

ESTTA Tracking number: **ESTTA382453**

Filing date: **12/07/2010**

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

Proceeding	91196926
Party	Plaintiff GMA Accessories, Inc.
Correspondence Address	ASHLEY J KUMER THE BOSTANY LAW FIRM 40 WALL STREET , 61ST FLOOR NEW YORK, NY 10005 UNITED STATES mail@bozlaw.com
Submission	Motion for Summary Judgment
Filer's Name	Conor F. Donnelly
Filer's e-mail	conor.donnelly@bozlaw.com
Signature	/Conor F Donnelly/
Date	12/07/2010
Attachments	Notice.Motion.12.07.10.pdf (1 page)(34327 bytes) Donnelly.Declaration.12.07.10.pdf (3 pages)(89526 bytes) Ex.A.pdf (4 pages)(31677 bytes) Ex.B.pdf (6 pages)(247352 bytes) Ex.C.pdf (3 pages)(69262 bytes) Ex.D.pdf (1 page)(20794 bytes) Ex.E.pdf (1 page)(19789 bytes) Ex.F.pdf (5 pages)(167795 bytes) Ex.G.pdf (9 pages)(306849 bytes) COS.Summary.Judgment.12.07.10.pdf (1 page)(20169 bytes)

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

-----X
GMA ACCESSORIES, INC.,

Opposer,

Opposition No.: 91196926

- against -

NOTICE OF MOTION

DORFMAN-PACIFIC CO.,

Applicant.
-----X

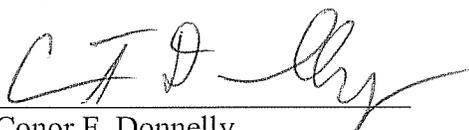
Mark: CAPPELLI STRAWORLD
Serial No.: 77-965, 616
Class (es): 18, 25

PLEASE TAKE NOTICE upon the Declaration of Conor F. Donnelly dated December 7, 2010 and the exhibits annexed thereto and upon all prior pleadings and proceedings heretofore had hearing, the undersigned hereby moves this Honorable Board, for an Order, (1) granting summary judgment in favor of Opposer GMA Accessories, Inc. on the grounds of *res judicata*; (2) issuing a denial of Applicant's trademark application; and (3) for such further relief as this Board deems proper.

Dated: New York, New York
December 7, 2010

Respectfully submitted,

By:



Conor F. Donnelly
THE BOSTANY LAW FIRM
Attorneys for Opposer
40 Wall Street, 61st Floor
New York, New York 10005

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

-----X
GMA ACCESSORIES, INC.,

Opposer,

Opposition No.: 91196926

- against -

**DECLARATION IN SUPPORT
OF OPPOSER'S MOTION FOR
SUMMARY JUDGMENT**

DORFMAN-PACIFIC CO.,

Applicant.
-----X

Mark: CAPPELLI STRAWORLD
Serial No.: 77-965, 616
Class (es): 18, 25

CONOR F. DONNELLY hereby declares, under penalty of perjury pursuant to 28 U.S.C. § 1746, as follows:

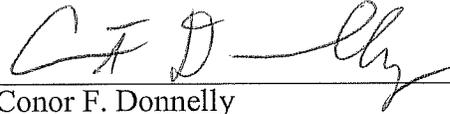
1. I am an attorney at The Bostany Law Firm, Attorneys for the Opposer located at 40 Wall Street, New York, New York and as such I am fully familiar with the facts of the case.
2. I make this declaration based on my review of the file maintained in this Firm's office and in support of Opposer's Motion for Summary Judgment as to Applicant Dorfman-Pacific Co. (hereinafter "Applicant").
3. On or about September 28, 2005, Opposers filed a petition to cancel the Cappelli Strawworld trademark (hereinafter "Mark"). *See* Opposer's Petition for Cancellation dated September 28, 2005 attached hereto as Exhibit A.
4. On or about November 9, 2005, Cappelli Strawworld, Inc. (hereinafter "Strawworld") answered Opposers Petition for Cancellation. *See* Strawworld's Answer dated November 9, 2005 attached hereto as Exhibit B.

