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Attorneys for Respondent
Ren Jei Liou

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

In Re: the matter of)	Proceeding No. 92055616
)	
Trademark Registration No. 4050680)	MOTION TO SUSPEND
For the mark: BANG)	THE OPPOSITION PROCEEDING
)	
Christopher Qingyu Fu, an individual; and)	
Bang Golf, Inc., a California Corporation,)	
)	
Petitioners,)	
vs.)	
)	
Ren Jei Lou, an individual,)	
)	
Respondent)	
_____)	

Respondent Ren Jei Liou (“Respondent”) by and through his counsel of record, the Law Offices of Maxwell E. Lin & Associates, hereby petitions the Director to suspend Petition to Cancel, Proceeding No. 92055616, and to stay all relevant deadlines in the Proceeding based on a pending civil action in the California Superior Court, pursuant to 37 CFR Sections 2.117, 2.146(g).



MEMORANDUM OF POINTS AND AUTHORITIES

I.

PROCEDURAL BACKGROUND

1. On May 15, 2012, Petitioners filed a Petition to Cancel with the Trademark Trial and Appeal Board, claiming prior ownership of the trademark BANG and use in association with golf equipment. Petitioner Fu alleges that he is the owner of the common-law trademark BANG which he had continuously used in commerce since June 2001, and of U.S. Trademark Registration 2272185 for the same mark, cancelled on May 15, 2010 for failure to file the required declaration under Section 8, as well as Trademark Application Serial No. 85/552,604 for the mark, filed on February 24, 2012. Respondent is the owner of U.S. Trademark Registration No. 4050680 for the mark BANG, filed on November 1, 2011.
2. On June 22, 2012, Respondent filed an answer to the Petition to Cancel, denying all material allegations of the filing. Respondent contends that the mark was abandoned by Petitioners.
3. On January 22, 2013, Petitioners through and by their attorney of record Philip Boesch made an settlement offer in which Petitioner would dismiss the pending proceedings in return for Respondent's transfer of the mark to Petitioner; Petitioner would release all claims against Respondent; and the parties would bear their own attorney's fees and costs. Mr. Boesch set a deadline by January 24 at 12:00 p.m. to accept the offer. On January 24 at 10:36 a.m., Respondent through and by his attorney of record Maxwell Lin emailed Mr. Boesch requesting that he draft a settlement agreement.
4. On February 23, 2013 Mr. Lin contacted Mr. Boesch by email inquiring as to the settlement status. Mr. Boesch did not respond.

5. On March 13, 2013 Mr. Lin telephoned Mr. Boesch and inquired about the settlement status; Mr. Boesch responded that he would contact his client and get back to him. Despite Respondent's acceptance of Petitioner's settlement offer on January 24, 2013, Petitioners not only took action to move this matter forward, but filed a largely unsubstantiated civil action as noted below.

6. On July 26, 2013 Petitioners Chris Fu and Bang Golf filed a complaint in the Superior Court of California, County of Los Angeles, against Respondent for damages and equitable relief, which included counts for unfair competition; trademark infringement; trade name infringement; violation of Racketeer Influenced and Corrupt Organizations Statute (RICO); misappropriation and conversion; unjust enrichment; injunction; constructive trust; and declaratory relief (the "Civil Action"). Respondent, by and through his attorney of record, filed an answer on September 23, 2013 denying all material allegations of the complaint.

II.

SUSPENSION OF PROCEEDING PURSUANT TO 37 CFR SECTION 2.117

37 CFR Section 2.117 authorizes the Director to suspend a Board proceeding whenever the same parties are engaged in a civil action that may have a bearing on the case, until termination of the civil action. The relevant code section states:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that A party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or other Board proceeding.

Since the decision of the state court is often binding upon the Board, especially in matters concerning infringement, as is the case here, where the interest in prompt adjudication far outweighs the value of having the views of the USPTO [See *Goya Foods vs. Tropicana Products, Inc.*, 846 F.

2d 848, 6 USPQ2d 1950, 1954 (2nd Cir. 1988)], the Director should suspend the Proceeding until termination of the Civil Action. Otherwise, the simultaneous adjudication of the matters before the Board and the state court may give rise to inconsistent, multiple and costly obligations and results.

Based on the above, the Respondent respectfully and specifically requests that the Director suspend the Proceeding and stay all applicable deadlines in the Proceeding in accordance with 37 CFR 2.117 and 37 CFR 2.146(g).

Further, another basis exists for a stay, to wit: to allow for ongoing settlement discussions. Additional time for the Proceeding will allow the parties in the Civil Action to focus their resources on settlement discussions/mediation for the mutual benefit of all parties.

Furthermore, in the event settlement discussions are not fruitful, Respondent intends to file a motion for summary judgment in the Civil Action to establish non-infringement, non-RICO violation, non-misappropriation and non-conversion. The motion will have a significant impact on the Director's evaluation of the instant proceeding.

III.

CONCLUSION

Based on the foregoing Respondent respectfully requests that the Director suspend the Proceeding and stay all relevant deadlines due to the pending Civil Action in the California state court.

Dated: October 11, 2013

Respectfully Submitted,

LAW OFFICES OF MAXWELL E. LIN

By: 
Maxwell E. Lin, Esq., Attorney for
Respondent Ren Jei Liou

CERTIFICATE OF SERVICE

I, the undersigned certify that on October 11, 2013, I served the documents described as:

Motion to Suspend the Opposition Proceeding

on the interested parties in this case by mailing a true copy thereof to the followings:

Philip W. Boesch, Esq.
THE BOESCH LAW GROUP
225 Santa Monica Blvd., 11th Floor
Santa Monica, CA 90401

Executed on October 11, 2013 at West Covina, California.



Connie Du

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