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: July 16, 2015

Opposition Nos. 91221141 (parent)
91221566

Stanley Logistics, LLC

v.

JS Products, Inc.

Robert H. Coggins,
Interlocutory Attorney:

Now before the Board is Opposer's motion (filed May 26, 2015, in Opposition No. 91221566) to consolidate Opposition Nos. 91221141 and 91221566.[1] The motion is fully briefed.

Motion to Consolidate

Federal R. Civ. P. 42(a), made applicable to these proceedings by Trademark Rule 2.116(a), provides with respect to consolidation of proceedings that, when actions involve a common question of law or fact, the Board may join for hearing or trial any or all of the matters at issue in the actions, may consolidate the actions, and may issue any other orders to avoid unnecessary costs or delay. *See* TBMP § 511 (2015).

[1] Applicant's appearance of counsel (filed April 27 and May 29, 2015, in the respective oppositions) is noted.

The Board has reviewed the records in Opposition Nos. 91221141 and 91221566, and concludes that these cases involve identical parties, identical marks, and common questions of law and fact. All but four of the thirty-three paragraphs in the respective notices of opposition are identical; indeed, Opposer pleads ownership of the same thirteen registrations in both pleadings and alleges the same grounds for opposition. Three of the four differing paragraphs (1, 5, and 9) contemplate the difference between the goods in Applicant's respective applications, with paragraphs 1 and 5 of Opposition No. 91221566 merely including Opposer's additional allegation of common law rights in its marks with regard to "lighting products." It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a). Indeed, Applicant concedes that these proceedings likely will have overlapping proofs. Applicant's arguments that the goods in its respective applications differ and that its evidence and arguments for its Classes 8 and 11 goods may differ do not reveal any prejudice or inconvenience that would outweigh the savings in time, effort, and expense which may be gained from consolidation. Despite being consolidated, each proceeding retains its separate character and requires entry of a separate 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. In view thereof, the motion to consolidate is **granted**. The above-noted proceedings are hereby consolidated and may be presented on the same record and briefs. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

The Board file will be maintained in Opposition No. 91221141 as the "parent" case. Except for amended notices of opposition, if filed, and answers thereto (see discussion, *infra*), only a single copy of all motions and papers should be filed in the parent case only, and should caption all consolidated proceeding numbers listing the parent case first.[2]

Count II Stricken *Sua Sponte*

Upon review of the notices of opposition, which was necessary for consideration of the motion to consolidate, the Board has determined that Count II ("deception/false suggestion of a connection") in each notice of opposition is insufficient.

In the header for Count II, Opposer cites to "§ 43(a)." Section 43(a) of the Trademark Act provides recourse to a party by way of a civil action but is not applicable to an opposition proceeding. The Board may not entertain any claim based on Trademark Act § 43(a). *Andersen Corp. v. Therm-O-Shield Int'l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985). This is not, however, the only flaw in pleading Count II. Although Opposer also cites to Section 2(a) of the Trademark Act (*see* paragraph 20), neither the ground of deception nor false suggestion of a connection is sufficiently pleaded under Section 2(a); instead, they appear to be another iteration of Count I (likelihood of confusion).

In order to properly assert a ground of false suggestion of a connection, Opposer must plead that (1) Applicant's mark is the same or a close approximation of

[2] 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.

Opposer's previously used name or identity; (2) that the mark would be recognized as such, in that it points uniquely and unmistakably to Opposer; (3) that Opposer is not connected with the goods sold by Applicant under the mark; and (4) that Opposer's name or identity is of sufficient fame or reputation that when Applicant's mark is used on its goods, a connection with Opposer would be presumed. *See Boston Red Sox Baseball Club LP v. Sherman*, 88 USPQ2d 1581 (TTAB 2008); and *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985). While Opposer provides some conclusory allegations as to part of a claim of false suggestion of a connection, neither notice of opposition contains an allegation that Opposer's PROTO marks serve as Opposer's *name* or *identity* instead of merely a *mark* owned by Opposer. Specifically, paragraph 21 alleges that the subject mark closely resembles Opposer's marks -- not Opposer's previously used name or identity.

In order to properly assert a ground that the mark is deceptive, Opposer must plead that (1) Applicant's mark misdescribes the character, quality, function, composition or use of the goods, (2) prospective purchasers are likely to believe that the misdescription actually describes the goods, and (3) the misdescription is likely to affect a significant portion of the relevant consumers' decision to purchase. *See In re Spirits Int'l, N.V.*, 563 F.3d 1347, 90 USPQ2d 1589 (Fed. Cir. 2009); and *In re Budge Mfg. Co.*, 857 F.2d 773, 775, 8 USPQ2d 1259, 1260 (Fed. Cir. 1988), *aff'g* 8 USPQ2d 1790 (TTAB 1987). *See also In re White Jasmine LLC*, 106 USPQ2d 1385 (TTAB 2013). There does not appear to be anything other than bare bones, conclusory allegations in the notices of opposition as to any of the individual factors.

Moreover, paragraph 20 alleges that the mark misdescribes the "origin" of the goods, and paragraph 23 alleges that the mark "is deceptive in that it falsely suggests a connection with" Opposer. These allegations are, in essence, more appropriate to a claim of likelihood of confusion under Section 2(d) rather than deceptiveness under Section 2(a). Opposer fails to allege how the use of the mark by Applicant would be deceptive in relation to the goods, and there is nothing that would allege plausibility or materiality of a Section 2(a) deceptiveness claim. Moreover, Opposer appears to improperly conflate the separate grounds. *See* para. 23 ("Applicant's mark PROTOCOL is *deceptive* in that it *falsely suggests a connection* with" Opposer) (emphasis added).

In view thereof, Count II (the false suggestion of a connection and deceptiveness grounds pleaded in paragraphs 19-25) is **stricken** from each notice of opposition. However, Opposer is allowed until **August 7, 2015**, to file an amended notice of opposition in each proceeding that properly alleges a ground of false suggestion of a connection and/or deceptiveness, should Opposer have a reasonable basis for such claim(s); failing which, the consolidated oppositions will go forward on the two remaining grounds of likelihood of confusion (Count I) and dilution (Count III) in the original notices of opposition, as **stricken**. Applicant is allowed until **August 28, 2015**, in which to file an answer to each prospective first amended notice of opposition, if amended notices of opposition are filed.[3]

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[3] As mentioned above, the complaint and answer are exceptions to the general rule that a paper should be filed only in the "parent" case. The parties should file the individual complaint and answer in the respective file.

Schedule

Dates are reset on the schedule below.[4]

Amended Notice(s) of Opposition Due, if Filed	8/7/2015
Answer(s) to Amended Notice(s) Due	8/28/2015
Initial Disclosures Due	9/11/2015
Expert Disclosures Due	1/9/2016
Discovery Closes	2/8/2016
Plaintiff's Pretrial Disclosures	3/24/2016
Plaintiff's 30-day Trial Period Ends	5/8/2016
Defendant's Pretrial Disclosures	5/23/2016
Defendant's 30-day Trial Period Ends	7/7/2016
Plaintiff's Rebuttal Disclosures	7/22/2016
Plaintiff's 15-day Rebuttal Period Ends	8/21/2016

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. Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

[4] Discovery is open. Inasmuch as the deadline for the parties' discovery conference in each proceeding has run, the new, consolidated schedule does reset this date.