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

Proceeding	91211895
Party	Plaintiff Dixie Flyers Motorcycle Club, Inc.
Correspondence Address	JULIE A TENNYSON BOEHL STOPHER & GRAVES LLP 410 BROADWAY PADUCAH, KY 42001 UNITED STATES itennyson@bsgpad.com, nholland@whitlow-law.com
Submission	Motion to Amend Pleading/Amended Pleading
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Date	02/21/2014
Attachments	Dixie Flyers Motion to amend opposition.pdf(80047 bytes ) Dixie Flyers Motion to amend opposition memorandum.pdf(101642 bytes ) Dixie Flyers Exhibit A William Curtis wearing a Dixie Flyers t-shirt.pdf(1682541 bytes ) Dixie Flyers AMENDED NOTICE OF OPPOSITION.pdf(105627 bytes ) Dixie Flyers Exhibit B William Curtis at a Dixie Flyers Meeting.pdf(1196934 bytes ) Dixie Flyers ORDER on Motion to amend notice of opposition.pdf(73853 bytes )

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

DIXIE FLYERS MOTORCYCLE CLUB, INC,	)	OPPOSITION NO. 91211895
OPPOSER	)	
	)	
V.	)	SERIAL NO. 85859162
	)	
WILLIAM CURTIS,	)	MARK: DIXIE FLYERS M/C
APPLICANT	)	

**MOTION TO AMEND OPPOSITION**

Dixie Flyers Motorcycle Club, Inc. (“Dixie Flyers MC”) moves to amend opposition to more specifically add a claim of fraud.

Respectfully submitted,

BOEHL STOPHER & GRAVES, LLP

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**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing has been served by email and mail on:

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on this the 21<sup>st</sup> day of February, 2014

/Julie A. Tennyson/  
\_\_\_\_\_  
Julie A. Tennyson

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**MEMORANDUM IN SUPPORT OF MOTION TO AMEND**

Dixie Flyers Motorcycle Club, Inc. (“Dixie Flyers MC”) moves to amend its complaint to more specifically add a claim of fraud.

**FACTS**

In 1938, Dixie Flyers MC was established. (Affidavit of Ritch Metcalfe, ¶4 filed with Motion for Summary Judgment). In 1969, William Curtis, Roger Cron, and six other men decided to make the organization more active. (Id. at ¶5). During that time period, eight of the members created the double-winged wheel with eight spokes logo that Dixie Flyers MC registered along with the name “Dixie Flyers” as a Kentucky trademark on February 20, 2013. (Id. at ¶6, see also Notice of Opposition). The eight spokes in the logo represented the eight members that came together to make the logo. (Id. at ¶7). In 1996, Dixie Flyers MC again experienced a surge in membership and activities. (Id. at ¶8). Dixie Flyers MC became incorporated with the Kentucky Secretary of State in 2007. (Id. at ¶9). William Curtis became a member of Dixie Flyers MC around 1969. (Id. at ¶10a). By 1996, William Curtis was no longer an active member of Dixie Flyers MC. (Id. at ¶10b). On or around 2012, William Curtis was considered a past member who could attend meetings but did not have full membership privileges, such

as the right to vote and did not pay dues. (Id. at ¶11). On or around 2012, William Curtis became upset with how the election of officers went. (Id. at ¶12). The election was consistent with the by-laws of Dixie Flyers MC. (Id. at ¶13). William Curtis has in bad faith fraudulently attempted to procure the rights to the trademark Dixie Flyers MC by filing SERIAL NO. 85859162 on August 6, 2013. (Id. at ¶14). William Curtis knows that the trademark Dixie Flyers MC belongs to the club itself and not to him as an individual. (Id. at ¶15). William Curtis filed SERIAL NO. 85859162 with the intent to deprive the rightful owners—the club itself—from being able to exercise its common law, Lanham Act, and Kentucky trademark rights. (Id. at ¶16). Dixie Flyers MC is the senior user and any right that Mr. Curtis had to the trademark was derived from his membership in the club. (Id. at ¶17). William Curtis was expelled from the club on October 6, 2013 as a result of his fraudulent actions in trying hijack the club’s trademark for his personal use. (Id. at ¶18).

