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

Proceeding	91162370
Party	Plaintiff De Boulle Diamond & Jewelry, Inc.
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Submission	Motion to Suspend for Civil Action
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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De Boulle Diamond & Jewelry, Inc.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition Nos. 91162370
	§	91164615
De Beers LV Ltd.	§	
	§	
Applicant.	§	

OPPOSER’S MOTION TO SUSPEND

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510, Opposer moves to suspend this opposition proceeding. Opposer has filed a complaint against Applicant, in the United States District Court for the Northern District of Texas (the “Court”) in the civil action styled *De Boulle Diamond Jewelry, Inc. v. De Beers LV Ltd.*, Civil Action No. 3:10-cv-00212-M (the “Civil Action”), which may be dispositive of this case. A copy of Opposer’s Complaint (the “Complaint”) is attached as Exhibit A.

As can be seen from the Complaint, the parties in this opposition proceeding also are also parties in the Civil Action, and an issue in dispute in both cases is Applicant’s right to register the DB SIGNATURE mark. Suspension of this opposition proceeding is clearly appropriate under these circumstances. As stated in TBMP § 510.02(a), “Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board.” This is because, “To the extent that a civil action in a Federal district court involves issues in common with those in a proceeding before the Board, the decision of the Federal district court is binding upon the Board, while the decision of the Board is not binding upon the court.” *Id.*

Here, there is no question that the Civil Action will have a bearing on the issues in this opposition proceeding. Indeed, a determination by the Court that Applicant has no right to register the DB SIGNATURE mark would be dispositive of this opposition proceeding.

Finally, suspension of this proceeding will not prejudice Applicant in any way. Applicant will have a full and fair opportunity to pursue its position on any disputed issues between the parties in the Civil Action, which proceeding should allow for final resolution of all disputes between the parties.

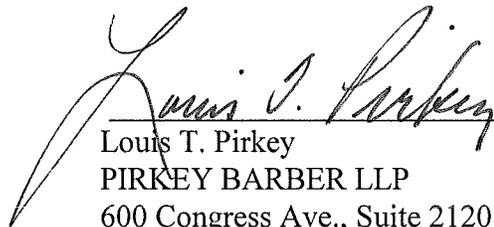
For these reasons, this proceeding should be suspended pending termination of the Civil Action.

CONCLUSION

Because there is a civil action pending between these parties that is potentially dispositive of (or at the very least will have a bearing on) this opposition proceeding, the opposition should be suspended until termination of that action.

Respectfully Submitted,

Date: February 3, 2010



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CERTIFICATE OF SERVICE

I hereby certify that the foregoing MOTION TO SUSPEND was served by first class mail, postage prepaid, upon the following on February 3, 2010:

Darren W. Saunders
Hiscock & Barclay, LLP
Seven Times Square
New York, NY 10036

A handwritten signature in black ink, appearing to read "E R Olson", written over a horizontal line.

Eric R. Olson

EXHIBIT A

2. Plaintiff seeks a judgment that the use of the mark “DB” or any form thereof by Defendants, infringes on, dilutes, and constitutes unfair competition with, Plaintiff’s rights in its “dB” and “deB” marks used in commerce in connection with the sale of diamonds, timepieces, and jewelry.

3. Plaintiff further seeks the cancellation, in its entirety, of Defendant De Beers’ Federal Trademark Registration No. 3132505 (Application Serial No. 78/683644), registered on August 22, 2006, and an Order directing the Patent and Trademark Office to deny registration of the mark in De Beers’ pending application no. 78/245,210, in that Plaintiff believes that it is or will be damaged by the registration of these marks on the principal register in connection with the sale of diamonds, timepieces, and jewelry being likely to cause confusion, or to cause mistake, or to deceive as to the source or origin of Plaintiff’s and Defendants’ goods and services.

II.

Jurisdiction and Venue

4. This Court has jurisdiction over all aspects of this action pursuant to: (a) 15 U.S.C. Section 1121 and 28 U.S.C. Section 1331, in that this action arises under the Constitution, laws, or treaties of the United States, more specifically, the Lanham Act, Title 15 of the United States Code (the “Lanham Act”); (b) 28 U.S.C. Section 1338, in that this is a civil action arising under an Act of Congress relating to trademarks, more specifically the Lanham Act; and (c) 28 U.S.C. Section 1332, in that the matter in controversy exceeds the sum or value of \$75,000, exclusive of interest and costs, and is between citizens of different states. Jurisdiction is further specifically conferred upon this

Court by Section 39 of the Lanham Act, 15 U.S.C. Section 1121. Plaintiff's Petition for Cancellation of a Trademark and Order denying registration are authorized by Sections 14 and 37 of the Lanham Act, 15 U.S.C. Sections 1063, 1064 and 1119.

