

## **REQUEST TO LIFT SUSPENSION**

On January 21, 2013, the Examining Attorney issued a Notice of Suspension in connection with Application Serial No. 85/762,536 for Applicant's mark MAJESTIC for "jewelry" ("Applicant's Mark") on the grounds that Applicant's Mark may be refused registration if Application Serial No. 77/776,779 for MAJESTIC, originally for "jewelry; pearls", and Application Serial No. 77/779,710 for MAJESTIC PEARL, originally for "pearls" (collectively, the "Cited Applications") mature into registrations. Applicant notes in passing that the specifications of the Cited Applications have both been altered by the December 16, 2013 order of the Trademark Trial and Appeals Board (attached as Exhibit A) to read "pearls, excluding pearl jewelry".

In accordance with an Order of the United States District Court for the Southern District of New York (attached as Exhibit B) the owner of the Cited Applications has executed an agreement specifically consenting to Applicant's registration of Applicant's Mark (attached as Exhibit C). Furthermore, the Trademark Trial and Appeals Board's December 16, 2013 Order directs Applicant to file the Consent first with the Trademark Examining Unit, and then with the Board itself.

In light of these Orders and the Consent, Applicant now respectfully requests that the suspension of examination of its Application be lifted and that the Cited Applications be removed as potential obstacles to registration of Applicant's mark.

# **Exhibit A**

**UNITED STATES PATENT AND TRADEMARK OFFICE**  
**Trademark Trial and Appeal Board**  
**P.O. Box 1451**  
**Alexandria, VA 22313-1451**

CME/dmd

Mailed: December 16, 2013

Opposition No. 91197824  
Opposition No. 91198210

Perfect Pearl Co., Inc.  
d/b/a Majestic Pearl Co.

v.

Majestic Pearl & Stone Inc.

**By the Trademark Trial and Appeal Board:**

Although not consolidated by way of this order, for administrative convenience, we issue a joint order with respect to these opposition proceedings.

On September 30, 2013, the Board issued a joint order in these proceedings allowing applicant thirty days to show cause why the Board should not take the following action to give effect to a November 30, 2012 decision of the United States District Court for the Southern District of New York in a case involving the parties, *Perfect Pearl Co. v. Majestic Pearl & Stone, Inc.*, Case No. 10-cv-3998:

1. amend application Serial No. 77776779 involved in Opposition No. 91197824 from "jewelry; pearls" to "pearls, excluding pearl jewelry";
2. enter judgment in favor of opposer in Opposition No. 91197824 with respect to "jewelry";

Opposition No. 91198210 and 91197824

3. amend application Serial No. 77779710 involved in Opposition No. 91198210 from "pearls" to "pearls, excluding pearl jewelry"; and
4. suspend the oppositions to allow the parties time to execute and file with the Trademark Examining Operation an agreement indicating applicant's consent to the registration of opposer's application Serial No. 85762536 and for the Trademark Examining Operation to consider the consent agreement.

No response having been received to the Prior Order:

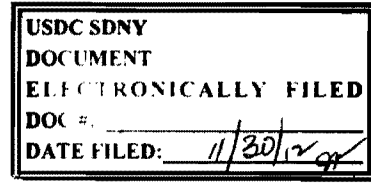
1. application Serial No. 77776779 is amended from: "jewelry; pearls" **to:** "pearls, excluding pearl jewelry" in International Class 14, and judgment is entered against applicant and in favor of opposer with respect to "jewelry." Opposition No. 91197824 remains pending with respect to application Serial No. 77776779 as amended herein;
2. application Serial No. 77779710 is amended from: "pearls" **to:** "pearls, excluding pearl jewelry" in International Class 14; and
3. opposition Nos. 91197824 and 91198210 are suspended.  
**The parties are allowed until SIXTY DAYS from the mailing date of this order in which to file** with the Trademark Examining Operation an agreement indicating applicant's consent to the registration of opposer's application Serial No. 85762536. **Within THIRTY DAYS**

Opposition No. 91198210 and 91197824

of the Trademark Examining Operation acting on the  
consent agreement, the parties shall so notify the  
Board so that the Board may take appropriate action in  
these proceedings.

