



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

SPORTS MACHINE, INC.,  
d/b/a/ Bike Source,

Opposer,

v.

MIDWEST MERCHANDISING, INC.,

Applicant.

Opposition No.: 122,948

Application No. 76/035,008



03-12-2003

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #77

MEMORANDUM IN SUPPORT OF  
APPLICANT'S MOTION TO RESUME PROCEEDINGS AND ENTER  
JUDGEMENT UNDER TBMP 510.02(b)

Background

Cancellation No. 30,578 (the "Cancellation") involved the single issue of whether the Applicant's registered mark:

**BIKESOURCE**

is merely descriptive of "retail store outlets featuring bicycles, bicycle accessories and replacement parts, and apparel relating to bicycling."

The subject Opposition (the "Opposition") was suspended by order of the Board on November 14, 2001 in response to Opposer's request to consolidate the two proceedings. The Opposition involves precisely the same single issue as

applied to the mark BIKESOURCE in block letter form, for which registration is sought for the same services.

The Subject Opposition Should be Resumed

Basis of Motion

Applicant's Motion is governed by TBMP § 510.02(b), which provides:

When a proceeding before the Board has been suspended pending the outcome of another proceeding, and that other proceeding has been finally determined, the interested party should file a paper notifying the Board of the disposition of the other proceeding, and requesting that further appropriate action be taken in the Board proceeding (i.e., usually, the interested party requests, as a result of the decision in the other proceeding, that judgment be entered in its behalf on one or more issues in the Board proceeding). The paper should be accompanied by a copy of the decision in the other proceeding.

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.

The Cancellation was dismissed by judgement of the Board entered on December 31, 2002, and the time period for filing a Notice of Appeal expired on March 1, 2003. A copy of the Board's decision in the Cancellation is attached hereto as Exhibit A.

Accordingly, the Cancellation has been fully and finally determined and no appeal has been filed. Resumption of the Opposition is therefore proper.

Judgement in Favor of Applicant Should Now be Entered and the Opposition

Dismissed

The Opposition involves precisely the same issue as applied to the mark BIKESOURCE in block letter form – whether the mark as applied to the “retail store outlets featuring bicycles, bicycle accessories and replacement parts, and

apparel relating to bicycling” is merely descriptive. The Board so ruled in its decision of November 14, 2001, agreeing with Opposer<sup>1</sup> that the “co-pending Cancellation and Opposition do involve nearly identical legal and factual issues and thus have a bearing on one another.” See Board Decision of November 14, 2001, attached as Exhibit B.

Indeed, Opposer has admitted that the issues in the Cancellation and the Opposition are the same inasmuch as this was the grounds upon which Opposer originally sought consolidation of the Cancellation and the Opposition. See Opposer’s Motion to Consolidate Proceedings filed July 5<sup>th</sup>, 2001 herein and attached as Exhibit C.

The Board has already decided that the mark BIKESOURCE (Stylized) is not merely descriptive of the services for which it has been registered.

As part of that decision, the Board clearly considered whether the term BIKESOURCE (regardless of stylization) was merely descriptive of the services for which it has been registered. The Board considered all of the evidence Opposer mustered relating to its charge that the term BIKESOURCE was merely descriptive of the services for which it had been registered, and yet the Board still ruled that the constituent words “bike” and “source” are not merely descriptive of retail bicycle services. See pages 9 - 14 of the Board’s holding in the Cancellation relating to its analysis of the alleged mere descriptiveness of the words comprised by the mark BIKESOURCE, and the denial of Petitioner’s request to require disclaimer of “BIKESOURCE,” attached as Exhibit A.

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<sup>1</sup> A review of this decision reveals that the Board mistakenly reversed reference to the Applicant’s position and Opposer’s position.

Accordingly, even though the Board's decision was directed to whether the mark BIKESOURCE in stylized lettering is merely descriptive, the analysis of the alleged mere descriptiveness of the mark BIKESOURCE in block letter form would no doubt lead to the same result; i.e., that the term BIKESOURCE itself is not merely descriptive, and remains registrable without disclaimer as does its stylized script equivalent.

