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

Proceeding	92061514
Party	Plaintiff John Shuman
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Date	01/18/2017
Attachments	Notice of Disposition of Civil Action.pdf(505143 bytes) Memorandum Opinion.pdf(2072861 bytes) Order Granting Motion for Summary Judgment.pdf(46419 bytes)

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

JOHN SHUMAN,

Petitioner,

v.

Cancellation No. 92061514

HUI KUN LI,

Respondent.

PETITIONER'S NOTICE OF DISPOSITION OF CIVIL ACTION

Petitioner, John Shuman, pursuant to the Board's order of January 11, 2016, hereby gives notice of the disposition of the civil action between Petitioner and Respondent, Hui Kun Li, and states as follows:

1. On May 18, 2015, Petitioner, acting *pro se*, filed a petition to cancel Reg. No. 4216849 and Reg. No. 4265943. Petitioner asserted, among other things, that the registrations should be cancelled because Respondent ceased use of the subject marks in 2011, prior to seeking registration, and because Petitioner or his related businesses were using the marks exclusively at that time.

2. On October 12, 2015, Petitioner, again acting *pro se*, and with leave of the Board, filed an amended petition to cancel Reg. No. 4216849 and Reg. No. 4265943. In addition to his prior arguments, Petitioner asserted that Respondent committed fraud in the procurement of the registration of the marks, in that she represented she was using the marks in commerce when in fact she had ceased using them in 2011; that any prior use of the marks had not been by Respondent personally, as she represented, but through a multi-member limited liability company of which Petitioner was also a member; and that Petitioner had continuously used the

marks exclusively in connection with his own business entities, of which Respondent was not a member or owner, or personally, since June 2011.

3. Respondent filed a federal court action in the United States District Court for the Western District of Virginia against Petitioner, alleging infringement of the subject marks and other related claims (the “civil action”). Petitioner defended the civil action on many of the same grounds asserted before the Board in support of his petition for cancellation of the marks. On January 11, 2016, the Board suspended these proceedings pending final disposition of the civil action.

4. Pursuant to the Board’s January 11, 2016 order suspending these proceedings, Petitioner hereby notifies the Board of the final disposition of the civil action. The parties engaged in full discovery in the civil action, including extensive written discovery, document exchange, and oral testimony by way of deposition, including depositions of Petitioner and Respondent. Following discovery and briefing submitted to the court by Petitioner and Respondent, the court dismissed Respondent’s trademark infringement claims and the civil action as a whole on December 9, 2016. A copy of the court’s memorandum opinion and order are submitted herewith. Respondent’s time to appeal the disposition of the civil action expired on January 9, 2017, without an appeal, and that disposition is final.

5. In dismissing the civil action, the court made certain findings which are pertinent to the Board’s determination of these proceedings. The court, citing Respondent’s own deposition testimony, found that Respondent had not used the marks since May 2011 (*see* memorandum opinion at p. 21 and fn. 16). The court further found that Respondent did not apply for registration of the marks until December 2011, after she ceased any use of the marks and after Petitioner began using the marks exclusively (*see* memorandum opinion at p. 26 and fn.

16). The court also found that, even if Respondent could prove the validity of the marks, her prior use of the marks was only through the limited liability company of which she and Petitioner were both members, and not by Respondent personally (*see* memorandum opinion at p. 34-37, citing *Kristin Marie Conolty d/b/a Fairway Fox Golf v. Conolty O'Connor NYC LLC*, 111 U.S.P.Q.2d 1302 (TTAB July 3, 2014)).

6. These factual findings demonstrate that Petitioner's request for cancellation is appropriate, because, as the court recognized in the civil action, the registrations obtained by Respondent are void *ab initio* since Respondent was not the sole owner of the marks; Respondent was not using the marks in commerce when she sought registration; and Petitioner had been using the marks exclusively in connection with his separate businesses since June 2011, both before and during Respondent's registration proceedings before the Board. Respondent's false representations to the contrary in seeking registration of the marks should result in their cancellation.

WHEREFORE, Petitioner respectfully requests that Reg. No. 4216849 and Reg. No. 4265943 be cancelled and that his Amended Petition to Cancel be sustained.

Dated: January 18, 2017

Respectfully submitted,

JOHN SHUMAN

By: /s/ Andrew S. Baugher
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CERTIFICATE

I hereby certify that a true and complete copy of the foregoing Notice of Disposition of Civil Action has been served on Michael N. Lau, Esq., counsel for Respondent, Hui Kun Li, by mailing said copy on January 18, 2017, by First Class Mail, postage prepaid, and by e-mailing said copy on the same date, to:

Michael N. Lau, Esq.
Lau & Associates, LLC
10517 West Drive, unit B
Fairfax, VA 22030
M-Lau@Michaelnlau.com
Counsel for Respondent

/s/ Andrew S. Baugher
Dated: January 18, 2017

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