

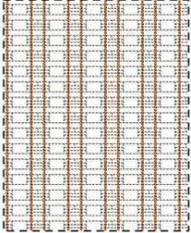
ESTTA Tracking number: **ESTTA721371**

Filing date: **01/19/2016**

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

Proceeding	91222215
Party	Plaintiff Lumite, Inc.
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Date	01/19/2016
Attachments	Opposer Lumite's Response in Opposition to Applicant's Renewed and Amended Motion to Consolidate.pdf(65322 bytes)

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

LUMITE, INC.,)	
)	
<i>Opposer,</i>)	Opposition No. 91222215
)	Application Serial No. 86/057,945
v.)	Filing Date: September 6, 2013
)	Publication Date: February 3, 2015
NICOLON CORPORATION,)	Mark: 
)	
)	
<i>Applicant.</i>)	
_____)	

**OPPOSER LUMITE’S RESPONSE IN OPPOSITION TO APPLICANT’S RENEWED
AND AMENDED MOTION TO CONSOLIDATE**

LUMITE, INC. (“Opposer” or “Lumite”), through its undersigned attorneys, files this Response in Opposition to Applicant Nicolon Corporation’s (“Applicant” or “Nicolon”) Renewed and Amended Motion to Consolidate, which Applicant filed on December 29, 2015 (“Renew Motion” or “Motion”) and served by regular U.S. Mail. Applicant has moved to consolidate this opposition with two other opposition proceedings pending against it.¹ For the reasons set forth herein, Nicolon’s Motion should be denied with prejudice. In the alternative, if the Board does consolidate these proceedings, Lumite requests reasonable additional discovery and the ability to file its own pleadings and briefs with respect to individual and unique arguments not shared with another Opposer.

FACTUAL BACKGROUND

Applicant filed its Section 1(a) Application to register the COLOR ORANGE Mark, Serial No. 86/057,945, in connection with “[g]eosynthetics, namely, geotextiles for the purpose of drainage, stabilizing inclines, recultivation, plant support, absorption, filtration, separation,

¹ The docket numbers of the two other opposition proceedings that Nicolon seeks to consolidate with the instant proceeding are: 91222214 (Dandy) and 91222223 (Willacoochee).

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 Class 19, with a claimed date of first use of May 20, 2010 (“the Application”).

Lumite filed a Notice of Opposition on June 3, 2015 on the grounds that: (1) the mark is functional under 15 U.S.C. § 1052(e)(5), (2) the mark has not acquired distinctiveness under 15 U.S.C. § 1052(e); and (3) inequitable conduct/fraud. Dandy Products, Inc. (“Dandy”) also filed a Notice of Opposition (Opposition Proceeding 91222214) on June 3, 2015 alleging: (1) likelihood of confusion under 15 U.S.C. § 1052(d); (2) the mark is functional under 15 U.S.C. § 1052(e)(5), (3) the mark has not acquired distinctiveness under 15 U.S.C. § 1052(e); and (4) inequitable conduct/fraud. Willacoochee Industrial Fabrics, Inc. (“Willacoochee”) also filed a Notice of Opposition (Opposition Proceeding 91222223) on June 3, 2015 on the grounds that: (1) the mark is functional under 15 U.S.C. § 1052(e)(5), and (2) the mark has not acquired distinctiveness under 15 U.S.C. § 1052(e). (All three companies are collectively referred to herein as “Opposers”).

Nicolon filed its initial Motion to Consolidate on August 17, 2015. After conducting a teleconference with the Board on August 24, 2015, the Opposers and Nicolon agreed to suspend proceedings in order to discuss settlement.

After this teleconference, Lumite sent proposed settlement terms to Nicolon on September 10, 2015. As Nicolon was still reviewing Lumite’s proposed settlement terms, a Stipulated/Consented Motion to Extend the Suspension was filed on October 22, 2015 to extend the suspension period to November 23, 2015. Two months after Lumite sent proposed settlement terms, with no substantive response from Nicolon in the interim, Nicolon sent a settlement

proposal on November 18, 2015. With the end of the suspension period closing in, Lumite consented to another stay on November 20, 2015 in order to review the Nicolon settlement proposal.

