

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

wbc

Mailed: June 13, 2016

Opposition No. 91217630

*Sturgis Motorcycle Rally, Inc.*

*v.*

*Hansen, Gary St. Martin*

**Wendy Boldt Cohen, Interlocutory Attorney:**

On June 9, 2016 the Board convened a telephone conference between the parties to discuss the status of these proceedings and various pending motions further described below. Participating in the call were Applicant, Gary St. Martin Hansen, Opposer's attorneys Sarah Hsia and Megan Sorokes, and Board interlocutory attorney Wendy Boldt Cohen.<sup>1</sup>

*Motion to Suspend*

Applicant's motion, filed June 2, 2016, seeks to suspend this proceeding pending disposition of Cancellation No. 92054714, *Concerned Citizens for Sturgis v. Sturgis Motorcycle Rally Inc.* The Board allowed Opposer to provide its response on the phone and allowed Applicant to provide his reply in support of his motion on the phone.

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<sup>1</sup> The Board presumes the parties' familiarity with the arguments made in support of the various motions, whether filed with the Board or made during the telephone conference, and does not recount them here except as necessary to explain the Board's order.

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action, which may be dispositive of or have a bearing on the Board case. *See* Trademark Rule 2.117(a); TBMP § 510.02(a) (2015). However, the Board seldom grants a motion to suspend a particular proceeding pending disposition of other opposition or cancellation proceedings brought by unrelated plaintiffs against the same application or registration, and asserting unrelated claims, absent the consent of the other parties. *See New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1551 (TTAB 2011).

As confirmed by Applicant in the conference call, Applicant is not a member of or has any relation to *Concerned Citizens for Sturgis*, the party plaintiff or any other party in Cancellation No. 92054714. Further, the claims before the Board in this proceeding (false suggestion of a connection and likelihood of confusion) are different from those before the Board in Cancellation No. 92054714 (fraud, geographically descriptive, and that the mark is not sufficiently distinctive).

As discussed, suspension of these proceedings pending disposition of Cancellation No. 92054714 is **denied**.

*Motion to Strike*

The Board now turns to the motion to strike. The motion is fully briefed.

As an initial matter, although captioned as a motion to strike, Applicant's motion filed April 15, 2016, as it pertains to Applicant, is a motion to quash the notice of deposition of Applicant, which has not yet occurred, on the ground of inadequate notice.

The Board reminds Applicant that a nonmovant is allowed to file only one brief in response to a motion. *See* Trademark Rule 2.127(a); *Pioneer Kabushiki Kaisha v. Hitachi High Technologies*, 73 USPQ2d 1672, 1677 (TTAB 2005). Surreply briefs will not be considered by the Board. *See* TBMP § 502.02(b). “The presentation of one’s arguments and authority should be presented thoroughly in the motion or opposition brief thereto.” *Johnston Pump/General Valve Inc. v. Chromalloy American Corp.*, 13 USPQ2d 1719, 1720 n.3 (TTAB 1989). Inasmuch as Applicant has included further arguments related to its April 15, 2016 motion to quash in its May 23, 2016 filing, those arguments related to its motion to quash are an impermissible surreply and accordingly, **will receive no consideration.**

As discussed and inasmuch as the deposition for Applicant was cancelled per the Board’s April 20, 2016 order, the motion to quash Applicant’s deposition is **moot.**

Notwithstanding the foregoing, if Opposer wishes to take Applicant’s deposition, it may do so by serving a new notice of deposition within **twenty days** of this order. The parties must negotiate in good faith to schedule a mutual time and place for any properly noticed deposition.

Applicant is reminded that if a proposed deponent residing in the United States is a party, or, at the time set for the taking of the deposition, is an officer, director, or managing agent of a party, or a person designated under Fed. R. Civ. P. 30(b)(6) or 31(a)(4) to testify on behalf of a party, the deposition may be taken on notice alone. *See Consolidated Foods Corp. v. Ferro Corp.*, 189 USPQ 582, 583

(TTAB 1976). When such a proposed deponent fails to appear for a noticed deposition, the deposing party may seek to compel attendance by a motion to compel. TBMP § 404.03(a).

During the conference, Applicant withdrew any objections he may have had regarding the depositions of Mr. Kinney,<sup>2</sup> Mr. Brengle<sup>3</sup> and Ms. Simmons.<sup>4</sup> In view thereof, the motion to strike these depositions is **moot**.<sup>5</sup>

*Motion to Show Cause*

In the Board's April 20, 2016 order, Applicant was allowed until May 2, 2016 to advise the Board whether it intends to represent himself or whether he has retained counsel. On May 5, 2016, Opposer filed a motion to show cause because Applicant failed to respond to the Board's order. Thereafter, on May 6, 2016 Applicant informed the Board, *inter alia*, that he would be representing himself. On May 12, 2106 Applicant then informed the Board that he had retained counsel. Lastly, on May 23, 2016, Applicant informed the Board that he had been mistaken and he had not retained counsel but would instead be representing himself.

