

ESTTA Tracking number: **ESTTA247614**

Filing date: **11/07/2008**

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

Proceeding	91186148
Party	Defendant The Great Atlantic & Pacific Tea Company, Inc., Inc.
Correspondence Address	ARLANA S. COHEN COWAN, LIEBOWITZ & LATMAN, P.C. 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036-6710 UNITED STATES trademark@cll.com
Submission	Motion to Consolidate
Filer's Name	Heather L. Jensen
Filer's e-mail	hlj@cll.com, asc@cll.com, gta@cll.com
Signature	/Heather L. Jensen/
Date	11/07/2008
Attachments	Publix Opposition - Motion to Consolidate.pdf (5 pages)(17956 bytes)

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

	x	
	:	
PUBLIX ASSET MANAGEMENT COMPANY,	:	
	:	
Opposer,	:	OPPOSITION NO. 91186148
	:	
v.	:	MOTION TO CONSOLIDATE
	:	ON CONSENT
THE GREAT ATLANTIC & PACIFIC TEA	:	
COMPANY, INC.,	:	
	:	
Applicant.	:	
	x	

Applicant, The Great Atlantic & Pacific Tea Company, Inc. (“A&P”) hereby moves the Board pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a) for an order consolidating the above-referenced Opposition No. 91186148 with Opposition No. 91186863. As set forth more fully below, these proceedings involve substantially identical legal and factual issues. Accordingly, in the interests of convenience, efficiency, and judicial economy, A&P requests that the Board consolidate these proceedings. Opposer, Publix Asset Management Company (“Publix”) has consented to this motion. In support of this motion, A&P states as follows:

CONSOLIDATION OF THE OPPOSITIONS IS WARRANTED

1. Specifically, the instant Opposition No. 91186148 involves Applicant’s application to register GREEN WAY in connection with the following goods and services in Classes 3: Shampoos and hair conditioners; skin moisturizers; human body conditioners; skin treatment lotions and creams; anti-aging and stretch mark creams; non-medicated lotions and creams for hands, nails, skin, face, hair, foot and leg muscles and joints; depilatory lotions and creams; shaving lotions and creams; non-medicated skin care preparation, namely, lotions and

creams for treating dry and damaged skin, anti-aging, firming, anti-wrinkle, stretch marks, under eye and eyelid firming; gels, namely, depilatory gels, shaving gels, shower gels; oils, namely, body oils, non-medicated human body serums; soaps; liquid soaps; bar soaps; anti-bacterial liquid soaps; anti-bacterial bar soaps; body washing soaps; bubble bath; body and facial scrubs; masks, namely, beauty masks, facial masks, body masks, gel eye masks, skin masks, and skin moisturizer masks; non-medicated skin care preparations, namely, face peels; cosmetic sun protection creams and lotions, sun creams and lotions; sun block; soaps and detergents for household use for the purposes of cleaning and maintenance without harm to the environment; Class 4: charcoal; white birch firewood; fire wood chips for use as fuel; fireplace logs; Class 5: hand sanitizing preparations; dietary food supplements; Class 8: disposable forks, knives, and spoons; Class 9: batteries; Class 11: compact fluorescent electric light bulbs; Class 16: paper towels; paper table cloths; paper napkins; bathroom tissue; notebooks; notebook paper; and facial tissues; Class 20: reeds, namely, diffuser reeds; Class 21: paper plates and paper cups; Class 29: frozen hamburger patties; processed edible seeds; processed nuts; dried fruits; raisins; trail mix, namely, snack mixes primarily consisting of processed fruits, processed nuts, pretzels; potato chips; Class 30: teas; sesame sticks; chocolate coated nuts; yogurt coated nuts; macaroni and cheese; pesto sauce; bread; tortillas; tortillas chips; Class 31: pet food; Class 32: soda pop.

