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

Proceeding	92058956
Party	Defendant 578539 B.C. Ltd.
Correspondence Address	DEAN A PALMER IPROPERTY INC 609 WEST HASTINGS STREET VANCOUVER, BC V6B 4W4 CANADA johnwell@shaw.ca, info@iproperty.ca
Submission	Motion to Suspend for Civil Action
Filer's Name	Paul W. Reidl
Filer's e-mail	paul@reidllaw.com
Signature	/pwr/
Date	06/06/2014
Attachments	Motion to Suspend_Conformed Exhibits.pdf(4112006 bytes)

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

3 Registration No. 4,156,487

4 Mark: MAICO and Design

6 _____)
7 **J. GARY KORTZ,**)

8 Petitioner,)

9 v.)

10 **578539 B.C Ltd.**)

11 Respondent.)

Opposition No. 92058956

**MOTION TO SUSPEND
PENDING FEDERAL COURT
LITIGATION**

12 Pursuant to TBMP Section 510.02, Respondent hereby requests that these proceedings be
13 suspended by the Board pending the outcome of Case No. 2:14-cv-04375 filed by Respondent
14 in the United States District Court for Central District of California. A copy of the Complaint is
15 attached as Exhibit 1

16 TBMP Section 510.02(a) states: "Whenever it comes to the attention of the Board that a
17 party or parties to a case pending before it are involved in a civil action which may have a
18 bearing on the Board case, proceedings before the Board may be suspended until final
19 determination of the civil action." The civil action claims that Petitioner is infringing
20 Respondent's registered and unregistered trademarks, including the registration at issue herein.
21 The civil action will inevitably decide the issues of ownership of the registration that have been
22 raised by Petitioner in this proceeding. In fact, the claims made by Petitioner in the present
23 proceeding are compulsory counterclaims in the civil action.

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EXHIBIT 1

1 PAUL W. REIDL (SBN 155221)
2 Law Office of Paul W. Reidl
3 Second Floor
4 241 Eagle Trace Drive
5 Half Moon Bay, CA 94019
6 Phone: (650) 560-8530
7 paul@reidllaw.com

8 Attorneys for Plaintiff

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**UNITED STATES DISTRICT COURT
CENTRAL DISTRICT OF CALIFORNIA
WESTERN DIVISION**

578539 B.C. Ltd, t/a/ CANADIAN MAICO,

a Canadian corporation,

Plaintiff,

v.

J. GARY KORTZ, d/b/a SOCAL MAICO,

an individual residing in this District,

Defendant.

Case No. _____

**COMPLAINT FOR TRADEMARK
INFRINGEMENT, TRADE LIBEL,
UNFAIR COMPETITION AND
RESTITUTION FOR UNJUST
ENRICHMENT**

Plaintiff, 578539 B.C. Ltd., also known as “Canadian Maico” (hereinafter “Maico”), by and through its counsel, for its Complaint against J. Gary Kortz (hereinafter “Kortz”), alleges and states as follows:

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JURISDICTION

1. This action arises out of the Federal Lanham Act, 15 U.S.C. § 1114(1) and 15 U.S.C. § 1125 (a). This Court has subject matter jurisdiction over the Federal claims pursuant to 28 U.S.C. §§ 1331, 1338(a) and 15 U.S.C. § 1121, and supplemental jurisdiction over the state law claims pursuant to 28 U.S.C. §§1338 (b) and 1367 (b).

2. Venue is proper in this Court pursuant to 28 U.S.C. § 1391(b) because Kortz is located in and transacts affairs in this district and a substantial part of the events giving rise to the claims asserted herein arose in this district.

THE PARTIES

3. Plaintiff 578539 B.C. Ltd. is a corporation organized and existing under the laws of Canada, with its principal place of business in Victoria, Canada. It trades under the name Canadian Maico.

4. Defendant J. Gary Kortz is an individual residing in Ventura, California. He trades under the business name Social Maico. His principal place of business at 2790 Sherwin Avenue, Suite 13 Ventura, California 93003.

NATURE OF THE CASE

5. This is an action for trademark infringement arising from the intentional and deliberate use by Kortz of trademarks confusingly similar to Maico’s well known and registered and unregistered MAICO trademarks; Kortz’s repeated acts of trade libel against Maico; unfair competition under California state law; and for restitution for unjust enrichment.

