

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

am

Mailed: November 8, 2010

Cancellation No. 92052163

King Par, LLC

v.

John S. Franklin

Cancellation No. 92052950

John S. Franklin

v.

King Par, LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

The parties' stipulation (filed October 25, 2010) to consolidate proceedings is hereby granted. See Fed. R. Civ. P. 42(a); and Trademark Trial and Appeal Board Manual of Procedure (TBMP) §511 (2d ed. rev. 2004).

In Cancellation No. 92052163, King Par, LLC pleads its Registration No. 2087314 (DIAMOND for golf clubs) and seeks cancellation of John S. Franklin's Registration No. 3231278 (DIAMOND GOLF for clothing and sporting goods, including golf clubs) on the ground of priority and likelihood of

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confusion.¹ In Cancellation No 92052950, John S. Franklin seeks cancellation of King Par, LLC's Registration No. 2087314 on the ground of abandonment. Answers have been filed in both proceedings. Because the two proceedings have common issues of law and fact, the stipulation to consolidate Cancellation Nos. 92052163 and 92052950 is approved, and Cancellation Nos. 92052163 and 92052950 are hereby consolidated and may be presented on the same record and briefs.

Cancellation No. 92052163 is the "parent" case. Papers should bear the number of each of the consolidated cases in ascending order as shown at the beginning of this order and the parties should file a single copy of each paper only in the parent case. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

The stipulation that the March 4, 2010 scheduling order entered in Cancellation No. 92052163 will be in effect for the consolidated proceeding presents two problems. First, because the parties are in reverse position in the two

¹ The petition to cancel also pleaded King Par, LLC's Registration Nos. 1558172 and 1556973, but those registrations have since expired under Trademark Act Sec. 9 and petitioner's amended petition withdrawing reference to those registrations was accepted.

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proceedings, the usual schedule is inappropriate, and the parties must use a counterclaim schedule which reflects that King Par, LLC is plaintiff as to the priority and likelihood of confusion claim (treated in the schedule as plaintiff), and Mr. Franklin is plaintiff as to the abandonment claim (treated in schedule as counterclaim plaintiff).

Second, according to the March 4, 2010 order in Cancellation No. 92052163 which would be effective for this consolidated proceeding, discovery is scheduled to close November 9, 2010, and in Cancellation No. 92052950, that same date is the deadline for the parties' discovery conference. If the parties have been treating these cases as consolidated and addressed both proceedings in the discovery conference and initial disclosures served in Cancellation No. 92052163, this should have been part of the stipulation. Similarly, if the parties agreed to waive the discovery conference or initial disclosures in Cancellation No. 92052950, this should have been part of the stipulation. Trademark Rule 2.120(a)(2) ("Disclosure deadlines and obligations may be modified upon written stipulation of the parties approved by the Board, or upon motion granted by the Board, or by order of the Board."). While the Board generally accommodates stipulations filed by the parties, in this case the stipulation imposes the wrong type of schedule and has the potential effect of waiving the required initial

disclosures and the opportunity to seek discovery in the cancellation filed by Mr. Franklin.²

Accordingly, proceedings herein are suspended, and the parties are allowed until TEN DAYS to file a stipulation with the Board indicating how the parties have addressed disclosure and discovery issues in Cancellation No. 92052950 (e.g. disclosure and discovery has been completed or waived), and if they wish to adopt the schedule set forth below which incorporates the November 9, 2010 close of discovery, but otherwise employs the counterclaim form which is necessary for this consolidated proceeding.

The parties are free to adopt an alternate schedule for this consolidated proceeding, but it must employ the counterclaim form used below.

Discovery Closes	November 9, 2010
Plaintiff's Pretrial Disclosures	December 24, 2010
30-day testimony period for plaintiff's testimony to close	February 7, 2011
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	February 22, 2011

² The Board notes that Mr. Franklin is acting without counsel. While Patent and Trademark Rule 10.14 permits any person to represent himself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in inter partes proceedings before the Board to secure the services of an attorney who is familiar with such matters. Strict compliance with the Trademark Rules of Practice and, where applicable, the Federal Rules of Civil Procedure, is expected of all parties before the Board. *McDermott v. San Francisco Women's Motorcycle Contingent*, 81 USPQ2d 1212, 1212 (TTAB 2006).

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30-day testimony period for defendant and plaintiff in the counterclaim to close	April 8, 2011
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	April 23, 2011
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	June 7, 2011
Counterclaim Plaintiff's Rebuttal Disclosures Due	June 22, 2011
15-day rebuttal period for plaintiff in the counterclaim to close	July 22, 2011
Brief for plaintiff due	September 20, 2011
Brief for defendant and plaintiff in the counterclaim due	October 20, 2011
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	November 19, 2011
Reply brief, if any, for plaintiff in the counterclaim due	December 4, 2011

Proceedings herein are suspended pending the parties' response to this order.

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