2. On October 8, 2008, Opposer Publix Asset Management Company filed an opposition namely, Opposition No. 91186863, to A&P's application to register GREEN WAY in connection with the following goods and services in Class 29: olive oil, canned tomatoes, canned beans, broth, soups, applesauce, jams, fruit preserves, peanut butter, soybean milk, milk, butter, cheese, frozen entrees consisting primarily of meat or cheese, frozen vegetables, namely, peas, broccoli, cauliflower, green beans and mixed vegetables, frozen fruits, pre-cut vegetable salad;

Class 30: balsamic vinegar, pasta, pasta sauce, salad dressing, salsa, macaroni and cheese, breakfast cereals, coffee, tortilla chips, cheese flavored snacks, namely, cheese puffs and cheese curls, popcorn, pretzels, crackers, cookies, ravioli, frozen entrees consisting primarily of rice or pasta, burritos, enchiladas, ice cream, ice cream sandwiches, sorbets; frozen corn; Class 31: fresh vegetables; Class 32: fruit juices and fruit drinks, soft drinks.

3. Opposer's Notice of Opposition in Opposition No. 91186148 contains substantially identical factual and legal allegations as those in Opposition No. 91186863, namely that Applicant's mark GREEN WAY is allegedly confusingly similar to Opposer's GREENWISE marks. Moreover, Applicant has filed answers and affirmative defenses to both notices and also raised the same legal and factual issues in such answers.

4. Pursuant to section 511 of the TBMP, "when cases involving a common question of law or fact are pending before the Board, the Board may order the consolidation of the cases." TBMP § 511; *see also* Fed. R. Civ. P. 42(a) ("[w]hen actions involving a common question of law or fact are pending before the Court...it may order all the actions consolidated."); *S. Industries, Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q. 1293, 1297 (TTAB 1997) (consolidation appropriate where pleadings substantially related).

5. When determining whether consolidation is appropriate, the Board considers the savings in time, effort and expense to be gained from consolidation, as well as whether any actual prejudice will result from consolidation. TBMP § 511; *see also World Hockey Ass'n. v. Tudor Metal Products Corp.*, 185 U.S.P.Q. 246, 248 (TTAB 1975) (ordering consolidation where issues substantially the same and consolidation benefited both parties).

6. The present case strongly warrants consolidation. First, the mark in question is identical, GREEN WAY. In addition, the proceedings largely stem from the same central facts

and raise identical issues of confusing similarity. Thus, given the similarities between the respective actions, consolidation is necessary to ensure consistent judgments. *See, e.g., Rio Energy Int'l. v. Hilton Oil Transport*, 776 F.Supp. 120, 122 (S.D.N.Y. 1991) (ordering consolidation where common questions of law and fact existed, as well as the danger of conflicting findings).

7. Moreover, the identical parties are involved in both oppositions. Accordingly, consolidation would generate significant savings in time, effort and money. *See* TBMP § 511; *see also World Hockey*, 185 U.S.P.Q. 246, 248 (ordering consolidation where it would be “advantageous to [all] parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings alternately”); 9 Fed. Prac. & Proc. § 2384.

8. Importantly, Publix consents to the consolidation of these proceedings in view of the foregoing, Opposition No. 91186148 should be consolidated with Opposition No. 91186863.

WHEREFORE, A&P requests that the Board enter an Order consolidating Opposition No. 91186148 with Opposition No. 91186863 and to issue a new scheduling order in such consolidated opposition.

Dated: New York, New York
November 7, 2008

Respectfully submitted,

COWAN, LIEBOWITZ & LATMAN, P.C.

By: /Heather L. Jensen/

Arlana S. Cohen

Heather L. Jensen

1133 Avenue of the Americas

New York, NY 10036

(212) 790-9237

Attorneys for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on November 7, 2008 she caused a true copy of the **Motion to Consolidate On Consent** to be served by mailing a true and correct copy thereof to Opposer's attorneys to:

James B. Lake, Esq.
Thomas & LoCicero, PL
400 N. Ashley Drive, Suite 1100
Tampa, FL 33602

/Heather L. Jensen/
Heather L. Jensen