

ESTTA Tracking number: **ESTTA291086**

Filing date: **06/22/2009**

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

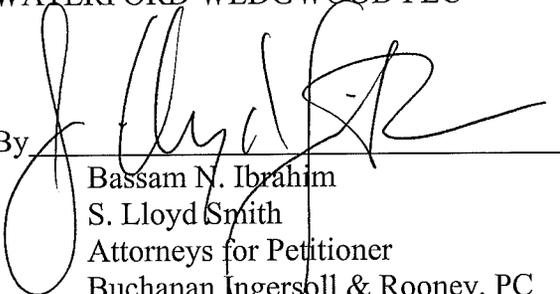
Proceeding	92048654
Party	Plaintiff Waterford Wedgwood PLC
Correspondence Address	Bassam N. Ibrahim Buchanan Ingersoll & Rooney P.C. P. O. Box 1404 Alexandria, VA 22313-1404 UNITED STATES bassam.ibrahim@bipc.com, lloyd.smith@bipc.com
Submission	Opposition/Response to Motion
Filer's Name	S. Lloyd Smith
Filer's e-mail	lloyd.smith@bipc.com
Signature	/SLS/
Date	06/22/2009
Attachments	92048654.pdf ( 19 pages )(590718 bytes )



unilaterally attempted to void the Settlement Agreement in correspondence on May 12, 2009, which accompanied its contemporaneously filed motion with the Board. Exhibit D.

Based on the existence of an executed Settlement Agreement and Registrant's acknowledgment that the proceedings have been resolved, Petitioner's lack of testimony during the testimony period was reasonable and excusable. Petitioner's counter-execution of the agreement was further excusably delayed by bankruptcy. Thus, Registrant's motion should be denied and the Board should suspend proceedings pursuant to 11 U.S.C. § 362 or reopen the testimony period for good cause.

WATERFORD WEDGWOOD PLC

By 

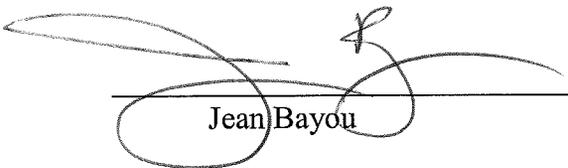
Bassam N. Ibrahim  
S. Lloyd Smith  
Attorneys for Petitioner  
Buchanan Ingersoll & Rooney, PC  
1737 King Street  
Alexandria, Virginia 22314-2727  
Telephone: 703-836-6620  
Facsimile: 703-836-2021

Date: June 22, 2009

**CERTIFICATE OF SERVICE**

I hereby certify that a true copy of the foregoing PETITIONER'S OPPOSITION TO MOTION FOR DISMISSAL AND MOTION TO REOPEN TESTIMONY PERIOD was served this 22<sup>nd</sup> day of June, 2009 by first-class mail, postage prepaid, on:

Baila C. Celedonia, Esq.  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036-6799



Jean Bayou

**EXHIBIT A**

**THIS SETTLEMENT AGREEMENT** (hereinafter referred to as "Settlement Agreement") by and between WATERFORD WEDGWOOD PLC, a limited corporation organized and existing under the laws of Ireland, having its principal place of business at Kilbarry, Waterford, Ireland (hereinafter referred to as "Waterford"); and TOB International Marketing Corp., a New York corporation located and doing business at 419 Broome Street New York, NY 10013 (hereinafter referred to as "TOB"). These entities are the parties to this Settlement Agreement and shall collectively be referred to as the "Parties."

**W I T N E S S E T H:**

**WHEREAS**, Waterford is the owner of U.S. Trademark Registration No. 2,892,400 for the trademark VINTAGE (hereinafter "Waterford's VINTAGE Mark") for use in connection with "articles of glassware for domestic use, namely, stemware, tumblers, iced tea glasses, high ball glasses, goblets, tumblers, champagne glasses, liqueur glasses, brandy glasses, wine glasses, sherbet glasses, shot glasses, carafes, ice buckets, decanters, vases, pitchers, bowls, candle holders not of precious metal, candle sticks not of precious metal, finger bowls, salad bowls, cake stands, salad serving spoons and forks, cocktail shakers, serving trays not of precious metal, perfume bottles and atomizers sold empty, corkscrews, bottle openers, ice buckets, wine coolers, glass stoppers, and cut crystal glassware" in International Class 21.

