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Filing date: **05/10/2011**

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

Proceeding	91199117
Party	Defendant Sergeant's Pet Care Products, Inc.
Correspondence Address	MATTHEW J SMITH POL SINELLI SHUGHART PC 100 S FOURTH STREET, SUITE 1000 ST LOUIS, MO 63102 UNITED STATES uspt@polsinelli.com, kgrady@polsinelli.com, jchallis@polsinelli.com
Submission	Reply in Support of Motion
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Signature	/Keith J. Grady/
Date	05/10/2011
Attachments	OPP 91199117 2011-05-10 SERG Reply ISO of Mt Consolidate.pdf ( 5 pages ) (18456 bytes ) OPP 91199117 2011-05-09 Ex A.pdf ( 6 pages ) (314399 bytes )

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

**IN THE MATTER OF TRADEMARK  
APPLICATION SERIAL NO. 85/120,994**

<b>MERIAL</b>	)	
	)	
Opposer	)	
	)	
v.	)	Opposition No. 91199117
	)	
<b>SERGEANT’S PET CARE PRODUCTS, INC.</b>	)	
	)	
Applicant	)	
	)	

**REPLY BRIEF IN SUPPORT OF APPLICANT’S MOTION TO CONSOLIDATE**

In its Opposition Brief to Applicant, SERGEANT’S PET CARE PRODUCTS, INC.’S (“Applicant”) Motion to Consolidate, Opposer MERIAL (“Merial”) has misrepresented the facts and the communications between the parties. For the reasons set forth herein,<sup>1</sup> as well as the reasons set forth in Applicant’s initial Brief in Support of its Motion, Applicant respectfully requests that the Board consolidate this proceeding with Opposition No. 91197053.

This is not the first time that these parties have been before this Board. In Opposition Nos. 91192979 and 91193879, Opposer opposed certain trademark registrations sought by Applicant. In those proceedings, it was Opposer that sought consolidation. In so doing, Opposer extolled the similarities in the parties, counsel, questions of law, and questions of fact in seeking consolidation. *See* Opposer’s Motion to Consolidate filed in Opposition No. 91193879, at p. 2. This Board ultimately granted Opposer’s Motion for those exact reasons. The same logic and

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<sup>1</sup> Applicant is mindful of the Board’s position on reply briefs as set forth in TBMP § 502.02(b). But the misstatements and mischaracterizations of Opposer in its Opposition Brief necessitated this Reply Brief to clarify the record.

common questions are involved in this case. And the result should be the same notwithstanding Opposer's sudden departure from the similarities it found replete in the prior proceedings.

These Oppositions involve four of Applicant's applications. Those marks include PRONYL OTC, F-PRONIL, FIPROGUARD, and FIPROSPOT, with the first application subject to one proceeding and the latter three subject to the other. With regard to the PRONYL OTC application, Opposer asserts that Applicant is not entitled to registration because said mark is generic, descriptive, or descriptively misdescriptive and should therefore be denied registration under 15 U.S.C. § 1052(a) and (e), as well as 15 U.S.C. § 1051. Notwithstanding Applicant's strong disagreement with the veracity of this statement, those are Opposer's purported grounds for opposing that application. *See* Opposer's Petition in Opposition No. 91199117, at ¶ 6. Notwithstanding its protestations to the contrary, those are the exact same legal grounds on which Opposer has opposed Applicant's F-PRONIL application in the other Opposition pending before this Board. *See* Opposer's Petition in Opposition No. 91197053, at ¶¶ 8-9. Additionally, both of these Oppositions rest on the faulty factual premise that Opposer has legal rights in the generic chemical name "fipronil." *See* Opposer's Petition in Opposition No. 91199117, at ¶ 9; Opposer's Petition in Opposition No. 91197053, at ¶ 4.

As such, there are clearly common questions of law and fact permeating these separate proceedings.<sup>2</sup> The legal issues related to these positions will have to be, if Opposer succeeds in its position, decided two separate times notwithstanding their identity, as well as the identity of the parties and counsel. It is clear that, for the same reasons Opposer sought, and ultimately succeeded, in consolidating the prior Oppositions between these parties, that these proceedings

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<sup>2</sup> In its Opposition Brief, Opposer focuses not on these clear common questions of law and fact, but rather on the other two applications (FIPROGUARD and FIPROSPOT) at issue in Opposition No. 91197053. While the grounds for the opposition of those Applications may, indeed, be different, the above legal issues, related to alleged "genericness," "descriptiveness," and "descriptive misdescriptiveness" will have to be decided in both proceedings. As such, to proceed as proposed by Opposer will indeed provide for a significant duplication of efforts.

should also be consolidated. To force these proceedings to continue independently will only waste this Board and the parties' time and resources. Accordingly, this Motion should be granted.