Accordingly, the issue of descriptiveness of the term BIKESOURCE is *res judicata*, and judgement in favor of Applicant may now be entered in the subject Opposition.

Relitigation of this same issue would be a waste of the Board's time and resources.

Conclusion

In view of the foregoing, Applicant respectfully requests that the Opposition be resumed, and that judgement in favor of Applicant may now be entered in the subject Opposition.

Respectfully submitted,

**MIDWEST MERCHANDISING, INC.**

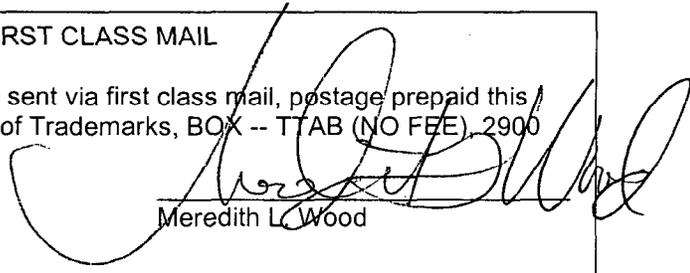
Date

March 10, 2003

  
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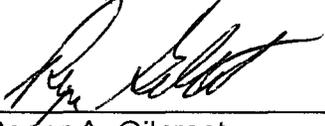
CERTIFICATE OF FIRST CLASS MAIL

I hereby certify that this correspondence is being sent via first class mail, postage prepaid this 10<sup>th</sup> day of March, 2003 to Assistant Commissioner of Trademarks, BOX -- TTAB (NO FEE), 2900 Crystal Drive, Arlington, Virginia 22202-3513.

  
Meredith L. Wood

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing APPLICANT'S MOTION TO RESUME PROCEEDINGS AND ENTER JUDGEMENT UNDER TBMP 510.02(b) and MEMORANDUM IN SUPPORT OF APPLICANT'S MOTION TO RESUME PROCEEDINGS AND ENTER JUDGEMENT UNDER TBMP 510.02(b) were sent U.S. Mail, postage pre-paid this 10<sup>th</sup> day of March, 2003 to Mary J. Gaskin, Esq., Attorney for Opposer, Sports Machine, Inc., Annelin & Gaskin, 2170 Buckthorne Place, Suite 200, The Woodlands, Texas 77380.

  
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THIS DISPOSITION IS  
NOT CITABLE AS PRECEDENT  
OF THE TTAB

Mailed: December 31, 2002  
Paper No. 22  
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Sports Machine, Inc., dba BikeSource  
v.  
Midwest Merchandising, Inc.

Cancellation No. 30,578

Mary J. Gaskin of Annelin & Gaskin for Sports Machine, Inc.

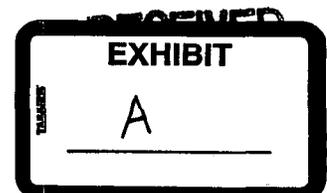
Roger A. Gilcrest of Standley & Gilcrest LLP for Midwest  
Merchandising, Inc.

Before Walters, Chapman, and Bucher, Administrative  
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

Sports Machine, Inc., dba BikeSource (a Texas  
corporation) has filed a petition to cancel a registration  
on the Principal Register issued to Midwest Merchandising,  
Inc. (a Delaware corporation), for the mark shown below

**BIKE SOURCE**



for "retail store outlets featuring bicycles, bicycle accessories and replacement parts, and apparel relating to bicycles" in International Class 42.<sup>1</sup>

Petitioner asserts as grounds for cancellation that it "is the owner of common law rights in the service mark Bike Source, which it has used continuously in the State of Texas since March 1, 1994, to identify its retail stores and related equipment" (Paragraph 1); that respondent wrote to petitioner on February 28, 2000 demanding that petitioner "immediately discontinue use of the name 'BikeSource' or face legal action" (Paragraph 3); that the words making up respondent's mark are merely descriptive of the services in connection with which the mark is used; that because the words "BIKESOURCE are merely descriptive, Petitioner should be entitled to use the words 'bike' and 'source' in connection with its operation of its retail store outlets for bicycles, etc." (Paragraph 5); and that registration of respondent's service mark violates Section 2(e)(1) of the Trademark Act.

