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

Proceeding	92047433
Party	Defendant Jay-Y Enterprise Co., Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**  
**BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

GADO S.R.L.,

Petitioner,

v.

JAY-Y ENTERPRISE CO., INC.,

Respondent.

AND RELATED COUNTERCLAIM.

Cancellation No. 92047433

**JAY-Y ENTERPRISE CO., INC.’S REPLY IN SUPPORT OF ITS EVIDENTIARY**  
**OBJECTIONS TO EVIDENCE OFFERED IN GADO S.R.L.’S PRINCIPAL BRIEF**

Respondent Jay-Y Enterprise Co., Inc. (“Jay-Y”) hereby submits this response to the Brief in Opposition To Respondent’s Evidentiary Objections And In Further Support Of Its Evidentiary Objections (“Pet. Evid. Opp.”) filed by Gado S.R.L.(“Gado”).

**I. INTRODUCTION**

Gado’s response to Jay-Y’s evidentiary objections not only misapprehends the focus of those objections, but illustrates the remarkably incomplete showing Gado has made in support of its Petition for Cancellation. Given Gado’s heavy burden of proof in showing that Jay-Y’s registrations should be cancelled, it is astounding that Gado is forced to rely on strained interpretations of its own witnesses’ testimony in order to support facts that should have been easy to prove, such as the date when each of Gado’s marks was first used in the United States. As discussed herein, Jay-Y’s objections to that testimony are meritorious, and the testimony should be excluded and not considered.

Similarly, while Gado's discussion regarding the financial information contained in its 2001 Annual Report responds to an objection Jay-Y has not raised, that discussion exemplifies another fundamental defect in Gado's overall evidentiary showing. In stark contrast to Jay-Y's inherently credible documentary evidence of specific sales of specific products to specific customers (all attested to by the owners of Jay-Y and a disinterested computer consultant), Gado has introduced nothing more than a single annual report and reports created for litigation tied together by the testimony of witnesses with little or no personal knowledge of the information to which they testified.

Because Jay-Y's evidentiary objections are meritorious, they should be sustained.

**II. ALL OF THE EVIDENCE REGARDING "THE LAUNCH OF DOLCE & GABBANA IN THE UNITED STATES" (SECTION II.A) IS INADMISSIBLE HEARSAY OR LACKS FOUNDATION**

Section II.A of the Principal Brief purports to describe the history of the Dolce & Gabbana line. That history is based almost entirely on Exhibit A (the 2001 Annual Review) and the testimony of Ms. Forte. Because the supporting evidence is inadmissible, the entire section should not be considered.

**A. Jay-Y's Objection To The 2001 Annual Report Should Be Sustained**

In its Evidentiary Objections, Jay-Y objected to Gado's reliance on the 2001 Annual Report to the extent it purported to set forth the alleged renown of the Dolce & Gabbana brand and the history of the company. (Jay-Y Evid. Obj. at 2-3.) In response, Gado simply asserts that the Annual Report is a business record of the company, and therefore is admissible under Fed. R. Evid. 803(6). (Pet. Evid. Opp. at 2-4.) In reality, because of the varied nature of the information generally contained in an annual report, the admission of that information requires a more nuanced analysis than simply determining whether or not the report is a business record.

For example, in *American Express Co. v. Darcon Travel Corp.*, 215 USPQ 529 (TTAB 1982), the Board dealt with the issue of which portions of a 1980 annual report were admissible and which were not. While the testifying witness was responsible for the report's publication, he was not competent to testify regarding data included in the report that dated from 1975 because "the keeping of the underlying records for the year 1975 was not a matter within his personal knowledge." *Id.* at 532 (citing *Transamerica Financial Corp. v. Trans-American Collections, Inc.*, 197 USPQ 43, 49 (TTAB 1977) (10-year earnings data from corporate annual report introduced by witness employed during middle of period deemed not reliable); *Ferro Corporation v. Nicrofibers, Inc.*, 196 USPQ 41, 42 at fn. 2 (TTAB 1977) (officer's testimony as to sales figures, advertising costs, etc. prepared by other individuals not available for cross-examination not considered by Board)).

Similarly, Mr. Vannucchi expressly testified that the 2001 Annual Report included two types of information, financial data and general information about the company. (Vannucchi Depo. 35:25-36:13 ("It's a mix of financial information and I'll say information of the company ... what is the story and what is the numbers")). Mr. Vannucchi also made it clear that he was only responsible for the financial portion of the Report.

Specifically, Mr. Vannucchi testified that the Report was created not by him, but by the "General Affairs Department" of the company. (Vannucchi Depo. 36:22-37:4.) He then described the portions of the report that he could substantiate and those that he could not:

- Q. Where did the General Affairs Department get the information?
- A. Basically I will say the picture from the advertising and the PR department, the story, talking with Mr. Dolce, historical person that's working since the beginning of the company; and the financial from my office or -- Planning and Control or from the other department that is Finance and Administration office. We have two separate functions.