## **DISCUSSION**

TBMP § 507.2 states:

a party may amend its pleading only by written consent of every adverse party or by leave of the Board; leave must be freely given when justice so requires. See FRCP 15(a). In view thereof, the Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties.

Id. Further, “The timing of a motion for leave to amend under FRCP 15(a) plays a large role in the Board’s determination of whether the adverse party would be prejudiced by allowance of the proposed amendment.” Id. Numerous cases have held that the Board should allow pleadings to be amended prior to the trial period starting. See *Commodore*

*Electronics Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503 (TTAB 1993) (no prejudice to applicant--discovery still open when motion filed, and opposer agreed to allow applicant further time for follow-up discovery on new claim); *United States Olympic Committee v. O-M Bread Inc.*, 26 USPQ2d 1221 (TTAB 1993) (applicant would not be prejudiced because proceeding still in pre-trial stage and discovery had been extended); *Focus 21 International Inc. v. Pola Kasei Kogyo Kabushiki Kaisha*, 22 USPQ2d 1316 (TTAB 1992) (motion to amend filed prior to opening of petitioner's testimony period); *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (where oppose filed motion to amend its pleading during its testimony period, motion nevertheless granted since the interests of justice and judicial economy would best be served thereby, and since any prejudice suffered by applicant could be mitigated by reopening discovery solely for applicant); *Microsoft Corp. v. Qantel Business Systems Inc.*, 16 USPQ2d 1732 (TTAB 1990) (ordinarily, leave to amend should be granted whenever, inter alia, doing so will not unduly delay trial--here, proceeding was still in the discovery stage, and respondent had not shown that any undue prejudice would result from the amendment of the petition to cancel); *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989) (since cases were still in the discovery stage, respondent would not be prejudiced by allowance of amendment); *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) (no substantial prejudice to applicant by allowance of amendment--proceeding remained in a fairly early stage); *Caron Corp. v. Helena Rubenstein, Inc.*, 193 USPQ 113 (TTAB 1976) (neither party had as yet taken testimony); *Anheuser-Busch, Inc. v. Martinez*, 185 USPQ 434 (TTAB 1975) (since proceeding was still in the pre-trial stage, amendment of the pleadings could not prejudice opposer).

Public policy dictates that Applicants shall not violate the Trademark Office's integrity by filing fraudulent registrations. Discovery is still open in this case. Opposer filed a motion for summary judgment on fraud. Applicant did not respond. The Board denied the claim because the Board found that fraud had not been pled. Opposer files this motion to amend to more specifically plead fraud.

Wherefore, Opposer respectfully requests that its Notice of Opposition be amended as stated in the proposed amended notice of opposition attached to this Motion.

Respectfully submitted,

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on this the 21<sup>st</sup> day of February, 2014

/Julie A. Tennyson/  
Julie A. Tennyson



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V.	)	SERIAL NO. 85859162
	)	
WILLIAM CURTIS,	)	MARK: DIXIE FLYERS M/C
APPLICANT	)	

**AMENDED NOTICE OF OPPOSITION**

1. Opposer Dixie Flyers Motorcycle Club, Inc. (“DFMC” or “Opposer”) believes that it and the public will be damaged by Applicant William Curtis’s application to register the mark DIXIE FLYERS M/C pursuant to Application Serial No. 85859162 (the “Proposed Mark”) filed February 25, 2013, and any resulting registration therefrom, and any use of the Proposed Mark, and hereby opposes the registration of the Proposed Mark.

2. DFMC is a Kentucky non-profit corporation, with its principal office at 669 AC Slaton Road, Madisonville, Kentucky 42431. Though the corporation was only formally incorporated in 2007, the predecessor club has been in continuous operation as a fraternal organization since 1938.

