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

Proceeding	91222215
Party	Defendant Nicolon Corporation
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Submission	Motion to Consolidate
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Date	12/29/2015
Attachments	Motion to Consolidate Renewed and Amended Lumite srs edits 1229.pdf(37843 bytes)

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

Dandy Products, Inc.		:	
	Opposer,	:	
v.		:	Opposition No. 91222214
		:	
Nicolon Corporation,		:	
	Applicant.	:	
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Lumite, Inc.,		:	
	Opposer,	:	
v.		:	Opposition No. 91222215
		:	
Nicolon Corporation,		:	
	Applicant.	:	
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Willacoochee Industrial Fabrics, Inc.		:	
	Opposer,	:	
v.		:	Opposition No. 91222223
		:	
Nicolon Corporation,		:	
	Applicant.	:	
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APPLICANT’S RENEWED AND AMENDED MOTION TO CONSOLIDATE

United States Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Dear Sir or Madam:

Nicolon Corporation (the “Applicant”), by its undersigned attorney, in the interest of judicial and pecuniary economy, moves pursuant to Fed. R. Civ. P 42(a) and Trademark Trial and Appeal Board Manual of Procedure (TBMP) § 511, to consolidate the above-captioned oppositions (the “Oppositions”) filed by Dandy Products, Inc. (Opposition No. 91222214);

Lumite, Inc. (Opposition No. 91222215); and Willacoochee Industrial Fabrics, Inc. (Opposition No. 91222223) (collectively “the Opposers”). It is Applicant’s understanding that the Opposers have not consented to consolidation.

The grounds for the Motion to Consolidate are as follows:

1. Opposition Nos. 91222214, 91222215, and 91222223, involve the same Applicant, namely, Nicolon Corporation.
2. Opposition Nos. 91222214, 91222215, and 91222223, involve the same trademark, namely, U.S. Trademark Application No. 86057945 for the ORANGE COLOR Mark described as “the color orange as applied to one or more yarns of threads woven into the body of a geosynthetic or geotextile fabric of indefinite length and width producing a radiant orange surface when lights strikes the fabric,” in Class 19.
3. Opposition Nos. 91222214, 91222215, and 91222223 are at the earliest stage in the proceedings. An Answer has been filed in each Opposition, discovery conferences have been conducted, and initial disclosures and discovery have not yet been served.
4. The Opposers are separate entities. In this regard, identity of the parties, although one factor to be considered, is not required. TBMP § 511 n.4, citing New Orleans Louisiana Saints LLC v. Who Dat? Inc., 99 USPQ2d 1550, 1552 (TTAB 2011) (if multiple oppositions brought by different opposers are at the same stage of litigation and plead the same claims, the Board may consolidate for consistency and economy).
5. The Oppositions should be consolidated because these proceedings involve common questions of law and fact. TBMP § 511.
6. Dandy Product, Inc. (“Dandy”) filed its Notice of Opposition on June 3, 2015. In its Notice of Opposition, Dandy asserted four grounds for opposition: (1) likelihood of

confusion under Section 2(d) of the Trademark Act; (2) Applicant’s mark is functional under Section 2(e)(5) of the Trademark Act; (3) Applicant’s mark has not acquired distinctiveness under Section 2(e); and (4) inequitable conduct/fraud.

7. Lumite, Inc. (“Lumite”) filed its Notice of Opposition on June 3, 2015. In its Notice of Opposition, Dandy asserted three grounds for opposition: (1) Applicant’s mark is functional under Section 2(e)(5) of the Trademark Act; (2) Applicant mark has not acquired distinctiveness under Section 2(e) of the Trademark Act; and (3) inequitable conduct/fraud.
8. Willacoochee Industrial Fabrics, Inc. (“Willacoochee”) filed its Notice of Opposition on June 3, 2015. In its Notice of Opposition, Willacoochee asserted two grounds for opposition: (1) Applicant’s mark is functional under Section 2(e)(5) of the Trademark Act and (2) Applicant’s mark is descriptive and has not acquired distinctiveness under Section 2(e) of the Trademark Act.
9. The following chart shows that the overlap between the claims asserted by Dandy, Lumite, and Willacoochee:

	Priority/Likelihood of Confusion	Functionality	Lack of Acquired Distinctiveness	Inequitable Conduct/Fraud
Dandy	X	X	X	X
Lumite		X	X	X
Willacoochee		X	X	

10. With the exception of Dandy’s priority/likelihood of confusion claim, Dandy’s and Lumite’s Notices of Opposition are virtually identical. S. Industries Inc. v. Lamb-Weston Inc., 45 USPQ2d 1293, 1297 (TTAB 1997) (granting consolidation where both proceedings involve the same mark and virtually identical pleadings).

