

TAB

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

ORO DALL' ITALIA INC.,

Petitioner,

v.

JAANA KOPRA LTD.,

Registrant.

Cancellation No. 30,113

02 OCT 24 PM

TRADEMARK TRIAL AND APPEAL BOARD



10-10-2002

U.S. Patent & TMO/TM Mail Ropt Dt. #76

SETTLEMENT AGREEMENT

Oro Dall' Italia Inc. ("Oro"), having offices at 119 West 40th Street, New York, New York 10018, and Jaana Kopra Ltd., having offices at 1, Convent Road Sivadon Bldg., 10th Floor 10500 Bangkok, Thailand, agree to this Settlement Agreement. The petitioner and registrant together are referred to as the "Parties" to this Settlement Agreement. In exchange of mutual consideration, the Parties give and accept the rights and responsibilities set forth in this Settlement Agreement.

WHEREAS, Jaana Kopra Ltd. is the owner of the U.S. Trademark Registration No. 2,284,005 for the word mark JAANA for jewelry;

WHEREAS, Jaana Kopra Ltd. first used the mark JAANA in February, 1998 and first used the mark JAANA in commerce in the United States on May 17, 1999;

WHEREAS, Jaana Kopra Ltd. has taken steps to protect its JAANA mark and has secured U.S. Trademark Registration No. 2,284,005 as shown in Attachment A hereto.

WHEREAS, Oro on January 19, 1999 filed an application before the United States Trademark Office for registration on the principal register of the trademark JANA DESIGNS for jewelry and said application was assigned Serial No. 75/622,148;

WHEREAS, in response to Oro's January 19, 1999 application, the Trademark Office issued an Office Action, mailing date August 31, 1999, wherein the Trademark Office identified the then pending application of Jaana Kopra Ltd. for the registration of the mark JAANA, as a potentially conflicting pending application, stating that there may be a likelihood of confusion between the marks under Trademark Action Section 2(d), 15 U.S.C. Section 1052(d) and that if the Jaana Kopra Ltd. mark matured into registration that the Trademark Office may refuse registration of Oro's mark under Section 2(d) 37 C.F.R. Section 2.83 and TMEP Section 1208.01;

WHEREAS, Oro claims to have first used its mark JANA DESIGNS through a predecessor-in-interest since at least December 4, 1990 as a mark for jewelry made of gold and containing diamonds, precious and semiprecious stones, such as are shown in Attachment B hereto.

WHEREAS, Oro filed a petition on or about March 3, 2000 to cancel the Registration No. 2,284,005 of Jaana Kopra Ltd. for the mark JAANA, and said proceeding was assigned Cancellation No. 30,113.

WHEREAS, Oro's application Serial No. 75/622,148 has been suspended pending the disposition of Cancellation No. 30,113.

WHEREAS, the Parties have exchanged information and are desirous to amicably resolve their differences;

In consideration of the foregoing, and in consideration of the undertakings set forth hereinafter, and intending to be legally bound, the parties agree as follows:

1. The Cancellation No. 30,113 shall be dismissed. Attached hereto as Exhibit C is a Stipulation of Dismissal of said Cancellation, which shall be signed by counsel for the Parties and filed in the Trademark Office.
2. Based on the information and materials which have been exchanged, and the parties' coexistence without significant instances of actual confusion coming to the attention of either, the parties are of the opinion that confusion as to the source or sponsorship of the goods or as to the affiliation between the parties may be avoided, granted the differences between the parties, traditional trade channels and product lines, based on the representations and undertakings set forth herein.
3. Jaana Kopra Ltd. and its affiliates, parents, subsidiaries, assignees and related entities consent to the registration by Oro of the mark JANA DESIGNS in the United States Trademark Office. Jaana Kopra Ltd. represents and warrants that it will cooperate with Oro and take all reasonable steps to assist Oro in obtaining the registration of the mark JANA DESIGNS in the United States Trademark Office, including but not limited to, signing declarations supporting Oro's application Serial No. 75/622,148. Oro shall be responsible for payment of any and all costs and legal fees incurred by Jaana Kopra Ltd. in connection with cooperating with Oro in obtaining registration of the mark JANA DESIGNS.
4. Jaana Kopra Ltd. represents and warrants that it has used the mark JAANA in the United States on jewelry designs of the style shown in Exhibit D, attached hereto. Said designs consist of jewelry made of silver, beads and semiprecious stones and all of said jewelry is produced by hand. Said jewelry may also include machine made silver or metal tags

which identifies the JAANA mark. No gold jewelry has ever been sold by Jaana Kopra Ltd. under the mark JAANA.

5. Jaana Kopra Ltd. represents and warrants that it will limit and restrict the use of its trademark JAANA to use with jewelry made only of silver, beads and semiprecious stones and all of said jewelry is to be produced by hand. Jaana Kopra Ltd. further specifically represents and warranties that it will not use its mark JAANA with jewelry made of gold.

6. Oro represents and warrants that it will not use its mark JANA on jewelry made exclusively of silver, beads, and semiprecious stones. Oro represents and warrants that it will limit and restrict the use of its trademark JANA DESIGNS to use with jewelry made ~~only~~ of gold, which may include precious and semiprecious stones, which is not produced by hand.

7. Oro agrees never to use "JAANA" as one word or as a mark, notwithstanding Oro's right to use "JANA DESIGNS" as a mark.

