

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Brown

Mailed: June 30, 2008

Opposition No. 91179480

Opposition No. 91179482

Plasti-Fab Ltd.

v.

Kobelco Construction
Machinery Co., Ltd.

(as consolidated)

Brian D. Brown, Interlocutory Attorney:

This case now comes before the Board for consideration of opposer's motion to extend the discovery and trial dates in this proceeding. Opposer's motion is contested. For the reasons set forth below, proceedings herein are consolidated and the motion to extend is granted.

I. Consolidation

First, when cases involving common questions of law or facts are pending before the Board, the Board may, upon its own initiative or upon motion, order the consolidation of the cases. See Fed. R. Civ. P. 42(a) and Trademark Trial and Appeal Board Manual of Procedure ("TBMP") § 511 and authorities cited therein (2d ed. rev. 2004).

Here, the parties in both cases are the same, our review of the pleadings in the two proceedings indicates

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that the cases involve common questions of law and fact, and the Board's ruling in one proceeding will likely have a bearing on the other proceeding. As a result, these proceedings may be presented on the same record and briefs without appreciable inconvenience or confusion. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

Moreover, consolidation would be equally advantageous to both parties by avoiding the extra expense involved in conducting the proceedings individually as well as the duplication of effort. Since consolidation would contribute to the orderly and timely administration of these two pending cases, the Board finds consolidation is appropriate.

Therefore, Opposition No. 91179480 and Opposition No. 91179482 are hereby consolidated. Consequently, the parties' future submissions should be captioned as in this order. The Board file will be maintained in Opposition No. 91179480 as the "parent" case. As a general rule, only a single copy of any paper or motion should be filed in the parent case file.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues

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raised by the respective pleadings. The parties are further advised that they are to inform the Board of any other proceedings which involve the same parties and the same or related issues.

II. Opposer's Motion to Extend Discovery

Turning to opposer's motion to extend, the appropriate standard for allowing an extension of a prescribed period prior to the expiration of the term is "good cause." See Fed. R. Civ. P. 6(b) and TBMP § 509 (2d ed. rev. 2004) and cases cited therein. Generally, the Board is liberal in granting extensions of time before the period to act has elapsed so long as the moving party has not been guilty of negligence or bad faith and the privilege of extensions is not abused.

Here, the Board recognizes that this is opposer's first unconsented request to extend any deadline in the proceeding and that the extension privilege has not been abused in this case. There is also no evidence of bad faith on the part of opposers in requesting the extension. After considering the entire record and the parties' arguments therefore, the Board finds that opposer has made the minimum showing necessary to establish good cause to support an extension of the discovery period for sixty days.

In support of its motion, opposer primarily argues that the parties have been exploring settlement and that they

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need "additional time in which to determine whether settlement is possible." In that regard, the record suggests that applicant, by both word and action, assured opposer that it would at least consider an offer of settlement. Consistent therewith, on March 28, 2008, the parties submitted a consented motion to extend discovery because they were "engaged in settlement discussions." Moreover, in response to opposer's letter outlining its proposed terms for settlement, applicant stated in a letter dated April 3, 2008 and attached as applicant's "Exhibit B" that it remained "interested in settlement" and was "willing to consider any other proposals aimed at allowing the marks to peacefully co-exist."

While applicant may no longer be interested in settlement and was opposed to some of the terms in opposer's initial proposal, opposer could have reasonably concluded that settlement or even legitimate talk of settlement was likely as late as of April 2008 and the parties need not move forward and serve requests for discovery. See *Instruments SA, Inc. v. ASI Instruments, Inc.*, 53 USPQ2d 1925 (TTAB 1999).

In addition, the Board finds that the request in this case is not unreasonable and will not result in any interminable delay. Likewise, there is nothing in the

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record to suggest that such an extension will have an adverse impact on these proceedings.

Accordingly and given the Board's liberal nature in granting extensions, opposer's sixty-day extension request of the discovery and trial period is hereby granted. With proceedings herein consolidated, discovery and trial dates are reset as follows:¹

DISCOVERY PERIOD TO CLOSE: **August 30, 2008**

30-day testimony period for party in
position of plaintiff to close: **November 28,
2008**

30-day testimony period for party in
position of defendant to close: **January 27, 2009**

15-day rebuttal testimony period for
plaintiff to close: **March 13, 2009**

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. See Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b).

¹ Upon consolidation, the Board typically resets trial dates for the consolidated proceeding, usually adopting the trial dates as set in the most recently instituted of the cases being consolidated. However, as both proceedings were filed on the same day in close proximity to each another, the trial dates in both proceedings were the same.

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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>