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In the Matter of Application Serial No. 76/447466  
Published in the Official Gazette of April 8, 2003

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TRI VIN IMPORTS, INC., )  
 )  
Opposer, )  
 )  
 )  
vs. )  
 )  
 )  
VINIVAL, S.A.R.L., )  
 )  
 )  
Applicant, )  
 )  
\_\_\_\_\_ )

Opposition No.  
91156850



09-02-2003  
U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

Assistant Commissioner For Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513  
Attn., Box TTAB FEE

OPPOSER'S REPLY TO APPLICANT'S RESPONSE  
IN OPPOSITION TO MOTION TO SUSPEND

Applicant's alleged mark JEAN BALMONT was published for Opposition on April 8, 2003. Pursuant to TMEP §2.101(c), Opposer filed a Notice of Opposition to preserve its rights against the application. Following service of Applicant's Answer, Opposer moved to suspend the opposition proceeding under TBMP §510.02 pending disposition of a previously filed civil action<sup>1</sup>.

\_\_\_\_\_  
<sup>1</sup>Pursuant to a stipulation by the parties (a copy of the electronically filed joint motion is annexed as Exhibit A), the court proceeding has been suspended and the matter has been referred to a federal mediator (a copy of the electronically transmitted order granting the motion is annexed as Exhibit B).

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Applicant affects surprise that “Even though Tri-Vin and its counsel knew of the action pending in Federal Court, they nonetheless filed the subject Notice of Opposition...” Applicant tries to make an issue of the argument that Opposer filed the Notice of Opposition then moved to suspend the proceeding pending resolution of the previously filed civil action. The argument is disingenuous.

Applicant fails to recognize that it was necessary for Opposer to file the subject proceeding in order to preserve its rights against the application. The suspension of the civil action had no effect on the pending application in the Trademark Office. Had Opposer not filed its Notice of Opposition, the application would have proceeded to registration thereby creating a *primaefacae* presumption that Applicant is the owner of the mark JEAN BALMONT. It is clear from the complaint attached to Opposer’s Motion to Suspend, that ownership of the mark is an element of the pending court case and resolution of the case may be dispositive of the Board proceeding. Although the determination whether to suspend a proceeding is discretionary, “[I]t is generally the Board’s policy to suspend when the parties are engaged in such a civil action.” Boyd’s Collection, Ltd. v. Herrington & Company 2003 Lexus TTAB 11 (TTAB 2003).

Applicant’s reliance upon Boyd’s Collection is misplaced. In refusing to suspend the proceeding in Boyd’s Collection the Board noted that the trial of the matter was over. Thus, the Motion to Suspend was inappropriate as there would be “little or nothing” to resume before the Board. In the present case, however, the opposition proceeding is in its early stages. Thus, the Motion to

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Suspend is properly before the Board and should be granted.

Secondly, Applicant does not contest that the issues raised by the opposition are duplicative of issues pending before the civil court. Nor does Applicant deny that resolution of the civil action through federal mediation would be dispositive of the Opposition proceeding. Rather, the thrust of Applicant's opposition to the pending Motion is that a suspension would prevent Applicant from taking discovery which "will be critical to the success of the federal mediation." Thus, Applicant seeks to accomplish through the opposition proceeding, that which it has voluntarily suspended in the civil action.

Further, Applicant asks this Board to deny Opposer's Motion to Suspend until the Federal Court has ruled upon the Motion to Dismiss the civil action<sup>2</sup>; however, Applicant is, again, being disingenuous. The Motion to Dismiss has been tabled pending the federal mediation process<sup>3</sup>. Should the parties reach a resolution through the mediation process, the Motion to Dismiss will be mooted. Moreover, and more importantly for this purpose, should a resolution be reached through mediation, the opposition proceeding will be mooted.

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<sup>2</sup>Opposer points out that the Motion to Dismiss has not been acted upon as a result of the parties' stipulated, and voluntary, request that the civil court remand the matter to federal mediation.

<sup>3</sup>Applicant argues that the outstanding discovery requests "will afford the parties their best chance of resolving their dispute... and will help avert prolonged expensive proceedings in either forum." In fact, that is the purpose of the mediation process.

