

ESTTA Tracking number: **ESTTA759641**

Filing date: **07/21/2016**

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

Proceeding	91224626
Party	Plaintiff Astucci U.S. Ltd.
Correspondence Address	DAVID B SUNSHINE COZEN OCONNOR PC 277 PARK AVE NEW YORK, NY 10172 UNITED STATES tmdocketing@cozen.com, dsunshine@cozen.com
Submission	Answer to Counterclaim
Filer's Name	David B. Sunshine
Filer's e-mail	tmdocketing@cozen.com, dsunshine@cozen.com
Signature	/David B. Sunshine/
Date	07/21/2016
Attachments	AstucciAnswer3 PDF.pdf(128960 bytes)

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

ASTUCCI U.S. LTD.)	
)	
)	
Opposer/Counterclaim Defendant,)	Opposition No. 91224626
)	
v.)	Mark Subject of Counterclaim: ASTUCCI
)	
GATTO ASTUCCI S.P.A.)	
)	Registration No.: 2,627,183
Applicant/Counterclaim Plaintiff)	
)	
)	

ANSWER TO COUNTERCLAIM FOR CANCELLATION

Astucci U.S. Ltd. (hereinafter, “Astucci” or “Opposer”), by its undersigned attorneys, Cozen O’Connor, hereby responds to the Counterclaim for Cancellation (hereinafter, the “Counterclaim Petition”) filed by Gatto Astucci S.p.A. (hereinafter, “Gatto Astucci” or “Applicant”) against Astucci’s U.S. Trademark Registration No. 2,627,183 (the “183 Registration”) for the mark ASTUCCI as follows:

In response to the first unnumbered paragraph of the Counterclaim Petition, Astucci denies allegations.

1. Astucci admits that its registration for ASTUCCI is directed to eyeglass cases in Class 9 and handbags in Class 18. Astucci denies the remaining allegations of Paragraph 1 of the Counterclaim Petition.
2. Astucci denies the allegations of Paragraph 2 of the Counterclaim Petition.
3. Astucci denies the allegations of Paragraph 3 of the Counterclaim Petition.

4. Astucci denies the allegations of Paragraph 4 of the Counterclaim Petition. In addition, Applicant's claim in Paragraph 4 of the Counterclaim Petition that the ASTUCCI mark is descriptive has been dismissed from the Counterclaim Petition. See Dkt. No 11.

5. Astucci denies the allegations of Paragraph 5 of the Counterclaim Petition. In addition, Applicant's claim in Paragraph 4 of the Counterclaim Petition that the ASTUCCI mark is descriptive has been dismissed from the Counterclaim Petition. See Dkt. No 11.

AFFIRMATIVE DEFENSES

First Affirmative Defense

Applicant's Counterclaim Petition fails to state a claim upon which relief may be granted.

Second Affirmative Defense

The claims asserted by Applicant in the Counterclaim Petition is barred by the doctrine of unclean hands on the ground that, *inter alia*, during the prosecution of the application for Applicant's GATTO ASTUCCI 1937 and Design mark, Applicant entered a translation statement of the mark "Gatto Astucci" as "cat boxes." That translation is inconsistent with the translation that Applicant is now arguing should be applied to Astucci's ASTUCCI mark. Moreover, Applicant has unclean hands because Applicant failed to disclaim exclusive rights to the term "Astucci" which contradicts its position in this proceeding that the term "Astucci" is generic for "cases."

Third Affirmative Defense

Applicant is estopped from asserting the claims it asserts in the Counterclaim Petition since, *inter alia*, during the prosecution of the application for Applicant's GATTO ASTUCCI 1937 and Design mark, Applicant entered a translation statement of the mark "Gatto Astucci" as "cat boxes." Applicant is estopped from now arguing that the term "Astucci" should be

translated as “cases” when it previously asserted that “Astucci” means “boxes.” Applicant is also estopped from asserting that Astucci is generic because in its own application for GATTO ASTUCCI 1937 and Design, Applicant failed to disclaim exclusive rights to the term “Astucci.” That position is directly at odds with its position in this proceeding that the term “Astucci” is generic for “cases.”

Fourth Affirmative Defense

Applicant’s Counterclaim Petition is barred by the doctrine of laches and estopped because inter alia Applicant waited over thirteen (13) years from the registration date of the ASTUCCI registration to commence this proceeding. There can be no reasonable dispute that Applicant unduly and/or unreasonably delayed commencing this proceeding and such delay prejudiced Astucci.

WHEREFORE, Astucci hereby respectfully requests that the Counterclaim Petition be dismissed with prejudice.

Respectfully submitted,

COZEN O’CONNOR

Dated: July 21, 2016

By:

/David B. Sunshine/
David B. Sunshine
277 Park Avenue
New York, New York 10172
Tel. (212) 883-4900
Fax (212) 986-0604
E-mail: dsunshine@cozen.com
Attorneys for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing ANSWER TO COUNTERCLAIM PETITION was served upon counsel for Applicant by First Class Mail, postage prepaid, on this July 21, 2016 as follows:

JONATHAN MYERS
LUCAS & MERCANTI LLP
30 BROAD ST FL 21
NEW YORK, NY 10004
UNITED STATES

/David B. Sunshine/