UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: May 8, 2007

Opposition No. 91175892
Opposition No. 91175893[1]

Microsoft Corporation

v.

Mark T. Daniel

Frances S. Wolfson, Interlocutory Attorney:

On April 9, 2007, applicant filed a motion to suspend proceedings pending the final outcome of opposer's pleaded trademark applications for the mark ZUNE.[2] Opposer has filed a response to applicant's motion. Applicant contends

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[1] When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. Such consolidation may be ordered on the Board's own initiative. See Fed. R. Civ. P. 42(a); and TBMP § 511 (2d ed. June 2003). Accordingly, these cases are hereby consolidated. The cases may now be presented on the same records and briefs. Papers should bear the number of each of the consolidated cases, although Opposition No. 91175892 is treated as the "parent" case, and most of the papers filed by the parties, or issued by the Board, will be placed only in the file of the parent case. The parties need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

[2] Serial Nos. 78953571 and 78977970.

that the disposition of opposer's applications will have a bearing on these proceedings. Opposer contends that regardless of the outcome of the applications, it has pleaded its standing and a sufficient ground for the opposition such that to suspend would unduly delay proceedings without cause.

In this case, opposer's claim of priority is not based on an allegation that it was the first to use its mark.[3] Opposer instead asserts priority on two grounds: (1) the priority filing date of its pleaded applications; and (2) the concept of "use analogous to trademark use," in which the junior user of a mark claims priority on the basis of activity that occurs prior to the date of first use of the senior user but which is thereafter supported by "open and notorious" public use. See *Era Corp. v. Electronic Realty Associates, Inc.*, 211 USPQ 734, 745 (TTAB 1981); *Dyneer Corporation v. Automotive Products, plc;* 37 USPQ2d (BNA) 1251 (TTAB 1995).

Opposer has not adequately stated the "use analogous to trademark use" grounds to support a claim of priority on this basis. Opposer states that it first used its mark "on or in July 2006" (paragraph 6). Inasmuch as applicant filed the earliest of its applications on July 16, 2006, opposer

[3] Opposer states, in paragraph 6 of the notices of opposition, that it first used its mark on November 14, 2006, which is after the filing date of applicant's application.

must plead use prior thereto or it would not have any use onto which it could tack its later use. Thus, the notices of opposition fail to present a claim of priority based on "use analogous to trademark use."

In view thereof, opposer is allowed until THIRTY DAYS from the mailing date of this order to file amended pleadings that cure the deficiencies in the complaints noted above. Decision on applicant's motion to suspend is deferred pending opposer's response.

Proceedings are otherwise herein suspended.

If, during the suspension period either of the parties or their attorneys should have a change of address the Board should be so informed in writing.

The parties should keep this Office apprised of any change in status of opposer's pleaded trademark applications.