**WHEREAS**, TOB is the owner of U.S. Registration No. 3,231,740 for the mark VINTAGE MODERN for clocks in International Class 14; U.S. Registration No. 3,292,390 for the mark VINTAGE MODERN for lighting fixtures, namely, lamps in International Class 11; furniture, namely, chairs, tables, cabinets, desks, stools, chests, benches, mirrors, picture frames, decorative pillows and mattress cushions, decorative cushions, curtain rods, poles, hooks and finials, curtain rings, window blinds, window shades in International Class 20; dinnerware; plates, pitchers, bowls, teapots not of precious metal, cups, mugs, salt and pepper shakers, platters, ice buckets, casseroles, canister sets, cake plates, stemware, glasses, candle sticks and candle holders, not of precious metal, bathroom

accessories, namely, soap dishes, liquid soap dispensers, cup holders, toothbrush holders, pails, facial tissue holders, in International Class 21; bed and bath linens; drapery; table linens and kitchen linens; curtains; draperies and fabric window treatments; tapestries and fabric wall hangings, in International Class 24; and rugs and carpets, in International Class 27; and U.S. Registration No. 3,458,542 for Flatware, in International Class 8; stationery, note cards, paper hangtags, blank writing journals, gift wrap and paper gift bags, adhesive note pads, paper clips, paper clip holders and pens, in International Class 16; artificial flower arrangements, wreaths and garlands; decorative cord, braid, tassels and fringe for upholstery, in International Class 26; stuffed toy animals; artificial Christmas garlands, Christmas stockings, Christmas tree ornaments, Christmas tree skirts, snow globes, in International Class 28 (hereinafter the "VINTAGE MODERN Registrations").

**WHEREAS**, TOB has used its VINTAGE MODERN mark in conjunction with its THOMAS O'BRIEN mark, forming a composite mark (hereinafter, the "TOB VINTAGE MODERN Mark"). Attached as Exhibit A is an example of how TOB has used the TOB VINTAGE MODERN Mark.

**WHEREAS**, Waterford has filed a Petition for Cancellation the United States Patent and Trademark Office's Trademark Trial and Appeal Board, No. 92048654, against TOB (the "Cancellation");

**WHEREAS**, the Parties seek to avoid any future conflict with respect to each of the Parties respective rights in the above-mentioned marks;

**WHEREAS**, the Parties to this Settlement Agreement have resolved, consented and agreed to resolve the pending Cancellation.

**NOW THEREFORE**, the Parties to this Settlement Agreement, intending to be legally bound, and in consideration of the matters referred to herein, do hereby agree as follows:

1. This Settlement Agreement is effective as of the date of the last signature of the Parties (hereinafter the "Effective Date"), and, when it becomes effective it shall inure to the benefit of and be

binding upon the Parties and their successors, owners, employees, shareholders, directors, officers, attorneys, assigns, parents, subsidiaries, and parties in interest.

2. The Parties believe that there is no likelihood of confusion among the relevant purchasing public as to the source, origin or sponsorship arising out of Waterford's use of Waterford's VINTAGE Mark and TOB's use of the TOB VINTAGE MODERN Mark (collectively, the Parties' Respective Marks").

3. Within thirty (30) days of the Effective Date, TOB agrees to file a U.S. Trademark Application or Trademark Applications for the mark THOMAS O'BRIEN VINTAGE MODERN (the "New Applications") for the goods listed in the VINTAGE MODERN Registrations.

4. TOB agrees to expressly abandon the VINTAGE MODERN Registrations within ten (10) days of the filing date of the New Applications.

5. Within thirty (30) days after the filing date of the New Applications, Waterford shall pay TOB \$6,000.00 US (six thousand dollars US), as per an invoice to be sent to Waterford.

6. TOB further agrees that, it will use the VINTAGE MODERN mark only as part of a composite mark with the THOMAS O'BRIEN mark, whether in the form THOMAS O'BRIEN VINTAGE MODERN or VINTAGE MODERN THOMAS O'BRIEN, provided that the typeface in VINTAGE MODERN shall be sufficiently prominent to be noticeable to consumers. Waterford expressly agrees that the form of the TOB VINTAGE MODERN Mark shown in Exhibit A is in full compliance with this Settlement Agreement.

