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

Proceeding	77663101
Applicant	EK Success, Ltd.
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Submission	Applicant's Motion to Suspend
Attachments	MotiontoSuspendAppeal77663101.pdf ( 11 pages )(357904 bytes )
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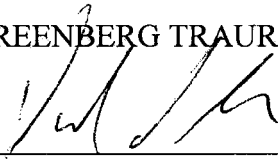
Therefore, the respective rights of Applicant and the cited registrant JJI International, Inc. with respect to the same marks are at issue in the Civil Action, which will clearly have a bearing on the issues in this appeal. Accordingly, Applicant respectfully requests that the Board suspend this appeal pending the outcome of the Civil Action.

Dated: July 21, 2010

Respectfully submitted,

GREENBERG TRAURIG, LLP

By:

  
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**EXHIBIT A**

**UNITED STATES DISTRICT COURT FOR  
THE DISTRICT OF RHODE ISLAND**

JJI INTERNATIONAL, INC. )  
 )  
 Plaintiff, )  
 )  
 v. )  
 )  
 EK SUCCESS, LTD., )  
 )  
 Defendant. )

**CA 10 - 216 ML**  
Civil Action No.

**COMPLAINT**

Plaintiff, JJI International, Inc. (“JJI”), brings this action against defendant, EK Success, Ltd. (“EKS”), for federal trademark infringement and federal and state unfair competition. By this Complaint, JJI seeks injunctive relief and monetary damages and alleges as follows:

**The Parties**

- 1. JJI is a company organized and existing under the laws of the State of Rhode Island, with its principal place of business located at 200 First Avenue, Cranston, Rhode Island 02910.
- 2. Upon information and belief, EKS is a company organized under the laws of New York, with a principal place of business located at 261 River Road, Clifton, New Jersey 07014.

**Jurisdiction and Venue**

3. This is an action for trademark infringement and false designation of origin arising under section 43(a) of the Lanham Act, 15 U.S.C. § 1125, and for related claims of common law unfair competition under Rhode Island law. This Court has jurisdiction over the section 43(a) claims pursuant to the provisions of section 39(a) of the Lanham Act, 15 U.S.C. § 1121, and jurisdiction over the common law claim for unfair competition brought herein under

the provisions of 28 U.S.C. § 1338(b) in that said claim is joined with a substantial and related claim under the Trademark Laws of the United States, 15 U.S.C. § 1051, et seq.

4. This Court has personal jurisdiction over EKS because, among other reasons, EKS markets and sells products throughout the State of Rhode Island in retail outlets from Middletown to Smithfield.

5. Venue is proper in this court pursuant to 28 U.S.C. §§ 1391(b) and (c).

#### **Facts**

6. Established in 1989, JJI designs, sources and manufactures a wide variety of décor, gifts and accessories, including jewelry items. JJI services all channels of distribution such as retail, direct marketing and television shopping networks.

7. JJI provides its clients with logistics, sales analysis, product fulfillment, quality assurance testing and consumer safety laboratory testing as well as other services.

8. In or about January, 1998, JJI first began using the word mark, JOLIE®, in commerce in connection with the marketing and sale of jewelry products, and has been using it in commerce continuously since then.

9. To protect the substantial goodwill associated with its line of jewelry products branded with the mark, JOLIE®, JJI has applied for trademark registrations from the United States Patent and Trademark Office (the "PTO"). Today, JJI owns federal trademark registrations for a family of JOLIE marks (the "JOLIE® Marks") in connection with its jewelry products: JOLIE JEWELS® (Reg. No. 2,758,913); and JOLIE® (Reg. No. 3,781,111). True copies of the United States Patent and Trademark Office Certificates of Registration are attached hereto as Exhibit A.

10. The above trademark registrations are valid and subsisting. The JOLIE JEWELS® mark for “jewelry” is incontestable as a matter of law.

