

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451

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Mailed: September 18, 2013

**Cancellation No. 92057242**

Elite Motorcycle Tours

v.

Bruce Odiorne II dba Elite  
Motorcycle Tours

By the Board:

This proceeding is before the Board for consideration of respondent's June 28, 2013 filing, and respondent's July 1, 2013 filings. As noted herein, the Board construes the latter filings as a motion to dismiss for failure to state a claim upon which relief may be granted under Fed. R. Civ. P.

12(b)(6).<sup>1</sup> The motions have been fully briefed.

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<sup>1</sup> Respondent's June 28, 2013 and first July 1, 2013 filings do not include the required proof of service; moreover, the "certificate of service" in the second July 1, 2013 filing contains incorrect information, and indicates service "by electronic mail" whereas the record does not include or reference a stipulation between the parties to serve service copies by electronic mail pursuant to Trademark Rule 2.119(b)(6). As explained below (under "Information for Pro Se Party"), every motion, brief and paper filed in Board proceedings must include accurate proof of service pursuant to Trademark Rule 2.119(a).

To advance this proceeding and to avoid further delay, the Board gives consideration to respondent's filings. Nevertheless, respondent is advised that the Board may decline to consider any filing which is noncompliant with applicable Rules of Procedure.

Petitioner's June 5, 2013 notice of ineffective service is noted. Inasmuch as respondent's filings indicate that respondent received a copy of the petition for cancellation, the issue of service by publication is moot. Respondent's current address is noted on the ESTTA filing cover sheet to his June 28, 2013

The parties' filings

On June 28, 2013, prior to the due date for filing an answer, respondent filed a paper setting forth only the following: "in (sic) reference to Proceeding # 925057242, (sic) I would like to request a 60 day extension to file an answer to the cancellation petition."

It is noted that petitioner contests the filing, asserting, *inter alia*, that it contains no facts said to constitute good cause, and that respondent never contacted petitioner to discuss any circumstances necessitating an extension.

The Board construes respondent's June 28, 2013 filing as a motion to extend the time to file an answer pursuant to Fed. R. Civ. P. 6(b).

On July 1, 2013, the due date for filing an answer to the petition to cancel as set in the May 22, 2013 order instituting this proceeding, respondent filed a copy of a document entitled "Articles of Organization," and separately filed a paper captioned "MOTION TO Dismiss case #92057242 with Prejudice" wherein, *inter alia*, respondent requests that the Board deny the petition "and order Default Judgment in favor of Registrant." Respondent's filings set forth minimal substantive argument. Notwithstanding, petitioner filed a brief in response thereto.

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filing. The Board's record for this proceeding has been updated

Accordingly, the Board construes respondent's July 1, 2013 filings as a motion to dismiss for failure to state a claim upon which relief may be granted under Fed. R. Civ. P. 12(b)(6).<sup>2</sup>

Analysis

A motion to dismiss for failure to state a claim upon which relief can be granted is a test solely of the legal sufficiency of the allegations set forth in a pleading. To survive a motion to dismiss, a plaintiff need only allege sufficient factual matter as would, if proved, establish that 1) the plaintiff has standing to maintain the proceeding, and 2) a valid and available ground exists for opposing or cancelling the mark. *Lipton Industries, Inc. v. Ralston Purina Co.*, 670 F.2d 1024, 213 USPQ 185, 187 (CCPA 1982). See also TBMP § 503.02 (2013).

Specifically, "a complaint must contain sufficient factual matter, accepted as true, to state a claim to relief that is plausible on its face." *Ashcroft v. Iqbal*, 556 U.S. 662, 129 S.Ct. 1937, 1949-50 (2009), quoting *Bell Atlantic Corp. v. Twombly*, 550 U.S. 544, 570 (2007). In the context of inter partes proceedings before the Board, a claim has facial plausibility when the opposer or petitioner pleads factual content that allows the Board to draw a reasonable

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to reflect this address.

<sup>2</sup> Given this construction, respondent's June 28, 2013 motion for an extension of time is moot.

inference that the opposer or petitioner has standing and that a valid ground for the opposition or cancellation exists. *Cf. Bell Atlantic Corp. v. Twombly*, 550 U.S. at 556, 127 S.Ct. at 1955. Dismissal for insufficiency is appropriate only if it appears certain that opposer or petitioner is entitled to no relief under any set of facts that could be proved in support of its claim. All of the well-pleaded allegations must be accepted as true, and the complaint must be construed in the light most favorable to opposer or petitioner. *See Advanced Cardiovascular Systems Inc. v. SciMed Life Systems Inc.*, 988 F.2d 1157, 26 USPQ2d 1038, 1041 (Fed. Cir. 1993). The pleading must be examined in its entirety, construing the allegations therein so as to do justice. Fed. R. Civ. P. 8(e); *see also Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861, 1862 (TTAB 2007).

