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

Proceeding	92064297
Party	Plaintiff Bombardier Recreational Products Inc.
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Bombardier Recreational Products Inc.,)	
)	
Petitioner,)	
)	Cancellation No. 92064297
v.)	
)	Reg. No. 1,803,707
Jaguar Land Rover Limited,)	
)	
Registrant.)	

**PETITIONER’S RESPONSE TO REGISTRANT’S
NOTICE OF CIVIL ACTION AND
REQUEST FOR SUSPENSION OF PETITION TO CANCEL**

Petitioner Bombardier Recreational Products Inc. (“BRP”) hereby responds to the Notice of Civil Action issued by the Board on September 20, 2016 and the Request for Suspension of Petition to Cancel (“Request”) filed by Registrant Jaguar Land Rover Limited (“JLR”) on September 26, 2016, as follows:

I. THE PRESENT CANCELLATION ACTION SHOULD NOT BE SUSPENDED

JLR requests that the Board suspend the present action based on nothing more than the terse assertion that the lawsuit it filed against BRP in the U.S. District Court for the Eastern District of Michigan a mere 15 days ago on September 19, 2016 “may have a bearing on this proceeding.” There are several reasons why JLR’s Request must be denied.

A. JLR’s Request is Premature

This is the second of two Board proceedings between BRP and JLR concerning JLR’s registration for DEFENDER for “motor land vehicles; namely, station wagons.” The first proceeding, which is captioned *Jaguar Land Rover Limited v. Bombardier Recreational*

Products Inc., Opposition No. 91223380, is an action in which JLR has opposed BRP's application for DEFENDER for "recreational vehicles, namely, side-by-side vehicles and structural parts therefor." That proceeding, which JLR initiated against BRP, has been pending for over a year. The next deadline in that proceeding is the close of discovery, which will soon be re-set by the Board at the request of JLR. Importantly, much of the discovery obtained – or to be obtained – by BRP in that dispute will overlap significantly with the discovery BRP intends to pursue in the present cancellation proceeding.

In stark contrast, even though BRP commenced use of its DEFENDER mark in September 2015, JLR waited almost a year before filing the lawsuit supporting the Request just fifteen days ago, on September 19, 2016. To date, JLR has yet to serve its complaint in the lawsuit on BRP, which is a Canadian company headquartered in Canada. As a result, not only are the pleadings in the district court case far from closed, there is no pending counterclaim seeking cancellation of JLR's Registration No. 1,803,707 for DEFENDER, which is the relief requested in this cancellation proceeding. In addition, there are also foundational questions as to whether the U.S. District Court for the Eastern District of Michigan has personal jurisdiction over BRP and as to whether that court is a proper forum, especially because the only connection to Michigan is that JLR's attorneys are located there. At a minimum, issues like these, and others, strongly suggest that JLR's recently-filed lawsuit in Michigan is far from progressing, if at all. Moreover, the district court may decide, for the reasons set forth herein, that it will stay its proceedings pending the final disposition of the opposition and cancellation.

Because JLR's 15-day-old lawsuit is still in its infancy, it would be premature for the Board to suspend the present proceeding.

B. BRP Would Be Prejudiced Should JLR's Request Be Granted

As explained above, this is the second of two Board proceedings between BRP and JLR concerning the latter's registration for DEFENDER for "motor land vehicles; namely, station wagons." The first proceeding, which JLR initiated, has been pending for over a year. The next deadline in that proceeding is the close of discovery, which, as explained above, will likely be no later than November or December 2016.

Because of the advanced nature of the first proceeding, both parties have already engaged in significant discovery. On August 15, 2016, JLR filed a motion to compel in the first proceeding (Opposition No. 91223380) on several discrete discovery issues. The issues raised in that motion, which were the only issues JLR previously sought to meet and confer about, were ultimately addressed by BRP in a response filed on September 6, 2016. The fact that JLR has not raised any other discovery issues with BRP strongly suggests that JLR does not have any other concerns about the nature or extent of BRP's discovery responses, and thus already has what it needs from BRP.