8. Jaana Kopra Ltd. agrees never to use "JAANA" with the word "DESIGNS" as a phrase or mark.

9. The Parties acknowledge that Jaana Kopra Ltd. and Oro shall be allowed to co-exist in the market, respectively using their JAANA and JANA DESIGNS trademarks, subject to the foregoing restrictions. Subject to these restrictions, the Parties further acknowledge that there is no likelihood of confusion between the marks JAANA and JANA DESIGNS under the Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), or otherwise, and further represent and acknowledge that the goods for which each aforesaid mark is used are not substantially similar.

10. The parties agree that they will not interfere with the other's business and will use their best efforts to resolve any instances of apparent confusion which may arise.

11. The parties agree that they will not challenge directly or indirectly the other party's right to maintain its U.S. Trademarks or Registrations discussed herein and will not contest, directly or indirectly, the right of the other party to use the marks of its marks or registrations on or in connection with any of the goods identified with the parties' respective goods as set forth herein.

12. Nothing in this Agreement shall limit, restrict or otherwise interfere with each of the Parties' right to convey, transfer, assign, otherwise dispose of or alienate (together, referred to as "Transfer") any rights to the aforesaid marks, provided that such Transfer shall be subject to the terms and conditions of this Settlement Agreement and the entity accepting the Transfer (the "Transferee") shall be bound by this Settlement Agreement.

13. This Agreement is binding on the parties, their successors, assigns and related companies.

14. Each of the parties hereby releases the other from any claims or demands that were or would have been made in the Cancellation Proceeding and from any claims or demands which could have been made by the parties with respect to any commercial activities in the United States prior to the effective date of this Agreement.

15. This Agreement constitutes the entire understanding of the parties with respect to the subject matter, and there are no other commitments or agreements, express or implied.

16. The parties will cause their counsel to file in the United States patent and Trademark Office before the Trademark Trial and Appeal Board a Stipulation of Dismissal of the Cancellation Proceeding in the form of Attachment C within five (5) business days of the complete execution of this Settlement Agreement by the parties.

17. Each party acknowledges that it has consulted respectively with attorneys before entering into this Settlement Agreement. Oro has been represented by, Levisohn, Lerner, Berger & Langsam, 757 Third Avenue, New York, New York 10017, (212) 486-7272 and Fax (212) 486-0323. Jaana Kopra Ltd. has been represented by Akin, Gump, Strauss, Hauer & Feld, L.L.P., Once Commerce Square, 2005 Market Street, 22nd Floor, Philadelphia, Pennsylvania 19103, (215) 965-1200 and Fax (215) 965-1210.

18. Each party represents and warrants that it is fully authorized to enter into this Settlement Agreement.

19. This agreement may be executed in one or more counterparts, each of which shall be deemed an original and together shall constitute one and the same instrument.

IN WITNESS HEREOF, the parties have duly executed this Agreement as of the day and year set forth below.

Dated: 6-9-01

JAANA KOPRA LTD.

By: ~~_____~~
ORF D. MADSEN
(Print Name)

Title: DIRECTOR

Dated: _____

ORO DALL' ITALIA INC.

By: _____
(Print Name)

Title: _____

17. Each party acknowledges that it has consulted respectively with attorneys before entering into this Settlement Agreement. Oro has been represented by, Levisohn, Lerner, Berger & Langsam, 757 Third Avenue, New York, New York 10017, (212) 486-7272 and Fax (212) 486-0323. Jaana Kopra Ltd. has been represented by Akin, Gump, Strauss, Hauer & Feld, L.L.P., Once Commerce Square, 2005 Market Street, 22nd Floor, Philadelphia, Pennsylvania 19103, (215) 965-1200 and Fax (215) 965-1210.

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IN WITNESS HEREOF, the parties have duly executed this Agreement as of the day and year set forth below.

Dated: _____

JAANA KOPRA LTD.

By: _____

(Print Name)

Title: _____

Dated: 8/20/01

ORO DALL' ITALIA INC.

By: *[Signature]*

BARBI OKUN
(Print Name)

Title: CFD

EXHIBIT A

U.S. Trademark Electronic Search System

TESS was last updated on Sat Aug 11 04:24:39 EDT 2001

PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT BOTTOM HELP



Please logout when you are done to release system resources allocated for you.

Record 1 out of 1

Check Status

(TARR contains current status, correspondence address and attorney of record for this mark. Use the "Back" button of the Internet Browser to return to TESS)

Typed Drawing

Word Mark JAANA

Goods and Services IC 014. US 002 027 028 050. G & S: jewelry. FIRST USE: 19980200. FIRST USE IN COMMERCE: 19990517

Mark Drawing Code (1) TYPED DRAWING

Serial Number 75416756

Filing Date January 12, 1998

Filed ITU FILED AS ITU

Published for Opposition December 8, 1998

Registration Number 2284005

Registration Date October 5, 1999

Owner (REGISTRANT) Jaana Kopra Ltd. CORPORATION THAILAND 1, Convent Road Sivadon Bldg., 10th Floor 10500 Bangkok THAILAND

