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Filing date: **01/03/2018**

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

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|------------------------|---|
| Proceeding | 92066968 |
| Party | Defendant Software Freedom Conservancy |
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| Signature | /Pamela S Chestek/ |
| Date | 01/03/2018 |
| Attachments | Motion-to-Suspend-Proceedings-final-signed.pdf(620407 bytes) |

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

In the Matter of Registration No. 4212971
Mark: SOFTWARE FREEDOM CONSERVANCY
Registration date: September 25, 2012

Software Freedom Law Center

Petitioner,

v.

Software Freedom Conservancy

Registrant.

Cancellation No. 92066968

REGISTRANT'S MOTION TO STAY PROCEEDINGS

Introduction

Registrant Software Freedom Conservancy ("Conservancy") moves for stay of any proceedings not germane to the pending motion by petitioner Software Freedom Law Center ("SFLC") to amend its petition to add a claim that the subject registration should be cancelled for fraud.

Statement of Facts

This action was filed on September 22, 2017¹ and timely answered on November 2, 2017.² On December 11, Conservancy filed a Motion for Summary Judgment on its affirmative defenses.³ On the

1 1 TTABVUE.

2 5 TTABVUE.

3 6 TTABVUE.

filing of the motion, all proceedings not germane to the motion were suspended. Trademark Rule 2.127(d), 37 C.F.R. § 2.127(d). On December 22, SFLC filed a motion for leave to amend the petition to cancel and to toll the time to respond to the motion for summary judgment,⁴ that is, asking that the time during which proceedings were suspended be further extended. On December 28, the Board deemed Conservancy's motion for summary judgment moot and resumed the proceedings.⁵ Conservancy now moves that the proceedings be re-suspended.

Argument

The Board may suspend the proceedings on motion. Trademark Rule 2.117, 37 C.F.R. § 2.117. This motion is brought very early in the case, before either party has propounded discovery. The scope of the claims in the petition will have a significant impact on what is required for discovery, especially as it relates to Petitioner's newly-asserted claim for fraud. Conservancy is a leanly-staffed non-profit⁶ that will be stretched by responding to discovery, much less multiple rounds of it with duplicative requests at different points in time depending on whether the petition is amended.

There is no harm by a further suspension. After all, the parties have co-existed for over ten years, and have had co-existing registrations for over five years.⁷ The petitioner could not have waited any

4 7 TTABVUE.

5 8 TTABVUE.

6 6 TTABVUE, Declaration of Karen M. Sandler in Support of Respondent's Motion for Summary Judgment on Its Affirmative Defenses, ¶ 23.

7 1 TTABVUE, ¶¶ 2-3, 7.

longer to file its petition to cancel, waiting until three days before the five-year anniversary of Conservancy's registration before filing its petition. A few more weeks will not cause any greater hardship to SFLC than it created for itself by its multi-year delay in filing the petition.

Further, the petitioner itself asked that its time for response to the motion for summary judgment be tolled.⁸ This was, in effect, a request to stay of the proceedings for the same time period that Conservancy now seeks, until a final determination on whether SFLC may amend its petition to add a claim that the subject registration should be cancelled for fraud. Thus, it appears both parties are in agreement that a stay is to both their benefit.

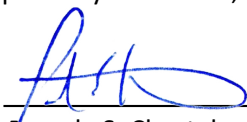
Conclusion

For all the reasons given above, the Respondent's Motion to Stay Proceedings should be GRANTED.

Respectfully submitted,

Dated: January 3, 2018

By: _____



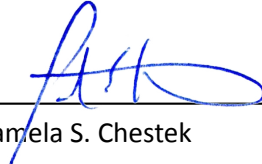
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Certificate of Service

I hereby certify that a true and complete copy of the foregoing REGISTRANT'S MOTION TO STAY PROCEEDINGS has been served on Software Freedom Law Center by mailing said copy on January 3, 2018, via electronic mail to:

Daniel Byrnes
Software Freedom Law Center
1995 Broadway, 17th Floor
New York, NY 10023

Email: dbyrnes@softwarefreedom.org

By:  _____
Pamela S. Chestek