5. On June 5, 2006, the TTAB issued an order to compel Strawworld to answer Opposer's first set of interrogatories. *See* TTAB Order date June 5, 2006 attached hereto as Exhibit C.
6. On August 28, 2006, the TTAB issued a judgment against Strawworld and granting Opposers petition to cancel Strawworld's registration of the Mark. *See* TTAB Judgment dated August 28, 2006 attached hereto as Exhibit D.
7. On October 24, 2006, the TTAB issued a judgment canceling Strawworld's registration of the Mark. *See* TTAB Judgment dated October 24, 2006 attached hereto as Exhibit E.
8. Applicant purchased Strawworld. Exhibits F and G, namely paragraph 22 of the Notice of Opposition (Exhibit F) admitted same in paragraph 22 of Applicant's Answer (Exhibit G.)
9. The TTAB's judgment canceling the Mark is *res judicata* and requires refusal of this application. *See International Nutrition Company v. Horphag Research Ltd.*, 220 F.3d 1325 (Fed. Circuit 2000) stating ("Application of *res judicata* requires a prior final judgment on the merits by a court or other tribunal of competent jurisdiction; identity of the parties or those in privity with the parties; and a subsequent action based on the same claims that were raised, in the prior action.")
10. Here, Applicant, as purchaser of the defendant in the prior action is in privity with it and subject to the *res judicata* effects of Exhibits D and E, namely loss of the Capelli Strawworld mark

WHEREFORE it is respectfully requested that Opposer's motion for summary judgment be granted and Applicant's application for the Capelli Strawworld mark be denied.

Dated: December 7, 2010
New York, NY

Respectfully Submitted,

A handwritten signature in cursive script, appearing to read "C F Donnelly", written over a horizontal line.

Conor F. Donnelly
The Bostany Law Firm
40 Wall Street, 61st Floor
New York, New York 10005
(212) 530-4400

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

-----X

GMA ACCESSORIES, INC.,

Petitioner,

- against -

PETITION FOR CANCELLATION

CAPPELLI STRAWORLD, INC.,

Respondent.

-----X

Mark: CAPPELLI

Reg. No.: 2,670,642

Registration Date: Dec. 31, 2002

Petitioner GMA Accessories, Inc. ("GMA"), through its undersigned counsel of record, hereby seeks cancellation of the above mark registered on the supplemental register to CAPPELLI STRAWORLD ("STRAWORLD") in International Classes 18 and 25, and in support thereof respectfully submits as follows:

1. The GMA Mark consist of words only, with the dominant word CAPELLI prominently appearing in block letters.
2. The use of the word CAPELLI in connection with GMA's products is arbitrary.
3. The GMA Mark CAPELLI has been continuously used, on a nationwide basis, in connection with GMA's products since 1993, and GMA has incurred substantial expense in promoting and advertising its products under the GMA Marks.
4. In support of its application, respondent STRAWORLD alleged its earliest first use and first use in commerce to be April 10, 2002.

5. STRAWORLD'S Mark consists of words only and prominently incorporates the word CAPPELLI in block lettering.

6. STRAWORLD alleges use of its mark in connection with handbags and hats in International Classes 18 and 25 as early as April 10, 2002.

7. The items with which the STRAWORLD commenced identifying with the mark CAPPELLI are strikingly similar to those goods that were already being identified in commerce by GMA for many years before as CAPELLI.

8. In determining whether there is a likelihood of confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E. I. Dupont de Nemurs & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

9. Numerous courts have found a likelihood of confusion notwithstanding the inclusion of additional words, prefixes or suffixes. *In re Denisi*, 225 U.S.P.Q. 624 (TTAB 1985); *CFM Majestic, Inc. v. NHC, Inc.*, 93 F. Supp.2d 942 (N.D. Ind. 2000); *Trident Seafoods Corp. v. Triton Fisheries, LLC.*, 2000 WL 33675750 at * 6 (D. Alaska June 30, 2000); 3 *McCarthy on Trademarks* §§ 23:55-23:56 at 23-164 through 23-169.

10. In determining whether there is a likelihood of confusion, the goods or services are to be compared to be determined if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

11. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

12. The STRAWORLD Mark is similar to the GMA Mark in appearance, sound, connotation and commercial impression.

13. The goods that the STRAWORLD seeks to identify by its mark are commercially similar and will be marketed in similar commercial channels as GMA's products.

14. While STRAWORLD won the race to the Trademark Office in terms of filing an application and obtaining registration on the supplemental register before GMA, priority and ownership of a trademark arises not out of adoption and registration but out of use and appropriation. *United Drug Co. v. Theodore Rectanus Co.*, 248 U.S. 90 (1918); *Buti v. Impresa Perosa, S.R.L.*, 139 F.3d 98 (2d Cir.1998); *Warnervision Entertainment, Inc. v. Empire*, 101 F.3d 259 (2d Cir. 1996).