Attorney of Record JAY K MEADWAY

Type of Mark TRADEMARK

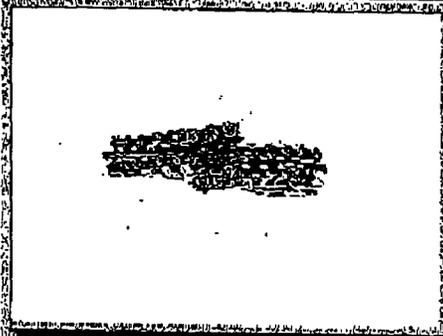
Register PRINCIPAL

Live/Dead Indicator LIVE

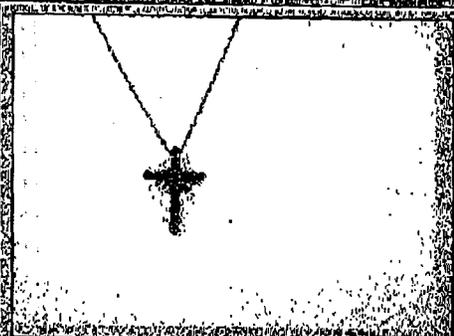
PTO HOME TRADEMARK TESS HOME NEW USER STRUCTURED FREE FORM BROWSE DICT TOP HELP

EXHIBIT B

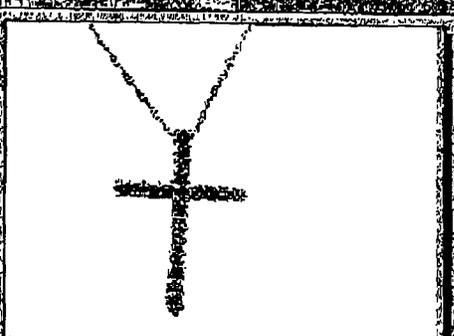
COPYRIGHTS - SUMMER COLL. 2001



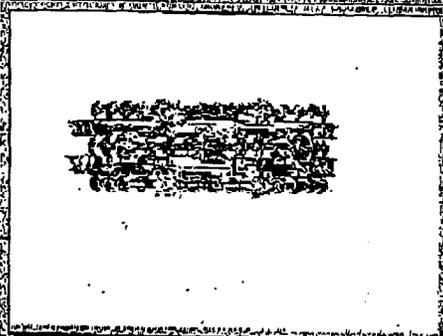
E-18855
DIA Ring



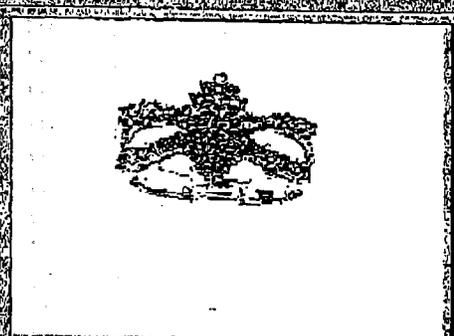
E-18879
10Kt Cross Pendant w/Chain



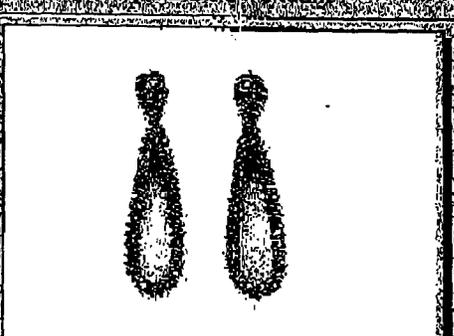
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White Gold Pendant



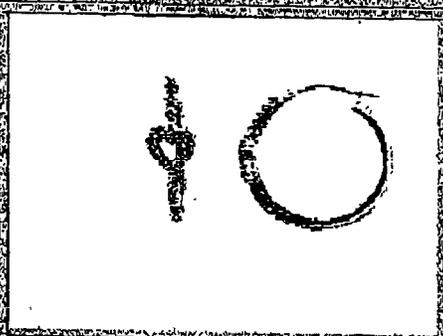
E-18856
DIA Ring



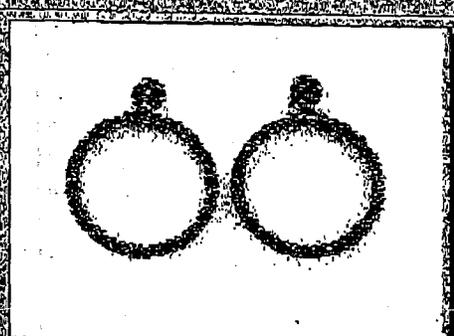
E-18852
DIA Ring



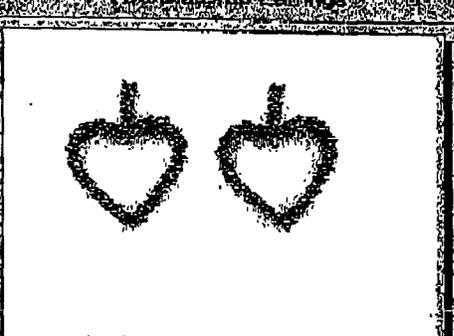
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14K White Gold Earrings



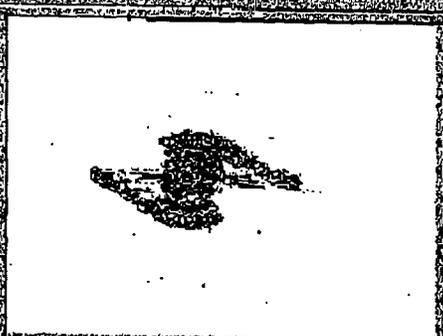
E-18858
DIA Ring



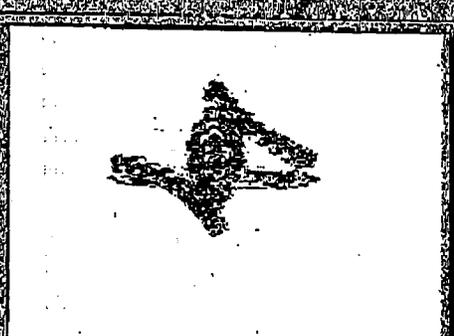
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14K White Gold Earrings



