

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING DEPOSITED WITH THE UNITED STATES POSTAL SERVICE AS FIRST CLASS MAIL IN AN ENVELOPE ADDRESSED TO COMMISSIONER FOR TRADEMARKS, 2900 CRYSTAL DRIVE, ARLINGTON, VA. 22202-3513, ON THE DATE INDICATED BELOW.

TTAB

BY Doree Rickonbaker

DATE April 23, 2004

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

\_\_\_\_\_  
Optimize Technologies, Inc.,

Opposer,

vs.

Wicom GmbH,

Applicant.

Opposition No. 91156666

Opposition No. 91158331

**APPLICANT'S MEMORANDUM IN OPPOSITION  
TO MOTION TO CONSOLIDATE**

**I. INTRODUCTION**

Wicom, GmbH, ("Applicant") opposes the Motion of Optimize Technologies, Inc. ("Opposer") to consolidate the above two Opposition Proceedings insofar as Opposer seeks to re-open discovery for all purposes in Opposition 91156666. Applicant does not object to consolidation for purposes of trial and post trial matters.

**II. PERTINENT BACKGROUND FACTS**

Opposition No. 91156666 was filed on May 1, 2003 and Opposer waited until November 21, 2003 to serve Interrogatories, Requests for Admissions, and Requests for



04-26-2004

Production. Applicant's responses to these discovery requests were due December 26, 2003 right in the middle of the holiday season.

Applicant requested a 30 day extension of time to respond to discovery because of the holiday season and the fact that Applicant is located in Germany. This was the first such request by Applicant. Opposer refused and initially agreed only to 10 days to January 5, 2004. Opposer's counsel explained that Opposer wanted to put pressure on Applicant and to resolve this matter promptly. Opposer, after being informed Applicant would seek relief from the Board, agreed to 20 days and Applicant served its discovery responses on January 15, 2004 (See Exhibit 1). Discovery in the proceeding actually closed on January 3, 2004.

In February, Applicant observed that it had erroneously admitted Paragraph 6 of the Notice of Opposition in 91156666 and asked Opposer for consent to correct this error by a Consented to Motion. Applicant agreed to permit Opposer to have follow-up discovery on any issue raised by the change in the Amended Answer.<sup>1</sup>

Then, in a surprising reversal of position, Opposer asked Applicant to consent to the re-opening of discovery in 91156666 for all purposes because it wanted to take more discovery. It did this after waiting until the end of the discovery period to serve its initial discovery and then forcing Applicant to work over the Christmas holidays to respond to discovery because Opposer professed it wanted to proceed promptly to trial. Applicant, who took no discovery and wanted to get the matter resolved, refused to consent to the general re-opening of discovery.

The Consented to Motion to Amend Answer in 91156666 was filed March 2, 2004 and that

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<sup>1</sup> Applicant will also need to make the same correction in 91158331. This case has not been active. Applicant has just focused on this issue and has not yet discussed it with Opposer. It should be resolved easily.

proceeding was suspended on March 12, 2004 with an Order stating that any paper filed during suspension which is not relevant to the Motion to Amend would not be considered.

On March 15, 2004 counsel for Opposer called Applicant's counsel and asked for consent to a Motion to Consolidate 91156666 and the later filed 91158331. Upon questioning, Opposer stated that it wanted the cases consolidated "for all purposes" including the re-opening of discovery in 91156666. Applicant again stated it would not agree to the re-opening of such discovery, to which it had already objected, but would consider consolidation for other purposes such as trial.

On March 16, 2004, Opposer filed a Motion to Consolidate Opposition 91156666 with 91158331. At the time of this filing, the cases were in far different procedural postures. In 91156666 discovery was closed and the case suspended awaiting only a ruling on the Consented to Motion which appears to be a routine matter easily resolved.

The other Opposition involving the same parties, 91158331 was not filed until October 20, 2003. An Answer was filed on December 12, 2003 and discovery is still open although it will soon terminate.

Upon receiving the Motion to Consolidate which involved the suspended case, counsel for Applicant wrote to Opposer's counsel objecting to the Motion to Consolidate as a veiled attempt to re-open discovery in 91156666 under the subterfuge of "consolidation". Applicant informed Opposer that Applicant would agree to consolidation for trial and post trial matters but would oppose any consolidation that re-opened discovery in 91156666. Opposer never responded to that letter. A copy of that March 30, 2004 letter is attached as Exhibit 2, and incorporated herein by reference.

Applicant now formally files this Memorandum in Opposition to Opposer's Motion to Consolidate.

### III. ARGUMENT

Opposer in its Memorandum in Support of Motion to Consolidate Opposition Proceedings (Opposer's Memorandum), goes on at length about the wisdom of consolidating the two proceedings to avoid duplication of effort, loss of time and extra expense while, at the same time, seeking to re-open discovery to add effort, time and expense.

