

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CG/JD

Mailed: February 29, 2008

Opposition No. 91178927
Opposition No. 91180771
Opposition No. 91180772

Royal Crown Company, Inc.

v.

The Coca-Cola Company

Cheryl Goodman, Interlocutory Attorney:

This case now comes up for consideration of the following motions:

- 1) opposer Royal Crown's motion, filed October 11, 2007, to suspend;
- 2) applicant's motion, filed October 31, 2007, to consolidate; and
- 3) opposer Royal Crown's motion, filed November 16, 2007, to consolidate.

Applicant's Motion to Consolidate Opposition Nos. 91178927, 91177358 and 91178953

By way of background, applicant has sought to consolidate Opposition No. 91178927 (*Royal Crown Company, Inc. v. The Coca-Cola Company*, also referred to as *Royal Crown*) with Opposition No. 91177358 (*Mayim Tovim v. The Coca-Cola Company*, also referred to as *Mayim Tovim*) and Opposition No. 91178953 (*Companhia de Bebidas das Americas - AMBEV v. The Coca-Cola Company*, also referred to as *AMBEV*).

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The involved application in each of these oppositions is Serial No. 78580598 for the mark COCA-COLA ZERO for "beverages, namely soft drinks; syrups and concentrates for making of the same."

Issue is joined in all three oppositions, and each opposition involves a different party opposer and different counsel. The grounds for relief in the three oppositions are as follows: In *Royal Crown*, opposer claims that registration of applicant's mark, without a disclaimer of the term ZERO is barred under Trademark Act Sections 2(e)(1) and 2(f) because the term is merely descriptive and has not acquired distinctiveness. Opposer Royal Crown also alleges that applicant committed fraud by claiming acquired distinctiveness because applicant could not have shown and proved substantially exclusive use of the term ZERO for the identified goods. In *Mayim Tovim*, opposer claims priority of use and likelihood of confusion with its registered trademark ZERO CAL, stylized, for "soft drinks, carbonated and non-carbonated cola." In *AMBEV*, opposer claims that applicant's mark is merely descriptive as to the term ZERO.

In support of its motion to consolidate, applicant argues that the *Royal Crown*, *Mayim Tovim*, and *AMBEV* oppositions should be consolidated because all three proceedings relate to the same application filed by applicant; that the proceedings involve common questions of

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law and fact which will require similar discovery, witnesses, testimony and evidence; that consolidation would avoid duplication of effort, unnecessary delay and added costs; and that none of the parties will suffer prejudice from the consolidation "as long as their rights to discovery are not adversely affected."

In response, opposer Royal Crown argues that consolidation is improper because all three opposers are separate and distinct parties that are represented by different counsel; that the claims asserted in each proceeding are different; and that consolidation will require that the three opposing parties work together thereby multiplying the parties' administrative burdens, causing delays, driving up costs and providing "no benefit or judicial economy." Opposer AMBEV also argues against consolidation, as discussed below; but opposer Mayim Tovim did not respond to the motion to consolidate.

In reply, applicant argues that consolidation of these proceedings is proper and appropriate as it would forestall duplicative and/or overlapping discovery and testimony and avoid unnecessary costs or delays since all of the oppositions involve "common issues."

When cases involving common questions of law or fact are pending before the Board, consolidation of such cases may be appropriate. See Fed. R. Civ. P. 42(a); and TBMP

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§511 (2d ed. rev. 2004). On occasion, actions brought by different plaintiffs may be consolidated and, where the plaintiffs are represented by different counsel, the parties may be required to appoint lead counsel to supervise the cases. Generally, however, the Board will not order consolidation of cases involving different unrelated plaintiffs unless the parties so agree. 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.

After reviewing the arguments of both parties, the Board finds applicant's arguments in favor of consolidation of the *Royal Crown*, *Mayim Tovim* and *AMBEV* oppositions to be unpersuasive.

First with respect to the *Royal Crown* opposition and the *AMBEV* opposition, both opposers object to consolidation. While both the *Royal Crown* proceeding and the *AMBEV* proceeding include claims of mere descriptiveness, the former proceeding also includes the additional claim of fraud. As such, the focus of some of the discovery and testimony in the *Royal Crown* proceeding will necessarily be somewhat different from the *AMBEV* opposition. Therefore, the Board finds that if this proceeding and the *AMBEV* opposition were consolidated, the different focus

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potentially could result in prejudice or inconvenience to one or more parties.

Second, with respect to the *Royal Crown* opposition and the *Mayim Tovim* opposition, the claims in these proceedings differ, as the later opposition involves the question of likelihood of confusion whereas the former opposition involves claims of mere descriptiveness and fraud. Therefore, these differences may preclude the savings in time, expense or judicial economy that otherwise come from consolidation.

In view thereof, the Board finds that consolidation of the *Royal Crown*, *Mayim Tovim* and *AMBEV* oppositions would not save the parties or the Board time or effort, but would instead risk causing prejudice to the different opposers and likely cause confusion of the issues before the Board in each proceeding. Accordingly, applicant's motion to consolidate Opposition Nos. 91177358, 91178927 and 91178953 is hereby denied.

