

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

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Mailed: December 7, 2015

Cancellation No. 92061413
(parent case)

Cancellation No. 92062224

Emm. Kokologiannis and Sons, Societe
Anonyme of Trade, Hotels and
Tourism S.A.

v.

Proveedores y Soluciones DAC S.A.

By the Board:

The two captioned cancellation proceedings are before the Board for consideration of

- 1) the July 30, 2015 motion to dismiss counterclaims, filed by Emmanouil Kokologiannis and Sons, Societe Anonyme of Trade, Hotels and Tourism S.A. (“Kokologiannis”) in Cancellation No. 92061413;
- 2) the August 3, 2015 motion to suspend filed by Proveedores y Soluciones DAC S.A. (“Proveedores”) in Cancellation No. 92061413; and
- 3) the October 23, 2015 motion to suspend filed by Proveedores in Cancellation No. 92062224.

Sua sponte consolidation

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. Fed. R. Civ. P.

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42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, *supra*; *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991).

Provedores is the record owner of the two involved registrations in Cancellation Nos. 92061413¹ and 92062224, which are, respectively:

- 1) Registration No. 3786010, issued May 4, 2010, for the mark ECONOMY RENT A CAR and design (shown below; RENT A CAR disclaimed) for “car rental; car rental, garage and parking space rental; rental car reservation; rental of cars; rental of vehicles; vehicle rental; car leasing; vehicle leasing” in International Class 39; and



- 2) Registration No. 3846482, issued September 7, 2010, for the mark ECONOMY and design (shown below) for “rental car, truck, van and sport utility vehicle reservation services” in International Class 39.



Kokologiannis filed petitions:

¹ The Board notes Proveedores' returned copy of the May 4, 2015 order instituting Cancellation No. 92061413. Inasmuch as the party now has counsel of record, the issue of nondelivery is moot.

- 1) to cancel Registration No. 3786010 on the grounds of a) mere descriptiveness under Trademark Act § 2(e)(1), b) priority and likelihood of confusion under Trademark Act § 2(d), and c) fraud on the USPTO; and
- 2) to cancel Registration No. 3846482 on the grounds of a) mere descriptiveness under Trademark Act § 2(e)(1), and b) priority and likelihood of confusion under Trademark Act § 2(d).

In both proceedings, Kokologiannis pleads common law rights, and ownership of Trademark Act § 66(a) Registration No. 3256667 ECONOMY CAR RENTALS RENTAL-HIRE-RENT A CAR-AUTOVERMIETUNG-MIETWAGEN and design (shown below; ECONOMY CAR RENTALS RENTAL-HIRE-RENT A CAR AUTOVERMIETUNG- MIETWAGEN disclaimed), issued June 26, 2007, which covers “transport by car, organization of travel, car rental services” International Class 39.



In Cancellation No. 92061413, Proveedores filed a counterclaim to cancel Kokologiannis’ Registration No. 3256667 on the grounds of 1) fraud on the USPTO, and 2) abandonment.

The parties to Cancellation Nos. 92061413 and 92062224 are identical, the marks in which Kokologiannis pleads rights are identical, Proveedores’

involved marks are similar, and Kokologiannis' claims based on Trademark Act §§ 2(d) and 2(e)(1) overlap.²

The Board finds that consolidation is appropriate. Cancellation Nos. 92061413 and 92062224 are hereby consolidated and may be presented on the same record and briefs. *Hilson Research Inc. v. Society for Human Resource Management, supra*; and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Cancellation No. 92061413 as the "parent case." From this point forward, the parties shall file only a single copy of all motions, briefs and papers in the "parent case" only, and shall caption all filings as styled above, namely, listing the consolidated proceeding numbers, and identifying the parent case.

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Kokologiannis' motion to dismiss counterclaims

² The Board notes that in the May 4, 2015 order instituting Cancellation Nos. 92061413, as well as the September 11, 2015 order instituting Cancellation No. 92062224, the Board directed the parties to immediately notify it of any other proceeding(s) involving the same or related marks such that the issue of consolidation could be considered.

