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

Proceeding	92049987
Party	Plaintiff Jewelry by S.A. Gauthier, Inc.
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Submission	Other Motions/Papers
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Date	03/05/2009
Attachments	477lift.pdf (5 pages)(271239 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:	)	
	)	
Applicant:	)	
Jewelry by S.A. Gauthier, Inc.	)	
	)	REQUEST TO LIFT
Applicant Address:	)	SUSPENSION AND
4211 North Marshall Way	)	CONSIDERATION OF
Scottsdale, Arizona 85251	)	COEXISTENCE AGREEMENT
	)	
Mark: GAUTHIER	)	
	)	
Serial No.: 77/354,477	)	
	)	

Dear Ms. Munson-Ott,

Applicant, Jewelry by S.A. Gauthier, Inc., respectfully requests the examining attorney lift the suspension against its GAUTHIER application, Serial No. 77/354,477 for the following reasons. Prior registrations for ROMAIN GAUTHIER, U.S. Reg. 3,196,976, and for R. GAUTHIER, U.S. Reg. No. 3,325,015, have been cited against Applicant. In response, Applicant filed a petition to cancel the registrations based upon its prior use of the GAUTHIER mark in the United States.

The parties have now entered a coexistence agreement and have asked the TTAB to suspend the cancellation proceedings so that the Examining Attorney can consider the agreement.

Applicant respectfully submits the coexistence agreement entered between the parties and asks the Examining Attorney to remove the 2(d) refusal against its GAUTHIER applications and allow them to proceed to publication.

The coexistence agreement details the reasons why the parties believe no likelihood of confusion exists and undertakes means to avoid confusion, if any, in the

future. Applicant's coexistence agreement is the product of arms-length negotiations executed after both parties carefully considered their respective customer bases, geographic usage, interests and markets. Coexistence agreements entered between the parties most interested in precluding confusion are entitled to "great weight." *Amalgamated Bank of New York v. Amalgamated Trust & Savings Bank,* 842 F.2d 1270, 6 USPQ2d 1305 (Fed. Cir. 1988). "It is at least difficult to maintain a subjective view that confusion will occur when those directly concerned say it won't. A mere assumption that confusion is likely will rarely prevail against uncontroverted evidence from those on the firing line that it is not." T.M.E.P. § 1207.01(d)(viii).

Respectfully submitted this 5th day of March, 2009.

Christy L.E. Hubbard, Esq.
Lewis and Roca, LLP
40 North Central Avenue, Suite 1900
Phoenix, Arizona 85004
(602) 262-5311

COEXISTENCE AGREEMENT

This Agreement (the "Agreement") is by and between Jewelry by S.A. Gauthier, Inc., an Arizona corporation located at 4211 North Marshall Way, Scottsdale, Arizona 85251 ("JBG") and Montres Romain Gauthier SA, a company organized and existing under the laws of Switzerland located at Grande Rue 19, CH1347 Le Sentier, Switzerland ("MRG"). Unless the context clearly requires otherwise, a "Party" will refer to JBG and MRG separately, as the case may be, and the word "Parties" will refer to JBG and MRG together. This Agreement will be effective as of the last date it is signed by a Party below. For convenience, this Agreement will refer to both a trademark and a trade name as a "mark."

RECITALS

WHEREAS JBG has adopted and used in United States commerce the trademarks and trade names GAUTHIER, JEWELRY BY GAUTHIER and JEWELRY BY S.A. GAUTHIER, INC. in connection with jewelry, the custom design of jewelry and the sale of jewelry, since at least as early as 1989 and the marks have been used extensively throughout the country since that date (the "Jewelry Marks");

WHEREAS JBG owns two pending federal trademark applications for GAUTHIER for "retail store services" in Class 35 and "jewelry" in Class 14, Serial Numbers 77/354,477 and 77/354,468 respectively (the "Jewelry Applications");

WHEREAS MRG owns an International Registration for ROMAIN GAUTHIER, No. 0865365, and R. GAUTHIER, No. 0917643, for "timepieces" that was extended into the United States via Registration Nos. 3196976 and 3325015 (the "Timepiece Registrations");

WHEREAS the US Patent and Trademark Office has cited the Timepiece Registrations in office actions against the Jewelry Applications;

WHEREAS, the Parties desire to resolve the differences between them and avoid future controversy.

NOW THEREFORE, in consideration of the mutual promises set forth in this Agreement, and for other good and valuable consideration, the receipt and sufficiency of which are acknowledged, the Parties agree as follows under the following terms and conditions:

AGREEMENT

1. The Parties believe and agree that given the different commercial impressions of the marks as a whole, given the differences in the goods and services involved, the custom and expensive nature of the products and the sophistication of their respective clientele, confusion is not likely between their marks and that they can peacefully coexist.

