

ESTTA Tracking number: **ESTTA693626**

Filing date: **09/03/2015**

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

Proceeding	91220335
Party	Plaintiff Charles B.H. James and Louise D.B. James
Correspondence Address	MARK LERNER SATTERLEE STEPHENS BURKE & BURKE LLP 230 PARK AVE, STE 1130 NEW YORK, NY 10169-0079 UNITED STATES mlerner@ssbb.com
Submission	Motion to Consolidate
Filer's Name	Mark Lerner
Filer's e-mail	mlerner@ssbb.com
Signature	/Mark Lerner/
Date	09/03/2015
Attachments	Opposers' Motion to Consolidate and Suspend Related Proceedings.pdf(38372 bytes )



consolidating the above-captioned proceedings and suspending them pending the resolution of a prior related opposition proceeding involving the same parties. In support of the motion, Opposers state:

1. On April 30, 2014, the Opposers commenced Opposition Proceeding No. 91216176 (the “First Proceeding”) to oppose the Applicant’s application (Serial No. 77/622989) to register the mark “CHARLES JAMES.”

2. Opposers subsequently commenced the above-captioned Opposition Proceeding Nos. 91220335 and 91220654 and Cancellation Proceeding No. 92060843 with respect to Applicant’s subsequent applications (Serial Nos. 86/279620, 86/279661) to register and registration of the very same mark “CHARLES JAMES.”

3. The First Proceeding and the Subsequent Proceedings each involve the same parties and substantially identical questions of law and fact. In each proceeding, Opposers assert that Applicant’s use of the mark “CHARLES JAMES” would falsely suggest a connection to Opposers’ deceased father, the famous designer Charles James, in violation of 15 U.S.C. § 1052(a). Thus, identical legal and factual issues are raised in each proceeding.

4. Therefore, consolidating the Subsequent Proceedings and suspending them pending the conclusion of the First Proceeding would result in substantial savings in time, effort and expense and would not prejudice any party.

5. Accordingly, Opposers respectfully request that the Board enter an order consolidating the above-captioned Subsequent Proceedings and suspending them pending the conclusion of the First Proceeding.

Dated: September 3, 2015

Respectfully submitted,

SATTERLEE STEPHENS BURKE &  
BURKE LLP

s/ Mark Lerner

Mark Lerner

230 Park Avenue

New York, NY 10169

Attorney for Opposers and Petitioners

**CERTIFICATE OF SERVICE**

(37 C.F.R. § 2.119)

I declare under penalty of perjury that on the 3rd day of September, 2015, OPPOSERS' MOTION TO CONSOLIDATE AND SUSPEND RELATED PROCEEDINGS was served on applicant, LUVANIS, S.A., by delivering a true and correct copy, by First Class Mail, postage prepaid, to:

John L. Welch  
Wolf Greenfield  
600 Atlantic Avenue  
Boston, MA 02210-2206

/s/ Charles J. Keeley  
Charles J. Keeley