7. TOB hereby expressly acknowledges the validity and enforceability of Waterford's VINTAGE Mark, and agrees not to challenge or to assist others, directly or indirectly, in challenging the validity and/or enforceability of any of the Waterford's VINTAGE Mark. TOB further agrees to assist and cooperate with Waterford, if necessary, in providing any consent necessary for Waterford to

obtain any future registration of Waterford's VINTAGE Mark or any mark containing or comprising VINTAGE other than a mark which contains or comprises the term "Vintage Modern."

8. Waterford hereby expressly acknowledges the validity and enforceability of the TOB VINTAGE MODERN Mark, and agrees not to challenge or to assist others, directly or indirectly, in challenging the validity and/or enforceability of the TOB VINTAGE MODERN Mark or the mark VINTAGE MODERN THOMAS O'BRIEN. Waterford further agrees to assist and cooperate with TOB, if necessary, in providing any consent necessary for TOB to obtain any future registration of the TOB VINTAGE MODERN Mark or the mark VINTAGE MODERN THOMAS O'BRIEN.

9. TOB shall not use or register anywhere in the world the mark VINTAGE or VINTAGE MODERN, or any confusingly similar mark, except as a component of the mark THOMAS O'BRIEN VINTAGE MODERN or VINTAGE MODERN THOMAS O'BRIEN, in accordance with all the terms and conditions of this Settlement Agreement. Waterford acknowledges that nothing contained herein shall prevent TOB from using the terms "vintage" or "vintage modern" descriptively and not as a mark.

10. The terms this Settlement Agreement shall be kept and remain strictly confidential and shall not be disclosed to any person or entity except to (a) officers, accountants, attorneys, insurers, or others associated with the Parties hereto who have a need to know in order to carry out the terms of the Settlement Agreement (including but not limited to TOB licensees of the TOB VINTAGE MODERN Mark) or for tax, financial, or legally required reporting, or (b) as required by law, pursuant to a properly issued subpoena, any order of any court, or other authority or governmental agency with the authority to request information regarding the terms of, or facts underlying the Settlement Agreement.

11. In the event of a claimed breach of this Agreement, the party claiming a breach shall give notice to the breaching party, which shall have thirty (30) days after receipt of such notice to cure the alleged breach, or request mediation under paragraph 13 of the Settlement Agreement. However, if

said breach cannot be cured within thirty (30) days, the allegedly breaching party shall take all reasonable steps to remedy such breach expeditiously.

12. The terms and conditions of this Agreement shall remain binding upon the parties until either TOB has abandoned the TOB VINTAGE MODERN Mark, as abandonment is defined in Sec. 45 of the Lanham Act, 15 U.S.C. § 1050. or Waterford has abandoned Waterford's VINTAGE Mark, as abandonment is defined in Sec. 45 of the Lanham Act, 15 U.S.C. § 1050.

13. The parties shall endeavor to resolve any dispute arising out of or relating to this Settlement Agreement by mediation under the INTA Mediation Procedures. Unless the parties agree otherwise, the mediator will be selected from the INTA Panel of Neutrals. Any controversy or claim arising out of or relating to this Settlement Agreement or the breach, termination or validity thereof, which remains unresolved forty-five (45) days after appointment of a mediator, shall be settled by arbitration by a sole arbitrator in accordance with the CPR Rules for Non-Administered Arbitration of International Disputes (or any other rules that the parties agree upon), and judgment upon the award rendered by the arbitrator may be entered by any court located in the City of New York, whose jurisdiction over the parties thereof is acknowledged by the Parties. The seat of both the mediation and the arbitration shall be New York, NY, USA. The mediation and the arbitration shall be conducted in English.

14. In consideration of this Settlement Agreement, Waterford hereby releases TOB from any and all claims, demands, damages, losses, liabilities, rights, or causes of action arising out of or related to its use of the mark VINTAGE MODERN and/or TOB VINTAGE MODERN up to the date of this Settlement Agreement.

