

ESTTA Tracking number: **ESTTA564856**

Filing date: **10/14/2013**

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

Proceeding	92057820
Party	Defendant American D.J. Supply, Inc.
Correspondence Address	AMERICAN D J SUPPLY INC 6122 SOUTH EASTERN AVENUE LOS ANGELES, CA 90040 UNITED STATES
Submission	Other Motions/Papers
Filer's Name	Joshua A. Schaul
Filer's e-mail	trialteam@sziplaw.com, docketing@sziplaw.com
Signature	/s/ Joshua A. Schaul
Date	10/14/2013
Attachments	20131007 ADJ1-LIT.e16.C_Motion to Suspend.pdf(393574 bytes )

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

In the matter of Trademark Registration

Reg. No.: 3,964,197  
Registered: May 24, 2011  
By: American DJ Supply, Inc.  
For the Trademark: AMERICAN AUDIO

AMERICAN PRO INTERNATIONAL  
CORP.,

Petitioner,

vs.

AMERICAN DJ SUPPLY, INC.,

Respondent.

Cancellation No. 92057820

**MOTION TO SUSPEND PROCEEDINGS**

**MOTION TO SUSPEND PROCEEDINGS**

Respondent American DJ Supply, Inc. (“American DJ”) hereby notifies the Trademark Trial and Appeal Board that American DJ and petitioner American Pro International Corp. (“American Pro”) are engaged in multiple civil actions and other Board proceedings which may have a bearing on the instant case. American DJ respectfully requests suspension of the instant proceedings pursuant to T.B.M.P. section 510 and 37 C.F.R 2.117.

On October 17, 2013, American DJ initiated an action against American Pro and its conspirators in the United States District Court for the Central District of California, case no.: CV12-08951 MWF (Ex), alleging, among other things,

infringement of American DJ's American DJ®, American Audio® and American™ trademarks (the "First Action"). The First Action is currently on appeal in the United States Court of Appeals for the Ninth Circuit, case no.: 13-56087.

On June 11, 2013, American Pro and its conspirators initiated an action for declaratory judgment in the United States District Court for the Southern District of California, case no.: CV13-22093 CMA (the "Second Action"). In the Second Action, American Pro seeks a declaratory judgment that its use of an "American Pro" mark neither infringes nor falsely designated American DJ's American DJ® and American Audio® trademarks.

Moreover, on July 26, 2013, American DJ filed counterclaims against American Pro and its conspirators in the Second Action, alleging trademark infringement of American DJ's American DJ®, American Audio® and American™ trademarks. On September 13, 2013, American Pro filed its amended answer and affirmative defenses, a copy of which is attached hereto as **Exhibit A** and incorporated by reference herein. In its fourth affirmative defense, American Pro unequivocally asserts that American DJ's counterclaim for trademark infringement "is barred, in whole or in substantial part, because the mark AMERICAN AUDIO is merely descriptive and this trademark has not acquired secondary meaning." See Exhibit A, pg. 11.

Further, contemporaneous with the filing of the instant action, American Pro filed two additional petitions to cancel to American DJ's American DJ® and AmericanDJ® trademarks, cancellation nos.: 92057806 and 92057807.

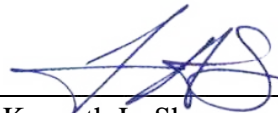
Pursuant to TBMP 510 and 37 C.F.R. 2.117(a), "[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding." 37 C.F.R.

2.117(a).

The First and Second Actions involve American Pro's infringement of American DJ's American Audio® trademark, the subject of the instant petition to cancel. Additionally, in its fourth affirmative defense in the Second Action, American Pro asserts that American DJ's American Audio® trademark is merely descriptive. The outcome of this affirmative defense will have a bearing on the instant petition to cancel. Therefore, American DJ respectfully requests suspension of the instant cancellation proceeding pending termination of the First and Second Actions.

Date: October 14, 2013

SHERMAN & ZARRABIAN LLP

By:   
Kenneth L. Sherman, Reg. No.: 33783  
Joshua A. Schaul, Reg. No.: 57691  
Attorneys for respondent  
AMERICAN DJ SUPPLY, INC.

