

TTAB

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04-23-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #74

Brian P. O'Donnell

Name of applicant, assignee, or Registered Rep.

Brian O'Donnell
Signature

4/21/03
Date

Docket No.: 41196-10675

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

MILTON SALES, INC.

Opposer,

v.

UNIVERSAL MANUFACTURING
COMPANY, INC.

Applicant.

)
) Opposition No.: 91153705

)
) Serial No.: 76/335,302

)
) Mark: RACE FOR CASH

TRADEMARK TRIAL AND
APPEAL BOARD
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MOTION TO CONSOLIDATE

Pursuant to Fed. R. Civ. P. 42(a) and TBMP § 511, Universal Manufacturing Company, Inc. ("Applicant") hereby moves to consolidate proceedings in Opposition No. 91153705 with proceedings in Opposition Nos. 91154237, 91154459, 91154650, 91155391, 91155450 and Cancellation No. 92041773. In support of its motion, Applicant states as follows:

1. On October 16, 2002, Opposer filed a Notice of Opposition to registration of Applicant's mark RACE FOR CASH, Serial No. 76/335,302. On October 30, 2002, Opposer filed a Motion to Amend Notice of Opposition and an Amended Notice of Opposition and Opposition No. 91153705 was instituted on December 4, 2002.

2. On October 16, 2002, Opposer filed a Notice of Opposition to registration of Applicant's mark BULL DOG, Serial No. 76/335,343. On October 30, 2002, Opposer filed a Motion to Amend Notice of Opposition and an Amended Notice of Opposition and Opposition No. 91154237 was instituted on January 7, 2003.

3. On October 16, 2002, Milton Sales, Inc. ("Opposer") filed a Notice of Opposition to registration of Applicant's mark BOSS HOG, Serial No. 76/335,344. On November 5, 2002, Opposer filed a Motion to Amend Notice of Opposition and an Amended Notice of Opposition and Opposition No. 91154459 was instituted on January 15, 2003.

4. On October 16, 2002, Opposer filed a Notice of Opposition to registration of Applicant's mark RACING FOR CASH, Serial No. 76/334,453. On October 30, 2002, Opposer filed a Motion to Amend Notice of Opposition and an Amended Notice of Opposition and Opposition No. 91154650 was instituted on January 28, 2003.

5. On October 16, 2002, Opposer filed a Notice of Opposition to registration of Applicant's mark DOUBLE PECKERS, Serial No. 76/335,301 and Opposition No. 91155391 was instituted on March 6, 2003.

6. On November 7, 2002, Applicant filed a Notice of Opposition to registration of Opposer's mark THE HOG, Serial No. 76/375,562 and Opposition No. 91155450 was instituted on March 10, 2003.

7. On March 5, 2003, Opposer filed a Petition for Cancellation of Registrant's registration of the mark SPEEDY, Reg. No. 2,674,475 and Cancellation No. 92041773 was instituted on March 21, 2003.

8. In each of Opposition Nos. 91153705, 91154237, 91154459, 91154650, 91155391, 91155450 and Cancellation No. 92041773 Applicant has filed Motions to Suspend

pending resolution of Civil Action No. 2:01-01046 filed by Opposer on November 16, 2001 in the U.S. District Court for the Southern District of Virginia ("West Virginia action").

9. Opposer alleged in its complaint filed in the West Virginia action that it "provided and continued to provided products and services in West Virginia and outside West Virginia under" the trademarks BOSS HOG, BULL DOG, SPEEDY, and CASH RACE, (as well as other marks not the subject of the instant Opposition) and further alleged that Applicant engaged in *inter alia*, federal and common law trademark infringement, federal unfair competition, unlawful practices, tortious interference with business relationship and breach of contract. *See* Ex. 2 to Applicant's Motion to Suspend filed in Opposition Nos. 91153705, 91154237, 91154459, 91154650 and Cancellation No. 92041773.