The short of it is that Applicant does not oppose consolidation for trial and post trial matters. It informed Opposer of that fact in its March 30, 2004 letter and reiterates that offer here. Opposer has not responded to Applicant's offer because its real motives are not to consolidate for valid purposes, but to re-open discovery in the case where discovery is closed in 91156666. It has drafted its Motion and proposed Order to name proceeding 91158331, in which discovery is still open, as the "parent" case so that the closed discovery in 91156666 would be re-opened. This is a result it can not otherwise justify so it seeks to obtain it under the guise of "consolidation". If true consolidation for laudatory purposes is Opposer's goal, it can obtain that result by agreeing to consolidation without putting Applicant, its potential competitor, through more delay and expense with discovery Opposer could have taken during the discovery period.

In determining whether (and how) to consolidate proceedings, the Board should weigh the savings in time, effort and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. TBMP § 511.

In determining Motions to Consolidate, the Board also considers the procedural posture of the involved proceedings. The Board has refused consolidation where one case was in the pleading

stage and testimony periods had ended in the other. Lever Brothers Company v. Shalsler Corporation 214 U.S.P.Q. 654 (T.T.A.B., 1982).

Since Applicant has agreed to consolidation for trial and post trial matters, the ends of the administration of justice, economy and avoidance of duplication will be served by consolidation for those purposes. Discovery is still open in 91158331 so Opposer can obtain whatever discovery it requires in that case if it proceeds promptly. However, this case will also soon enter the testimony periods.

Discovery is closed in 91156666 except for the limited issue of one changed response if Applicant's Consented to Motion to Amend is granted. To grant the Motion to Consolidate proposed by Opposer would effectively re-open this discovery. That would seriously prejudice Applicant, a potential competitor of Opposer, and cause it more expense and delay.

Opposer propounded wide ranging discovery in 91156666 and Applicant served responses month ago. Opposer has expressed no issues with the response it received, it simply wants the Board's approval to put the Applicant through the effort and expense of responding to further discovery. It apparently hopes such harassment will dim Applicant's efforts to compete with Opposer in the business world. It could have taken such discovery during the discovery period but failed to do so. It should not be permitted to do so now under the guise of a Motion to Consolidate.

#### **IV. CONCLUSION**

For the reasons stated herein, Opposer's Motion to Consolidate should be denied. Or, if granted, the ruling of the Board should consolidate the above proceedings only for trial and post-trial proceedings while explicitly refusing to allow the re-opening of discovery in 91156666

except for the limited purpose of issues directly related to Applicant's changed response to Paragraph 6 of the Notice of Opposition.

Respectfully submitted,

Connolly Bove Lodge & Hutz LLP

A handwritten signature in black ink, appearing to read "Stanley C. Mocol, III", written over a horizontal line.

Stanley C. Mocol, III, Esquire  
1007 North Orange Street  
P.O. Box 2207  
Wilmington, DE 19899  
(302) 658-9141

Attorneys for Applicant

DATED: April 23, 2004

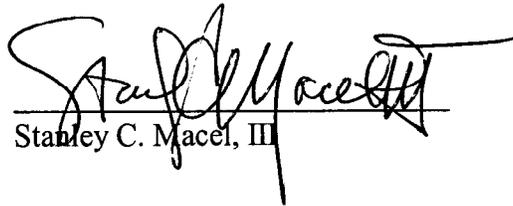
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**CERTIFICATE OF SERVICE**

I hereby certify that on this 23rd day of April 2004, I caused two copies of  
**APPLICANT'S MEMORANDUM OPPOSITION TO MOTION TO CONSOLIDATE** to  
be served upon the following counsel in the manner indicated:

**By U.S. First Class Mail**

Everett E. Fruehling, Esquire  
Christensen, O'Connor, Johnson, Kindness, PLLC  
1400 Fifth Avenue, Suite 2800  
Seattle, Washington 98101-2347

  
Stanley C. Macel, III

Stanley,

Pursuant to our telephone conversation of December 15, 2003, and your subsequent e-mail of today, we will consent to an additional 10-days, until January 5, 2004.

Please feel free to call and discuss this matter.

Happy Holidays!

Thank you,

Everett

Everett E. Fruehling  
Christensen O'Connor Johnson Kindness  
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Seattle, WA 98101  
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-----Original Message-----

From: Stanley Macel [<mailto:Scm@cblhlaw.com>]  
Sent: Tuesday, December 16, 2003 12:48 PM  
To: Everett Fruehling  
Subject: Optimize Technologies v. Wicom

Dear Everett:

I understand you are checking with your client about Wicom's request for a 30 day extension to respond to discovery.

