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Filing date: **03/29/2012**

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

Proceeding	91203351
Party	Defendant GMA Accessories, Inc.
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Submission	Opposition/Response to Motion
Filer's Name	Kathryn C. Haertel
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Signature	/KCH/
Date	03/29/2012
Attachments	Reply.3.29.12.pdf (4 pages)(124861 bytes) Exhibit A.pdf (1 page)(59317 bytes) Cert.of.Service.2.7.12.pdf (1 page)(26969 bytes) Cert.of.Service.3.29.12.pdf (1 page)(30509 bytes)

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

-----X
DORFMAN-PACIFIC CO.,

Opposer,
v. —
GMA ACCESSORIES, INC.,

Opposition No.: 91203351
Application No.: 85/341679
Mark: CAPELLI
Class: 18

Applicant.
-----X

**APPLICANT’S REPLY TO OPPOSER’S MOTIONS TO STAY THE
PROCEEDINGS OR IN THE ALTERNATIVE TO EXTEND TIME TO OPPOSE
MOTION TO DISMISS OR TO DENY APPLICANT’S MOTION FOR FAILURE
OF SERVICE**

BACKGROUND

On February 7, 2012, Applicant GMA Accessories, Inc. (hereinafter “GMA”) filed a Motion to Dismiss the Opposition with the Trademark Trial and Appeal Board. Due to an unintentional oversight when filing, GMA concedes that a Certificate of Service was not attached to its Motion to Dismiss. However, on February 7, GMA served its Motion on Opposer Dorfman-Pacific Co. (hereinafter “Dorfman”) via the U.S. Postal Service.

There is no dispute that Opposer received the Motion. On March 6, 2012, Dorfman filed a Motion to Stay. On March 8, 2012, Dorfman filed a Motion to Extend Time to Oppose Applicant’s Motion to Dismiss or, in the Alternative, to Deny Applicant’s Motion for Applicant’s Failure to Serve its Moving Papers in Accordance with Board Rule 110.09(d).

ARGUMENT

I. Pursuant to Board Rule 110.09 and 37 CFR 2.119, GMA has attached the Certificate of Service to its Motion to Dismiss filed and served on February 7, 2012

Realizing its oversight, the Certificate of Service of GMA's Motion to Dismiss dated February 7 is attached. Therefore GMA requests the Board to consider its Motion in its entirety as filed and served on February 7. *See* 37 CF § 2.119 (a) (A statement signed by the attorney or other authorized representative, attached to or appearing on the original paper when filed, clearly stating the date and manner in which service was made will be accepted as prima facie proof of service).

II. Dorfman's March 6 Motion to Stay is deemed its response to GMA's Motion to Dismiss and therefore no prejudice has occurred

GMA filed its Motion to Dismiss on February 7, 2012. That same day, GMA served Dorfman with the Motion via the U.S. Postal Service. On March 8, 2012, Dorfman filed a Motion for the extension of time to oppose GMA's Motion, claiming it needed more time to respond due to GMA's failure to file a Certificate of Service with the TTAB on February 7. However, on March 6, 2012, Dorfman had filed a Motion to Stay the present opposition proceeding.

Although it is true that a Certificate of Service was not filed on March 7, it was in fact mailed that same day and as such, Dorfman has suffered no prejudice as evidenced by its timely filed response to GMA's Motion to Dismiss, which took the form of Dorfman's Motion to Stay dated March 6 and not its Motion to Extend Time or in the alternative, deny GMA's Motion to Dismiss, which was not filed until March 8.

To note, this is also not the first time that Dorfman's attorney, Mr. Cronen, has alleged that he did not have notice of a particular court filing. See Exhibit A annexed hereto. On December 19, 2011, GMA and Dorfman had a conference with United States Magistrate Judge Theodore H. Katz, the former Judge presiding over the pending federal case between the parties. During that conference, one of the topics addressed was a particular Subpoena dated December 9, 2011 that GMA had served on Dorfman on December 9. The Affidavit of Service was attached as a docket entry. On December 29, weeks after the conference and the eve of the close of discovery, Mr. Cronen was still claiming that he did not receive notice of the Subpoena in order to support his unwillingness to produce a witness, when it was clear notice was given on multiple prior occasions.

Therefore, GMA respectfully requests the Board not deny its Motion to Dismiss based on the failure to file a Certificate of Service alone, but instead consider and grant its Motion in its entirety.