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# **Exhibit B**



UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF NEW YORK

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PERFECT PEARL CO., INC., :
  
:
  
Plaintiff, : 10 Civ. 3998 (PAE)
  
:
  
-v- : ORDER
  
:
  
MAJESTIC PEARL & STONE, INC., :
  
:
  
Defendant. :
  
:
  
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PAUL A. ENGELMAYER, District Judge:

On November 15, 2012, the Court received a motion from the defendant Majestic Pearl & Stone, Inc., asking the Court to amend or alter the judgment and permanent injunction issued on October 18, 2012. On November 16, 2012, the Court issued an order directing defendant to submit a proposed revised judgment and permanent injunction, and directing plaintiff Perfect Pearl Co., Inc. to respond to that submission.

The Court has reviewed the papers submitted by the parties. In the interest of clarity, the Court has modified the wording of its judgment and permanent injunction.

The judgment and permanent injunction now is as follows:

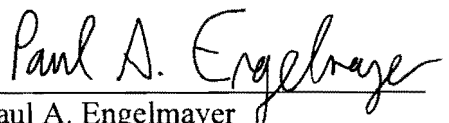
1. Defendant and Defendant’s officers, agents, servants, employees, and attorneys and those persons in active concert or participation with them are hereby permanently enjoined from:
  - A. Using the trademarks MAJESTIC and MAJESTIC PEARL, or any other trademark likely to cause confusion with those marks, on or in connection with the offer for sale or sale of pearl jewelry; however, this does not prevent defendant from using those trademarks in connection with the sale of items other than pearl jewelry, *e.g.*, loose pearls and beads;
  - B. Using any trademark which may be calculated to falsely represent or which has the effect of falsely representing that the products or services of Defendant or third parties are sponsored by, authorized by, or in any way associated with Plaintiff;
  - C. Otherwise infringing Plaintiff’s MAJESTIC or MAJESTIC PEARL trademarks, including, without limitation, using those marks, or any corporate or trade name containing the word “MAJESTIC” or any derivative of that

word, in connection with the offer for sale or sale of pearl jewelry; however, this does not prohibit Defendant from continuing to use its corporate or trade name for purposes other than in connection with the offer for sale or sale of pearl jewelry;

- D. Falsely representing themselves as being connected with Plaintiff, or sponsored by or approved by or associated with Plaintiff or engaging in any act which is likely to falsely cause the trade, retailers, and/or members of the purchasing public to believe that Defendant is, in any way, associated with Plaintiff, and;
  - E. Misusing the statutory registration symbol, ®, in connection with the sale of any product, or otherwise indicating that Defendant owns a Registration for MAJESTIC or MAJESTIC PEARL that it does not own.
2. Defendant shall consent to the registration by Plaintiff of the trademark MAJESTIC and/or MAJESTIC PEARL for jewelry and shall promptly execute any document reasonably required by Plaintiff to evidence such consent.
  3. This judgment shall be entered without the award of damages to either party. Each party shall bear its own costs and attorney's fees.

The Clerk of Court is directed to terminate the motion at docket number 105, and to close this case.

SO ORDERED.

  
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Paul A. Engelmayer  
United States District Judge

Dated: November 30, 2012  
New York, New York



# **Exhibit C**

UNITED STATES PATENT AND TRADEMARK OFFICE

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In re MAJESTIC  
U.S. TRADEMARK APPLICATION  
SERIAL NO.: 85/762,536

Applicant: Perfect Pearl Co., Inc.

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**CONSENT**

Pursuant to the November 30, 2012 Order of the United States District Court for the Southern District of New York in *Perfect Pearl Co., Inc. v. Majestic Pearl & Stone, Inc.*, Civil Action No. 10 Civ. 3998 (PAE), Majestic Pearl & Stone Inc. hereby consents to the registration by Perfect Pearl Co., Inc. of the trademarks MAJESTIC and MAJESTIC PEARL in connection with jewelry, including without limitation, registration of Application Serial No. 85/762,536.

IN WITNESS WHEREOF, Majestic Pearl & Stone, Inc. has caused this Consent to be executed below by its duly authorized representative.

MAJESTIC PEARL & STONE, INC.

By: 

Panagiota Betty Tufariello

Attorney for Majestic Pearl & Stone, Inc.

Dated: July 28, 2014  
Mount Sinai, New York