Opposer's Motion to Suspend

Turning next to Royal Crown's motion to suspend, Royal Crown seeks suspension of the *Royal Crown* proceeding pending final disposition of the *Mayim Tovim* opposition, arguing that "[i]f the First Opposers succeed, the COCA-COLA mark will be refused registration, and this entire proceeding

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would be moot." Opposer Royal Crown also argues that suspension would not be prejudicial.

In response, applicant objects to this suspension arguing that a final determination in the *Mayim Tovim* opposition will not be binding on the parties in the *Royal Crown* proceeding, and "will not necessarily dispose of [that] proceeding." Applicant further argues that suspension would be prejudicial to applicant and subject applicant to an "indefinite delay."

The Board may suspend a proceeding pending disposition of another Board proceeding in which the parties are involved or in which one of the parties is involved, if the disposition of the other action will have a bearing on the proceedings before the Board. See TBMP §510.02(a).

In this case, the opposers are different, the claims are different (likelihood of confusion versus descriptiveness and fraud), and the disposition of the first proceeding (the *Mayim Tovim* opposition) will not necessarily have a bearing on the *Royal Crown* proceeding.

In view thereof, opposer Royal Crown's motion to suspend is denied.

Opposer Royal Crown's Motion to Consolidate Opposition Nos. 91178927, 91180771 and 91180772

The Board now turns to Royal Crown's motion to consolidate. Opposer seeks consolidation of *Royal Crown* opposition (Opposition No. 91178927) with two other

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oppositions, Opposition Nos. 91180771 and 91180772. In support of its motion, opposer argues that the three oppositions "now pending against applicant and its 'zero'-inclusive applications" (COCA-COLA ZERO, SPRITE ZERO, AND COKE ZERO) involve "identical parties and identical issues of law"; that consolidation will not result in undue delay or prejudice; and that "consolidation will save time, effort and expense because it will obviate the need for either party to duplicate discovery, testimony or arguments in three separate proceedings . . . and will obviate the need for the Board to consider the identical evidence, testimony and arguments in three separate proceedings."

In response, applicant advises that "[The Coca-Cola Company] does not oppose the consolidation of the three Royal Crown cases and therefore has not filed any opposition to the Royal Crown motion to consolidate."¹

A review of the pleadings in Opposition Nos. 91178927, 91180771 and 91180772 confirms Royal Crown's contention that the proceedings involve substantially identical questions of law and fact, and similar marks. The Board finds that consolidation would be equally advantageous to the parties and the Board by avoiding duplication of effort, loss of time, and the extra expense involved in conducting the

¹ To the extent that applicant is moving in its "reply brief" for consolidation of AMBEV's Opposition Nos. 91180439 and 91180442

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proceedings individually. Accordingly, the Board finds consolidation appropriate.

In view thereof, Royal Crown's motion to consolidate is granted. Opposition Nos. 91178927, 91180771 and 91180772 are hereby consolidated, and while each proceeding retains its separate character, the consolidated cases may be presented on the same record and briefs.² The Board file will be maintained in Opposition No. 91178927 as the "parent" case. As a general rule, only a single copy of any paper or motion should be filed in the parent case; but that copy should bear all proceeding numbers in its caption in ascending order. The parties' future submissions in the consolidated proceedings should be captioned as set forth above.

The parties are further advised that they are to inform the Board of any subsequent proceedings involving the parties and related marks so that the Board can consider whether consolidation may be appropriate.

It is noted that Opposition Nos. 91180771 and 91180772 were filed on November 15, 2007, after implementation of Miscellaneous Changes to Trademark Trial and Appeal Board Rules which amended Trademark Rule 2.120 to require that the

with the three *Royal Crown* proceedings, applicant's motion is denied for the reasons set forth supra.

² The decision on the consolidated cases shall take into account any difference in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

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parties participate in a discovery conference and provide initial and expert disclosures. See Trademark Rule 2.120(a). In each of those cases, the deadline for required settlement and discovery conference was January 24, 2008 and initial disclosures were due on February 23, 2008. It is noted that the parties did not request participation by a Board professional in the required conferences. When parties do not request Board involvement in a required conference, the parties are expected to conference without the Board being involved and the Board will operate on the assumption that the parties have or will conference. Further, initial disclosures are to be exchanged between the parties and are not required to be filed with the Board. Here, too, the Board will presume that parties have complied with their disclosure obligations if they have not stipulated to alternative arrangements. The parties are reminded of the rule that a party may not seek discovery from its adversary until it has made the required initial disclosures.

In accordance with the Board's standard practice, remaining dates in the consolidated proceeding are reset to adopt the trial schedule of Opposition No. 91180772:

Expert Disclosures Due	6/22/08
Discovery Closes	7/22/08
Plaintiff's Pretrial Disclosures	9/5/08
Plaintiff's 30-day Trial Period Ends	10/20/08

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Defendant's Pretrial Disclosures	11/4/08
Defendant's 30-day Trial Period Ends	12/19/08
Plaintiff's Rebuttal Disclosures	1/3/09
Plaintiff's 15-day Rebuttal Period Ends	2/2/09

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

NEWS FROM THE TTAB:

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:
<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>
http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:
<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>