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July 21, 2015

United States Patent and Trademark Office
Trademark Trial and Appeal Board
Box- TTAB
Fee
P. O. Box 1451
Arlington, VA 22313-1451

Re: Opposition Proceeding No. 91216503

Dear Trademark Trial and Appeal Board:

Enclosed please find an original and one copy of our Motion to Suspend the above-captioned proceedings pending the outcome of a Federal Case and Cancellation proceeding 92054714.

Thank you for your anticipated help and cooperation in this matter.

Very truly yours,



Michaeline A. Ré

MAR:md
enclosures



07-24-2015

U.S. Patent and Trademark Office #72

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the matter of U. S. Trademark Application
Serial No. 86/031,102
For the mark LEGENDARY STURGIS
Filed: August 7, 2013
Published in the Official Gazette on January 21, 2014

Sturgis Motorcycle Rally, Inc.)	
)	Opposition No.91216503
Opposer,)	
)	
v.)	
)	
John Paul DeJoria, an individual,)	
)	
Applicant.)	
_____)	

TTAB Fee: NONE

Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3515

MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL
ACTION PURSUANT TO TRADEMARK RULE 2.117(a)

Applicant, John Paul DeJoria, an individual, by his attorney Michaeline A. Re, hereby
moves for suspension of these proceedings pursuant to Trademark Rule 2.117(a), 37 C.F. R.
Section 2.117(a).

Applicant is seeking suspension pending the outcome of a civil proceeding involving the
opposer currently pending involving Registration No. 3923284 (Sturgis Motorcycle Rally, Inc. V.
Rushmore Photo & Gifts, Inc. Et al., Case No. 5:11-cv-05052-JLV, pending in the U.S.District

Court for the District of South Dakota) (the “Federal Case”). The Federal Case involves the validity of Sturgis Motorcycle Rally, Inc., the opposer’s here-involved registrations are at issue.

In addition there is currently pending, but under suspension, a Cancellation proceeding No. 92054714 in the matter of Concerned Citizens for Sturgis, Inc. V. Sturgis Motorcycle Rally, Inc. before this Board that would affect the validity of opposer’s registrations at issue in this proceeding.

Application specifically requests that these proceedings be suspended, pending a final determination in the Federal Case and in the Cancellation proceeding pursuant to Trademark Rule 2.117(a).

In the Notice of Opposition filed by Sturgis Motorcycle Rally, Inc. against application for registration of John Paul DeJoria’s trademark LEGENDARY STURGIS, Serial No. 86031102 filed August 7, 2013 and published in the Official Gazette on January 21, 2014, the opposer claims that it is the owner of the following marks:

1. STURGIS, U.S. Registration Nos. 3,923,284 and 4,440,406 (which are the subject of the Federal Case and the Cancellation proceeding cited herein above)in Classes 06, 08, 09, 13, 16, 20, 21, 24, 25, 26, 28, 32, 33, 35, and 41;
2. THE LEGEND LIVES ON, U.S. Registration No. 2513621 in Class 25;
3. STURGIS BIKE WEEK, U.S. Registration No. 3818703in Class No. 34;
4. TAKE THE RIDE TO STURGIS, U.S. Registration No. 2698677, in Class 25;
5. BLACK HILLS MOTOR CLASSIC STURGIS RALLY & RACES BLACK HILLS, S.D., U.S. Registration No. 1948097, in Class 035.

In the Petition for Cancellation, the petitioner claims that the STURGIS mark is the name and designation of a geographical place, a city in the State of South Dakota, is primarily a

geographical description and not sufficiently distinctive to warrant protection.

The Federal Case involves the same issues as this proceeding, whether or not the STURGIS trademark provides a legitimate basis to support a finding of infringement or likelihood of confusion. The determination of these issues by the District Court and the Cancellation proceeding will likely be dispositive of the issues involved in this proceeding.

Applicant therefore respectfully requests suspension of these proceedings pending determination of the Federal Case and the Cancellation proceeding pursuant to Trademark Rule 2.117(a), 37 C.F.R. Section 2.177(a). *Whopper-Burger, inc. V. Burger King Corp.*, 171 U.S.P.Q. 805, 807 (T.T.A.B. 1971) (suspending Cancellation proceeding in light of pending federal litigation because “the outcome of the civil action will have a direct bearing on the question of the rights of the parties herein and may in fact completely resolve all the issues.”) *See, Goya Foods, Inc. V. Tropicana Products Inc.*, 846 F.2d 848, 6 USPO2d 1950, 1954 (2nd Cir. 1988) and *The Tamarkin Co. V. Seaway Food town, Inc.* , 34 USPQ2d 1587, 1592 (TTAB 1995).

Respectfully submitted,

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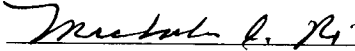
Dated: July 21, 2015

Opposition Proceeding 91216503

CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing MOTION TO SUSPEND PROCEEDING IN VIEW OF PENDING CIVIL ACTION AND CANCELLATION PROCEEDING was served on counsel for Opposer this 21 day of July 2015, by sending th same via First Class Mail, postage prepaid to:

Jason M. Sneed, Esq.
Gina R. Iacona, Esq.
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Michaeline A. Re
Attorney for the Applicant