10. On December 18, 2001, Applicant filed its Answer in the West Virginia action denying Opposer's allegations. Applicant also filed counterclaims for declaratory relief alleging *inter alia*, that an actual controversy exists between Applicant and Opposer over ownership of the (1) BOSS HOG, (2) BULLDOG, (3) SPEEDY, (4) CASH RACE, and (5) RACING FOR CASH trademarks. *See* Ex. 3 to Applicant's Motion to Suspend filed in Opposition Nos. 91153705, 91154237, and 91154650.

11. In its Reply to Counterclaims filed in the West Virginia action on January 7, 2002, Opposer denied Applicant's allegations. Opposer further asserted in its Affirmative Defenses that it "is the owner of the marks [including BOSS HOG, BULLDOG, SPEEDY, CASH RACE, and RACING FOR CASH] . . . alleged in the Counterclaims." *See* Ex. 4 to Applicant's Motion to Suspend filed in Opposition Nos. 91153705, 91154237, and 91154650.

12. Furthermore, ownership of the mark DOUBLE PECKERS and Opposer's use of THE HOG mark was discussed in connection with settlement discussions between Applicant and Opposer in the West Virginia action.

13. As indicated in ¶¶ 9-12 above, Opposition Nos. 91153705, 91154237, 91154459, 91154650, 91155391 and 91155450 and Cancellation No. 92041773 should be consolidated because they involve the same parties and common questions of law and fact. *Regatta Sport Ltd. v. Telux-Pioneer, Inc.*, 20 U.S.P.Q.2d 1154, 1156 (T.T.A.B. 1991)(Board may order the consolidation of cases when they involve common questions of law or fact).

14. In determining whether to consolidate proceedings, the Board also weighs the savings in time, effort, and expense which may be gained from consolidation, against any prejudice or inconvenience which may be caused thereby. *No Fear, Inc. v. Victor Des Prez*, 1997 TTAB LEXIS 140, *11 (T.T.A.B. November 4, 1997); TBMP § 511.

15. In each of Opposition Nos. 91153705, 91154237, 91154459, 91154650, and 91155391 and Cancellation No. 92041773, Opposer makes virtually identical allegations in its Notices of Opposition and Petition for Cancellation and Applicant has responded to those allegations with virtually identical responses. Moreover, in each of Opposition Nos. 91153705, 91154237, 91154459, 91154650, 91155391 and 91155450, Opposer has served virtually identical interrogatories, document requests and requests for admissions (with respect to Cancellation No. 92041773, neither Applicant nor Opposer has yet served discovery).

16. Furthermore, Opposer will not be prejudiced or inconvenienced by consolidation because all proceedings are in their early stages, with the discovery period having only recently begun.

17. It is, therefore, clear that many, if not all, of the discovery issues and much of the evidence at trial will be the same in all proceedings and consolidation will result in a savings of *significant* time, effort and expense by the Board. *See No Fear, Inc. v. Victor Des Prez*, 1997 TTAB LEXIS 140, *11-12 (T.T.A.B. November 4, 1997); TBMP § 511.


In the interest of judicial economy and consistent with the Board's discretionary authority to regulate its own proceedings to avoid duplicating the effort of the court and the possibility of reaching an inconsistent conclusion, Applicant respectfully requests that its Motion to Consolidate be GRANTED and that Opposition No. 91153705 be consolidated with proceedings in Opposition Nos. 91154237, 91154459, 91154650, 91155391, 91155450 and Cancellation No. 92041773.

Date: April 21, 2003

Respectfully submitted,

UNIVERSAL MANUFACTURING COMPANY

By:



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CERTIFICATE OF SERVICE

I, Brian P. O'Donnell, attorney for Applicant, hereby certify that a copy of this MOTION TO CONSOLIDATE, which was filed with the TTAB on April 21, 2003, a copy of which is attached, was duly served upon Bruce A. Tassan, Tassan Law Firm, 4143 North 27th Street, Arlington, VA 22207-5211, attorney for Opposer, by First Class Mail, postage prepaid, on April 21, 2003.

Brian O'Donnell