6. By this action, Maico seeks to permanently enjoin Kortz from engaging in trademark infringement in violation of, 15 U.S.C. §§ 1114(1) and 1125 (a), to obtain cancellation of Kortz’s Federal trademark application no. 86/253,051 for SOCAL MAICO and Design, and to recover damages and attorneys’ fees for Kortz’s willful and deliberate conduct.

BACKGROUND

7. Maicowerk A.G. was a German motorcycle manufacturer. Founded in 1926, it manufactured smaller motorcycles for civilian and military uses. After World War II, these

1 became popular for use in motocross racing. The company encountered financial difficulties in
2 the 1970's and went out of business in the 1980's.

3 8. Plaintiff Maico was founded in 1996 by a motorcycle enthusiast, John Caldwell.
4 His dream was to restore the Maicowerk business, albeit on a smaller scale, by restoring and
5 selling genuine Maicowerk motorcycles and by selling parts that could be used by others to
6 restore and maintain Maicowerk motorcycles. These goods are sold by mail order and via
7 Maico's web site, www.maicomotorcycles.com.

8 9. Maico's business was very successful and quickly grew beyond Western Canada
9 to encompass sales throughout the United States, Canada and the world.

10 10. Maico has obtained Federal trademark registrations for MAICO and Design,
11 Federal Registration Nos. 4,137,895 and 4,156,487. This mark covers the word mark MAICO
12 and the shield design featuring a large letter "M." The mark is depicted below:



21 Copies of the registrations for the foregoing trademarks (hereinafter referred to as the "MAICO
22 Marks") are attached as Exhibit 1.

23 11. The MAICO Marks cover motorcycles for motocross, motorcycles and structural
24 parts for motorcycles in International Class 12.

25 12. The MAICO Marks are arbitrary and fanciful and have no meaning outside their
26 use by Maico to distinguish its products from those offered by others. As a result of Maico's
27 advertising and promotional efforts and its continuous use of the MAICO Marks in the United States,
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1 the MAICO Marks have become well-known for goods originating with Maico, especially among
2 motocross motorcycle aficionados.

3 13. Defendant Kortz observed the success of Maico and he started his own business
4 which he named SoCal Maico. He offered the same goods and services as Maico, including the
5 sales of restored motorcycles and parts.

6 14. Maico welcomed the competition from Kortz because it reflected the increased
7 demand for Maciowerk motorcycles, which would help both businesses. Unfortunately, Kortz
8 wanted Maico to limit its sales to Canada and he embarked on a scheme to destroy the goodwill
9 among American consumers that Maico had so carefully cultivated over the years.

10 15. Among other things, Kortz adopted Maico's trademark as his own, and he
11 incorporated it into his logo. Kortz applied to register this trademark on April 15, 2014 (SN
12 86/253,051). The applied for mark is as follows:



17 This application is for "On-line retail store services featuring new and used Maico motorcycle
18 parts" in International Class 35. His web address is www.socalmaico.com. He then petitioned the
19 Trademark Office to cancel Canadian Maico's registration no. 4,156,487, claiming that only he
20 should be permitted to register and use the MAICO Marks in the United States.

21 16. In addition to the deliberate copying of Maico's trademark, Kortz has on numerous
22 occasions made false and degrading statements about Maico and its goods to potential customers
23 and the trade. This includes sending demand letters to Maico's suppliers and posting false and
24 defamatory statements about Maico on various websites. These statements were made with the
25 purpose of harming Maico's business and its reputation so that potential customers would do
26 business with Kortz and not Maico. These repeated false statements have caused and will
27 continue to cause substantial economic damage, loss and injury to Maico.
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1 Unless such acts and practices are enjoined by the Court, Maico will continue to cause irreparable
2 harm to Maico for which there is no adequate remedy at law, and for which Maico is entitled to
3 injunctive relief.

4 **CLAIM THREE**

5 **(Common Law Trademark and Trade Name Infringement)**

6 29. Plaintiff repeats and incorporates by reference the allegations of paragraphs 1-28 as
7 though fully set forth herein. .

