

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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WINTER

Mailed: September 5, 2014

Cancellation No. 92056674 (parent)
Cancellation No. 92059164

Brothers of the Wheel MC
Executive Council, Inc.

v.

Gerald R. Mollohan
aka Brothers of the Wheel

BY THE TRADEMARK TRIAL AND APPEAL BOARD:

Respondent's Motions to Dismiss and to Strike/Dismiss Briefs

These cases now comes up for consideration of the following six motions filed in *Cancellation No. 92059164*: Respondent's motion (filed May 14, 2014) to dismiss the petition for cancellation for lack of service; Respondent's motion (filed June 13, 2014) "for interrogatories, documents and things"; Respondent's motion (filed June 23, 2014) for dismissal of Petitioner's Response to motion to dismiss and motion to consolidate; Respondent's Motion (filed June 25, 2014) to Dismiss the Petition for Cancellation and to Sanction Attorney Richard J. Lindroth; Respondent's Motion (filed June 25, 2014) to Dismiss the Petition for Cancellation; and Respondent's motion (filed June 26, 2014) to strike Petitioner's brief. Inasmuch as Petitioner's

responsive brief and amended responsive brief were untimely filed, said responses will be given no consideration. *See* Trademark Rules 2.119(c) and 2.127(a) (“a brief in response to a motion shall be filed within fifteen days from the date of service of the motion”). Nonetheless, because Petitioner clearly contests Respondent’s initial motion to dismiss, the Board exercises its discretion to consider the motions to dismiss and to strike on their merits, rather than to grant the motions as conceded. *See* Trademark Rule 2.127(a).

For purposes of this order, the Board presumes the parties’ familiarity with the Respondent’s motions and the arguments contained in said motions. Although the Board shall not address each of the arguments separately, the Board has given due consideration to Respondent’s arguments.

Respondent’s motions are duplicative in nature. In view thereof, the Board shall summarize Respondent’s requests and address each request in turn.

- 1) Respondent alleges that Petitioner’s counsel should be disqualified and requests that the petition be dismissed because Richard J. Lindroth, Petitioner’s counsel, is not authorized to represent a party before the Trademark Trial and Appeal Board. Respondent’s motion filed June 25, 2014, to disqualify Mr. Lindroth and for entry of judgment is **denied**. The record indicates that Mr. Lindroth is an attorney licensed in West Virginia. Any individual who is an attorney as defined in 37 C.F.R. § 11.1 may represent others before the Office in trademark and

other non-patent cases. *An attorney is not required to apply for registration or recognition to practice before the Office in trademark or other non-patent cases. See 37 C.F.R. § 11.14(a); TBMP¹ § 114 (2014).*

- 2) Respondent contends that Paul Warner is not qualified or certified to appear before the Board and cannot represent the Petitioner corporation. Mr. Warner's submission to the Board of the petition for cancellation was permissible because he is identified to be an officer of the Petitioner. A party in an *inter partes* proceeding before the Board may be represented by an attorney *or* an authorized representative. TBMP § 114.01. Specifically, if a party electing to represent itself is a corporation or an association, the party may act through any individual who is (1) an officer of the party and who is (2) in fact authorized to represent it. 37 C.F.R. § 11.14(e). There is no information in the record indicating that Mr. Warner is not authorized to act on behalf of Petitioner. In view of the foregoing, the fact that Mr. Warner submitted the petition for cancellation is not a basis for dismissing the cancellation proceeding. Therefore, to the extent Respondent's motion to dismiss filed on June 25, 2014, request dismissal on this basis, said motion is **denied**.

¹ The TBMP (Trademark Board Manual of Procedure) may be accessed at the following URL:
http://www.uspto.gov/trademarks/process/appeal/Preface_TBMP.jsp.

