

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

Mailed: February 5, 2010

Opposition No. 91162370

Opposition No. 91164615

DE BOULLE DIAMOND & JEWELRY, INC.

v.

DE BEERS LV LTD.

**Cheryl Butler, Attorney, Trademark Trial and Appeal Board:**

As discussed in the Board's order of February 24, 2009, only Opposition No. 91164615, concerning application Serial No. 78245210, remains pending. However, because the trial record has been maintained in the consolidated proceeding with Opposition No. 91162370 as the "parent" case, the parties were instructed to continue filing their submissions in Opposition No. 91162370. In accordance with the latest scheduling order, applicant's 30-day testimony period was set to close on February 19, 2010.

On February 4, 2010 at 10 a.m. Eastern Time, the Board held a conference with Pieter Tredoux, representing opposer, and Darren Saunders, representing applicant, concerning opposer's motions, filed February 3, 2010, to suspend proceedings in view of a civil action filed on the same day and for entry of a protective order preventing applicant's testimonial depositions from going forward. The deposition of Hamida Belkadi was

scheduled for February 4, 2010 and the deposition of Denis Boulle was scheduled for February 19, 2010.

It was recognized and acknowledged that applicant was given very little notice of the filing of the civil action and of the filing of the pending motions yesterday and has not had sufficient time to review such filings.<sup>1</sup> Nonetheless, because of the deposition scheduled for today, the Board agreed to hold a phone conference on the pending matters. Both parties presented their respective positions.

The Board informed that parties that because the complaint in the court case sought an order directing the USPTO to refuse registration of applicant's Serial No. 78245210 (Count Seven), the Board was obliged to suspend this opposition proceeding. It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or at least have a bearing on the Board case. See Trademark Rule 2.117(a); and TBMP §510.02(a) (2d ed. rev. 2004).

The Board cancelled the deposition scheduled for February 19, 2010.

The focus of the conference, then, was the deposition scheduled for February 4, 2010. Applicant noted that the court reporter and the witness were ready. Opposer noted that the same witness may be called in the court case, resulting in a second,

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<sup>1</sup> *De Boulle Diamond & Jewelry, Inc. v. De Beers Diamond Jewelers Limited f/k/a/ De Beers LV Limited and De Beers Diamond Jewelers US, Inc.*, Case No.

potentially duplicative deposition. Applicant, noting that it had not had time to review the complaint in the court case, surmised the court case may be dismissed upon a motion. As a consequence, applicant wished to go forward with the deposition so that it would be available when the Board proceeding resumed. The parties presented additional facts for consideration. Opposer offered to reimburse applicant the fee for cancellation of the court reporter. Applicant accepted the offer. The Board then cancelled the deposition scheduled for February 4, 2010 and the conference concluded.

As noted earlier, proceedings are suspended pending final disposition of the civil action between the parties.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action. During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

In the event proceedings are resumed, applicant's testimony period will be reset.

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