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: May 5, 2014

Opposition No. **91214933** (parent)

Alfredo Romo Dimas

v.

Favian Tapia and Delia Tapia

----------and----------

Cancellation No. **92057596**

Alfredo Romo Dimas

v.

Favian Tapia Matilde

Robert H. Coggins,
Interlocutory Attorney:

Now before the Board in Opposition No. 91214933 are (1) a request, filed March 28, 2014, to withdraw as counsel of record for applicants, (2) applicants' motion, filed March 28, 2014, to suspend proceedings pending disposition of a civil action, (3) opposer's motion, filed April 1, 2014, for default judgment, and (4) applicants' statement, filed April 8, 2014, of self-representation.

Consolidation

It has come to the attention of the Board that Opposition No. 91214933 and Cancellation No. 92057596 involve identical marks, common questions of law and fact, the same plaintiff, and one of the same defendants. It would

therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a). Consolidation is discretionary with the Board, and may be ordered upon the Board's own initiative. *See, for example*, Wright, Miller, Kane, and Marcus, *Federal Practice and Procedure*, 9A Fed. Prac. & Proc. Civ. § 2383 (3d ed. April 2013 update); and *Venture Out Properties LLC v. Wynn Resorts Holdings LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007)(*sua sponte* consolidation). The Board may exercise its discretion to consolidate cases prior to joinder of issue. *See* TBMP § 511 (3d ed. rev.2 2013). Accordingly, the Board exercises its discretion, and the above-noted opposition and cancellation proceedings are hereby **consolidated** upon the Board's own initiative and may be presented on the same record and briefs.[1] *See Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989), and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1432 (TTAB 1993).

The Board file will be maintained in Opposition No. 91214933 as the "parent" case. Except for an answer to the notice of opposition in Opposition No. 91214933, the parties should no longer file separate papers in connection with each proceeding. Except for that answer (when appropriate), only a single copy of each paper should be filed by the parties in the parent case, and each paper should bear all proceeding numbers in the caption. Despite being consolidated, each proceeding retains its separate character and requires entry of a separate

[1] The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Withdrawal of Counsel

Inasmuch as applicants state in Opposition No. 91214933 that they have asked their counsel to withdraw and that they will represent themselves, the motion to withdraw as counsel is granted. Accordingly, The Trademark Company PLLC no longer represents applicants in Opposition No. 91214933.

It is noted that same counsel previously withdrew and respondent Favian Tapia Matilde stated that he would represent himself in Cancellation No. 92057596, which is currently suspended pending disposition of a civil action.

Motion for Default in Opposition No. 91214933

Answer was due in Opposition No. 91214933 on March 27, 2014. Opposer moved for default judgment on April 1, 2014, four days after applicants filed their March 28, 2014 motion to suspend Opposition No. 91214933. Opposer acknowledges as much in his motion, but states that default judgment should be entered against applicants for their failure to file an answer by March 27, 2014.

Applicants, in their motion to suspend (determined *infra*), ask the Board to "[p]lease excuse the late filing due to the lack of communication with [their now-former] attorney..."; and in their combined notice of self-representation and brief in opposition to the motion for default judgment argue that default is

"inappropriate in this matter" because they "are able to represent [them]selves and [they] will make sure all future time limitations are reached."

The determination of whether default judgment should be entered against an applicant lies within the sound discretion of the Board. In exercising that discretion, the Board is mindful of the fact that it is the policy of the law to decide cases on their merits; and, in view thereof, the Board is reluctant to enter a default judgment for failure to file a timely answer, and tends to resolve any doubt on the matter in favor of the defendant.

While the Board presumes that any appearance or power of attorney in the subject application file at the time of commencement of a Board opposition is effective for purposes of the proceeding (*see*, TBMP § 117.03 (3d ed. rev.2 2013)), such presumption may not reflect the reality of the agreement of representation between applicants and their attorney. Moreover, the Board notes that applicants' counsel withdrew from representation of applicant Favian Tapia, as respondent in now-child Cancellation No. 92057596, long prior to the institution of the opposition proceeding; and opposer makes no substantive argument for default, but instead attempts to gain a mere procedural advantage over applicants.

Applicants failure to file a timely answer the notice of opposition does not appear to be the result of willful conduct or gross neglect on the part of applicants; and, in view of the one-day delay in filing a motion to suspend instead of an answer, applicants' failure to file a timely answer cannot be said to

be unduly prejudicial to opposer. Additionally, without evaluating the merits of the opposition proceeding, the Board finds that the answer filed in now-child Cancellation No. 92057596 by applicant Favian Tapia, as respondent in the cancellation proceeding, suggests, inasmuch as it contains a plausible response to opposer's similar allegations (as petitioner) in the cancellation proceeding, that the joint applicants will have a meritorious defense to the notice of opposition.

In view thereof, the Board finds goods cause to deny opposer's motion for default judgment. Fed. R. Civ. P. 55(c); *Fred Hayman Beverly Hills Inc. v. Jacques Bernier Inc.*, 21 USPQ2d 1556 (TTAB 1991). Accordingly, opposer's motion for default is **denied**.

Motion to Suspend

Applicants' motion to suspend Opposition No. 91214933 is based on the same civil action which occasioned the suspension of Cancellation No. 92057596.[2] Inasmuch as opposer, as respondent in Cancellation No. 92057596, failed to contest the motion to suspend filed therein; the opposition and cancellation cases have been consolidated; the now-child cancellation is already suspended; opposer makes no substantive arguments against suspension, but instead attempts to gain a procedural advantage over applicants; the Notice of Suit (i.e., the Report on the Filing or Determination of an Action Regarding a Patent or Trademark) submitted to the USPTO indicates that

[2] Civil action No. 2:13-cv-08840, styled *Agust Ramirez, et al., v. Mario Sotello, et al.*, filed in the U.S. District Court for the Central District of California.

opposer/petitioner's pleaded registration and respondent's subject registration are at issue in the civil action; and it is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case (*see* TBMP § 510.02(a) (3d ed. rev.2 2013); and *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 USPQ2d 1550, 1552 (TTAB 2011)); applicants' motion to suspend proceedings pending final disposition of the civil action which involves the parties is **granted**. Trademark Rule 2.117(a).

Accordingly, proceedings are **suspended** pending final disposition of the civil action. Within twenty days after the final determination of the civil action, the parties shall so notify the Board so that these consolidated cases may be called up for appropriate action (which may include resetting applicants' time in which to file an answer to the notice of opposition in Opposition No. 91214933, if appropriate).[3] Such notification to the Board should include a copy of any final order or final judgment which issued in the civil action. During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.

A copy of this order has been mailed to each address below:

Matthew H Swyers
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[3] A proceeding is considered to have been finally determined when a decision on the merits of the case (*i.e.*, a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom after expiration of the time to appeal or all appeals have been decided. *See* TBMP § 510.02(b).

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