

ESTTA Tracking number: **ESTTA249616**

Filing date: **11/18/2008**

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

Proceeding	91185615
Party	Defendant za za zsu
Correspondence Address	W. Swain Wood WOOD LAW FIRM PLLC 301 Glenwood Avenue, Suite 2800 Raleigh, NC 27603 UNITED STATES swain@woodcolaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	W. Swain Wood
Filer's e-mail	swain@woodcolaw.com
Signature	/s/ W. Swain Wood
Date	11/18/2008
Attachments	Motion to Suspend.pdf ( 4 pages )(93886 bytes ) File-stamped Complaint.pdf ( 6 pages )(109640 bytes )

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

S. CLAUDIA KOCH, d/b/a,	)	
ZAZOU,	)	
	)	
Opposer,	)	
	)	Opposition No. 91185615
v.	)	
	)	Serial No. 77245292
ZA ZA ZSU,	)	
	)	
Applicant.	)	

**MOTION TO SUSPEND PROCEEDINGS AND BRIEF IN SUPPORT**

Applicant Za Za Zsu, LLC (“Applicant”), pursuant to 37 C.F.R. § 2.117 and TBMP Rule 510.02(a), respectfully submits the following Motion to Suspend these proceedings pending the disposition of a recently commenced civil action between the parties in the United States District Court for the Middle District of North Carolina which may have a bearing on this proceeding. In support of its Motion, Applicant states the following:

1. Opposer commenced this action by filing its Notice of Opposition on or about August 2, 2008. Among Opposers grounds for relief is the claim that registration of Applicant’s “Za Za Zsu” mark (“Za Za Zsu Mark”) would harm Opposer because it is allegedly confusingly similar to Opposer’s unregistered “Zazou,” “Zazousac,” and “Zazouluxe” marks (“Opposer’s Marks”).

2. Opposer alleges in its Notice of Opposition that use by Applicant of its Za Za Zsu Mark causes a likelihood of consumer confusion, mistake, or deception as to the connection, sponsorship, or approval of Applicant’s goods and services by Opposer, and

that such confusion allegedly will damage Opposer and result in lost sales. *See Notice of Opp.* at ¶¶ 12-13, 18.

3. Applicant recently commenced a civil action against Opposer in the United States District Court for the Middle District of North Carolina (“MDNC”), alleging that there is no likelihood of confusion between Applicant’s Mark and Opposer’s Mark, and seeking declaratory judgment that Applicant’s use of the Za Za Zsu Mark therefore does not infringe any trademark rights of Opposer. A true and correct copy of Applicant’s Complaint for Declaratory Judgment in the federal court civil action is attached hereto as Exhibit A.

4. 37 C.F.R. § 2.117(a) provides in relevant part that “whenever it shall come to the attention of the [TTAB] that a party or parties to a pending case are engaged in a civil action . . . which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action[.]” *See also* TBMP § 510.02(a).

5. Disposition of the pending MDNC civil action will directly impact this Opposition proceeding because it will resolve the issue of whether there is a likelihood of confusion between Plaintiff’s Mark and Opposer’s Marks, and whether Plaintiff’s use of the Za Za Zsu Mark therefore violates Defendant’s trademark rights.

6. The issue of whether there is a likelihood of confusion is central to this registration proceeding. *See* 15 U.S.C. § 1052(d)(likelihood of confusion may be grounds for refusing registration). In its Notice of Opposition, Opposer expressly alleges such supposed likelihood of confusion as grounds for denying Applicant’s registration. *See Notice of Opp.* ¶¶ 12-13, 18.



**CERTIFICATE OF SERVICE**

I hereby certify that on this date the foregoing Motion was served upon Opposer's counsel of record by depositing a copy thereof with the United States Postal Service, addressed as follows, and by electronic mail:

Megan E. Gray  
Gray Matters  
2017 Kalorama Road, N.W. #3  
Washington, DC 20009  
Telephone: (202) 265-2738  
[mg@megangray.com](mailto:mg@megangray.com)

This the 18<sup>th</sup> day of November, 2008.