In its answer, respondent denied the salient allegations of the petition to cancel, and raised the affirmative defenses of laches (asserting petitioner had knowledge of respondent's use and registration of its mark,

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<sup>1</sup> Registration No. 1,887,592, issued April 4, 1995, Section 8 affidavit accepted. The claimed date of first use and first use in commerce is March 15, 1991.

but unreasonably delayed in bringing action), and estoppel (asserting petitioner uses the mark BIKESOURCE as a source-indicative mark for retail stores featuring bicycles, and is therefore estopped from claiming the term functions merely to describe the registered services).

The record consists of the pleadings; the file of respondent's registration; petitioner's testimony, with exhibits, of Leonard Garland, petitioner's president and owner; respondent's testimony, with exhibits, of (i) Van Shuff, respondent's operations manager, and (ii) Karl Rosengarth, an employee of A.K.A. Productions, Inc., publisher of "Dirt Rag Magazine"<sup>2</sup>; and notices of reliance filed by both parties on various items such as: (1) the discovery deposition transcript, with exhibits, of Leonard Garland, petitioner's president and owner; (2) certain discovery responses to interrogatories and/or requests for admissions; (3) a photocopy of respondent's pending application Serial No. 76/035,008<sup>3</sup>; (4) printouts from the USPTO's Trademark Electronic Search System (TESS) of numerous third-party applications and registrations; and (5)

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<sup>2</sup> Petitioner neither attended the depositions nor cross-examined either of respondent's two witnesses.

<sup>3</sup> Application Serial No. 76/035,008 was filed April 20, 2000 for the mark BIKESOURCE (typed drawing) for the same services as those in respondent's involved registration. (These services are now classified by the USPTO in International Class 35.)

photocopies of dictionary definitions of the words "bike" and "source."

Both parties filed briefs on the case.<sup>4</sup> Neither party requested an oral hearing.

Petitioner, Sports Machine, Inc., was incorporated in Texas in April 1991, and it is 100% owned by Leonard Garland, who serves as president of the corporation, with his wife serving as corporate secretary. Petitioner operates two BikeSource stores<sup>5</sup>, one in Kingwood, Texas and the other in The Woodlands, Texas (both being in the Houston area). The Kingwood store opened in April 1994 and The Woodlands store opened in May 1996. Petitioner has continuously operated these stores since 1994 and 1996 respectively. The signs on petitioner's stores appear as shown below.



There are also neon signs in the windows showing "BikeSource,"<sup>6</sup> and the mark as shown above appears

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<sup>4</sup> On pages 11-12 of its reply brief, petitioner objects to the "tone of" respondent's brief and "inaccuracies and misstatements" therein. Petitioner's objections to respondent's brief on the case are overruled. See TBMP §540.

<sup>5</sup> In March 1994 petitioner applied for a certificate of doing business under an "Assumed Name" for "BIKE SOURCE" and in October 1995 did the same for "BikeSource."

<sup>6</sup> The record shows that petitioner uses "Bike Source" in various formats, including in all capital letters or with only two letters capitalized, and with and without the half wheel design, and with and without a space between the words.

prominently on petitioner's website.<sup>7</sup>

When petitioner first started the business as "Sports Machine, Inc.," it carried sports machines such as treadmills, steppers, stationary bicycles, as well as bicycles and related accessories. Petitioner now sells bicycles, bicycle apparel, bicycling accessories, and parts and accessories for bicycles.

Petitioner does not engage in any mail order or Internet sales, with all sales made to the customers on-site in the stores. Petitioner's website ("thebikesource.com") is used only as a store locator and as a bridge from bicycle manufacturers' sites to local bicycle dealers in the inquirer's area.

