UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: June 10, 2014

Opposition No. 91196016 (parent)

Carlos Ramirez

v.

Fredrick J. Staves

----------and----------

Opposition No. 91198643

Fredrick J. Staves

v.

Carlos Ramirez

By the Trademark Trial and Appeal Board:

Now before the Board are (1) Carlos Ramirez's ("Ramirez") motion, filed in the parent case on October 4, 2013, for involuntary dismissal of child Opposition No. 91198643 for Fredrick J. Staves' ("Staves") failure to take testimony therein; and (2) Todd Land's ("Land") motion, filed in the parent case on January 30, 2014, to intervene.

Relevant Procedural Background

Application Serial No. 77729569 is the subject of parent Opposition No. 91196016, is owned by Staves, and was published for opposition April 13, 2010; Ramirez was granted an extension of time, until August 11, 2010, to oppose Staves' application; and Ramirez filed a notice of opposition against Staves' application on August 11, 2010. Application Serial No. 77662861 is the subject of child Opposition No. 91198643, is owned by Ramirez, and was published for opposition October 9, 2010; Staves was granted extensions of time, until February 16, 2011, to oppose Ramirez's application; and Staves filed a notice of opposition against Ramirez's application on February 15, 2011. One month after Staves filed his notice of opposition, Opposition Nos. 91196016 and 91198643 were consolidated, with Opposition No. 91196016 as the parent. Discovery closed in these consolidated cases on April 25, 2013; Ramirez's testimony period as plaintiff in the parent case closed July 24, 2013; and Staves' testimony period as defendant in the parent case and as plaintiff in the child case closed September 22, 2013. *See* Board order dated December 20, 2012.

The two parties to these consolidated oppositions are Ramirez and Staves, two individuals. Although Ramirez also listed Majestics Car Club - SoCal ("SoCal") in the caption and body of his first amended notice of opposition [*see* TTABVUE filing # 26], SoCal has never been joined as a party to these proceedings, nor has Ramirez filed a motion seeking such action. By

way of the December 20, 2012 order, the Board noted, *inter alia*, that Ramirez had pleaded in his amended complaint that he was the owner of Registration No. 4109381, and, as such, had pleaded an allegation of ownership of a mark that would entitle him to bring his claim; and that it did not appear that Ramirez had asserted a collective membership mark. *See* TTABVUE filing # 33 (Board order dated December 20, 2012); and TTABVUE filing # 22 (Board order dated March 7, 2012) which required the parties to file either (1) an allegation of ownership, right to use, or other proprietary interest in their asserted marks that would entitle them to bring their claims, or (2) a brief explaining why they have standing to bring their respective oppositions.

Motion to Intervene

Intervention is controlled by Fed. R. Civ. P. 24 which contemplates both intervention of right (under Rule 24(a)) and permissive intervention (under Rule 24(b)). In his motion to intervene, Land argues that he should be permitted to intervene as a matter of right (Motion, p. 2) and permissively (Motion, p. 4). Land's motion to intervene was filed after the close of discovery and after the first two trial periods. The motion was not accompanied by either a notice of opposition (for the child case) or an answer (for the parent case), but was accompanied by the statements, which Land refers to as "affidavits/verifications," of 35 alleged car club chapter presidents.

Fed. R. Civ. P. 24(a) permits, "[o]n timely motion," a party to intervene as of right who:

> 1) is given an unconditional right to intervene by a federal statute; or
> 2) claims an interest relating to the property or transaction which is the subject of the action, and is so situated that disposing of the action may as a practical matter impair or impede the movant's ability to protect its interest, unless the existing parties adequately represent the interest;

and Fed. R. Civ. P. 24(b) states, in relevant part, that permissive intervention is permitted as follows:

> 1) On timely motion, the court may permit anyone to intervene who:
> A) is given a conditional right to intervene by a federal statute; or
> B) has a claim or defense that shares with the main action a common question of law or fact.

When one moves to intervene, Fed. R. Civ. P. 24(c) requires that the motion to intervene "must state the grounds for intervention and be accompanied by a pleading that sets out the claim or defense for which intervention is sought." Instead of providing the required pleadings, Land asks the Board to "advise him as to which pleading he should file...." Motion, p. 6. *See* also Reply, p. 3. Rule 24(c) requires that the motion be accompanied by a pleading, not a request for advice from the Board; the rule makes the pleading mandatory (i.e., "must ... be accompanied by a pleading..." [emphasis added]). Inasmuch as neither Land's motion nor his reply brief in support thereof was accompanied by any pleading, the motion to intervene may be denied on this procedural ground. In view thereof, the

motion to intervene is **denied**. In addition, the Board denies the motion as untimely, as explained below.[1]

Intervention is of right either where a federal statute confers an unconditional right or where an absentee must be permitted to intervene because (1) the absentee claims an interest relating to the property or transaction that is the subject of the action, and (2) is so situated that the disposition of the action may as a practical matter impair or impede the absentee's ability to protect that interest, unless (3) the existing parties adequately represent that interest. *See* Wright, Miller & Kane, 7C *Fed. Prac. and Proc.: Civ.* §§ 1906 and 1908 (3d ed. 2013).