3. DFMC is a fraternal organization operating in Madisonville, Kentucky in which the members have a shared interest in motorcycles and motorcycle culture. DFMC offers its members an opportunity to engage with each other regarding their shared interests at regular meetings and other social events. In addition, DFMC and its members are active in the local community, holding numerous charity and fundraising events throughout the year. This includes an annual DFMC “Backpack Run,” where

DFMC raises funds and collects donations of school supplies for children and families in need.

4. DFMC is the owner of several common law trademarks, including DIXIE FLYERS, DIXIE FLYERS M/C, and DIXIE FLYERS MOTORCYCLE CLUB. In addition, since 1938, DFMC has used a design mark that includes the words “Dixie Flyers” over a picture of a winged-wheel which has the letters “MC” inside the wheel (the “Design Mark” and together with DIXIE FLYERS, DIXIE FLYERS M/C, and DIXIE FLYERS MOTORCYCLE CLUB the “DFMC Marks”). DFMC has continuously used these marks in commerce since 1938 to identify its services and activities and has protected these marks from use by others.

5. DFMC has continuously used the DFMC Marks in association with its services as a fraternal and charitable organization. Consumers and the public have come to associate the DFMC Marks with DFMC and these services and charitable efforts. As a result, DFMC Marks have become assets of substantial value to DFMC.

6. On February 20, 2013, DFMC filed a trademark registration with the Kentucky Secretary of State for the word mark DIXIE FLYERS and for its Design Mark. A copy of the registration certificate is attached to this filing as Exhibit “A.” Both the state registration and DFMC’s first use in commerce predate the filing of the application for registration of the Proposed Mark.

7. The DFMC Marks were first used in commerce long before Applicant’s application for registration of the Proposed Mark was filed. DFMC has priority common law rights and state law rights in the DFMC Marks, including DIXIE FLYERS M/C.

8. DFMC members pay annual dues. Membership in DFMC includes the privilege

to wear the DFMC Marks. DFMC sells shirts, patches, rings, belt buckles and other items of clothing featuring the DFMC Marks. Particularly relevant to this opposition, DFMC regularly uses the DFMC Marks on t-shirts that it sells or distributes free to promote DFMC and to commemorate special events or fundraisers.

9. DFMC's services and activities are well known as providing a first-class fraternal organization and the public has come to associate the DFMC Marks with DFMC and its services. DFMC has also been recognized in news stories for its good works, and such stories have featured the DFMC Marks.

10. DFMC is informed and believes that Applicant William Curtis is an individual having an address of 211 Cherokee Court, Cadiz, Kentucky, 42211. Applicant has filed his application under Section 1(b), indicating his intent to use the mark on products in Class 25, including "t-shirts."

11. Applicant is a member of DFMC who has recently expressed dissatisfaction with the leadership of DFMC. Upon information and belief, Applicant has filed the instant Application in an improper effort to lay claim to the DFMC Marks and use them as leverage to wrest control away from the current leadership. Opposer has spoken to Applicant recently in an effort to resolve this matter, but Applicant has rejected this effort. DFMC has not given Applicant permission or approval to register the Proposed Mark.

12. On or around 2012, William Curtis became upset with how the election of officers for DFMC went.

13. The election was consistent with the by-laws of DFMC.

14. William Curtis has in bad faith fraudulently attempted to procure the rights to the trademark Dixie Flyers MC by filing SERIAL NO. 85859162 on August 6, 2013.

15. William Curtis knows that the trademark Dixie Flyers MC belongs to the club itself and not to him as an individual.

16. William Curtis filed SERIAL NO. 85859162 with the intent to deprive the rightful owners—the club itself—from being able to exercise its common law, Lanham Act, and Kentucky trademark rights.

17. Dixie Flyers MC is the senior user and any right that Mr. Curtis had to the trademark was derived only from his membership in the club.

18. William Curtis was expelled from the club on October 6, 2013 as a result of his fraudulent actions in trying hijack the club's trademark for his personal use.

