

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

CME

Mailed: July 25, 2016

Cancellation No. 92062379 (Parent)
Cancellation No. 92062380

D.B.C. Corporation

v.

Nucita Venezolana, C.A.

Christen M. English, Interlocutory Attorney:

On June 13, 2016, Petitioner filed in each of the above-captioned proceedings a motion to consolidate, a motion for leave to amend, and a motion to suspend and extend (the “June 13, 2016 Motions”).¹ In the June 13, 2016 Motions, Petitioner indicated that Respondent, through its prior counsel, consented to the motions to consolidate and for leave to amend on May 18, 2016, but that Respondent’s new counsel, appointed May 20, 2016,² did not respond to Petitioner’s email of May 27, 2016 attempting to confirm Respondent’s consent. Respondent did not oppose the June 13, 2016 Motions; however, on July 6, 2016, Petitioner filed a paper stating that Respondent “does not consent” to the June 13, 2016 Motions, but will consent to a 45-day

¹ The June 13, 2016 Motions include overlapping arguments, and therefore, should have been filed as one combined motion.

Petitioner’s change of correspondence address, filed June 13, 2016, is noted and the Board’s records have been updated accordingly.

² Respondent filed an entry of appearance of new counsel on May 20, 2016.

extension of deadlines. Cancellation No. 92062379 at 13 TTABVUE 2 and Cancellation No. 92062380 at 12 TTABVUE 2.

Accordingly, rather than grant Petitioner's motions to consolidate and for leave to amend as conceded, the Board treats the motions on their merits. The Board also treats Petitioner's consented motion to extend, filed July 6, 2016, as superseding its unconsented motion to suspend and extend, filed June 13, 2016. As such, the latter motion will be given no further consideration.

Motion to Consolidate

Petitioner seeks to consolidate Cancellation No. 92062379, involving the mark

pirucream

for "cookies,"³ with Cancellation No. 92062380 involving the mark PIRUCREAM, in standard character form, also for "cookies."⁴ In both cancellation actions, Petitioner alleges a claim of likelihood of confusion based on prior common law use and registration of the mark PIROULINE, among other marks, for confectionary products.

When cases involving common questions of law and fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a). Inasmuch as the parties to Cancellation Nos. 92062379 and 92062380 are the same and the proceedings involve common questions of law and fact, consolidation will avoid

³ Registration No. 4732480; filed November 11, 2013; issued May 5, 2015.

⁴ Registration No. 4732479; filed November 11, 2013; issued May 5, 2015.

duplication of effort concerning the factual issues, and therefore, will avoid unnecessary costs and delays. Accordingly, Petitioner's motion to consolidate is GRANTED, and the proceedings are consolidated and may be presented on the same record and briefs. See *Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424, n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619, n.1 (TTAB 1989).

The record will be maintained in Cancellation No. 92062379 as the "parent" case. The parties should no longer file separate papers or submissions in connection with each proceeding,⁵ but instead should file only a single copy of each submission in the parent case. Each submission should bear the case caption set forth above and the parent case should be designated as such by following the case number with: "(parent)."

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The single decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. See *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

Motion for Leave to Amend

At this stage in the proceeding, Petitioner may amend its petitions to cancel only by the written consent of Respondent or by leave of the Board. See Fed. Civ. P. 15(a);

⁵ There is one exception. A separate complaint and answer must be filed in each proceeding.

TBMP § 507.02(a) (2016). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law or be prejudicial to the rights of the adverse party or parties. *See* TBMP § 507.02; *see also Am. Optical Corp. v. Am. Olean Tile Co.*, 168 USPQ 471, 473 (TTAB 1971). In deciding whether to grant leave to amend, the Board may consider undue delay, prejudice to the opposing party, bad faith or dilatory motive, futility of the amendment and whether the party has previously amended its pleading. *See Foman v. Davis*, 371 U.S. 178, 182 (1962).

“[T]he concept of ‘undue delay’ is inextricably linked with the concept of prejudice to the non-moving party[.]” *See Marshall Field & Co. v. Mrs. Field Cookies*, 11 USPQ2d 1355, 1359 (TTAB 1989). Here, Petitioner merely seeks to correct a typographical error and amplify an existing allegation by pleading the registration that has matured from pleaded application Serial No. 86666835. *Space Base Inc. v. Stadis Corp.*, 17 USPQ2d 1216, 1217 (TTAB 1990) (allowing amendment to complaint during testimony period to add newly issued registration). Allowing such amendments would not result in the type of prejudice that would warrant denying a motion for leave to amend, *e.g.* where the delay in moving for leave to amend denies the non-moving party an adequate opportunity to prepare its case on the new issues raised by the amended pleading or results in the loss of valuable evidence or an important witness becoming unavailable. *Trek Bicycle Corp. v. Styletrek Ltd.*, 64 USPQ2d 1540, 1541 (TTAB 2001). Moreover, as set forth herein, discovery remains open such that Respondent will have an opportunity to conduct discovery on the issues raised in the

amended pleading, if desired. *Commodore Elecs. Ltd. v. CBM Kabushiki Kaisha*, 26 USPQ2d 1503, 1505-06 (TTAB 1993) (no undue delay where discovery still open); *Microsoft Corp. v. Qantel Bus. Sys. Inc.*, 16 USPQ2d 1732, 1733-34 (TTAB 1990) (proceeding still in the discovery stage and no undue prejudice shown).

In addition there is no evidence of bad faith or dilatory motive on the part of Petitioner in seeking to amend its pleadings, and this is the first time that Petitioner has sought leave to amend. See *Am. Express Mktg. & Dev. Corp. v. Gilad*, 94 USPQ2d 1294 (TTAB 2010) (finding no abuse of amendment privileges where applicant sought to amend its pleading for the first time). Lastly, amendments to amplify or correct allegations set forth in an original pleading are permissible. *Avedis Zildjian Co. v. D.H. Baldwin Co.*, 180 USPQ 539, 541 (TTAB 1973).

In view of the foregoing, Petitioner's motion for leave to amend is GRANTED, and Petitioner's [proposed] amended consolidated petition attached to its motions for leave to amend⁶ is accepted and is now Petitioner's operative pleading in these consolidated proceedings. Respondent is allowed until August 14, 2016 to file an answer to the amended consolidated petition.⁷

Motion to Extend

Petitioner's consented motion to extend, filed July 6, 2016, is GRANTED, and dates are reset in accordance with Petitioner's motion as follows:

Expert Disclosures Due	7/26/2016
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⁶ See Cancellation No. 92062379 at 9 TTABVUE 25-37 and Cancellation No. 92062380 at 9 TTABVUE 12-24.

⁷ Pursuant to footnote 5, Respondent must file a copy of its answer in each proceeding.

Deadline to Answer Amended Consolidated Petition to Cancel	8/14/2016
Discovery Closes	8/25/2016
Plaintiff's Pretrial Disclosures Due	10/9/2016
Plaintiff's 30-day Trial Period Ends	11/23/2016
Defendant's Pretrial Disclosures Due	12/8/2016
Defendant's 30-day Trial Period Ends	1/22/2017
Plaintiff's Rebuttal Disclosures Due	2/6/2017
Plaintiff's 15-day Rebuttal Period Ends	3/8/2017

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 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.
