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Filing date: **11/05/2008**

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

Proceeding	91186200
Party	Plaintiff Holder Suisse, SA
Correspondence Address	Dwayne K. Goetzel Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. P.O. Box 398 Austin, TX 78767-0398 UNITED STATES dkgpto@intprop.com
Submission	Reply in Support of Motion
Filer's Name	Dwayne K. Goetzel
Filer's e-mail	dkgpto@intprop.com
Signature	/Dwayne K. Goetzel/
Date	11/05/2008
Attachments	Reply to Opp to Mtn to Consolidate.pdf (12 pages)(314063 bytes)

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

Holder Suisse, SA)	Opposition No.: 91181892 (Serial No. 77/102,556 for the mark PAULETTE)
Opposer)	
v.)	Opposition No.: 91181896 (Serial No. 77/102,540 for the mark PAULETTE MACARON)
Paule and Gerard Koumetz)	
Applicants)	Opposition No.: 91186200 (Serial No. 77/395,849 for the mark PAULETTE [stylized])
)	Opposition No. 91186198 (Serial No. 77/395,818 for the mark PAULETTE & Design)

REPLY TO OPPOSITION TO MOTION TO CONSOLIDATE

Pursuant to Fed. R. Civ. P. 42(a) and T.B.M.P. 511, Opposer Holder Suisse, SA (“Opposer”) previously moved to consolidate the above four (4) opposition matters into one opposition. Applicant’s entire basis for opposing the motion to consolidate (the “Motion”) is that “**Applicant will be much better off** with a separate action in front of a new panel for each application ...” (emphasis added), despite the fact that every application opposed by Opposer contains the word “Paulette” for basically the same goods or services.

I. Applicant Asks the TTAB to Only Consider Applicant’s Position.

Applicant bluntly states that it (and only it) will be “better off” if the four pending matters are not consolidated. Applicant’s position does not take into account (a) the prejudice to Opposer, (b) the burden of time, effort and duplication, or (c) the risk of confusion, mistake or conflicting results from different panels. Applicant’s unilateral view of whether consolidation should be granted is simply incorrect.

Further, and perhaps more importantly though, the risk of confusion, mistake and duplicative effort is amply illustrated by the fact that Applicant has mistakenly served discovery requests contemporaneous with the current Motion. Specifically, Applicant served interrogatories and requests for production in connection with Opposition No. 91181896, which involves the mark PAULETTE MACARON. *See* title, signature and certificate of service pages for these discovery requests, attached as composite **Exhibit A**. According to the trial order mailed on October 3, 2008 for this particular matter, discovery does not even open until November 8, 2008. *See* **Exhibit B**. Therefore, not only should discovery be stayed pending resolution of the motion to consolidate, the present set of discovery that was sent by Applicant is premature under the existing trial order.

Opposer originally argued that consolidation will save both parties and the Board a great deal of time, effort and expense by eliminating the need for separate trial orders, schedules, protective orders, motions, discovery, and trial. Opposer argued that consolidation would reduce the risk of oversight, mistake, or conflicting results from different panels. As indicated by the premature sending of discovery requests, the risk of confusion, mistake, duplicated effort and expense arising from proceeding with separate matters is not only likely, it has already occurred.

II. Common Questions of Law or Fact.

- A. Each of the four applications opposed by Opposer contain the word PAULETTE:
PAULETTE MACARON (word mark), Serial No. 77/102,540
PAULETTE (word mark), Serial No. 77/102,556
PAULETTE (stylized), Serial No. 77/395,849



PAULETTE TT & Design, Serial No. 77395818



- B. Each application was filed by the same applicants.
- C. The registered mark (PAUL) that is the basis of each opposition is the same.
- D. The opposer in each opposition is the same.
- E. The goods or services listed in each application are essentially the same (all four applications list “bakery goods” in class 30, and three of the four applications also add “retail bakery services” in class 35).

Thus, all four oppositions involve the same questions of law and fact. As established by the previously cited case of Ritchie v. Simpson, 41 U.S.P.Q.2d 1859 (TTAB 1996), rev’d on other grounds, 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999), cases can be consolidated even where there are variations in the marks or the goods offered thereunder. In this case, there are minimal differences between the marks, and no differences between the goods and services recited in each application, other than deletion of services from one of the four applications. The TTAB should consider these additional issues, not simply Applicant’s desire to have a second, third and fourth bite at the same “apple.”

III. The Cases Cited by Applicant are Not Relevant.

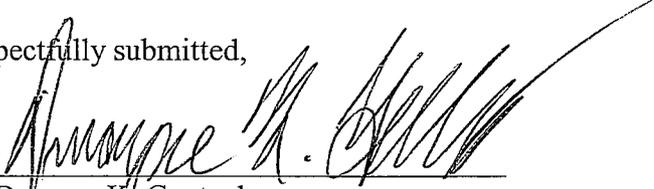
The cases cited by Applicant in its opposition to consolidation do not involve trademark matters. Those cases simply stand for a general proposition of law regarding Fed. R. Civ. P. 42. The cases cited by Opposer, on the other hand, involve trademark matters decided by the TTAB, and specifically discuss consolidation of separate trademark matters, unlike Applicant’s cited cases.

IV. Conclusion.

As the Board can see by virtue of the premature discovery requests sent out by Applicant, the risk of confusion, mistake, duplicated effort and expense from separate matters is not only likely, it has already occurred. Therefore, Opposer respectfully requests that the above four (4) opposition matters be consolidated into one "parent" opposition, and that the Board re-set the times for discovery and trial for the consolidated opposition following decision as to this motion to consolidate.

