

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Mailed: February 13, 2003

Opposition Nos. 112,850;
and 112,851;
Cancellation No. 41,048

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Motion to Consolidate

This case now comes before the Board for consideration of the motion to consolidate Opposition Nos. 112,850 and 112,851 with Cancellation No. 41,048, filed by Viacom International Inc. (hereinafter "Viacom") as opposer/petitioner herein.¹ Minataur Productions, Inc. (hereinafter "Minataur") has filed a brief in opposition thereto.

The Board has carefully considered the arguments of both parties with regard to the above motion. However, an exhaustive review of those arguments would only serve to delay the Board's disposition of this matter.

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a);

¹ Opposition Nos. 112,850 and 112,851 were consolidated in a Board order issued on November 22, 2002.

Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. See, for example, Wright & Miller, *Federal Practice and Procedure: Civil* §2383 (1971); and *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982). Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, for example, *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); and *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991).

In this case, the parties to the instant proceedings are identical; the pleadings in all three proceedings are based upon likelihood of confusion and priority, with the addition of an abandonment claim in Cancellation No. 41,048; and all three proceedings are in the pre-trial stage. As such, the savings in time, effort and expense on the part of the Board and the parties outweighs any potential prejudice or inconvenience which may be occasioned by the consolidation of these cases.

Accordingly, Viacom's motion to consolidate is hereby **granted** to the extent that Opposition Nos. 112,850 and 112,851 are hereby consolidated with Cancellation No. 41,048.

The consolidated cases may be presented on the same record and briefs. See *Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989). The Board file will be maintained in Opposition No. 112,850 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear all three proceeding numbers in its caption. Exceptions to the general rule involve stipulated extensions of the discovery and trial dates, and briefs on the case. See Trademark Rules 2.121(d) and 2.128.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. See *Wright & Miller, Federal Practice and Procedure, supra*. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

In keeping with standard Board practice, the consolidated proceeding schedule is reset to that of the

"youngest" of the consolidated cases, that is, Cancellation No. 41,048.

Answers Noted

Minatuar's consented motions to extend its time to answer the notice of opposition in Opposition No. 112,850 and the petition for cancellation in Cancellation No. 41,048 are granted. Accordingly, Minataur's answers filed in the above referenced proceedings are timely, and as such are accepted and made of record.²

Determination on Motions to Amend Deferred

The motions to amend its application Serial No. 75/192,631 and Registration No. 2,317,477, filed by Minataur in Opposition Nos. 112,850 and Cancellation No. 41,048, are noted.

The Board generally will defer determination of an unconsented motion to amend in substance until final decision, or until the case is decided upon summary judgment. See *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216 (TTAB 1990) (defendant's motion to amend its identification of goods to include restriction); *Fort Howard Paper Co. v. C.V. Gambina Inc.*, 4 USPQ2d 1552 (TTAB 1987) (defendant's motion to amend dates of use in its subject application); and *Mason Engineering & Design Corp. v.*

² It is noted that Minataur's answer (filed June 20, 2001) to the notice of opposition in Opposition No. 112,851 is of record.

Mateson Chemical Corp., 225 USPQ 956 (TTAB 1985)

(defendant's motion to amend dates of use in its subject application). See also Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991).³

Accordingly, determination of Minataur's above motions to amend is hereby deferred.

³ If the Board ultimately finds that a defendant is not entitled to registration in the absence of a restriction which was timely proposed by the defendant, the proposed restriction will be approved and entered. If a further refinement thereof is found necessary by the Board, and is within the scope of the notice given to plaintiff by defendant, or was tried with the express or implied consent of plaintiff, defendant will be allowed time in which to file a request that its application or registration be amended to conform to the findings of the Board, failing which judgment will be entered against the party. See 37 CFR §2.133(b), and Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, 81 Trademark Rep. 408 (1991). See also Section 18 of the Act, 15 U.S.C. §1068. If, on the other hand, the Board ultimately finds that defendant is entitled to registration even without the proposed restriction, defendant will be allowed time to indicate whether it still wishes to have the restriction entered. See Louise E. Rooney, *TIPS FROM THE TTAB: Rule 2.133 Today*, *supra*.