

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

Mailed: April 28, 2014

Opposition No. 91214017

Factory Holding Company 25, S.L.

v.

Google Inc.

Opposition No. 91214020

Border Stylo LLC

v.

Google Inc.

Cancellation No. 92058784

Google Inc.

v.

Border Stylo LLC and Factory Holding
Company 25, S.L.

Cancellation No. 92058815

Google Inc.

v.

Border Stylo LLC

Cheryl S. Goodman, Interlocutory Attorney:

Opposition Nos. 91214017 and 91214020, Cancellation Nos. 92058784 and 92058815

Opposition No. 91214017

On March 27, 2014, new counsel (Fross Zelnick Lehrman & Zissu, P.C.) appeared in this case, and then on April 14, 2014, additional counsel (Saul Ewing LLP) appeared in this case. Then on April 16, 2014, Fross Zelnick Lerhman & Zissu, P.C. withdrew as counsel of record in this case.

The request to withdraw as counsel is in compliance with the requirements of the Trademark Rules and is accordingly granted. The attorneys at the law firm of Fross Zelnick Lehrman & Zissu, P.C no longer represent opposer, Factory Holding Company 25, S.L. in this proceeding. Saul Ewing LLP is the sole counsel of record for opposer in this proceeding.

Opposition No. 91214020

It is noted that on April 14, 2014, counsel Gregory S. Bernabeo and Stephen J. Driscoll of Saul Ewing LLP appeared as counsel of record in Opposition No. 91214020 on behalf of Border Stylo LLC.

Cancellation No. 92058784

Petitioner served the petition to cancel on Factory Holding Company 25, S.L.'s USPTO correspondence address of record, and on Border Stylo at 1500 Market Street, Philadelphia, PA, which petitioner identified in the petition to cancel as Border Stylo's USPTO correspondence address of record. However, Office's records reflect 729 Seward Street, Los Angeles, CA as the correspondence address of record for registrant Border Stylo. Petitioner's service copy to the 7257 Beverly Blvd., Los Angeles, CA address is considered

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a courtesy copy which does not substitute for proper service in compliance with the applicable rules. *Jacques Moret Inc. v. Speedo Holdings B.V.*, 102 USPQ2d 1212, 1215 n. 7 (TTAB 2012).

Petitioner was directed on March 10, 2014 in the notice of institution to forward an additional copy of its petition to cancel to the current owner of record Border Stylo LLC at its correspondence address of record in the Office, 729 Seward Street, Los Angeles, CA. Nothing in the record reflects that this has been done. Petitioner is allowed until FIFTEEN DAYS from the mailing date of this order to file notice of its service copy to the 729 Seward Street, Los Angeles, CA address as directed by the Board's notice of institution.

The filing date of Cancellation No. 92058784 will be amended to the amended proof of service date, as Border Stylo is listed in the Office as the current registrant of record of the involved registration. *See Equine Touch Foundation Inc. v. Equinology Inc.*, 91 USPQ2d 1943 (TTAB 2009) (Board amended filing date based on amended proof of service date).

Notwithstanding the ineffective service on Border Stylo, respondent is on notice of this proceeding via respondent's counsel, who made an appearance in this case on April 14, 2014.¹

Cancellation No. 92058815

Petitioner did not properly serve the petition to cancel on registrant's correspondence address of record in this cancellation proceeding.

¹ The Board's notice of institution sent to the 729 Seward Street address was returned as undeliverable in Cancellation No. 92058784.

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Petitioner's petition to cancel identifies registrant's USPTO correspondence address of record as 1500 Market Street Philadelphia, PA; however, the Office's records reflect 729 Seward Street, Los Angeles, CA as the correspondence address of record for registrant.² Petitioner's service copy to the 7257 Beverly Blvd address is considered a courtesy copy which does not substitute for proper service in compliance with the applicable rules. *Jacques Moret Inc.*, 102 USPQ2d at 1215 n. 7.

Petitioner failed to perfect service; however, although not normally the Board's practice, the Board forwarded a service copy to registrant at its correspondence address of record on March 10, 2014 when issuing the notice of institution. Additionally, counsel for respondent on April 14, 2014 made appearance in this case reflecting registrant's notice of this proceeding.

