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

Proceeding	92059289
Party	Plaintiff D.J. Bronson, Inc.
Correspondence Address	J ALISON GRABELL EZRA BRUTZKUS GUBNER LLP 21650 OXNARD STREET, SUITE 500 WOODLAND HILLS, CA 91367 UNITED STATES agrabell@ebg-law.com, sbroffman@ebg-law.com, rezra@ebg-law.com
Submission	Motion to Suspend for Civil Action
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Signature	/J. Alison Grabell/
Date	10/08/2014
Attachments	Request for Suspension of Proceeding.pdf(107431 bytes) Ex. A to Request for Suspension.pdf(1092766 bytes)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

D.J. BRONSON, INC.,	)	**Cancellation No. 92059289**
	)	
Petitioner,	)	**Mark: MASQUERADE**
	)	
v.	)	**Registration No. 3,427,380**
	)	
DAMO TEXTILE,	)	**Date of Registration: May 13, 2008**
	)	
Registrant.	)	
	)	

PETITIONER'S MOTION TO SUSPEND PROCEEDINGS

Pursuant to TBMP § 510.02(a), Petitioner D.J. Bronson, Inc. ("Petitioner") hereby requests a suspension of Cancellation No. 92059289 pending disposition of civil litigation. Petitioner hereby notifies the Board that Case No. 2:14-cv-07818 was filed on October 8, 2014 in Federal District Court in the Central District of California. A copy of the Complaint as filed is attached hereto as Exhibit A.

Petitioner further requests that, accordingly, the Board suspend a decision on Registrant's Motion for Leave to Amend Its Answer, filed September 18, 2014.

Dated: October 8, 2014

Respectfully submitted,

Robert Ezra
J. Alison Grabell

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CERTIFICATE OF SERVICE

I hereby certify that on this 8th day of October, 2014, the foregoing PETITIONER'S MOTION TO SUSPEND PROCEEDINGS was served upon Registrant by United States first-class mail, postage prepaid, addressed as follows:

George Busu, Esq.
Lim, Ruger & Kim, LLP
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EXHIBIT A

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Attorneys for Plaintiff, **D.J. BRONSON, INC.**

UNITED STATES DISTRICT COURT

FOR CENTRAL DISTRICT OF CALIFORNIA

D.J. BRONSON, INC., a California corporation, Plaintiff, v. DAMO TEXTILE, INC., a California corporation; and DOES 1 through 10, inclusive, Defendants.	Case No. 2:14-cv-07818 **COMPLAINT FOR:** **(1) COMMON LAW TRADEMARK INFRINGEMENT;** **(2) UNFAIR COMPETITION (15 U.S.C. § 1125(a));** **(3) UNFAIR COMPETITION (Cal. Bus. & Prof. Code § 17200, et seq.);** **(4) CALIFORNIA COMMON LAW UNFAIR COMPETITION; and** **(5) DECLARATORY RELIEF** **DEMAND FOR TRIAL BY JURY**

Plaintiff D.J. BRONSON, INC., complains of Defendant DAMO TEXTILE, INC., as follows:

PARTIES, JURISDICTION, AND VENUE

1. Plaintiff D.J. BRONSON, INC. ("Plaintiff") is a corporation organized and existing pursuant to the laws of the State of California, with its principal place of

business located in the County of Los Angeles, State of California. D.J. Bronson, Inc. is a designer of apparel for young women.

2. Plaintiff is informed and believes and thereon alleges that Defendant DAMO TEXTILE, INC. ("Defendant") is a corporation organized and existing pursuant to the laws of the State of California with its principal place of business located in the County of Los Angeles, State of California. Plaintiff is informed and thereon alleges that Defendant is a designer, manufacturer and off-price seller of women's and young women's apparel.

3. Plaintiff is informed and believes and thereon alleges that Defendant DAMO TEXTILE, INC. is a California corporation qualified to do business in the state of New York. Plaintiff is informed and believes and thereon alleges that that the individuals and/or entities designated herein as DOES 1 through 10 are the agents and/or representatives of the named Defendant herein (collectively "Defendants"), and in doing the acts complained of herein, acted in their capacities as agents, representatives, and/or co-conspirators of the named Defendant, thereby making them a part of this action. As soon as the specific names and capacities of the DOE Defendants are ascertained, this Complaint will be amended to reflect same.

4. The Court has personal jurisdiction over Defendant by virtue of the fact that Defendant conducts business within the Central District of California.

5. The Court has subject matter jurisdiction over this action pursuant to 28 U.S.C. § 1331 (Federal Question), 15 U.S.C. § 1125(a) (Lanham Act § 43(a)), and supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. § 1367. The Court also has federal jurisdiction under 28 U.S.C. § 2201 (the Declaratory Judgment Act).

