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: August 24, 2015

Opposition No. 91222214

Dandy Products, Inc.

v.

Nicolon Corporation

Opposition No. 91222215

Lumite, Inc.

v.

Nicolon Corporation

Opposition No. 91222223

Willacoochee Industrial Fabrics, Inc.

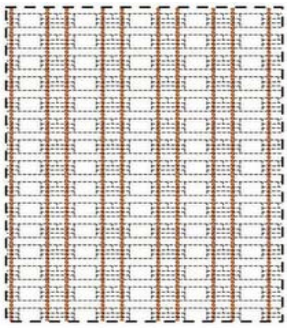
v.

Nicolan Corporation

George C. Pologeorgis,
Interlocutory Attorney:

Nicolan Corporation ("Applicant") seeks to register the mark, as displayed below, for "geosynthetics, namely, geotextiles for the purposes of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation, stabilization

and reinforcement of the soil; geotextiles for use in connection with road construction, tunnel construction, waterway construction and public works construction; fabrics for use in civil engineering; erosion control fabric" in International Class 19.[1]



Applicant has provided the following description of its involved mark: "The mark consists of the color orange as applied to one or more yarns or threads woven into the body of geosynthetic or geotextile fabric of indefinite length and width producing a radiant orange surface when light strikes the fabric and the matter shown in broken lines is not part of the mark and serves only to show the position or placement of the mark." Applicant has also included the following color statement: "The color(s) orange is/are claimed as a feature of the mark."

Opposers Dandy Products, Inc., Lumite, Inc., and Willacoochee Industrial Fabrics, Inc. have each opposed the registration of Applicant's involved mark on the grounds that the involved mark is functional and has not acquired distinctiveness. Opposers Dandy Products, Inc. and Lumite, Inc. have also opposed registration of

[1] Application Serial No. 86057945, filed on September 6, 2013, based upon an allegation of use in commerce under Section 1(a) of the Trademark Act, claiming March 30, 2010 as the date of first use and May 20, 2010 as the date of first use in commerce. Applicant seeks registration of its involved mark, in its entirety, under Section 2(f) of the Trademark Act.

Applicant's involved mark on the additional ground of fraud. Opposer Dandy Product, Inc. has also opposed registration of Applicant's involved mark on the stand alone ground of likelihood of confusion under Section 2(d) of the Trademark Act.

Applicant has filed answers to the notices of opposition in Opposition Nos. 91222214 and 91222215. Although Applicant filed an answer in Opposition No. 91222223, the Board, by order dated August 8, 2015 in that case, allowed Applicant until September 6, 2015 in which to file an amended answer in Opposition No. 91222223.

Applicant's Motion To Consolidate

On August 17, 2015, Applicant filed a motion to consolidate Opposition Nos. 91222214, 91222215, and 91222223. Applicant filed its motion in each proceeding it seeks to consolidate.

The Board, in its discretion, suggested that the issues raised in Applicant's motion should be resolved by telephonic conference as permitted by TBMP § 502.06. The Board contacted the parties to discuss the date and time for holding the phone conference.

The parties agreed to hold the telephonic discovery conference with the Board at 3:00 p.m. EDT on Monday, August 24, 2015. The conference was held as scheduled among Terry Clark and Brian Iverson, as counsel for Opposer Dandy Products, Inc., Bradley Groff and Lauren Brenner, as counsel for Opposer Lumite, Inc., Joel Samuels, as counsel for Opposer Willacoochee Industrial Fabrics, Inc., Jeffrey

Arnold and Stacy Stewart, as counsel for Applicant Nicolan Corporation, and George C. Pologeorgis, as a Board attorney responsible for resolving interlocutory disputes in these cases.

During the telephone conference, the Board afforded each Opposer time in which to respond orally to Applicant's motion to consolidate. Based upon the responses provided, the Board determined that it requires full briefing on the motion.

Notwithstanding the foregoing, during the telephone conference, the parties agreed to suspend each individual proceeding for sixty days to allow the parties to discuss settlement.

Accordingly, Opposition Nos. 91222214, 91222215, and 9122223 are individually suspended for settlement up to, and including **October 23, 2015**, subject to the right of a party to a particular proceeding to request resumption of that proceeding at any time. *See* Trademark Rules 2.117(c) and 2.127(a); and TBMP § 605.02.

If, during the suspension period, any of the parties or their attorneys should have a change of address, the Board should be so informed.[2]

In the event that there is no word from any party concerning the progress of their settlement negotiations, upon conclusion of the suspension period, each Opposer is allowed until **November 12, 2015** in which to file and serve a written response to Applicant's motion to consolidate. Each Opposer should file their response in their respective proceeding. Applicant, in turn, may file a reply brief in

[2] If the parties are (or during the pendency of this proceeding become) parties to another proceeding involving the subject application/registration, the parties must notify the Board so the Board can consider whether consolidation or suspension of proceedings is appropriate.

support of its motion to consolidate in accordance with Trademark Rule 2.127. Applicant should file its reply brief in each opposition proceeding. Additionally, upon conclusion of the suspension period, Applicant is allowed until **November 12, 2015** in which to file an amended answer in Opposition No. 91222223.

Following the conclusion of the suspension period for settlement, each opposition proceeding will remain suspended pending the disposition of Applicant's motion to consolidate, except to the extent that Applicant is still required to file its amended answer in Opposition No. 91222223 by the deadline set forth above.

The Board would like to thank counsel for their cooperation and professional decorum during the telephone conference.