15. The notices required by this Settlement Agreement shall be given as follows:

**NOTICE TO WATERFORD:**

**Via Facsimile and Overnight Mail**

Sinead Gillen  
Waterford Wedgwood Plc  
Kilbarry, Waterford  
Ireland Attn: Keith Kancar

Fax No.: 011 353 51 33 2880

with a copy to:

Bassam N. Ibrahim  
Buchanan Ingersoll & Rooney, P.C.  
1737 King Street, Suite 500  
Alexandria, Virginia 22314-2727

Fax No.: 703 836-2021

**NOTICE TO TOB:**

**Via Facsimile and Overnight Mail**

TOB International Marketing Corp.  
419 Broome Street  
New York, NY 10013

Fax No. \_\_212 966-4701

with a copy to:

Baila H. Celedonia  
Cowan, Liebowitz & Latman, P.C.  
1133 Avenue of the Americas  
New York, NY 10036

Fax No.: 212 575-0671

Notice of any dispute, controversy, claim, demand for mediation or arbitration shall be provided as set forth above regardless of whether or not the complaining party is suffering immediate and/or irreparable harm. Notice shall be by both facsimile and overnight mail.

16. The Parties represent and acknowledge that they each have been advised by legal counsel relating to the terms of this Settlement Agreement. The Parties further represent and acknowledge that that they have thoroughly reviewed all agreements and fully understand their meaning and effect, and agree with their terms. The Parties also represent and acknowledge that each has had the benefit and advice of independent legal counsel in connection with this Settlement Agreement.

17. The Parties agree that this Settlement Agreement shall constitute the entire Agreement between the parties and that prior drafts of the Settlement Agreement, any changes to said prior drafts, or communications or negotiations relating to said prior drafts shall not be used to interpret the Settlement Agreement.

18. Neither this Settlement Agreement, nor any term or provision hereof, may be changed, waived, discharged or terminated except by an instrument in writing duly signed by the party against which enforcement of the change, waiver, discharge or termination is sought.

19. This Settlement Agreement may be executed in counterparts, and when counterparts of this Settlement Agreement have been signed by all Parties, it shall constitute an agreement.

20. The Parties each represent and warrant that the signatories to this Settlement Agreement are empowered with the authority to legally bind the Parties to each of the terms and conditions set forth in this Settlement Agreement.

**IN WITNESS WHEREOF**, the parties hereto, each acting under due and proper authority, have executed this Agreement on the dates indicated below.

**WATERFORD WEDGWOOD PLC**

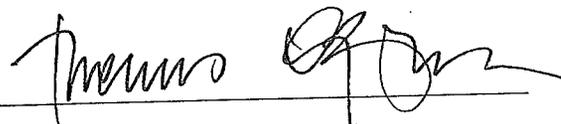
By: \_\_\_\_\_

Name: \_\_\_\_\_

Title: \_\_\_\_\_

Date: \_\_\_\_\_

**TOB INTERNATIONAL  
MARKETING CORP.**

By:  \_\_\_\_\_

Name: THOMAS O'BRIEN

Title: PRESIDENT

Date: 12.03.08

**EXHIBIT B**

# Cowan, Liebowitz & Latman, P.C.

LAW OFFICES

1133 Avenue of the Americas • New York, NY 10036-6799

(212) 790-9200 • www.cll.com • Fax (212) 575-0671

**Baila H. Celedonia**  
Direct (212) 790-9203  
bhc@cll.com

December 4, 2008

## By Federal Express

Bassam N. Ibrahim, Esq.  
Buchanan Ingersoll & Rooney PC  
1737 King Street, Suite 500  
Alexandria, VA 22314-2727

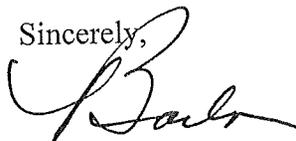
Re: Waterford v. TOB (Our Ref. 24143.005 -- Your Ref. 1030775-000298)

Dear Sam:

Enclosed are duplicate originals of the settlement agreement between our clients which have been signed by TOB International Marketing Corp. ("TOB") by its president, Thomas O'Brien. Once I receive a fully executed agreement from you, I will proceed with TOB's obligations under paragraphs 3 and 4 of the agreement.

I'm delighted that we were able to resolve this matter amicably.