Permissive intervention focuses on the existence of a common question of law or fact and the consideration of undue delay or prejudice. *See* Wright, Miller & Kane, 7C *Fed. Prac. And Proc.: Civ.* § 1911 (3d ed. 2013). The decision to grant permissive intervention is within the sole discretion of the court, and the key factor to be considered by the court in exercising that discretion is "whether the intervention will unduly delay or prejudice the rights of the original parties." *Bible Way Church of Our Lord Jesus Christ*

[1] To the extent Land's motion seeks to intervene as an opposer in child Opposition No. 91198643, the motion also may easily be disposed under Trademark Rule 2.101(c) which states that an "opposition must be filed within thirty days after publication ... of the application being opposed or within an extension of time ... for filing an opposition." Inasmuch as Land did not file an opposition within the 30 days allotted for initiating an opposition, did not request an extension of time to do so, and has not shown that he is in privity with the party that did so, it does not appear that the Board would have jurisdiction over any prospective notice of opposition filed by Land.

World Wide, Inc. v. Showell, 260 F.R.D. 1, 5 (D.C. Cir. 2009) (*quoting Fund for Animals, Inc. v. Norton*, 322 F.3d 728, 731 (D.C. Cir. 2003)).

Whether intervention is claimed as of right or as permissive, it is apparent from the both Rule 24(a) and 24(b) that a threshold inquiry that must be made prior to granting an intervention is whether the motion is "timely." *See Comm. of Pennsylvania v. Rizzo*, 530 F.2d 501, 506 (3rd Cir. 1976), *cert denied, Fire Officers Union v. Pennsylvania*, 426 U.S. 921 (1976); *Iowa State Univ. Res. Foun. v. Honeywell, Inc.*, 459 F.2d 447, 449 (8th Cir. 1972); *Lumbermens Mutual Cas. Co. v. Rhodes*, 403 F.2d 2, 5 (10th Cir. 1968). "If it is untimely, intervention must be denied." *Comm. of Pennsylvania*, 530 F.2d at 506. The timeliness requirement is determined by a court in the exercise of its discretion. *NAACP v. New York*, 413 U.S. 345, 365-66 (1973); *United States v. Yonkers Bd. Of Educ.*, 801 F.2d 593, 594-95 (2nd Cir. 1986). "The court has wide discretion in deciding whether the timeliness requirement has been satisfied." *Georgia-Pacific Consumer Prod. v. Von Drehle Corp.*, 815 F.Supp.2d 927, 930 (E.D.N.C. 2011) (*citing Brink v. DaLesio*, 667 F.2d 420, 428 (4th Cir. 1981)); *see also Chapman v. Manbeck*, 931 F.2d 46, 48, 18 USPQ2d 1565, 1567 (Fed. Cir. 1991).

Whether a motion to intervene is timely requires an analysis of the facts and circumstances surrounding the proceeding and in so doing, courts have considered how far the suit has progressed, the prejudice which delay might cause the other parties, and the reason for the tardiness in moving to

intervene. *See, e.g., Scardelletti v. Debarr*, 265 F.3d 195, 203 (4th Cir. 2001) (rev'd on other grounds, *Devlin v. Scardelletti*, 536 U.S. 1, 122 S.Ct. 2005 (2002)); *Gould v. Alleco, Inc.*, 883 F.2d 281, 286 (4th Cir. 1989) (*citing Comm. of Pennsylvania*, 530 F.2d at 506); *United States v. Pitney Bowes, Inc.*, 25 F.3d 66, 70 (2nd Cir. 1994).

As to the first factor - how far the suit has progressed - in the consolidated cases at hand, the parent opposition was filed on August 11, 2010, and the child opposition was filed on February 15, 2011;[2] discovery closed April 25, 2013; Ramirez's testimony period as opposer in the parent case closed July 24, 2013; and Staves' testimony period as applicant in the parent case and as opposer in the child case closed September 22, 2013. The motion to intervene was not filed until January 30, 2014, almost three years after the commencement of the child case, over nine months after the close of discovery, over six months after the first testimony period closed, over four months after the second testimony period closed, and almost four months after Ramirez filed the outstanding motion for involuntary dismissal. Thus, this first factor, how far the suit has progressed, weighs heavily against granting the motion.

