

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: August 27, 2015

Opposition No. 91216503

Sturgis Motorcycle Rally, Inc.

v.

John Paul Dejoria

**Robert H. Coggins,
Interlocutory Attorney:**

Now before the Board is Applicant's motion (filed July 24, 2015) to suspend proceedings pending disposition of a civil action and a Board cancellation proceeding to which Opposer is a party.

Telephone Conference

On August 19, 2015, at approximately 2:00 p.m. EDT the Board conducted a telephone conference to resolve the outstanding motion. Participating in the conference were Michaeline Re, counsel for Applicant; Gina Iacona, counsel for Opposer; and the above-signed Board attorney responsible for resolving interlocutory matters in this case. The Board appreciates the parties' availability for the conference.

Inasmuch as the conference was held prior to the time in which Applicant might otherwise file a written reply brief in support of the motion, Applicant was afforded

the opportunity during the conference to give an oral reply. The Board presumes familiarity with the issues, and for the sake of efficiency this order does not summarize the parties' arguments raised in the motion and briefs, or statements made during the conference. Instead, this order lists the decisions made by the Board.

Motion to Suspend

The motion to suspend proceedings was **granted** to the extent that it seeks suspension pending final disposition of the civil action involving Opposer.¹ Trademark Rule 2.117(a). It is the policy of the Board to suspend proceedings when a party to a case pending before it is involved in a civil action which may have a bearing on the Board case. *See* TBMP § 510.02(a) (2015). The motion was **denied** without prejudice to the extent that it seeks suspension pending Cancellation No. 92054714 also involving Opposer.

Change of Correspondence Address

Applicant stated that his correspondence address had changed. The Board noted and entered the new correspondence address which appeared on the motion to suspend.

Electronic Filing

Applicant was encouraged to make all future filings via the ESTTA filing system (<http://estta.uspto.gov>). *See* TBMP §§ 110.09.

¹ Civil Action No. 5-11-cv-05052-JLV, styled *Sturgis Motorcycle Rally, Inc. v. Rushmore Photo & Gifts, Inc., et al.*, filed June 22, 2011, in the United States District Court for the District of South Dakota. The operative pleadings from the civil action are available in multiple Board cases, including Opposition No. 91205827 at 9 TTABVUE 7-22 and 57-77.

Suspension

Proceedings were **suspended** pending final disposition of the civil action involving Opposer.

Within thirty days after the final determination² of the civil action, the parties shall so notify the Board so that this proceeding may be called up for appropriate action.³ Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action. During the suspension period, the parties must notify the Board of any address changes for the parties or their attorneys. In addition, the parties are to promptly inform the Board of any other related cases, even if they become aware of such cases during the suspension period.

² A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom or all appeals filed have been decided. *See* TBMP § 510.02(b).

³ The Board noted that the motion to suspend was filed within the thirty-day period allowed for Applicant to comply with the Board's order compelling discovery responses. *See* Order dated July 17, 2015. Applicant stated that he had since provided the compelled responses.