5. This Court has personal jurisdiction over the Defendants in that:

(a) Such jurisdiction is authorized by Tex. Civ. Prac. & Rem. Code Ann. §17.041 et seq. (the "Long-Arm Statute");

(b) Defendants market and sell their goods in association with the marks in issue in this lawsuit *inter alia* through their store at North Park Center, 8687 North Central Expressway, Suite 1320, Dallas, Texas 75225. In addition, Defendants market and sell their goods in association with the marks through an electronic catalog on the Web site <www.debeers.com> owned and operated by De Beers, targeting consumers in the State of Texas, including in this District. Defendants further market and sell their goods in association with the marks through advertising targeted at consumers in the State of Texas, including in this District;

(c) In the ordinary course of business and specifically with regard to the transactions herein complained of, Defendants have conducted business within the State of Texas sufficient to satisfy the jurisdictional requirements of §17.042 of the Long-Arm Statute;

(d) The causes of action asserted herein are connected with such acts or transaction business; and

(e) The assumption of jurisdiction will not offend traditional notions of fair play and substantial justice, and equity demands that this Court assumes jurisdiction over the person of the Defendants.

6. Venue is proper in this district pursuant to 28 U.S.C. Section 1391(b) and (c), in that a substantial part of the events or omissions giving rise to the claims occurred in the District, Defendants are subject to personal jurisdiction in the District at the time this action is brought, and Defendants are deemed to reside in the District.

III.

The Parties

7. Plaintiff, deBoule Diamond & Jewelry, Inc. (“Plaintiff” and/or “deBoule”) is a corporation duly organized and existing under the laws of the State of Texas, with its principal place of business in Dallas County, Texas.

8. Defendant De Beers Diamond Jewellers Limited f/k/a De Beers LV Limited, (“Defendant” and/or “De Beers”), is a company organized and existing under the laws of United Kingdom (Company No. 04117269). Said Defendant is a “Nonresident” as that term is defined in Tex. Civ. Prac. & Rem. Code Ann. §17.041 *et seq.* (the “Long-Arm Statute”), and is not, according to the Texas Secretary of State, currently registered to do business in the State of Texas. Said Defendant has done business in the State of Texas, as that term is defined in §17.042 of the Long-Arm Statute, and may be served with process herein by forwarding a copy of this pleading and Citation to the Texas Secretary of State, as its agent for service of process pursuant to §17.044(b) of the Long-Arm Statute, who is requested to serve said Defendant De Beers Diamond Jewellers Limited f/k/a De Beers LV

Limited at its home office at 45 Old Bond Street, London, W1S 4QT, United Kingdom, pursuant to §17.045(a) of the Long-Arm Statute. Such service is additionally authorized by Article 10(a) of the Convention of 15 November 1965 on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters (the “Hague Convention”). The United Kingdom has ratified the terms of the Hague Convention and did not object to the provisions of Article 10(a) thereof.

9. Defendant De Beers Diamond Jewellers US Inc. (“Defendant” and/or “De Beers USA”), is a Delaware corporation, company organized and existing under the laws of United Kingdom (Company No. 04117269). Said Defendant is a “Nonresident” as that term is defined in Tex. Civ. Prac. & Rem. Code Ann. §17.041 et seq. (the “Long-Arm Statute”), and is not, according to the Texas Secretary of State, currently registered to do business in the State of Texas. Said Defendant has done business in the State of Texas, as that term is defined in §17.042 of the Long-Arm Statute, and may be served with process herein by forwarding a copy of this pleading and Citation to the Texas Secretary of State, as its agent for service of process pursuant to §17.044(b) of the Long-Arm Statute, who is requested to serve Defendant De Beers Diamond Jewellers US Inc., at its home office at 540 Madison Avenue, New York, New York, 10022, pursuant to §17.045(a) of the Long-Arm Statute.

IV.

**Allegations Common
to all Causes of Action**

10. Well-known to consumers of luxury goods and services for more than 25 years, Plaintiff owns and operates a prominent jewelry store in Dallas, Texas under the trade name and mark “De Boule”. Plaintiff has also marketed and sold diamonds, timepieces, and jewelry to the general public in Texas and elsewhere in the United States in association with the marks “deBoule”, “DeB”, and “dB” (collectively the “deBoule Marks”), used in the advertisement, rendition, and sale of its diamonds, timepieces, and jewelry, and has done so continuously, from at least as early as June, 2001. deBoule’s marketing activities include advertising and promoting its brand and products in local and national media. deBoule further promotes its brand and offers its “deBoule Collection” and other products for sale to general public throughout the United States on its Web site <www.deboule.com>. Through the years, the deBoule Marks and brand have developed a reputation in Texas, and elsewhere in the United States for, and consumers have come to identify the deBoule Marks with, the fine quality of the exclusive jewelry that the deBoule craftsmen custom design and manufacture, as well as the fine quality of its diamonds and other gems.

