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

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| Proceeding | 91214508 |
| Party | Plaintiff Tekni-Plex, Inc. |
| Correspondence Address | CARRIE WEBB OLSON DAY PITNEY LLP ONE INTERNATIONAL PLACE BOSTON, MA 02110 UNITED STATES trademarks@daypitney.com, colson@daypitney.com, cdoconnor@daypitney.com, rosterweil@daypitney.com, jlanzano@daypitney.com |
| Submission | Other Motions/Papers |
| Filer's Name | Ryan S. Osterweil |
| Filer's e-mail | trademarks@daypitney.com, colson@daypitney.com, cdoconnor@daypitney.com, rosterweil@daypitney.com, jlanzano@daypitney.com |
| Signature | /Ryan S. Osterweil/ |
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| Attachments | EDGE PULL - Reply Brief - Motion to Consolidate.PDF(47837 bytes) |

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| Tekni-Plex, Inc., |) | |
| |) | |
| Opposer, |) | Opposition No. 91214508 |
| |) | Application Serial No. 86/001,725 |
| v. |) | Mark: EDGEPULL |
| |) | Class 17 |
| Selig Sealing Products, Inc. |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

OPPOSER’S REPLY IN FURTHER SUPPORT OF MOTION TO CONSOLIDATE

The Opposer, Tekni-Plex, Inc. (hereinafter, “Tekni-Plex” or “Opposer”) submits this Reply in further support of its Motion to Consolidate this proceeding with the nearly identical proceeding, Opposition No. 91215874, brought by Opposer against Selig Sealing Products, Inc.’s (“Selig” or “Applicant”) application to register the mark EDGEPEEL.

Selig’s Opposition ignores the key common factual and legal issues underlying both cases, and distorts the arguments presented by Tekni-Plex in its Notices of Opposition and its Motion to Consolidate the two proceedings. As set forth in Tekni-Plex’s motion, these matters satisfy the standard for consolidation, and consolidation would not prejudice Selig, but instead would promote judicial economy.

A. The EDGEPULL and EDGEPEEL proceedings involve multiple common questions of law and fact.

Selig asserts in its opposition that “[t]here is a fundamental difference in the two cases in the rights being claimed by Tekni-Plex. That fundamental difference creates distinct differences in the arguments of the parties and more importantly the effect of the legal burden on the parties.” (Selig Opp. at 2.) As support, Selig argues that the “fundamental difference” in the two

proceedings lies in Tekni-Plex's claim to priority based on prior use of EDGEPULL, and based only on a likelihood of confusion with EDGEPEEL. This argument ignores both the standard for consolidation and the claims actually asserted by Tekni-Plex in its Notices of Opposition in each proceeding.

Contrary to Selig's suggestion, consolidation is appropriate under Fed. R. Civ. P. 42(a) if the cases involve "a common question of law or fact." No more than a single common question or law or of fact is required for the cases to be consolidated. 9A Charles Alan Wright et al., Federal Practice and Procedure § 2382 ("[T]he existence of a common question by itself is enough to permit consolidation under Rule 42(a), even if the claims arise out of independent transactions.").

Here, the proceedings do not involve just one common question, but there are multiple common questions of law and fact, as illustrated by Tekni-Plex's Notices of Opposition. In the EDGEPULL proceeding, No. 91214508, Tekni-Plex asserts that "Applicant is not lawfully entitled to register the EDGEPULL mark because its mark so resembles Opposer's previously used EDGEPULL mark as to be likely, when used on or in connection with Applicant's goods, to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d)." (Notice of Opp. ¶ 17, Dkt. No. 1). In the EDGEPEEL proceeding, No. 91215874, Tekni-Plex asserted the identical claim, that "Applicant is not lawfully entitled to register the EDGEPEEL mark because its mark so resembles Opposer's previously used EDGEPULL mark as to be likely, when used on or in connection with Applicant's goods, to cause confusion, to cause mistake, or to deceive within the meaning of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d)." (Notice of Opp. ¶ 17, Dkt. No. 1).