15. Had STRAWORLD properly represented GMA's prior use and/or had the examiner been aware of it, registration even on the supplemental register would have been denied and therefore the mark should be canceled under 15 U.S.C. 1092.

16. The Board may cancel a registration on the supplemental register within 5 years of its registration for any reason that would have been sufficient to deny its initial registration and the cancellation of the mark is not appealable as there is no presumption to validity of the mark. See e.g. 15 U.S.C. 1094.

WHEREFORE, GMA respectfully requests that the CAPPELLI registration be canceled.

Dated: September 28, 2005

Respectfully submitted,
THE BOSTANY LAW FIRM

**John P.
Bostany**

Digitally signed by John P. Bostany
DN: CN = John P. Bostany, C = US
Reason: I am the author of this
document
Date: 2005.09.29 15:42:45 -05'00'

By: John P. Bostany

40 Wall Street – 61st Floor
New York, New York 10005
(212) 530-4400
Attorneys for Petitioner

LAW OFFICES OF
CHARLES J. PRESCOTT, P.A.
A PROFESSIONAL ASSOCIATION

TTAB

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PATENTS
TRADEMARKS
COPYRIGHTS
AND RELATED
MATTERS

November 9, 2005

Express Mail Label EV636656537US

MAIL STOP TTAB
Commissioner for Trademarks
P O Box 1451
Alexandria, Virginia 22313-1451

Re: Cancellation No. 92044972
In the Matter of Reg. No. 2,670,642
GMA ACCESSORIES, INC., Petitioner
CAPPELLI STRAWORLD, INC., Respondent

Sir:

Please enter the enclosed Answer and Affirmative Defenses of Respondent in the official file of this cancellation proceeding.

It is my understanding that no fee is required for submittal of this Answer, however, you are authorized to deduct any underpayment from Account No. 16-2454.

Thank you for your cooperation in this matter.

Sincerely,



Charles J. Prescott

CJP:mm
Enclosures
cc: Cappelli Strawworld, Inc.



11-09-2005

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #01

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

In the matter of:

GMA ACCESSORIES, INC.)	
)	
Petitioner,)	
)	
v.)	Cancellation No. 92044972
)	
CAPPELLI STRAWORLD, INC.)	In the Matter of Reg. No. 2.670,642
)	
Respondent.)	
<hr style="width: 40%; margin-left: 0;"/>		

**ANSWER AND AFFIRMATIVE DEFENSES OF
RESPONDENT CAPPELLI STRAWORLD, INC.**

Respondent, Cappelli Strawworld, Inc., (Cappelli Strawworld) respond as follows to the Petition to Cancel of GMA Accessories, Inc. (GMA) in the above-referenced action.

1. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 1 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

2. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 2 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

3. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 3 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

4. Cappelli Strawworld's first use and first use in commerce of its mark CAPPELLI is May 22, 1967.

5. Cappelli Strawworld's registered mark consists of the word CAPPELLI only in block letters.

6. Cappelli Strawworld's first use and first use in commerce of CAPPELLI in connection with handbags and hats in International Classes 018 and 025 is as early as May 22, 1967.

7. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 7 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

8. Admitted as being a part of general trademark law.

9. Admitted as being a part of general trademark law.

10. Admitted as being a part of general trademark law.

11. Admitted as being a part of general trademark law.

12. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 12 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

13. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in paragraph numbered 13 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

14. Cappelli Strawworld, Inc. filed its trademark application which materialized into the above-referenced registration on December 31, 2002. Cappelli Strawworld is without knowledge or information sufficient to form a belief as to the truth of the allegation contained in the remainder of paragraph numbered 14 of the Petition for Cancellation and therefore denies the same and requires full proof therefor.

15. Denied.

16. Admitted as being a part of general trademark law.

AFFIRMATIVE DEFENSES

1. Upon information and belief, GMA has adopted a mark which includes additional dominant words prominently appearing in stylized form formed into a single word, namely CAPPELLINEWYORK,

capellinewyork

in conjunction with handbags and hats and therefore has not acquired any alleged rights in the term "CAPPELLI" standing alone and therefore GMA is barred from relief.

