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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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Submission	Opposition/Response to Motion
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Attachments	Applicant's Opposition to Motion to Opposer's Consolidate.pdf ( 7 pages )(38849 bytes )

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

<p>THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA,  Opposer,  vs.  UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,  Applicant.</p>	<p>Opposition No. 91-156,321  Reg. No. 2,777,830</p>
<p>THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA,  Petitioner,  vs.  UNITED STATES HISPANIC CHAMBER OF COMMERCE,  Respondent.</p>	<p>Cancellation No. 92-045,876  Reg. No. 2,886,207</p>

**APPLICANT/RESPONDENT'S OPPOSITION TO OPPOSER /PETITIONER'S  
MOTION TO CONSOLIDATE PROCEEDINGS OR, IN THE ALTERNATIVE, TO  
RESET TRIAL DATES**

Applicant United States Hispanic Chamber of Commerce Foundation and Respondent United States Hispanic Chamber of Commerce (collectively "Hispanic Chamber") hereby oppose Opposer/Petitioner The Chamber of Commerce of the United States of America's ("Opposer") Motion to Consolidate Or, In The Alternative,

to Reset Trial Dates (“motion to consolidate”), filed on June 2, 2006. This opposition is supported by the accompanying Brief in Support of Response to Motion to Consolidate Or, In The Alternative, to Reset Trial Dates and such other papers and arguments as may be presented to the Board.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Date: June 22, 2006

By:  /s/Jessica J. Slusser  
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**BRIEF IN SUPPORT OF OPPOSITION TO MOTION TO CONSOLIDATE PROCEEDINGS OR, IN THE ALTERNATIVE, TO RESET TRIAL DATES**

Opposer's motion to consolidate should be denied, as presented, for the following reasons.

**I. INTRODUCTION**

Hispanic Chamber is not in principle opposed to the consolidation of the two proceedings. However, it files this opposition to Opposer's motion to ensure that the pivotal dates to be set by the Board in the consolidated proceeding do not prejudice Hispanic Chamber's ability to adequately conduct discovery and prepare its respective defenses and counterclaims.

Whereas the opposition has been pending for more than three years and the order of dismissal as to the opposition relating to Reg. No. 2,886,207 was issued more than two years ago, Opposer's cancellation proceeding has only been filed recently. Therefore, the testimony periods and other important dates in the respective proceedings are far apart. Specifically, in the opposition proceeding, discovery closed on June 1, 2006, while in the cancellation proceeding discovery is scheduled to commence on June 22, 2006 and last through December 19, 2006. The dates in the new, consolidated proceeding will therefore have to be chosen so as to not compromise Hispanic Chamber's rights.

Therefore, for the reasons detailed below, Hispanic Chamber respectfully requests that, should the Board decide that it would inure to the benefit of all the parties to consolidate the two proceedings, the Board should set the consolidated proceeding's discovery and testimony periods as currently set in the cancellation proceeding or otherwise stay the consolidation motion pending resolution of Hispanic Chamber's impending motion to compel. The motion to compel is likely to be necessary as

Opposer has repeatedly responded to Hispanic Chamber's discovery late and has therefore waived all of its objections.

**II. THE DISCOVERY AND TESTIMONY PERIODS IN THE CONSOLIDATED PROCEEDING SHOULD BE AS THAT SET IN THE CURRENT CANCELLATION PROCEEDING, OR, IN THE ALTERNATIVE, THE BOARD SHOULD STAY THE MOTION TO CONSOLIDATE PENDING RESOLUTION OF HISPANIC CHAMBER'S MOTION TO COMPEL IN THE OPPOSITION PROCEEDING**

More than three years ago, on April 11, 2003, Opposer filed its Notice of Opposition of Applicant's Application Serial No. 78/081,731. Since the inception of this Opposition, the proceedings have been either extended or suspended seven times, all but once initiated by Opposer. Opposer's eighth request for a suspension was denied by the Board. This latest motion by Opposer is an attempt to get another extension from the Board, apparently disguised as a motion to consolidate.