11. During its long, widespread and continuous use of the JOLIE® Marks, JJI has expended considerable monies to advertise and promote jewelry marks under the JOLIE® brand. Through its promotion, advertising and the quality of products and services associated with the JOLIE® Marks, JJI has developed considerable goodwill in the JOLIE® brand and it is widely recognized by consumers. Accordingly, the JOLIE Marks are extremely valuable commercial assets.

**EKS’s Bad Faith Adoption and Use of the JOLIE® Marks**

12. Approximately 10 years after JJI launched the JOLIE® brand, in late 2008, EKS began using the designations, JOLEE’s and JOLEE’s JEWELS (the “Accused Marks”), in connection with jewelry products and promotes them as “innovative products under brands you know and trust.” EKS markets and sells products bearing the Accused Marks in the same channels as JJI and competes in direct competition with products bearing the JOLIE® Marks.

13. On or about February 21, 2008, EKS filed with the PTO an intent-to-use trademark application for the mark, JOLEE’S, for “jewelry.” EKS represented falsely under oath to the PTO that it has the right to use the mark, JOLEE’S, in connection with “jewelry” products. A true copy of EKS’s February 21, 2008 trademark application for the “JOLEE’S” mark and July 22, 2008 Declaration are attached hereto as Exhibit B.

14. On July 6, 2009, EKS filed a Statement of Use indicating a first use anywhere in commerce of June 2, 2008, approximately 9 years after JJI launched the JOLIE® Marks. Apparently relying on EKS’s misrepresentations set forth in the Declaration, the PTO issued a trademark registration to EKS on September 8, 2009.

15. On February 7, 2009, EKS filed a second intent-to-use application, this one for the word mark, JOLEE'S JEWELS (Ser. No. SS/663,101), for "jewelry making components for use in crafts, namely, gems and strands."

16. On or about December 9, 2009, the PTO issued a Final Office Action and maintained its refusal to register the mark given the likelihood of confusion with JJI's prior registration for JOLIE JEWELS®.

17. By using the Accused Marks, EKS creates a false designation of origin as to the source of the jewelry products.

18. EKS actions create a likelihood of confusion and deception as to whether its jewelry products originate with, or sponsored, affiliated, or approved by, JJI.

19. By using the mark JOLEE, EKS commits federal and common law trademark infringement and competes unfairly with JJI.

20. On November 3, 2009, JJI's counsel sent EKS a cease and desist letter demanding that EKS stop using the Accused Marks. Nonetheless, EKS continues its unauthorized use of the marks to compete unfairly with JJI.

**COUNT I**  
**Federal Trademark Infringement**  
**(Violation of 15 U.S.C. § 1114, et seq.)**

21. JJI repeats and realleges each and every allegation contained in paragraphs 1 through 20 as if fully set forth herein.

22. JJI is the owner of federal trademark registrations for the marks JOLIE JEWELS® and JOLIE®.

23. The unauthorized acts of EKS in advertising and promoting its goods as alleged above constitute trademark infringement of JJI's federally registered trademarks in violation of



the Lanham Act, 15 U.S.C. § 1114 et seq., to the substantial and irreparable injury of the public and JJI's business reputation and goodwill.

24. Unless EKS is enjoined from engaging in such unlawful conduct, JJI will continue to suffer irreparable harm and monetary damages and there remains a likelihood that consumers will be misled and confused.

25. JJI has no adequate remedy at law.

**COUNT II**  
**Federal Unfair Competition and False Designation of Origin**  
**(Violation of 15 U.S.C. § 1125(a), et seq.)**

26. JJI hereby realleges and incorporates by reference the allegations of paragraphs 1 through 25 of this Complaint as if fully set forth herein.

27. The aforesaid acts of EKS constitute the intentional use of words, terms, names, symbols and devices and combinations thereof; false designations of origin; and false and misleading representations of fact that are likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection or association with JJI, or as to the origin, sponsorship or approval of EKS's products or other commercial activities by EKS.