2. Cappelli Straworld incorporated and began doing business in Florida on July 25, 1957 under the name, "Straw World, Inc.". On June 29, 1967, the name of "Straw World" was changed to "Cappelli Straworld, Inc.". During this 1967 time period, the trademark CAPPELLI was adopted as a trademark in conjunction with straw hats, felt hats, velvet hats and cotton hats in International Class 025 and tote bags and handbags made of straw in International Class 018 by Cappelli Straworld. On May 22, 1967, Cappelli Straworld filed for, and on August 11, 1977, Straworld received a Florida Registration No. 909130 registering the trademark CAPPELLI. Since 1967, the mark CAPPELLI has been utilized by Cappelli Straworld for these products on a substantially continuous basis up to the present time. Cappelli Straworld has earned priority and ownership of the mark CAPPELLI in the stated stream of commerce arising out of adoption, registration, and substantially continuous use of the mark, all being superior to GMA's alleged and/or non-existent rights. Therefore, GMA has no priority of use that would serve to defeat Cappelli Straworld's rights in the mark CAPPELLI and therefore

Straworld is entitled to use the mark in commerce and to continue the benefits of Federal supplemental registration therefor.

3. GMA is barred from relief because GMA will not actually be damaged by Defendant's registration for the mark CAPPELLI.

4. GMA is barred from relief because the Petition fails to allege sufficient facts to support GMA's allegations.

5. GMA is barred from relief because the Petition fails to state a claim on which relief can be granted.

6. GMA is barred from relief because GMA's Petition fails as a matter of law.

WHEREFORE, Cappelli Straworld, Inc. prays judgment as follows:

1. That this Petition be dismissed with prejudice and that it's registration be upheld;
2. That GMA take nothing from this Petition;
3. That Cappelli Straworld, Inc. recover its costs of action herein;
4. That this Court award such other and further relief as it deems just and proper.

Respectfully submitted,



Charles J. Prescott
Attorney for Respondent
Charles J. Prescott, P.A.
2033 Wood Street, Suite 115
Sarasota, Florida 34237
(941) 957-4208 phone
(941) 957-4210 fax
cj.prescott@verizon.net

CERTIFICATE OF EXPRESS MAILING

I hereby certify that this Answer is being deposited in the U.S. Mail, Express Mail Label EV636656537US, this 9th day of November, 2005, addressed to the United States Patent and Trademark Office, Trademark Trial and Appeal Board, P. O. Box 1451, Alexandria, Virginia 22313-1451 and a copy is being deposited in the U.S. Mail, first class postage paid, addressed to John P. Bostany, the Bostany Law Firm, 40 Wall Street, 61st Floor, New York, New York 10005.



Charles J. Prescott

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: June 5, 2006

Cancellation No. 92044972

GMA Accessories, Inc.

v.

Cappelli Strawworld, Inc.

George C. Pologeorgis, Interlocutory Attorney:

This case now comes up on petitioner's motion, filed April 20, 2006, to compel respondent to answer petitioner's first request for production of documents and petitioner's first set of interrogatories. Respondent has failed to file a brief in response to petitioner's motion.

Accordingly, petitioner's motion to compel discovery is hereby granted as conceded. See Trademark Rule 2.127(a).

Respondent is allowed until **thirty days** of the mailing date of this order to respond to petitioner's first set of document requests and first set of interrogatories.

Moreover, these responses must be made in full and without objection because respondent failed either to timely respond or to object to petitioner's discovery requests.

See No Fear Inc. v. Rule, 54 USPQ2d 1551 (TTAB 2000).

Cancellation No. 92044972

Should respondent fail to provide the ordered responses, then petitioner's remedy will lie in a motion for entry of sanctions, in the form of entry of judgment sustaining the petition to cancel. See Trademark Rule 2.120(g)(1).

Proceedings are hereby resumed. Although discovery was already closed when proceedings were suspended pending disposition of petitioner's motion to compel, the discovery period is reset as indicated below for the limited purpose of allowing petitioner to take follow-up discovery, if necessary. Respondent is precluded from propounding any discovery at this juncture. Trial dates are also reset as follows:

DISCOVERY TO CLOSE **August 15, 2006**
(limited to petitioner's follow-up discovery)

Thirty-day testimony period for party in
position of plaintiff to close: **November 13, 2006**

Thirty-day testimony period for party in
position of defendant to close: **January 12, 2007**

Fifteen-day rebuttal testimony period for
plaintiff to close: **February 26, 2007**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days

Cancellation No. 92044972

after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

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UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

dmd

Mailed: August 28, 2006

Cancellation No. 92044972

GMA Accessories, Inc.

v.

Cappelli Straworld, Inc.

