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Filing date: **02/12/2014**

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

Proceeding.	91213564
Applicant	Plaintiff Shenzhen Bao Ye Heng Industrial Development Co., Ltd
Other Party	Defendant Paul Audio, Inc.
Have the parties held their discovery conference as required under Trademark Rules 2.120(a)(1) and (a)(2)?	Yes

### **Motion for Suspension in View of Civil Proceeding With Consent**

The parties are engaged in a civil action which may have a bearing on this proceeding. Accordingly, Shenzhen Bao Ye Heng Industrial Development Co., Ltd hereby requests suspension of this proceeding pending a final determination of the civil action. Trademark Rule 2.117.

Shenzhen Bao Ye Heng Industrial Development Co., Ltd has secured the express consent of all other parties to this proceeding for the suspension and resetting of dates requested herein.

Shenzhen Bao Ye Heng Industrial Development Co., Ltd has provided an e-mail address herewith for itself and for the opposing party so that any order on this motion may be issued electronically by the Board.

### **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.

Respectfully submitted,  
/Hubert H. Kuo/  
Hubert H. Kuo  
hkuo@ardentlawgroup.com  
hkuo@ardentlawgroup.com  
02/12/2014

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

*In re* U.S. Trademark Application Serial No. 85/697,706 for “C-MARK” filed August 7, 2012  
and Published in the *Official Gazette* on November 5, 2013

Shenzhen Bao Ye Heng Industrial	)	Opposition No. 91/213,564
Development Co., LTD.,	)	
	)	
Opposer,	)	<b>CONSENT MOTION TO SUSPEND</b>
	)	<b>PROCEEDING IN VIEW OF PENDING</b>
v.	)	<b>TTAB ACTION PURSUANT TO</b>
	)	<b>TRADEMARK RULE 2.117(a)</b>
	)	
Paul Audio, Inc.,	)	
	)	
Applicant	)	
_____	)	

Opposer, Shenzhen Bao Ye Heng Industrial Development Co., LTD. (“Opposer”), by his attorneys Ardent Law Group, P.C., hereby moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F.R. Section 2.117 (a). This motion is made with the consent of Applicant Paul Audio, Inc.

Prior to the commencement of the instant action on July 13, 2012, Opposer filed Opposition No. 91206084 (the “6084 Opposition”) in opposition to the registration by Paul Audio, Inc. of the mark “C-MARK” under International Class 009 pursuant to Application No. 77312117. Attached as Exhibit 1 is Opposer’s Notice of Opposition in the 6084 Opposition.

In the 6084 Opposition, Opposer alleges that Paul Audio’s mark “C-MARK” will, among other things, cause the confusion in the marketplace with its own mark, and that Paul Audio, Inc. provided fraudulent statements to the USPTO in order to obtain its registration of its mark. Paul

Audio, Inc.'s applications at issue in the 6084 Opposition and this instant opposition both deal with the same mark –C-MARK- for goods and service categories that are related.<sup>1</sup>

The 6084 Opposition proceeding accordingly involves issues that are likewise involved in this instant proceeding, including without limitation the priority of use of the C-MARK mark between the parties. The determination of this issue by the TTAB in the 6084 Opposition will likely be dispositive of the issues involved in this instant proceeding.

Opposer, with Applicant's consent, therefore respectfully requests the suspension of the instant proceeding pending determination of the prior 6084 Opposition pursuant to Trademark Rule 2.117(a), 37 C.F.R. Section 2.117(a). Opposer further requests that all discovery and trial deadlines be reset upon the recommencement of the instant proceeding.

Dated: February 12, 2014

Respectfully submitted,  
ARDENT LAW GROUP, P.C.

By: /s/ Hubert H. Kuo  
Hubert H. Kuo  
Alexander J. Chang  
David Yu  
2600 Michelson Dr., Suite 1700  
Irvine, CA 92612  
Tel: (949) 863-9782  
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<sup>1</sup> The stated goods and services for Application No. 77312117 (which is the subject of Opposition No. 91206084) is as follows: "Audio apparatus, namely, speakers, loud speakers, loud speaker boxes, speaker boxes, loud speaker enclosures, speaker enclosures, amplifiers, mixers, equalizers, horns and driver, audio related accessories, namely, adaptor cables, subwoofer/bass speakers, stage speaker 2-way full range speaker, 3-way full range speakers, 4-way full range speakers, tweeters, and head set receivers." The stated goods and services for Application No. 85697706 (which is the subject of this instant Opposition No. 91213564) is as follows: "Wholesale distributorships featuring audio apparatus; Retail store and on-line retail store services all featuring audio apparatus."

