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

Proceeding	92060387
Party	Plaintiff PRL USA HOLDINGS, INC.
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Date	12/03/2014
Attachments	Santa Fe Motion to Consolidate.pdf(695594 bytes)

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

PRL USA HOLDINGS, INC. Petitioner, v. FABIAN CLAUDIO OLEMBERG Registrant.	Cancellation No.: Registration No.: Petition Filed:	92059632 4,042,469 June 30, 2014
PRL USA HOLDINGS, INC. Petitioner, v. FABIAN CLAUDIO OLEMBERG Registrant.	Cancellation No.: Registration No.: Petition Filed:	92060387 4,589,994 November 17, 2014

MOTION TO CONSOLIDATE CANCELLATION PROCEEDINGS

Pursuant to TBMP 511, Petitioner PRL USA Holdings, Inc. ("Petitioner") hereby moves to consolidate Cancellations Nos. 92059632 and 92060387 (collectively, the "Petitions") filed by Petitioner in June 2014 and November 2014, respectively. The Petitions seek cancellation of the registrations (collectively, the "Registrations") listed below, both of which are design marks that are nearly identical, cover nearly identical goods and are owned by the same registrant, Fabian Claudio Olemberg ("Registrant").

Cancellation No.	Mark	Reg. No.	Class and ID of Goods and Services
92059632		4,042,469 Registered October 18, 2011	IC 25 shirts and sport shirts
92060387		4,589,994 Registered August 19, 2014	IC 25 men's and boys' apparel, namely, polo shirts, shirts, sport shirts; men's and boys' apparel, namely, t-shirts, sweatshirts, sweaters, shorts, tops

Motions to consolidate should be granted where the proceedings involve common questions of law or fact and a consolidation will save time, effort and expense of both the parties and the Board. TMBP 511. Here, both cancellations involve the same questions of law and fact, namely whether the Registrations, which are for nearly identical marks and cover identical or closely related goods, are confusingly similar to and dilute Petitioner's famous POLO and Polo Player Marks, as defined in the Petitions. Petitioner anticipates that discovery for both proceedings will be substantially the same, as will the evidence presented by the parties.

Consolidation is appropriate because it will be advantageous to both parties and Petitioner is not aware of any prejudice or inconvenience it may cause.

In both Petitions, Petitioner relies on the same sixteen registrations it owned prior to the issuance of the Registrations, namely Regs. Nos. 1,212,060, 1,448,580, 1,485,359, 2,019,947, 2,052,315, 2,085,471, 2,823,094, 3,199,839, 3,470,318, 1,363,459, 1,446,173, 1,468,420, 1,532,557, 2,083,276, 3,684,457 and 3,306,101 for various word and design marks, including several marks using or identical to the word "POLO" and/or the Polo Player Mark to support Petitioner's claims that the continued registration of Registrant's marks will result in consumer confusion and will dilute Petitioner's famous and prior registered POLO and Polo Player Mark. Both Registrations depict a polo player riding a horse and the word "POLO" is a predominant part of both marks. Further, both Registrations cover goods that are identical or related to the goods covered by the registrations relied upon by Petitioner in the Petitions. Finally, the Petitions filed in both proceedings are virtually identical. *See S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (consolidation is proper where both proceedings involved the same mark and virtually identical pleadings).

Registrant filed its answer in Cancellation No. 92059632 on August 25, 2014. The parties have held the required discovery conference and served initial disclosures, however, the parties have not exchanged discovery demands to date. The answer in the second cancellation proceeding, Cancellation No. 92060387 is due on December 28, 2014. Since issue has been joined in one of the cancellations, Petitioner requests that the Board exercise its discretion and consolidate the two cancellations before issue is joined in the other one. *See* TBMP § 511.

Upon consolidation, it is the Board's policy to reset dates for the consolidated proceeding by adopting the dates as set in the most recently institute of the cases being consolidated. TBMP

§ 511. Petitioner therefore requests that the Board reset the disclosure, discovery and trial dates in both proceedings using the schedule in Cancellation No. 92060387 as follows:

Event	**Date**
Time to Answer (92060387 only)	12/28/2014
Deadline for Discovery Conference	1/27/2015
Discovery Opens	1/27/2015
Initial Disclosures Due	2/26/2015
Expert Disclosures Due	6/26/2015
Discovery Closes	7/26/2015
Petitioner's Pretrial Disclosures	9/9/2015
Petitioner's 30-day Trial Period Ends	10/24/2015
Registrant's Pretrial Disclosures	11/8/2015
Registrant's 30-day Trial Period Ends	12/23/2015
Petitioner's Rebuttal Disclosures	1/7/2015
Petitioner's 15-day Rebuttal Period Ends	2/6/2015

Petitioner further requests that Cancellation No. 92059632 be stayed pending the determination of this instant motion.

For the foregoing reasons, Petitioner requests that Board stay Cancellation No. 92059632 pending this motion, consolidate both proceedings and reset the deadlines in the consolidated cancellations as set forth above.

Dated: December 3, 2014

Respectfully submitted,

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CERTIFICATE OF SERVICE

The undersigned certifies that on December 3, 2014 a true and correct copy of the foregoing document was served by email on the following:

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