

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

Mailed: November 20, 2013

Cancellation No. 92057242

Elite Motorcycle Tours

v.

Bruce Odiorne II dba Elite
Motorcycle Tours

Jennifer Krisp, Interlocutory Attorney:

Pursuant to Fed. R. Civ. P. 26(f) and Trademark Rules 2.120(a)(1) and (2), the parties held their required discovery and settlement conference on November 13, 2013. See TBMP § 401.01 (2013). Pursuant to petitioner's request, the Board attorney assigned to this proceeding participated in the conference. Participating were petitioner's counsel Dana P Jozefczyk, Esq., respondent, Bruce Odiorne, II, attending pro se, and the Board interlocutory attorney.

The Board apprised the parties of some general procedural rules and guidelines that govern *inter partes* proceedings, including the Board's liberal granting of motions to suspend for settlement efforts, the requirement that initial disclosures be served prior to or concurrent with the service of discovery requests absent specific modification of this requirement in writing (see Fed. R.

Civ. P. 26(a)(1); Trademark Rule 2.120(a)(3)), and the provision limiting circumstances under which disclosures are to be filed with the Board (see Trademark Rule 2.120(j)).

The Board noted that its Standard Protective Order (SPO) is automatically applicable in this proceeding, and that the parties must file for the Board's approval any modifications thereto (see Trademark Rule 2.116(g)). The parties herein do not anticipate modifying the SPO.

It is not necessary for the parties to sign and exchange a copy of the SPO, although it is advisable that they do so. Inasmuch as respondent is, at this time, pro se, the Board drew attention to the terms of the SPO whereunder respondent would need to secure outside legal counsel in order to access any information or documents produced which are properly designated as "trade secret" or "commercially sensitive."

Once this proceeding has been finally determined, the Board has no further jurisdiction over the parties. Thus, according to the terms of the SPO, within 30 days following termination, the parties and their attorneys must return to each disclosing party any protected information and documents disclosed or produced during the proceeding. In the alternative, the disclosing party or its attorney may provide a written request that such materials be destroyed rather than returned.

The Board had previously reviewed the petition to cancel in ruling on the merits of respondent's motion to dismiss; however, subsequent to said ruling, petitioner filed an amended petition to cancel without an accompanying motion to amend. The Board inquired regarding what specific amendment(s) are in the amended petition, and counsel for petitioner clarified that the amended petition adds a claim of fraud by way of Paragraph 13 thereof. The Board acknowledged the amended petition as petitioner's operative pleading in this proceeding. See Fed. R. Civ. P. 15(a)(2).

Respondent's answer is deemed timely. The Board confirmed that respondent's answer responds to the amended petition.

Respondent stated that he anticipates filing a civil action, naming petitioner as defendant therein, in a U.S. District Court. The Board advised the parties to notify the Board in the event that a civil action is filed, and to file herein a copy of the pleadings in said action, so the Board can ascertain whether suspension of this cancellation is appropriate pursuant to Trademark Rule 2.117(a), which provides:

Whenever 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.

Inasmuch as respondent states in his answer that he served the answer "electronically," the Board inquired as to whether the parties had stipulated to the exchange of service copies of all motions and Board filings by electronic mail pursuant to Trademark Rule 2.119(b)(6). The parties had not so stipulated, but did so stipulate in the conference. The Board confirmed that the parties had previously exchanged accurate and working email addresses. Regarding how the method of service under Trademark Rule 2.119(b)(6) has an impact on the allowed response times, the parties are directed to TBMP § 113.05 (2013).

The parties agreed to the exchange of documents produced during discovery by email, or by a password-protected ftp site which counsel for petitioner will establish.

The Board advised the parties to consult Chapter 400 of the TBMP regarding discovery deadlines and obligations, and in particular to thoroughly review TBMP § 414 (2013), which sets forth selected discovery guidelines and the discoverability of various matters. The Board noted that any settlement stipulation should be filed with the Board in accordance with the applicable rules. See TBMP § 605 (2013).

The Board explained the availability and features of the "accelerated case resolution" ("ACR") process, and noted that this proceeding is suitable for expedited determination. In general, if the parties expect to proceed

without expert testimony, and with the testimony of only one or two witnesses, do not anticipate taking numerous depositions, and expect that the overall record will not be over extensive, resolution of the opposition and cancellation without a full 6-month discovery period and trial periods may be attainable. The Board's web page's "ACR & ADR" links, as well as TBMP §§ 528.05(a) and 702.04 (2013), include an array of detailed information.

The parties can also, or in the alternative, stipulate to certain procedural efficiencies to save time and resources. For example, they should consider stipulating to the presentation of testimony by affidavit or declaration, as appropriate.

In the event that the parties agree to pursue an ACR option, they are directed to contact the assigned interlocutory attorney (571-272-9183).