(Vannucchi Depo. 37:5-15.) Thus, Mr. Vannucchi was responsible for some portion of the financial aspects of the Report, but not “the picture” or “the story,” namely the information regarding the company itself. (See Vannucchi Depo. 37:16-38:6; 38:19-39:11.) This makes perfect sense, given that Mr. Vannucchi was not employed by Dolce & Gabbana until 1999, and therefore had no personal knowledge regarding the history of the company. (Vannucchi Depo. 7:16-21.)<sup>1</sup>

Because Mr. Vannucchi was not competent to testify regarding the history of the company, his testimony does not support the introduction of the 2001 Annual Report to the extent it purports to set forth that history. Jay-Y’s objection to the Report to the extent it is relied upon by Gado as a basis for determining the history of the use of the DOLCE & GABBANA mark, and the history of the company, should be sustained.

B. Ms. Forte’s Testimony Regarding The History Of Dolce & Gabbana Lacks Foundation And Is Hearsay

In response to Jay-Y’s objections to Ms. Forte’s testimony, Gado relies on her testimony that she knows of what she speaks “because I work in a competitive industry. It’s my job to know what’s going on.” (Pet. Evid. Opp. at 5; Forte Depo. 31:7-9.) While Ms. Forte states further that her knowledge is based on her conversations with “all the journalists” and “everyone” (Forte Depo. 33:2-3), at no point does she present any testimony regarding *how* she knows about the early history of Dolce & Gabbana *other* than her conversations with “all the journalists” and “everyone.” If all that it took for a witness to lay a foundation for testimony

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<sup>1</sup> Gado’s footnoted reliance on the decision in *Tele Atlas N.V. v. NAVTEQ Corp.*, 2008 WL 4809441, \*6 (N.D. Cal. Oct. 20, 2008) is unavailing. In *Tele Atlas* the court held that “[p]ersonal knowledge of certain aspects of a business may be inferred from a person’s position in that business.” *Id.* Therefore, the court reasoned, “it is a reasonable inference” that the Chief Operating Officer of a party has familiarity with certain aspects of the party’s business relationships. *Id.* Here, in contrast, Mr. Vannucchi expressly testified that the information in the Annual Report relied upon by Gado was *not* obtained from him.

under Rule 602 of the Federal Rules of Evidence was to state “it is my job to know,” then the Rule would have no meaning. Because Ms. Forte did not provide any foundation for her statements regarding the history of Dolce & Gabbana, her testimony is inadmissible.<sup>2</sup>

C. By Not Addressing Them, Gado Tacitly Admits That Jay-Y’s Objections To Gado’s Cited Articles Are Well Taken

Jay-Y noted in its Evidentiary Objections that the articles cited by Gado to support the purported history of Dolce & Gabbana – NOR Exhibits 50, 52, 53, 54, 78 and 83 – are only admissible for what they show on their face, but not for the truth of the matters stated therein. *Syngenta Crop Protection Inc. v. Bio-Chek LLC*, 90 USPQ2d 1112, 1117 n.7 (TTAB 2009) (printed publications probative only for what they show on their face, not for the truth of the matters contained therein, unless a competent witness has testified to the truth of such matters). For example, NOR 50, an article that purports to discuss clothing worn by Madonna, is not admissible for the proposition that Madonna actually wore clothing designed by Mr. Dolce and Mr. Gabbana, but simply for the fact that there was an article that mentions the two designers. Similarly, NOR 52, 53, 54 and 83 simply show that articles were published that mentioned the designers. NOR 78 is nothing more than the cover and a few pages from a book entitled “the Girlie Tour”; there is no mention of Gado or its marks in the Notice of Reliance. This evidence, untethered as it is to any testimony or even the marks at issue, does not support the notion that any of Gado’s marks were in use in the United States.

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<sup>2</sup> Gado’s citation to *Florida Engineered Construction Products Corp. v. Cast-Crete, Inc.*, 2006 WL 1087855, \*5 (TTAB April 13, 2006) is unavailing. In *Florida Engineered*, the Board overruled objections based on hearsay expressly because “the statements of both declarants were made with personal knowledge and not based on out-of-court statements of persons other than the declarants.” *Id.* By contrast, Ms. Forte’s statement *were* based on out-of-court statements of persons other than Ms. Forte.

**III. JAY-Y’S OBJECTIONS TO THE TESTIMONY OF MS. FORTE  
AND MR. VANNUCCHI REGARDING THE PURPORTED FIRST  
USE OF “DOLCE & GABBANA” AND “D&G DOLCE &  
GABBANA” SHOULD BE SUSTAINED**

As noted above, it is remarkable that Gado relied solely upon the testimony of two witnesses, neither of whom were employed by Dolce & Gabbana prior to 1999, to attempt to prove that it first used the D&G DOLCE & GABBANA mark in or around 1994. As can be seen from Jay-Y’s evidence – computerized sales records reflecting the dates specific model numbers of products were sold coupled with samples of those products reflecting the specific model numbers – it is relatively easy to demonstrate the date when a mark was first used in commerce in the United States.<sup>3</sup>

In stark contrast to Jay-Y’s evidence, Gado relies on the testimony of Mr. Vannucchi and Ms. Forte, neither of whom had the requisite personal knowledge to render competent their testimony regarding use of the D&G DOLCE & GABBANA mark.