6. Venue is proper in this District pursuant to 28 U.S.C. §§ 1391(b)-(d) and 18 U.S.C. § 1965.

STATEMENT OF FACTS

A. Plaintiff's Business, Adoption and Use of the Masquerade Trademark

7. Plaintiff D. J. Bronson, Inc. is a designer of women's clothing. Plaintiff was incorporated in 1994 and has continuously conducted business since that date.

8. Plaintiff selected and adopted the MASQUERADE trademark (the "MASQUERADE Mark" or "Plaintiff's Mark") for its apparel in or about 1997.

9. Plaintiff has been well-known in the apparel industry for twenty years and is recognized as the source of stylish special occasion apparel for young women. Plaintiff's apparel is sold at national department stores, such as Nordstrom, Dillard's, Sears, and J.C. Penney; in specialty stores nationwide, such as Windsor Stores and David's Bridal; and online, *inter alia*, at www.windsorstore.com, www.bonton.com, and www.debshops.com. Plaintiff's dresses bearing the MASQUERADE Mark have been advertised, for example, in Seventeen Magazine (also accessible at www.seventeen.com).

10. A substantial majority of Plaintiff's business is conducted under the MASQUERADE Mark. Since 1997, Plaintiff's sales of goods under the MASQUERADE Mark have exceeded $100,000,000.00.

B. Defendant's Business, Use and Registration of the MASQUERADE Trademark

11. On information and belief, Defendant Damo Textile, Inc. is a designer and manufacturer of women's clothing.

12. On information and belief, Defendant is the successor business to and/or purchased the name and/or assets of and/or is otherwise related to Damo Textiles Corp., which Plaintiff is informed and believes is a dissolved New York corporation.

13. Damo Textiles Corp. manufactured apparel for Plaintiff under Plaintiff's Mark for several years and was aware that Plaintiff sold apparel under the MASQUERADE Mark prior to Plaintiff's first use of the MASQUERADE Mark.

14. In or about May 2014, Plaintiff first learned of Defendant's unauthorized use of the MASQUERADE Mark. Plaintiff thereupon learned that Defendant had federally registered the MASQUERADE Mark at the United States Patent and Trademark Office ("USPTO") under Registration No. 3427380 (the "'380 Registration"), claiming a date of first use anywhere and in commerce of January 1, 2008. The application for registration, Serial No. 77005252 (the "'252 Application"), matured to registration on May 13, 2008, for "Blouses; body suits; bras; briefs; camisoles; crop tops; dresses; jackets; jeans; loungewear; overalls; pajamas; panties; pants; polo shirts; shorts; skirts; sleepwear; sweat pants; sweat shirts; T-shirts; tank tops; undershirts; underwear.

15. On information and belief, Defendant did not use and was not using the MASQUERADE Mark on each and every good covered in the '252 Application at the time it was filed or a time thereafter.

16. On information and belief, during statutory maintenance of the '380 Registration, Defendant deleted the following goods from the '380 Registration: "Body suits; jackets; jeans; loungewear; overalls; pajamas; pants; polo shirts; skirts; sleepwear; sweat pants; sweat shirts."

C. Plaintiff's Application to Register the MASQUERADE Trademark and Petition for Cancellation of Defendant's Registration

17. On June 3, 2014, Plaintiff filed an application to register the MASQUERADE Mark at the USPTO, under Application Serial No. 86299540 for "dresses" in Class 25 (the "'540 Application").

18. On June 4, 2014, Plaintiff filed a Petition for Cancellation of the '380 Registration at the USPTO Trademark Trial and Appeal Board ("TTAB"), under Cancellation No. 92059289 (the "Cancellation"). As grounds for the Cancellation, Plaintiff alleged priority of trademark rights and fraud on the Trademark Office. Plaintiff also requested suspension of the '540 Application pending disposition of the Cancellation.

19. On July 14, 2014, Defendant answered the Petition for Cancellation.

20. On September 17, 2014, responding to early discovery, Defendant stated that it did not use the MASQUERADE Mark before January 1, 2008.

21. On September 18, 2014, Defendant filed a Motion at the TTAB for leave to amend its answer (the "Motion"), to assert an affirmative defense of statute of limitations. Plaintiff has not yet consented to the Motion and it remains uncontested pursuant to 37 C.F.R. § 2.127(c).

22. Concurrently with the filing of this Complaint, Plaintiff has requested suspension of the Cancellation at the TTAB, pending disposition of the instant action.

FIRST CAUSE OF ACTION

(Common Law Trademark Infringement)

23. Plaintiff re-alleges and incorporates by reference all of the allegations contained in paragraphs 1 through 22 of this Complaint, inclusive.

24. The MASQUERADE Mark has been extensively used and promoted through the United States in connection with Plaintiff's apparel.