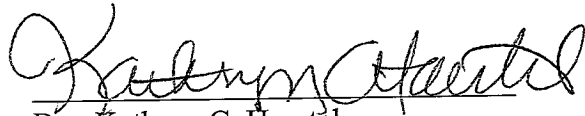
CONCLUSION

I respectfully ask for permission for this filing to be accepted late. We do not oppose Defendant's Motion for a Stay and did not realize he had filed a second Motion to Dismiss until this week. For the foregoing reasons, Dorfman's Motion to Dismiss should be denied and GMA's Motion to Dismiss should be considered by the Board and granted.

Dated: New York, New York
March 27, 2012

Respectfully submitted,

THE BOSTANY LAW FIRM, PLLC



By: Kathryn C. Haertel
Attorneys for Applicant
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RECEIVED
 JAN - 3 2011
 THEODORE H. KATZ
 US MAGISTRATE JUDGE

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 FILED
 DATE FILED 1/3/12

December 29, 2011

Hon. Theodore H. Katz
 United States Magistrate Judge
 Southern District of New York
 Daniel Patrick Moynihan United States Courthouse
 500 Pearl Street
 New York, New York 10007

Re: GMA Accessories, Inc. v. Dorfman-Pacific Co., Inc.
 Case No. 11-CIV-3731 (RJH)(THK)

Your Honor:

In response to defense counsel's flurry of letters today, Mr. Cronen apparently forgot that the Wadler subpoena was specifically addressed in an on the record call with the Court on December 19. So even if Mr. Cronen somehow failed to receive the notice that we mailed to him on December 9 (affidavit of service attached to docket entry 85.2), he is still misrepresenting that he first received Notice on December 27.

Also, Mr. Cronen's other technical arguments are academic because he never voiced them prior to the time Mr. Wadler was to appear and never filed a motion to quash.

We will abide by whatever date the Court sets for the Wadler deposition. One alternative to the 6 week adjournment that Mr. Cronen is seeking is to set a date that can be adjourned upon a showing of good cause by the witness. However, we will cooperate with whatever date the Court sets. We are available January 13, 18, 23, 27, 30, 31. If the Court sees fit to adjourn to February 16, as Mr. Cronen has requested, we will proceed on that date.

*The Wadler deposition
 still proceed on
 February 16, 2012.*

Respectfully,

Kathryn C. Haertel
 Kathryn C. Haertel

SO ORDERED

cc: Michael J. Cronen, Esq.

Theodore H. Katz
 THEODORE H. KATZ
 UNITED STATES MAGISTRATE JUDGE
 1/3/12

Kathryn C. Haertel, an attorney duly licensed to practice in the state of New York, hereby affirms under penalty of perjury: deponent is not a party to the action, is over 18 years of age and works at 75 Wall Street, New York, New York 10005. On February 7, 2012, deponent served the Applicant's Motion to Dismiss the Opposition dated February 7, 2012, with Exhibits attached thereto on:

<u>Attorney</u>	<u>Address</u>	<u>Party</u>
Michael James Cronen, Esq.	Zimmerman & Cronen, LLP 1330 Broadway, Ste. 710 Oakland, California 94612	Dorfman-Pacific

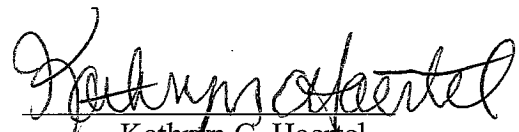
the said address(es) for that purpose by depositing the same enclosed in a post-paid, properly addressed wrapper, in an official depository under the exclusive care and custody of the United States Postal Service within the State of New York.


Kathryn C. Haertel

Kathryn C. Haertel, an attorney duly licensed to practice in the state of New York, hereby affirms under penalty of perjury: deponent is not a party to the action, is over 18 years of age and works at 75 Wall Street, New York, New York 10005. On March 29, 2012, deponent served Applicant's Reply to Opposer's Motions to Stay the Proceedings or in the Alternative, to Extend Time to Oppose Motion to Dismiss or to Deny Applicant's Motion for Failure of Service dated March 27, 2012, with Exhibits attached thereto on:

<u>Attorney</u>	<u>Address</u>	<u>Party</u>
Michael James Cronen, Esq.	Zimmerman & Cronen, LLP 1330 Broadway, Ste. 710 Oakland, California 94612	Dorfman-Pacific

the said address(es) for that purpose by depositing the same enclosed in a post-paid, properly addressed wrapper, in an official depository under the exclusive care and custody of the United States Postal Service within the State of New York.


Kathryn C. Haertel