In September 1998 an employee of respondent (Mark Eisenberg) approached Mr. Garland at the Trek company's booth at a trade show and advised Mr. Garland that respondent owned the mark "BIKE SOURCE." Subsequently, in a letter dated February 28, 2000, respondent formally requested that petitioner cease use of "BikeSource." And in late March 2000, petitioner filed this petition to cancel.

Mr. Garland testified that he is aware of a large California bicycle retailer whose website is "bikesource.com"; and he explained, "This is the large bike

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<sup>7</sup> Petitioner includes the following statement on its website: "Bike Source is not affiliated with any other Bike Source outside the State of Texas."

source in the United States. This would be primarily one that a customer, if they thought of Bike Source, they would normally think of this one because this is the one that has done the most national advertising [full-page advertisements appearing in magazines such as Mountain Bike Action and Velo News].” (Dep., pp. 13-14.)

He also testified regarding a listing of Trek bicycle company accounts in which the words “Bike Source” or “BikeSource” appear. These accounts consist of petitioner’s stores and respondent’s stores, as well as two others—the BikeSource in Irvine, California which is the large bicycle dealer on the Internet mentioned previously, and a store in Chandler, Arizona. Mr. Garland testified about petitioner’s answer to respondent’s interrogatory No. 11, asking for all uses of “BIKESOURCE” by anyone other than petitioner or respondent. The list consists of one store each in Anchorage, Alaska; Chandler, Arizona; Monroe, Louisiana; and Austin, Texas; as well as three websites, including the large company in Irvine, California; one in Berkeley, California; and one identified only as “bikesource.co.uk.”

Mr. Garland testified that he believes “the two words together, bike and source, are quite descriptive to [sic?-of] bicycle retail outlets and bicycle stores.” (Dep., p. 22.) Further, he explained that he uses the term “source” to mean the place from which something comes, and that the

primary reason he chose the assumed name "BikeSource" was so that people would come by the store and see that it is a retail outlet for bikes. (Dep., p. 24.)

Respondent first adopted the mark "BIKESOURCE" in March 1991, and respondent currently operates ten bicycle stores under the mark "BIKESOURCE," with four in the Columbus, Ohio area; one in Dayton, Ohio; two in the Kansas City area; one in Charlotte, North Carolina; one in Downers Grove, Illinois; and one in Denver, Colorado. Some of these stores were opened as "BIKESOURCE" stores, while others had been operating under other names and were later converted to "BIKESOURCE" stores.

Respondent engages in advertising on radio and television, in print media, through direct mail and on the Internet. Respondent has sponsored bicycle racers; and it uses the mark BIKESOURCE on various promotional products such as jersey shirts and water bottles. Its sales have been nationwide through telephone call orders and Internet sales.

Mr. Shuff, respondent's operations manager, testified that customers recognize BIKESOURCE as identifying respondent's stores; and that no customer has used "BIKESOURCE" to refer to bicycle stores in general. The terms used to refer to any bicycle store include bicycle dealer, bike shop, bike store, etc.

He also testified that respondent has sent cease and desist letters to several businesses operating under the name "BIKESOURCE" (with or without a space between the words), including bicycle stores in Chandler, Arizona, Pittsburgh, Pennsylvania, Rocky River, Ohio, and Irvine, California. These companies generally complied or worked out a resolution with respondent, but none of the companies asserted that "BIKESOURCE" is not a mark. With regard to the three websites testified to by petitioner (petitioner's answer to respondent's interrogatory No. 11), one is a bicycle registry, one is a motorcycle informational site, and one sells bikes retail, which is the large company in Irvine, California who clearly uses "BIKE SOURCE" as a mark, not in a merely descriptive manner.

The record shows that petitioner operates two bicycle stores; and that respondent has written to petitioner requesting that petitioner cease using BIKE SOURCE as the name of its stores. Thus, petitioner's standing to bring this petition to cancel is established.<sup>8</sup>

The only issue remaining before the Board is whether the registered mark (BIKESOURCE in the form appearing in the

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<sup>8</sup> Respondent's specific request in its brief (p. 24) that the Board find petitioner does not have standing is denied.