On December 2, 2015, the Board granted a further suspension to consider settlement and denied Nicolon's initial Motion to Consolidate. In its ruling, the Board required that if Nicolon renewed its Motion to Consolidate it "must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties." (Doc. 15, p 2-3). Nicolon withdrew its support for the suspension to consider settlement by filing a Request for Resumption of Proceedings on December 16, 2015. On December 29, 2015, Nicolon filed a Renewed and Amended Motion to Consolidate, which Lumite now opposes.

ARGUMENT

Nicolon's Renewed Motion should be denied for two reasons: (1) it does not demonstrate that the savings gained by consolidation are greater than the prejudice and/or inconveniences consolidation would impose on the Opposers, and (2) it is procedurally defective. In the alternative, if the Board does grant the Renewed Motion, Lumite requests additional considerations for discovery and briefing as reasonably necessary to avoid prejudice to Opposer.

A. Prejudice or Inconvenience Outweighs Savings in Time, Effort, and Expense

When exercising its discretion in deciding motions to consolidate, the Board weighs the "savings in time, effort, and expense" gained "against any prejudice or inconvenience that may be caused thereby." TBMP § 511. Consolidating these three oppositions will complicate discovery and filings for each Opposer and will prejudice each Opposer in view of *B & B Hardware, Inc. v. Hargis Indus., Inc.*, 135 S. Ct. 1293, 191 L. Ed. 2d 222 (2015).

In the case at hand, the prejudice, inconvenience, and disadvantage that would be caused to Lumite (and the other Opposers Willacoochee and Dandy) outweigh any potential savings gained. While there is some overlap of the claims asserted by Lumite and the other Opposers, Lumite would be prejudiced, inconvenienced, and disadvantaged if the proceedings were consolidated due to:

- a. All three Opposers are competitors and have different products, which would be impacted in different ways by registration of a mark that would preclude functional use of “safety orange” on their respective products.
- b. As evidenced by some Opposers trying to work towards settlement (Lumite) and other Opposers resuming proceedings (Willacoochee), the Opposers have different strategies in their respective proceedings.
- c. Each party would be prejudiced and at a disadvantage if all three Opposers were required to submit one shared or consolidated brief in response to Applicant’s filings.
- d. Each party would be prejudiced and at a disadvantage during discovery, for example if all three Opposers were required to share in a single deposition of Nicolon’s witnesses, providing each Opposer significantly less time.
- e. Lumite would be prejudiced by consolidation because Dandy has raised a claim for priority for the mark, and if Dandy is successful in its argument on this point, Dandy’s prior trademark rights could create a claim by Dandy against Lumite, which Lumite could be prejudiced in defending due to its being a joint party to a consolidated proceeding that determined Dandy has senior trademark rights.

Nicolon would not be under a triple burden to produce discovery, as it claims it would be in its Motion. *See* Doc. No. 15 at ¶ 15. Instead, if each Opposer requests similar evidence or

answers, Nicolon would be able to simply copy and paste its answers to each respective Opposer. On the other hand, if the Opposers do seek some different information from Nicolon in discovery, that is likely the result of the above-enumerated reasons why the Opposers would be prejudiced by consolidation, and thus weighs against consolidating the actions. Nicolon has shown it can manage three oppositions without additional effort as it has already filed a number of pleadings in the separate proceedings.