Therefore, the filing date for the petition to cancel is amended to March 10, 2014, the date the Board served the petition to cancel on respondent at its correspondence address of record. *Cf. Equine Touch*, 91 USPQ2d at 1943 (petitioner cured defective service by filing its amended proof of service; Board accorded petition a new filing date based on the date of the amendment).

Motion to Suspend and/or Consolidate

On March 27, 2014, applicant/petitioner filed in Opposition Nos. 91214017 and 91214020 and Cancellation Nos. 92058784 and 9258815

² The Board's institution orders sent to the 729 Seward Street address and the 1500 Market Street address were both returned as undeliverable in Cancellation No. 92058815.

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consented motions to suspend oppositions and consolidate cancellation actions, or alternatively to consolidate all proceedings.³

Upon consideration of the matter, the Board finds consolidation appropriate for all proceedings, although issue is not joined in the oppositions or cancellations. Counsel for both opposers and registrants are the same, and the cancellation proceedings (which involve both opposers' pleaded registrations) involve similar questions of law and facts.

Accordingly, the parties' alternative consented motion to consolidate is granted, rendering the consented motion to suspend the oppositions and consolidate the cancellations moot.

In view thereof, Opposition Nos. 91214017 and 91214020 and Cancellation Nos. 92058784 and 92058815 are hereby consolidated and, although each proceeding retains its separate character, the cases may be presented on the same record and briefs.⁴ The record will now be maintained at the Board in Opposition No. 91214017 as the "parent" case, and all papers (accept the answers) should be filed in the parent, with all filings including all proceeding numbers in the ascending order.⁵

Dates in these proceedings adopt the schedule in the "junior" cancellation proceedings, with respect to answers, discovery conference and

³ Applicant filed the same motion without consent on March 12, 2014, in the oppositions.

⁴ Answers should be filed in each separate proceeding.

⁵ The parties are requested to advise of any further related proceedings involving the parties.

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initial and expert disclosures; the pretrial disclosure and trial schedule is modified to reflect the parties' reversed positions in the oppositions and cancellations.

Answers due in Oppositions Nos. 91214017 and 91214020 and Cancellations Nos. 92058784 and 92058815	May 14, 2014
Deadline for Discovery Conference consolidated proceedings	June 13, 2014
Discovery Opens consolidated proceedings	June 13, 2014
Initial Disclosures Due consolidated proceedings	July 13, 2014
Expert Disclosures Due consolidated proceedings	November 10, 2014
Discovery Closes consolidated proceedings	December 10, 2014
Plaintiff's Pretrial Disclosures	January 24, 2015
Opposition Nos. 91214017 and 91214020 30-day testimony period for plaintiffs testimony to close, Opposition Nos. 91214017 and 91214020	March 10, 2015
Defendant/Cancellation Plaintiffs Pretrial Disclosures Cancellation Nos. 92058784 and 92058815	March 25, 2015
30-day testimony period for defendant in Opposition nos. 91214017 and 91214020 and plaintiff in the Cancellation Nos. 92058784 and 92058815 to close	May 9, 2015
Cancellation Defendants Nos. 92058784 and 92058815 and Plaintiffs in Opposition Nos. 91214017 and 91214020 Rebuttal Disclosures Due	May 24, 2015
30-day testimony period for defendants in the Cancellation Nos. 92058784 and 92058815 and rebuttal testimony for plaintiffs in Opposition Nos. 91214017 and 91214020 to close	July 8, 2015
Cancellation Plaintiff's (Nos. 92058784 and 92058815) Rebuttal Disclosures Due	July 23, 2015

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August 22, 2015

15-day rebuttal period for plaintiff in the cancellation (Nos. 92058784 and 92058815) to close

October 21, 2015

Brief(s) for plaintiffs Opposition Nos. 91214017 and 91214020 due

November 20, 2015

Brief for defendant Opposition Nos. 91214017 and 91214020 and plaintiff in the Cancellation Nos. 92058784 and 92058815 due

December 20, 2015

Brief for defendant in the Cancellation Nos. 92058784 and 92058815 and reply brief(s), if any, for plaintiffs in Opposition Nos. 91214017 and 91214020 due

January 4, 2016

Reply brief, if any, for plaintiff in the Cancellation Nos. 92058784 and 92058815 due

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.

An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

A copy of this order has been sent to all persons listed below.

CC:
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