/s/ W. Swain Wood  
W. Swain Wood  
Attorney for Applicant

WOOD LAW FIRM PLLC  
301 Glenwood Avenue, Suite 280  
Raleigh, NC 27603  
Telephone: (919) 829-7394  
Facsimile: (919) 829-7396  
[swain@woodcolaw.com](mailto:swain@woodcolaw.com)

UNITED STATES DISTRICT COURT  
FOR THE MIDDLE DISTRICT OF NORTH CAROLINA

ZA ZA ZSU, LLC )  
 )  
 Plaintiff, )  
 )  
 vs. ) CIVIL ACTION NO. \_\_\_\_\_  
 )  
 S. CLAUDIA KOCH, d/b/a ZAZOU, )  
 )  
 Defendant. )  
 )  
 )  
 )

**COMPLAINT FOR  
DECLARATORY JUDGMENT**

Plaintiff Za Za Zsu, LLC (“Plaintiff”) brings this action against Defendant S. Claudia Koch, d/b/a Zazou, for declaratory judgment, alleging and saying as follows:

**NATURE OF THIS ACTION**

1. This action seeks a declaratory judgment that Plaintiff’s use of the term “Za Za Zsu” in commerce as its company name in promotional and marketing materials does not infringe on any valid trademark rights of Defendant. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*; the trademark laws of the United States, 15 U.S.C. § 1051 *et seq.*; and the laws of North Carolina.

**PARTIES, JURISDICTION AND VENUE**

2. Plaintiff Za Za Zsu, LLC (“Plaintiff”) is a company organized and existing under the laws of the State of North Carolina, with its principal place of business at 705 Ninth Street, Durham, North Carolina 27705.

3. Upon information and belief, Defendant S. Claudia Koch (“Defendant”) is an individual resident of the State of California doing business under the name “Zazou,”

with a principal place of business at 2249 Fifth Street, Berkeley, California 94708.

Defendant may be served with process at that address. Defendant sells scarves and gloves under the name “Zazou.”

4. Defendant conducts significant business activity within the State of North Carolina, including within this judicial district, and is subject to the jurisdiction of this Court. Defendant promotes and sells substantial amounts of “Zazou”-branded products within this State and within this district. Defendant also advertises its products and services on an interactive internet website and, upon information and belief, receives substantial traffic from and makes substantial sales to North Carolina-based customers through that website.

5. This Court has jurisdiction over Plaintiff’s claims pursuant to 28 U.S.C. §§ 1331, 1338(a) and 1367.

6. Venue is proper in this Court pursuant to 28 U.S.C. § 1391 because a substantial part of the events or omissions giving rise to the claim have occurred in this judicial district.

### **FACTS**

7. Plaintiff’s business consists primarily of the retail promotion and sale of women’s clothing and fashion accessories of a wide variety of brands. Plaintiff’s services, based at its retail location in Durham, North Carolina, include the selection, promotion, and sale of unique and fashionable women’s clothing and related accessories through its retail location, through the mail, telephone orders, and the internet.

8. Plaintiff selected the fanciful term “Za Za Zsu” (“Plaintiff’s Mark” or “Za Za Zsu Mark”) for its business and began doing business under that name in or about

2005. Since that time, Plaintiff has devoted substantial amounts of time, money, and effort in marketing and promoting its products under the Za Za Zsu Mark. As a result of these efforts, Plaintiff has developed substantial customer recognition and goodwill in North Carolina and elsewhere under the name “Za Za Zsu.”

9. Defendant, through counsel, has asserted in numerous communications with Plaintiff that Defendant possesses exclusive trademark rights in the terms “Zazou,” “Zazouluxe,” and “Zazousac” (“Defendant’s Marks”), and that Plaintiff’s use of the term “Za Za Zsu” in connection with its business creates a likelihood of consumer confusion and infringes upon Defendant’s alleged trademark rights. Defendant at one time possessed federal trademark registrations for Defendant’s Marks, but those registrations were subsequently cancelled by the United States Patent and Trademark Office (“USPTO”). Defendant has demanded that Plaintiff cease using Plaintiff’s Mark in connection with Plaintiff’s products and services and has asserted that Defendant is entitled to monetary damages for Plaintiff’s past use of its Plaintiff’s Mark.

10. Defendant’s claims of likelihood and confusion and trademark infringement are meritless. There is no likelihood of confusion between Plaintiff’s Marks and Defendant’s alleged Marks. Among other factors, Plaintiff’s Mark and Defendant’s alleged Marks are dissimilar, and the parties sell dissimilar goods and services through different channels of trade to different target consumers. Furthermore, in adopting the Za Za Zsu Mark, Plaintiff had no intent to trade on any reputation or goodwill that Defendant may have established in connection with Defendant’s alleged Marks.