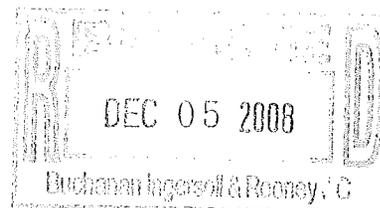
Sincerely,



Baila H. Celedonia

Enclosures

Cc: Gregory Marks, Esq. (w/o encl.)



**EXHIBIT C**



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## Waterford Wedgwood files for bankruptcy

### The British glassmaker filed for bankruptcy protection after it was unable to pay off its debt.

By Jim Boulden  
January 5, 2009: 8:23 AM ET

LONDON, England (CNN) -- Fine china and glasswork maker Waterford Wedgwood PLC has called in a receiver - the British equivalent of bankruptcy.

The company said its receiver will be the international accounting firm Deloitte, and added it will announce later Monday which of its Irish and U.K. subsidiaries will be put into administration.

The announcement was made in a statement Monday morning to the London Stock Exchange.

Receivership and administration are forms of bankruptcy protection. The administrator can choose to try and keep parts of the company operating or sell off the brands, shutting down the company. The aim is to find the most profitable way to pay creditors.

Waterford Wedgwood can trace its roots back to the 18th century, when glass blown in the Irish port of Waterford became a popular export and Josiah Wedgwood began to make affordable fine china in the British midlands.

The two well-known brands merged in 1986, but had suffered losses in each of the past three years. Waterford has been laying off employees in southeast Ireland since 2007, having moved much of its production to Slovenia. The company also has a ceramics plant in Jakarta, Indonesia. The group also includes the brands' Royal Doulton and Rosenthal porcelain.

In December the company announced it could no longer pay its debt obligations to a consortium of lenders, headed by Bank of America. (BAC, Fortune 500) Waterford Wedgwood was given two periods of 'forbearance' in December by the banks, giving it more time to find a buyer or a cash injection. That grace period ended on Monday.

Waterford Wedgwood is controlled by well-known Irish aristocrat Tony O'Reilly. In the company's announcement to the London Stock Exchange, O'Reilly said "We are consoled only by the fact that everything that could have been done, by management, and by the board, to preserve the Group, was done."

The company says its main markets are the United States, Britain and Germany, with a growing exposure in Asia and Eastern Europe. ■

**Find this article at:**

[http://money.cnn.com/2009/01/05/news/companies/wedgwood\\_bankruptcy](http://money.cnn.com/2009/01/05/news/companies/wedgwood_bankruptcy)

Check the box to include the list of links referenced in the article.

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**EXHIBIT D**

# Cowan, Liebowitz & Latman, P.C.

Law Offices

1133 Avenue of the Americas • New York, NY 10036-6799

(212) 790-9200 • www.cll.com • Fax (212) 575-0671

**Baila H. Celedonia**  
Direct (212) 790-9203  
bhc@cll.com

May 12, 2009

1030775-298

Bassam N. Ibrahim, Esq.  
Buchanan Ingersoll & Rooney, P.C.  
1737 King Street  
Suite 500  
Alexandria, VA 22314-2727

MAY 15 2009  
Buchanan Ingersoll & Rooney PC

Re: Waterford Wedgwood Plc v. TOB International Marketing Corp.,  
Cancellation No. 92048654

Dear Sam:

This letter serves as formal notice that my client TOB International Marketing Corp. is withdrawing its offer of settlement of the above cancellation proceeding. Pursuant to paragraph 19 of the tentative agreement, only "when counterparts of this Settlement Agreement have been signed by all Parties, it shall constitute an agreement." The Agreement sent to you signed by my client was, therefore, a mere offer of settlement, which your client has not yet formally accepted.

**Cowan, Liebowitz & Latman, P.C.**

Bassam N. Ibrahim, Esq.

May 12, 2009

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Given the months since the offer was made, your client's failure to formally accept the settlement offer in a timely fashion and the fact that you had not requested an extension of your client's testimony period, we have assumed that your client is no longer interested in pursuing this matter. We have, therefore, withdrawn the offer and moved for dismissal of the Cancellation for failure to take testimony under Trademark Rule 2.132(a). The service copy of our motion is enclosed.

Sincerely,

A handwritten signature in black ink, appearing to read "Baila", written in a cursive style.

Baila H. Celedonia

Enclosure