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

Proceeding	91196926
Party	Defendant Dorfman-Pacific Co.
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**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.)	
_____)	

**APPLICANT’S OPPOSITION TO OPPOSER’S REQUEST FOR
RECONSIDERATION OF THE BOARD’S ORDER DENYING
OPPOSER’S MOTION FOR SUMMARY JUDGMENT**

I. RECITATION OF FACTS

On April 4, 2011, after finding the “motion is fully briefed”, the Board denied “opposer’s motion for summary judgment based on res judicata.” Order, p.1. The Board held that “[i]n this case, on the record presented, we find that there are genuine disputes as to material facts remaining for trial.” Id. at p. 7. This holding was based upon the Board’s finding various genuine issues of material fact which precluded summary judgment. As stated in the Board’s Order:

At a minimum, genuine disputes exist as to whether CAPPELLI STRAWORLD, at issue in this proceeding, ‘is the same mark, in terms of commercial impression,’ as the mark CAPPELLI, which was at issue in the Prior Cancellation. (Citations omitted). In addition, because opposer did not specify any particular goods or services for which it alleged prior use of CAPELLI in the Prior Cancellation, there is a genuine dispute of material fact with respect to whether this proceeding is based on the same set of transactional facts as the Prior Cancellation. Accordingly, opposer’s motion for summary judgment is hereby **DENIED**. Order, p. 7 (emphasis in original, footnote omitted).

II. ARGUMENT

Trademark Rule 2.127(b) allows for “a request for reconsideration ... of an order or decision issued on a motion”. See also, 37 CFR §2.129(c). Such requests are generally based upon an argument that the Board clearly erred in reaching its

decision, “based on the evidence of record and the prevailing authorities”. TBMP, Rule 543 (2d ed. Rev. 2004), citing *Amoco Oil Co. V. Amerco, Inc.*, 201 USPQ 126 (TTAB 1978); see also *In re Cosmetically Yours, Inc.*, 171 USPQ563, 564 (TTAB 1971). The request cannot be used to submit additional evidence and it should not be based upon a reargument of the points made in the requesting party’s original moving papers. *Id.*

A. Opposer’s Request For Reconsideration Should Be Denied Because The Board Correctly Denied Opposer’s Motion For Summary Judgment

Opposer argues that “the Board has made an error in its determination whether the present proceeding is based on the same set of transactional facts as the” Prior Cancellation. Opposer’s Brief in Support of Reconsideration, p. 2, ¶5. Opposer fails, however, to point to any specific errors made by the Board in reaching its conclusion.

Instead, opposer improperly reargues the points already made in its original moving papers, i.e. opposer’s request for reconsideration sets forth the same legal standards for determining *res judicata*, and argues that “[t]he present proceeding is based on the same set of transactional facts ... because the proofs that governed cancellation of the mark in the first proceeding are the equivalent to the proofs

needed here.” Opposer’s Brief, p.3, ¶8.

In rearguing this point, Opposer does not even address the Board’s finding that: “because opposer did not specify any particular goods or services for which it alleged prior use of CAPELLI in the Prior Cancellation, there is a genuine dispute of material fact with respect to whether this proceeding is based on the same set of transactional facts as the Prior Cancellation.” Order, p.7.

The Board correctly found that opposer failed to “specify any particular goods or services” in the Prior Cancellation. Moreover, this cannot be overcome or changed, *nunc pro tunc*, by any action on the part of opposer, including by way of the present request for reconsideration. As the Board correctly found, Opposer’s failure to specify any such goods or services for which it alleged prior use of CAPELLI creates a genuine dispute with respect to transactional facts at issue in the present proceeding and the Prior Cancellation.

Opposer also reargues its position that the commercial impression of the marks in the present proceeding and the Prior Cancellation “are not sufficiently different so as to avoid that application of *res judicata*.” Opposer’s Brief, p.5, ¶15. This was specifically considered by the Board in its finding that “[a]t a minimum, genuine disputes exist as to whether CAPPELLI STRAWORLD, at issue in this proceeding, ‘is the same mark, in terms of commercial impression,’ as

the mark CAPPELLI, which was at issue in the Prior Cancellation.” Order, p.7.

Here, the Board previously considered the issue of commercial impression, provided sufficient legal and evidentiary support, and clearly articulated the reasons why it found material issues of dispute regarding this issue.

Opposer’s arguments constitute nothing but reargument of the same points made in its motion for summary judgment, which were considered and rejected by the Board. The Board should find no error in its decision.

III. CONCLUSION

For the foregoing reasons, opposer’s request for reconsideration should be denied, and the Board’s decision of April 4 should stand.

Respectfully submitted,

Dated: May 6, 2011

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Mark: CAPPELLI STRAWORLD

CERTIFICATE OF SERVICE

I, Michael J. Cronen, hereby certify that these papers: APPLICANT'S
OPPOSITION TO OPPOSER'S REQUEST FOR RECONSIDERATION OF THE
BOARD'S ORDER DENYING OPPOSER'S MOTION FOR SUMMARY
JUDGMENT are being deposited with the United States Postal Service on May 6, 2011,
postage pre-paid, addressed to the following:

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