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

Proceeding	92057779
Party	Defendant J.W. Pepper & Son, Inc.
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Submission	Motion to Consolidate
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Date	01/27/2014
Attachments	Registrant's Memorandum of Points and Authorities in Opposition to Petitioner's Motion to Consolidate Cancel. No. 92057779.pdf(2377104 bytes )

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

Sony Corporation v. J.W. Pepper & Son, Inc.

Registration No.: 4,222,713

Registered: October 9, 2012

Mark: SONIFLY

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SONY CORPORATION,	:	
	:	
Petitioner,	:	
	:	
v.	:	Cancel. No.: 92057779
	:	
J.W. PEPPER & SON, INC.,	:	
	:	
Registrant.	:	
	:	

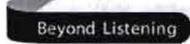
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Hon. Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3514

Attn.: Trademark Trial and Appeal Board

**REGISTRANT'S MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION  
TO PETITIONER'S MOTION TO CONSOLIDATE**

Petitioner Sony Corporation ("Petitioner") seeks to consolidate two cancellation proceedings and one opposition proceeding against J.W. Pepper & Son, Inc.'s ("J.W. Pepper")



registrations for  and SONIFLY and its application



for . As support for its motion, Petitioner asserts that Petitioner's pleaded marks are identical in all three proceedings, that J.W. Pepper's registrations and application share the same services, and therefore, consolidation will enhance judicial economy and efficiency.

While J.W. Pepper concedes that Petitioner's marks and the services listed in each of J.W. Pepper's registrations and application are identical, Petitioner's remaining arguments are not well taken and ignore strong evidence against consolidation. First and most significantly, J.W. Pepper's three marks are each **materially different and distinct marks**. In light of the material differences among J.W. Pepper's marks, the efficiency gains from consolidation would be scant, if any. Indeed, it is arguable that the inconveniences borne of consolidation far outweigh any of the minor efficiency gains outlined by Petitioner. Thus, even if the purported efficiencies were to be realized, the prejudice and inconvenience to the parties provide

a sufficient basis to deny the motion to consolidate these proceedings.

**BACKGROUND**

J.W. Pepper, the leading retailer of sheet music in the world, has been in business for over 130 years, with 11 store locations and 2 distribution centers across the United States.



J.W. Pepper started using the SONIFLY, , and



marks in the United States at least as early as January 17, 2012 in connection with its on-line retail store services.

Petitioner filed Petitions to Cancel against J.W. Pepper's Registration Nos. 4,222,713 for SONIFLY, and 4,222,714 for



. These cancellations were respectively assigned Cancellation Nos. 92057779 and 92057789. On the same day, Petitioner filed a Notice of Opposition on August 29, 2013 against J.W. Pepper's Application No. 85/795,562 for



. This opposition was assigned Opposition No. 91212240.

Petitioner pled Registration Nos. 4,313,348 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; Entertainment services, namely, production of television shows," and 888,316 for SONY for "shirts, jackets," in all three proceedings, along with alleged common law rights in the SONY MUSIC, SONY PICTURES, SONY FINANCIAL SERVICES, and SONY ENTERTAINMENT marks.

#### **ARGUMENT**

Consolidation should be denied due to the prejudice and likely inconvenience that would be caused if Petitioner's motion were granted.

J.W. Pepper's marks in its application and two

registrations, , SONIFLY, and , are three marks with distinguishing characteristics and components.

Perhaps most significantly, J.W. Pepper's  mark contains its unique slogan, "Beyond Listening," a component that

J.W. Pepper's other two marks do not include. The  mark also incorporates an oval containing the stylized depiction of the term "SONIFLY" connected to a banner containing the slogan "Beyond Listening." Additionally, Petitioner's

 mark is characterized by unique stylization that is not included in the SONIFLY word mark, and is different from

the stylization of the term "SONIFLY" in the  mark.

Due to these distinctions among J.W. Pepper's three marks, the substantive grounds of the three proceedings -- dilution under Section 43(c) and likelihood of confusion under Section 2(d) - must be analyzed differently in each of the three proceedings. As such, the consolidation of distinct arguments as to each of the three marks within the confines of one "parent" case will complicate rather than streamline the proceedings and will conflate rather than clarify the issues to be decided. Accordingly, there is no merit to Petitioner's bald assertion that consolidation will "result in less duplication of effort."

TTAB case law supports J.W. Pepper's position that consolidation should be denied. For instance, the Board sustained an applicant's objections to consolidation of allegedly similar marks based on "differences between the design characteristics of the various marks." *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981).

Nor does Petitioner's cited case law support consolidation. In *M.C.I. Foods v. Bunte*, the registered marks were both "STEALTH FRIES." 86 USPQ2d 1044, 1046 (TTAB 2008). *S. Industries Inc. v. Lamb-Weston Inc.* is similarly inapposite, in that the three registered marks were CABO CHIPS, LOS CABO

CHIPS, and EL CABO CHIPS. 45 USPQ2d 1293, 1297 (TTAB 1997). By contrast, each of J.W. Pepper's three marks is distinct and will require its own analysis and consideration with respect to each of Petitioner's claims. In such a circumstance, the cost savings and convenience are de minimis.

**CONCLUSION**

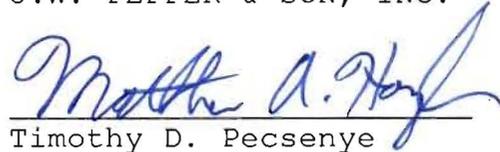
For the foregoing reasons, Petitioner's motion to consolidate should be denied.

Respectfully submitted,

J.W. PEPPER & SON, INC.

Date: January 27, 2014

By:



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Its Attorneys

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CERTIFICATE OF SERVICE

I, Matthew A. Homyk, do hereby certify that I have on this 27th day of January, 2014, mailed by first class United States Mail, postage prepaid, the foregoing REGISTRANT'S MEMORANDUM OF POINTS AND AUTHORITIES IN OPPOSITION TO PETITIONER'S MOTION TO CONSOLIDATE to the following:

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Matthew A. Homyk