# **EXHIBIT A**

**IN THE UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF FLORIDA**

**CASE NO. 13-CV-22093-ALTONAGA**

**AMERICAN PRO INTERNATIONAL  
CORP., ARPI GROUP, INC., CLAUDIO  
RESNICK, and OMAR DIAZ BLASCO,**

Plaintiffs,

v.

**AMERICAN DJ SUPPLY, INC.,**

Defendant.

\_\_\_\_\_ /

**AMERICAN DJ SUPPLY, INC.,**

Counter-Plaintiff,

v.

**AMERICAN PRO INTERNATIONAL  
CORP., ARPI GROUP, INC., CLAUDIO  
RESNICK, OMAR DIAZ BLASCO, and  
SHOW IMPORT SA,**

Counter-Defendants.

\_\_\_\_\_ /

**COUNTER-DEFENDANTS' AMENDED ANSWER TO COUNTER-  
PLAINTIFF'S COUNTERCLAIMS AND AFFIRMATIVE DEFENSES**

Counter-Defendants American Pro International Corp. ("American Pro"), ARPI Group, Inc. ("ARPI"), Claudio Resnick ("Resnick"), Omar Diaz Blasco ("Blasco"), and

Show Import SA (“Show Import”)<sup>1</sup> (collectively, “Counter-Defendants”), by their attorneys, hereby answer the numbered paragraphs of Counter-Plaintiff American DJ Supply, Inc.’s (“ADJ”) Counterclaims (Doc. No. 20), as follows:

**PARTIES**

1. Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1 and they are therefore denied.

2. American Pro admits the allegations of Paragraph 2; the remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2 and they are therefore denied.

3. ARPI admits the allegations of Paragraph 3; the remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in the third numbered paragraph and they are therefore denied.

4. Resnick admits the allegations of Paragraph 4; the remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4 and they are therefore denied.

5. Blasco and Show Import admit that Blasco is President of American Pro and a minority shareholder in Show Import. Blasco and Show Import deny the remaining allegations of Paragraph 5. The remaining Counter-Defendants are without knowledge or

---

<sup>1</sup> Show Import is waiving personal service strictly for purposes of responding to ADJ’s instant counterclaims. Show Import is not waiving any other position, particularly with respect to service of process or personal jurisdiction, in any other jurisdiction.

information sufficient to form a belief as to the truth of the allegations in Paragraph 5 and they are therefore denied.

6. Blasco and Show Import admit that Show Import is an Argentine company. Blasco and Show Import deny the remaining allegations of Paragraph 6, including the allegation that "Macaio Argentina" is a fictitious name of Show Import. The remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6 and they are therefore denied.

7. Counter-Defendants deny the allegations of Paragraph 7.

8. Counter-Defendants deny the allegations of Paragraph 8.

9. Counter-Defendants deny the allegations of Paragraph 9.

10. Counter-Defendants admit that ADJ alleges that its counterclaim is subject to the jurisdiction of this Court. Counter-Defendants deny the remaining allegations of Paragraph 10.

11. Counter-Defendants admit that ADJ alleges that its counterclaim is also based on diversity jurisdiction. Counter-Defendants deny the remaining allegations of Paragraph 11.

12. Counter-Defendants ARPI, American Pro, Blasco, and Resnick admit the allegations of Paragraph 12. Counter-Defendant Show Import denies the allegations of Paragraph 12, notwithstanding its waiver of formal service of process of the counterclaim.

13. Counter-Defendants ARPI, American Pro, Blasco, and Resnick admit the allegations of Paragraph 12. Counter-Defendant Show Import denies the allegations of



Paragraph 13, notwithstanding its waiver of formal service of process of the counterclaim.

14. Counter-Defendants deny the allegations of Paragraph 14.

15. Counter-Defendants deny the allegations of Paragraph 15.

16. Counter-Defendants deny the allegations of Paragraph 16.

17. Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 17 and they are therefore denied.

