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

Proceeding	91194547
Party	Plaintiff PayPal, Inc.
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Submission	Motion to Consolidate
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Date	07/22/2010
Attachments	Motion to Consolidate Oppositions against GUNPAL and GPAL.PDF (5 pages) (248014 bytes)

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

PayPal, Inc.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91194547
	§	Opposition No. 91195303
The Cannon Group of Companies	§	
dba GunPal, Inc.,	§	
	§	
Applicant	§	

Commissioner for Trademarks
P. O. Box 1451
Alexandria, VA 22313-1451

**MOTION TO CONSOLIDATE RELATED PROCEEDINGS AND TO
ESTABLISH A CONSOLIDATED DISCOVERY AND TRIAL SCHEDULE
AND BRIEF IN SUPPORT THEREOF**

I. INTRODUCTION

Opposer PayPal, Inc. (“PayPal”) moves to consolidate two opposition proceedings involving The Cannon Group Companies’ (“Cannon”) applications to register the marks GUNPAL and GPAL. As explained below, the Board should consolidate the proceedings because they involve the same parties, related issues, and overlapping evidence.

II. ARGUMENT

When proceedings involving common questions of law or fact are pending before the Trademark Trial and Appeal Board, the Board may consider consolidation of the proceedings pursuant to Fed.R.Civ.P. 42(a). See T.B.M.P. § 511. Here, PayPal moves the Board to consolidate the following two oppositions:

- a) Opposition No. 91194547 filed on April 12, 2010, against Application Serial No. 77/784325 (GUNPAL mark); and

b) Opposition No. 91195303 filed on June 11, 2010, against Application Serial No. 77/896153 (GPAL mark).

When considering whether to consolidate proceedings pursuant to Fed.R.Civ.P. 42(a) and T.B.M.P. §511, the Board weighs the savings in time, effort, and expense that may be gained from consolidation against the prejudice or inconvenience, if any, that may be caused thereby. *See, e.g., World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 U.S.P.Q. 246 (T.T.A.B. 1975). Identity of the parties is another factor that the Board can take into consideration. *See Bigfoot 4 X 4 Inc. v. Gold Circle Ins. Co.*, 5 U.S.P.Q.2d 1444 (T.T.A.B. 1987). Consolidation is warranted in this case because the two opposition proceedings involve common questions of law and fact, as well as complete identity of parties; thus, consolidated consideration by the Board would result in considerable savings in time, effort, and expense to both parties and the Board.

PayPal is the owner of numerous registered "PAYPAL" marks (*e.g.*, PAYPAL, Reg. No. 2,646,490; PAYPAL, Reg. No. 2,959,971; PAYPAL, Reg. No. 3,069,209; and PAYPAL (Stylized), Reg. No. 3,680,256) (collectively "PayPal Marks") for various payment processing services and software, and other related goods and services. Additionally, PayPal is the owner of the pending intent-to-use Trademark Application Serial No. 77/856,538 for the mark PAYPAL X for computer software for developing other computer software, software development tools, and computer software development services. Through widespread use in the United States and around the world, extensive advertising and promotion, continuous and unsolicited media coverage, and a high degree of consumer recognition among other reasons, the distinctive PAYPAL Marks have become famous within the meaning of Section 43(c) of the United States Trademark Act.

Applicant Cannon has filed applications to register two marks using the "PAL" suffix (GUNPAL and GPAL) for use on a variety of online financial services, including financial transaction processing services that are identical to those offered by PayPal under the famous

“PAYPAL” Marks. PayPal believes that Cannon initially sought to use the GUNPAL mark, but has since transitioned to the GPAL mark.

PayPal timely opposed both applications, which were published at different times. The basis of each opposition is the same; namely, that (a) the marks Applicant seeks to register so resemble PayPal’s PAYPAL Marks as to be likely to cause confusion, to cause mistake, or to deceive when used on or in connection with Applicant’s services and would thereby be a source of damage to PayPal, and (b) the marks Applicant seeks to register are so similar to the distinctive and famous PAYPAL Marks that they would create an unauthorized association with the PAYPAL Marks and would be likely to dilute the distinctiveness of the PAYPAL Marks. Both proceedings are at comparable stages of development. Applicant filed its Answer in the GUNPAL opposition and its Answer to the GPAL opposition is due shortly. The parties have not yet served any discovery.

There are clear advantages for both the Board and the parties to have consolidated consideration of these two oppositions. The savings in time, effort, and expense that would result from consolidation far outweigh any potential prejudice or inconvenience that may be caused by consolidation. In fact, because the facts and issues in each of these proceedings are virtually identical in material respects, the evidence to be presented and relied upon will be substantially the same, and the same legal precedent will be used to resolve each matter, there are no perceptible issues of prejudice or inconvenience raised by considering them collectively. On the contrary, consolidation is clearly in all parties’ best interest.

III. CONCLUSION

For the above reasons, PayPal respectfully requests the Board to consolidate the above-referenced proceedings. PayPal suggests that it would be appropriate to adopt the trial schedule currently established for the latter GPAL Opposition, which is as follows:

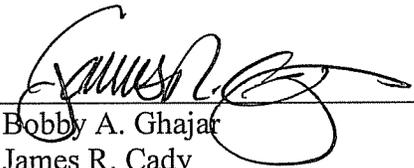
Deadline for Discovery Conference: August 25, 2010
Discovery Opens: August 25, 2010
Initial Disclosures Due: September 24, 2010
Expert Disclosures Due: January 22, 2011
Discovery Closes: February 21, 2011
Plaintiff's Pretrial Disclosures: April 7, 2011
Plaintiff's 30-Day Trial Period Ends: May 22, 2011
Defendant's Pretrial Disclosures: June 6, 2011
Defendant's 30-Day Trial Period Ends: July 21, 2011
Plaintiff's Rebuttal Disclosures: August 5, 2011
Plaintiff's 15-Day Rebuttal Period Ends: September 4, 2011

Respectfully submitted,

PAYPAL INC.

Date: July 22, 2010

By: _____

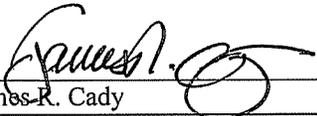

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CERTIFICATE OF ELECTRONIC TRANSMISSION

DATE OF DEPOSIT: July 22, 2010

I hereby certify that this correspondence is being transmitted to the United States Patent and Trademark Office Trademark Trial and Appeal Board using the Electronic System for Trademark Trials and Appeals (ESTTA) on the date indicated above.


James R. Cady

CERTIFICATE OF SERVICE VIA MAIL

I, Rosario F. Renojo, secretary to James R. Cady, of Howrey LLP, attorneys for Opposer PayPal Inc., hereby certify that a true and complete copy of the foregoing MOTION TO CONSOLIDATE RELATED PROCEEDINGS AND TO ESTABLISH A CONSOLIDATED DISCOVERY AND TRIAL SCHEDULE AND BRIEF IN SUPPORT THEREOF was served on Applicant, The Cannon Group of Companies dba GunPal, Inc., 1083 Vine Street, #215, Healdsburg, CA 95448 via postage prepaid by first-class mail on July 22, 2010.


Rosario F. Renojo