

ESTTA Tracking number: **ESTTA410831**

Filing date: **05/25/2011**

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

Proceeding	91198122
Party	Defendant BDO Remit (USA), Inc. DBA BDO Remittance (USA), Inc.
Correspondence Address	NELS T LIPPERT WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022 UNITED STATES nels.lippert@wilmerhale.com, michael.bevilacqua@wilmerhale.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Nels T. Lippert
Filer's e-mail	nels.lippert@wilmerhale.com, henry.chen@wilmerhale.com, WHIPNYTrademarkDocketStaff@wilmerhale.com
Signature	/Nels T. Lippert/
Date	05/25/2011
Attachments	BDO Motion to Suspend Proceedings.pdf (18 pages)(632035 bytes)

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

STICHTING BDO,

Opposer,

v.

BDO REMIT (USA), INC.,

Applicant.

Opposition No. 91198122

**BDO REMIT'S MOTION TO SUSPEND PROCEEDINGS
PENDING TERMINATION OF CIVIL ACTION**

Applicant, BDO Remit (USA), Inc. ("BDO Remit"), by its attorneys, hereby moves for suspension of these proceedings including the suspension of any current discovery deadlines for serving responses to Opposer's discovery requests pursuant to Trademark Rule 2.127(a), TBMP § 510.02(a), and 37 C.F.R. § 2.117(a), due to the civil action *BDO Remit (USA), Inc. v. Stichting BDO*, Civil Action No. CV11-04054, currently pending in the Central District of California. A true and correct copy of the complaint from the civil action is appended hereto as Exhibit A. The civil action is between the same parties in this proceeding, concerns the same trademark at issue in this proceeding, and involves issues in common with those in this proceeding.

BDO Remit therefore requests that this proceeding be suspended pursuant to Trademark Rule 2.127(a), TBMP § 510.02(a), and 37 C.F.R. § 2.117(a), until the termination of the civil action *BDO Remit (USA), Inc. v. Stichting BDO*, Civil Action No. CV11-04054.

Dated: May 25, 2011

Respectfully submitted

/s/ Nels T. Lippert
Nels T. Lippert
Wilmer Cutler Pickering Hale And Dorr LLP
399 Park Avenue
New York, NY 10022
Tel: (212) 937-7201
Fax: (212) 230-8888
Email: nels.lippert@wilmerhale.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing BDO Remit's Motion To Suspend Proceedings Pending Termination of Civil Action has been served on May 25, 2011 by mailing said copy by First Class Mail, postage prepaid to:

Marie Anne Mastrovito
ABELMAN FRAYNE & SCHWAB
666 Third Avenue
New York, NY 10017


Henry Chen

Exhibit A

1 MICHAEL D. JAY (SBN 223827)
(michael.jay@wilmerhale.com)
2 EMILY S. CHURG (SBN 261334)
(emily.churg@wilmerhale.com)
3 WILMER CUTLER PICKERING
HALE AND DORR LLP
4 350 South Grand Avenue, Suite 2100
Los Angeles, CA 90071
5 Telephone: (213) 443-5317
Facsimile: (213) 443-5400
6

7 NELS T. LIPPERT (*pro hac vice* to be filed)
(nels.lippert@wilmerhale.com)
8 HENRY CHEN (*pro hac vice* to be filed)
(henry.chen@wilmerhale.com)
9 WILMER CUTLER PICKERING
HALE AND DORR LLP
399 Park Avenue
10 New York, NY 10022
Telephone: (212) 230-8800
11 Facsimile: (212) 230-8888

12 Attorneys for Plaintiff
BDO REMIT (USA), INC.
13

14 UNITED STATES DISTRICT COURT
15 CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION

16 BDO REMIT (USA), INC., a California
17 Corporation,

18 Plaintiff,

19 v.

20 STICHTING BDO, a Netherlands
21 Corporation,

22 Defendant.
23
24
25
26
27
28

BY: _____

CLERK U.S. DISTRICT COURT
CENTRAL DISTRICT OF CALIF.
LOS ANGELES

11 MAY 11 PM 4:02

FILED

Case No. CV11-04054 MMM (CW)

COMPLAINT FOR
DECLARATORY RELIEF

JURY TRIAL DEMANDED

1 Plaintiff BDO Remit (USA), Inc. (“Remit” or “Plaintiff”) complains against
2 Defendant Stichting BDO (“Stichting” or “Defendant”) as follows:
3

4 1. This is an action for a declaratory judgment under 28 U.S.C. § 2201.
5 Remit seeks a declaration from this Court that its use of the mark BDO REMIT: (1)
6 does not infringe Defendant’s trademark rights under 15 U.S.C. § 1114; (2) does not
7 constitute false designation of origin under 15 U.S.C. § 1125(a); and (3) does not
8 constitute trademark dilution, unfair competition, or trademark infringement under
9 California state law.
10

11
12 **THE PARTIES**

13 2. Plaintiff BDO Remit (USA), Inc. is a corporation organized under the
14 laws of California with a principal business office at 2365 S. Azusa Avenue, West
15 Covina, California, 91792. Remit is a subsidiary of Banco De Oro Unibank, Inc., a
16 Philippines-based bank. BDO are the initials of and acronym for Banco De Oro
17 Unibank, Inc. (“BDO Unibank”), which is the largest bank in the Philippines. Remit
18 provides wire transfer services from the United States to the Philippines by
19 individuals and companies owned or operated by Filipinos located in the United
20 States.
21
22