28. The aforesaid acts of EKS constitute the use of words, terms, names, symbols and devices and combinations thereof; false designations of origin; and false and misleading representations of fact that in commercial advertising or promotion, misrepresent the nature, characteristics or qualities of EKS's products or other commercial activities.

29. The aforesaid acts of EKS constitute false designation of origin, false and misleading descriptions and representations and false advertising in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

30. The aforesaid acts of EKS have caused, and are causing, great and irreparable harm and damage to JJI, and unless permanently restrained by this Court, said irreparable injury will continue.

31. JJI has no adequate remedy at law.

**COUNT III**  
**(Common Law Unfair Competition)**

32. JJI hereby realleges and incorporates by reference the allegations of paragraphs 1 through 31 of this Complaint as if fully set forth herein.

33. EKS's aforesaid acts are a violation and in derogation of JJI's common law rights and are likely to cause confusion, mistake and deception among consumers and the public as to the source, origin, sponsorship, or quality of EKS's products, and to the extent that EKS does not sell products, EKS's aforesaid acts are likely to cause confusion, mistake and deception among consumers and the public as to EKS's affiliation with or sponsorship by JJI of EKS's aforesaid acts.

34. EKS's aforesaid acts are causing loss, damage and injury to JJI and to the purchasing public.

35. EKS knows, or in the exercise of reasonable care should know, that its conduct is likely to mislead the public.

36. The foregoing conduct by EKS has been knowing, deliberate, willful, intended to cause mistake or to deceive, and in disregard of JJI's rights.

37. As a direct and proximate result of EKS's wrongful conduct, JJI has been and will be deprived of sales of products and services and has suffered a diminution of the value of its JOLIE® brand.

38. The aforesaid acts of EKS constitute unfair competition in violation of common law.

39. The aforesaid acts of EKS have caused and are causing irreparable harm and damage to JJI and, unless permanently restrained by this Court, said irreparable injury will continue.

40. JJI has no adequate remedy at law.

**DEMAND FOR RELIEF**

WHEREFORE, Plaintiff JJI International, Inc. respectfully requests that the Court enter judgment in favor of JJI and against EK Success Ltd. and grant the following relief:

A. The damages sustained as a result of EKS's infringement and unfair competition, in an amount to be ascertained at trial;

B. A trebling of any and all relevant damages awarded, pursuant to 15 U.S.C. § 1117(a);

C. A temporary, preliminary and permanent injunction barring EKS and its officers, agents, servants, employees, and all persons acting on EKS's behalf from engaging in any use of the designation, JOLEE, or any other name or mark confusingly similar to the JOLIE® Marks either alone or in combination with other words or symbols, as a part of any trademark, service mark, trade name, corporate name, assumed name, domain name, web site, e-mail address, or in any other manner in connection with jewelry products;

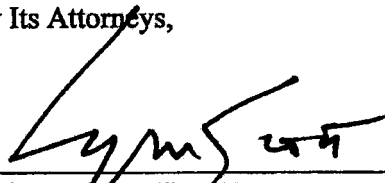
D. An injunction ordering EKS, pursuant to 15 U.S.C.A. § 1118, to deliver up for destruction all literature, signs, prints, advertising materials, stationary, and any other item bearing the Accused Marks, either alone or in combination with other words or symbols, that is published, even if not disseminated publically, for promoting EKS's services;

- E. Cancel the EKS trademark registration for the mark, JOLEE's, and/or direct its assignment to JJI pursuant to 15 U.S.C. § 1119;
- F. An award of Plaintiff's attorneys' fees and costs; and
- G. Such other and further relief the Court may deem just and proper under the circumstances.

**PLAINTIFF HEREBY DEMANDS A TRIAL BY JURY  
FOR ALL ISSUES SO TRIABLE**

JJI INTERNATIONAL, INC.

By Its Attorneys,



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Dated: May 14, 2010