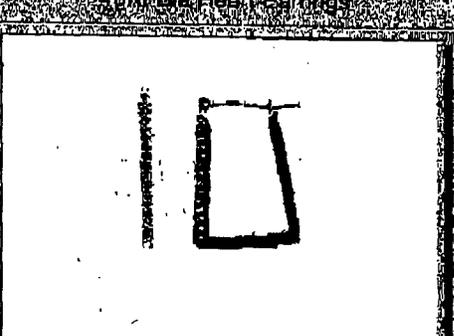
E-18860
14K White Gold Earrings



E-18861
DIA Ring

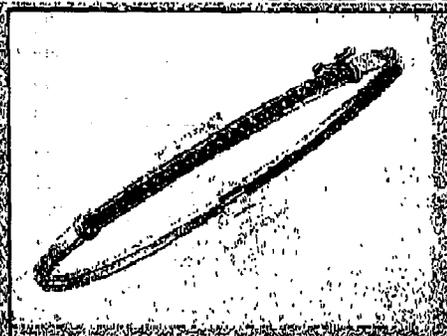
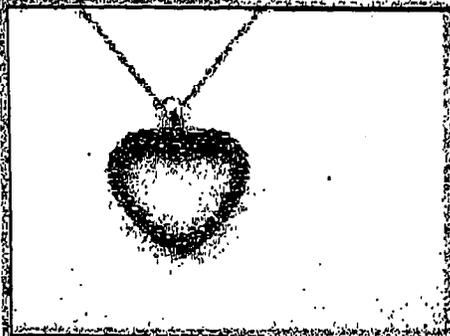


E-18862
DIA Ring



E-18863
14K DIA Square Earrings

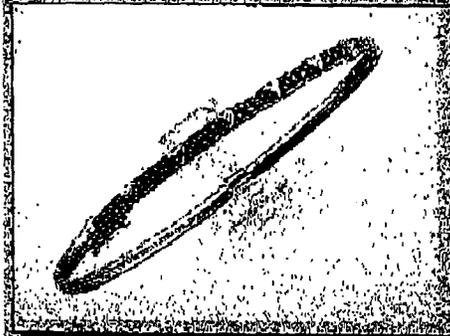
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E-1863
16K Dia Heart

E-18670
16K Dia Bangle

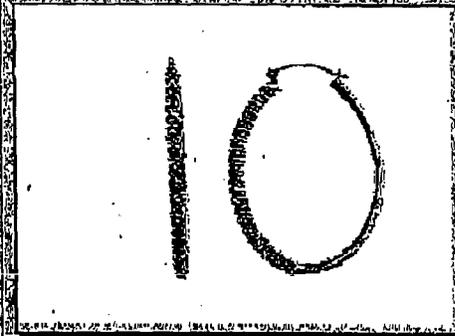
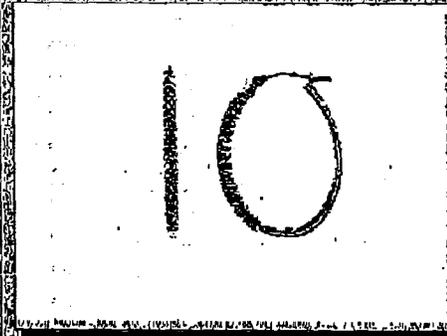
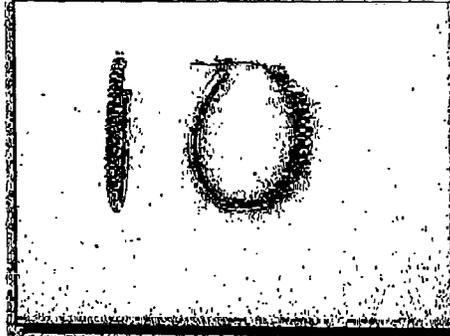
E-18675
Bangles



E-18637
Bangle

E-18677
Bangle

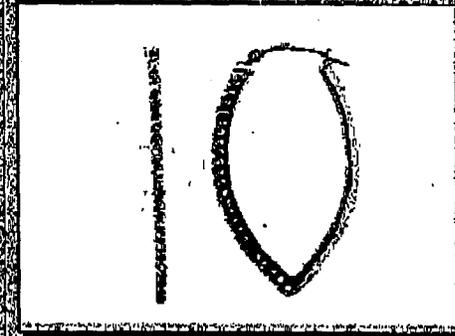
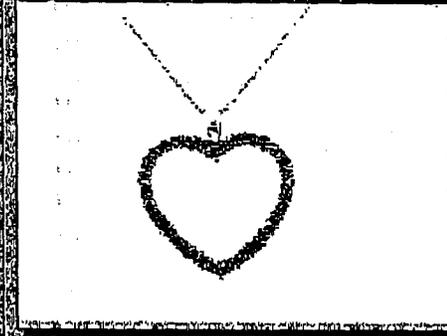
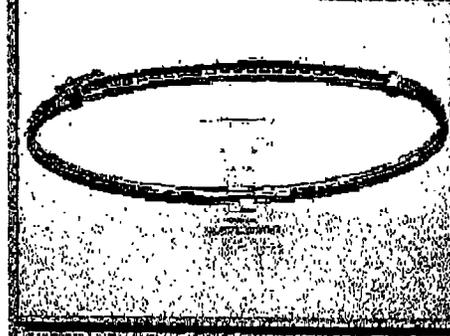
E-18678
16K Dia Ring



E-18639
16K Dia Hoop Earrings (1.21ctw)