With respect to standing, any person who establishes that he is or will be damaged by registration of a mark has standing. Trademark Act § 13(a), 15 U.S.C. § 1063(a). At the pleading stage, all that is required is that opposer or petitioner allege facts that are sufficient to show a "real interest" in the proceeding and a "reasonable basis" for his belief that he would be damaged if the mark is registered. *Ritchie v. Simpson*, 170 F.3d 1092, 50 USPQ2d 1023, 1025 (Fed. Cir. 1999); *Lipton Industries, Inc. v. Ralston Purina Co.*, 213 USPQ at 189. *See also* TBMP § 303.03 (2013). To

plead a "real interest," opposer or petitioner must allege a "direct and personal stake" in the outcome of the proceeding, and the specific allegations in support of its belief of damage must have a "reasonable basis in fact." *Ritchie v. Simpson*, 50 USPQ2d at 1026-27.

Petitioner alleges, *inter alia*, that it operates a motorcycle tour company in the United States under the name Elite Motorcycle Tours (petition, para. 1), that it has common law use of the ELITE MOTORCYCLE TOURS trademark for this business (petition, para. 2), that it has common law use of ELITE MOTORCYCLE TOURS for "[A] motorcycle tour company that provides guided motorcycle tours and training throughout the southwestern United States, including Colorado, Utah and Texas" (ESTTA filing form), and that respondent is a former employee of petitioner (petition, para. 3).

By way of these statements of its use of and rights in the mark ELITE MOTORCYCLE TOURS for the stated services, petitioner has sufficiently set forth allegations which, if proven, would establish its standing to bring this proceeding.

With respect to the grounds for cancellation, Petitioner lists the following two grounds for

cancellation:<sup>3</sup> 1) fraud; and 2) filed by non-existing entity.

Fraud in procuring or maintaining a trademark registration occurs when an applicant for registration or a registrant in a declaration of use or a renewal application knowingly makes a specific false, material representation of fact in connection with an application to register or a post-registration filing, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009); *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768, 1770 (TTAB 2010). Fraud on the USPTO, occurs "when an applicant knowingly makes false, material representations of fact in connection with his application." *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986); *Mister Leonard Inc. v. Jacques Leonard Couture Inc.*, 23 USPQ2d 1064, 1065 (TTAB 1992).

A claim of fraud must set forth the elements of the claim, that is, the circumstances constituting fraud, with a heightened degree of particularity in accordance with Fed. R. Civ. P. 9(b), which is made applicable to Board proceedings by Trademark Rule 2.116(a). See *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB

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<sup>3</sup> On the ESTTA cover sheet, petitioner's list of grounds for cancellation includes three grounds under Trademark Act Section 2(a), none of which are pleaded in the petition to cancel.

2009). To satisfy Fed. R. Civ. P. 9(b), allegations based on "information and belief" must be accompanied by a statement of facts upon which the belief is reasonably based. *Id.*, at 1479, citing *Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 (Fed. Cir. 2009). See also *Petroleos Mexicanos v. Intermix SA*, 97 USPQ2d 1403, 1407 (TTAB 2010). Intent to deceive is a specific element of the fraud claim. *In re Bose*, 91 USPQ2d at 1939-1940. See also *Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d at 1479-80.

By way of paragraphs 7, 8 and 13, in part, of the petition, petitioner sets forth allegations of a claim of fraud on the USPTO, alleging that respondent misrepresented his ownership of the mark ELITE MOTORCYCLE TOURS, and misrepresented his use of the mark through a specimen of use misappropriated from petitioner's website.<sup>4</sup>

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<sup>4</sup> The petition, and in particular paragraph 13 thereof, does not set forth a claim that applicant (respondent) committed fraud in executing the declaration or oath in its underlying application with knowledge that there was another use of the same or a confusingly similar mark at the time the oath was signed. A sufficient pleading of this ground specifically requires allegations that: 1) there was in fact another user of the same or a confusingly similar mark at the time the oath was signed; 2) the other user had legal rights superior to applicant's; 3) applicant knew that the other user had rights in the mark superior to applicant's, and either believed that a likelihood of confusion would result from applicant's use of its mark or had no reasonable basis for believing otherwise; and 4) applicant, in failing to disclose these facts to the USPTO, intended to procure a registration to which it was not entitled. See *Ohio State Univ. v. Ohio Univ.*, 51 USPQ2d 1289, 1293 (TTAB 1999), citing *Intellimedia Sport Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203,

By way of paragraphs 11 and 12 of the petition, petitioner sets forth allegations of a claim that the underlying application is void *ab initio* because it was filed by an entity that did not exist at the time the application was filed.

