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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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Submission	Motion to Amend/Amended Answer or Counterclaim
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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.	)	

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**ANSWER AND SECOND  
AMENDED COUNTERCLAIM**

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](http://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 either discontinuing use or having never used such marks in the first place, in that Opposer prominently and consistently uses CAPELLINEWYORK and CAPELLI NEW YORK, in connection with all of its goods, including hats, tote bags and hand bags, which are the subject of Applicant's application herein in, as well as its incontestible trademark registration. Applicant's recent review of marketplace information shows Opposer has discontinued without any intent to use or resume use its pleaded mark in connection with, for example, hats, caps, berets, hoods, belts and its other apparel products (Registration No. 3,248,875); hair barrettes, hair Bobby pins, hair Bonnet pins, "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 metals” (Registration No. 3,322,312); jewelry, clocks, chokers (Registration No. 3,241,182); cosmetics and perfumes, false nails and toothpaste, teeth cleaning preparations (Registration No. 3,258,734); and “linen sheets, towels” etc., cloth coasters, napkins, “Cotton fabric” Chenille fabric” “yarn”, curtains” “Fireproof upholstery fabrics”, “rubberized cloths” “Nylon fabric” (Registration No. 3,241,184), which tends to impair Applicant’s right to use and register its mark. Opposer was not using its registered mark in 2006 when it filed TTAB Cancellation No. 92044972, and it has not used such registered mark during the more than three (3) years since that date, and Opposer has an intent not to use or to resume use of its pleaded 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 Opposer never used its pleaded mark, that Opposer prominently and consistently uses CAPELLINEWYORK and CAPELLI NEW YORK, in connection with all of its goods, including hats, tote bags and hand bags, which are the subject of Applicant’s application herein in, as well as Applicant’s incontestible trademark registration. Opposer does not use its pleaded mark in connection with, for example, hats, caps, berets, hoods, belts and its other apparel products (Registration No.

3,248,875); hair barrettes, hair Bobby pins, hair Bonnet pins, “Hair accessories, namely claw clips; Hair accessories, namely snap clips; Hair accessories, namely twistors; Hair bands; Hair bows; Hair buckles; Hair clips; Hair curl clips; Hair ornaments; Hair pins; Hair ribbons; Hair scrunchies; Hat ornaments not of precious metals” (Registration No. 3,322,312); jewelry, clocks, chokers (Registration No. 3,241,182); cosmetics and perfumes false nails and toothpaste, teeth cleaning preparations (Registration No. 3,258,734); and “linen sheets, towels” etc., cloth coasters, napkins, “Cotton fabric” Chenille fabric” “yarn”, curtains” “Fireproof upholstery fabrics”, “rubberized cloths” “Nylon fabric” (Registration No. 3,241,184), which tends to impair Applicant’s right to use and register its mark. Opposer was not using its registered mark in 2006 when it filed TTAB Cancellation No. 92044972, and it has not used such registered mark during the more than three (3) years since that date. Nevertheless, in the formal application papers filed by Opposer in connection with its pleaded registrations, including the applicant’s declarations of use, and submitted “specimens of use” and/or “substituted specimens of use”, Opposer alleged its pleaded mark was being used in association with Opposer’s claimed goods when, in fact, Opposer knew the pleaded mark was not in use in association with such goods. 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: September 15, 2011

/s/Michael James Cronen  
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## 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 Second Amended Counterclaim**] is being deposited with the United States Postal Service on December 10, 2010, postage pre-paid, addressed to the following:

Ohn P. Bostany, Esq.  
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