E-18679
16K Dia Hoop Earrings

E-18677
16K Dia Hoop Earrings

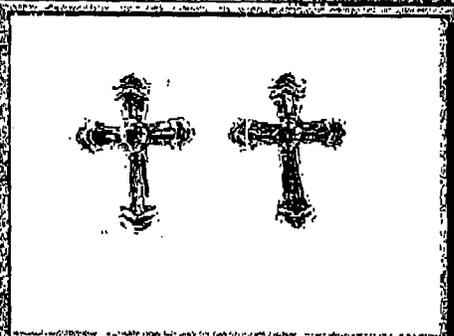
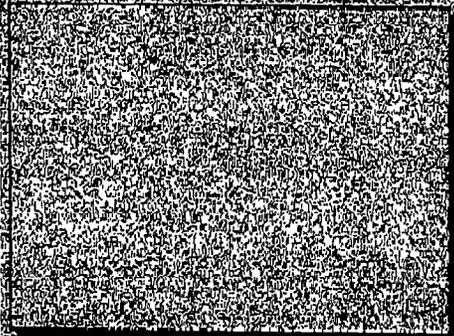


E-18671
Bangle

E-18673
16K Dia Heart

E-18685
16K Dia Hoop Earrings

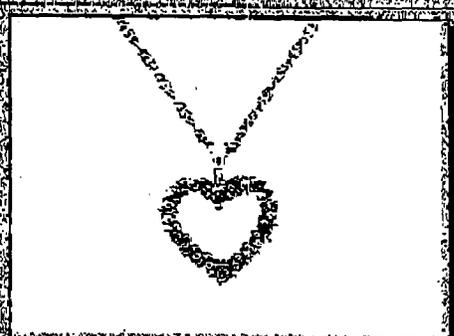
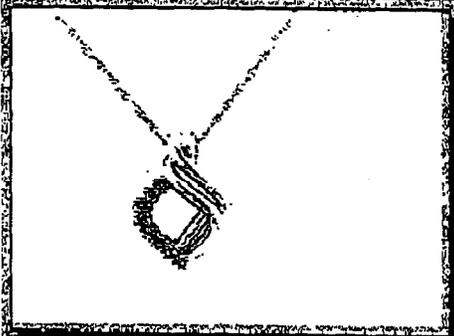
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Gold Pendant

E-1338

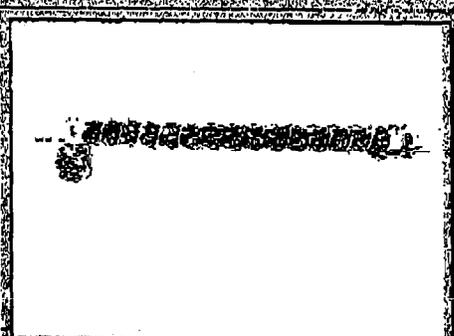
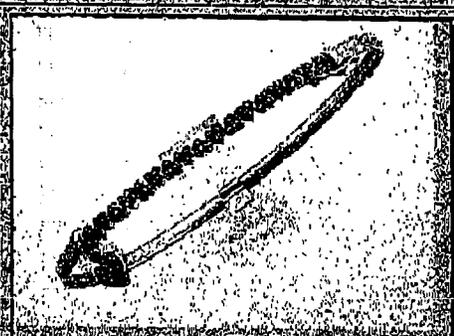
Gold Earrings



Gold Pendant

Gold Earrings

White Gold Pendant



E-1340

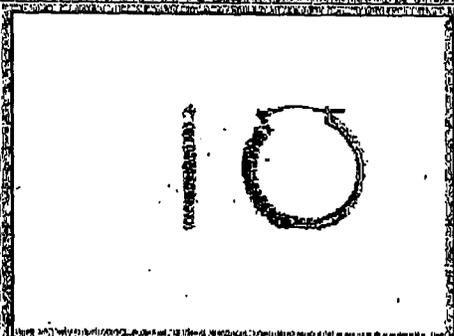
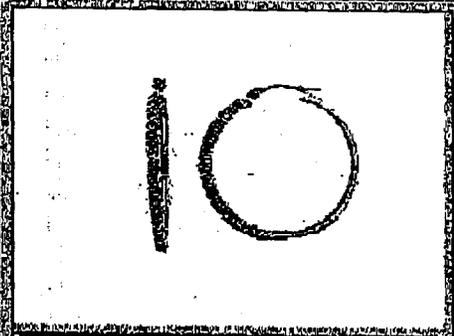
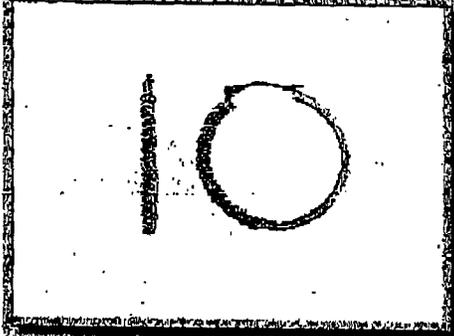
Diamond Family Pendant

E-1370

Diamond Ring

E-1373C

Black Gold Earrings



E-1357

10K Gold Hoop Earrings

E-1357

10K Gold Hoop Earrings

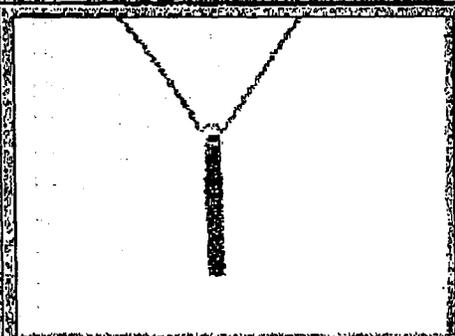
E-1357

10K Gold Hoop Earrings

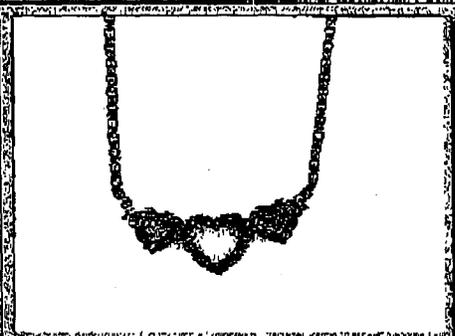
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12346 10K Yellow Pendant



