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

DUNN

Mailed: May 16, 2011

Opposition No. 91175880

Nick Lawrence

v.

Vivint, Inc. (by change of name from APX Alarm Security Solutions, Inc.[1]) and Todd Pedersen, Keith Nellesen and Shawn Brenchley

Opposition No. 91190505
Opposition No. 91190979
Opposition No. 91192970
Opposition No. 91192971
Opposition No. 91192972
Opposition No. 91193022
Opposition No. 91193458
Opposition No. 91193498
Opposition No. 91194458

Nick Lawrence and 911, Inc.

v.

Vivint, Inc.

Cancellation No. 92050773

Vivint, Inc.

v.

Nick Lawrence

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[1] The change of name has been recorded with the Office Assignment Branch at Reel 4432, Frame 0407.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the parties' April 11, 2011 progress report on their settlement negotiations in Opposition No. 91175880, which informs the Board that the settlement discussions includes several proceedings between these parties.[2] All the proceedings have featured multiple extensions or suspensions, and are, at the latest, still in discovery.

In Opposition No. 91175880, Nick Lawrence, an individual alleging common law rights in the mark APEX ALARM, pleads claims of priority and likelihood of confusion and false suggestion of a connection against the original joint applicants (three individuals doing business in Utah) and their assignee Vivint, Inc., a corporation of Utah, who seek to register the mark APX ALARM SECURITY SOLUTIONS (application Serial No. 78777843). Opposition No. 91175880 has been pending since February 27, 2007; was suspended before discovery was completed; and the parties currently are subject to the Board's order requiring a showing of good cause for continued suspension in the form of progress reports.

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[2] The parties are ordered to notify the Board in writing promptly if the parties become involved in another Board proceeding or a civil action with related marks or other issues of law or fact which overlap with this case.

On March 31, 2009, Registration No. 3597021 issued to Nick Lawrence for the mark APEX ALARM. On April 7, 2009, Vivant, Inc. (under its prior name) filed a petition to cancel Registration No. 3597021 on the grounds of abandonment, lack of ownership, nonuse, invalid assignment, and naked licensing (Cancellation No. 92050773).

In Opposition Nos. 91190505, 91190979, 91192970, 91192971, 91192972, 91193022, 91193458, 91193498, and 91194458, Nick Lawrence and his licensee, 911, Inc. oppose registration of defendant Vivint, Inc.'s other applications for marks including the term APX ALARM, alleging priority and likelihood of confusion with pleaded Registration No. 3597021.[3]

Because, with the exception of Opposition No. 91175880, every opposition pleads Registration No. 3597021 as a basis for the common likelihood of confusion claim, cancellation of the registration in Cancellation No. 92050773 plainly would have a bearing on the oppositions. Because the parties are the same, and the listed proceedings involve common issues of law and fact, the Board believes that the

[3] Opposition No. 91190505 also includes a claim of false association, and Opposition No. 91190979 also includes a claim of fraud. The parties are advised that the fraud claim does not include allegations regarding applicant's intent, and thus does not meet the pleading standard established by the Board's primary reviewing court in *In re Bose Corp.*, 580 F.3d 1240, 91 USPQ2d 1938 (Fed. Cir. 2009).

interest of judicial economy will be served by consolidation of Opposition Nos. 91175880, 91190505, 91190979, 91192970, 91192971, 91192972, 91193022, 91193458, 91193498, and 91194458, and Cancellation No. 92050773. *See* Fed. R. Civ. P. 42(a) and TBMP §511 (3d ed. 2011). Accordingly, Opposition Nos. 91175880, 91190505, 91190979, 91192970, 91192971, 91192972, 91193022, 91193458, 91193498, and 91194458, and Cancellation No. 92050773 are consolidated, and may be presented on the same record and briefs.[4]

The need for a separate answer addressing each proceeding's notice of opposition is an exception to how papers are filed once proceedings are consolidated. The parties need not file a copy of every paper filed in each consolidated case; a single copy bearing the number of each consolidated case as shown at the top of this order and filed in the parent case is sufficient. Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the decision shall be placed in each proceeding file.

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[4] The Board file will be maintained in Opposition No. 91175880 as the "parent" case.

With respect to the parties' stipulation for continued suspension in parent Opposition No. 91175880, which now will affect all consolidated proceedings, the Board notes that the parties' April 8, 2011 report states the draft created December 30, 2010 and modified January 26, 2011 is no longer the sole basis for negotiations, and that the parties presently are discussing terms which may be more advantageous to both parties than those included in the draft agreement. The Board also notes that the parties' discussions encompass all proceedings consolidated in this order, and thus involve nine additional applications by Vivint, Inc. as well as Nick Lawrence's registration. Accordingly, the Board finds good cause for continued suspension.[5]

Subject to the right of either party to request resumption at any time, proceedings herein are suspended for three months. *See* Trademark Rule 2.117(c). In the event that there is no word from either party concerning the progress of their negotiations, or the parties fail to meet the continuing obligation to show good cause for further

[5] The Board notes that both the February 7, 2011 and April 11, 2011 progress reports are 6 pages long and include the same accounts of past events, such as the change of counsel in 2008 and the 2010 mediation meetings. The Board is interested only in progress since its last order approving continued suspension for settlement. The detailed progress report does not have to be lengthy, but it must show by that negotiations remain active.

suspension in the form of a detailed progress report, upon conclusion of the suspension period proceedings shall resume without further notice or order from the Board upon the schedule set out below.

Applicant is allowed THIRTY DAYS from resumption in which to answer the notice of opposition in Opposition Nos. 911192970, 91190971, 91192972, and 91194458.[6]

The parties are allowed the same THIRTY DAYS in which to serve responses to any outstanding discovery requests.

Because ten of the eleven consolidated cases were instituted when the current rules were in effect, if settlement is not successful this consolidated proceeding will go forward with a new rules schedule and the requirements for disclosures. Because the parties are in reverse position in the cancellation, petitioner in the cancellation takes the position of the plaintiff in a counterclaim in the schedule. While the parties may have had discovery conferences in some proceedings, in view of the consolidation, if proceeding resume, the parties must again meet to discuss, at least, the sufficiency of the pleadings and arrangements for disclosure and discovery. Dates are reset below.

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[6] In Opposition Nos. 91175880, 91190505, 91190979, 91193458, and 91193498, and Cancellation No. 92050773, the answer already has been filed.

PROCEEDINGS RESUME:	THREE MONTHS FROM MAILING DATE OF THIS ORDER
ANSWERS DUE:	30 DAYS AFTER RESUMPTION
Deadline for Discovery Conference	October 16, 2011
Discovery Opens	October 16, 2011
Initial Disclosures Due	November 15, 2011
Expert Disclosures Due	March 14, 2012
Discovery Closes	April 13, 2012
Plaintiff's Pretrial Disclosures	May 28, 2012
30-day testimony period for plaintiff's testimony to close	July 12, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	July 27, 2012
30-day testimony period for defendant and plaintiff in the counterclaim to close	September 10, 2012
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	September 25, 2012
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	November 9, 2012
Counterclaim Plaintiff's Rebuttal Disclosures Due	November 24, 2012
15-day rebuttal period for plaintiff in the counterclaim to close	December 24, 2012
Brief for plaintiff due	February 22, 2013
Brief for defendant and plaintiff in the counterclaim due	March 24, 2013
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	April 23, 2013
Reply brief, if any, for plaintiff in the counterclaim due	May 8, 2013

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.l25.

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.l29.

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