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

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|------------------------|---|
| Proceeding | 92052531 |
| Party | Plaintiff The United States Playing Card Company |
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

UNITED STATES PLAYING CARD)
COMPANY,)
)
Petitioner,)
)
v.)
)
ANGEL PLAYING CARDS CO., LTD.,)
)
Registrant.)

Cancellation No. 92052531

REPLY IN SUPPORT OF MOTION TO CONSOLIDATE PROCEEDINGS

United States Playing Card Company (“USPC”), submits this reply in support of its Motion to Consolidate Cancellation No. 92052531 with Opposition No. 91190319. Because both proceedings are in the pre-trial discovery stage and because they involve common questions of law and fact with virtually identical pleadings, consolidation is appropriate.

I. ARGUMENT

A. Consolidation of Opposition and Cancellation Proceedings is Appropriate

Applicant Angel Playing Cards Co., Ltd. (“Angel”) first argues that, because the standards for oppositions and cancellations are different, this should preclude consolidation. (Applicant Resp. at 2.) Angel cites no authority supporting this proposition. Its only argument relies on procedural issues relating to the refusal of registration because of registration on the Supplemental Register but not for pending applications. This “standard” envisioned by Angel has no relation to the standard the Board applies when determining whether cancellation or

1 denial of registration would be appropriate. In fact, the Board does consolidate opposition and
2 cancellation proceedings when they involve common questions of law and fact. *See, e.g., 8440*
3 *LLC v. Midnight Oil Co.*, 59 U.S.P.Q.2d 1541 (2001). The Board should therefore disregard
4 Angel’s argument regarding the different standards for oppositions and cancellations and grant
5 consolidation because the proceedings share common questions of law and fact.

6 **B. The Proceedings Are Both Still in the Pre-Trial Stage**

7 Because both the ’319 Opposition and the instant Cancellation are in the pre-trial
8 discovery stage, consolidation would be appropriate. Angel mischaracterizes the status of the
9 ’319 Opposition as “fairly advanced.” (Applicant’s Resp. at 2.) This statement is entirely
10 inaccurate. Both the ’319 Opposition and the instant Cancellation are still in the pre-trial
11 discovery stage, with the parties only recently exchanging written discovery responses in the
12 ’319 Opposition. Furthermore, upon consolidation, the Board will reset the trial dates, as it did
13 when consolidating the ’319 Opposition to provide “the parties the benefit of the longest time.”
14 (TTAB Order at 2, Mar. 24, 2010); *see also Trademark Trial & Appeal Board Manual of*
15 *Procedure* § 511, [hereinafter *TBMP*] (“Upon consolidation, the Board will reset trial dates for
16 the consolidated proceeding, usually by adopting the trial dates as set in the most recently
17 instituted of the cases being consolidated.”). Because the proceedings are at similar stages and
18 because the scheduling dates can be adjusted, consolidation is appropriate.

19 **C. Use of the Mark is Irrelevant to Consolidation**

20 Angel argues that its use of the mark at issue in the instant Cancellation somehow
21 precludes the Board’s ability to consolidate it with the ’319 Opposition. Angel, however, cites
22 no authority for this argument. Furthermore, Angel seems to insinuate that consolidation would
23 deprive this Cancellation of its individual identity and prevent the Board from determining the
24 likelihood of confusion and use in commerce of the mark. Contrary to Angel’s contentions,
25 consolidation will not deprive Applicant of a fair evaluation of each individual mark because
26 “[c]onsolidated cases do not lose their separate identity....Each proceeding retains its separate
27 character and requires entry of a separate judgment.” *TBMP* at § 511. Consolidation, therefore,

1 would not preclude the Board from determining the likelihood of confusion for this mark
2 separate and apart from the other marks.

3 **D. The Proceedings Involve Common Questions of Law and Fact**

4 Fed. R. Civ. P. 42(a), as made applicable by Trademark Rule 2.116(a), provides that the
5 Board may consolidate proceedings pending before it that involve common questions of law and
6 fact. *S. Industries, Inc. v. Lamb-Weston, Inc.*, 45 U.S.P.Q.2d 1293, 1297 (T.T.A.B. 1997). As
7 discussed previously, consolidation will not deprive Applicant of a fair evaluation of each
8 individual mark and therefore, each design will be viewed separately. *See TBMP* at § 511.

9 Furthermore, in the case cited by Applicant to deny consolidation, the applicant and
10 opposer's marks applied to different classes of goods, and though the Board denied
11 consolidation, it did consolidate the record and render one decision applicable to all proceedings.
12 *Envirotech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724, 726-27 (T.T.A.B. 1981). Therefore,
13 because the proceedings here involve common questions of law and fact and because
14 consolidation does not deprive Applicant of a fair determination of the issues relating to each
15 mark, consolidation should be granted.

16 **II. CONCLUSION**

17 USPC therefore respectfully requests that the Board consolidate Cancellation
18 No. 92052531 with the five proceedings that previously were consolidated under parent
19 proceeding Opposition No. 91190319. USPC also requests that, after consolidation, the Board
20 reset the schedule for all these proceedings to the schedule set forth in Cancellation
21 No. 92052531, the last filed of the eight proceedings, with the case schedule revised to allow
22 litigation of the cancellation counterclaims.

1 RESPECTFULLY SUBMITTED this 30th day of August, 2010.

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CERTIFICATE OF SERVICE

I hereby certify that on the 30th day of August, 2010, a true and correct copy of Reply in Support of Motion to Consolidate Proceedings in Cancellation No. 91192531 was duly served upon the Applicant by mailing a copy thereof via the U.S. Postal Service, first-class mail to:

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CERTIFICATE OF FILING

I hereby certify that on August, 2010, I filed this Reply in Support of Motion to Consolidate Proceedings via the ESTTA Filing System of the U.S. Patent and Trademark Office.

DATED this 30th day of August, 2010.

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