18. Counter-Defendants deny the allegations of Paragraph 18.

19. Counter-Defendants deny the allegations of Paragraph 19.

20. Counter-Defendants deny the allegations of Paragraph 20.

21. Counter-Defendants deny the allegations of Paragraph 21.

22. Counter-Defendants admit that they were aware of the existence of ADJ prior to ADJ's initiation of a lawsuit in the Central District of California in October 2012. Counter-Defendants deny the remaining allegations of Paragraph 22.

23. Counter-Defendants Blasco and Show Import admit that Show Import has previously been a dealer of ADJ products in South America. Counter-Defendants Blasco and Show Import deny the remaining allegations of Paragraph 23. The remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 23 and they are therefore denied.

24. Counter-Defendants Resnick and ARPI admit that ARPI has previously been a dealer of ADJ products in the United States. Counter-Defendants Resnick and

ARPI deny the remaining allegations of Paragraph 24. The remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 24 and they are therefore denied.

25. Counter-Defendants Blasco and Show Import admit that Show Import has previously been a dealer of ADJ products in South America. Counter-Defendants Resnick and APRI admit that ARPI has previously been a dealer of ADJ Products in the United States. Counter-Defendants Blasco, Show Import, Resnick, and ARPI deny the remaining allegations of Paragraph 25. Counter-Defendant American Pro is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 25 and they are therefore denied.

26. Counter-Defendants deny the allegations of Paragraph 26.

27. Counter-Defendants Blasco and Show Import admit that Show Import has previously been a dealer of ADJ products in South America. Counter-Defendants Blasco and Show Import deny the remaining allegations of Paragraph 27. The remaining Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 27 and they are therefore denied.

28. Counter-Defendants deny the allegations of Paragraph 28.

29. Counter-Defendants deny the allegations of Paragraph 29.

30. Counter-Defendants deny the allegations of Paragraph 30.

31. Counter-Defendants deny the allegations of Paragraph 31.

32. Counter-Defendants deny the allegations of Paragraph 32.

33. Counter-Defendants deny the allegations of Paragraph 33.

34. Counter-Defendants deny the allegations of Paragraph 34.

35. Counter-Defendants Resnick and ARPI admit that Resnick is an owner of ARPI and involved in ARPI's day-to-day operations. Counter-Defendants Resnick, Blasco, and American Pro admit that Resnick and Blasco are owners of American Pro and involved in American Pro's day-to-day operations. Counter-Defendants deny the remaining allegations of Paragraph 35.

36. Counter-Defendants deny the allegations of Paragraph 36.

37. Counter-Defendants deny the allegations of Paragraph 37.

#### **FIRST CLAIM FOR RELIEF**

38. Counter-Defendants repeat and incorporate by reference their responses to Paragraphs 1-37 of the Counterclaim.

39. Counter-Defendants are without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 39 and they are therefore denied.

40. Counter-Defendants deny the allegations of Paragraph 40.

41. Counter-Defendants deny the allegations of Paragraph 41.

42. Counter-Defendants deny the allegations of Paragraph 42.

43. Counter-Defendants deny the allegations of Paragraph 43.

44. Counter-Defendants deny the allegations of Paragraph 44.

45. Counter-Defendants deny the allegations of Paragraph 45.

46. Counter-Defendants deny the allegations of Paragraph 46.

47. Counter-Defendants deny the allegations of Paragraph 47.

48. Counter-Defendants deny the allegations of Paragraph 48.

49. Counter-Defendants deny the allegations of Paragraph 49.

50. Counter-Defendants deny the allegations of Paragraph 50.

51. Counter-Defendants deny the allegations of Paragraph 51.

### **SECOND CLAIM FOR RELIEF**

52. Counter-Defendants repeat and incorporate by reference their responses to Paragraphs 1-37 of the Counterclaim.

53. Counter-Defendants admit that Paragraph 53 references the Florida Deceptive and Unfair Trade Practices Act. Counter-Defendants deny the remaining allegations of Paragraph 53.