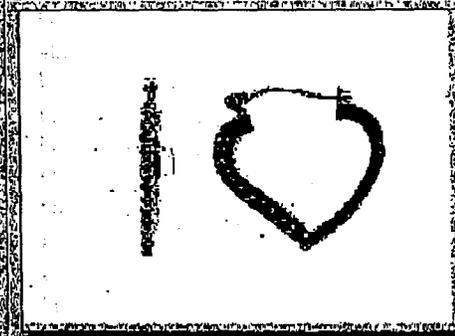
12329 10K Gold Bar Pendant



12530 14K Yellow Diamond Neck



12347 10K Gold Ring



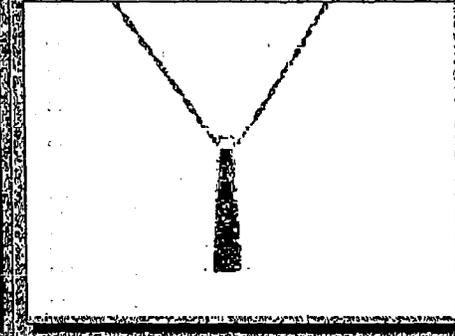
12351 10K Yellow Earrings



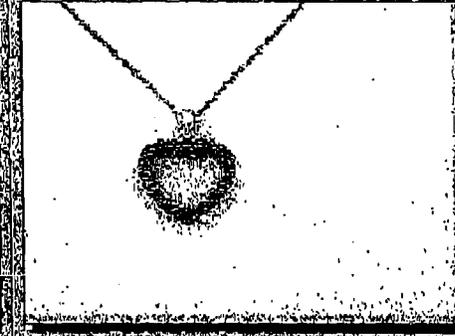
12350 10K Yellow Pendant



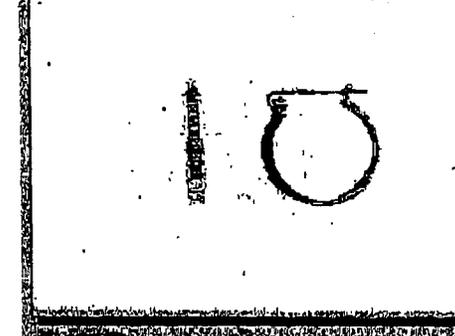
12348 10K Gold Pendant



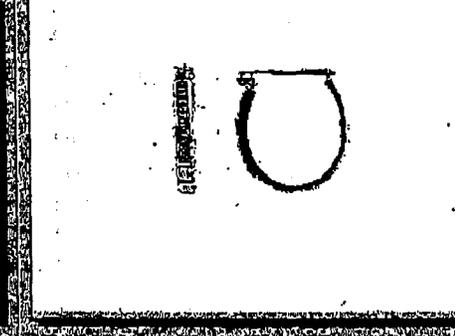
12352 10K Diamond Bar Pendant



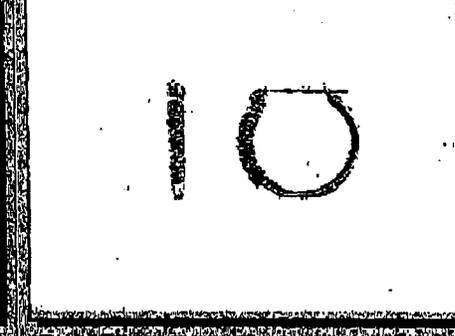
12349 10K Yellow Pendant



12353 10K Yellow Earrings

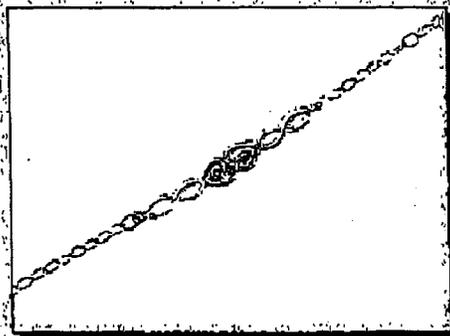


12354 10K Diamond Earrings

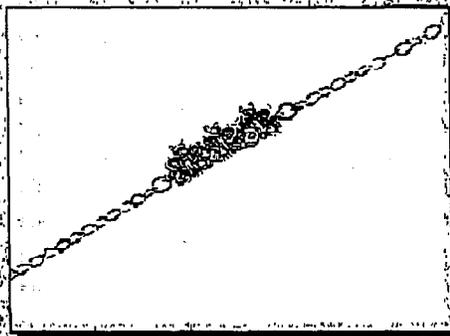


12355 10K Diamond Earrings

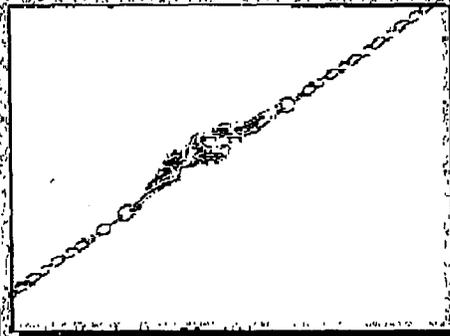
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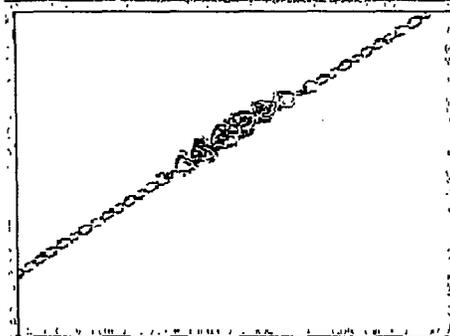
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10Kt Anklet