Respectfully submitted,

By:


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KOWERT & GOETZEL, P.C.
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(512) 853-8801 (facsimile)

**ATTORNEYS FOR OPPOSER
HOLDER SUISSE, SA**

CERTIFICATE OF SERVICE

This certifies that a true and correct copy of Opposer's *Reply to Opposition to Motion to Consolidate* has been sent by email and first class U.S. mail, postage prepaid, to Applicant's attorney of record as follows:

Laurent C. Vonderweidt
Vonderweidt & Johnson
11900 West Olympic Blvd., Suite 580
Los Angeles, California 90064

on this 5th day of November 2008.


Dwayne K. Goetzel

EXHIBIT A

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

In the Matter of Trademark Application Serial No. 77/102,540 for the mark "PAULETTE
MACARON" filed by Paule and Gerard Koumetz and Published in the Official Gazette
on September 18, 2007

HOLDER SUISSE, SA,)	Opposition No. 91181896
)	
Opposer,)	
)	
v.)	
)	
PAULE and GERARD KOUMETZ,)	
)	
Applicants.)	
_____)	

Applicants' First Set of Interrogatories

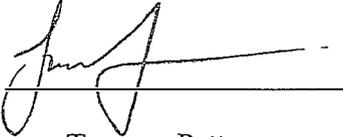
Pursuant to Rule 33 of the Federal Rules of Civil Procedure, Paule and Gerard Koumetz ("APPLICANTS") hereby request that Holder Suisse, SA ("OPPOSER") provide written responses to the interrogatories set forth below within thirty days of service thereof:

DEFINITIONS AND INSTRUCTIONS

1. "DOCUMENT(S)" as used herein, means all writings, without limitation, any handwritten, typewritten, printed, emails, computer-generated, computer-stored (on hard drive or any other drivers), computer diskettes, back-up data tapes or disks, and/or other computer materials, recorded, filmed, or graphic matter(s), whether produced or reproduced on papers, cards, tapes, film, electronic facsimile, digital recording, computer data storage device, or any other media, including without limitation, memoranda, notes,

Certificate of Service

I hereby certify that a copy of the foregoing **APPLICANT'S FIRST SET OF INTEROGATORRIES** was mailed first-class mail, postage prepaid, to Dwayne K. Goetzel of Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C., P.O. Box 398, Austin, Texas 78767-0398, attorneys for OPPOSER, this 28th day of October, 2008.



Tauwan Patterson

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

In the Matter of Trademark Application Serial No. 77/102,540 for the mark “PAULETTE
MACARON” filed by Paule and Gerard Koumetz and Published in the Official Gazette
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HOLDER SUISSE, SA,)	Opposition No. 91181896
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Opposer,)	
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v.)	
)	
PAULE and GERARD KOUMETZ,)	
)	
Applicants.)	
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**APPLICANTS’ FIRST SET OF REQUESTS FOR PRODUCTION OF
DOCUMENTS AND THINGS**

Applicants, Paule and Gerard Koumetz (“Applicants”), serve this First Set of Requests for Production of Documents and Things upon Holder Suisse, SA (“Opposer”) and hereby request that Opposer produce the following documents and things for inspection and copying, along with a written response at the offices of Applicants’ counsel of record within thirty (30) days after service. To the extent permitted by Rule 26(e) of the Federal Rules of Civil Procedure, these requests are to be deemed continuing and the responses thereto are to be supplemented promptly upon Applicants’ Opposer’s acquisition of further or additional information or documents.

GENERAL DEFINITIONS AND INSTRUCTIONS

The General Definitions and Instructions contained in Defendants’ First Set of Interrogatories, served simultaneously herewith, are incorporated herein by reference.

Certificate of Service

I hereby certify that a copy of the foregoing **APPLICANTS' FIRST SET OF REQUESTS FOR PRODUCTION OF DOCUMENTS AND THINGS** was mailed first-class mail, postage prepaid, to Dwayne K. Goetzel of Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C., P.O. Box 398, Austin, Texas 78767-0398, attorneys for Opposer, this 28th day of October, 2008.

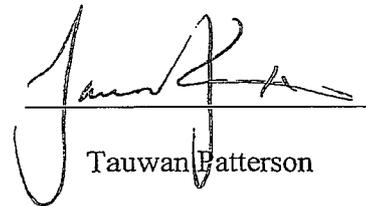

Tauwan Patterson

EXHIBIT B

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

Mailed: October 3, 2008

Opposition No. 91181896

Holder Suisse S.A.

v.

Paule Koumetz and Gerard
Koumetz

**M. Catherine Faint,
Interlocutory Attorney:**

Opposer's amended notice of opposition and applicant's
answer thereto are noted.

Accordingly, proceedings herein are resumed and dates are
reset as set out below.

Deadline for Discovery Conference	11/8/2008
Discovery Opens	11/8/2008
Initial Disclosures Due	12/8/2008
Expert Disclosures Due	4/7/2009
Discovery Closes	5/7/2009
Plaintiff's Pretrial Disclosures	6/21/2009
Plaintiff's 30-day Trial Period Ends	8/5/2009
Defendant's Pretrial Disclosures	8/20/2009
Defendant's 30-day Trial Period Ends	10/4/2009
Plaintiff's Rebuttal Disclosures	10/19/2009
Plaintiff's 15-day Rebuttal Period Ends	11/18/2009

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. 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/stdagmnt.htm>