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Filing date: **01/08/2016**

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

| | |
|------------------------|---|
| Proceeding | 91225152 |
| Party | Defendant Lesilu Productions, Inc. |
| Correspondence Address | DAVID A. JACKSON KLAUBER & JACKSON 25 E SPRING VALLEY AVE STE 160 MAYWOOD, NJ 07607-2154 info@kjiplaw.com |
| Submission | Answer and Counterclaim |
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| Signature | /lawrence d. mandel/ |
| Date | 01/08/2016 |
| Attachments | ANSWER AND AFFIRMATIVE DEFENSES AND COUNTERCLAIM PETITION.PDF(241003 bytes) |

Registration Subject to the filing

| | | | |
|-----------------|--|-------------------|------------|
| Registration No | 4380027 | Registration date | 08/06/2013 |
| Registrant | Macaluso, Jennifer 106 Tilson Place Staten Island, NY 10305 UNITED STATES | | |

Goods/Services Subject to the filing

Class 014. First Use: 2008/05/00 First Use In Commerce: 2008/10/00
All goods and services in the class are requested, namely: Jewelry

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

In the Matter of the Trademark Application Serial No. 86/353585
Published in the Official Gazette on August 4, 2015

JENNIFER MACALUSO,

Opposer,

v.

LESILU PRODUCTIONS, INC.,

Applicant.

Opposition No. 91225152

Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

Trademark Trial and Appeal Board

**ANSWER AND AFFIRMATIVE DEFENSES TO THE
NOTICE OF OPPOSITION AND COUNTERCLAIM
PETITION FOR CANCELLATION**

Applicant, Lesilu Productions, Inc., by and through its attorneys, hereby answers the Notice of Opposition as follows:

1. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 of the Notice of Opposition, and, therefore, denies the same.

2. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 of the Notice of Opposition, and, therefore, denies the same.

3. Applicant admits the allegations in Paragraph 3 of the Notice of Opposition.

4. Applicant denies the allegations in Paragraph 4 of the Notice of Opposition.

5. Applicant denies the allegations in Paragraph 5 of the Notice of Opposition.
6. Applicant denies the allegations in Paragraph 6 of the Notice of Opposition.
7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 7 of the Notice of Opposition, and, therefore, denies the same.
8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 8 of the Notice of Opposition, and, therefore, denies the same.
9. Applicant denies the allegations in Paragraph 9 of the Notice of Opposition.
10. Applicant admits that a portion of Applicant's business is in private label manufacturing and sales, and Applicant denies all other allegations in Paragraph 10 of the Notice of Opposition.
11. Applicant denies the allegations in Paragraph 11 of the Notice of Opposition.
12. Applicant denies the allegations in Paragraph 12 of the Notice of Opposition.

FIRST AFFIRMATIVE DEFENSE

Opposer has failed to state a claim upon which relief can be granted.

SECOND AFFIRMATIVE DEFENSE

Opposer lacks standing to assert the claims in the Notice of Opposition.

THIRD AFFIRMATIVE DEFENSE

Opposer does not own any trademark or service mark.

FOURTH AFFIRMATIVE DEFENSE

Opposer has made no use in commerce (as the term is defined in the Trademark Act, 15 U.S.C. § 1127) of the designation "HEY, DOLLFACE!".

FIFTH AFFIRMATIVE DEFENSE

Opposer has no standing to assert the claims made in the Notice of Opposition.

SIXTH AFFIRMATIVE DEFENSE

Applicant has priority of use over Opposer.

SEVENTH AFFIRMATIVE DEFENSE

If it is true that, as Opposer claims, "Applicant's identified goods are identical or so closely related to Opposer's goods that they are likely to be encountered by the same persons under circumstances that would lead to the mistaken belief that they originate from the same source," then Opposer has no right to be selling jewelry under Opposer's alleged mark.

WHEREFORE, Applicant prays for judgment dismissing the Notice of Opposition, with prejudice in all respects, and allowing Application Serial No. 86/353,585 to proceed to registration.