8 30. As between the parties, Plaintiff was the first to use the MAICO Marks in the State
9 of California and nationwide. Defendant's use of an identical or highly similar trademark and
10 trade name for identical goods and services that move in the same channels of trade has and is
11 likely to confuse consumers into believing that Defendants' goods and services originate with, are
12 licensed by otherwise associated or affiliated with Plaintiff. This constitutes common law
13 trademark and trade name infringement under California law.
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15 **CLAIM FOUR**

16 **(Unfair Competition Under California Law)**

17 31. Plaintiff repeats and incorporates by reference the allegations of paragraphs 1-30
18 as though fully set forth herein.

19 32. The foregoing acts of trademark infringement constitute unfair competition under
20 Business & Professions Code §17200. Plaintiff has suffered direct injury from these actions,
21 including the lost revenues from sales resulting from the diversion of potential customers who
22 purchased goods from Defendants in the mistaken belief that they were purchasing goods
23 authorized, licensed or sponsored by Maico.
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1 **CLAIM FIVE**

2 **(Trade Libel)**

3 33. Plaintiff repeats and incorporates by reference the allegations of paragraphs 1-32 as
4 though fully set forth herein.

5 34. As a result of Defendant's repeated false statements about Maico, its goods and its
6 business, all of which were made knowingly and with the intention of harming and inflicting
7 injury on Maico, Plaintiff has suffered pecuniary damage, injury and loss.

8 **WHEREFORE**, Plaintiff demands judgment against the Defendant as follows:

9 1. An injunction against Defendant enjoining any further infringement of Plaintiff's
10 trademarks in the United States;

11 2. An injunction against Defendant enjoining him from using any domain name
12 containing Plaintiff's trademarks in the United States;

13 3. An injunction against Defendant enjoining him from using any business name
14 containing Plaintiff's trademarks in the United States;

15 4. An injunction against Defendant enjoining him from prosecuting either his
16 trademark application or the cancellation petition filed against Plaintiff's registration;

17 5. An injunction against Defendant enjoining him from making false statements
18 about Plaintiff or its business or its products;

19 6. An award of damages in an amount to be determined at trial;

20 7. An enhancement of the that portion of the award of damages attributed to the
21 trademark infringement for wilful and deliberate conduct as permitted by the Lanham Act;

22 8. An award in the amount by which Defendant has been unjustly enriched;

23 9. Costs of suit, including Plaintiff's reasonable attorneys' fees;

24 10. An order of remedial advertising as this Court deems just; and
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11. Such further relief as this Court deems just.

Respectfully submitted,

LAW OFFICE OF PAUL W. REIDL

Dated: June 6, 2014

By: /s/ Paul W. Reidl

Paul W. Reidl (CA Bar No. 155221)
LAW OFFICE OF PAUL W. REIDL
241 Eagle Trace Drive
Half Moon Bay, CA 94019
Telephone: (650) 560-8530
Email: paul@reidllaw.com

Attorney for Plaintiff, 578539 B.C. Ltd

1 PAUL W. REIDL (SBN 155221)
Law Office of Paul W. Reidl
2 Second Floor
241 Eagle Trace Drive
3 Half Moon Bay, CA 94019
Phone: (650) 560-8530
4 paul@reidllaw.com

5 Attorneys for Plaintiff
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11 **UNITED STATES DISTRICT COURT**
12 **CENTRAL DISTRICT OF CALIFORNIA**
13 **WESTERN DIVISION**
14

15 **578539 B.C. Ltd, t/a/ CANADIAN MAICO,**

16 a Canadian corporation,

17 Plaintiff,

18 v.

19 **J. GARY KORTZ, d/b/a SOCAL MAICO,**

20 an individual residing in this District,

21 Defendant.
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Case No. _____

EXHIBIT 1

United States of America

United States Patent and Trademark Office



Reg. No. 4,156,487

578539 B.C. LTD. (CANADA CORPORATION), TA CANADIAN MAICO
4124 TORQUAY DR.

Registered June 12, 2012

VICTORIA, B. C., CANADA V8N3K9

Int. Cl.: 12

FOR: MOTORCYCLES FOR MOTOCROSS, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

TRADEMARK

FIRST USE 12-1-2002; IN COMMERCE 12-1-2002.

