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Filing date: **05/24/2010**

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

Proceeding	92047433
Party	Plaintiff Gado S.A.R.L.
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Submission	Answer to Counterclaim
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Date	05/24/2010
Attachments	10 05 24 Reply to Counterclaims.pdf (4 pages)(117714 bytes)

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GADO S.A.R.L.	:	
	Petitioner,	Cancellation No. 92047433
		:
-against-		Petitioner GADO S.R.L.'s Reply
		to Counterclaims by Respondent
JAY-Y ENTERPRISES CO., INC.,	:	Jay-Y Enterprises Co. Inc.
		:
	Respondent.	:
		:
JAY-Y ENTERPRISES CO., INC.,	:	
	Counterclaimant,	:
		:
-against-		:
		:
GADO S.A.R.L.	:	
		:
	Counterclaim-Defendant.	

Petitioner/Counterclaim-Defendant Gado S.r.l.¹ (“Petitioner” or “Gado”), by its attorneys Satterlee Stephens Burke & Burke LLP, for its answer and reply to the counterclaim raised in the First Amended Answer to Consolidated Petition For Cancellation and Counterclaims for Cancellation, as modified by the Board’s Order of April 15, 2010, (the “Counterclaim”), responds to the allegations as follows:

1. Denies knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 1 of the Counterclaim, except admits that Jay-Y Enterprises Co. Inc (“Jay-Y” or “Counterclaimant”) is the respondent in the above-captioned cancellation proceeding.

¹ Petitioner changed its corporate name from Gado S.A.R.L. to Gado S.R.L. after the initiation of this proceeding.

2. Petitioner denies the allegations contained in Paragraph 2 of the Counterclaim, and affirmatively states that Counterclaim-Defendant Gado *S.r.l.* is organized and exists under the laws of Italy.

3. Petitioner admits the allegations contained in Paragraph 3 of the Counterclaim.

4. Petitioner offers no response to the allegations made in Paragraphs 4 through 44 of the Counterclaim as these paragraphs were stricken from the Counterclaim pursuant to the Board's Order of April 15, 2010.

5. In response to Paragraph 45 of the Counterclaim, Petitioner repeats and reavers the responses made to the allegations found in Paragraphs 1-3 and 37-44 as if fully set forth herein.

6. In response to Paragraph 46 of the Counterclaim, Petitioner begs leave to refer the Board to a true and correct copy of Registration No. 3,108,433 for a true and complete statement of the contents thereof and a full statement of the goods covered.

7. In response to Paragraph 47 of the Counterclaim, Petitioner begs leave to refer the Board to a true and correct copy of Registration No. 3,108,433 and the trademark file for a true and correct statement of the contents thereof.

8. Petitioner denies the allegations contained in Paragraph 48 of the Counterclaim.

9. In response to Paragraph 49 of the Counterclaim, Petitioner begs leave to refer the Board to the Petition for Cancellation for a true and complete statement of the contents thereof.

10. Petitioner denies the allegations contained in Paragraph 50 of the Counterclaim.

Affirmative Defenses

Priority

11. Petitioner's actual or constructive date of first use for the Mark D&G (U.S. Registration No. 3,108,433) is prior to Jay-Y's actual or constructive dates of first use for the mark DG purportedly used by Counterclaimant on sunglasses or the mark DG found in Registrations Nos. 2,582,314 and 2,663,337 ("Respondent's DG Marks").

Estoppel/Unclean Hands

12. Counterclaimant's DG Marks were derived from marks owned and registered by Gado: D&G (Registration No. 3,108,433), D&G DOLCE & GABBANA (Registration No. 2,096,500), DOLCE & GABBANA (Registration No. 1,742,622) and its unregistered DG mark (collectively, "Petitioners' DG Marks").

13. Counterclaimant created, marketed, and registered its DG Marks in an attempt to take advantage of goodwill surrounding Petitioner's DG Marks.

14. Thus Counterclaimant should be estopped from seeking the cancellation of the Mark D&G (U.S. Registration No. 3,108,433).

Laches

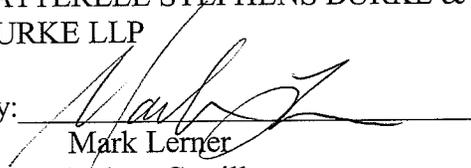
15. The Counterclaim is barred by the doctrines of waiver, laches, and/or the applicable statute of limitations.

WHEREFORE, Petitioner Gado S.r.l. prays that the Board dismiss the Counterclaim in its entirety and that the Board provide such other and further relief as it deems just and necessary.

Dated: New York, New York
May 14, 2010

SATTERLEE STEPHENS BURKE &
BURKE LLP

By:


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CERTIFICATE OF SERVICE
(37 C.F.R. § 2.119)

I declare under penalty of perjury that on the 24 day of MAY, 2010,
Petitioner/Counterclaim-Defendant's Reply to the Counterclaim by
Respondent/Counterclaimant was served by Federal Express Overnight Mail, addressed to
Kenneth L. Wilton, Seyfarth Shaw LLP, 2029 Century Park East, Suite 3500, Los Angeles,
California 20067-3063, Attorney for the Respondent.