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

Proceeding no.	92078410
Party	Defendant JEAN ROYERE SAS
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Date	04/13/2022
Attachments	Reply ISO Motion to Suspend.pdf(127657 bytes) REPLY ISO MTION TO SUSPEND - EXHIBIT 1 DECLARATIONS OF NON-SERVICE.pdf(202139 bytes)

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

EDITION MODERN)	Cancellation No.: 92078410
)	Registration No.: 6197569
Petitioner,)	Mark: JEAN ROYERE
)	
v.)	
)	
JEAN ROYERE SAS)	
)	
Registrant)	
)	

REGISTRANT’S REPLY IN SUPPORT OF MOTION FOR
SUSPENSION PENDING CIVIL ACTION

Absent **unusual circumstances**, the Board typically suspends proceedings where a civil action may have a bearing on issues before the Board. TBMP § 510.02(a) (emphasis added).

Here, no “unusual circumstances” exist to otherwise deny Registrant’s suspension request – only baseless conjecture¹ and inferences² by Petitioner. Such speculations – at

¹ Petitioner served their first set of discovery requests (including requests for admissions, documents and things, and interrogatories) on the same day they served initial disclosures. Pursuant to the parties’ agreement, Registrant timely responded to this first set of discovery requests on March 3, 2022. Three business days thereafter, on March 8, 2022, Registrant produced responsive documents. At that time, counsel for Registrant suggested, and counsel for Petitioner agreed, to wait until after the latter had time to review the production before leveraging accusations of non-compliance. Not surprisingly, Petitioner makes no reference to these post-production communications in its opposition. *Nothing was heard further from Petitioner regarding discovery until 1 day before they filed their opposition to this motion*—in an obvious effort to conjure a “faux discovery dispute” as false grounds for their opposition.

² Registrant has not been able to serve its federal complaint because Petitioner is either (1) evading service; or (2) has provided erroneous information regarding its agent for service to the California Secretary of State. See attached Exhibit 1, Declarations regarding non-service. As a result, Registrant’s counsel in the civil action has requested that Petitioner’s counsel in this proceeding accept service. As of the date of the filing of this Reply, counsel has not responded to this request. Petitioner’s insinuation that Registrant only filed a federal complaint alleging numerous counts of intellectual property infringement to avoid discovery is dishonest and absurd.

best – are woefully insufficient to refute a request for suspension. The Court's finding on Registrant's trademark infringement claim will dispose of the priority and likelihood of confusion claims before the Board *in their entirety*.

Indeed, included in Registrant's prayer for relief from the current civil action is dismissal of this cancellation proceeding with prejudice. (See DKT 5, pp. 25 & 29) The civil action also seeks redress for, amongst others, copyright and trade dress infringement and false endorsement (collectively "Infringement Claims"). These Infringement Claims each support Registrant's affirmative defense that Petitioner is barred by the doctrine of unclean hands from alleging any ownership in or use of the JEAN ROYERE name. Thus, not only will the subject civil action have direct bearing on this case, its resolution will dispose of this proceeding entirely.

In Opposition, Petitioner's truncated citation to *Rhoades v. Avon Products* is not applicable and frankly, is misleading. The full quote by the Ninth Circuit in *Rhoades* states:

"...some situations might justify deferring a declaratory judgment case when related TTAB proceedings are pending; specifically, where the "district court action **involves only the issue of whether a mark is entitled to registration,**" it might make more sense to resolve the registration claims at the TTAB first. See *id.*, at 853–54. **On the other hand, if, as here, a potential infringement claim "requires the district court to resolve much or all of [the registration issues], it would waste everyone's time not to settle the registration issue now [, in district court]."** *Rhoades*, 504 F.3d 1151, 1165 citing *PHC v. Pioneer Healthcare*, 75 F.3d 75, 81 (1st Cir.1996) (emphasis added).

This is not “*some situation*” of only declaratory relief being sought in a District Court civil action. To the contrary, the civil action involves multiple claims of copyright, trademark, and trade dress infringement, false endorsement and, finally, of declaratory judgment.

Further, the Infringement Claims are not distinct from Petitioner’s trademark ownership claim—nor has Petitioner attempted to define how such a “distinction” even exist. To wit, if the federal court finds that Petitioner infringed Registrant’s proprietary Jean Royere’s designs and trade dress, then it must also find that Petitioner’s use of the Jean Royere name is unlawful. This is not a case involving a random word—the mark at issue is the name of a famous furniture designer, the rights to which are owned and controlled by his Estate.