PRINCIPAL REGISTER

THE MARK CONSISTS OF A STYLIZED LETTER "M" IN BLACK AND WHITE WITH GOLD COLORED WINGS EMANATING FROM EITHER SIDE, THE WINGS HAVE BLACK HORIZONTAL LINES ON THEM AND ARE OUTLINED IN BLACK. THE NAME "MAICO" IS IN GOLD LETTERS ON A RED BACKGROUND ON THE TOP CENTER OF THE STYLIZED LETTER "M" AND WINGS. THERE IS A SEMI BADGE SHAPE AROUND THE PERIMETER WITH GOLD AND BLACK STRIPES

THE COLOR(S) BLACK, WHITE, RED, GOLD IS/ARE CLAIMED AS A FEATURE OF THE MARK.

SER. NO. 85-222,759, FILED 1-21-2011.

MICHELLE DUBOIS, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office

**REQUIREMENTS TO MAINTAIN YOUR FEDERAL
TRADEMARK REGISTRATION**

**WARNING: YOUR REGISTRATION WILL BE CANCELLED IF YOU DO NOT FILE THE
DOCUMENTS BELOW DURING THE SPECIFIED TIME PERIODS.**

Requirements in the First Ten Years*

What and When to File:

First Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) between the 5th and 6th years after the registration date. *See* 15 U.S.C. §§1058, 1141k. If the declaration is accepted, the registration will continue in force for the remainder of the ten-year period, calculated from the registration date, unless cancelled by an order of the Commissioner for Trademarks or a federal court.

Second Filing Deadline: You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between the 9th and 10th years after the registration date.*
See 15 U.S.C. §1059.

Requirements in Successive Ten-Year Periods*

What and When to File:

You must file a Declaration of Use (or Excusable Nonuse) **and** an Application for Renewal between every 9th and 10th-year period, calculated from the registration date.*

Grace Period Filings*

The above documents will be accepted as timely if filed within six months after the deadlines listed above with the payment of an additional fee.

**The United States Patent and Trademark Office (USPTO) will NOT send you any future notice or
reminder of these filing requirements.**

***ATTENTION MADRID PROTOCOL REGISTRANTS:** The holder of an international registration with an extension of protection to the United States under the Madrid Protocol must timely file the Declarations of Use (or Excusable Nonuse) referenced above directly with the USPTO. The time periods for filing are based on the U.S. registration date (not the international registration date). The deadlines and grace periods for the Declarations of Use (or Excusable Nonuse) are identical to those for nationally issued registrations. *See* 15 U.S.C. §§1058, 1141k. However, owners of international registrations do not file renewal applications at the USPTO. Instead, the holder must file a renewal of the underlying international registration at the International Bureau of the World Intellectual Property Organization, under Article 7 of the Madrid Protocol, before the expiration of each ten-year term of protection, calculated from the date of the international registration. *See* 15 U.S.C. §1141j. For more information and renewal forms for the international registration, see <http://www.wipo.int/madrid/en/>.

NOTE: Fees and requirements for maintaining registrations are subject to change. Please check the USPTO website for further information. With the exception of renewal applications for registered extensions of protection, you can file the registration maintenance documents referenced above online at <http://www.uspto.gov>.

United States of America

United States Patent and Trademark Office



Reg. No. 4,137,895

Registered May 8, 2012

Int. Cl.: 12

TRADEMARK

PRINCIPAL REGISTER

578539 BC. LTD (CANADA CORPORATION), DBA CANADIAN MAICO
4124 TORQUAYDR.
578539 BC LTD.
VICTORIA BC, CANADA V8N3K9

FOR: MOTORCYCLES; STRUCTURAL PARTS FOR MOTORCYCLES, IN CLASS 12 (U.S. CLS. 19, 21, 23, 31, 35 AND 44).

FIRST USE 1-20-2004; IN COMMERCE 1-20-2004.

THE MARK CONSISTS OF THE STYLIZED WORDING "MAICO" AND THE LETTER "M" WITHIN A DESIGN OF A SHIELD. HORIZONTAL LINES THAT LOOK LIKE WINGS ARE ATTACHED TO THE LETTER "M".

SER. NO. 85-307,242, FILED S.R. 4-28-2011 AM. P.R. 12-16-2011.

EVELYN BRADLEY, EXAMINING ATTORNEY



David J. Kyppas

Director of the United States Patent and Trademark Office

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Requirements in Successive Ten-Year Periods*

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