- 3) Respondent argues that the proceeding should be dismissed because Petitioner failed to include proof of service on Respondent. Respondent's motion is not well taken. On the ESTTA cover sheet to the petition for cancellation, which is considered to be a part of the petition, Petitioner's representative signed the statement that he "certifies that a copy of this paper has been served upon all parties, at their address [of] record by First Class Mail on this date." "[A]ny plaintiff who files through ESTTA is viewed by the Board as having included proof of service with its pleading." *Schott AG v. L'Wren Scott*, 88 USPQ2d 1862, 1863 fn. 3 (TTAB 2008). In view thereof, Petitioner's motion to dismiss filed on May 14, 2014, for failure to include proof of service is **denied**.

Regarding Petitioner's allegation in the same motion that Petitioner failed to "properly serve" the petition on Respondent, Respondent appears to support that contention with an argument that Petitioner's President, Paul Warner, has no qualifications or "certification" to represent a corporation in this proceeding. In the first instance, it is unclear what Respondent means by "properly serve." All that is required of Petitioner is that it serve the petition for cancellation on the owner of record at the correspondence address of record in the Office by one of the methods set forth in Trademark Rule 2.119. See Trademark Rule 2.111(a). There is no substantiated

evidence in the record that Petitioner did not use one of these methods to serve Respondent with the petition for cancellation. Further, Petitioner's statement signed by its President setting forth the date and manner in which service was made is accepted as *prima facie* proof of service. Trademark Rule 2.119(a). Here, Petitioner's President executed the certificate of service, which, as noted, states that service was made upon all parties at their address of record. Thus, the Board must presume that Petitioner's authorized representative mailed a copy of the petition to Respondent's address of record. The fact that the service copy of the petition for cancellation may not have been received by Respondent does not negate Petitioner's *prima facie* proof of actual service, because non-receipt may have resulted from other causes, such as misdelivery by the U.S. Postal Service. In view of the foregoing, Respondent's motion to dismiss filed on May 14, 2014, based on the ground of lack of service is **denied**.

- 4) Because Petitioner's responsive briefs were untimely and have not been considered, Respondent's motions to dismiss and to strike Petitioner's briefs, filed on June 23, 2014 and on June 26, 2014, respectively, are moot and shall be given no further consideration.
- 5) Respondent's uncontested motion (filed June 13, 2014) "for interrogatories, documents and things" is **denied**. A party cannot compel the adverse party to serve discovery requests. Furthermore, the

parties are not allowed to serve discovery requests upon the adverse party until after the parties' mandatory discovery and settlement conference and after initial disclosures are served on the adverse party. *See generally* TBMP §§ 401 *et seq.* (2014).

Respondent's Future Submissions to the Board

Respondent's motions, all of which have been denied, clearly show that Respondent is unfamiliar with the Trademark Rules, relevant case law and Board procedures. In order to prevent any further delay to the proceedings by the filing of motions without sufficient grounds,² **RESPONDENT IS PROHIBITED FROM FILING ANY FURTHER PAPERS OR MOTIONS WITH THE BOARD WITHOUT FIRST OBTAINING THE CONSENT OF THE ASSIGNED INTERLOCUTORY ATTORNEY.**³ *See Carrini, Inc. v. Carla Carini S.R.L.*, 57 USQP2d 1067 (TTAB 2000) (The Board has the inherent authority to schedule the disposition of cases on its own docket); and *Optician's Ass'n of America v. Independent Opticians of America, Inc.*, 734 F.Supp. 1171, 14 USPQ2d 2021 (D.N.J. 1990).

² As regards any future submission, Respondent is reminded that under Rule 11 of the Federal Rules of Civil Procedure, Respondent is certifying that all claims and other legal contentions asserted must be warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law. *See* Fed. R. Civ. P. 11. The Rule 11 certification standard applies to parties who are not represented by counsel. *Central Mfg. Inc. v. Third Millennium Tech. Inc.*, 61 USPQ2d 1210 (TTAB 2001).

³ The assigned Interlocutory Attorney, Elizabeth Winter, may be contacted at the following telephone number: 571-272-9240.