With regard to Ms. Forte, and again illustrating the insubstantial character of its evidence of use, Gado goes to great lengths to impart personal knowledge on Ms. Forte where none exists.

Ms. Forte’s testimony regarding the first use of the D&G DOLCE & GABBANA mark in the United States consists solely of her reference to a fashion show at which the D&G DOLCE & GABBANA mark allegedly was displayed. In response to Jay-Y’s objections, Gado curiously asserts that Ms. Forte’s testimony is “not offered to prove the details of what happened at the fashion show [but rather] to show that a show for the D&G DOLCE & GABBANA line was

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<sup>3</sup> While Gado quibbles with the fact that certain of the invoices printed by Jay-Y included incorrect customer information because that specific information changed between 1993 and 2009, it cannot counter the overwhelming evidence that the records are inherently reliable and admissible.

planned and took place in New York.” (Pet. Evid. Opp. at 6.) Accepting Gado’s representation at face value, Ms. Forte’s testimony is rendered irrelevant in that she cannot competently testify regarding whether the D&G DOLCE & GABBANA mark was even used during the purported fashion show. There is no support for the notion that a mark was used simply because a fashion show “was planned and took place.” Moreover, given the uncertainty of Ms. Forte’s testimony regarding when the fashion show allegedly took place – “it could have been ’95, ’96, ’97, *it’s around that time*” (emphasis added) – her testimony is both inadmissible and far too vague to support the proposition for which it was introduced.

It is noteworthy that Gado makes no attempt to salvage Ms. Forte’s testimony regarding where she allegedly first saw the D&G DOLCE & GABBANA mark. (Forte Depo. 42:9-18; Jay-Y Obj. at 5.)

In short, Ms. Forte has no personal knowledge regarding when and where Gado allegedly first used its D&G DOLCE & GABBANA mark. As a result, not only is her testimony inadmissible, but there is no support for Gado’s assertion that it first used its D&G DOLCE & GABBANA mark in the United States at any time prior to 1999.

With regard to Mr. Vannucchi, Gado presents only a half-hearted (and footnoted) response to Jay-Y’s objection that he has no personal knowledge to support his testimony regarding the opening of a store that used the D&G DOLCE & GABBANA mark. (Pet. Evid. Opp. at 7 n.3.) In the portion of his testimony cited by Gado, Mr. Vannucchi outlines his duties as the “Director of Planning and Control” at Dolce & Gabbana, duties which he describes as primarily involving gathering financial information and presenting a budget to the company’s board of directors. (Vannucchi Depo. 7:16-10:9.) There is nothing in Mr. Vannucchi’s testimony

that supports the proposition that he knows (or even should know) when specific stores opened. Particularly when they allegedly opened before he was employed at the company.

Because neither Ms. Forte nor Mr. Vannucchi have personal knowledge regarding when the D&G DOLCE & GABBANA mark was first used in the United States, their testimony on that score should be stricken and not considered.

**IV. BY NOT ADDRESSING THEM, GADO TACITLY ADMITS THAT JAY-Y'S OBJECTIONS TO THE EVIDENCE REGARDING GADO'S ADOPTION OF THE DG MARK ARE WELL TAKEN**

Jay-Y objected to the evidence regarding the purported adoption and first use of the DG mark by Gado on the ground it lacked foundation. (Jay-Y Evid. Obj. at 6.) Gado has not addressed the objection, thereby admitting that Ms. Forte's testimony regarding Gado's first use of the DG mark is, indeed, inadmissible.

**V. JAY-Y'S PRIOR APPLICATIONS ARE NOT RELEVANT TO THE ISSUES PRESENTED IN THIS PROCEEDING**

Citing a single inapplicable case, Gado again misapprehends the nature of Jay-Y's objection to the introduction of some of its prior applications to register marks not at issue here. As previously noted, the prior applications are not relevant because they illustrate nothing more than that some of Jay-Y's applications to register marks were rejected. Even had there been an adjudication that one of Jay-Y's applied-for marks was considered by the Patent and Trademark Office to be confusingly similar to a third-party's mark, such an adjudication would not in any manner impact the Board's decision in this proceeding.

The only case cited by Gado, *Racine Industries, Inc. v. Bane-Clene Corp.*, 35 USPQ2d 1832 (TTAB 1994), is inapplicable here. Racine opposed registration of the mark "PCA" on the



**CERTIFICATE OF SERVICE**

I hereby certify that on December 23, 2011, I served the foregoing JAY-Y ENTERPRISE CO., INC.'S REPLY IN SUPPORT OF ITS EVIDENTIARY OBJECTIONS TO EVIDENCE OFFERED IN GADO S.R.L.'S PRINCIPAL BRIEF on Petitioner and Counterclaim Respondent Gado S.R.L. ("Gado") by depositing a true copy thereof in a sealed envelope, postage prepaid, in First Class U.S. mail addressed to Gado's counsel as follows:

Mark Lerner, Esq.  
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*/s/ Kenneth L. Wilton*

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Kenneth L. Wilton