

ESTTA Tracking number: **ESTTA569673**

Filing date: **11/07/2013**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Shenzhen Bao Ye Heng Industrial Development Co., LTD		
Entity	Corporation	Citizenship	China
Address	Futian District, 3rd Floor, Jilian Building #4, North Xinzhou Rd. Shenzhen, 518031 CHINA		

Attorney information	Hubert H. Kuo Ardent Law Group, P.C. 2600 Michelson Dr., Suite 1700 Irvine, CA 92612 UNITED STATES hkuo@ardentlawgroup.com Phone:949-863-9782		
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Applicant Information

Application No	85697706	Publication date	11/05/2013
Opposition Filing Date	11/07/2013	Opposition Period Ends	12/05/2013
Applicant	Paul Audio, Inc. 5157 Cliffwood Drive Montclair, CA 91763 CANADA		

Goods/Services Affected by Opposition

Class 035. First Use: 1993/12/01 First Use In Commerce: 1993/12/01 All goods and services in the class are opposed, namely: Wholesale distributorships featuring audio apparatus; Retail store and on-line retail store services all featuring audio apparatus

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)

Marks Cited by Opposer as Basis for Opposition

U.S. Application No.	85648979	Application Date	06/11/2012
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	C-MARK		

Design Mark	C-MARK
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 2000/08/28 First Use In Commerce: 2005/06/06 Amplifiers; audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers and speaker housings; audio mixers; audio speaker enclosures; audio speakers; digital signal processors; echo sounding devices; electric connectors; electric current switches; electric light dimmers; electric light switches; graphic equalizers; microphones; radios; signal processors; sound mixers; stereo tuners

U.S. Registration No.	3252760	Application Date	09/25/2006
Registration Date	06/19/2007	Foreign Priority Date	NONE

Word Mark	C-MARK
Design Mark	C-MARK
Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 1993/00/00 First Use In Commerce: 2006/08/00 Amplifiers; Audio equipment for vehicles, namely, stereos, speakers, amplifiers, equalizers, crossovers and speaker housings; Audio mixers; Audio speaker enclosures; Audio speakers; Digital signal processors; Echo sounding devices; Electric connectors; Electric current switches; Electric light dimmers; Electric light switches; Graphic equalizers; Microphones; Radios; Signal processors; Sound mixers; Stereo tuners

Related Proceedings	Opposition 91206084 (Shenzhen Bao v Paul Audio)
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Attachments	Notice of Opposition (Shenzhen Bao v Paul Audio).pdf(97876 bytes) 85648979#TMSN.jpeg(bytes) 77006199#TMSN.jpeg(bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Hubert H. Kuo/
Name	Hubert H. Kuo
Date	11/07/2013

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

In re Application of:

Paul Audio, Inc.

Mark: C-MARK in International Class 035

Application No. 85/697706

Filing Date: August 7, 2012

Published in the Official Gazette: November 5, 2013

Shenzhen Bao Ye Heng Industrial Development Co., LTD.

Opposer.

v.

Opposition No: (to be assigned)

Paul Audio, Inc.

NOTICE OF OPPOSITION

Shenzhen Bao Ye Heng Industrial Development Co., LTD. ("Opposer"), a Chinese corporation, with offices at Futian District, 3rd Floor, Jilian Building #4, North Xinzhou Road, Shenzhen, 518031, China, believes that it will be damaged by registration of the mark C-MARK ("Applicant's Mark") as shown in Application Serial No. 85/697706 (the "Application") filed August 7, 2012 by Paul Audio, Inc. ("Applicant"), in connection with "Wholesale distributorships featuring audio apparatus; Retail store and on-line retail store services all featuring audio apparatus", in International Class 035 and hereby opposes the application.

As grounds for opposition, it is alleged that:

1. Applicant seeks to register the mark "C-MARK" for use with "Wholesale distributorships featuring audio apparatus; Retail store and on-line retail store services all featuring audio apparatus" in International Class 035, as evidenced by the publication of said mark in the November 5, 2013 issue of the Official Gazette.

2. Opposer is one of the world's most prominent audio equipment manufacturers. Opposer has sold audio equipment for over eight years in the United States and over twelve years abroad under the C-MARK mark.

3. Opposer first acquired the right to the C-MARK mark in China through an assignment from Hong Da Development Co., a Chinese company, in 2000. Hong Da Development Co. had previously obtained the same rights through a Chinese court order.

4. Applicant was the owner of U.S. registered trademark 1906390, to the mark "C-MARK."

5. Soon after the Chinese court order relating to the trademark rights of the same mark in China, Applicant publicized its intent to abandon its use of the U.S. registered trademark. Such public announcement of abandonment was in January of 2002, at the NAMM tradeshow in California. Another public announcement of abandonment was in May of 2002, at a tradeshow in Beijing, China, and on its website.

6. In 2006, Applicant's U.S. registered trademark 1906390, to the mark "C-MARK." was expired for failing to file its tenth year section 8 declaration of use.

7. During the time of Applicant's non-use of the C-MARK mark, the Opposer had begun using the mark in United States commerce, in connection with the same or substantially similar goods and/or services as indicated in the Application.

