

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

Attorney Docket: T-59135

Applicant : The Swatch Group Management Services AG
(The Swatch Group Management Services SA)
(The Swatch Group Management Services Ltd.)
Serial No. : 75/485,977
Filed : May 15, 1998
Mark : PIERRE BALMAIN

TO THE TRADEMARK TRIAL AND APPEAL BOARD:



06-09-2005

U.S. Patent & TMO/TM Mail Rcpt Dt. #11

MOTION TO SUSPEND APPEAL

The Applicant respectfully requests that the appeal in the instant matter be suspended for extraordinary circumstances. 37 C.F.R. 2.117

The Applicant's mark has been refused based upon the existence of a prior registered mark. The Applicant is in privity of contract with that cited trademark owner. Indeed a prior consent agreement has already been made of record in the U.S. Patent and Trademark Office, however, the Examiner has found the previous document to be unsatisfactory and the Applicant has been engaged in the process of obtaining an additional letter of consent from the cited registrant.

As shown in the attached Declaration of Jess M. Collen, an ongoing dialog has occurred with the cited registrant's attorneys. As set forth in further detail in the Request for Reconsideration and the accompanying Declaration, counsel for the registrant advised

that the company was in bankruptcy and that her firm no longer represented the registrant (please see the attached).

The registrant's former attorneys further advised that the attorney who had been working with the registrant was no longer in that firm's employ.

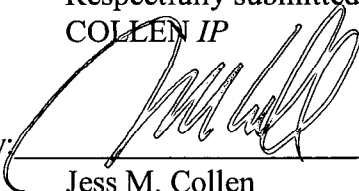
The Applicant has now advised its attorneys that the registrant's company is still in business and advises that there are ongoing contacts with that company, the registrant, Pierre Balmain. It has further now been shown that the information provided by the registrant's American (former) attorney of record is inaccurate. Further still, the Applicant is in the process of directly contacting the registrant's counsel which is, like the Applicant, located in Europe, to obtain the agreement (See Declaration of Josiane Citiso).

In light of the best efforts of the Applicant to secure a further co-existence agreement to which the registrant is contractually bound to supply, it would serve no useful purpose to force the Applicant to appeal this issue. Due to circumstances unexplainable in part, (namely the comments of registrant's U.S. former attorney of record), and the conflicting information that the Applicant has now provided, there is no dispute for the Board to resolve in this appeal; the only issue appears, under current facts, to be essentially moot.

Therefore, the Applicant moves for a reasonable period of time for the Applicant to file an appeal brief or preferably for the Board to suspend for a reasonable period of time, to permit the parties to conclude the necessary agreement, which would further the interests of the economy and fairness.

Respectfully submitted,
COLLEN IP

By: _____


Jess M. Collen
Telephone: (914) 941-5668
The Applicant's attorney

JMC/SEG:

Dated: June 6, 2005

Enclosures: Jess Collen Declaration
Josiane Citiso Declaration
Request for Reconsideration and Attachments

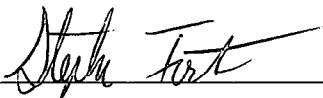
COLLEN IP
Intellectual Property Law, P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Town of Ossining
Westchester County, New York 10562

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL, POSTAGE PREPAID IN AN ENVELOPE ADDRESSED TO: TRADEMARK TRIAL AND APPEAL BOARD, BOX- NO FEE, BOX 1451, ALEXANDRIA, VIRGINIA 22313-1451.

COLLEN IP Intellectual Property Law

BY: _____



Date: June 6, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
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TO THE TRADEMARK TRIAL AND APPEAL BOARD:

DECLARATION OF JESS M. COLLEN

I, Jess M. Collen, enclose a declaration which was previously submitted to the Trademark Examining Attorney, which I executed under penalty of perjury.

I further state that I have been advised by the Applicant itself that there is a lawyer in Paris, France, with the company, Pierre Balmain, S.A., Mrs. Valerie Veysseyre-Constant, which is now able to provide a new letter of consent upon our request.

As shown in the further declaration of Mrs. Josiane Citiso, the French company, Pierre Balmain S.A. was known to have had financial difficulties, but the situation seems now to have been remedied.

It is further anticipated that such an agreement could be obtained and signed within the next 180 days.