Kokologiannis filed an answer to the counterclaims, as well as a motion to dismiss and to strike them, citing Fed. R. Civ. P. 12(b)(6) and 12(f), respectively. Inasmuch as the motion is not based on the sufficiency of the counterclaim pleading, but rather that it is duplicative or redundant, the Board construes this as a motion to strike matter from a pleading pursuant to Fed. R. Civ. P. 12(f).

The Board may strike from a pleading any insufficient defense, or any redundant, immaterial, impertinent or scandalous matter. *See* Fed. R. Civ. P. 12(f); TBMP § 506 (2015); *American Vitamin Products, Inc. v. Dow Brands Inc.*, 22 USPQ2d 1313, 1314 (TTAB 1992); *S.C. Johnson & Son, Inc. v. GAF Corp.*, 177 USPQ 720 (TTAB 1973). Also, the Board has the authority to strike an impermissible or insufficient claim, or portion of a claim, from a pleading. *See* TBMP § 506.01 (2015). A defense will not be stricken as insufficient if the insufficiency is not clearly apparent, or if it raises factual issues that should be determined on the merits. *Id.*

Kokologiannis moves to strike the counterclaim for fraud on the basis that it is a compulsory counterclaim in Cancellation No. 92055558, citing Trademark Rule 2.114(b), and arguing that Proveedores, through its alleged related company Economy Rent-A-Car, Inc. could have brought the fraud claim in that proceeding.

The compulsory counterclaim rule of Trademark Rule 2.114(b) does not apply as to Cancellation No. 92055558 inasmuch as the entity alleged to be related to Proveedores - Economy Rent-A-Car, Inc. - is plaintiff, not defendant, in that proceeding. Furthermore, in Cancellation No. 92061413, Proveedores, not

Economy Rent-A-Car, Inc., has pleaded the counterclaim for fraud. In view of these findings, Kokologiannis' motion is denied as to this counterclaim.

Kokologiannis moves to strike the abandonment counterclaim on the basis that it was already raised in, and is duplicative of, the abandonment claim raised in Cancellation No. 92055558, and that allowing the same abandonment claim in the counterclaim could lead to inconsistent judgments.

In the abandonment claim in Cancellation No. 92055558, Economy Rent-A-Car, Inc. alleges that Kokologiannis “renders no transportation and/or car rental services in the United States and has never rendered such services in the United States before or subsequent to the date of acquiring ownership of Reg. No. 3,256,667 on June 26, 2007” and that “nonuse of the mark for transportation and car rental services... for more than three years subsequent to the date of such registration, with no intent to make such use, amounts to an abandonment of the mark...in connection with such services.”³ In the June 11, 2015 counterclaim for abandonment in Cancellation No. 92061413, Proveedores alleges that Kokologiannis “ceased use of the mark set forth in the ‘667 registration more than three years ago and did so with no intention to resume use of the mark as it was actually registered by the Trademark Office. Such nonuse, with no intent to resume use, amounted to an abandonment of the mark.”⁴

In Cancellation No. 92061413, in response to the motion to dismiss, Proveedores states that it “does not concede the claim of ‘privity’” between it and

³ Cancellation No. 92055558, 10 TTABVUE 3-4; amended pet. to cancel, para. 4-5.

⁴ Cancellation No. 92061413, 4 TTABVUE 7.

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Economy Rent-A-Car, Inc.,⁵ repeatedly refers to that entity as its licensee,⁶ and does not directly respond to Kokologiannis' contention that the abandonment counterclaim is duplicative.

Provedores' counterclaim for abandonment is duplicative of the abandonment claim brought by Economy Rent-A-Car in Cancellation No. 92055558. In view thereof, Kokologiannis' motion is granted as to this counterclaim, and in Cancellation No. 92061413 Provedores' counterclaim to cancel Registration No. 3256667 on the ground of abandonment is stricken as redundant. Fed. R. Civ. P. 12(f).

