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

Proceeding	91197824
Party	Plaintiff Perfect Pearl Co., Inc. d/b/a Majestic Pearl Co.
Correspondence Address	HOLLY PEKOWSKY AMSTER ROTHSTEIN & EBENSTEIN LLP 90 PARK AVENUE NEW YORK, NY 10016 UNITED STATES ptodocket@arelaw.com
Submission	Response to Board Order/Inquiry
Filer's Name	Anthony F. LoCicero
Filer's e-mail	ptodocket@arelaw.com
Signature	/Anthony F. LoCicero/
Date	08/29/2013
Attachments	Opps. No. 91197824 & 91198210 -- Notice of Disposition.pdf(276383 bytes)

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

PERFECT PEARL CO., INC. d/b/a/ MAJESTIC PEARL CO., Opposer, v. MAJESTIC PEARL & STONE INC., Applicant.	Oppositions No. 91197824 and 91198210

NOTICE OF DISPOSITION OF
U.S. FEDERAL DISTRICT COURT ACTION

Pursuant to Trademark Rule 2.117(a) and the Orders dated May 3, 2011 and June 5, 2012 in Opposition No. 91197824, and April 13, 2011 and June 15, 2012 in Opposition No. 91198210, Opposer Perfect Pearl Co., Inc. d/b/a Majestic Pearl Co. ("Perfect") hereby notifies the Board that the civil action that occasioned the suspension of these two Board proceedings has reached a final determination.

On November 30, 2012, the U.S. District Court for the Southern District of New York issued an Order in *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, No. 10-cv-3998, determining the Parties' respective rights to the MAJESTIC and MAJESTIC PEARL trademarks (the "11/30/12 Order in the Civil Action"). *See* Ex. A.

In particular, the 11/30/12 Order in the Civil Action permanently enjoins Majestic Pearl & Stone, Inc. ("Pearl & Stone") from using Perfect's marks, MAJESTIC and MAJESTIC PEARL, "on or in connection with the offer for sale or sale of pearl jewelry," and also from "[o]therwise infringing [Perfect's] MAJESTIC or MAJESTIC PEARL trademarks, including, without limitation, using those marks, or any corporate or trade name containing the word

'MAJESTIC' or any derivative of that word, in connection with the offer for sale or sale of pearl jewelry." The Order also specifies that "[Pearl & Stone] shall consent to the registration by [Perfect] of the trademark MAJESTIC and/or MAJESTIC PEARL for jewelry and shall promptly execute any document reasonably required by Plaintiff to evidence such consent."

Although Pearl & Stone timely appealed the 11/30/12 Order in the Civil Action, Pearl & Stone's appeal was dismissed by the U.S. Court of Appeal for the Second Circuit in an Order dated August 13, 2013. *See* Ex. B.

To the extent that a civil action in a U.S. District Court involves issues in common with those in a Board proceeding, as is the case here, the District Court's decision is binding on the Board. *See, e.g., Am. Bakeries Co. v. Pan-O-Gold Baking Co.*, 650 F. Supp. 563, 2 U.S.P.Q.2d 1208 (D.C. Minn. 1986). Accordingly, Perfect respectfully requests the Board to take the following actions pursuant to TBMP § 510.02(b):

Perfect's U.S. Trademark App. Ser. No. 85/762,536 for MAJESTIC for Jewelry

Perfect's U.S. Trademark App. Ser. No. 85/762,536 for MAJESTIC for jewelry in Class 14 ("Perfect's Application") was potentially refused registration based on a likelihood of confusion with Pearl & Stone's U.S. Trademark Apps. Ser. No. 77/776,779 for MAJESTIC for jewelry; pearls in Class 14 and 77/779,710 for MAJESTIC PEARL for pearls in Class 14. Perfect opposed these two Applications (in Oppositions No. 91197824 and 91198210 respectively), and Perfect's Application was suspended pending determination of the two Oppositions.

In light of the 11/20/12 Order in the Civil Action prohibiting Pearl & Stone from using MAJESTIC for jewelry and indicating that Pearl & Stone must consent to Perfect's registration of MAJESTIC for jewelry, Perfect respectfully requests the Board to instruct the Examining

Trademark Attorney assigned to Perfect's Application to lift the suspension and pass Perfect's Application to publication.

Opposition No. 91197824

Opposition No. 91197824 concerns U.S. Trademark App. Ser. No. 77/776,779 for MAJESTIC for jewelry and pearls in Class 14. In light of the 11/30/13 Order in the Civil Action, Perfect respectfully requests the Board to issue an Order rendering judgment in Perfect's favor with respect to jewelry and deleting jewelry from the specification of goods covered by the '779 Application.

Opposition No. 91198210

Opposition No. 91198210 concerns U.S. Trademark App. Ser. No. 77/779,710 for MAJESTIC PEARL for pearls in Class 14. In light of the 11/30/13 Order in the Civil Action, and the subsequent passing of Perfect's Application to publication, Perfect respectfully requests the Board to issue an Order dismissing this Opposition as moot.

Respectfully submitted,

AMSTER, ROTHSTEIN & EBENSTEIN LLP
Attorneys for Opposer
90 Park Avenue
New York, New York 10016
E-mail: ptodocket@arelaw.com

By: _____
Anthony F. LoCicero

Dated: New York, New York
August 29, 2013

Exhibit A

USDC SDNY
DOCUMENT
ELECTRONICALLY FILED
DOC #:
DATE FILED: 11/30/12

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

PERFECT PEARL CO., INC.,

Plaintiff,

-v-

MAJESTIC PEARL & STONE, INC.,

Defendant.