11. In addition to its substantial common law rights, deBoule is the owner of the following federal trademark registrations in International Class 14 (jewelry, diamonds, watches) and 35 (retail jewelry stores, catalogue sales, and web based sales): (a) Federal Trademark Registration No. 3078625 (Application Serial No. 78/444,880), for the Mark

“DE BOULLE” registered on April 11, 2006 (the “DE BOULLE Mark”); and (ii) Federal Trademark Registration No. 3078627 (Application Serial No. 78/440,907), for the Mark “DE B” and Design, registered on April 11, 2006:



(the “DE B Mark”). In addition, deBoulle filed an application for federal registration of the Mark “DB”, in International Class 14 (jewelry, diamonds, watches) and 35 (retail jewelry stores, catalogue sales, and web based sales), U.S. Trademark Application Serial No. 78/604,056, applied for on April 7, 2005 (the “DB Mark”).

12. Defendant De Beers is the owner of Federal Trademark Registration No. 3132505 (Application Serial No. 78/683644), in International Class 35 (retail store services featuring luxury goods) for the Mark “DB” and design, registered on August 22, 2006:



(the “DB Mark”). In addition, Defendant De Beers filed an application for federal registration of the Mark “DB SIGNATURE”, in International Class 14 (precious metals and their alloys, namely, jewelry, imitation jewelry, gemstones; precious stones; semi-precious stones, diamonds, horological and chronometric instruments, namely, watches and clocks and parts thereof for all the aforementioned goods) U.S. Trademark Application Serial No. 78/245210, applied for on May 2, 2003 (the “DB SIGNATURE Mark”).

13. Defendants sell and market their goods and services, including, diamonds, timepieces, jewelry, and store services in interstate commerce in the United States and elsewhere, in association with the DB Mark, the DB SIGNATURE Mark, and other “DB” marks, through a network of retail stores, including their store at North Park Center, 8687 North Central Expressway, Suite 1320, Dallas, Texas 75225. In addition, Defendants market and sell their goods in association with the marks through an electronic catalog on the Web site <www.debeers.com> owned and operated by De Beers and national advertising.

14. Defendants’ use of the DB Mark, the DB SIGNATURE Mark, and other “DB” marks to sell and market diamonds, timepieces, jewelry, and store services, are likely to deceive and confuse the public into mistakenly believing that the goods and services offered and sold by Defendants under the name and mark “DB” (and DB combinations, including DB SIGNATURE) originate with or are those of Plaintiff or are sponsored by, licensed by, endorsed by or are otherwise associated with Plaintiff. Defendants’ use of the “DB” Marks have occurred without authorization or approval by Plaintiff.

15. Defendants’ unauthorized use of the DB and DB combination marks are likely to dilute the distinctive value of Plaintiff’s marks and constitute unfair competition with Plaintiff in violation of 15 U.S.C. Section 1125(a) and Texas common law.

16. Defendants have been and continue to be unjustly enriched at Plaintiff’s expense by their unauthorized use of the DB and DB combination marks.

17. Defendants' unauthorized use of the DB and DB combination marks remove from Plaintiff the ability to control the nature and quality of the products and services provided by Plaintiff, and place the reputation and goodwill of Plaintiff in the hands of Defendants, over whom Plaintiff has absolutely no control.

18. Unless restrained by this Court, these acts of Defendants will continue, and they will continue to cause irreparable injury to Plaintiff and to the consuming public, for which there is no adequate remedy at law.

V.

COUNT ONE

Federal Trademark Infringement

19. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 18 hereof as part of this claim for relief.

20. The acts of Defendants complained of herein constitute infringement of Plaintiff's federally registered marks in violation of 15 U.S.C. Section 1114(a).

VI.

COUNT TWO

Federal Unfair Competition

21. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 20 hereof as part of this claim for relief.

22. The acts of Defendants complained of herein constitute unfair competition, including false designation of origin, in violation of Section 43(a) of the Lanham Act, 15 U.S.C. Section 1125(a).

VII.

COUNT THREE

Dilution Under Texas Law

23. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 22 hereof as part of this claim for relief.