COUNTERCLAIM PETITION FOR CANCELLATION

Lesilu Productions, Inc., having an address at 60 West 38th Street, 3rd Floor, New York, New York 10018 believes that it is or will be damaged by Registration No. 4,380,027 for the mark HEY, DOLLFACE! and hereby petitions to cancel said registration. As grounds for cancellation, Petitioner alleges as follows:

1. Petitioner has adopted and continuously used the trademark HEY DOLL since at least as early as June 30, 2004 to the present, to distinguish its goods, namely, jewelry, namely, earrings, rings, diamonds, necklaces, chains, bracelets, brooches, pins, and watches, in International Class 14.
2. Through its extensive sales and advertising, Petitioner has developed extensive goodwill with respect to the mark HEY DOLL.

3. Petitioner filed an Application for registration of the mark HEY DOLL in respect of “jewelry, namely, earrings, rings, diamonds, necklaces, chains, bracelets, brooches, pins and watches,” in International Class 14 on July 31, 2014 and received U.S. Trademark Application Serial No. 86/353,585.

4. On July 31, 2014, Petitioner applied to register HEY DOLL for “cosmetics, body lotions, perfume, skin moisturizers, shampoos, and conditioners, in International Class 3; eyewear, namely sunglasses, eyeglasses, ophthalmic frames, chains for eyeglasses, eyeglass cases, eyeglass cords, eyeglass lanyards, eyeglass lenses, eyeglass retaining cords, in International Class 9; handbags for men and women; purses and wallets, in International Class 18; hair brushes and combs, in International Class 21; clothing; namely, shirts, tops, shoes, hats and caps, in International Class 25, based on an intent to use the mark, and received Application Serial No. 86/353,924.

5. Upon information and belief, Jennifer Macaluso is an individual and is the owner of Registration No. 4,380,027 for the mark HEY, DOLLFACE! in respect of “jewelry,” in International Class 14 (“Registrant”).

6. In the course of the examination of Petitioner’s Application Serial No. 86/353,585 for the mark HEY DOLL in class 14, Registrant has asserted Registration No. 4,380,027 as an obstacle to Petitioner obtaining a Federal Registration for its HEY DOLL mark for the class 14 goods stated above.

7. Registrant has claimed a date of first use in commerce of October 2008. Petitioner’s use of its mark HEY DOLL predates Registrant’s claimed date of first use, thereby entitling Petitioner to priority in rights over Registrant.

8. The goods recited in Registration No. 4,380,027 are closely related to the goods offered for sale and sold by Petitioner so that the use of Registrant's mark HEY, DOLLFACE! for such goods is likely to cause confusion, or to cause mistake or to deceive.

9. HEY, DOLLFACE! for "jewelry" is confusingly and deceptively similar to Petitioner's mark, such that the trade and purchasing public will be confused and deceived by believing that Registrant's goods originate with or are otherwise authorized, sponsored, licensed or associated with Petitioner.

10. Based on the foregoing, registration of Registration No. 4,380,027 is causing and will continue to cause damage to Petitioner.

11. This Petition for Cancellation is submitted herewith along with the Requisite Fee of \$300.00.

WHEREFORE, it is respectfully requested that the Trademark Trial and Appeal Board cancel Registration No. 4,380,027.

Respectfully submitted,
LESILU PRODUCTIONS, INC.

By:



Lawrence D. Mandel
Attorneys for Petitioner
GERTNER MANDEL, LLC
P.O. Box 499
Lakewood, New Jersey 08701
(732) 363-3333

CERTIFICATE OF SERVICE

I hereby certify that the foregoing Answer, Affirmative Defenses to the Notice of Opposition and Counterclaim Petition for Cancellation was served this 8th day of January, 2016, by depositing a copy thereof in the U.S. mail, postage prepaid, addressed to the Attorney for Registrant as follows:

Ron Lazebnik
Lincoln Square Legal Services, Inc.
150 W 62nd St., 9th Floor
New York, NY 10023

A handwritten signature in black ink, appearing to read "Lawrence D. Mandel", written over a horizontal line.

Lawrence D. Mandel