10 Civ. 3998 (PAE)

ORDER

PAUL A. ENGELMAYER, District Judge:

On November 15, 2012, the Court received a motion from the defendant Majestic Pearl & Stone, Inc., asking the Court to amend or alter the judgment and permanent injunction issued on October 18, 2012. On November 16, 2012, the Court issued an order directing defendant to submit a proposed revised judgment and permanent injunction, and directing plaintiff Perfect Pearl Co., Inc. to respond to that submission.

The Court has reviewed the papers submitted by the parties. In the interest of clarity, the Court has modified the wording of its judgment and permanent injunction.

The judgment and permanent injunction now is as follows:

1. Defendant and Defendant's officers, agents, servants, employees, and attorneys and those persons in active concert or participation with them are hereby permanently enjoined from:

    A. Using the trademarks MAJESTIC and MAJESTIC PEARL, or any other trademark likely to cause confusion with those marks, on or in connection with the offer for sale or sale of pearl jewelry; however, this does not prevent defendant from using those trademarks in connection with the sale of items other than pearl jewelry, *e.g.*, loose pearls and beads;

    B. Using any trademark which may be calculated to falsely represent or which has the effect of falsely representing that the products or services of Defendant or third parties are sponsored by, authorized by, or in any way associated with Plaintiff;

    C. Otherwise infringing Plaintiff's MAJESTIC or MAJESTIC PEARL trademarks, including, without limitation, using those marks, or any corporate or trade name containing the word "MAJESTIC" or any derivative of that

word, in connection with the offer for sale or sale of pearl jewelry; however, this does not prohibit Defendant from continuing to use its corporate or trade name for purposes other than in connection with the offer for sale or sale of pearl jewelry;

D. Falsely representing themselves as being connected with Plaintiff, or sponsored by or approved by or associated with Plaintiff or engaging in any act which is likely to falsely cause the trade, retailers, and/or members of the purchasing public to believe that Defendant is, in any way, associated with Plaintiff, and;

E. Misusing the statutory registration symbol, ®, in connection with the sale of any product, or otherwise indicating that Defendant owns a Registration for MAJESTIC or MAJESTIC PEARL that it does not own.

2. Defendant shall consent to the registration by Plaintiff of the trademark MAJESTIC and/or MAJESTIC PEARL for jewelry and shall promptly execute any document reasonably required by Plaintiff to evidence such consent.

3. This judgment shall be entered without the award of damages to either party. Each party shall bear its own costs and attorney's fees.

The Clerk of Court is directed to terminate the motion at docket number 105, and to close this case.

SO ORDERED.

Paul A. Engelmayer

Paul A. Engelmayer
United States District Judge

Dated: November 30, 2012
New York, New York

Exhibit B

UNITED STATES COURT OF APPEALS
FOR THE
SECOND CIRCUIT

At a Stated Term of the United States Court of Appeals for the Second Circuit, held at the Thurgood Marshall United States Courthouse, 40 Foley Square, in the City of New York, on the 13th day of August, two thousand and thirteen.

Before: Ralph K. Winter,
Circuit Judge.

Perfect Pearl Company, Inc., DBA Majestic Pearl Company,

Plaintiff-Counter-Defendant-Appellee,

v.

Majestic Pearl & Stone, Inc.,

Defendant-Counter-Claimant-Appellant.

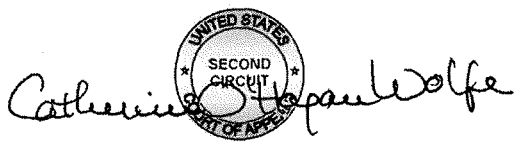
ORDER
Docket No. 13-99

On July 11, 2013, the Court issued an order dismissing the appeal effective July 25, 2013 if the Appellant's brief and the joint appendix are not filed by that date. On July 25, 2013, instead of filing the brief, Appellant's counsel filed a motion to stay this appeal pending the outcome of an action for declaratory judgment filed in the U.S. District Court for the Southern District of New York.

Because no brief was filed by July 25, 2013, the appeal was dismissed effective that date. IT IS HEREBY ORDERED that the motion to stay the appeal is DENIED as moot.

For the Court:

Catherine O'Hagan Wolfe,
Clerk of Court



CERTIFICATE OF SERVICE

The undersigned hereby certifies that he is one of the attorneys for Opposer, Perfect Pearl Co., Inc. d/b/a/ Majestic Pearl Co., in the above-captioned Opposition proceeding and that on the date which appears below, he caused a copy of the foregoing NOTICE OF DISPOSITION OF U.S. FEDERAL DISTRICT COURT ACTION to be served by Federal Express:

(1) to the address of record for Applicant, as follows:

Jason R. Lee, Esq.
Lee Lee and Associates PC
2531 Jackson Road, Suite 234
Ann Arbor, MI 48103

(2) to the attorney representing Applicant in the Action and the Appeal, as follows:

P. Betty Tufariello, Esq.
Intellectulaw™
The Law Offices of P.B. Tufariello, P.C.
25 Little Harbor Road
Mount Sinai, NY 11766

David Goldberg

Dated: New York, New York
August 29, 2013

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