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

Proceeding	91156321
Party	Plaintiff THE CHAMBER OF COMMERCE OF THE UNITED ST
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Attachments	Motion to Consolidate UNITED STATES HISPANIC CHAMBER OF COMMERCE.PDF (8 pages)(195647 bytes)

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

THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Petitioner,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE *Respondent.*	Cancellation No.: 92/045,876 Registration No. 2,886,207
THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA *Opposer,* v. UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION, *Applicant.*	Opposition No.: 91/156,321 Serial No.: 78/081,731

MOTION TO CONSOLIDATE PROCEEDING OR,
IN THE ALTERNATIVE, TO RESET TRIAL DATES

Pursuant to TBMP Section 511 and Fed. R. Civ. P. 42(a), Petitioner/Opposer, The Chamber of Commerce of The United States of America, respectfully requests that the Board consolidate recently-filed Cancellation No. 92/045,876 (H UNITED STATES HISPANIC CHAMBER OF COMMERCE & Design) with pending Opposition No. 91/156,321 (UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design), and that the trial dates in the consolidated proceedings be

established to run concurrently with those set by the Board in Cancellation No. 92/045,876, or as the Board may deem appropriate to subsequently modify (such as using the dates from the pending opposition proceeding instead, as discussed *infra*). Should the Board deny this request, Petitioner/Opposer requests in the alternative that the trial dates in pending Opposition No. 91/156,321 be reset so that Opposer's testimony period opens thirty days after the Board's decision on the pending motion so as to allow sufficient time for the orderly presentation of the evidence relating to this case.

BACKGROUND

The parties' dispute centers upon the desire of Respondent/Applicant to register UNITED STATES HISPANIC CHAMBER OF COMMERCE for services that would be regarded by consumers as being similar to services offered by Petitioner/Opposer under its registered U.S. CHAMBER OF COMMERCE mark (U.S. Reg. No. 1,522,157). The two marks for which Respondent/Applicant originally sought registration are as follows:

Serial No. 78/081,731[1]	**Serial No. 78/087,678 (now Reg. No. 2,886,207)**
Services: "providing educational and professional development classes, seminars, workshops, conferences, and camps to promote leadership and foster development of entrepreneurship and business acumen among youth" (Cl. 41)	Services: "chamber of commerce services, namely promoting business by and among Hispanic businesses and corporate America while fostering procurement and economic development opportunities as well as commercial and financial relations by and among Hispanic businesses with the general business community" (Cl. 35)

[1] In October 2003, this application inadvertently issued to registration as Reg. No. 2,777,830. The Board has since ordered that registration to be cancelled.

Petitioner/Opposer initially sought to oppose both applications, filing a notice of opposition against 78/081,731 on April 11, 2003 (leading to Opp. No. 91/156,321) and another against 78/087,678 on May 7, 2003 (leading to Opp. No. 91/156,340). However, because former counsel for Petitioner/Opposer made what the Board recognized to be an "inadvertent error" (namely, confusing the extension dates associated with the two applications), the opposition against 78/087,678 was dismissed as a nullity, with the Board explaining that "would-be opposer's remedy lies in the filing of a petition for cancellation, pursuant to Section 14 of the Act, 15 U.S.C. § 1064, when and if a registration is issued." *Order of May 6, 2004 (Opp. No. 91/156,340)*, p. 4.

That subject application (78/087,678) eventually issued to registration on September 21, 2004. At that time, however, proceedings in related Opposition No. 91/156,321 had been suspended on consent so as to allow the parties to pursue settlement discussions, which continued into early-2006. Moreover, up until early-2006, while settlement as to all issues regarding UNITED STATES HISPANIC CHAMBER OF COMMERCE (which is the common element of both of Registrant/Applicant's marks) appeared possible, it was deemed unnecessary to institute the cancellation proceeding before the Board, and settlement correspondence between the parties reflected that fact.

Recently, however, it appears that Respondent/Applicant no longer regards settlement as a likely outcome, as evident by its filing of April 21, 2006 (in Opp. No. 91/156,321). This came to the complete surprise of Petitioner/Opposer, which at that time was still waiting for a response from Respondent/Applicant to an October 12, 2005 settlement offer Petitioner/Opposer had made, and which circumstances led it to move to

suspend proceedings on March 13, 2006, to allow further time to pursue settlement.[2] Based on this turn of events, the Board lifted the suspension on April 26, 2006, and Opposition No. 91/156,321 has since move forward, with discovery closing on June 1, and Petitioner/Opposer taking steps to prepare itself for the testimony phase.