Petitioner's motion for discovery sanctions, filed July 17, 2006, is hereby granted as conceded. See Trademark Rules 2.120(g) and 2.127(a).

Accordingly, judgment is hereby entered against respondent, the petition to cancel is granted, and Registration No. 2670642 will be cancelled in due course.

*By the Trademark Trial
and Appeal Board*

DelGizzi

U. S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

GMA Accessories, Inc.

v.

Cappelli Straworld, Inc.

Cancellation No. 92044972

John P. Bostany of The Bostany Law Firm for GMA Accessories, Inc.

Charles J. Prescott of the firm of Charles J. Prescott, PA for Cappelli Straworld, Inc.

The petition of GMA Accessories, Inc., having been granted on August 28, 2006, Registration No. 2670642 is hereby cancelled.

OCT 24 2006



Lynne G. Beresford
Commissioner for Trademarks

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

-----X
GMA ACCESSORIES, INC.,

Opposer,

- against -

NOTICE OF OPPOSITION

DORFMAN-PACIFIC CO.,

Respondent.
-----X

Mark: CAPPELLI STRAWORLD
Serial No.: 77-965, 616
Class (es): 18, 25

Petitioner GMA Accessories, Inc. ("GMA"), through its undersigned counsel of record, hereby opposes the above application presented by DORFMAN-PACIFIC CO. ("DORFMAN-PACIFIC") to register CAPPELLI STRAWORLD in Classes 18 and 25 and in support thereof respectfully submits as follows:

1. GMA is the current title owner of Registration # 3,241,182 for the mark CAPELLI in International Class 14.
2. GMA is the current title owner of Registration # 3,241,184 for the mark CAPELLI in International Class 24.
3. GMA is the current title owner of Registration # 3,246,017 for the mark CAPELLI in International Class 9.
4. GMA is the current title owner of Registration # 3,248,875 for the mark CAPELLI in International Class 25.

5. GMA is the current title owner of Registration # 3,258,734 for the mark CAPELLI in International Class 3.
6. GMA is the current title owner of Registration #3,273,451 for the mark CAPELLI in International Class 28.
7. GMA is the current title owner of Registration #3,322,312 for the mark CAPELLI in International Class 26.
8. CAPPELLI STRAWORLD Mark consists of words only and prominently incorporates the word CAPPELLI which is practically identical to GMA's CAPELLI Mark.
9. DORFMAN-PACIFIC alleges use of its mark in connection with International Classes 18 and 25 as early as September 2009.
10. GMA's registration of CAPELLI in Class 25 shows use as early as 1991.
11. Bags are related to goods for which CAPELLI is registered to GMA.
12. GMA is the senior user.
13. GMA's registration in Class 25 pre-dates DORFMAN-PACIFIC's date of first use of CAPPELLI STRAWORLD.
14. The items with which the DORFMAN-PACIFIC commenced identifying with the mark CAPPELLI STRAWORLD are strikingly similar to those goods that were already being identified in commerce by GMA for many years before as CAPELLI.
15. In determining whether there is a likelihood of confusion, courts will consider whether the marks themselves are similar in appearance, sound, connotation and commercial impression. *In re. E. I. Dupont de Nemurs & Co.*, 476 F.2d 1357, 177 U.S.P.Q. 563 (CCPA 1973).

16. Numerous courts have found a likelihood of confusion notwithstanding the inclusion of additional words, prefixes or suffixes. *In re Denisi*, 225 U.S.P.Q. 624 (TTAB 1985); *CFM Majestic, Inc. v. NHC, Inc.*, 93 F. Supp.2d 942 (N.D. Ind. 2000); *Trident Seafoods Corp. v. Triton Fisheries, LLC.*, 2000 WL 33675750 at * 6 (D. Alaska June 30, 2000); 3 *McCarthy on Trademarks* §§ 23:55-23:56 at 23-164 through 23-169.

17. In determining whether there is a likelihood of confusion, the goods or services are to be compared to be determined if they are related or if the activities surrounding their marketing are such that confusion as to origin is likely. *In re August Storck KG*, 218 USPQ 823 (TTAB 1983); *In re International Telephone and Telegraph Corp.*, 197 USPQ 910 (TTAB 1978); *Guardian Products Co., v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978).