19. On February 24, 2013, Applicant filed the following declaration:

The undersigned, being hereby warned that willful false statements and the like so made are punishable by fine or imprisonment, or both, under 18 U.S.C. Section 1001, and that such willful false statements, and the like, may jeopardize the validity of the application or any resulting registration, declares that he/she is properly authorized to execute this application on behalf of the applicant; he/she believes the applicant to be the owner of the trademark/service mark sought to be registered, or, if the application is being filed under 15 U.S.C. Section 1051(b), he/she believes applicant to be entitled to use such mark in commerce; to the best of his/her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce, either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion, or to cause mistake, or to deceive; and that all statements made of his/her own knowledge are true; and that all statements made on information and belief are believed to be true.

20. The Applicant knew that DFMC was the rightful owner of the mark having used it since 1938.

21. The Applicant knew that DFMC had the right to use the mark in commerce.

22. The Applicant has attempted to procure the registration by fraud. He willfully and with intent to deceive the Trademark Office represented that he believes himself to be entitled to use the mark in commerce and no other person, firm, corporation, or association has the right to use the mark in commerce.

23. Prior to filing the Application, the Applicant wore a DFMC t-shirt and DFMC patches as seen in the attached photographs at (Exhibit A & B).

24. Prior to filing the Application, DFMC gave Applicant a plaque for his donation of his deceased son's motorcycle to the club as seen in Exhibit A. Applicant is seen wear a patch denoting his 40 years of membership in the organization.

25. The Applicant has filed the Application and attempted to adopt the Mark in bad faith because he knew of DFMC's senior, prior use, and he is attempted to procure it for himself only.

26. The Proposed Mark is identical to DFMC's common law marks DIXIE FLYERS M/C, DIXIE FLYERS MOTORCYCLE CLUB, the Design Mark and the DIXIE FLYERS mark registered with the Commonwealth of Kentucky. The Proposed Mark is likely to cause confusion, mistake, and/or deception among consumers.

27. Applicant's proposed goods, including "Shirts," are identical or confusingly similar to the goods and services provided in connection with the DFMC Marks, which include shirts, patches, rings, belt buckles and other items of clothing featuring the DFMC Marks.

28. Additionally, Applicant's proposed goods represent a natural zone of expansion for DFMC.

29. Applicant's Proposed Mark is identical or confusingly similar in sound, appearance, and commercial impression to the DFMC Marks. It so resembles the DFMC Marks as to likely cause confusion, mistake, and or deception by creating the false and misleading impression that the Applicant's products are produced, sponsored, approved, licensed, or otherwise associated with DFMC. Furthermore, any objection or fault found with Applicant's proposed goods would necessarily reflect upon and injure the reputation of DFMC and/or its goods and services.

30. Registration of the Proposed Mark would give Applicant the unqualified right to wrongfully appropriate DFMC's goodwill and reputation associated with the DFMC Marks, to benefit from that goodwill, and possibly to tarnish that goodwill by producing goods which consumers would perceive to be endorsed or licensed by DFMC.

31. Registration of the Proposed Mark should be refused because DFMC's Marks are threatened by the Applicants proposed use of the Proposed Mark and DFMC would otherwise be damaged by registration of the Proposed Mark.

32. Registration of the Proposed Mark should be refused because the Applicant has committed fraud on the Trademark Office in filing a false declaration.

33. Registration of the Proposed Mark should be refused because the Applicant in bad faith has attempted to adopt a mark that he knew DFMC had used for the more than 40 years he has been a member of the organization.

34. Registration of the Proposed Mark should be refused because the Applicant did not have authority from DFMC to register the Proposed Mark in his own name and not the organization's name.

WHEREFORE, Opposer Dixie Flyers Motorcycle Club, Inc. respectfully requests that this opposition be sustained.

Respectfully submitted,

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on this the 21<sup>st</sup> day of February, 2014

/Julie A. Tennyson/  
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**ORDER ON MOTION TO AMEND NOTICE OF OPPOSITION**

Upon Dixie Flyers Motorcycle Club, Inc. (“Dixie Flyers MC”)’s Motion to Amend Notice of Opposition and the Board being otherwise sufficiently advised,

IT IS HEREBY ORDERED:

Opposer’s Motion to Amend the Notice of Opposition is GRANTED.

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