Consequently, the time has now come to consolidate the proceedings that were always intended to be consolidated—which is the position Petitioner/Opposer has maintained from the very start. Indeed, as can be seen by comparing the two marks (reproduced below again), the marks are almost identical both in word and design, and the services are highly related. Further, both marks are controlled by the same party (the United States Hispanic Chamber of Commerce) (otherwise it would be impossible for one to register over the other), and the proceedings involve the same Petitioner/Opposer.

Serial No. 78/081,731	**Serial No. 78/087,678 (now Reg. No. 2,886,207)**
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[2] In its April 21 filing, Respondent/Applicant claimed that Petitioner/Opposer was delaying the proceedings, and that Opposer "had not contacted Applicant regarding settlement … since the parties agreed to the … 90-day extension requested by Applicant in December 2005." That is quite misleading. As the written correspondence between the parties would confirm, when Applicant approached Opposer and requested the December 2005 extension, Applicant represented that it was "considering [the] October 12, 2005 letter," and that it "continue[d] to believe that a settlement can be reached." Evidently, Applicant decided sometime in early-2006 to reject Opposer's offer, but chose not to inform Opposer of that fact.

ARGUMENT

Petition/Opposer respectfully submits that consolidation of the two pending proceedings is appropriate inasmuch as Petitioner/Opposer is the same party in each proceeding; the primary mark on which Petitioner/Opposer relies (U.S. Reg. No. 1,522,157 for U.S. CHAMBER OF COMMERCE) in each proceeding is the same; and Applicant/Respondent is also the same (albeit technically two closely related parties)[3]. Further, the challenged marks are highly similar both in design and in content; both contain the objectionable phrase UNITED STATES HISPANIC CHAMBER OF COMMERCE; and both raise the same concerns as to a likelihood of confusion.

Thus, the two proceedings may be presented on the same record without appreciable inconvenience or confusion, thereby warranting consolidation both for trial and decision. Moreover, consolidation will serve the best interests of judicial economy, promote efficient administration of these proceedings, avoid inconsistent results, and save time, effort, and expense by allowing the parties to present essentially the same testimony just once, submit one set of trial briefs, and attend one oral argument before the Board.

Against these benefits, there is little or no prejudice to Respondent/Applicant. During discovery in Opposition No. 91/156,321 (which has now closed), much of the focus involved the "chamber of commerce" services recited in Reg. No. 2,886,207 and the "association services" recited in Petitioner/Opposer's Reg. No. 1,522,157. In fact, to the extent that Respondent/Applicant believes that it needs any additional discovery as

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[3] Although identity of the parties is a factor considered in determining whether consolidation should be ordered, the Board has made it clear that "it is not always necessary." *TBMP*, §511 (citing *Wright & Miller*, §2384. Moreover, the only "difference" between the parties involved in the proceedings to be consolidated here is that the Applicant (United States Hispanic Chamber of Commerce Foundation) is a "foundation" created and controlled by the Respondent (United States Hispanic Chamber of Commerce).

relates to Petitioner/Opposer's asserted mark, it will have an opportunity to pursue that during discovery in the cancellation proceeding. Alternately, if there is a fear of delay, Petitioner/Opposer would be receptive to foregoing discovery in the newly-instituted cancellation proceeding, and instead pursue those issues on the trial schedule presently associated with the pending opposition matter, provided that the opening of testimony is pushed back by at least thirty or sixty days from the date of any order so as to allow the orderly presentation of the evidence as to the consolidated issues.

The overriding concern here is efficiency. Once again, Respondent/Applicant's marks are essentially the same, both in word and design, and the primary focus in both proceedings will be on the use of the phrase UNITED STATES HISPANIC CHAMBER OF COMMERCE, and whether that phrase is likely to cause confusion with the registered U.S. CHAMBER OF COMMERCE mark.[4] Accordingly, Petitioner/Opposer believes that consolidation of Cancellation No. 92/045,876 with Opposition No. 91/156,321 is appropriate under the circumstances, and respectfully requests entry of an order of consolidation by the Board. *See* Fed. R. Civ. P. 42(a); *see also World Hockey Ass'n. v. Tudor Metal Products Corp.*, 185 U.S.P.Q. 246, 248 (TTAB 1975).

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[4] To the extent the opposition and cancellation proceedings presently involve other issues (such as additional marks raised in the opposition proceeding), Petitioner/Opposer would agree to limit the consolidated proceedings to the common element presented in each—namely, the existence of a likelihood of confusion as between Respondent/Applicant's marks and U.S. Reg. No. 1,522,157.

Respectfully submitted,

KENYON & KENYON LLP

Date: 6/2/06

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CERTIFICATE OF SERVICE

I hereby certify that the required number of copies of the foregoing *Motion to Consolidate Proceedings* was served on counsel on the date and as indicated below:

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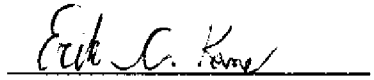

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