18. The goods of the parties need not be identical or directly competitive to find a likelihood of confusion. They need only be related in some manner, or the conditions surrounding their marketing be such, that they could be encountered by the same purchasers under circumstances that could give rise to the mistaken belief that the goods come from a common source. *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F. 2d 1565, 223 USPQ 1289 (Fed Cir. 1984); *In re Corning Glass Works*, 229 USPQ 65 (TTAB 1985); *In re Rexel, Inc.*, 223 USPQ 830 (TTAB 1984); *Guardian Products Co., Inc. v. Scott Paper Co.*, 200 USPQ 738 (TTAB 1978); *In re International Telephone & Telegraph Corp.*, 197 USPQ 910 (TTAB 1978).

19. The DORFMAN-PACIFIC Mark is similar to the GMA Mark in appearance, sound, connotation and commercial impression.

20. The goods that the DORFMAN-PACIFIC seeks to identify by its mark are commercially similar and will be marketed in similar commercial channels as GMA's services.

21. If the CAPPELLI STRAWORLD mark is allowed there will be likelihood of confusion with GMA's CAPELLI and dilution of GMA's CAPELLI mark.

22. DORFMAN-PACIFIC purchased CAPPELLI STRAWORLD, INC. sometime after 2006.

23. DORFMAN-PACIFIC is the successor in interest to CAPPELLI STRAWORLD, INC.

24. DORFMAN-PACIFIC is in privity with CAPPELLI STRAWORLD, INC.

25. Prior to filing its instant application, DORFMAN-PACIFIC had knowledge that GMA owned the mark CAPELLI.

26. GMA prevailed in a petition to cancel the CAPPELLI STRAWORLD Mark in 2006 in cancellation proceeding No. 92044972.

27. DORFMAN-PACIFIC's attorney, Charles Prescott represented CAPPELLI STRAWORLD, INC. in that proceeding.

28. On October 24, 2006, a Judgment was issued by the TTAB canceling the CAPPELLI STRAWORLD Mark.

29. DORFMAN-PACIFIC had a duty to include its awareness of GMA's CAPELLI Mark in its application.

30. DORFMAN-PACIFIC was aware its failure to disclose GMA's prior ownership of CAPELLI would decrease the chances of refusal.

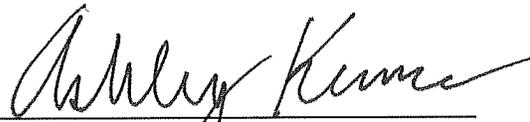
31. DORFMAN-PACIFIC's failure to disclose requires refusal of this application.

32. The TTAB's judgment canceling the CAPPELLI STRAWORLD' Mark is *res judicata* and requires refusal of this application.

WHEREFORE, GMA respectfully requests that the CAPPELLI STRAWORLD be refused registration.

Dated: October 14, 2010

Respectfully submitted,
THE BOSTANY LAW FIRM



By: Ashley Kurner

40 Wall Street – 61st Floor
New York, New York 10005
(212) 530-4400
Attorneys for Opposer

**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 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>.

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 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'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: November 23, 2010

/s/Michael James Cronen
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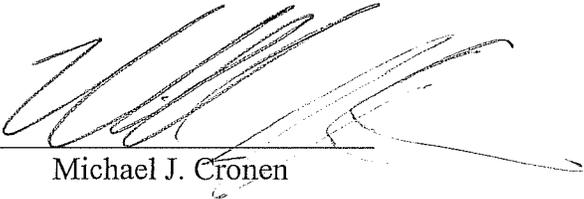
Attorneys For Applicant,
Dorfman-Pacific Co.

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

CERTIFICATE OF SERVICE

I, Michael J. Cronen, hereby certify that this paper (Answer and Counterclaim) is being deposited with the United States Postal Service on November 23, 2010, postage pre-paid, addressed to the following:

Ashley Kumar
The Bostany Law Firm
40 Wall Street - 61st Floor
New York, New York 10005
Attorney for Opposer



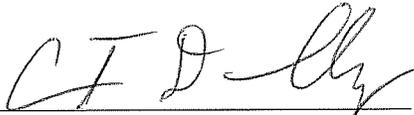
Michael J. Cronen

Mark: CAPPELLI
STRAWORLD
Serial No.: 77-965, 616
Class (es): 18, 25

CERTIFICATE OF SERVICE

I, Conor F. Donnelly, hereby certify that these papers (Notice of Motion for Summary Judgment and Declaration in Support with attached exhibits) are being deposited with the United States Postal Service on December 7, 2010, postage pre-paid, addressed to the following:

Michael J. Cronen
Zimmerman & Cronen, LLP
1330 Broadway, Suite 710
Oakland CA 94612-2506



Conor F. Donnelly, Esq.