23
24 3. Upon information and belief, Defendant Stichting BDO is a corporation
25 organized under the laws of the Netherlands and is affiliated with BDO International, a
26
27
28

1 network of public accounting firms. Upon information and belief, Defendant maintains
2 a principal business office at Dr. Holtropiaan 27, 5652 XR Eindhoven, the Netherlands.
3

4 JURISDICTION AND VENUE

5 4. This Court has original jurisdiction over Remit's federal claims pursuant
6 to 28 U.S.C. § 1331, § 1338, and § 2201.
7

8 5. This Court has supplemental jurisdiction over Remit's non-federal claims
9 pursuant to 28 U.S.C. § 1367, because these claims are so related to the federal claims
10 that they form a part of the same case or controversy under Article III of the United
11 States Constitution.
12

13 6. This Court has personal jurisdiction over Defendant because, *inter alia*,
14 (1) Defendant has appeared in this District and Court as plaintiff in litigation against
15 Remit on the same subject matter as this Complaint, and (2) Defendant's actions
16 threaten further litigation against Remit within this State and District.
17

18 7. Venue is proper in the Central District of California pursuant to 28
19 U.S.C. § 1391(b), (c), and (d).
20

21 8. An actual case or controversy has arisen between the parties. Defendant
22 initiated litigation against Remit for Remit's use of the BDO REMIT mark and sought
23 dismissal without prejudice; has filed a notice of opposition to the registration of
24
25
26
27

1 Remit's allowed application to register BDO REMIT; and has threatened or
2 commenced actions against Remit's parent, BDO Unibank, for use of marks including
3 the BDO formative in other countries.
4

5
6 **FACTS COMMON TO ALL CAUSES OF ACTION**

7 9. Remit uses the mark BDO REMIT in association with its wire transfer
8 services from the United States to the Philippines. On June 22, 2009, Remit filed an
9 application with the U.S. Patent and Trademark Office for the registration of the mark
10 BDO REMIT. Remit seeks registration of the BDO REMIT mark for "wire transfer
11 services to the Philippines by individuals and companies owned or operated by
12 Filipinos located in the United States." Remit's application was determined to be
13 entitled to registration over Defendant's registrations and was published for
14 opposition on July 13, 2010. Defendant obtained extensions of time to oppose the
15 registration of the mark, and on January 10, 2011, Defendant filed a notice of
16 opposition to the registration of Remit's application to register BDO REMIT based
17 upon an alleged likelihood of confusion and/or dilution of Defendant's marks.
18
19
20
21

22 10. Upon information and belief, Defendant is the owner of three federally
23 registered trademarks: U.S. Trademark Reg. No. 2,699,803 for the word mark BDO;
24 U.S. Trademark Reg. No. 2,699,812 for the word and design mark BDO; and U.S.
25 Trademark Reg. No. 2,699,804 for the word mark BDO INTERNATIONAL. These
26
27
28

1 trademark registrations list various services with which the marks are purportedly
2 used, but does not include banking services generally or specifically wire transfer
3 services.
4

5
6 11. Upon information and belief, Defendant is not a licensed bank in the
7 United States and does not engage in the business of wire transfer services from the
8 United States to the Philippines, under the mark BDO or any other mark.
9

10 12. Remit and Defendant are engaged in different business trades, provide
11 their services to different clients in distinct markets, and provide their services through
12 different channels of trade. In addition, Defendant's marks are not recognized as
13 famous or distinctive.
14

15
16 13. On April 20, 2010, Defendant filed a complaint against Remit in this
17 Court alleging that Remit's use of the mark BDO REMIT: (1) infringes Defendant's
18 alleged trademark rights under 15 U.S.C. § 1114; (2) constitutes false designation of
19 origin under 15 U.S.C. § 1125(a); (3) constitutes trademark dilution under California
20 Business and Professions Code § 14330; (4) constitutes unfair competition under
21 California Business and Professions Code § 17200; (5) constitutes trademark
22 infringement under California common law; and (6) constitutes unfair competition
23 under California common law.
24
25
26
27
28

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

(6) Does not constitute unfair competition against Defendant under California common law.

B. Awarding Remit its attorneys' fees, expenses, and costs incurred in this action; and

C. Awarding to Remit such further relief as this Court deems just and proper.

DEMAND FOR JURY TRIAL

Plaintiff Remit hereby demands a trial by jury on all issues so triable.

Dated: May 11, 2011

WILMER CUTLER PICKERING
HALE AND DORR LLP

By: 
Michael D. Jay

MICHAEL D. JAY (SBN 223827)
(michael.jay@wilmerhale.com)
EMILY S. CHURG (SBN 261334)
(emily.churg@wilmerhale.com)
WILMER CUTLER PICKERING
HALE AND DORR LLP
350 South Grand Avenue, Suite 2100
Los Angeles, CA 90071
Telephone: (213) 443-5317
Facsimile: (213) 443-5400

NELS T. LIPPERT (*pro hac vice* to be filed)
(nels.lippert@wilmerhale.com)
HENRY CHEN (*pro hac vice* to be filed)
(henry.chen@wilmerhale.com)
WILMER CUTLER PICKERING
HALE AND DORR LLP
399 Park Avenue

1
2
3
4
5
6
7
8
9
10
11
12
13
14
15
16
17
18
19
20
21
22
23
24
25
26
27
28

New York, NY 10022
Telephone: (212) 230-8800
Facsimile: (212) 230-8888

Attorneys for Plaintiff
BDO REMIT (USA), INC.