Although it denied Opposer's motion to suspend, on April 26, 2006, the Board extended the trial periods and set the close of discovery period for June 1, 2006. Having failed to conduct any discovery throughout the proceeding, Opposer finally served Applicant with a set of discovery requests on the last allowable date, June 1, 2006.

Opposer also failed to respond to Hispanic Chamber's discovery at all in one instance, and served its responses to the second set more than six weeks late. On January 12, 2004, Applicant served a set of discovery requests, for which it has not received any responses from Opposer. On March 13, 2006, Applicant served its second set of discovery requests, which Opposer responded to on June 1, 2006. No extension of time to respond was requested, nor granted. Opposer's late responses to those requests were inadequate, and, unless Opposer agrees to provide the requested information and documents (without objection), Applicant intends to file a motion to compel Opposer's responses.

Opposer's cancellation of Hispanic Chamber's Registration No. 2,886,207 filed on June 1, 2006, follows in the footsteps of Opposer's opposition filed against Respondent

on May 7, 2003, and dismissed by the Board for lack of jurisdiction on May 6, 2004. The Board set the discovery period in the current cancellation proceeding to open on June 22, 2006.

Although Hispanic Chamber is not completely opposed to the consolidation of the two proceedings, such a consolidation should not compromise the ability of Hispanic Chamber to obtain sufficient discovery and to effectively defend itself. Should the Board set the discovery period in the consolidated proceeding as that set in the opposition proceeding (i.e., through June 1, 2006), Hispanic Chamber will effectively be deprived of any discovery and thus be severely prejudiced if it does not succeed on its motion to compel. Thus, if Opposer does produce complete discovery responses (without objection as it is required to do), the Board should set a combined testimony period for both proceedings. If Hispanic Chamber does not prevail on its motion to compel, the discovery period should run as currently scheduled for the cancellation proceeding, with discovery being closed in the opposition proceeding. Both proceedings then can begin a combined testimony period after the discovery period in the cancellation proceeding closes.

In sum, to prevent any prejudice to Hispanic Chamber by Opposer's delay and failure to comply with the Trademark Rules of Practice or the Federal Rules of Civil Procedure, the Board should set the discovery period in the consolidated proceeding to run concurrently with that set by the Board in the cancellation proceeding or, in the alternative, the Board should postpone its decision on the motion to consolidate until after the resolution of Hispanic Chamber's impending motion to compel in the opposition proceeding. *See Lever Bros. Co. v. Shaklee Corp.*, 214 U.S.P.Q. 654, 655 (T.T.A.B. 1982) (consolidation of two cases denied where one case was just in the pleading stage, and testimony periods had expired in the other). Here, discovery is closed in the opposition proceeding and Opposer's testimony is about to begin. In contrast, the cancellation has just started.

III. CONCLUSION

For the reasons stated above, Opposer's motion to consolidate should not be granted, as requested. Rather, the ruling on the motion to consolidate must ensure that Hispanic Chamber is not prejudiced by the consolidation, and the Board should set the discovery and testimony periods as requested above, or defer the ruling on Opposer's motion to consolidate until after the Board rules on Hispanic Chamber's motion to compel.

Respectfully submitted,

MANATT, PHELPS & PHILLIPS, LLP

Dated: June 22, 2006

/s/Jessica J. Slusser

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 22nd day of June, 2006.

/s/Ruth Quintanilla

Ruth Quintanilla

**CERTIFICATE OF SERVICE**

I hereby certify that the foregoing **APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO SUSPEND** has been served upon the attorney for Opposer by depositing a copy thereof in an envelope addressed to:

William Merone  
KENYON & KENYON  
1500 K Street, N.W., Suite 700  
Washington, DC 20005

on this 22nd day of June, 2006.

/s/ Ruth Quintanilla  
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Ruth Quintanilla

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