25. Plaintiff's Common Law Trademark is inherently distinctive. As a result of Plaintiff's prior use and promotion of Plaintiff's Common Law Trademark, the MASQUERADE Mark has become well and favorably known throughout the United States. Plaintiff's Common Law Trademark has developed exceedingly valuable goodwill.

26. Defendant has adopted, selected, and used Plaintiff's Common Law Trademark on or in connection with Defendant's apparel without Plaintiff's authorization. Such unauthorized adoption, selection, and use are likely to cause confusion with Plaintiff's MASQUERADE Mark.

27. On information and belief, Defendant has adopted, selected, and used Plaintiff's Common Law Trademark on or in connection with Defendant's apparel without Plaintiff's authorization knowingly, willfully, and intentionally to advertise, promote, display, offer for sale, and/or sell apparel and related goods. Defendant's

knowledge of Plaintiff's prior use of the MASQUERADE Mark is in part based upon its succession with Damo Corp., who manufactured MASQUERADE labeled apparel for Plaintiff. Such unauthorized adoption, selection and use are likely to cause confusion with Plaintiff's MASQUERADE Mark.

28. Defendant's unauthorized use of the MASQUERADE Mark on Defendant's apparel and related goods, in its advertisements and on its website, has caused confusion in the market and is likely to cause further confusion among members of the relevant public and trade to believe that Defendant's apparel and related goods are provided by, affiliated with, or under the sponsorship or approval of Plaintiff.

29. Defendant willfully or negligently selected, adopted and/or used the MASQUERADE Mark on the infringing clothing and accessories with knowledge of Plaintiff's valuable goodwill and business reputation associated therewith, to the extent of willful adoption, Defendant acted with intent to confuse, mislead, and deceive the public into believing the infringing apparel and related goods are associated with, manufactured by, sold approved, sponsored or endorsed by Plaintiff.

30. The confusion, mistake, or deception referred to above arises out of acts alleged above which constitute common law trademark infringement and false designation of origin as that phrase is used in 15 U.S.C § 1125(a).

31. Unless restrained by this Court, Defendants will continue to infringe Plaintiff's Common Law Trademark by their use on the infringing products, advertisements, and websites.

32. By its wrongful acts, Defendants have caused and, unless restrained by this Court, will further cause serious and irreparable harm to Plaintiff.

SECOND CAUSE OF ACTION

(Unfair Competition (15 U.S.C. § 1125(a)))

33. Plaintiff re-alleges and incorporates by reference all of the allegations contained in paragraphs 1 through 32 of this Complaint, inclusive.

34. The acts of Defendants, as set forth above, constitute unfair competition and are in violation of 15 U.S.C. § 1125(a).

35. Defendants' use of Plaintiff's MASQUERADE Mark is likely to cause confusion, cause mistake, and/or deceive as to the affiliation, connection, or association of Plaintiff and its aforementioned design, with Defendant, and/or as to the origin, sponsorship, or approval of Defendant's goods.

36. Plaintiff has suffered, and continues to suffer, damages to its profits, sales, and business as a result of Defendants' misconduct as referenced herein. Plaintiff has sustained, and will continue to sustain, great and irreparable injury in that it will lose customers and goodwill associated with its MASQUERADE Mark. Plaintiff has no adequate remedy at law for these injuries. Unless Defendants are restrained from engaging the unfair competition practice in the future, Plaintiff will be compelled to bring a multiplicity of suits to protect its interests.

37. In addition to recovery of compensatory damages, Plaintiff also seeks recovery of its attorney's fees and costs pursuant to 15 U.S.C. § 1117.

THIRD CAUSE OF ACTION

(Unfair Competition (Cal. Bus. & Prof. Code § 17200 *et seq.*))

38. Plaintiff re-alleges and incorporates by reference all of the allegations contained in paragraphs 1 through 37 of this Complaint, inclusive.

39. Defendants have committed acts of illegal and unfair business practices, as defined by California Business and Professions Code § 17200 et seq., by engaging in, among other unfair practices including trademark infringement.

40. These acts and practices violate Business and Professions Code § 17200 in that they are illegal, unfair, and/or fraudulent business practices.

41. The unlawful, unfair, and/or fraudulent business practices as described above, present a continuing threat to members of the public in that Plaintiff and members of the general public have no other adequate remedy at law to halt and remedy said practices and/or policy.

42. As a direct and proximate result of the aforementioned acts, Defendants have received and continues to hold ill-gotten gains resulting from their unfair business practices, which properly belong to Plaintiff. Plaintiff, accordingly, seeks restitution of all such gains.

FOURTH CAUSE OF ACTION

(California Common Law Unfair Competition)

43. Plaintiff re-alleges and incorporates by reference all of the allegations contained in paragraphs 1 through 42 of this Complaint, inclusive.