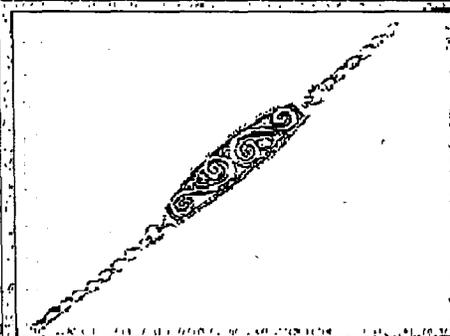
B-13310
Dia Butterfly Anklet-0.12Tw



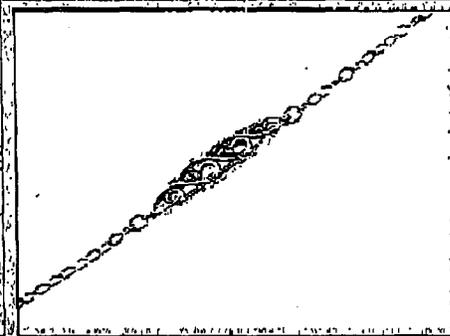
B-13311
10Kt Anklet



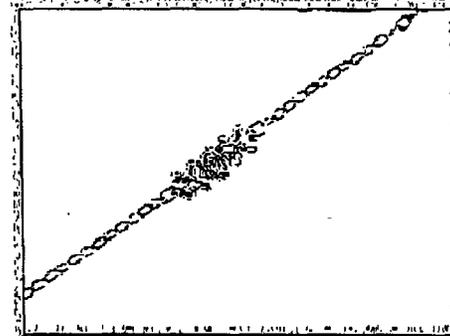
B-13305
Dia Hrt Anklet-0.12Tw



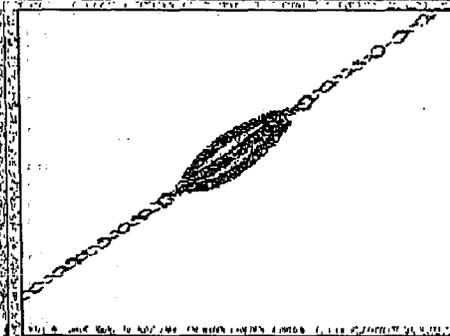
B-13300
Diamond Scroll Anklet-0.12Tw



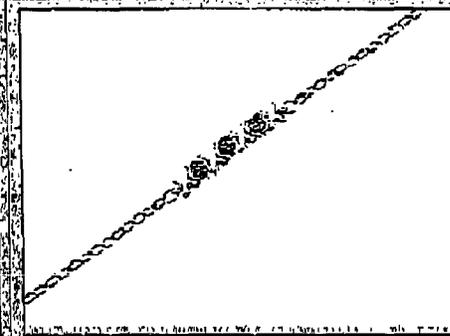
B-13307
10Kt Anklet



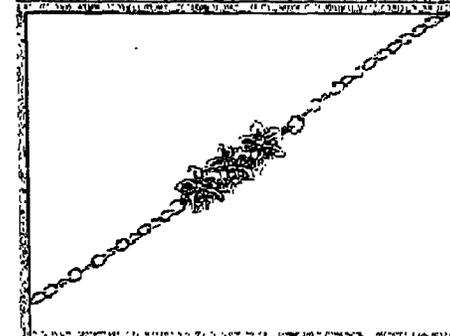
B-13309
10Kt Anklet



B-13301
10Kt Anklet



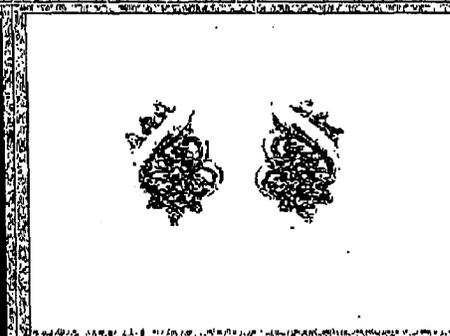
B-13312
10Kt Anklet



B-13303
10Kt Anklet



B-13306
10Kt Fancy Pendant



B-13308
10Kt Fancy Earrings

EXHIBIT C

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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ORO DALL' ITALIA INC.,

Petitioner,

v.

JAANA KOPRA LTD.,

Registrant.

Cancellation No. 30,113

STIPULATION OF DISMISSAL

Oro Dall'Italia Inc., Petitioner, having offices at 119 West 40th Street, New York, New York 10018, and Jaana Kopra Ltd., Registrant, having offices at 1, Convent Road Sivadon Bldg., 10th Floor 10500 Bangkok, Thailand, by their undersigned attorneys stipulate and agree that, pursuant to Rule 41(a)(1) of the Federal Rules of Civil Procedure the above captioned Cancellation No. 30, 113 is dismissed. Each party is to bear its own costs and attorney's fees in this action.