Petitioner's Insufficient Claims

On review of the pleadings in Cancellation No. 92059164, the Board finds that Petitioner's fraud claim is insufficient. Fraud in procuring a trademark registration occurs when an applicant for registration knowingly makes false, material representations of fact in connection with an application to register. *In re Bose Corp.*, 580 F.3d 1240; 91 USPQ2d 1938, 1939 (Fed. Cir. 2009); *Torres v. Cantine Torresella S.r.l.*, 808 F.2d 46, 1 USPQ2d 1483, 1484 (Fed. Cir. 1986). To sufficiently allege that Respondent committed fraud in procuring his registration by fraudulently executing the declaration or oath in its application for registration, Petitioner must allege particular facts, which, if proven, would establish that: (1) Petitioner was using the same or a similar mark at the time Respondent signed the oath in its application; (2) Petitioner's legal rights were superior to Respondent's rights; (3) Respondent knew that Petitioner had superior rights, and either believed that a likelihood of confusion would result from his use of its mark or had no reasonable basis for believing otherwise; and that (4) Respondent, in failing to disclose these facts to the Patent and Trademark Office, intended to procure a registration to which he was not entitled. *Qualcomm Inc. v. FLO Corp.*, 93 USPQ2d 1768 (TTAB 2010), *citing Intellimedia Sports Inc. v. Intellimedia Corp.*, 43 USPQ2d 1203 (TTAB 1997). While malice, intent, knowledge, and other conditions of mind may be averred generally, Petitioner "must state with particularity the circumstances constituting [the alleged]

fraud.” *See* Fed. R. Civ. P. 9(b); Trademark Rule 2.116(a).⁴ Petitioner specifically has failed to allege that Petitioner’s legal rights were superior to Respondent’s rights and that Respondent knew that Petitioner had superior rights, and either believed that a likelihood of confusion would result from his use of its mark or had no reasonable basis for believing otherwise.

Additionally, Petitioner’s claims of deceptiveness, false suggestion of a connection, misrepresentation as to source, and dilution, which are set forth on the ESTTA cover sheet to the petition for cancellation are not supported by any allegations and are thus **STRICKEN**. *See* Fed. R. Civ. P. 12(f); Trademark Rule 2.116(a). Furthermore, Petitioner’s allegation of “perjury” is also **STRICKEN** insofar as the Board does not have jurisdiction to consider such an allegation. *See id.* *See also* TBMP § 102.01 (“The Board is empowered to determine only the right to register.”) (2014).

Should these proceedings resume (*see infra*), Petitioner shall be allowed time to submit an amended pleading.

Proceedings Consolidated

It has come to the attention of the Board that Cancellation Nos. 92056674 and 92059164 involve the same parties and common questions of law and

⁴ Further, 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 founded. *See Asian and Western Classics B.V. v. Selkow*, 92 USPQ2d 1478, 1479 (TTAB 2009), *citing Exergen Corp. v. Wal-Mart Stores Inc.*, 575 F.3d 1312, 91 USPQ2d 1656, 1670 n.7 (Fed. Cir. 2009).

fact.⁵ It is therefore appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a). *See* TBMP § 511 (2014).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g.*, 9A Wright & Miller, Fed. Prac. & Proc. Civ.2d § 2383 (2008); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).

Accordingly, the above-noted cancellation proceedings are hereby **CONSOLIDATED** and may be presented on the same record and briefs. The Board file will be maintained in Cancellation No. 92056674 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear the case captions as set forth above.⁶

Proceedings Suspended

The Board notes that Cancellation No. 92056674 is suspended pending the disposition of Civil Action No. 2:11-cv-00104 between the parties pending in the United States District Court for the Southern District of West Virginia (Charleston) and in the United States Court of Appeals for the Fourth Circuit (see Board's order in Canc. No. 92056674 dated August 2, 2013, May 2, 2014, and August 14, 2014). Inasmuch as Cancellation No. 92059164 is now

⁵The Board also notes that issue has been joined in these proceedings.

⁶The parties should promptly inform the Board in writing of any other related *inter partes* proceedings. *See* Fed. R. Civ. P. 42(a).

Cancellation Nos. 92056674 and 92059164

consolidated with Cancellation No. 92056674, Cancellation No. 92059164 is also **SUSPENDED** pending the disposition of the above-referenced civil action.