In its Opposition Brief, Opposer also misstates to this Board the timing of seeking consent on this Motion. Since before the time that Opposition No. 91199117 was even pending, counsel for Applicant had attempted to obtain consent for consolidation or other means to streamline these proceedings. In fact, as early as January 25, 2011, after Applicant filed certain express abandonments of applications not yet opposed by Opposer, counsel for Applicant wrote to counsel for Opposer and suggested a discussion on the possibilities of streamlining these opposition proceedings (the last of which had yet to be filed). *See* E-mail attached as *Exhibit A*. Again on February 18, 2011, counsel for Applicant inquired about the potential consolidation of these proceedings. This was over a month before Opposition No. 91199117 was even filed and two months before the instant Motion was filed. For Opposer to suggest it was blindsided by this attempt to conserve this Board's and the parties' resources is disingenuous at best.

Similarly misplaced are Opposer's concerns regarding discovery. Opposer is correct that, on the same day it refused to consent to the instant Motion, it served discovery on Applicant, including twenty-two (22) interrogatories, eighty-two (82) requests for production of documents, and ninety-six (96) requests for admission. Many of the requests seek clearly irrelevant information such as formulas for products and supply sources for chemicals which appear designed to uncover information for other potential litigation. The instant Motion is not intended to delay discovery. Applicant is not seeking to close the already-open discovery period and consents to having it remain open through the time set for it to close in Opposition No. 91199117. But the breadth of this discovery is yet another reason to consolidate these proceedings. If left unchecked, Opposer could serve another 200 discovery requests in the second Opposition.

Consolidation will allow the discovery to be used in both proceedings and force Opposer to be slightly more selective with its discovery requests.

Finally, Opposer's hypothesis and "suggestions" to Applicant as to how to "streamline" these proceedings have no merit and no place in this Motion. Applicant is allowed, under the very same trademark laws touted by Opposer, to file applications for which it has a bona fide intention to use in commerce. If Opposer was truly interested in streamlining these proceedings, it would consent to this Motion, and not waste this Board's time with the mischaracterizations of its own pleadings and the record.

For all the foregoing reasons, good cause exists to consolidate these Opposition proceedings. There are clearly common questions of law and fact. Nothing in Opposer's Opposition Brief changes the simple facts framed by its own pleadings. Applicant therefore requests that these proceedings be consolidated, that Opposition No. 91197053 become the parent proceeding, and that all dates be re-set in the consolidated Opposition proceeding to coincide with the dates set by the Board in Opposition No. 91199117 with the exception that the discovery period would be deemed to have already begun.

Respectfully submitted,

POLSINELLI SHUGHART PC

By:           /Keith J. Grady/            
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          jchallis@polsinelli.com

ATTORNEYS FOR APPLICANT  
SERGEANT'S PET PRODUCTS, INC.



**Keith Grady**

---

**From:** Keith Grady  
**Sent:** Friday, February 18, 2011 10:52 AM  
**To:** 'btaylor@stites.com'  
**Cc:** 'kpleas@sergeants.com'; John Challis  
**Subject:** RE: Merial v. Sergeant's

Dear Mr. Taylor,

I am writing to follow up on our conversation of January 25. You were going to check with your client on the concept of streamlining the pending opposition by an agreement under which Merial would withdraw its opposition to certain of the pending marks and Sergeant's would agree to abandon those marks. We also discussed the possibility of combining any potential opposition to the mark for which you have sought additional time to oppose (Pronyl OTC) with the pending opposition. Please let me know if you would be available to discuss these issues on Monday, Feb. 21.

Best regards,

Keith Grady



**Keith J. Grady** 100 S. Fourth Street  
*Shareholder* Suite 1000  
St. Louis, MO 63102

tel: 314.552.6883  
fax: 314.622.6783

kgrady@polsinelli.com  
*Add me to your address book...*



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**From:** Keith Grady  
**Sent:** Tuesday, January 25, 2011 3:35 PM  
**To:** 'Taylor, Brewster'  
**Subject:** RE: Merial v. Sergeant's

Possibilities for streamlining the opposition proceeding.