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Finally, Applicant argues that should the Motion to Dismiss the court case be granted, it would not be dispositive of the opposite proceeding. Should that occur, however, Applicant's remedy is to file a Motion with the Board requesting resumption of these proceedings.

Therefore, the present opposition action was instituted to preserve Opposer's rights against application no. 76/447,466. However, the mediation process in the pending civil action, may resolve the issue of ownership of the trademark. Therefore, the motion to suspend the opposition is properly before the Board and should be granted.

Dated: Edison, New Jersey

September 2, 2003

Respectfully submitted,  
BUCHMAN & O'BRIEN, LLP  
Attorneys for Applicant


By: Paulette R. Carey  
Paulette R. Carey  
510 Thornall St., Suite 200  
Edison, NJ 08837  
(732) 632-9463

09/11/2003 TTAB  
09/11/2003 TTAB

CERTIFICATE OF EXPRESS MAILING

I hereby certify that on September 2, 2003 I served the foregoing Opposer's Reply to Applicant's Response In Opposition to Motion to Suspend by delivering a copy to the United States Post Office, Via Express Mail, postage prepaid in an envelope addressed to:

Box TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3514

  
Lindsey Farina-Bowlin

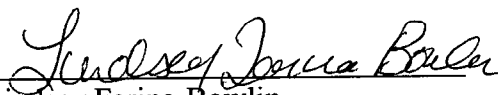
EV098310106US

Express Mail #

CERTIFICATE OF EXPRESS MAILING

I hereby certify that on September 2, 2003 I served the foregoing Opposer's Reply to Applicant's Response In Opposition to Motion to Suspend by delivering a copy to the United States Post Office, Via Express Mail, postage prepaid in an envelope addressed to:

David K. Heasley  
Silverberg, Goldman & Bikoff, LLP  
1101 30<sup>th</sup> Street, N.W., Suite 120  
Washington, D.C. 20007

  
Lindsey Farina-Bowlin

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RECEIVED

IN THE UNITED STATES DISTRICT COURT  
FOR THE DISTRICT OF MARYLAND  
(Southern Division)

VINIVAL, S.A.R.L.

Plaintiff

v.

TRI-VIN IMPORTS, INC.

Defendant

\*  
\*  
\*  
\*  
\*

Civil Action No. DKC 03-CV-33

\* \* \* \* \*

**JOINT MOTION TO REFER THE PARTIES TO  
A UNITED STATES MAGISTRATE JUDGE FOR THE  
PURPOSE OF MEDIATION AND STAY LITIGATION OF  
THE PROCEEDINGS PENDING THE OUTCOME OF THE MEDIATION**

Plaintiff, Vinival, S.A.R.L and Defendant, Tri-Vin Imports, Inc., by and through their undersigned counsel, respectfully request that this Court refer the parties to a United States Magistrate Judge for the purpose of mediation. The parties further request that the litigation of the above-captioned case be stayed pending the outcome of the mediation.

In the event that the case is not resolved through mediation, the parties agree that the stay will be lifted upon the conclusion of the mediation, and Plaintiff's Opposition to Defendant's Motion to Dismiss will be due twenty (20) days after the conclusion of the mediation.

The parties further agree that neither this Joint Motion nor Defendant's participation in mediation shall be construed in anyway as a waiver of any of the arguments raised by Defendant in its Motion to Dismiss.

WHEREFORE, Plaintiff, Vinival, S.A.R.L and Defendant, Tri-Vin Imports, Inc. jointly request that this Court refer the parties to a United States Magistrate Judge for the purpose of mediation and stay litigation of the proceedings pending the outcome of the mediation.







**Carm Jenkins**

From: MDD\_CM-ECF\_Filing@mdd.uscourts.gov

S. Friday, May 09, 2003 5:44 PM

Subject: Activity in Case 8:03-cv-00033-DKC Vinival, S.A.R.L. v. Tri-Vin Imports "Motion to Stay"

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U.S. District Court

District of Maryland

## Notice of Electronic Filing

The following transaction was received from St John, Jason M entered on 5/9/2003 at 5:44 PM EDT and filed on 5/9/2003

Case Name: Vinival, S.A.R.L. v. Tri-Vin Imports

Case Number: 8:03-cv-33

Filer: Tri-Vin Imports, Inc.

