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

Proceeding	91213081
Party	Plaintiff The Trustees of the Bonnie Cashin Foundation Lucia Keller and David Baum
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the matter of trademark application Serial No. 85/525339
Filed January 25, 2012
For the mark BONNIE CASHIN
Published in the Official Gazette on June 25, 2012

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THE TRUSTEES OF THE BONNIE CASHIN	:	
FOUNDATION, LUCIA KELLAR AND DAVID	:	
BAUM, a New York Trust,	:	Opposition No. 91213081
Opposer,	:	
	:	
-against-	:	
	:	
STEPHANIE DAY LAKE, an individual	:	
	:	
Applicant.	:	
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MOTION TO CONSOLIDATE

Opposer The Trustees of the Bonnie Cashin Foundation, Lucia Kellar and David Baum, a New York trust (the “Foundation”), by and through its attorneys Tannenbaum Helpern Syracuse & Hirschtritt LLP, hereby move pursuant to Federal Rule of Civil Procedure 42(a), as made applicable by Trademark Rule 2.116(a), for an order consolidating its opposition (the “Foundation Opposition”) to trademark application Serial No. 85/525339 (the “Application”) filed by Stephanie Day Lake (the “Applicant”) with Opposition No. 91213082 filed by Coach, Inc. (the “Coach Opposition”). The Foundation Opposition and Coach Opposition both pertain to the Application and involve multiple common questions of law and fact. Consolidation would benefit not only the Foundation and Coach as opposers, but also the Applicant as well as the

Board by saving time, effort and expense. Coach, through its counsel, has consented to the consolidation.

ARGUMENT

“When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases.” Dating DNA, LLC. v. Imagini Holdings, Ltd., 94 U.S.P.Q.2D 1889, 1893 (TTAB 2010) (citing Fed. R. Civ. P. 42(a)); see also M.C.I. Foods, Inc. v. Brady Bunte, 86 U.S.P.Q.2D 1044, 1046 (TTAB 2008). The Board may “order all actions consolidated and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.” S. Indus., Inc. v. Lamb-Weston, Inc., 45 U.S.P.Q.2D 1293, 1297 (TTAB 1997) (consolidating two separate cancellation proceedings based on common questions of law and fact). Consolidation is particularly appropriate where it “will avoid duplication of effort concerning the factual issues in common.” Id. Moreover, if there are multiple oppositions against the same application and those oppositions are at the same stage of litigation and plead similar claims, the Board may order consolidation. See New Orleans Louisiana Saints, LLC v. Who Dat?, Inc., 99 U.S.P.Q.2D 1550, 1551 (TTAB 2011); see also Wright & A. Miller, Federal Practice and Procedure Civil 3d §§ 2382, 2384 (2013). “Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered, it is not always necessary.” TBMP § 511 (2014).

As set forth in its Notice of Opposition, the Foundation is the owner of all rights in Bonnie Cashin’s intellectual property, including, without limitation, her trademark BONNIE CASHIN, trade name “Bonnie Cashin,” and all rights in her name, including her right of publicity. See Foundation Notice of Opposition ¶ 3. In 2011, the Foundation licensed the rights to the trademark BONNIE CASHIN to Coach, which has made use of the trademark in

connection with “handbags, small leather goods, apparel, accessories and other products.” Id. ¶ 4(d); Coach Notice of Opposition ¶ 7. As a result, the oppositions of both the Foundation and Coach to the Application arise from the trademark, the same set of intellectual property rights more broadly and the same set of facts and legal circumstances. Upon even a cursory review of the two Notices of Opposition, the Board will clearly see that the Foundation and Coach make similar and/or identical allegations.

For example, both assert that the use of Applicant’s mark in connection with the goods for which registration is sought is likely to cause confusion, mistake or consumer deception. See the Foundation Notice of Opposition ¶¶ 12, 16-17; Coach Notice of Opposition ¶¶ 12, 15. Both the Foundation and Coach also allege that Applicant’s mark would falsely suggest a non-existent connection between Applicant and each opposer. See the Foundation Notice of Opposition ¶¶ 26-28; Coach Notice of Opposition ¶ 12. In addition, both the Foundation and Coach allege that Applicant, through her authorized Attorney of Record, made willful false representations in the Application, constituting an act of fraud on the Patent and Trademark Office. See the Foundation Notice of Opposition, ¶¶ 31-37; Coach Notice of Opposition, ¶¶ 17-19. These allegations arise from a common set of legal and factual circumstances and, as a result, give rise to numerous overlapping questions of fact and law common to both the Foundation and Coach Oppositions.

At present, both the Foundation Opposition and the Coach Opposition share a common schedule with common deadlines for expert disclosures, the close of discovery and other items. See the Foundation Opposition, Motion to Suspend for Settlement with Consent dated October 1, 2014; see also the Coach Opposition, Motion to Suspend for Settlement with Consent, dated August 15, 2014. However, as Coach’s suspension period expired on October 14 and the

Foundation's current suspension period was set to expire on November 1, 2014, counsel for the Applicant has granted Coach an extension of time to February 1, 2015 in order to respond to Applicant's outstanding discovery requests but has declined to grant the Foundation a similar extension. This would put these overlapping oppositions on two different schedules, resulting in otherwise avoidable inefficiencies and the unnecessary expenditure of resources by both the Board and the parties. To give just one example; documents produced by Coach in response to the Applicant's discovery requests are likely to be relevant to the Foundation Opposition, as well as the Coach Opposition. And yet, Applicant would force the Foundation to produce documents 90 days prior to Coach and proceed without the benefit of Coach's production. This makes no sense for the Foundation, the Applicant or the Board, as all would stand to benefit from the more robust factual record that Coach's production would likely provide.

To put it simply, the Applicant's apparent plan to send the Coach Opposition and the Foundation Opposition off on two different tracks makes no sense. In order to avoid inefficiency and waste, the Board should consolidate the oppositions and impose a uniform schedule of procedure so that both the Foundation and Coach can proceed with their productions in tandem. Only then will the Board be able to "avoid unnecessary costs or delay." S. Indus., Inc., 45 U.S.P.Q.2D at 1297. Through counsel, Coach, recognizing the benefits of consistency between the two oppositions, has consented to consolidation. If the Board should decline to consolidate the oppositions despite the existence of numerous common questions of law and fact, the Foundation requests, in the alternative, that the Board order that the Foundation and Coach both receive an extension of the current deadlines to February 1, 2015 so as to put the Foundation and Coach on the same schedule to respond to Applicant's discovery requests.

CONCLUSION

In light of the questions of law and fact common to both the Foundation Opposition and the Coach Opposition, the Foundation hereby moves for these two oppositions to be consolidated or, in the alternative, that the deadlines for both the Foundation and Coach to respond to the Applicant's outstanding discovery requests be uniformly extended to February 1, 2015.

Dated: New York, New York
November 5, 2014

TANNENBAUM HELPERN SYRACUSE
& HIRSCHTRITT

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CERTIFICATE OF SERVICE

I hereby certify that on November 5, 2014 I caused a true and correct copy of the foregoing MOTION TO CONSOLIDATE to be served by overnight courier on the attorney and correspondent of record for and the Applicant as follows:

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and on the attorney and correspondent of record for the Opposer in Opposition No. 91213082 as follows:

Sarah B. Kickham, Esq.
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516 West 34th Street
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/L. Donald Prutzman/

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