

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: May 8, 2008

Opposition No. 91182589

Cancellation No. 92048912

Vinedos y Bodegas Corpora S.A.

v.

Bodegas Portia, S.L.

Michael B. Adlin, Interlocutory Attorney:

These cases now come up for consideration of: (1) applicant/respondent Bodegas Portia, S.L.'s ("applicant") consented motion to correct office mistake in Cancellation No. 92048912, filed April 21, 2008; and; (2) opposer/petitioner Vinedos y Bodegas Corpora S.A.'s ("opposer") motions on consent for suspension of both Opposition No. 91182589 and Cancellation No. 92048912, filed April 25, 2008 in each proceeding.

Consolidation

Before addressing these motions, a review of the files in each of the above-referenced proceedings reveals that each involves identical parties, similar or identical marks and related or identical issues. When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.

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See Fed. R. Civ. P. 42(a); see also, Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991). In view thereof, Opposition No. 91182589 and Cancellation No. 92048912 are hereby consolidated.

The consolidated cases may be tried and presented on the same record and briefs. See Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618 (TTAB 1989); Hilson Research Inc. v. Society for Human Resource Management, 27 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91182589 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but that copy should bear both proceeding numbers in its caption. **However, because these proceedings are being consolidated before the filing of an answer in Cancellation No. 92048912, applicant must file its answer in the cancellation proceeding (as further discussed below), following which subsequent filings may generally be filed only in the parent case.**

Despite being consolidated, each proceeding retains its separate character. 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.

Motion to Correct Office Mistake and Motions to Suspend

It has come to the attention of the Board that, due to a clerical error by the Patent and Trademark Office, Trademark Registration No. 3346964 (application Serial No. 77075872), for the mark PORTIA PRIMA & Design, was inadvertently issued on December 4, 2007. Accordingly, the consented motion to correct office mistake is **GRANTED** as conceded, see Trademark Rule 2.127(a), and the above-identified application will be referred to the Commissioner for Trademarks for appropriate action.¹

The consented motions to suspend are also hereby **GRANTED**, id., and proceedings in these now-consolidated cases are hereby suspended pending action by the Commissioner for Trademarks. In the event opposer files a notice of opposition against the inadvertently-issued registration after it is returned to pending application status and re-published for opposition, that opposition proceeding will be consolidated with these proceedings. Opposer shall call this case up for appropriate action within **THIRTY DAYS** after it either files a notice of opposition against the application or its time for doing so

¹ The Office of the Commissioner for Trademarks may issue an order cancelling the inadvertently issued registration and restoring the application to pendency. It may also then enter the proposed amendment to the application filed February 28, 2007.

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expires without opposer filing a notice of opposition.

Applicant will then be given time to file its answer in
Cancellation No. 92048912 and discovery, trial and other
dates will be reset.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stndagmnt.htm>