**Keith J. Grady** 100 S. Fourth Street  
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**From:** Taylor, Brewster [mailto:btaylor@stites.com]  
**Sent:** Tuesday, January 25, 2011 3:28 PM  
**To:** Keith Grady  
**Subject:** RE: Merial v. Sergeant's

5 pm today would be fine. Any specific topics for discussion?

**Brewster B. Taylor, Member**  
Direct: (703) 837-3906, Cell: (703) 344-4510  
Fax: (703) 518-2936, [btaylor@stites.com](mailto:btaylor@stites.com)

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**From:** Keith Grady [mailto:KGrady@Polsinelli.com]  
**Sent:** Tuesday, January 25, 2011 4:09 PM  
**To:** Taylor, Brewster  
**Subject:** RE: Merial v. Sergeant's

Dear Mr. Taylor,

How about today at 4:00 pm CT, 5:00 pm ET or tomorrow 1:30 pm CT, 2:30 pm ET?

Let me know which time works best for you or if another time would be preferable.

Regards,

Keith Grady



**Keith J. Grady**  
Shareholder

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**From:** Taylor, Brewster [mailto:btaylor@stites.com]  
**Sent:** Tuesday, January 25, 2011 2:47 PM  
**To:** Keith Grady  
**Subject:** RE: Merial v. Sergeant's

Dear Mr. Grady:  
We could talk this afternoon or tomorrow. Let me know a time when you would like to call.  
Regards,

**Brewster B. Taylor, Member**  
Direct: (703) 837-3906, Cell: (703) 344-4510  
Fax: (703) 518-2936, [btaylor@stites.com](mailto:btaylor@stites.com)

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**From:** Keith Grady [mailto:KGrady@Polsinelli.com]  
**Sent:** Tuesday, January 25, 2011 2:22 PM  
**To:** Taylor, Brewster  
**Cc:** John Challis; Patrick Woolley; 'Kelly Pleas'  
**Subject:** Merial v. Sergeant's

Dear Mr. Taylor,

I am writing to inform you that Sergeant's filed an express abandonment for the PRONYL trademark application (U.S. App. No. 85/120,965) yesterday (see below). Please let me know if you will be available today or tomorrow to discuss Merial's pending opposition to F-PRONIL, FIPROSPOT and FIPROGUARD.

Best regards,

Keith Grady

5/9/2011

**Polsinelli  
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**From:** teas@uspto.gov [mailto:teas@uspto.gov]

**Sent:** Monday, January 24, 2011 11:43 AM

**To:** US Patent and Trademark

**Subject:** 027146- PRON Serial number 85120965: Received Your Request for Express Abandonment (Withdrawal) of Application

We have received your Request for Express Abandonment form below.  
Application serial no. 85120965 has been amended as follows:

PTO Form 2202 (Rev 9/2004)  
OMB No. 0651-0054 (Exp. 09/30/2011)

## Request for Express Abandonment

The table below presents the data as entered.

Input Field	Entered
<b>SERIAL NUMBER</b>	85120965
<b>LAW OFFICE ASSIGNED</b>	LAW OFFICE 104
<b>PUBLISH FOR OPPOSITION DATE</b>	11/30/2010
<b>MARK SECTION</b>	
<b>MARK</b>	PRONYL
<b>REQUEST FOR EXPRESS ABANDONMENT SECTION</b>	
<b>STATEMENT</b>	The applicant hereby expressly abandons the application for trademark registration made under

	the serial number identified above.
<b>SIGNATURE SECTION</b>	
<b>SIGNATURE</b>	/Matthew J. Smith/
<b>SIGNATORY NAME</b>	Matthew J. Smith
<b>SIGNATORY DATE</b>	01/24/2011
<b>SIGNATORY POSITION</b>	Attorney of record
<b>AUTHORIZED SIGNATORY</b>	YES
<b>FILING INFORMATION SECTION</b>	
<b>SUBMIT DATE</b>	Mon Jan 24 12:42:41 EST 2011
<b>TEAS STAMP</b>	USPTO/REA-209.135.145.206 -20110124124241683213-851 20965-420d3344fa362501f99 272d87a7bc1d6d9-N/A-N/A-2 0110124123826442175

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Thank you,

The TEAS support team

Mon Jan 24 12:42:41 EST 2011

STAMP: USPTO/REA-209.135.145.206-20110124124241683213-85120965-420d3344fa362501f99272d87a7bc1d6d9-N/A-N/A-20110124123826442175

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