24. The acts of Defendants complained of herein constitute dilution of Plaintiff's marks in violation of the Texas Anti-Dilution Statute, Tex. Bus. & Comm. Code Section 16.29.

VIII.

COUNT FOUR

Common Law Trademark Infringement

25. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 24 hereof as part of this claim for relief.

26. The acts of Defendants complained of herein constitute common law trademark infringement under Texas law.

IX.

COUNT FIVE

Common Law Unfair Competition

27. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 26 hereof as part of this claim for relief.

28. The acts of Defendants complained of herein constitute unfair competition in violation of the common law of Texas.

X.

COUNT SIX

Petition for Cancellation of Trademark

29. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 28 hereof as part of this claim for relief.

30. Plaintiff further believes and hereby alleges that it is or will be damaged if the Defendant De Beers is permitted to continue to maintain its Reg. No. 3,132,505 for the DB Mark on the principal register, and use such mark in commerce in connection with the sale of diamonds, timepieces, jewelry, and store services. Defendants' use of the DB Mark, to sell and market diamonds, timepieces, jewelry, and store services, is likely to deceive and confuse the public into mistakenly believing that the goods and services offered and sold by Defendants under the name and mark "DB" originate with or are those of Plaintiff or are sponsored by, licensed by, endorsed by or are otherwise associated with Plaintiff.

31. By virtue of such damage and harm, Plaintiff petitions the Court, pursuant to Sections 14 and 37 of the Lanham Act, 15 U.S.C. Sections 1064 and 1119, that Defendant De Beers' Federal Trademark Registration No. 3132505, as registered, be cancelled in its entirety.

XII.

COUNT SEVEN

Order Directing the Patent and Trademark Office to Refuse Registration

32. Plaintiff repeats, realleges and incorporates by reference herein the allegations contained in Paragraphs 1 through 31 hereof as part of this claim for relief.

33. Plaintiff further believes and hereby alleges that it is or will be damaged if the Defendant De Beers is permitted to register the DB SIGNATURE mark on the principal register, and use such mark in commerce in connection with the sale of diamonds, timepieces, jewelry and store services. Such use is likely to deceive and confuse the public into mistakenly believing that the goods and services offered and sold by Defendants under the mark DB SIGNATURE originate with or are those of Plaintiff or are sponsored by, licensed by, endorsed by or are otherwise associated with Plaintiff.

34. By virtue of such damage and harm, Plaintiff petitions the Court, pursuant to Sections 12 and 37 of the Lanham Act, 15 U.S.C. Sections 1063 and 1119, and 28 U.S.C. Section 2201, to issue an Order directing the United States Patent and Trademark Office to refuse registration of De Beers' Application Ser. No.78/245210, which application was timely opposed by Plaintiff.

XIII.

Prayer

WHEREFORE PREMISES CONSIDERED, deBoulle Diamond and Jewelry, Inc., Plaintiff, prays that:

(i) Defendants, their officers, agents, servants, employees, and attorneys, and all other persons in active concert or participation with any of them, be permanently enjoined and restrained from using the DB and DB combination marks.

(ii) Defendants, their officers, agents, servants, employees, and attorneys, and all other persons in active concert or participation with any of them, be ordered to deliver to the Court for destruction, or show proof of destruction of, any and all labels, signs, prints, packages, wrappers, receptacles, advertisements, websites, and any other matter in Defendants' possession or control that bear or depict the DB or DB combination marks.

(iii) Defendants be ordered to file with the Court and serve upon Plaintiff, within thirty days after the entry and service on Defendants of an injunction, a report in writing and under oath setting forth in detail the manner and form in which Defendants have complied with the injunction.

(iv) Plaintiff recover its damages sustained as a result of Defendants' activities complained of herein.

(v) Plaintiff recover judgment of and against Defendant De Beers Diamond Jewellers Limited f/k/a De Beers LV Limited, that its Federal Trademark Registration No. 3132505, as registered, be cancelled in its entirety, and that Application No. 78/245,210 be

denied registration, and that this Court so order the United States Patent and Trademark Office.

(vii) Plaintiff recover the costs of this action, and pre- and post- judgment interest; and,

(viii) Plaintiff have and recover such other and further relief, legal and equitable, general and special, to which Plaintiff may show itself justly entitled.

Respectfully submitted,

/s/ Pieter J. Tredoux

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CO-COUNSEL FOR PLAINTIFF

JURY DEMAND

Plaintiff demands a trial by jury by the maximum number of jurors permitted by law on all issues so triable.

/s/ Pieter J. Tredoux
Pieter J. Tredoux