Document Number: 14

## Docket Text:

Joint MOTION to Stay Case and Refer Parties to a United States Magistrate Judge For The Purpose of Mediation by Tri-Vin Imports, Inc.. Responses due by 5/27/2003 (Attachments: # (1) Text of Proposed Order)(St John, Jason)

The following document(s) are associated with this transaction:

Document description: Main Document

Original filename: n/a

Electronic document Stamp:

[STAMP dcecfStamp\_ID=1046883720 [Date=5/9/2003] [FileNumber=129800-0]  
[286f3435d1adac90628aa210ef1894e899f75593e019c7c61e3ecc3b08ae34100c912  
9757925d14781805c208b5affa890dcd707f7841e5bb8647a18f968f8c3]]

Document description: Text of Proposed Order

Original filename: n/a

Electronic document Stamp:

[STAMP dcecfStamp\_ID=1046883720 [Date=5/9/2003] [FileNumber=129800-1]  
[a3fb9ac6cd534a0dacda48464a82c45c1bd8d3c6150b4a383c7f58441ada9b4d62490  
86cf38d3cb1642a61120bfee29501e8d95a5a69980921d6d9a594ddf4bb]]

8:03-cv-33 Notice will be electronically mailed to:

David K Heasley dheasley@sbgdc.com

Cynthia L Leppert CLL@nqgrg.com

Jason M St John jms@nqgrg.com

8:03-cv-33 Notice will not be electronically mailed to:

5/19/2003

**Carm Jenkins****From:** MDD\_CM-ECF\_Filing@mdd.uscourts.gov**Sent:** Monday, May 12, 2003 11:00 AM**Subject:** Activity in Case 8:03-cv-00033-DKC Vinival, S.A.R.L. v. Tri-Vin Imports "Order on Motion to Stay"

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U.S. District Court

District of Maryland

## Notice of Electronic Filing

The following transaction was received from Chasanow, Deborah entered on 5/12/2003 at 10:59 AM EDT and filed on 5/12/2003

**Case Name:** Vinival, S.A.R.L. v. Tri-Vin Imports**Case Number:** 8:03-cv-33**Filer:****Document Number:** 15**Docket Text:**

Paperless ORDER granting [14] Motion to Stay the case pending settlement negotiations. A separate referral will be entered. In the event the case does not settle, plaintiff's opposition to defendant's motion to dismiss will be due twenty (20) days after the conclusion of the mediation. Signed by Judge Deborah K. Chasanow on 5/12/03. (Chasanow, Deborah)

The following document(s) are associated with this transaction:

**8:03-cv-33 Notice will be electronically mailed to:**

David K Heasley dheasley@sbgdc.com

Cynthia L Leppert CLL@nqgrg.com

Jason M St John jms@nqgrg.com

**8:03-cv-33 Notice will not be electronically mailed to:**

5/19/2003

TTAB

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\*\*\* ALSO ADMITTED IN NY, CA  
• ONLY ADMITTED IN NY, FL, DC  
•• ONLY ADMITTED IN NY



September 2, 2003

09-02-2003  
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Box TTAB NO FEE  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Va 22202-3514

Re: Opposition No.91156850  
Tri Vin Imports, Inc. v.  
Vinival, S.A.R.L.,

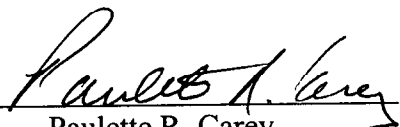
Dear Sir:

On behalf of Opposer, Tri Vin Imports, Inc., we submit the enclosed Opposer's Reply to Applicant's Response In Opposition to Motion to Suspend.

Kindly acknowledge receipt of the document by stamping and returning the enclosed stamped self-addressed post card.

Cordially,

BUCHMAN & O'BRIEN, LLP

By:   
Paulette R. Carey