Respondent further requested that the Board find petitioner filed the petition to cancel in bad faith in violation of Fed. R. Civ. P. 11. The record herein does not warrant such a finding and respondent's request is denied.

registration) is merely descriptive of "retail store outlets featuring bicycles, bicycle accessories and replacement parts, and apparel relating to bicycles."

A term is considered merely descriptive, and therefore unregistrable pursuant to Section 2(e)(1), if it immediately conveys knowledge or information about the qualities, characteristics, or features of the goods or services on or in connection with which it is used. On the other hand a term which is suggestive is registerable. A suggestive term is one which suggests, rather than describes, such that imagination, thought or perception is required to reach a conclusion on the nature of the goods or services. See *In re Gyulay*, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987).

Petitioner bears the burden of proving, by a preponderance of the evidence, its asserted ground of mere descriptiveness. See *Cerveceria Centroamericana, S.A. v. Cerveceria India Inc.*, 892 F.2d 1021, 13 USPQ2d 1307 (Fed. Cir. 1989); and *Cerveceria Modelo S.A. de C.V. v. R.B. Marco & Sons Inc.*, 55 USPQ2d 1298, 1300 (TTAB 2000).

The Oxford American Dictionary (1980) definitions submitted by petitioner are set forth below:

**bike** n. (informal) a bicycle or motorcycle. v. (biked, biking) (informal) to travel on either of these; and

**source** n. 1. the place from which something comes or is obtained....

In addition, petitioner offered the testimony of its owner that he personally believes customers will perceive the mark BIKESOURCE as merely descriptive of retail bicycle stores. However, on cross examination (p. 44), Mr. Garland was asked "Q. Do you have any evidence that customers ever referred to one of your competitors by the name Bike Source in common parlance?" and he answered "A. No."

Mr. Garland also testified regarding several uses of BIKESOURCE by others. However, these uses, including the use on the Internet by the company located in Irvine, California, are trademark/service mark uses of the term "BIKESOURCE." That is, the third-party entities are not using the mark in a merely descriptive manner, but rather as a trademark/service mark. Moreover, respondent has established that it has challenged (generally successfully) the use of BIKESOURCE by most of the entities listed on the Trek bicycle company account listing customers with BIKESOURCE as part of their name, as well as those listed in petitioner's answers to respondent's interrogatories. Petitioner has essentially made no showing of existing, unchallenged merely descriptive uses by others of the term "BIKESOURCE."

While petitioner urges that its own use is merely descriptive in nature, the record clearly shows that petitioner, in fact, uses BIKESOURCE (and the wheel design)

as a service mark to identify its stores. (See e.g., Garland discovery deposition, exhibits 25-27, 30, 31 and 34.)

As evidence of the descriptive nature of respondent's registered mark, petitioner also submitted copies of several third-party registrations and third-party applications, all incorporating the word "SOURCE," some with disclaimers of the word and some without, some registered under Section 2(f) of the Trademark Act; and some on the Supplemental Register. Petitioner contends that these third-party registrations/applications "are relevant to show that a disclaimer of the word or words 'BIKESOURCE' may have been appropriate in the present situation. However, under trademark practice, even in the absence of a disclaimer, Registrant should have, at most, prima facie ownership only of the compound term BIKESOURCE as shown in the special form drawing." Petitioner went on to request that the registration "should be cancelled unless the word BIKESOURCE is disclaimed." (Brief, pp. 20-21.)<sup>9</sup>

In defending against the petitioner's claim, respondent also submitted copies of several third-party registrations and third-party applications, all relating to whether the

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<sup>9</sup> We construe petitioner's statement as an alternative request that the Board require such a disclaimer. Petitioner's alternative request is denied.

term "source" is viewed by the USPTO as a merely descriptive term with regard to retail services.<sup>10</sup>

Of course, third-party applications are not evidence of anything except that the applications were filed on particular dates. With regard to the third-party registrations (those including and those not including disclaimers), we note that each case must be decided on its own merits. We are not privy to the records of the third-party registration files, and the determination of registrability of those particular marks by the Trademark Examining Attorneys cannot control the merits in the case now before us. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). See also, TMEP §1213.01(a) regarding USPTO disclaimer policy.