I would appreciate a prompt response as it is a fairly simple matter but will necessitate a conference with a TTAB attorney if your client refuses. At this time of year it is sometimes difficult to schedule things.

I hope to hear from you soon.

Regards,  
Stan Macel

Stanley C. Macel III  
Connolly Bove Lodge & Hutz LLP  
1007 N. Orange Street  
P.O. Box 2207  
Wilmington, DE 19899  
Tel: 302 888 6260  
Fax: 302 658-5614  
[scm@cblhlaw.com](mailto:scm@cblhlaw.com)

**From:** Stanley Macel  
**To:** Everett Fruehling  
**Date:** 12/17/03 1:04PM  
**Subject:** RE: Optimize Technologies v. Wicom; OPTI 6 2384

Dear Everett:

This will confirm that you refused our request for a 30 day extension of time to respond to discovery but offered a 20 day extension. We accept the 20 day extension for now but expressly reserve the right to seek additional time if we can not complete our responses by January 15,2004. We discussed this during our telephone conversation today and you agreed to the 20 days with the understanding we may seek more time.

The current due date for the responses is January 15, 2004. I do not believe it is necessary to file anything with the TTAB at this time. Our e-mail exchange confirms our agreement.

Regards,  
Stan

>>> Everett Fruehling <[everett@cojk.com](mailto:everett@cojk.com)> 12/17/03 12:34PM >>>

Dear Stan,

Pursuant to today's telephone conference, we will consent to an extension of time to an additional 20-days, until January 15, 2003, for Wicom to Answer our Discovery requests.

Please send us a courtesy copy of your Extension Request so that we may docket the new date without having to wait for our official copy from the TTAB.

Thank you,

Everett

Everett E. Fruehling  
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-----Original Message-----

**From:** Everett Fruehling  
**Sent:** Tuesday, December 16, 2003 3:09 PM  
**To:** 'Stanley Macel'  
**Cc:** John Denkenberger; Jim Anable  
**Subject:** RE: Optimize Technologies v. Wicom



**CONNOLLY BOVE LODGE & HUTZ LLP**

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March 30, 2004

**BY E-MAIL AND U.S. FIRST CLASS MAIL**

Everett E. Fruehling, Esquire  
Christensen, O'Connor, Johnson, Kindness, PLLC  
1420 Fifth Avenue, Suite 2800  
Seattle, Washington 98101-2347

Re: Motion to Consolidate Opposition Proceedings  
Optimize Technologies, Inc. v. Wicom GmbH  
Our Reference: 9698\*5

Dear Everett:

I received your Motion to Consolidate Opposition Proceedings Nos. 91158331 and 91156666 and to designate the latter filed proceeding (91158331) as the "parent" matter. You mislead the Board when you represent that I declined to grant consent to the consolidation without explaining what I actually told you.

As you will recall, when you asked me about consolidation, I asked you for what purposes you sought consolidation. You stated that you wanted the matters consolidated for all purposes including discovery as well as trial.

I told you we would not agree to a consolidation that would permit you to re-open discovery in 91156666 beyond the narrow scope we offered in connection with our Motion to Amend our Response. I told you we would consider consolidation for other purposes such as trial. You were well aware that we had previously refused your request to re-open discovery in 91156666.

I heard nothing further from you until I received your Motion to Consolidate. Your Motion is a blatant attempt to re-open discovery in 91156666 under the guise of consolidation for the avoidance of duplication of effort. We will inform the Board about this when the suspension is lifted.

You are well aware that discovery in 91156666 terminated on January 3, 2004. You thereafter requested that the Applicant agree to re-open discovery so you could take "follow-up" discovery and a deposition you failed to take during the discovery period.

CONNOLLY BOVE LODGE & HUTZ LLP

ATTORNEYS AT LAW

Everett E. Fruehling, Esquire

March 30, 2004

Page 2

We were surprised at this request because you previously represented that your client wanted this matter handled on an expedited basis. It was so expedited that, over the Christmas and New Year holiday, you refused to provide Applicant with a 30 day extension to file its responses to Opposer's discovery. You offered only 10 days and finally, after the threat of a Motion for Extension of Time, agreed to 20 days. Because your client was in such a rush to resolve this matter, we refused to extend discovery when you later made that request.

Applicant is willing to agree to consolidation of the two proceedings for trial purposes and/or other post-discovery matters where consolidation may actually save costs, time and serve the purpose of the administration of justice.

We will not agree to the subterfuge you propose by making the latter filed case the "parent" for purposes of extending your discovery. If you want to consolidate the cases without re-opening discovery in 91156666, please contact me. Otherwise, we shall oppose your Motion when the suspension is lifted and inform the Board of your true motives and misleading statements.

Very truly yours,



Stanley C. Macel, III

SCM/nar

CB:325041v1