54. Counter-Defendants deny the allegations of Paragraph 54.

55. Counter-Defendants deny the allegations of Paragraph 55.

56. Counter-Defendants deny the allegations of Paragraph 56.

57. Counter-Defendants deny the allegations of Paragraph 57.

58. Counter-Defendants deny the allegations of Paragraph 58.

59. Counter-Defendants deny the allegations of Paragraph 59.

60. Counter-Defendants deny the allegations of Paragraph 60.

### **THIRD CLAIM FOR RELIEF**

61. Counter-Defendant Show Import repeats and incorporates by reference its responses to Paragraphs 1-37 of the Counterclaim.

62. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

63. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

64. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

65. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

66. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

67. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

68. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

69. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

70. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

71. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

72. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

73. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

74. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

75. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

76. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

77. Show Import states that the Third Claim for Relief is the subject of a Motion to Dismiss (Doc. No. 22) and will be answered, if necessary, upon disposition of the Motion to Dismiss.

#### **FOURTH CLAIM FOR RELIEF**

78. Counter-Defendants repeat and incorporate by reference their responses to Paragraphs 1-37 of the Counterclaim.

79. Counter-Defendants deny the allegations of Paragraph 79.

80. Counter-Defendants deny the allegations of Paragraph 80.

81. Counter-Defendants deny the allegations of Paragraph 81.

82. Counter-Defendants deny the allegations of Paragraph 82.

#### **FURTHER ANSWER AND AFFIRMATIVE DEFENSES**

By way of further Answer and as affirmative defenses, Counter-Defendants deny that they are liable to ADJ on any of the claims alleged and denies that ADJ is entitled to damages, treble or punitive damages, equitable relief, attorneys' fees, costs, pre-judgment interest or to any relief whatsoever, and states as follows:

#### **FIRST AFFIRMATIVE DEFENSE**

As a first, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim, on one more counts as set forth therein, is barred as ADJ has failed to properly plead the proper elements upon which relief can be granted.

### **SECOND AFFIRMATIVE DEFENSE**

As a second, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred because ADJ does not have any protectable rights in the term "American" and therefore cannot state a claim upon which relief can be granted.

### **THIRD AFFIRMATIVE DEFENSE**

As a third, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in part, by the doctrine of unclean hands. ADJ has unclean hands because ADJ committed fraud on the United States Patent and Trademark Office ("PTO") in maintaining and renewing the trademark registrations for their so-called "family of American marks," including without limitation AMERICANDJ and AMERICAN DJ, when ADJ knowingly made false, material representations with the intent to deceive the PTO. Specifically, ADJ knowingly and falsely represented that it was using the AMERICANDJ and AMERICAN DJ trademarks, with the intent to deceive the PTO when it maintained and renewed its registrations, as the PTO would not have maintained and renewed ADJ's trademark registrations but for ADJ's false representations.

### **FOURTH AFFIRMATIVE DEFENSE**

As a fourth, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in substantial part, because the mark AMERICAN AUDIO is merely descriptive and this trademark has not acquired secondary meaning with respect to ADJ.



**FIFTH AFFIRMATIVE DEFENSE**

As a fifth, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in substantial part, by laches because ADJ had prior knowledge of Counter-Defendants' use of the term "American" and failed to object to this usage and unreasonably delayed in bringing suit.

**SIXTH AFFIRMATIVE DEFENSE**

As a sixth, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in substantial part, by estoppel because ADJ's delay in bringing suit against Counter-Defendants caused and is causing prejudice to Counter-Defendants.

**SEVENTH AFFIRMATIVE DEFENSE**

As a seventh, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in substantial part, by acquiescence because Counter-Defendants openly used the phrase "American Pro" for over 10 years without objection, and in fact with consent, from ADJ.

**EIGHTH AFFIRMATIVE DEFENSE**

As an eighth, separate and distinct affirmative defense, Counter-Defendants assert that there has been no actual confusion or confusion of any type or quality during a substantial period of concurrent use and therefore no likelihood of confusion exists.

**NINTH AFFIRMATIVE DEFENSE**

As a ninth, separate and distinct affirmative defense, Counter-Defendants assert that even assuming infringement, unfair competition or any other allegedly improper

activity is proven by ADJ, which Counter-Defendants expressly deny, ADJ cannot establish that it has suffered or will suffer damages.

