

ESTTA Tracking number: **ESTTA612043**

Filing date: **06/25/2014**

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	PAUL W REIDL LAW OFFICE OF PAUL W REIDL 241 EAGLE TRACE DRIVE, SECOND FLOOR HALF MOON BAY, CA 94019 UNITED STATES johnwell@shaw.ca, info@iproperty.ca, paul@reidllaw.com
Submission	Reply in Support of Motion
Filer's Name	Paul W. Reidl
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Signature	/pwr/
Date	06/25/2014
Attachments	Reply on Motion to Suspend.pdf(42434 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. )

Cancellation No. 92058956

**REPLY ON MOTION TO SUSPEND**

12           Respondent submits this brief reply on its motion to suspend.

13           1.       The motion should be stricken because it does not contain a certificate of service  
14 and is therefore procedurally defective. Counsel for Petitioner only learned of it during a routine  
15 docket check.

16           2.       The second paragraph of Petitioner’s response is simply an elaboration on the  
17 arguments made in his petition. It is not germane to the motion.

18           3.       The principal argument against suspension seems to be that Petitioner “is not  
19 contesting [Respondent’s] ownership” of the mark and the validity of the registration in the  
20 Federal Court action. Technically, this is true because Petitioner has until June 30 to answer or  
21 otherwise plead. But it is also irrelevant because as TBMP § 510.02 (a) makes clear, the issue is  
22 not whether Petitioner has raised the precise issue with the Court but, rather, whether the Federal  
23 Court proceeding has issues in common with the Board proceeding. It is hornbook law that in  
24

1 any infringement action the first element of proof is ownership of the trademark. *E. & J. Gallo*  
2 *Winery v. Gallo Cattle Co.*, 12 U.S.P.Q.2d 1657, 1670, (E.D.Cal.1989), *aff'd*, 967 F.2d 1280 (9th  
3 Cir.1992). That is the precise issue raised by Petitioner before the Board. While Petitioner may  
4 prefer to have the Board, and not the Federal Court, resolve that question, he makes that tactical  
5 decision at his peril. Once the Federal Court determines that the registration is valid, Petitioner  
6 will not be permitted to relitigate that question before the Board. *See, e.g., Zachry*  
7 *Infrastructure, LLC v. American Infrastructure, Inc.*, 101 U.S.P.Q.2d 1249 (TTAB 2011); Fed.  
8 R. Civ. 13 (a)(1)(A)(“A pleading must state as a counterclaim any claim that – at the time of its  
9 service – the pleader has against an opposing party if the claim .... arises out of the transaction or  
10 occurrence that is the subject matter of the opposing party's claim....”); *see Polymer Indus. Prod.*  
11 *Co. v. Bridgestone/Firestone, Inc.*, 347 F.3d 935 (Fed. Cir. 2003)(failure to bring a compulsory  
12 counterclaim waives the claim.)

13 4. The Board should therefore suspend this proceeding in the interests of judicial  
14 economy.

Respectfully submitted,

**LAW OFFICE OF PAUL W. REIDL**



By: \_\_\_\_\_

19 Dated: June 25, 2014

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*Attorney for Respondent,  
578538 B.C. Ltd.*

1 **PROOF OF SERVICE**

2 On June 25, 2014, I caused to be served the following document:

3 **REPLY ON MOTION TO SUSPEND**

4 on Petitioner by placing a true copy thereof in the United States mail enclosed in an envelope,  
5 postage prepaid, addressed as follows to their counsel of record at his present business address:

6 J. Gary Kortz  
7 2790 Sherwin Drive  
8 Suite 13  
9 Ventura, CA 93003

10 Executed on June 25, 2014 at Half Moon Bay, California.

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