**EXHIBIT A**

Ref No. 21606-056-02TMK

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

In re Application Serial No. 77312117  
Filed: 10-24-2007  
For Mark: C-MARK  
Published in the Official Gazette: May 15, 2012

-----X  
SHENZHEN BAO YE HENG INDUSTRIAL :  
DEVELOPMENT CO, LTD. :

Opposer,

v.

PAUL AUDIO, INC.

Applicant.

Opposition No.

**NOTICE OF OPPOSITION**

-----X  
Commissioner for Trademarks  
Attn: Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

Opposer, 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. 77312117 (the “Application”) filed by Paul Audio, Inc. (“Applicant”), and, having been granted extensions of time to oppose up to and including July 14, 2012, hereby opposes the same.

As grounds for opposition, it is alleged that:

1. Opposer is one of the world’s most prominent audio equipment manufacturers.

Opposer has sold audio equipment for over seven years in the United States and over eleven years abroad.

2. Opposer first acquired the right to the same 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.

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

4. 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.

5. In 2006, Applicant's U.S. registered trademark 1906390, to the mark "C-MARK." was expired for failing to file its 10th year section 8 declaration of use.

6. 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 goods as indicated in the instant application.

7. 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, and subsequently canceled in 2011 for inadvertent formality error made during initial filing.

8. 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 described in the instant application, and have offered such goods and rendered such services in commerce.

9. As a result of the extensive sales and promotion of goods and 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.

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

11. On October 24, 2007, Applicant filed the Application in the United States Patent and Trademark Office ("USPTO") for the mark C-MARK, in International Class 09.

12. Applicant filed the Application based on use pursuant to Section 1(a), claiming a first use date of December 31, 1993, with the knowledge that it had, in 2002, publicly announced its abandonment of the C-MARK mark, and with the knowledge of its non-use for years subsequent to those public announcements. The Applicant had the intent to defraud the U.S. Patent and Trademark Office, at the time the Application was filed.

13. 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**

14. Opposer repeats and re-alleges the allegations contained in paragraphs 1 – 13 of the Notice of Opposition as if fully set forth herein.

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

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

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

### **COUNT II**

18. Opposer repeats and re-alleges the allegations contained in paragraphs 1 – 17 of the Notice of Opposition as if fully set forth herein.

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

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

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

### **COUNT III**

22. Opposer repeats and re-alleges the allegations contained in paragraphs 1 – 21 of the Notice of Opposition as if fully set forth herein.

23. 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 October 24, 2007, the Application filing date.

24. 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 identified in the Application in United States commerce since the first use date through the filing date of the Application.

25. 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 31, 1993 through the application filing date.

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

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

28. 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 Kuo and Anthony King (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: Irvine, California  
July 13, 2012

Respectfully submitted,

ARDENT LAW GROUP, P.C.  
Attorneys for Opposer

By: /Anthony King/

Hubert Kuo  
Anthony King

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Irvine, CA 92612  
(949) 863-9782

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on October 26, 2011, 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, David W. Lee, Law Offices of David W. Lee, 108 N. Ynez Ave. Suite 128, Monterey Park, CA 91754-1680.

/Anthony King/  
Anthony King

## CERTIFICATE OF SERVICE

I HEREBY CERTIFY that, on February 12, 2014, I caused a true and correct copy of the foregoing CONSENT MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING TTAB ACTION PURSUANT TO TRADEMARK RULE 2.117(a) and accompany exhibit(s) to be sent via First Class Mail, postage prepaid, to Applicant's Attorney and Correspondent of Record:

A. Justin Lum  
Lum Law Group, LLP,  
1005 E. Colorado Blvd, Ste. 207,  
Pasadena, CA 91106.

/s/ Hubert H. Kuo  
Hubert H. Kuo