Provedores' motions to suspend

The Board notes Provedores' August 3, 2015 motion to suspend Cancellation No. 92061413 pending disposition of Cancellation No. 92055558, and its October 23, 2015 motion to suspend Cancellation No. 92062224 pending disposition of Cancellation Nos. 92055558 and 92061413. The Board has reviewed the record of both parties' submissions on the issue of suspension, but does not restate each of their arguments herein.

It is the policy of the Board to suspend proceedings when the parties are involved in an action, which may be dispositive of or may have a bearing on the Board case. Trademark Rule 2.117(a) provides:

Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing

⁵ Cancellation No. 92061413, 9 TTABVUE 4.

⁶ Cancellation No. 92061413, 9 TTABVUE 5.

on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

The Board may, in its discretion, suspend a proceeding pending, *inter alia*, the final determination of another Board proceeding in which the parties are involved, or another proceeding action in which only one of the parties is involved. TBMP 510.02(a) (2015).

The Board has consolidated Cancellation Nos. 92061413 and 92062224 based on the identity of parties, and similarity of the issues therein. In Kokologiannis' motion to dismiss or strike the counterclaim in Cancellation No. 92061413, it states, and relies in part on its assertion that Proveedores and Economy Rent-A-Car, Inc. (Petitioner in Cancellation No. 92055558) are related companies and are in privity through common control,⁷ and restates that they are related companies in its answer to the counterclaim filed by Proveedores.⁸ In its brief in opposition to the motion to dismiss, Proveedores states that Economy Rent-A-Car, Inc. is an authorized licensee of Proveedores.⁹

In view of this record, because the similarity of issues of law and fact indicates that the proceedings should be decided together, and to avoid inconsistent outcomes in these proceedings, suspension of Cancellation No. 92055558 is appropriate. Accordingly, Cancellation No. 92055558 is

⁷ Cancellation No. 92061413, 6 TTABVUE 3-4.

⁸ Cancellation No. 92061413, 7 TTABVUE 3.

⁹ Cancellation No. 92061413, 9 TTABVUE 3.

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suspended pending trial and final briefing of Cancellation Nos. 92061413 and 92062224.¹⁰

Accordingly, Proveedores' motions to suspend Cancellation No. 92061413 and 92062224 are denied.¹¹

Schedule

Proceedings in Cancellation Nos. 92061413 and 92062224 are resumed, and the consolidated proceedings shall proceed on the following reset schedule:

Deadline for Required Discovery Conference	1/6/2016
Discovery Opens	1/6/2016
Initial Disclosures Due	2/5/2016
Expert Disclosures Due	6/4/2016
Discovery Closes	7/4/2016
Plaintiff's Pretrial Disclosures Due	8/18/2016
Plaintiff's 30-day Trial Period Ends	10/2/2016
Defendant's Pretrial Disclosures Due	10/17/2016
Defendant's 30-day Trial Period Ends	12/1/2016
Plaintiff's Rebuttal Disclosures Due	12/16/2016
Plaintiff's 15-day Rebuttal Period Ends	1/15/2017

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. Briefs shall

¹⁰ Pursuant to Trademark Rule 2.128(a)(1), in Cancellation No. 92055558 the due date for the filing of a reply brief has passed; accordingly, that proceeding is briefed on the merits.

¹¹ The Board considered Kokologiannis' arguments in contesting the motions to suspend. The arguments are either incorrect or inapposite. Of note, all three cancellation proceedings involve a § 2(d) claim, and the existence of claims in addition to the § 2(d) claims does not lead to the conclusion that the proceedings "could not be more different," as Kokologiannis asserts at page 3 of its brief. Furthermore, the Board notes the inconsistency between Kokologiannis' argument, on its motion to strike, that Economy Rent-A-Car, Inc. and Proveedores are related, and its argument contesting the motion to suspend that the parties are "different."

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be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.