Finally, Nicolon's Motion should be denied as it has not satisfied its burden of showing authority in favor of consolidation. The authority cited by Nicolon is not on point as to whether to consolidate three oppositions between different parties involving different arguments and claims. *New Orleans Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (TTAB 2011), did not involve nor address a motion to consolidate, but instead discussed suspension of another proceeding (which the Board declined to suspend). *World Hockey Assn. v. Tudor Metal Prods. Corp.*, 185 U.S.P.Q. 246, 248 (TTAB 1975) dealt with consolidation because the Applicant and the Opposer were the same in multiple opposition proceedings (i.e. there were not different opposers, as in the case at hand). *Zoba Intl. Corp. v. DVD Format/LOGO Licensing Corp.*, 98 U.S.P.Q.2d 1106, 1115 (TTAB 2011) dealt with a summary judgment motion being determined in relation to three cancellation actions between the same parties. And *S. Industries Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (TTAB 1997) dealt with two cancellations proceedings between the same parties.

B. Nicolon's Motion is Procedurally Defective and Non-Compliant with the Board's Order

In the Board's December 2, 2015 order, the Board required that if Nicolon renewed its Motion to Consolidate it "must be accompanied by a signed statement that the motion has been reviewed in its entirety and concerns matters still disputed between the parties." (Doc. 15, p 2-3).

Nicolon's December 29, 2015 Renewed Motion is almost identical to its initial Motion to Consolidate and does not contain this required statement. Therefore the Renewed Motion should be denied procedurally as non-compliant with the Board's order.

C. In the Alternative, Lumite Requests Additional Discovery and Supplemental Briefing

In the event the Board grants Applicant's Renewed Motion to Consolidate, Opposer requests that the consolidation order allow each Opposer reasonable terms in discovery and pleadings to minimize the potential prejudice the Opposers' abilities to obtain necessary discovery allowable under the Board's Rules of Practice as it relates to issues raised in this independent opposition proceeding.

More particularly, if consolidation is ordered, Lumite requests that the Board's order make clear that consolidation of these three matters in no way prejudices the Opposers' right to seek any discovery vehicles proper under the Board's rules as to this independent opposition proceeding. This could include, for example, allowing each Opposer: (1) the regularly allotted seventy-five (75) interrogatories, (2) separate Requests for Production of Documents as normally permitted under the Rules, (3) separate Requests for Admissions as normally permitted under the Rules, and (4) additional time for depositions or separate depositions, as reasonably necessary.

Further, to the extent the Board is inclined to grant the present Motion, Lumite requests that the Board's order make clear that consolidation of these three matters in no way prejudices the Opposers right to seek reasonable number of pages, above and beyond page limits for single-opposer proceedings, for consolidated briefs filed on behalf of all three Opposers, and the right to file supplemental pleadings and briefs with respect to individual arguments and issues not shared by another Opposer.

CONCLUSION

WHEREFORE, for the reasons set forth more fully above, Lumite respectfully requests this Board deny Applicant's Renewed and Amended Motion to Consolidate. In the alternative, if consolidation is granted, Lumite requests that the Board's consolidation order confirm that consolidation in no way limits or prejudices the parties' ability to: (1) obtain discovery by way of the allowed number Interrogatories, Requests for Production of Documents, Requests for Admissions, and/or Deposition time that would be allotted for Lumite in this independent opposition proceeding; (2) allow a reasonable number of additional pages for briefs filed on behalf of all three Opposers; and (3) allow Lumite the right to file supplemental pleadings and briefs with respect to individual arguments not shared by another Opposer in joint pleadings.

Respectfully submitted this 19th day of January, 2016.

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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Opposer Lumite's Response in Opposition to Applicant's Renewed and Amended Motion to Consolidate has been served on Thomas J. Mango by mailing said copy on 19th day of January, 2016, via First Class Mail, postage prepaid to:

Correspondent: Thomas J. Mango
Address: Cantor Colburn, LLP
20 Church Street, 22nd Floor
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A courtesy copy of the foregoing has been emailed to the Correspondent at the following email address: tmango@cantorcolburn.com, thansen@cantorcolburn.com, jarnold@cantorcolburn.com, cwilkinson@cantorcolburn.com.

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