11. On or about August 2, 2007, prior to being contacted by or even knowing of Defendant, Plaintiff filed an application with the USPTO (Application No. 77245292)

seeking to register the “Za Za Zsu” trademark for use in connection with retail store services featuring women’s clothing, jewelry, handbags, and accessories.

12. On or about April 8, 2008, the USPTO published Plaintiff’s “Za Za Zsu” Mark for opposition. Defendant filed a Notice of Opposition to Plaintiff’s Mark on or about August 5, 2008. Defendant’s Notice of Opposition alleged, among other things, that Defendant possesses unregistered trademark rights in Defendant’s Marks, and that Plaintiff’s Za Za Zsu Mark so resembles Defendant’s Marks as to be likely, when used by Plaintiff, to cause confusion or mistake or to deceive as to Plaintiff’s affiliation, connection, association or origin with, or sponsorship or approval by Defendant.

13. Defendant, through counsel, has repeatedly threatened to bring legal action against Plaintiff for trademark infringement.

14. As of the date of filing of this Complaint, there are no active settlement discussions ongoing between the parties.

15. As a result of Defendant’s repeated threats of bringing a trademark infringement action against Plaintiff, Plaintiff is under an imminent threat of litigation, is insecure in its rights, and is in need of a judicial declaration of the scope of its rights and those of Defendant, if any, in the term “Za Za Zsu.”

**FIRST CLAIM FOR RELIEF**  
**(Declaration of Non-Infringement Under Federal or State Law)**

16. The allegations in the preceding paragraphs of this Complaint are incorporated by reference as if fully set forth herein.

17. Defendant has repeatedly asserted that Plaintiff’s use of the term “Za Za Zsu” in connection with its retail women’s clothing business causes a likelihood of consumer confusion as to the source, origin, sponsorship, approval, affiliation,

connection, or association of Plaintiff's products by Defendant and violates Defendant's alleged trademark rights.

18. Plaintiff's use of the Za Za Zsu Mark in connection with its business is not likely to cause confusion, to cause mistake, or to deceive as to the affiliation, connection, or association of Plaintiff or its clothing with Defendant or its goods and services, or as to the source, origin, sponsorship, or approval of Plaintiff's goods by Defendant.

19. Plaintiff's use of Za Za Zsu Mark does not violate Defendant's legal rights under the federal Lanham Act, 15 U.S.C. § 1125(a), or under state law, and does not constitute trademark infringement, unfair competition, or unfair and deceptive trade practices.

20. An actual and justiciable controversy exists between Plaintiff and Defendant as to the non-infringement of Defendant's alleged Marks by Plaintiff's use of the Za Za Zsu Mark in connection with the offering and sale of its products and services. Pursuant to 28 U.S.C. § 2201, Plaintiff is entitled to a declaration of the rights and legal relations of the parties based on the foregoing and is entitled to a declaratory judgment that its use in connection with business of the Za Za Zsu Marks does not violate Defendant's rights and that Defendant is without right or authority to maintain a suit against Plaintiff for alleged trademark infringement, unfair competition, deceptive trade practices, or related causes of action under federal or state law based on such use.

WHEREFORE, Plaintiff respectfully requests:

1. That the Court declare and adjudicate, pursuant to 28 U.S.C. §§ 2201 and 2202, the respective rights and relations of the parties with respect to the matters in dispute, including a declaration that Plaintiff's use in connection with its business of the

term “Za Za Zsu” does not violate any trademark rights of Defendant under the federal Lanham Act, 15 U.S.C. § 1051 *et seq.* or under state law;

2. That Plaintiff recover of Defendant its costs and reasonable attorneys’ fees in this action;

3. That Plaintiff have and receive a jury trial on all issues so triable; and

4. That the Court grant such further relief as it may deem just and proper.

Respectfully submitted this the 18<sup>th</sup> day of November, 2008.

By: *s/ W. Swain Wood*  
W. Swain Wood  
N.C. State Bar No. 32037  
J. Christopher Jackson  
N.C. State Bar No. 26916  
WOOD LAW FIRM PLLC  
301 S. Glenwood Avenue, Suite 280  
Raleigh, NC 27603  
Telephone: (919) 829-7394  
Facsimile: (919) 829-7396  
*Email: swain@woodcolaw.com*

COUNSEL FOR PLAINTIFF