

ESTTA Tracking number: **ESTTA672899**

Filing date: **05/18/2015**

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

Proceeding	91214606
Party	Defendant Will Heitman
Correspondence Address	TROY I ROBERTS LAW OFFICE OF TROY I ROBERTS PC 245 NE PERRY AVENUE PEORIA, IL 61603 UNITED STATES troyiroberts@ameritech.net
Submission	Reply in Support of Motion
Filer's Name	Troy Roberts
Filer's e-mail	troyiroberts@ameritech.net
Signature	/Troy Roberts/
Date	05/18/2015
Attachments	Reply Brief to Response to Motion to Dismiss.pdf(252747 bytes )

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

In the matter of trademark application for the mark	)	
CHROME MAFIA MOTORCYCLE CLUB	)	
(STANDARD CHARACTER MARK)	)	
Published in the Official Gazette on September 24, 2013	)	
	)	
JASON SMITH, individually and as President of	)	Opposition No. 91214606
CHROME MAFIA, a motorcycle club located in the	)	Serial No. 85910676
City of Jacksonville, Illinois, Opposer	)	
	)	
v.	)	
	)	
WILL HEITMAN, Applicant	)	

**Reply Brief of Defendant to  
Plaintiff's Response to Motion to Dismiss**

To all parties of record:

Troy I. Roberts, Esquire, Law Office of Troy I. Roberts, 245 N.E. Perry Ave., Peoria, IL 61603, Attorney for Applicant, Will Heitman.

Pursuant to Trademark Rules 2.127 (a) and 2.132(a); Applicant/Defendant, Will Heitman, ("Applicant" or "Defendant") hereby replies to the Response to Motion for Dismissal for Failure to Prosecute Pursuant to 37 C.F.R. 2.132(a) submitted by the Opposer/Plaintiff, Jason Smith, individually and as President of Chrome Mafia, ("Opposer" or "Plaintiff") as follows, reaffirming his request for dismissal of this proceeding due to the Plaintiff's absolute total failure to prosecute his case without a justifiable showing of good and sufficient cause. This Reply Brief supplements Defendant's original Motion to Dismiss and addresses additional issues submitted by the Plaintiff.

## I. ADDITIONAL RELEVANT FACTS

Plaintiff has alleged, without any supporting documentation, that he has suffered from undefined “*severe medical issues*” requiring alleged hospitalization for “*weeks at a time*” and which allegedly required surgery on May 5, 2015. Plaintiff’s entire response contains self-serving, unsubstantiated statements which fail to support his request for denial of the pending motion and for the establishment of all new deadlines in this cause. Plaintiff has failed to provide specific facts regarding the nature of the alleged medical issues and whether or not such alleged issues were so debilitating so as to significantly impair his ability to proceed in this cause in a timely fashion. More importantly, Plaintiff has failed to provide specific dates, so that this Board is unable to determine whether or not any such alleged medical issues, even if true, were at such times and of such a degree as to constitute excusable neglect for the Plaintiff’s total failure to meet any deadlines and to submit any testimony or evidence. It is important to note that, even with said alleged medical issues and pending surgery, Plaintiff apparently was able to file a response to Defendant’s pending Motion to Dismiss on May 1, 2015, just four days prior to this alleged surgery.

In addition to the Plaintiff’s failure to provide any initial discovery disclosures, failure to provide any pre-trial disclosures, and failure to take any evidence or testimony at all during his trial period, it is important to look at additional actions available to the Plaintiff, based upon his alleged medical issues, which were also not taken.

Defendant’s counsel had already shown Plaintiff the ability to compromise regarding deadline dates in this cause. As detailed in his Motion filed on April 2, 2014, Defendant and his counsel attempted to initiate this matter’s Initial Discovery Conference on said date.