In view of the findings that the petition to cancel sets forth allegations of petitioner's standing, as well as available grounds for cancellation, respondent's motion to dismiss for failure to state a claim is hereby denied.<sup>5</sup>

Schedule

In the event that, and to the extent that the parties have treated this proceeding as being suspended, this proceeding is now resumed.

Respondent is allowed until thirty days from the mailing date of this order in which to file herein, and serve on counsel for petitioner, an answer to the petition for cancellation.<sup>6</sup>

Conferencing, discovery and trial dates are hereby reset as follows:

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1206 (TTAB 1997). See also *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d at 1770.

<sup>5</sup> The Board has not given consideration to the document entitled "Articles of Organization" which respondent submitted. The Board refers respondent to TBMP Chapter 700, in general, regarding the appropriate introduction of evidence at trial.

<sup>6</sup> As noted below, the Board advises respondent to secure legal counsel. Respondent may consult TBMP § 311 *et seq.* (2013) with respect to the form and content of an answer.

Deadline for Required Discovery Conference <sup>7</sup>	11/18/2013
Discovery Opens	11/18/2013
Initial Disclosures Due	12/18/2013
Expert Disclosures Due	4/17/2014
Discovery Closes	5/17/2014
Plaintiff's Pretrial Disclosures due	7/1/2014
Plaintiff's 30-day Trial Period Ends	8/15/2014
Defendant's Pretrial Disclosures due	8/30/2014
Defendant's 30-day Trial Period Ends	10/14/2014
Plaintiff's Rebuttal Disclosures due	10/29/2014
Plaintiff's 15-day Rebuttal Period Ends	11/28/2014

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

Information for Pro Se Party

It is apparent from the brevity and nature of respondent's filings that respondent is unfamiliar with *inter partes* Board proceedings, and with the Federal Rules of Civil procedure.

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<sup>7</sup> In the event that either or both parties request the participation of a Board attorney in the required discovery and settlement conference, a request should be filed herein. To facilitate scheduling the parties should confer to determine at least two times that they are both available for said conference.

A party may represent itself in this *inter partes* proceeding. However, while Patent and Trademark Rule 11.14 permits any entity to represent itself, it is strongly advisable for persons who are not acquainted with the technicalities of the procedural and substantive law involved in *inter partes* proceedings before the Board to secure the services of an attorney who is familiar with these matters. The Patent and Trademark Office cannot aid in the selection of an attorney, and may not provide legal advice. It may provide information as to purely procedure matters.

Any party who does not retain counsel should become familiar with the rules governing this proceeding, and may access useful legal resources, such as the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, from the Board's web page at <http://www.uspto.gov/trademarks/process/appeal/index.jsp>. Also available are links to TTABVue, to view filings and proceeding history at <http://ttabvue.uspto.gov/ttabvue>, and to ESTTA, the Board's electronic filing system at <http://estta.uspto.gov>. All parties are encouraged to use ESTTA to submit filings. Furthermore, many Federal Rules of Civil Procedure govern the conduct of this proceeding.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure,

is required of all parties, whether or not they are represented by counsel. See *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, n.2 (TTAB 2006).

Trademark Rules 2.119(a) and (b) require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served on the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board. See TBMP § 113.03 (2013). Therefore, copies of all papers filed in this proceeding must be accompanied by a signed statement indicating the date and manner in which such service was made. The statement, whether attached to or appearing on the paper when filed, will be accepted as prima facie proof of service. The statement should take the form of a certificate of service which must be signed and dated, and should read as follows

***I hereby certify that a true and complete copy of the foregoing \_\_\_\_\_ (insert title of submission) has been served on \_\_\_\_\_ (insert name of opposing counsel or party) by mailing said copy on \_\_\_\_\_ (insert date of mailing), via First Class Mail, postage prepaid (or insert other appropriate method of delivery) to: \_\_\_\_\_ (set out name and address of opposing counsel or party).***

An *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. The parties

file pleadings and may file a wide range of possible motions, as appropriate. The process of discovery (serving of interrogatories, requests for production of documents and things and requests for admission, as well as depositions) is followed by a testimony (trial) period, after which final briefs on the case are filed. The Board does not preside at the taking of testimony; all testimony is taken out of the presence of the Board during the parties' assigned testimony (trial) periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence unless it has been introduced in evidence in accordance with the applicable rules.

The Board's order instituting this proceeding also contains a vast amount of information regarding the parties' obligations and the manner in which this proceeding shall be conducted.