Rather than being “fundamentally different,” the rights being claimed by Tekni-Plex in both cases are identical. Both oppositions assert prior rights in the EDGEPULL mark based on Tekni-Plex’s use of EDGEPULL, before Selig’s filing date, in connection with marketing, promotion, product testing, and interstate commerce of adhesive seals for packaging, also known as closure liner/seal products. Based upon its prior rights in EDGEPULL, Tekni-Plex has opposed registration to Selig of the identical mark, EDGEPULL, and the confusingly similar mark, EDGEPEEL.¹

These claims involve at least one common question of fact, including: (1) the date when Tekni-Plex began to use the EDGEPULL mark and (2) the manner of such use. These questions in turn will depend on identical evidence in each proceeding showing Tekni-Plex’s use of EDGEPULL before Selig’s July 3, 2013 priority date. Notably, in support of its assertion of priority, Tekni-Plex has produced hundreds of pages of documents in response to Selig’s document requests, which are equally relevant and will need to be considered in both cases.²

Both proceedings also involve at least one common question of law, including whether Tekni-Plex’s use of EDGEPULL before July 3, 2013 was sufficient to gain rights in the mark. In addition, Tekni-Plex has also filed in both proceedings a Motion to Amend the Notice of Opposition—and simultaneously a Motion for Summary Judgment—seeking to include a claim the Selig lacked a *bona fide* intent to use the Marks at the time its applications were filed. The

¹ Indeed, Selig’s own actions reflect the similarity of the two marks: Selig’s Answer in Opposition No. 91215874 (EDGEPEEL) mistakenly referred to EDGEPEEL as EDGEPULL throughout the document, prompting Selig to move to amend its answer. (See Dkt. Nos.4, 5.)

² Selig’s contention that Tekni-Plex has presented no evidence of actual use of the mark and at most “claims that it had thought of the mark first” (Selig Opp. at 2) is simply wrong. This contention is belied by the many supporting documents produced by Tekni-Plex which demonstrate its use of EDGEPULL (e.g., in marketing EDGEPULL-branded products to multiple customers), well before Selig’s priority date.

bases for these motions is identical in both proceedings: namely, that Selig's failure to produce a single piece of evidence in discovery relating to its *bona fide* intent to use the Marks is objective proof that Selig lacked such a *bona fide* intent.

Selig also tries to fault Tekni-Plex for initially opposing only Selig's EDGEPULL application while extending the time to oppose for EDGEPEEL. Thus, Selig argues that Tekni-Plex "could have filed them as consolidated oppositions at that time" if Tekni-Plex "truly believed that the cases were so identical." (Selig Opp. at 1.) The fact that Tekni-Plex initially brought these matters separately does not negate the appropriateness or benefits of consolidation at this time. Tekni-Plex acted properly in first opposing the identical EDGEPULL mark and, upon further consideration, also opposing the confusingly similar EDGEPEEL mark based on the identical claim of priority. Contrary to Selig's assertion, there was no requirement for Tekni-Plex to bring these cases together, and Tekni-Plex should not be prejudiced for exercising its right under the TTAB rules to extend the time to oppose and being deliberate, rather than rash, in filing these oppositions.

Regardless of the sequence of filing, it is clear that, rather than involving "vastly different" claims (Selig Opp. at 2), the claims asserted in each proceeding involve multiple common questions of law and fact, such that consolidation is appropriate.

B. Consolidation will not Prejudice Selig, but will Promote Judicial Economy.

Selig's opposition to the Motion to Consolidate further asserts that "Tekni-Plex... will use consolidation of the two cases to bootstrap its claims of priority to the one mark onto the other," allegedly causing prejudice to Selig. (Selig Opp. at 1-2, 4.) Not only does Selig misconstrue and ignore Tekni-Plex's identical assertions of priority in each proceeding, but it ignores the TTAB rules, which specifically state that "Consolidated cases do not lose their

separate identity because of consolidation. Each proceeding retains its separate character and requires the filing of separate pleadings and entry of a separate judgment.” TBMP § 511. The Board is fully capable of deciding any distinct issues (such as the likelihood of confusion between Tekni-Plex’s EDGE PULL mark and Selig’s EDGE PULL mark, in the EDGE PULL case, and the likelihood of confusion between Tekni-Plex’s EDGE PULL mark and Selig’s EDGE PEEL mark, in the EDGE PEEL case) on their own merits. Putting aside Selig’s misleading characterizations of the evidence of priority that has been produced by Tekni-Plex (*e.g.*, Selig Opp. at 4), which is in fact plentiful, the issue of prior use of EDGE PULL is the same in both cases. That the Board must then decide whether that mark is close enough to EDGE PEEL to bar Selig’s application – an area uniquely within the Board’s expertise -- is not a reason to deprive the Board, and the parties, of the efficiencies to be had from consolidating a hearing on the common issues.

