

ESTTA Tracking number: **ESTTA741634**

Filing date: **04/21/2016**

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

| | |
|------------------------|--|
| Proceeding | 91226201 |
| Party | Plaintiff ICON Health & Fitness, Inc. |
| Correspondence Address | GREGORY M HESS PARR BROWN GEE & LOVELESS PC 101 S 200 E STE 700 SALT LAKE CITY, UT 84111 UNITED STATES ghess@parrbrown.com, lshaw@parrbrown.com |
| Submission | Motion to Consolidate |
| Filer's Name | Gregory M. Hess |
| Filer's e-mail | ghess@parrbrown.com |
| Signature | /Gregory M. Hess/ |
| Date | 04/21/2016 |
| Attachments | Motion to Consolidate Opposition Proceedings.pdf(28281 bytes) |

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

In the Matter of Application Serial No. 86728087 (PRO-FORM 2)

Filed: August 19, 2015

Published for Opposition: December 8, 2015

| | | |
|---------------------------------|---|--|
| ICON HEALTH & FITNESS, INC., |) | |
| |) | Opposition No. 91226201 |
| Opposer, |) | |
| |) | <u>MOTION TO CONSOLIDATE</u> |
| v. |) | <u>OPPOSITION PROCEEDINGS</u> |
| |) | <u>NOS. 91226201 AND 91226202</u> |
| |) | |
| MYCONE DENTAL SUPPLY CO., INC., |) | |
| |) | |
| Applicant. |) | |

Opposer ICON Health and Fitness, Inc. (“ICON”) hereby moves the Board, pursuant to Federal Rule of Civil Procedure 42(a) and TBMP § 511, to consolidate this opposition proceeding and Opposition No. 91226202. The grounds for consolidation are as follows:

1. The parties in Opposition Nos. 91226201 and 91226202 are identical – Opposer ICON and Applicant Mycone Dental Supply Co., Inc.

2. Opposition Nos. 91226201 and 91226202 both involve ICON’s PRO FORM marks and registrations, U.S. Registration Nos. 1,346,441; 1,525,754; 1,718,385; 2,944,885; 4,665,905.

3. Applicant’s alleged marks that are at issue in Opposition Nos. 91226201 and 91226202 are similar to each other, PRO-FORM 2 in Opposition No. 91226201 and PRO-FORM PF2 (and design) in Opposition No. 91226202.

3. The goods covered by Applicant’s challenged applications in Opposition Nos. 91226201 and 91226202 are identical – “Dental instruments for use in protection of mouth and teeth,” in International Class 10; and “Athletic equipment, namely, mouth guards; Mouth guards for athletic use,” in International Class 28.

4. The bases for ICON's opposition in Opposition Nos. 91226201 and 91226202 are identical – a claim of priority and likelihood of confusion under 15 U.S.C. § 1052(d) and a claim of dilution under 15 U.S.C. § 1125(c).

5. ICON's allegations with respect to its claims in Opposition Nos. 91226201 and 91226202 are substantially similar, see ttabvue-91226201-OPP-1 and ttabvue-91226202-OPP-1, and, except for one affirmative defense, Applicant's responses and affirmative defenses are substantially similar, see ttabvue-91226201-OPP-9 and ttabvue-91226202-OPP-9.

6. As a result, Opposition Nos. 91226201 and 91226202 present numerous common questions of law and fact. Moreover, the conferencing, discovery, and trial dates in these two proceedings are identical. See ttabvue-91226201-OPP-8 and ttabvue-91226202-OPP-8.

7. For these reasons, consolidation of Opposition Nos. 91226201 and 91226202 for all phases, including conferencing, discovery, and trial, will result in significant savings in time, effort, and expense for the parties and for the Board, without any prejudice or inconvenience to any party.

Wherefore, Opposer moves the Board to grant this motion and consolidate Opposition Nos. 91226201 and 91226202 for all phases, including conferencing, discovery, and trial.

Dated: April 21, 2016

Respectfully submitted,
PARR BROWN GEE & LOVELESS

/s/ Gregory M. Hess
Gregory M. Hess
LaShel Shaw
PARR BROWN GEE & LOVELESS, P.C.
101 South 200 East, Suite 700
Salt Lake City, Utah 84111
801-532-7840
gness@parrbrown.com
lshaw@parrbrown.com
Attorneys for ICON Health and Fitness, Inc.

CERTIFICATE OF SERVICE

I hereby certify that on April 21, 2016, I caused a true and correct copy of the foregoing Motion for Leave to File Amended Notice of Opposition to be served by United States First Class Mail, postage prepaid, upon the following attorney of record for applicant:

Lisa A. Lori
KLEHR HARRISON HARVEY BRANZBURG LLP
1835 Market Street, Suite 1400
Philadelphia, PA 19103

/s/ Gregory M. Hess