

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

Mailed: April 15, 2010

Cancellation No. 92047433

Gado S.A.R.L.

v.

Jay-Y Enterprise Co., Inc.

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on respondent's motion (filed August 26, 2009) to amend the answer.

Telephone Conference

The Board exercised its discretion to determine the outstanding motion by telephone and conducted a conference on March 26, 2010, at approximately 3:00 p.m. Eastern time. Participating in the conference were Mark Lerner, counsel for petitioner; Kenneth Wilton, counsel for respondent; and the above-signed attorney responsible for resolving interlocutory disputes in this case.

During the conference the Board considered the briefs on the motion and supporting exhibits, as well as statements made by counsel for both parties. In addition to addressing the substantive analysis of the issues presented by the motion, the Board discussed several procedural issues and inquired as to the possibility of settlement between the parties.

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The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the briefs or the statements made during the telephone conference. Instead, this order lists the decisions made by the Board.

Motion to Amend the Answer

By way of its motion, respondent seeks to amend the answer to assert an affirmative defense of priority, and to add counterclaims against petitioner's pleaded registrations as follows: Counterclaims on the ground of fraud against Registration Nos. 1742622, 2096500, and 3108433, and a counterclaim on the ground of priority and likelihood of confusion against Registration No. 3108433.

Respondent's motion to amend was granted, in part, as to the affirmative defense of priority and the counterclaim on the ground of priority and likelihood of confusion against Registration No. 3108433. However, the motion was denied, in part and without prejudice, as to the counterclaims on the ground of fraud. In view thereof, the Board struck paragraphs 4 through 44 (inclusive) of the "counterclaims for cancellation" section of the first amended answer.

Schedule

Respondent is allowed until April 26, 2010, in which to file a second amended answer and counterclaims which may include properly pleaded counterclaims of fraud against Registration Nos. 1742622, 2096500, and 3108433, failing

which, the first amended answer and counterclaim, as stricken, will be respondent's operative pleading.

Petitioner is allowed until May 26, 2010, in which to file an answer or other responsive pleading to the second amended answer and counterclaims, if filed, or to the first amended answer and counterclaim, as stricken, if no second amended answer is filed.

Proceedings were resumed on the schedule below. Discovery is open and limited to issues concerning the affirmative defense of priority and the operative counterclaim(s).

Second amended answer and counterclaims due, if filed:	April 26, 2010
Answer to counterclaim(s) due:	May 26, 2010
Limited discovery period to close:	August 26, 2010
30-day testimony period for Gado as plaintiff in the Cancellation to close:	November 24, 2010
30-day testimony period for Jay-Y as defendant in the cancellation and as plaintiff in the counterclaim to close:	January 23, 2011
30-day testimony period for Gado as defendant in the Counterclaim and its rebuttal testimony as plaintiff in the cancellation to close:	March 24, 2011
15-day rebuttal testimony period for Jay-Y as plaintiff in the counterclaim to close:	May 8, 2011
Brief for Gado as plaintiff in the cancellation shall be due:	July 7, 2011
Brief for Jay-Y as defendant in the cancellation and as plaintiff in the counterclaim shall be due:	August 6, 2011

Brief for Gado as defendant in the counterclaim and its reply brief (if any) as plaintiff in the cancellation shall be due: September 5, 2011

Reply brief (if any) for Jay-Y as plaintiff in the counterclaim shall be due: September 20, 2011

Procedural Issues

The filing fee for the counterclaim against all five International Classes of Registration No. 3108433 will be charged to the deposit account as authorized in respondent's motion.

Petitioner need not re-file its testimony already made of record.

Although this is an "old" rules case, commenced prior to the November 1, 2007 amendment of Trademark Rule 2.120 (*See Miscellaneous Changes to Trademark Trial and Appeal Board Rules*, 72 Fed. Reg. 42242 (Aug. 1, 2007)), and there is no requirement for a mandatory discovery conference, the parties indicated that they would meet and discuss discovery issues related to the affirmative defense of priority and the operative counterclaim(s).