Petitioner contends that respondent's own use as shown on the specimen in the registration shows the registered mark is merely descriptive because the advertisement which is the specimen states "The Source!" and "Kansas City's Best Source for Bikes, Rollerblades, Clothing & Accessories!"

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<sup>10</sup> Despite the fact that respondent submitted copies under a notice of reliance, it nonetheless requested in its notice of reliance that the Board take judicial notice of these third-party applications and registrations. Besides being an unnecessary request in this case, the Board does not take judicial notice of registrations or applications in the USPTO. See *Wright Line Inc. v. Data Safe Services Corporation*, 229 USPQ 769, footnote 5 (TTAB 1985); *In re Lar Mor International, Inc.*, 221 USPQ 180, 183 (TTAB 1983); and *In re Duofold Inc.*, 184 USPQ 638, 640 (TTAB 1974). While we have considered the material because it was submitted with a notice of reliance, respondent's request that the Board take judicial notice of USPTO records is denied.

thereon. We disagree that respondent's use of the word "source" in advertisements for its retail bicycle stores transforms the word "source" and/or the entire mark into a merely descriptive term for the involved services. On the contrary, we find the registered mark (BIKESOURCE in stylized lettering) requires some exercise of mental gymnastics to perceive a descriptive significance thereof.

While it is clear that "bike" is a shortened term for "bicycle" and "source" is a broad term relating to the place from which something comes, we are not persuaded on this record that the registered mark

**BIKESOURCE**

considered in its entirety, is merely descriptive of respondent's retail stores. See Bose Corp. v. International Jensen Inc., 963 F.2d 1517, 22 USPQ2d 1704 (Fed. Cir. 1992) (Court affirmed Board's finding ACOUSTIC RESEARCH not merely descriptive of speaker units and turntables for phonographs); In re Wells Fargo & Company, 231 USPQ 117 (TTAB 1986) (EXPRESS SAVINGS not merely descriptive of banking services); In re Crocker National Bank, 223 USPQ 152 (TTAB 1984) (WORKING CAPITAL ACCOUNT not merely descriptive of banking services, with disclaimer of "account"; Plus Products v. Pharmative Pharmaceutical Corporation, 221 USPQ 256, 259 (TTAB 1984) (counterclaim petition denied as PLUS not merely descriptive of various food fortifiers and food

supplements); In re The House Store, Ltd., 221 USPQ 92 (TTAB 1983) (THE HOUSE STORE not merely descriptive of retail store services in the field of furniture and housewares, with "store" disclaimed; and In re TMS Corporation of the Americas, 200 USPQ 57 (TTAB 1978) (THE MONEY SERVICE not merely descriptive of financial services. See also, The Money Store v. Harriscorp. Finance, Inc. 689 F.2d 666, 216 USPQ 11, 17-18 (7th Cir. 1982).

The record does not establish that the registered mark BIKESOURCE (shown in a special form drawing) is merely descriptive under Section 2(e)(1) of the Trademark Act. The mark is certainly suggestive of the services for which it is registered, but this characteristic relates to the strength of the mark and is not fatal to its registrability. Even if it had been clearly established that the registered BIKESOURCE mark is a weak mark (which has not been established), weak marks remain entitled to protection against registration by a subsequent user of the same or similar mark for the same or related goods or services.<sup>11</sup> See Hollister Incorporated v. Ident A Pet, Inc., 193 USPQ 439 (TTAB 1976).