*Defendant's Motion for Extension of Discovery Conference (w/ consent), filed April 2, 2014.* At that time, Plaintiff indicated a desire to obtain legal counsel, which he said he could do within 24 hours. *Id.* Defendant's counsel agreed to allow Plaintiff 14 days to obtain legal counsel and allow said counsel sufficient time to familiarize him or herself with the case prior to the conference. *Id.*

Plaintiff not only failed to obtain legal counsel, but the only formal action he took in this cause after that initial conference was to file the Response to Motion for Dismissal over one year later, on May 1, 2015. At no time did Plaintiff file any type of motion or simply request from Defendant's counsel an extension of any of the multiple deadlines missed or ignored by Plaintiff for any reason, let alone alleged health issues. Certainly, any action on the part of the Plaintiff early in the proceedings in that manner would have been more understandable, and would have resulted in a much more limited and manageable delay of the proceedings. But to totally ignore all deadlines, fail to take any action at obtaining an agreed extension of any deadlines or timely moving to do the same, and then seek to obtain a "resetting" of the entire proceedings flies in the face of this Board's rules and any notion of equity and fair play. Indeed, it is a strong indicator of bad faith and an interest only in delaying this matter for as long as possible.

## **II. LEGAL ARGUMENT**

### **Opposer's Response Fails to Provide "Excusable Neglect" for His Failure to Prosecute, and Therefore This Proceeding Should Be Dismissed With Prejudice**

Trademark Rule 2.132(a) provides that a motion for dismissal for failure to prosecute may be made by a defendant if a plaintiff's testimony period has expired and that party has neither taken any testimony nor offered any evidence in support of its case. In response, the

plaintiff must show cause why judgment should not be rendered against it and in the absence of a showing of good and sufficient cause, judgment may be rendered against the plaintiff. See 37 CFR Section 2.132(a). The "good and sufficient cause" standard, in the context of this rule, is equivalent to the "excusable neglect" standard which would have to be met by any motion under FRCP 6(b) to reopen the plaintiff's testimony period. *HKG Industries, Inc. and Floodtronics, Inc. v. Perma-Pipe, Inc.*, 49 U.S.P.Q.2d 1156, 1998 WL 916482 (TTAB 1998) citing *Grobet File Co. of America, Inc. v. Associated Distributors Inc.*, 12 USPQ2d 1649 (TTAB 1989); and *Fort Howard Paper Co. v. Kimberly-Clark Corp.*, 216 USPQ 617 (TTAB 1982). See also, TBMP Section 535.02. It is the Plaintiff's burden to establish and show this "good and sufficient cause"/"excusable neglect." See *HKG*; and *37 C.F.R. Section 2.132(a)*.

In *Pioneer Investment Services Company v. Brunswick Associates Limited Partnership et al.*, 507 U.S. 380 (1993), as discussed by the Board in *Pumpkin Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997), the Supreme Court held that the determination as to whether a party's neglect is excusable is at bottom an equitable one, taking account of all relevant circumstances surrounding the party's omission. These include . . . [1] the danger of prejudice to the [nonmovant], [2] the length of the delay and its potential impact on judicial proceedings, [3] the reason for the delay, including whether it was within the reasonable control of the movant, and [4] whether the movant acted in good faith.

In *HKG*, in response to a motion to dismiss, based upon the Plaintiffs' failure to take any testimony or offer any evidence in support of their case during their testimony period, the Plaintiffs alleged that their attorney of record who was "*responsible for all aspects of the cancellation proceeding*" had "*recently died.*" The Board focused upon the third factor identified in *Pioneer*, the reason for the delay, including whether it was within the reasonable

control of the movant (which the Board opined might be the most important of the Pioneer factors), in ultimately granting the Defendant's motion to dismiss. The Board found, *inter alia*, that the failure of the Plaintiffs to provide specific information connecting the alleged excuse with the inability to present any evidence during their testimony period was troubling, as follows:

*“Ordinarily the death of plaintiff's counsel would constitute good and sufficient cause as contemplated by Trademark Rule 2.132, provided, however, that the death occurred at a time relatively contemporaneous with the opening and closing of the plaintiff's testimony period. In this particular case, however, petitioners have not provided critical factual information as to the precise date of Mr. Podwil's death, with the result that there is no evidence of record that his death occurred at such a time as to prevent petitioners from going forward with their testimony period. The Board is unable to weigh the third Pioneer factor in petitioners' favor in view of the absence of evidence linking the reason for the delay with the expiration of petitioners' testimony period.” Id.*