I declare under penalty of perjury under the laws of the United States of America that all statements made herein are true and any statements made on information and belief are believed to be true and any willful false statements so made are punishable under Title 18 section 1001 of the United States Code.



Jess M. Collen

Dated: 6/6/05

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

Attorney Docket T-59135

Applicant : The Swatch Group Management Services AG
(The Swatch Group Management Services AS)
(The Swatch Group Management Services Ltd.)
Serial No. : 75/485,977
Filed : May 15, 1998
Mark : PIERRE BALMAIN


Examining Attorney : Linda M. Powell
Law Office : 106

DECLARATION OF JOSIANE CITSO

1. I make this declaration in support of the Applicant's Motion to Suspend
2. I am employed by the SWATCH GROUP SA, the holding company which controls the applicant. My office is located in the city of Bienne, Switzerland. I have worked in the Trade Marks service of this company for over 15 years and am highly familiar with the applicant's worldwide trademark portfolio.
3. Upon learning of the information our attorneys in the USA received from Pierre Balmain's lawyers, I further investigated. While I understand that this company had been in some financial difficulty, it is to the best of my knowledge, still in business and able to provide us with necessary consent agreement.
4. I am in the process of contacting Ms Valerie Veysseyre-Constant at Pierre Balmain in Paris, for the purpose of arranging for a consent agreement, which I am highly confident will be signed.. I am in the process of coordinating with our American attorneys to complete the draft agreement they had been negotiating with Balmain's US lawyer before she apparently left her firm.

5. It is my belief that we will be able to complete this process of finalization and signature in less than six months. It is the belief of our company that Pierre Balmain is obligated to consent to our application, and it is my further belief that they have no reason to object nor do they possess, to the best of my knowledge, any intention to object.

I declare under penalty of perjury under the laws of the United States of America that all statements made herein are true and any statements made on information and belief are believed to be true and any willful false statements so made are punishable under Title 18 Section 1001 of the United States Code.



Josiane Citso

JMC:mlw

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

Attorney Docket: T-59135

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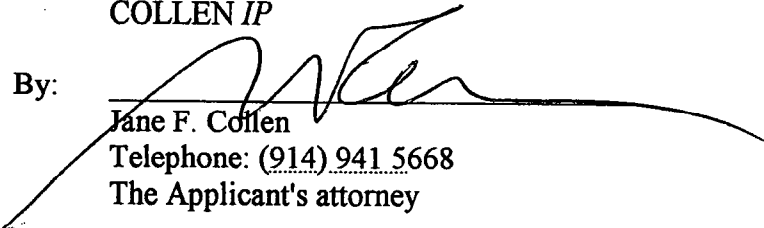
TO THE TRADEMARK TRIAL AND APPEAL BOARD:

Applicant hereby appeals to the Trademark Trial and Appeal Board from the decision of the Examiner of Trademarks refusing registration.

Filed together with this notice is the Applicant's Request for Reconsideration.

Respectfully submitted,
COLLEN *IP*

By:


Jane F. Collen
Telephone: (914) 941 5668
The Applicant's attorney

JFC:kdr

Enclosure: - Check in the amount of \$100.00 appeal fee

DATED: February 2, 2005

COLLEN *IP*

Intellectual Property Law, P.C.
The Holyoke-Manhattan Building
80 South Highland Avenue
Town of Ossining
Westchester County, New York 10562

SHOULD ANY OTHER FEE BE REQUIRED, THE PATENT AND TRADEMARK OFFICE IS HEREBY REQUESTED TO CHARGE SUCH FEE TO OUR DEPOSIT ACCOUNT 03-2465.

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO: COMMISSIONER FOR TRADEMARKS, P.O. BOX 1451, ALEXANDRIA, VA 22313-1451.

COLLEN *IP* Intellectual Property Law, P.C.

By: Kajra D Rora

Date: February 2, 2005

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK EXAMINING OPERATION

ATTORNEY DOCKET NO: T-59135

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Filed : May 15, 1998
Mark : PIERRE BALMAIN

ATTENTION:

Examining Attorney: Linda A Powell
Law Office: 106

TO:

Commissioner for Trademarks
Box: Responses - No Fee
P.O. Box 1451
Alexandria, VA 22313-1451

RESPONSE AFTER FINAL REFUSAL:
REQUEST FOR RECONSIDERATION
FILED WITH NOTICE OF APPEAL

In response to the official action dated August 3, 2004, Applicant requests reconsideration of the Examiner's refusal to register under Trademark Act Section 2(d). In addition, Applicant requests reconsideration of the

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Examiner's refusal to grant suspension of the application in order to secure a consent agreement with the owner of the cited application.