It stands to reason then, the broader, inclusive claims at issue in the civil action – and an eventual decision there on infringement – will necessarily act to resolve a more limited issue of registration now before the Board. On this point, the Board is specifically not authorized to determine, for example, the right to use, nor may it decide broader questions of infringement or unfair competition. TBMP § 102.01; *General Mills Inc. v. Fage Dairy Processing Industry SA*, 100 USPQ2d 1584, 1591 (TTAB 2011) (no authority to determine the right to use, or the broader questions of infringement, unfair competition, damages or injunctive relief); *McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 USPQ2d 1212, 1216 (TTAB 2006) (“[T]he Board’s jurisdiction is limited to determining whether trademark registrations should issue or whether registrations should be maintained; it does not have authority to determine whether a party has engaged in criminal or civil wrongdoings.”), *aff’d unpub’d*, 240 F.

App'x 865 (Fed. Cir. July 11, 2007), cert. denied., 552 U.S. 1109 (2008); *Carano v. Vina Concha Y Toro S.A.*, 67 USPQ2d 1149, 1151-52 (TTAB 2003) (no jurisdiction to determine copyright infringement; opposer's claim that applicant neither owns nor is entitled to use mark was not separable from opposer's copyright claim).

There is no prejudice — and Petitioner has not argued any — if this proceeding is suspended. At the time of Registrant's filing of this request to suspend, four-plus (4+) months remain in the discovery schedule. Any claim of perceived "delay" is therefore disingenuous. More importantly, it is immaterial in evaluating whether suspension pending the civil action is appropriate.

Judicial economy is satisfied by a stay of this proceeding where, as here, it would conserve party and judicial resources and avoid potentially inconsistent judgments.

Dated: April 12, 2022

Respectfully Submitted,

By: /amanda dwight/
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Certificate of Service

The undersigned hereby certifies that on April 13, 2022, a copy of the foregoing *Registrant's Reply In Support of Motion for Suspension Pending Civil Action* was served on Petitioner' attorney of record, by electronic mail, addressed as follows:

Edward D Lanquist, Jr.
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Dated: April 13, 2022

By: /s/Amanda V. Dwight
Amanda V. Dwight

DECLARATION OF NON-SERVICE

CASE NAME: **JEAN ROYERE SAS, a French business entity; et al.**
 v.
EDITION MODERN, a California corporation; et al.

CASE NUMBER: **2:22-cv-1507 DMG (JPRx)**

We are and were on the dates herein mentioned, over the age of 18 years and not a party to the action. We received the within process on **March 7, 2022** and after due diligent effort, we have been unable to effect personal service of the following documents on the within named: **SUMMONS; COMPLAINT; CIVIL COVER SHEET; PLAINTIFFS' FRCP RULE 7.1 AND LOCAL RULE 7.1-1 DISCLOSURE STATEMENT; REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK; REPORT ON THE FILING OR DETERMINATION OF AN ACTION OR APPEAL REGARDING A COPYRIGHT; NOTICE OF ASSIGNMENT TO UNITED STATES JUDGES; NOTICE TO PARTIES OF COURT-DIRECTED ADR PROGRAM; NOTICE TO COUNSEL RE CONSENT TO PROCEED BEFORE A UNITED STATES MAGISTRATE JUDGE; INITIAL STANDING ORDER**

Name: **EDITION MODERN, a California corporation**

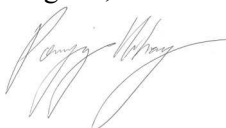
Residence Address: **3268 Midvale Avenue
 Los Angeles, California 90034**

Dates and times of attempts with reported details are listed below.

Date	Time	Location	Server	Result
03/08/22	6:48 p.m.	Residence	Poeu Chhay	I arrived at the address given for service of process. The address corresponds to a residence. The lights inside the residence were on. I knocked on the door a couple of times but received no answer. There was a mail detected on the floor addressed to Edition Modern. No activity was detected.
03/09/22	7:42 p.m.	Residence	Joshua Feria	I arrived at the address given for service of process. I knocked on the door a couple of times but received no answer. The lights inside the residence were on. The package addressed to Edition Modern was in the porch by the door. There were no vehicles detected.
03/13/22	5:52 p.m.	Residence	Joshua Feria	I arrived at the address given for service of process. I knocked on the door a couple of times but received no answer. The same package was still at the same spot. It appears no one has been at this location for a while. No activity was detected.

We declare under penalty of perjury that the foregoing is true and correct. Executed this **5th** day of **April 2022** at **Los Angeles, California**.

Process Server for
Ace Attorney Service, Inc.
 811 Wilshire Boulevard, Suite 900
 Los Angeles, California 90017



Poeu Chhay



Joshua Feria