44. The acts and conduct of Defendants as alleged above in this Complaint constitute unfair competition pursuant to the common law of California.

45. Defendants' conduct as alleged above has damaged and will continue to damage Plaintiff's goodwill and reputation and has resulted in losses to Plaintiff and an illicit gain of profit to Defendants in an amount unknown at the present time.

FIFTH CAUSE OF ACTION

(Declaratory Relief for Cancellation of Trademark Registration against Defendant Damo Textile, Inc.)

46. Plaintiff re-alleges and incorporates herein by reference all of the allegations contained in Paragraphs 1 through 45, inclusive.

47. A controversy has arisen with respect to the '380 Registration. Plaintiff believes that it has priority of rights in the MASQUERADE Mark as to Defendant and, accordingly, is entitled to registration of the MASQUERADE Mark in lieu of Defendant.

48. Plaintiff believes that Defendant's act of registering Plaintiff's MASQUERADE Mark with the USPTO constitutes fraud on the Trademark Office and that the '380 Registration was fraudulently obtained, as Defendant falsely stated to the USPTO that Defendant was entitled to registration of the MASQUERADE Mark based on a date of first use anywhere and in commerce of January 1, 2008, when in fact the MASQUERADE Mark was first used by Plaintiff anywhere and in

commerce at least as early as August 31, 1997, long before Defendant's claimed date of first use. Accordingly, the '380 Registration should be cancelled.

49. A declaration by the Court is needed to determine the rights and obligations of the parties.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff requests judgment against Defendants as follows:

1. The Defendants, their officers, agents, servants, employees, representatives, and attorneys, and all persons in active concert or participation with them, be permanently enjoined from using, offering for sale, selling or distributing apparel bearing the MASQUERADE Mark, or a mark likely to cause confusion with the MASQUERADE Mark, and from any other form of dealing or transaction in connection with any and all clothing, apparel, accessories, advertising and promotional materials, print media, signs, Internet websites, or any other media, either now known or hereafter devised, bearing any mark which infringes, contributorily infringes or vicariously infringes the MASQUERADE Mark.

2. The Defendants, their officers, agents, servants, employees, representatives, and attorneys, and all persons in active concert or participation with them, be permanently enjoined from seeking to register or registering the MASQUERADE Mark or a mark likely to cause confusion with the MASQUERADE Mark for or in connection with any and all clothing, apparel, accessories and related goods and services.

3. The Defendants be enjoined from unfairly competing with Plaintiff in any manner.

4. The Defendants be held liable to Plaintiff for Defendant's profits in accordance with 15 U.S.C. § 1117(a)(1).

5. The Defendants be held liable to Plaintiff for any damages sustained by Plaintiff in accordance with 15 U.S.C. § 1117(a)(2).

6. The Defendants be held liable to Plaintiff for the costs of this action in accordance with 15 U.S.C. § 1117(a)(3).

7. The Defendants be held liable to Plaintiff for treble profits together with a reasonable attorney's fee and prejudgment interest in accordance with 15 U.S.C. § 1117(a)(3).

8. An accounting be made for all profits, income, receipts or other benefit derived by Defendants from the display, promotion, distribution, or sale of clothing and related goods and services that improperly or unlawfully infringed upon Plaintiff's rights in the MASQUERADE Mark.

9. Requiring Defendants to account for and pay over to Plaintiff all profits derived by Defendants from their acts of federal statutory unfair competition and to reimburse Plaintiff for all damages suffered by Plaintiff by reasons of Defendants' acts, pursuant to 15 U.S.C. § 1117.

10. For injunctive relief, pursuant to, *inter alia*, 15 U.S.C. § 1116, ordering Defendants to cease any and all further acts of federal and state statutory unfair competition and/or to assign any and all of its trademark applications and registrations to Plaintiff.

11. For an order cancelling Defendant's trademark registration which bears Registration No. 3427380.

12. For Plaintiff's attorneys' fees and costs of this action.

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13. For punitive and exemplary damages.

14. For any such other and further relief as the Court may deem just and appropriate, including pre-and post-judgment interest.

Dated: October 8, 2014

EZRA BRUTZKUS GUBNER LLP

By: _____

ROBERT EZRA
J. ALISON GRABELL
JEFFREY A. KOBULNICK
Attorneys for Plaintiff,
D.J. BRONSON, INC.

DEMAND FOR JURY TRIAL

Plaintiff hereby demands a jury trial for each and every cause of action set forth in the Complaint.

Dated: October 8, 2014

EZRA BRUTZKUS GUBNER LLP

By: _____

ROBERT EZRA
J. ALISON GRABELL
JEFFREY A. KOBULNICK
Attorneys for Plaintiff,
D.J. BRONSON, INC.