For the reasons discussed in the telephone conference and inasmuch as Applicant has informed the Board that he intends to represent himself, the motion to show cause is **denied**.

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<sup>2</sup> Chairperson of Opposer.

<sup>3</sup> Licensing Agent of Opposer.

<sup>4</sup> Treasurer of Opposer.

<sup>5</sup> During the conference, Applicant noted he had received the deposition transcripts of Mr. Kinney, Mr. Brengle and Ms. Simmons and that he has not objections thereto nor does he wish to cross-examine these witnesses.

*Motion to Extend Opposer's Response Deadline*

In view of the Board's order herein and the telephone conference conducted in relation thereto, the motion to extend Opposer's response deadline filed June 7, 2016 is **moot**.

Notwithstanding the foregoing, the Board finds it necessary to address Applicant's motion to recant his consent to Opposer's motion to extend, filed June 7, 2016 and again on June 8, 2016 and Opposer's motion for sanctions, filed June 8, 2016.

Opposer moved for sanctions in the form of judgment under Rule 11 in response to Applicant's motion to recant his consent. With regard to Opposer's motion for sanctions under Rule 11, Fed. R. Civ. P. 11(c)(2) provides a "safe harbor" provision allowing the party or attorney an opportunity to withdraw or correct a challenged submission. This provision delays filing of a motion for sanctions before the Board for twenty-one days after service of the motion and allows the motion to be filed only if the challenged submission is not withdrawn or appropriately corrected within those twenty-one days or within another time that the Board may set. The Board will deny motions for Fed. R. Civ. P. 11 sanctions which fail to comply with this requirement. TBMP § 527.02.

For the reasons discussed in the phone call and inasmuch as Opposer has not served the motion on Applicant for at least twenty-one days prior to filing it before the Board, Opposer has not complied with the safe harbor provision. In view thereof, the motion is premature and **will not be considered**.

Applicant is reminded, however, that pursuant to Rule 11:

(b) **Representations to Court.** By presenting to the court a pleading, written motion, or other paper--whether by signing, filing, submitting, or later advocating it – an attorney or unrepresented party certifies that to the best of the person’s knowledge, information, and belief, formed after an inquiry reasonable under the circumstances:

- (1) it is not being presented for any improper purpose, such as to harass, cause unnecessary delay, or needlessly increase the cost of litigation;
- (2) the claims, defenses, and other legal contentions are warranted by existing law or by a nonfrivolous argument for extending, modifying, or reversing existing law or for establishing new law;
- (3) the factual contentions have evidentiary support or, if specifically so identified, will likely have evidentiary support after a reasonable opportunity for further investigation or discovery; and
- (4) the denials of factual contentions are warranted on the evidence or, if specifically so identified, are reasonably based on belief or a lack of information.

Rule 11 certification standards apply to parties as well as attorneys. *See Business Guides, Inc. v. Chromatic Communications Enterprises, Inc.*, 498 U.S. 533, 547 (1991); *Central Manufacturing Inc. v. Third Millennium Technology Inc.*, 61 USPQ2d 1210, 1213 (TTAB 2001) (authority to sanction pro se party "is manifestly clear."). If a paper filed in an *inter partes* proceeding before the Board violates the provisions of Fed. R. Civ. P. 11, any party to the proceeding may file a motion for the imposition of an appropriate sanction. The Board may also impose an appropriate sanction, not only upon motion, but also upon its own initiative. *See* Fed. R. Civ. P. 11(c)(2) and (3); *ITC Entertainment Group Ltd. v. Nintendo of America Inc.*, 45 USPQ2d 2021, 2023 (TTAB 1998) (order to show cause issued where, although Fed. R. Civ. P. 56(f) (restyled by amendment as Fed. R. Civ. P. 56(d)) motion was granted, party responded to summary judgment without taking

the requested discovery); *Giant Food, Inc. v. Standard Terry Mills, Inc.*, 231 USPQ 626, 633 n.19 (TTAB 1986) (Rule 11 permits court to enter sanctions *sua sponte*).

Proceedings are resumed and dates are reset as follows:

Plaintiff's 30-day Trial Period Ends	<b>7/11/2016</b>
Defendant's Pretrial Disclosures	<b>7/26/2016</b>
Defendant's 30-day Trial Period Ends	<b>9/9/2016</b>
Plaintiff's Rebuttal Disclosures	<b>9/24/2016</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>10/24/2016</b>

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.