

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

CME/dmd

Mailed: September 30, 2013

Opposition No. 91197824

Opposition No. 91198210

Perfect Pearl Co., Inc. d/b/a
Majestic Pearl Co.

v.

Majestic Pearl & Stone Inc.

Christen M. English, Interlocutory Attorney:

Although not consolidated by way of this order, for administrative convenience, we issue a joint order with respect to these opposition proceedings since the parties involved are the same and the papers filed in both of the opposition proceedings are identical.

These proceedings were suspended pending the disposition of a civil action filed in the United States District Court for the Southern District of New York, *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, No. 10-cv-3998, and an appeal to the United States Court of Appeals for the Second Circuit, *Perfect Pearl Company,*

Inc., DBA Majestic Pearl Company v. Majestic Pearl & Stone, Inc., No. 13-99.

On August 29, 2013, opposer informed the Board that on August 13, 2013, the United States Court of Appeals for the Second Circuit dismissed the appeal filed by applicant. As such, the order issued by the U.S. District Court for the Southern District of New York (the "District Court") on November 30, 2012 stands. The November 30, 2012 order provides as follows:

1. It permanently enjoins applicant and its officers, agents, servants, employees, attorneys and those persons in active concert or participation with them 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 [applicant] or third parties are sponsored by, authorized by, or in any way associated with [opposer];
- C. Otherwise infringing [opposer'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
[applicant] 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 [opposer], or sponsored by or approved or associated with [opposer] or engaging in any act which is likely to falsely cause the trade, retailers, and/or members of the purchasing public to believe that [applicant] is, in any way, associated with [opposer], and;
- E. Misusing the statutory registration symbol, ®, in connection with the sale of any product, or otherwise indicating that [applicant] owns a [r]egistration for MAJESTIC or MAJESTIC PEARL that it does not own; and

2. orders applicant to consent to opposer's registration of the mark MAJESTIC and/or MAJESTIC PEARL for jewelry and promptly execute any documents necessary to evidence such consent.

In view of the District Court's order, applicant is allowed until **THIRTY DAYS** from the mailing date of this order to show cause why the Board should not:

- 1. amend application Serial No. 77776779 involved in Opposition No. 91197824 **from** "jewelry; pearls" **to** "pearls, excluding pearl jewelry";
- 2. enter judgment in favor of opposer in Opposition No. 91197824 with respect to "jewelry";

3. amend application Ser. No. 77779710 involved in Opposition No. 91198210 **from "pearls" to "pearls, excluding pearl jewelry";**¹ and
4. suspend the oppositions to allow the parties time to execute and file with the Trademark Examining Operation an agreement indicating applicant's consent to the registration of opposer's application Serial No. 85762536 and for the Trademark Examining Operation to consider the consent agreement.²

Pending a response to this order from applicant, the oppositions remain suspended.

¹ Contrary to opposer's assertion, Opposition No. 91198210 is not "moot" because the identification of goods covered by involved application Serial No. 7779710 is broad enough to encompass jewelry. However, the amendment proposed in this order would address this issue.

² The parties are advised that the Board does not have jurisdiction over opposer's application Serial No. 85762536, and therefore, has no authority to instruct the Examining Attorney to take any action with respect to application Serial No. 85762536.