REMARKS

Applicant has advised the Examiner that it has the consent of the cited registrant to use the trademark, PIERRE BALMAIN in connection with the goods in this application. Applicant has submitted letters of consent for the Examiner's consideration. However, these have not been found sufficient.

In the course of negotiations, Applicant has just learned that the registrant is bankrupt. Furthermore, Applicant has just been advised that the attorneys who had been representing Pierre Balmain Company are no longer representing them.

On information and belief, Applicant advises that the registered mark in question will no longer be in use.

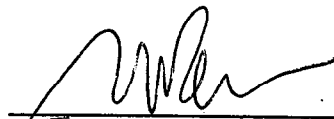
Applicant submits a declaration verifying this information has been received by Applicant's attorney. Due to the bankruptcy proceeding of the registrant, Applicant requests suspension of action on this application in order to give Applicant sufficient time to contact the company, find out who the representative in bankruptcy will be, and continue to seek sufficient evidence of

the consent to use this mark on these goods to support this application. In the alternative, Applicant will seek to cancel the cited registration of this trademark.

The Applicant submits that this application is now in proper condition for publication. Accordingly, the Applicant respectfully requests that the above-captioned trademark be passed to publication in the Official Gazette of the United States Patent and Trademark Office.

Respectfully submitted,
COLLEN *IP*

By:



Jane F. Collen

Telephone: (914) 941 5668

The Applicant's attorney

JFC:kdr

Enclosure: Declaration of Jess M. Collen

Dated: February 2, 2005

COLLEN *IP*

Intellectual Property Law, P.C.

The Holyoke-Manhattan Building

80 South Highland Avenue

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By: Kajra DiRosa

T210.doc

Date: 2/2/2005

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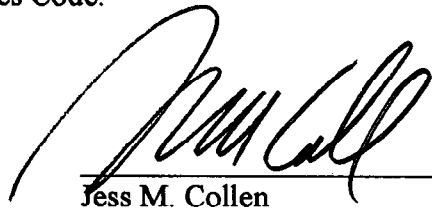
DECLARATION OF JESS M. COLLEN

1. I make this declaration in support of the Applicant's Request for Reconsideration.
2. I am an attorney representing the Applicant in the above captioned matter.
3. We have attempted to finalize a co-existence agreement with the company, Pierre Balmain, with whom the Applicant has had an ongoing relationship and with whom there was an agreement regarding use and registration of the Pierre Balmain name and trademark.
4. I attempted to contact Ms. Setton, counsel of record for the registered owner of the PIERRE BALMAIN cited mark, with whom I had been carrying on a dialog regarding completion of the consent agreement.
5. According to my files, Ms. Elaine Setton had advised me on March 6, 2003 that it was her understanding that the two parties had entered into a substantive agreement regarding the BALMAIN and PIERRE BALMAIN marks owned by each party and recognize that each party owned applications or registrations in

various jurisdictions which may have been blocking or hindering registration by the other. Accordingly, the simple consent agreement to registration was drafted.

6. Having had no correspondence with Ms. Setton during the period of suspension, we again attempted to contact her at her law firm. It was our understanding that Ms. Setton had been counsel of record for PIERRE BALMAIN for a period of years.
7. Finally on November 23, 2004, in the early evening I received a phone call from Ms. Allyn Taylor. Ms. Taylor's message to me was that she had been advised that the PIERRE BALMAIN company had filed for bankruptcy and that her firm, therefore, was no longer representing them. She further indicated that she "supposed" that they were not in business and indicated that in any case she had no one who she could contact any longer. She did confirmed that the former, Attorney Ms. Setton had left the firm and that it was now Ms. Taylor's responsibility to look after these files (if indeed there was anything to do).
8. The Applicant is directly attempting from Switzerland, to re-establish contact regarding this mark.

I declare under penalty of perjury under the laws of the United States of America that all statements made herein are true and any statements made on information and belief are believed to be true and any willful false statements so made are punishable under Title 18 section 1001 of the United States Code.



Jess M. Collen

JMC:mlw:kdr