LEVISOHN, LERNER, BERGER, LANGSAM

By: Marilyn Neiman
Marilyn Neiman (MN 6194)
757 Third Avenue
New York, New York 10017
(212) 486-7272

Attorneys for Petitioner
Oro Dall'Italia Inc.

Dated: 10/1/01

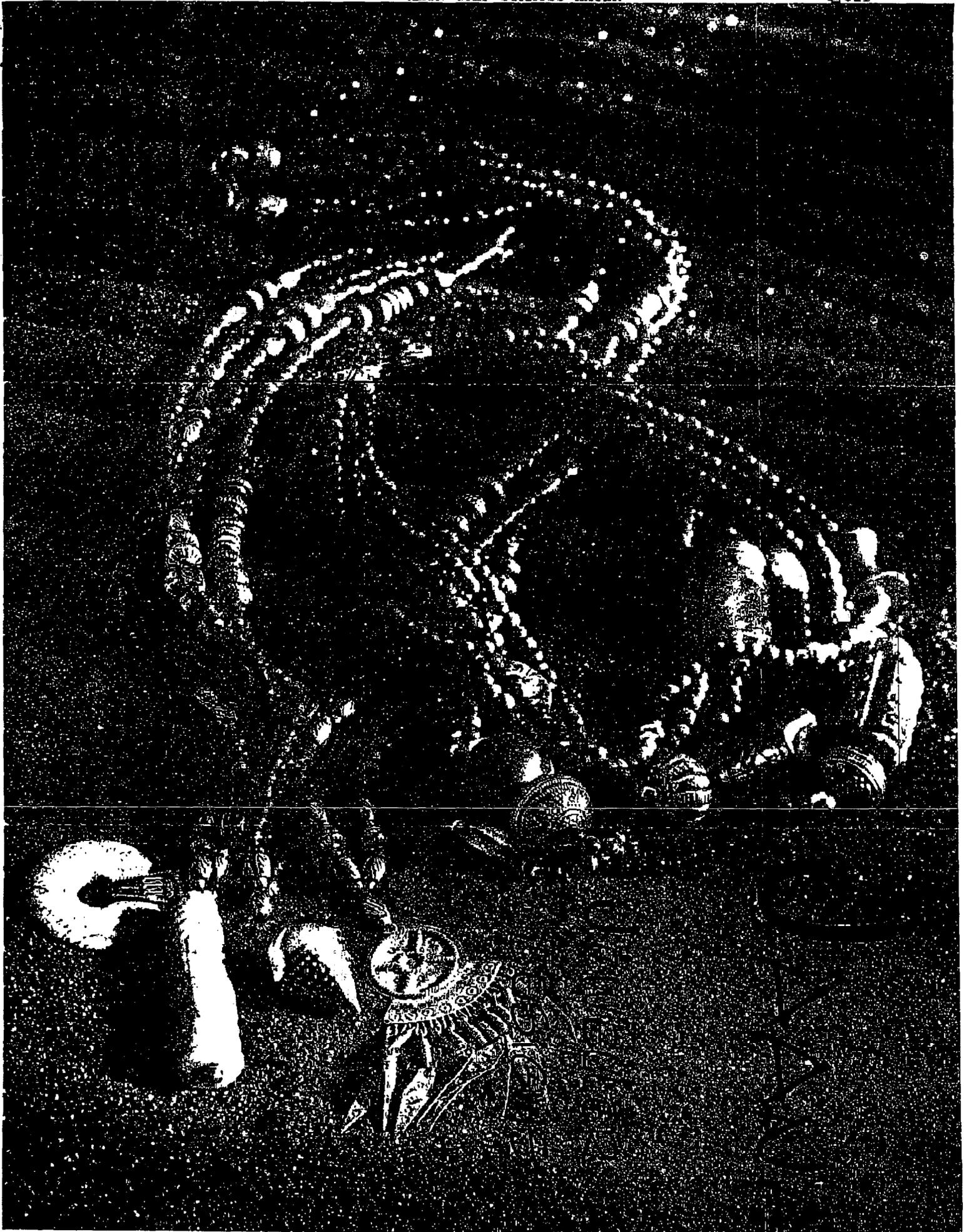
AKIN, GUMP, STRAUSS, HAUER &
FELD, L.L.P.

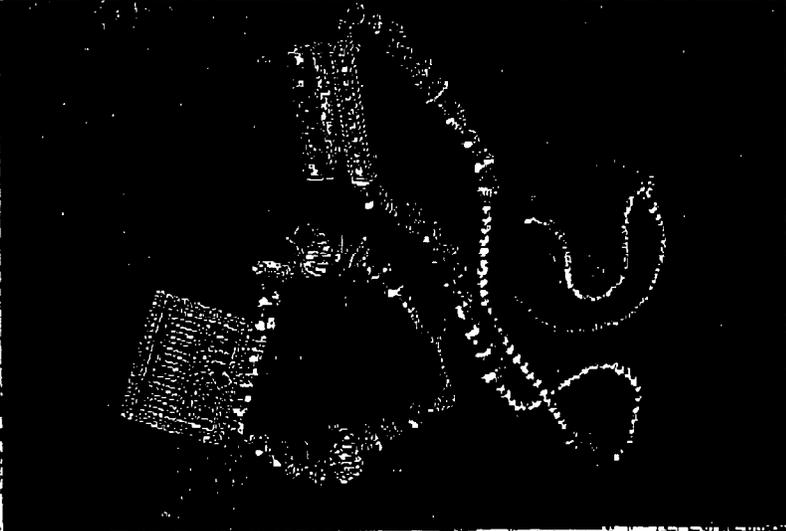
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Dated: 9/20/01

EXHIBIT D





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