Similarly, in this cause, Plaintiff has failed to provide any specifics regarding his alleged medical issues such as would allow this Board to weigh the third Pioneer factor in Plaintiff's favor based upon a total lack of evidence linking the reason for the delay with the expiration of every deadline which the Plaintiff missed, especially the Plaintiff's trial period. Plaintiff did not provide competent evidence regarding the nature of his alleged medical issues. Plaintiff did not provide competent evidence regarding relevant time frames so as to excuse every missed deadline. Plaintiff did not explain how he could file a quick response to the pending motion, but could not file timely motions regarding extension of any of the missed deadlines. He simply

waited until all of the applicable deadlines had passed before seeking a whole new set of deadlines. This new set of requested deadlines and the subsequent reopening of Plaintiff's trial period would significantly increase the Defendant's time delay and expense relating to this initial, simple application. This type of conduct establishes bad faith on the part of the Plaintiff as contemplated within the fourth Pioneer factor. The length of delay and corresponding extended costs for Defendant if he has to "start over" also weigh in Defendant's favor as to the first and second Pioneer factors.


And while the facts of this case even more clearly support dismissal of Plaintiff's action with prejudice, as compared with the decision in *HKG*, the overwhelming factor supporting Defendant's Motion for Dismissal is the reasonable control available to the Plaintiff. While illness isn't always avoidable, even giving Plaintiff the benefit of the doubt that there was some type of illness (which Defendant is not conceding and which has certainly not been established by any competent evidence), it was certainly within the reasonable control of the Plaintiff to take some type of action, to file some type of motion prior to the expiration of all applicable deadlines, or even to reach out to Defendant's counsel much earlier in the proceeding regarding any type of extension agreement prior to the passing of any deadline. Plaintiff has certainly provided no evidence or support to indicate that he was somehow unable to undertake any or all of these simple, possible actions. His objection to the pending motion thus fails, as he has failed to meet his burden of showing good and sufficient cause for the failure to meet all of his requisite deadlines and further failure to provide any testimony or evidence in this cause.

### III. CONCLUSION

For the foregoing reasons and applicable legal authority, in addition to the facts and authority presented within the initial Motion for Dismissal, Applicant/Defendant requests that his Motion for Dismissal for Failure to Prosecute Pursuant to 37 C.F.R. 2.132(a) be granted, and that Opposer's/Plaintiff's cause of action be dismissed with prejudice.

Dated: 5/18/15

Respectfully submitted,

By: 

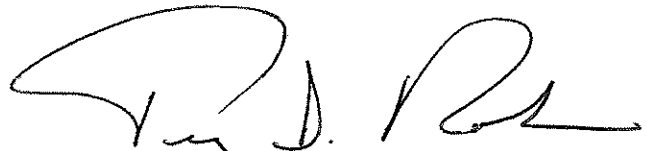
TROY I. ROBERTS, ARDC No. 6216753  
Law Office of Troy I. Roberts, P.C.  
245 N.E. Perry Avenue  
Peoria, Illinois 61603  
[troyiroberts@ameritech.net](mailto:troyiroberts@ameritech.net)  
Telephone – (309) 655-3003  
Facsimile – (309) 637-5433

Attorney for Defendant, Will Heitman

**CERTIFICATE OF ELECTRONIC FILING  
AND CERTIFICATE OF SERVICE**

I, the undersigned, do hereby certify that on 5/18/15, I electronically filed a true and correct copy of the foregoing document with the Trademark Trials and Appeals Board using the ESTTA system, and mailed a copy to all other parties of record by first class mail, addressed as follows:

Jason Smith  
869 Route  
Jacksonville, IL 62650  
Houseofink2@hotmail.com



---

TROY I. ROBERTS, ARDC No. 6216753  
Law Office of Troy I. Roberts, P.C.  
245 N.E. Perry Avenue  
Peoria, Illinois 61603  
troyiroberts@ameritech.net  
Telephone – (309) 655-3003  
Facsimile – (309) 637-5433