UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

JST

Mailed: February 3, 2004

Opposition Nos. 91120820; 91120842; and 91155782

Johnson Publishing Company, Inc.

v.

Industria De Deseno Textil, S.A.
(as consolidated)

Jyll S. Taylor, Attorney:

On January 28, 2004, applicant, through counsel, requested telephone disposition of opposer's motion (filed January 10, 2004) to suspend these proceedings pending examination and publication of applicant's application Serial No. 78/301068. The Board agreed to hear applicant's response by telephone and instructed applicant to inform opposer of the time and date of the telephone conference, to make appropriate arrangements for the call, and to fax confirmation of the arrangements to the Board. Instead of fax confirmation, on February 2, 2004, in a joint telephone call by the parties' counsel, the date and time for the telephone conference was set for February 3, 2004 at 11:15am EST.

On February 3, 2004 at approximately 11:15am EST, the Board held a telephone conference between Erik Bertin and Glenn Gundersen, counsel for applicant; John Filosama, counsel for opposer; and Jyll Taylor, as the Board attorney responsible for resolving interlocutory matters in this case.

As an initial matter, the Board noted that the parties are treating this proceeding as a consolidated one prior to Board approval of applicant's consented motion (filed October 8, 2003) to consolidate.[1] The Board advised the parties to wait for Board approval of motions to consolidate in the future and granted the motion to consolidate (as more fully set forth *infra*).

Turning to opposer's motion to suspend, opposer seeks to suspend these consolidated proceedings pending the publication for opposition of applicant's application Serial No. 78/301068 because it intends to file an opposition against that application. As support for the motion, opposer argues that, as applicant agreed when it filed the [above-noted] motion to consolidate, consolidation is appropriate when multiple proceedings involve the same parties, the same legal and factual arguments and the same evidence; that the "intended" opposition would involve the

[1] By that motion, the parties seek to consolidate Opposition Nos. 91120820, 91120842, and 91155782.

same legal and factual arguments and the same evidence; that there would be no prejudice to either party as the consolidated opposition is still in the discovery phase; and that any additional delay would not cause any prejudice to applicant. For those reasons, opposer maintains that suspension is appropriate to avoid piecemeal and protracted litigation that would unnecessarily expend the Board's and the parties' resources.

In an oral response, applicant, through counsel, argued that the motion to suspend should not be granted because it was inappropriately filed during the pendency of applicant's motion to compel. Applicant further argues that the discovery period is set to close on March 5, 2004 and that the completion of discovery would be delayed if the motion were granted. Applicant also argues that application Serial No. 78/301068 has not been assigned to an Examining Attorney and that there is no guarantee that the Examining Attorney would pass the application to publication.

In an oral reply, opposer, through counsel, argued that suspension would give the parties an opportunity to have all of the United States proceedings decided in a cost efficient manner, using the least amount of party and judicial resourses. Opposer further argues that the motion to suspend is proper because it is germane to the motion to

compel and that it is willing to agree to an extension of the discovery period so that discovery could be completed.

As noted by opposer, the Board may suspend these proceedings for good cause shown. See Trademark Rule 2.117(c). Opposer has based its good cause showing on the need to consolidate an "intended" proceeding with this one. As set forth in Fed. R. Civ. P. 42(a), when actions involving a common question of law or fact are pending before the Board, the Board may order all the actions consolidated to avoid unnecessary costs and delays. However, consolidation is ordered only after weighing the savings in time effort and expense against the prejudice or inconvenience that would be caused by consolidation. TBMP Section 511. (2d ed. June 2003).

In this case, opposer is, in essence, seeking consolidation of a "potential" proceeding with these consolidated proceedings. There is no proceeding involving application Serial No. 78/301068 pending before the Board. Furthermore, and as pointed out by applicant, because application Serial No. 78/301068 has not been assigned to an Examining Attorney for examination, the Board cannot predict when, or if, the application will be published for opposition. As such, waiting for application Serial No. 78/301068 to be ripe for opposition would substantially and unduly delay resolution of these proceedings. Moreover,

while opposer is correct that discovery is still open in these consolidated cases, two of the proceedings have been pending for over three years with discovery open for most of that time. The Board finds that further delay of these proceedings, especially of an indeterminate length, would be prejudicial to applicant. For the reasons set forth above, consolidation of the "intended" proceeding with these consolidated cases is impracticable on this record or in the predictable future.

In view thereof, opposer's motion to suspend, having been based solely on the ground of the need to consolidate an "intended" opposition proceeding with this one, is denied.

As indicated previously in this order, applicant's motion (filed October 8, 2003) to consolidate, with opposer's consent, is approved. Accordingly Opposition Nos. 91120820, 91120842 and 91155782 are hereby consolidated.

The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91120820 as the "parent" case. As a general rule, from this point on, only a single copy of any paper or motion should

be filed herein; but that copy should bear all three proceeding numbers in its caption.

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

Finally, applicant's motion (filed December 4, 2003) to compel is noted. Accordingly, the consolidated proceedings herein are suspended, and are considered to have been suspended since the filing date of the motion, pending disposition of the motion to compel, except as discussed below. The parties should not file any paper which is not germane to the motion to compel. See Trademark Rule 2.120(e)(2), as amended effective October 9, 1998.

This suspension order does **not** toll the time for either party to respond to discovery requests which had been duly served prior to the filing of the motion to compel, nor does it toll the time for a party to appear for a discovery deposition which had been duly noticed prior to the filing of the motion to compel. See Id. The motion to compel will be decided in due course.

* * *