Our primary reviewing court, the Court of Appeals for the Federal Circuit, has made clear that descriptiveness

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<sup>11</sup> We specifically note that respondent's mark is registered on the Principal Register with no disclaimer and no claim of acquired distinctiveness under Section 2(f) of the Trademark Act.

issues generally cannot be determined on the basis of analogies drawn from terms other than the term that is registered or sought to be registered. See *In re Seats, Inc.*, 757 F.2d 274, 225 USPQ 364 (Fed. Cir. 1985). See also, *Levi Strauss & Co. v. R. Josephs Sportswear, Inc.*, 28 USPQ2d 1464 (TTAB 1993); and *Fuji Jyukogyo Kabushiki Kaisha v. Toyota Jidosha Kabushiki Kaisha*, 228 USPQ 672 (TTAB 1985). That is, the issue before us is whether the term "BIKESOURCE" (in stylized lettering), not "bike store" or "bike outlet" or "bike dealer," is merely descriptive of the involved services. We cannot focus on the related terms, rather, we must focus on the registered mark itself.

Based on the record before us, we find that petitioner has not met its burden of proof; and we conclude that the registered mark BIKESOURCE (in stylized lettering) is suggestive rather than merely descriptive of respondent's services.

**Decision:** The petition to cancel is denied.

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STANDLEY & GILCREST

UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office  
Trademark Trial and Appeal Board  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

Taylor

DOCKETED

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STANDLEY & GILCREST

MAILED

NOV 14 2001

PAT. & T.M. OFFICE

Opposition No. 122,948

Sports Machine, Inc.

v.

Midwest American

This case now comes up for consideration of (1) applicant's motion (filed July 9, 2001) to consolidate this proceeding with Cancellation No. 30,578<sup>1</sup>; and (2) applicant's motion (filed on or about September 21, 2001) to suspend this proceeding pending the Board's decision on the motion to consolidate.

Turning first to the motion to consolidate, applicant argues that the proceedings should be consolidated because the parties to both proceedings are identical and the proceedings share common issues of law and fact.<sup>2</sup>

<sup>1</sup> It is further noted that opposer, in its notice of opposition, filed May 31, 2001, requested consolidation of this proceeding with Cancellation No. 30,578. Applicant, the petitioner in Cancellation No. 30,578, objected to consolidation in its answer. However, inasmuch as the request was imbedded in the complaint, it was given no consideration.

<sup>2</sup> Although applicant incorrectly cites to TBMP § 1214 which relates to *ex parte* proceedings, the standard governing *inter partes* proceedings is the same. See generally, TBMP § 511.

STAN  
Rec  
Date

EXHIBIT

B

Opposer has opposed consolidation, arguing that the timing of the motion is prejudicial to opposer, inasmuch as it was not brought until after the discovery period and applicant's testimony had closed. Opposer further argues that the pleadings in the opposition and cancellation raise different issues and allege different facts that may require resolution through discovery and testimony.<sup>3</sup>

Pursuant to Fed. R. Civ. Pro. 42(a), when actions involving a common question of law or fact are pending before the Board, it may order all the actions consolidated and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs and delays. The Board must also weigh the savings in the time, effort and expense that may be gained from consolidation against the prejudice or inconvenience caused by consolidation. TBMP Section 511.

After a review of the pleadings in both cases, and after careful consideration of the parties' arguments and applicant's submissions, for the reasons set forth below, the Board finds consolidation of the two referenced proceedings inappropriate. The Board is not persuaded by applicant's arguments that the two proceedings involve different issues of law and fact. Indeed, in its brief in opposition to opposer's

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<sup>3</sup> Applicant also argues that the motion to be denied because it is not accompanied by a brief. The Board finds this argument unpersuasive because the brief is embodied in the motion. See Trademark Rule 2.127(a).

motion to suspend the proceeding pending the Board's decision on the motion to consolidate, applicant admits that the "co-pending Cancellation and Opposition do involve nearly identical legal and factual issues and thus have a bearing on one another."

However, and as pointed out by applicant, the procedural posture of the two proceedings is vastly different. The discovery and testimony periods have closed in the cancellation proceeding - the main brief being due, whereas this proceeding is in its early stage, with discovery still open. To consolidate the proceedings at this juncture would result in unnecessary delay to the disposition of the cancellation and prejudice applicant, the plaintiff in the earlier-filed proceeding.