The Trademark Rules allow for consolidation of separate proceedings where there is a common question of law and fact. *See* TBMP § 511; Trademark Rule 2.116(a); Fed. R. Civ. P. 42(a). In considering whether to consolidate, the Board is to balance the savings in time, effort, and expense that may result from consolidation against any prejudice or inconvenience that may occur. *Id.*; *see S. Indus. Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (TTAB 1997) (consolidation ordered where pleadings were nearly identical). Here, consolidation would result in considerable savings in time, effort, and expense, and Selig can articulate no prejudice that it would suffer from consolidation.

Even if there were to be a difference in the analysis required in the two proceedings based on Tekni-Plex’s claim to priority based on its prior use of EDGE PULL, the rules do not require that all issues be identical, only that there be a common issue of law or fact. *See M.C.I. Foods*,

Inc. v. Bunte, 2008 TTAB LEXIS 9 (Trademark Trial & App. Bd. Feb. 19, 2008) (where consolidation was ordered when the “proceedings involve identical parties, an identical registration and related issues”); *see also Regatta Sport, Ltd. v. Telux-Pioneer, Inc.*, 1991 TTAB LEXIS 23 (Trademark Trial & App. Bd. Aug. 12, 1991) (where consolidation was ordered where “the parties are the same and the proceedings involve substantially identical questions of fact and law”). Under these facts, consolidation is routinely granted. *See Dating DNA, LLC v. Imagini Holdings, Ltd.*, 94 U.S.P.Q.2d, 1889, at *4 (T.T.A.B. 2010) (consolidating oppositions against the marks “VISUALDNA” and “VISUALDNA SHOPS”); *see also Plus Prods. v. Med. Modalities Assoc., Inc.*, 211 U.S.P.Q. 1199, 1201 (TTAB 1981) (granting opposer’s motion to consolidate oppositions to ZNPLUS for a zinc supplement, MN-PLUS for a manganese protein complex, and CA-PLUS for a calcium protein complex).

Further, Selig argues that Tekni-Plex’s motions should be denied “at this late stage of the proceeding.”³ However, there is no rule mandating a deadline for consolidation of related proceedings, only that “the Board will not consider a motion to consolidate until an answer has been filed.” TBMP §511. As the trial period had not yet commenced at the time Opposer filed its Motion to Consolidate the proceedings, Opposer submits that the Motion was timely and would not prejudice Applicant in any way. Importantly, the cases are at identical stages of the proceedings, so this is not a case where consolidation would delay the progress of one of the cases.

These two proceedings involve identical parties, nearly identical marks, and common issues of law and fact, such that consolidation will result in considerable savings of time, effort

³ Contrary to Selig’s arguments (Selig Opp. at 3), the Board has made few if any decisions in these cases to date; rather, the motions filed recently by Tekni-Plex are the first substantive decisions that Board has been called upon to make in either case.

and expense. Accordingly, in the interests of convenience, efficiency, and judicial economy, Opposer requests that the Board enter an Order pursuant to TBMP §511, Trademark Rule 2.116(a) and Fed. R. Civ. P. 42(a) consolidating this proceeding with proceeding No. 91215874.

Dated: March 9, 2015

Respectfully submitted,

TEKNI-PLEX, INC.

By its Attorneys,



Carrie Webb Olson
Catherine Dugan O'Connor
Day Pitney LLP
One International Place
Boston, MA 02110
Tel: 617-345-4600
E-mail: trademarks@daypitney.com
colson@daypitney.com
cdoconnor@daypitney.com

CERTIFICATE OF SERVICE

I hereby certify that on this date a true and correct copy of the foregoing was served upon the attorney of record for the Applicant by electronic mail, as agreed to between the parties, as follows:

Joseph T. Nabor
FITCH, EVEN, TABIN & FLANNERY, LLP
120 S. LaSalle St. Ste 1600
Chicago, IL 60603
jtnabo@fitcheven.com
trademark@fitcheven.com
asimmons@fitcheven.com



Catherine Dugan O'Connor