

ESTTA Tracking number: **ESTTA1052675**

Filing date: **05/01/2020**

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

Proceeding	86882884
Applicant	Elasticsearch BV
Applied for Mark	ELASTIC
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Submission	Appellant Motion to Consolidate and Suspend Proceedings
Attachments	Appellant Motion to Consolidate and Suspend Proceedings.pdf(135014 bytes)
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Date	05/01/2020

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) Serial Nos. 86882896
In re Elasticsearch BV,) 86882888
) 86882884
Applicant-Appellant.) 86882881
) 86882878
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APPELLANT’S MOTION TO CONSOLIDATE AND SUSPEND PROCEEDINGS

Pursuant to Federal Rule of Civil Procedure 42(a) and TBMP §§ 511, 1209.01 and 1213, Applicant-Appellant Elasticsearch BV (“Elastic”) moves for an order consolidating Appeal Proceeding Nos. 86882896, 86882888, 86882884, 86882881 and 86882878 (the “Appeals”) and suspending the proceedings pending resolution of the Office Actions recently issued by the Examining Attorney.

The Board may consolidate multiple proceedings where they involve common questions of fact and law. Fed. R. Civ. P. 42(a); TBMP § 511. In determining whether to consolidate proceedings, the Board weighs the savings in time, effort and expense which may be gained from consolidation against any prejudice or inconvenience which may be caused thereby. TBMP § 511. Moreover, the Board may suspend an appeal “upon written request by the applicant showing good cause for the requested suspension.” TBMP § 1213. For example, “[i]f, during an ex parte appeal to the Board, it appears to the Board that an issue not previously raised may render the mark of the applicant unregistrable, the Board may issue a written action suspending

the appeal and remanding the application to the examining attorney for further examination with respect to that issue.” TBMP § 1209.01.


The Appeals all involve common questions of fact and law. In particular, the Appeals all involve the issue of whether the mark ELASTIC has acquired distinctiveness. If these Appeals are not consolidated, Elastic and the Examining Attorney will have to enter repetitive evidence in separate cases, file repetitive sets of briefs, and prepare for and attend separate hearings on similar issues. On the other hand, consolidation of the Appeals would result in a significant savings of time and expense, since Elastic and the Examining Attorney will be filing only one set of briefs and preparing for and attending only one hearing. Neither Elastic nor the Examining Attorney will be prejudiced by consolidation.

The Appeals should be suspended because the Examining Attorney has now issued a non-final office actions on the key issue – whether Applicant has acquired distinctiveness in its ELASTIC mark. In particular, on April 20, 2020, the Examining Attorney withdrew her denials of requests for reconsideration and issued supplemental, non-final office actions to the applications, granting Elastic six months from the issue date to address the Examining Attorney’s objections.

Elastic therefore respectfully requests the Board to grant its motion and remand the applications to the Examining Attorney for further examination.

Dated: May 1, 2020

WILSON SONSINI GOODRICH & ROSATI
A Professional Corporation

By: 
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