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

TBC BRANDS, LLC.,

Opposer,

vs.

KUMHO INDUSTRIAL CO., LTD.,

Applicant.



05-17-2004
U.S. Patent & TMO/TM Mail Rcpt Dt. #22

Opposition No. 158,172

MOTION TO CONSOLIDATE AND TO SUSPEND

COMES NOW the Opposer, TBC BRANDS, LLC., and pursuant to Rule 42(a) of the Federal Rules of Civil Procedure and TBMP §511, moves for an Order from the Trademark Trial and Appeal Board consolidating these proceedings, and suspending same until an ruling issues on the present request for consolidation and Applicant's Motion for joinder (pending in Opposition Nos. 157,735 and 158,172). In further support of this Motion, Opposer states:

I. BACKGROUND

Opposer has filed Notices of Opposition against three MATRAC applications filed by Applicant under Section 1(b) of the Lanham Act, namely:

Mark	Serial No.	Goods	Opposition No.
MATRAC	76/416,504	automobile tires	158,172
MATRAC TX	76/416,503	automobile tires	157,735
MATRAC STX ("STX" disclaimed)	76/416,335	automobile tires	158,153

Both parties have timely served written discovery in each proceeding prior to the close of discovery on May 10, 2004 in each proceeding.

II. ARGUMENT

Since all three proceedings involve common questions of law and fact and since there is no appreciable prejudice or inconvenience to either party, these proceedings are ripe for consolidation.

A. All Three Proceedings Involve Common Questions of Law and Fact

Consolidation is appropriate when cases involve “common questions of law or fact.” *See* Fed.R.Civ.Pro. 42(a); Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) §511. Notwithstanding the operative test being phrased in the disjunctive, the present request meets *both* prongs of this threshold requirement. As the three opposition proceedings involve *nearly identical* questions of law *and* fact, they are particularly ripe for consolidation.

All three opposed applications are for MATRAC-formative marks, namely, MATRAC, MATRAX TX, and MATRAC STX (“STX” disclaimed). Additionally, the goods listed in the opposed applications are identical, namely, “automobile tires.”

Furthermore, there is an identity of parties. All three applications were filed by Kumho Industrial Co., Ltd., who has since purported to assign its rights in all three applications to Kumho Tires Co., Inc., who has sought to be joined as a party defendant in all three proceedings. All three applications are opposed by the same entity, namely, TBC Brands, LLC.

Moreover, Opposer’s pleaded marks and claims are identical in all three proceedings, which share the same procedural posture (the discovery period has closed but the first testimony period has not yet opened). Furthermore, the anticipated witnesses would almost certainly be identical in all three proceedings. Finally, there would likely be significant overlap in the parties’ document production.

Accordingly, Opposer respectfully submits that consolidation of these proceedings would result in significant savings in time, effort and expense. As such, this factor weighs in favor of consolidation.

B. Consolidation Would Afford Efficiency to the Parties and the Board Without Prejudice to Either Party

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.” TBMP §511. Not only would consolidation yield considerable savings in time, energy and expense, it would work no prejudice or inconvenience on Applicant. Indeed, consolidation would appear to benefit both parties. *World Hockey Association v. Tudor Metal Products Corp.*, 185 USPQ 246, 248 (TTAB 1975) (“Since the marks sought to be registered by applicant in each of its applications here involved are substantially similar, and inasmuch as opposer has in each instance challenged registration on the basis of its ownership of two substantially similar registered marks, it is believed that the two proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, the consolidation would be equally advantageous to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings alternately.”). Accordingly, the lack of prejudice or inconvenience weighs in favor of consolidation.

C. Request for Suspension

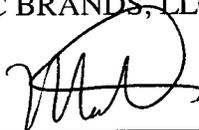
“Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board. TBMP §510.03(a), *see also* 37 C.F.R. §2.117(c). Opposer respectfully submits that good cause exists for suspension of these proceedings, namely consideration of the present Motion which, if granted, would yield considerable savings in time, energy and expense. Such savings would likely be minimized if both parties had to proceed according to the established discovery and trial dates. Additionally, Applicant’s Motion to Join Kumho Tires Co., Inc. is still pending in Opposition Nos. 157,735 and 158,172. Suspension of these proceedings would allow the Board time to consider and act upon Applicant’s motion.

WHEREFORE all of the foregoing reasons, Opposer respectfully requests that the Board GRANTS Opposer’s Motion to Consolidate and, in the interim, suspends these proceedings while it considers said Motion and Applicant’s request to join a party.

Respectfully submitted,

TBC BRANDS, LLC.

By:



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May 17, 2004

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CERTIFICATE OF SERVICE

I HEREBY CERTIFY that I have caused a true and correct copy of the foregoing Motion to Consolidate to be served by first-class mail, postage prepaid, upon counsel for Applicant:

R. Neil Sudol, Esquire
Coleman Sudol Sapone, P.C.
714 Colorado Avenue
Bridgeport, CT 06605-1601

this 17th day of May, 2004.

A handwritten signature in cursive script, reading "Paul Clemente", written over a horizontal line.