11. Willacoochee's Notice of Opposition overlaps with Dandy's and Lumite's Notice of Opposition on the claims of (1) functionality and (2) lack of acquired distinctiveness.
12. Consolidation does not require that the issues be identical. World Hockey Assn. v. Tudor Metal Prods. Corp., 185 U.S.P.Q. 246, 248 (TTAB 1975) (consolidation ordered where issues were substantially the same and consolidation would be advantageous to both parties)(emphasis added).
13. Opposers will not be prejudiced if the oppositions are consolidated because consolidated cases do not lose their separate identity when consolidated. TBMP § 511.
14. Further, according to TBMP § 511, "where a final disposition has been entered as to some, but not all, of the cases in a consolidated proceeding, the remaining cases will no longer considered consolidated with the cases for which a final disposition has been entered". Id. n.10, citing Zoba Intl. Corp. v. CVC Format/LOGO Licensing Corp., 98 U.S.P.Q.ed 1106, 1115 (TTAB)(because two of three cancellations dismissed, remaining cancellation no longer considered to be consolidated and shall proceed as a single proceeding). Accordingly, consolidation will not prejudice Opposers should Applicant prevail before trial on some, but not all claims.
15. Consolidation will promote efficiency and avoid unnecessary repetition, costs, and delays. TBMP § 511. The oppositions filed by Dandy, Lumite, and Willacoochee require substantially similar evidence, discovery, witnesses, testimony, and arguments. If these oppositions are consolidated, Applicant's witnesses will be deposed once, and not three times by each Opposer. In addition, triplicate discovery will be avoided, if these oppositions are consolidated. In addition, trial testimony will likely be substantially

similar in each proceeding. Trial testimony and evidence can be presented more efficiently in a single proceeding.

16. With respect to the outlier claims of priority/likelihood of confusion and fraud, the Board may, pursuant to Fed. R. Civ. P. 42(a)(1) and (3), “join for hearing or trial any or all matters at issue in the actions” and “issue any orders to avoid unnecessary cost or delay”. Accordingly, the Board has wide latitude in resolving any of the issues or concerns Opposers may have with respect to the preparation and filing of a joint trial brief, if these oppositions are consolidated.
17. Dandy, Lumite, and Willacoochee will not be prejudiced or inconvenienced if these oppositions are consolidated. The issues of functionality and lack of acquired distinctiveness are identical across all three Oppositions. Consolidation will avoid the risk of inconsistent judgements on these identical issues. See TBMP § 511 n. 4; See Cantrell v. GAF Corp., 999 F.2d 1007, 1011 (6th Cir. 1993) (holding risk of inconsistent adjudications is a factor to consider under Fed. R. Civ. Pro. 42, in determining whether to consolidate).
18. The Board upon its own initiative may consolidate the proceedings. TBMP § 511 n. 5. Consolidation of the three (3) opposition proceedings will save the Board time, effort and expense in managing and hearing consolidated oppositions, rather than three separate oppositions. Thus, consolidation would serve the interests of judicial economy.

WHEREFORE, pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a), in order to promote administrative efficiency and save time and expense for the parties, Applicant moves and requests that the TTAB consolidate Oppositions Nos. 91222214, 91222215, and 91222223.

Dated: December 29, 2015

Respectfully submitted,
Nicolon Corporation

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CERTIFICATE OF SERVICE

I, Stacy Raphael Stewart, counsel to Applicant Nicolon Corporation, in Opposition No. 91222215, certify that, on the 29th day of December, 2015, I served a copy of the **APPLICANT'S RENEWED AND AMENDED MOTION TO CONSOLIDATE**, via first class prepaid mail, upon:

LAUREN W BRENNER

BRAD GROFF

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