re E.I.Dupont de Nemurs, & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563(CCPA 1973), requires an analysis of several factors in determining whether or not a likelihood of confusion exists in a specific situation, it is not limited to “appearance, sound, connotation and commercial impression” as alleged in paragraph 15 of Opposer’s Notice of Opposition.

16. Denied. Determining whether or not a likelihood of confusion exists in a specific situation requires an analysis of several factors and the determination is not limited to an assessment of “the inclusion of additional words, prefixes or suffixes” as alleged in paragraph 16 of Opposer’s Notice of Opposition.

17. Denied. Determining whether or not a likelihood of confusion exists in a specific

situation requires an analysis of several factors and the determination is not limited to an assessment of “the goods or services” as alleged in paragraph 17 of Opposer’s Notice of Opposition.

18. Denied. Determining whether or not a likelihood of confusion exists in a specific situation requires an analysis of several factors and the determination is not limited to an assessment of whether the goods “are related in some manner” as alleged in paragraph 18 of Opposer’s Notice of Opposition.

19. Denied.

20. Denied.

21. Denied. Any such alleged “likelihood of confusion ... and dilution”, as alleged in paragraph 21 of Opposer’s Notice of Opposition, should result in the cancellation of registrations pled by Opposer in Opposer’s Notice of Opposition as set forth below in Applicant’s Counterclaims For Cancellation.

22. Admitted.

23. It is unclear to Applicant what specific meaning Opposer ascribes to the words “successor in interest” in paragraph 23 of Opposer’s Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 23 of Opposer’s Notice of Opposition as vague and ambiguous.

24. It is unclear to Applicant what specific meaning Opposer ascribes to the words “in privity with” in paragraph 24 of Opposer’s Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 24 of Opposer’s Notice of Opposition as vague and ambiguous.

25. Denied.

26. Denied. Cancellation No. 92044972 was never determined on the substantive merits. It terminated on the basis of a procedural matter relating to discovery issues and has no preclusive effect with respect to the present proceedings.

27. It is unclear to Applicant whether Opposer is referring to the undersigned counsel in these proceedings, i.e. Zimmerman & Cronen, LLP, or to counsel for the registrant in Cancellation No. 92044972, i.e. Charles J. Prescott, P.A., in paragraph 27 of Opposer's Notice of Opposition, and Applicant therefore denies the allegations contained in paragraph 27 of Opposer's Notice of Opposition as vague and ambiguous. However, the information relating to the identity of counsel of record and applicant information is publicly available information that may be found on the Trademark Office website, <www.uspto.gov>.

28. Denied. In an Order dated August 28, 2006, in Cancellation No. 92044972, the Trademark Trial and Appeal Board "granted" the "Petitioner's motion for discovery sanctions", stating that "Registration No. 2670642 will be cancelled in due course." (Emphasis added).

29. Denied.

30. Denied.

31. Denied.

32. Denied.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

1. As a first and separate defense to Opposer's Notice of Opposition, Applicant alleges

that Opposer's Notice of Opposition fails to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

2. As a second and separate defense to Opposer's Notice of Opposition, Applicant alleges that there is no reasonable dispute that Applicant has not infringed upon any valid rights of Opposer and that, therefore, there is no evidence to support Opposer's claims for relief in this matter.

THIRD AFFIRMATIVE DEFENSE

3. As a third and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer's claims are barred by the doctrine of unclean hands and/or fraud on the Trademark Office.

FOURTH AFFIRMATIVE DEFENSE

4. As a fourth and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer's claims are barred by the doctrines of laches, acquiescence, and estoppel.

FIFTH AFFIRMATIVE DEFENSE

5. As a fifth and separate defense to Opposer's Notice of Opposition, Applicant alleges that Opposer lacks standing to file this opposition proceeding.

**COUNTERCLAIM FOR CANCELLATION OF OPPOSER'S
ASSERTED TRADEMARK REGISTRATIONS**

1. Opposer hereby incorporates by reference the facts and information set forth above in numbered paragraphs 1 through 32 and in Opposer's First through Fifth Affirmative Defenses, in Opposer's Counterclaim for Cancellation of Opposer's alleged Trademark Registrations, as set

forth herein.

2. Opposer's Notice of Opposition alleges that Opposer is "current title owner" of the following United States Trademark Registration Nos.: 3,241,182; 3,241,184; 3,246,017; 3,248,875; 3,258,734; 3,273,451; 3,322,312, for the designation "CAPELLI".

3. Opposer's alleged registered mark is merely descriptive in that said designation is an apt and common term used to describe goods of the nature described in said registrations.

4. Opposer is not entitled to exclusive use of the designation in Opposer's alleged trademark registrations, and Opposer's alleged mark does not function to identify Opposer's goods and distinguish them from those offered by others.

5. Opposer's alleged registrations are for the common descriptive name of articles included in Opposer's description of goods and has become the generic name of such goods. Applicant is likely to be damaged by Opposer's registrations of said generic term as this tends to impair Applicant's right to legal use of said term.

6. Opposer abandoned said registered marks by discontinuing use of said marks in connection with the goods recited therein which tends to impair Applicant's right to use and register its mark.

7. Opposer has opposed Applicant's right to register its mark; however, the use of the name and mark CAPPELLI, including its common law usages, predates Opposer's alleged use, and therefore, Opposer cannot be considered as having senior rights to the name and mark CAPPELLI, and any likelihood of confusion, as alleged by Opposer, impairs Applicant's right to registration, and Applicant's continued and legal use of its said mark and should result in the cancellation of Opposer's asserted U.S. Trademark Registrations.

8. Opposer's registrations were obtained fraudulently in that the formal application papers filed by Opposer stated that the registered mark was being used in association with goods offered by Opposer when, in fact, upon information and belief, Opposer's registered marks were not being used in association with such goods. Upon information and belief, said knowingly false representation was made by an authorized agent of Opposer with the intent to induce authorized agents of the U.S. Trademark Office to grant such registrations, and, reasonably relying upon the truth of said false statements, the U.S. Trademark Office did, in fact, grant said registrations. Applicant was damaged by said false statements and the registrations issued in reliance thereon, and Applicant's continued and legal use of its said mark will be impaired by the continued registrations of the alleged mark of Opposer.

WHEREFORE, Applicant prays United States Trademark Registration Nos. 3,241,182; 3,241,184; 3,246,017; 3,248,875; 3,258,734; 3,273,451; and 3,322,312 be cancelled and that this Counterclaim For Cancellation be sustained in favor of Applicant.

Respectfully submitted,

Dated: December 10, 2010

/s/Michael James Cronen
Michael James Cronen
Zimmerman & Cronen, LLP
1330 Broadway, Suite 710
Oakland CA 94612-2506
tel: 510.465.0828
fax: 510.465.2041
e-mail: mcronen@zimpatent.com

Attorneys For Applicant,
Dorfman-Pacific Co.

CERTIFICATE OF SERVICE

Opposition No.:91196926
Application No.: 77/965,616
Mark: CAPPELLI STRAWORLD

I, Michael J. Cronen, hereby certify that this paper [Answer and Amended Counterclaim(With Fee)] is being deposited with the United States Postal Service on December 10, 2010, postage pre-paid, addressed to the following:

Conor F. Donnelly, Esq.
The Bostany Law Firm
40 Wall Street - 61st Floor
New York, New York 10005
Attorney for Opposer

/s/Michael James Cronen
Michael James Cronen
Zimmerman & Cronen, LLP
1330 Broadway, Suite 710
Oakland CA 94612-2506
tel: 510.465.0828
fax: 510.465.2041
e-mail: mcronen@zimpatent.com