In stark contrast, JLR has worked hard to stymie BRP's efforts to obtain discovery. The best example of JLR's obstructionism is its repeated objection that it does not know what the terms "recreational vehicles" or "side-by-side" vehicles mean in BRP's discovery requests. Clearly, JLR knew what these terms meant when it opposed BRP's Application Serial No. 86534043 for DEFENDER for "recreational vehicles, namely, side-by-side vehicles and structural parts therefor," and again when it recently decided to sue BRP. Nonetheless, JLR relied on its purported lack of understanding about these terms to refuse to respond outright to numerous of BRP's Interrogatories and several of BRP's document requests, and to deny 26 of

28 Requests for Admissions propounded by BRP.

On September 8, 2016, BRP sent JLR a nine-page meet and confer letter concerning JLR's failure to adequately respond to numerous of BRP's discovery requests in Opposition No. 91223380. BRP asked JLR to respond to BRP's letter by September 15, 2016. JLR failed to do so. Instead, on September 19, 2016, JLR filed a lawsuit against BRP in the U.S. District Court for the Eastern District of Michigan. Ironically, at the same time JLR was frustrating BRP's ability to obtain even the most rudimentary information through the discovery process in Opposition No. 91223380, JLR was using the information BRP had produced to JLR in Opposition No. 91223380 as the basis for JLR's decision to sue BRP.

Should the Board stay the present proceeding (and corresponding Opposition No. 91223380) in favor of JLR's 15-day-old lawsuit, BRP would be significantly prejudiced. For example, whereas JLR already has most – if not all – of the discovery it needs from BRP, BRP would have to wait several months before it could resume its efforts to receive a response to its September 8 letter and to obtain the very same discovery JLR has deliberately withheld from BRP. BRP should not be penalized simply because JLR decided to attempt to belatedly change the forum for the dispute between the parties—a forum it initially chose more than a year ago. If JLR is truly seeking a speedy resolution of its dispute with BRP, the better path would be to immediately move forward and conclude the present proceedings – including corresponding Opposition No. 91223380 – instead of re-setting the clock entirely by starting a new proceeding elsewhere.

C. A Final Determination Before the TTAB Would Have Collateral Estoppel Effect

One of the most frequent reasons why the TTAB stays proceedings in favor of district court cases is because of comity concerns, namely, a desire to conserve judicial and agency resources by prioritizing the court decision on likelihood of confusion. Historically, this was because, whereas a decision of a federal district court was often binding on the TTAB, a decision of the TTAB was not binding on a federal court. This dynamic has significantly changed since the Supreme Court's decision in *B&B Hardware, Inc. v. Hargis Industries, Inc.*, 575 U.S. ____ ; 135 S.Ct. 1293 (2015). Now a final determination by the Board on issues litigated before the Board can constitute collateral estoppel in a federal district court case between the same parties.

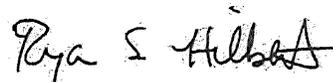
In light of the Court's decision in *B&B Hardware*, issues decided by the Board will not necessarily need to be re-litigated *de novo* in a subsequent action in a district court. Given the advanced nature of Opposition No. 91223380, it is possible that certain issues will be resolved by the Board well prior to any determination can be made by the U.S. District Court for the Eastern District of Michigan, especially given the jurisdictional and procedural issues raised by JLR's decision to sue a Canadian company like BRP in Michigan simply because it was convenient for JLR's counsel. Indeed, a final binding decision by the Board on certain matters involved in the cancellation and opposition would likely significantly streamline any corresponding federal lawsuit.

IV. CONCLUSION

For the reasons given above, BRP respectfully requests that the TTAB deny JLR's request for a suspension of the proceedings.

Respectfully submitted,

Bombardier Recreational Products Inc.



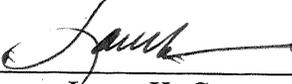
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CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing "**PETITIONER'S RESPONSE TO REGISTRANT'S NOTICE OF CIVIL ACTION AND REQUEST FOR SUSPENSION OF PETITION TO CANCEL**" was served on Registrant's counsel via first class mail, postage prepaid, on October 4, 2016, at the following address of record:

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By: 

Laura K. Greer