8. Mr. Baoning Zhou, representative of the Opposer, filed a U.S. trademark application on September 25, 2006 for the same mark. The mark was registered on June 19, 2007, but was subsequently canceled in 2011 for inadvertent formality error made during initial filing pursuant to the Trademark Trial and Appeal Board's (the "Board's") decision in cancellation proceeding number 92049924.

9. In cancellation proceeding number 92049924, however, the Board ruled that Applicant had abandoned its C-MARK mark.

10. Since Applicant's abandonment date, Opposer and its agents have extensively promoted and advertised the sale and distribution of goods and services bearing or offered in connection with Opposer's C-MARK Marks, including, but not limited to, the goods and/or services described in the Application or substantially similar thereto, and have offered such goods and/or rendered such services in commerce.

11. As a result of the extensive sales and promotion of goods and/or services bearing or offered in connection with Opposer's C-MARK Marks, Opposer has built up highly valuable goodwill in Opposer's C-MARK Marks and said goodwill has become closely and uniquely identified and associated with Opposer.

12. Opposer's C-MARK Marks are distinctive and famous, and were so after 2002, Applicant's abandonment date.

13. On August 7, 2012, Applicant filed the Application in the United States Patent and Trademark Office ("USPTO") for the mark C-MARK, in International Class 35.

14. Applicant filed the Application based on use pursuant to Section 1(a), claiming a first use date of December 1, 1993, with the knowledge of: (i) its public announcements of abandonment of the C-MARK mark in 2002; (ii) its non-use for years subsequent to those public announcements; and (iii) the Trademark Trial and Appeal Board, in cancellation proceeding number 92049924, having already adjudicated that Applicant abandoned the C-MARK mark by 2004. The Applicant had the intent to defraud the U.S. Patent and Trademark Office, at the time the Application was filed.

15. At the time of filing and executing the Application, Applicant submitted a sworn statement that "all statements made of his/her own knowledge are true" in connection with the statements contained in the Application.

COUNT I

16. Opposer repeats and re-alleges the allegations contained in paragraphs 1 - 15 of the Notice of Opposition as if fully set forth herein.

17. The goods covered by the Application are closely related to the goods offered and services rendered in connection with Opposer's C-MARK Marks.

18. Applicant's Mark so resembles Opposer's C-MARK Marks as to be likely, when used in connection with Applicant's goods and or services, to cause confusion, to cause mistake, and to deceive the trade and public, who are likely to believe that Applicant's goods and/or services have their origin with Opposer and/or that such goods and/or services are approved, endorsed or sponsored by Opposer or associated in some way with Opposer.

19. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

COUNT II

20. Opposer repeats and re-alleges the allegations contained in paragraphs 1 - 19 of the Notice of Opposition as if fully set forth herein.

21. Opposer's C-MARK Marks have achieved distinctiveness and fame during Applicant's period of abandonment from 2002 through 2007.

22. Applicant's use of Applicant's Mark would dilute Opposer's C-MARK Marks by rendering them less distinctive.

23. Opposer would thereby be injured by the granting to Applicant of a certificate of registration for Applicant's Mark.

COUNT III

24. Opposer repeats and re-alleges the allegations contained in paragraphs 1 - 23 of the Notice of Opposition as if fully set forth herein.

25. Upon information and belief, contrary to Applicant's sworn statement in the Application that Applicant's first use date was 1993, and that there was continuous use from 1993 to August 7, 2012, the Application filing date was false.

26. Upon information and belief, Applicant has no documentary evidence demonstrating Applicant's continuous use of Applicant's Mark in connection with some of the goods and/or services identified in the Application in United States commerce since the first use date through the filing date of the Application.

27. Accordingly, the Application is void, in whole or in part, as to the first use date in commerce. Applicant did not have continuous use of the Applicant's Mark in United States commerce since the stated first use date of December 1, 1993 through the application filing date.

28. The USPTO relied on Applicant's false statement and passed the Application for publication.

29. The USPTO would not have published the Application but for Applicant's false statement.

30. Applicant's false statement in procuring an allowance constitutes fraud, thereby invalidating the Application in its entirety. Accordingly, the Application should be declared void ab initio.

WHEREFORE, Opposer believes that it will be damaged by registration of Applicant's Mark and requests that the opposition be sustained and said registration be denied.

Please recognize as attorneys for Opposer in this proceeding Hubert H. Kuo, Alexander J. Chang, and David Yu (members of the bar of the State of California) and the firm Ardent Law Group P.C., 2600 Michelson Drive, Suite 1700, Irvine, California 92612.

Please address all communications to Hubert Kuo, Esq. at the address listed below.

Dated: November 7, 2013

Respectfully submitted,
ARDENT LAW GROUP, P.C.

By: /s/ Hubert H. Kuo
Hubert H. Kuo
Alexander J. Chang
David Yu
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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on November 7, 2013, I caused a true and correct copy of the foregoing Notice of Opposition to be sent via First Class Mail, postage prepaid, to Applicant's Attorney and Correspondent of Record, Tony W. Wong, Law Offices of David W. Lee, 108 N. Ynez Ave. Suite 128, Monterey Park, CA 91754-1680.

/s/ Hubert H. Kuo

Hubert H. Kuo