As to the second factor - prejudice to the parties - it is again noted that discovery concluded April 25, 2013, over nine months prior to the motion to

[2] A cancellation proceeding between the parties, with Staves as petitioner, was filed on August 2, 2012, but that proceeding was dismissed with prejudice on December 19, 2012, after Staves failed to contest Ramirez's motion to dismiss the petition therein for failure to state a claim upon which relief could be granted.

intervene. Were Land permitted intervention at this late stage, long after the close of discovery and well after trial had begun, discovery might be necessary to explore whatever claims Land might plead in the parent and defenses he might plead in the child. Of course, Land's claims and defenses are unknown since he failed to accompany his motion with any pleading. Re-opening and conducting further discovery at this very late stage in the proceedings would be likely to prejudice Ramirez. *See Iowa State Univ. Res. Foun.*, 459 F.2d at 448-49 (Motion to intervene denied noting that "any efforts to conduct additional discovery and to recall witnesses would result in substantial delay and might very well interfere with the orderly presentation of evidence in the present parties' primary cases."). Accordingly, the prejudice to Ramirez also weighs against granting the motion.

As to the third factor - reason for tardiness in filing the motion - Land has not fully revealed why he waited almost three and a half years after commencement of the parent proceeding and almost three years after commencement of the child proceeding to seek intervention. It is noted that Land included an "affidavit[]/verification[]" by Staves himself, which appears to be dated July 20, 2013, and which states that Staves and Land are both members of a six-member board that oversees multiple chapters of a car club. Land indicates in the motion that Ramirez "has been sending letters" about "the Majestics' symbol" (Motion, p. 3) and included with his reply brief a copy of a single, "recent threat" (Reply, p. 2, *see also* Exhibit B thereto) which is

dated June 17, 2013, but is not addressed to Land. Land offers no explanation why he waited over seven months from that "recent threat" - which was not directed to Land himself- to file his motion to intervene. Most of the "affidavits/verifications" submitted with the motion state that Ramirez was "voted out of his position as the Vice President of The So.Cal Chapter, and was also voted out of the Majestics Car Club as a whole on June 2013," but Land fails to explain why he waited over seven months from Ramirez's ouster to file his motion. Similarly, all of the "affidavits/verifications" submitted by Land with his motion appear to be dated July 20, 2013, but Land fails to explain why he waited over six months from the execution date to file his motion. The facts are sparse and the motion raises more questions than it answers about Land's tardiness. Thus, the third factor, the reason for the tardiness, also weighs against granting the motion.

For the reasons discussed, Land's motion to intervene is also **denied** as untimely.[3] In view of the Board's decision regarding timeliness of the motion to intervene and the failure of Land to accompany the motion with any pleading, the Board need not reach a decision on the remaining requirements of Rule 24.

[3] Land is not without recourse. He may, if appropriate, file a cancellation action against Ramirez's pleaded registration and pleaded application -if/when that application registers.

Motion to Dismiss

Ramirez's motion for involuntary dismissal is granted as conceded.[4] *See* Trademark Rules 2.127(a) and 2.132. Accordingly, child Opposition No. 91198643 is **dismissed** with prejudice.[5] Application Serial No. 77662861 will move forward. Inasmuch as the child is herein dismissed, proceedings are now unconsolidated. Only parent Opposition No. 91196016 survives.

Schedule

Proceedings are resumed in Opposition No. 91196016. Inasmuch as Staves did not introduce any evidence during his testimony period as defendant in Opposition No. 91196016, there is no need to reset a rebuttal testimony period for Ramirez. *See, e.g., Plus Products v. Don Hall Labs.*, 191 USPQ 584, 585 n.2 (TTAB 1976) (when defendant fails to take testimony there is nothing to rebut). In view thereof, Opposition No. 91196016 may proceed to final briefing. *See* Trademark Rule 2.128. Briefing dates are set as follows.

Plaintiff Ramirez's brief due:	August 8, 2014
Defendant Staves' brief due, if filed:	September 7, 2014
Reply brief due, if filed:	September 22, 2014

[4] Staves did not contest the motion. The Board notes, however, that Staves filed (on September 10, 2013) his "pre-trial disclosures" which include various exhibits. The filing fails to meet the requirements of a notice of reliance and will be given no consideration. *See* Trademark Rules 2.012(j)(8) and 2.122(e), and TBMP §§ 704.02 and 704.08(a).

[5] To the extent that Land's motion could be construed as one to reopen the time in which the intervener may file a brief in opposition to the motion for judgment, Land has presented not argument as to excusable neglect therefor, and Land failed to make any substantive argument opposing the motion to dismiss.

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.l29.

A copy of this order has been mailed to the following addresses:

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