In view thereof, opposer's motion to suspend is denied. Nonetheless, inasmuch as the two proceedings involve common issues of law and fact, it is judicially expeditious for the Board to suspend this case pending disposition of Cancellation No. 30,578 to avoid duplication of effort and inconsistent results.

The Board turns now to opposer's motion to suspend this proceeding pending decision on the motion to consolidate. While applicant's objections to suspension are noted, because the decision could have had a major bearing on the procedural

Opposition No. 112,948

sufficient cause to warrant the requested suspension.

Trademark Rule 2.117(c); see also TBMP § 510.02.

In view thereof, opposer's motion to suspend is granted and proceedings herein are considered to have been suspended since the filing date of the motion to consolidate.

Proceedings herein remain suspended pending the disposition of Cancellation No. 30,578. Within twenty days after the final determination, the interested party should call up this case for appropriate action.

If and when proceedings herein are resumed, appropriate dates will be reset.

The Board should be notified of any address changes for the parties or their attorneys.

  
Jyll Smith Taylor  
Attorney, Trademark  
Trial and Appeal Board  
(703) 308-9330, Ext. 146

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JUL 09 2001

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

SPORTS MACHINE, INC.,  
d/b/a Bike Source,

Opposer

v.

MIDWEST MERCHANDISING, INC.,

Applicant

Opposition No. 122,948

Serial No. 76/035,008

Mark: BIKESOURCE

**OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS**

Opposer, Sports Machine, Inc., pursuant to TBMP §1214, herein moves the Board for an Order consolidating the proceedings in the above-captioned Opposition Action with the proceedings in Cancellation No. 30,578, Registration No. 1,887,592 (Mark: BIKESOURCE, Special Form).

In the Notice of Opposition previously filed, Opposer asked to have the opposition proceeding consolidated with Cancellation No. 30,578, for a determination of Applicant's/Registrant's rights to the service mark in both the special and the word form.

In Paper No. 2, received from the TTAB in response to the Notice of Opposition, the Legal Assistant indicated that, if the parties to this proceeding are also parties to other TTAB proceedings involving related marks, they should notify the TTAB so that the TTAB

EXHIBIT

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can consider consolidation of both proceedings.

The parties to both the opposition proceeding and the cancellation proceeding are identical. In addition, the pending cancellation proceeding related to the BIKESOURCE (Special Form) mark shares common issues of law and fact with the present opposition proceeding related to the BIKESOURCE mark.

WHEREFORE, Opposer requests that the TTAB order this proceeding be consolidated with Cancellation No. 30,578, for a determination of Applicant's/Registrant's rights to the service mark in special and/or word form.

Respectfully Submitted,

SPORTS MACHINE, INC., d/b/a Bike Source,  
by its attorney

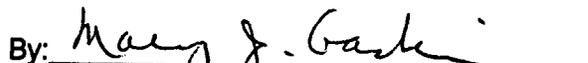
  
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Mary J. Gaskin  
Annelin & Gaskin  
2170 Buckthorne Place, #220  
The Woodlands, Texas 77380  
Phone: (281)363-9121  
Fax: (281)363-4066

Date: July 5, 2001

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**CERTIFICATE UNDER 37 CFR 1.8**

The undersigned hereby certifies that this motion is being deposited in the United States Postal Service, as first class mail, in an envelope addressed to: Assistant Commissioner for Trademarks, BOX TTAB - NO FEE, 2900 Crystal Drive, Arlington, VA 22202-3513, on July 5, 2001.

By:   
\_\_\_\_\_  
Mary J. Gaskin

motconbk.trd

CERTIFICATE OF SERVICE

I hereby certify that the foregoing OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS was served on counsel for Applicant, this 5<sup>th</sup> day of July, 2001, by mailing a true copy thereof via First Class U.S. Mail, postage prepaid, addressed to Roger A. Gilcrest, Standley & Gilcrest, L.L.P., Attorney for Registrant, 495 Metro Place South, Suite 210, Dublin, Ohio 43017-5319.

  
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Mary J. Gaskin