#### **TENTH AFFIRMATIVE DEFENSE**

As a tenth, separate and distinct affirmative defense, Counter-Defendants assert that ADJ's Counterclaim is barred, in whole or in substantial part, by its own bad faith acts because ADJ s filed the Counterclaim for the purpose of harassment and extortion.

#### **ELEVENTH AFFIRMATIVE DEFENSE**

As an eleventh, separate and distinct affirmative defense, Counter-Defendants assert, without admitting that the Counterclaim states a claim, that any remedies are limited to the extent that there is sought an overlapping or duplicative recovery pursuant to the various claims against Counter-Defendants for any alleged single wrong.

WHEREFORE, Counter-Defendants pray for judgment as follows:

1. That ADJ takes nothing by way of its Counterclaim;
2. That the Counterclaim, and each and every purported claim for relief therein, be dismissed with prejudice.
3. That Counter-Defendants be awarded their costs of suit incurred herein, including attorneys' fees and expenses; and
4. For such other and further relief as the Court deems just and proper.

DATED: September 13, 2013

Respectfully submitted,

**FRIEDLAND VINING, P.A.**

s/David K. Friedland

By: **David K. Friedland**

Florida Bar No. 833479

Email: [dkf@friedlandvining.com](mailto:dkf@friedlandvining.com)

**Jaime Rich Vining**

Florida Bar No. 030932

Email: [jrv@friedlandvining.com](mailto:jrv@friedlandvining.com)

1500 San Remo Ave., Suite 200

Coral Gables, FL 33146

(305) 777-1720 – telephone

(305) 456-4922 – facsimile

*Counsel for Plaintiffs  
and Counter-Defendants*

**CERTIFICATE OF SERVICE**

I hereby certify that on the above referenced date, I electronically filed the foregoing document with the Clerk of the Court using CM/ECF. I also certify that the foregoing document is being served this day on all counsel of record or pro se parties identified on the attached Service List in the Manner specified, either via transmission of Notices of Electronic Filing generated by CM/ECF or in some other authorized manner for those counsel or parties who are not authorized to receive electronically Notices of Electronic Filing.

**Allan A. Joseph, Esq.**

Email: [ajoseph@fuerstlaw.com](mailto:ajoseph@fuerstlaw.com)

**Michael B. Kornhauser, Esq.**

Email: [mkornhauser@fuerstlaw.com](mailto:mkornhauser@fuerstlaw.com)

**FUERST ITTLEMAN DAVID & JOSEPH, PL**

1001 Brickell Bay Dr., 32<sup>nd</sup> Floor

Miami, FL 33131

(305) 350-5690 – telephone

(305) 786-364-7995 – facsimile

*Service via CM/ECF*

**Kenneth L. Sherman, Esq.**

Email: Sherman@sziplaw.com

**Joshua Schaul, Esq.**

Email: schaul@sziplaw.com

**SHERMAN & ZARRABIAN LLP**

1411 5<sup>th</sup> St., Suite 306

Santa Monica, CA 90401

(424) 229-6800 – telephone

(424) 229-6815 – facsimile

*Service via CM/ECF*

**James A. McQueen, Esq.**

Email: jmcqueen@mcqueenashman.com

**MCQUEEN & ASHMAN LLP**

19900 MacArther Blvd., Suite 1150

Irvine, CA 92612

(949) 223-9601 – telephone

*Service via CM/ECF*

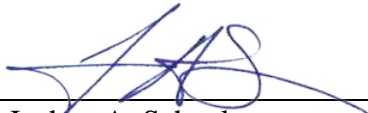
s/David K. Friedland

David K. Friedland

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing **MOTION TO SUSPEND PROCEEDINGS** has been served on Petitioner's counsel by mailing said copy on October 14, 2013, via First Class Mail, postage prepaid:

David K. Friedland  
FRIEDLAND VINING, P.A.  
1500 San Remo Avenue, Suite 200  
Coral Gables, Florida 33146

  
\_\_\_\_\_  
Joshua A. Schaul