2. MRG will use the R. GAUTHIER and ROMAIN GAUTHIER marks in the United States solely in connection with timepieces, defined for the purposes of this Agreement

as "a clock or a watch used to measure or show the progress of time" ("Timepieces"). MRG agrees not to use or register the R. GAUTHIER or the ROMAIN GAUTHIER mark in the United States in connection with any jewelry other than Timepieces and not to use the GAUTHIER mark alone without also using either the initial R. or the name ROMAIN in front of GAUTHIER (as in R. GAUTHIER or ROMAIN GAUTHIER); provided, however, that MRG shall be permitted to use its R. GAUTHIER or ROMAIN GAUTHIER marks in the United States in connection with a "boutique" or similar store which sells exclusively Timepieces that carry the R. GAUTHIER or ROMAIN GAUTHIER marks, so long as the name GAUTHIER is not used alone in connection with the store or the Timepieces.

3. JBG agrees not to use the GAUTHIER mark in connection with a brand of Timepieces and agrees to amend its Jewelry Applications to explicitly exclude Timepieces.

4. MRG consents to and agrees not to object to, oppose, seek to cancel or otherwise interfere with JBG's rights in, use, or registration of the Jewelry Marks and the Jewelry Applications at the local, state or federal level in the United States.

5. JBG consents to and agrees not to object to, oppose, seek to cancel or otherwise interfere with MRG's rights in, use, or registration of the R. GAUTHIER and ROMAIN GAUTHIER marks or the Timepiece Registrations at the local, state or federal level in the United States.

6. JBG and MRG hereby agree and acknowledge that this coexistence agreement will be filed with the PTO and become part of the record of the Jewelry Applications. Each Party agrees that it will, at the requesting Party's expense, prepare and file any reasonable additional documents with the PTO or other court or entity necessary to effectuate the terms and purposes of the Agreement.

7. In the event of actual consumer confusion, the Parties will work in good faith to direct a misguided inquiry to the other Party. Notwithstanding, JBG may terminate this Agreement upon thirty (30) days written notice to MRG in the event the PTO examining attorney refuses to accept the Agreement, or a variation of it approved by the Parties, in connection with the Jewelry Applications. This Coexistence Agreement will terminate and no longer be effective in the event either (a) JBG discontinues use with intent not to resume use of all of the Jewelry Marks or (b) MRG discontinues use with intent not to resume use of both of the ROMAIN GAUTHIER and R. GAUTHIER marks on Timepieces.

8. The Agreement will constitute the entire understanding of the Parties with respect to its subject matter. No modification or amendment of the Agreement will be binding unless executed in a writing signed by the Parties.

9. The Parties acknowledge that if a Party breaches any of the terms, conditions or representations or warranties of this Agreement, the non-breaching Party will be irreparably harmed by such breach and will have no adequate remedy at law. Each Party further agrees and acknowledges that this Agreement is reasonably necessary for the protection of it and its business and that, in addition to any rights and remedies available to it, at law or otherwise, the

non-breaching Party will be entitled to any preliminary or permanent injunction to be issued by any court of competent jurisdiction, enjoining and restraining the violation or threatened violation of this Agreement and consenting to issuance of such an injunction. A prevailing Party will be entitled to reimbursement of any court costs, including reasonable attorneys' fees, and other expenses incurred as a result of a breach of this Agreement.

10. The individual executing this Agreement on behalf of JBG and MRG represent and warrant that he/she is properly authorized to act on behalf of such entity, that the execution of the Agreement has been validly approved by all necessary action by the company, and that upon the execution of the Agreement, it will be fully binding and enforceable against such entity.

11. Each Party is represented by or has access to counsel. Each Party acknowledges that it has entered into this Agreement after being fully informed and advised by its respective counsel concerning the Agreement's terms or that it has voluntarily chosen not to seek the advice of counsel. The Parties have not relied on any statement or promise by any person other than those statements or promises contained in this Agreement.

12. Each Party to this Agreement has reviewed and cooperated in the drafting and preparation of this Agreement. This Agreement is the product of arms length negotiations carried on between the Parties and/or their respective counsel. As a jointly produced document, the Agreement and its terms will be simply construed according to their fair meaning and not strictly for or against any Party or the drafter hereof.

13. The Agreement and all of its terms, including the recitals above, which are hereby integrated into the Agreement, will be binding upon and will inure to the benefit of the Parties along with each Party's officers, directors, owners, executives, successors, assignees and licensees.

14. In the event that any portion of this Agreement is found invalid, that portion may be severed from, and will not affect the validity of, the remaining provisions.

15. The Agreement may be executed by facsimile signature and in one or more counterparts, each of which will be deemed an original for the purposes of enforcement.

By their execution below, the Parties agree to all of the terms and conditions of this Agreement.

JEWELRY BY S.A. GAUTHIER, INC.

By:
Name: Sylvie A. GAUTHIER
Title: Owner
Date: 12/08/08

MONTRES ROMAIN GAUTHIER SA

By:
Name: Romain Gauthier
Title: CEO
Date: 07.01.2008