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

Proceeding	92057779
Party	Plaintiff Sony Corporation
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Attachments	SONIFLY- MOTION TO CONSOLIDATE.pdf(417785 bytes)

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

SONY CORPORATION, Petitioner, v. J.W. PEPPER, INC., Registrant.	)	Cancellation Nos. 92057779 and 92057789
SONY CORPORATION, Opposer, v. J.W. PEPPER, INC., Applicant.	)	Opposition No. 91212240

MOTION TO CONSOLIDATE CASES

Petitioner and Opposer, Sony Corporation ("Sony"), by and through its counsel, hereby moves the Trademark Trial and Appeal Board for an order that consolidates the above-reverenced cancellation and opposition proceedings. This motion is made in good faith and for the purpose of saving time, effort and expense, and to conserve the Board's and parties' resources.[1]

[1] Sony notes that its counsel has asked opposing counsel stipulate to the consolidation of these proceedings. Sony's request, however, was declined which necessitated this motion.

A. The marks in issue.

As shown below, Sony's marks in all of these proceedings are identical. J.W. Pepper's marks are for SONIFLY in word mark and design mark forms, and the SONIFLY BEYOND LISTENING design mark, the dominant feature of which is the SONIFLY element.

1. Sony's registered marks involved in these proceedings.

The following registered marks Sony owns have been pled in all proceedings:

a. Registration No. 4313348 for SONY for "broadcasting 2D/3D programs via a global computer network; cable television broadcasting; 2D/3D podcasting services; providing electronic bulletin boards for transmission of messages among users; satellite television broadcasting; streaming of audio material on the Internet; streaming of 2D/3D video material on the Internet; 2D/3D video broadcasting; video-on-demand transmission services; webcasting services; television broadcasting services" in Class 37 and "entertainment services, namely, production of television shows" in Class 41.

b. Registration No. 888316 for SONY for "shirts, jackets" in Class 25.

2. Sony's common law marks.

Sony also has pled common law rights in the following marks:

a. SONY MUSIC

b. SONY PICTURES

c. SONY FINANCIAL SERVICES

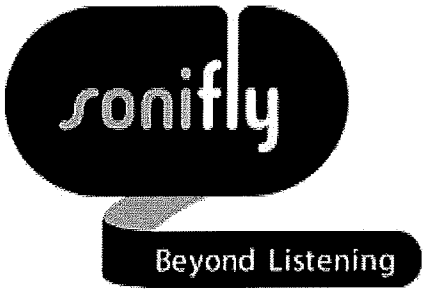
d. SONY ONLINE ENTERTAINMENT

3. J.W. Pepper's marks against which these proceedings have been brought:

a. Cancellation No. 92057779

SONIFLY (a word mark)

b. Cancellation No. 92057789



c. Opposition No. 91212240

Sony also notes that the pleadings in these proceedings are virtually identical.

B. J.W. Pepper's services.

J.W. Pepper's services for each mark Sony challenges are identical. They are: "on-line retail store services featuring downloadable pre-recorded music and videos, ebooks, musical products in the nature of printed sheet music, pre-recorded CDs featuring music, DVDs featuring concerts, music videos, documentaries and television shows featuring musical content, microphones, headphones, cables for connecting musical instruments and microphones to amplification systems and recording hardware, recording gear, controllers, namely, keyboard control surfaces for use in recording and

live audio, interfaces, namely, recording hardware used to connect instruments and microphones to computers, software, namely, digital audio recording software used in the creation and recording of audio, software, namely, music notation software used in the creation of music notation, tuners, metronomes, music stands, and gear used to promote music in the nature of t-shirts, sweatshirts and belt buckles" in Class 35.

ARGUMENT

Consolidation is warranted in these proceedings.

Rule 42(a) F.R.Civ.P. provides:

> If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary cost or delay.

[Emphasis added].

Section 511 TBMP sets forth factors the Board considers in determining whether to consolidate proceedings. One factor is "the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby". Another factor the Board considers is whether the parties are identical. In the subject proceedings, the parties are identical.

In *M.C.I. Foods Inc. v. Bunte,* 86 USPQ2d 1044, 1046 (TTAB 2008), a case involving identical parties and registrations, consolidation was granted. In *S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) consolidation was granted where both proceedings involved the same mark and virtually identical pleadings.

Moreover, a cancellation proceeding and an opposition proceeding may be consolidated, such as the Board did in *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423, 1424 & n. 1 (TTAB 1993).

Here, consolidation of the cases will be advantageous to both parties because it will result in less duplication of effort going forward. No prejudice or inconvenience would be caused by consolidation of the cases, all of which are early in their discovery periods. Rather, consolidation would save both parties time, effort and expense and will conserve the Board's resources (at least because only one interlocutory attorney, not three, will need to be involved in the proceedings).

Based upon the foregoing, Sony respectfully requests that the Board issue an order that grants this motion to consolidate Cancellation Nos. 92057779 and 92057789, and Opposition No. 91212240, and indicates the schedule that will govern all proceedings.

Dated: January 6, 2014

BAKER & HOSTETLER LLP

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing motion was served on January 6, 2014 by first class mail, postage prepaid, in an envelope addressed to opposing counsel as follows:

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