

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

In the Matter of Application Serial Nos. 76/516,126; 76/516,127; and 76/515,928
Filed on April 25, 2003
Published in the Official Gazette on March 16, 2004



07-12-04

U.S. Patent & TMO/TM Mail Rpt Dt. #78

RED PLANET MANAGEMENT CORPORATION)
d/b/a DETEMPLE GUITARS)
Opposer,)
v.)
FENDER MUSICAL INSTRUMENTS)
CORPORATION)
Applicant.)

Opposition No. 91160180

JASON LOLLAR, d/b/a LOLLAR GUITARS)
Opposer,)
v.)
FENDER MUSICAL INSTRUMENTS)
CORPORATION)
Applicant.)

Opposition No. 91160351

POTENTIAL OPPOSERS' MEMORANDUM IN OPPOSITION
TO APPLICANT'S MOTION TO CONSOLIDATE

Potential Opposers The ESP Guitar Company, JS Technologies, Inc., Indoor Storm, Ltd., Schecter Guitar Research Inc., Tradition Guitars, Inc., U.S. Music Corporation, Warmouth Guitar Products, Inc., W D Music Products, Inc., Sadowsky Guitars, Ltd., Levinson Music Products, Ltd., James Triggs, Raise Praise, Inc., MBT International, Inc., Richard Keldsen, Peavey Electronics Corporation, Lakland Musical

Instruments, LLC, Stuart Spector Designs, Ltd., and Michael Tobias (the "Potential Opposers") hereby opposes Fender Musical Instruments Corporation's (the "Applicant's") Motion to Consolidate the opposition proceedings that the Potential Opposers may file in the future against Applicant's Serial Nos. 76/516,126; 76/516,127; and/or 76/515,928 (the "Trademark Applications") with other potential future opposition proceedings that may be instituted by six (6) third-party potential opposers against the Trademark Applications, and the pending opposition proceedings against the Trademark Applications subject to Opposition Nos. 91160180 & 91160351 (the "Applicant's Motion").

FACTS

Applicant FMIC filed the Trademark Applications with the U.S. Patent and Trademark Office (the "PTO") on April 25, 2003. On March 16, 2004, the Trademark Applications were published for opposition on the PTO's Official Gazette. Between April 9, 2004 and April 14, 2004, the Potential Opposers filed a request to extend their time to oppose one or more of the Trademark Applications.

On May 14, 2004, the Potential Opposers filed a consented request for an additional sixty (60) day extension for the Potential Opposers to file their notice(s) of opposition. The new time period within which the Potential Opposers have to file an opposition against the Trademark Applications is set to expire on July 14, 2004. The extension request was made to give the Potential Opposers and the Applicant an opportunity to engage in settlement discussions with each other. To date, none of the Potential Opposers have filed a Notices of Opposition against one (1) or more of the Trademark Applications.

On April 13, 2004, Jason Lollar d/b/a Lollar Guitars ("Lollar") filed a Notice of Opposition against the Trademark Applications and thereby commenced Opposition Proceeding No. 91160351. The discovery period set by the Trademark Trial and Appeal Board (the "TTAB") commenced on May 20, 2004 and is scheduled to close on November 16, 2004. The testimony periods in this proceeding are set to close between February 14, 2005 and May 30, 2005.

On April 14, 2004, Red Planet Management Corporation d/b/a DeTemple Guitars ("DeTemple Guitars") filed a notice of opposition against the Trademark Applications and thereby commenced Opposition Proceeding No. 91160180. The discovery period commenced on May 6, 2004 and is scheduled to close on November 2, 2004. The testimony periods in this proceeding are set to close between January 31, 2005 and May 16, 2005.

Before the publication period for the Trademark Applications expired, six (6) other third-party companies, namely, Hoshino Gakki Co., Ltd and Hoshino USA, Gibson Guitar Corp., Behringer Holdings (Pte) Ltd., Behringer USA, Inc., and First Act, Inc. filed extensions of time to oppose the Trademark Applications (the "Additional Potential Opposers"). Upon information and belief, none of the Additional Potential Opposers have filed a Notice of Opposition against one (1) or more of the Trademark Applications at this time.

Despite the fact that none of the Potential Opposers have yet filed a Notice of Opposition against one (1) or more of the Trademark Applications, the Applicant filed the Applicant's Motion.

In support of Applicant's Motion, the Applicant speculates on the nature of the facts and legal issues which the Potential Opposers may present and speculates that consolidation is appropriate because the Potential Opposers claims involve common questions of law or fact.

In sole support of the Applicant's Motion and the common issues and facts that will be plead in these future Notices of Opposition, the Applicant curiously submits a communication from this office sent directly to one (1) or more of our clients concerning the pending Trademark Applications. The Applicant contends that our letter is sufficient to demonstrate that the Potential Opposers' future potential claims will involve the same facts or issues of law as the Additional Potential Opposers' potential future claims and Lollar and DeTemple Guitars' pending claims. However, and most significantly, the issues and facts of each Potential Opposer and Additional Potential Opposer's case have not yet been filed with this Board.

ARGUMENT

I. Applicant's Motion is Premature With Respect to the Potential Opposers

The Potential Opposers do not dispute that consolidation of opposition proceedings may be appropriate when the cases involve common questions of law or fact. However, Applicant's motion to consolidate the Potential Opposers' future potential oppositions with two (2) opposition proceedings that have already commenced and the Additional Potential Opposer's future potential opposition proceedings is premature with respect to the Potential Opposers and the Additional Potential Opposers.

Here, neither the Potential Opposers nor the Additional Potential Opposers have filed a Notice of Opposition against one (1) or more of the Trademark Applications. *Therefore, the issues and facts before the TTAB have not yet been established and a determination of the relatedness of the issues or facts of the future opposition proceedings with Lollar and DeTemple Guitars' current opposition proceedings cannot be made at this time.* The TTAB will generally not consider a motion to consolidate until an answer has been filed in each case sought to be consolidated and there is joinder of issue. See TBMP § 511.

Accordingly, it remains to be seen whether each of the Potential Opposers' grounds for opposition involve the same facts or issues with one another and/or with the Additional Potential Opposers because neither the Potential Opposers nor the Additional Potential Opposers have filed a Notice of Opposition against one (1) or more of the Trademark Applications.

Until the issues have been joined, in order to avoid any prejudice to the Potential Opposers, Applicant's motion should be denied because it is premature. See, e.g. Nomura Securities International, Inc. v. E-Trade Securities, Inc., 2002 WL 87696 (S.D.N.Y. 2002)(The court noted that a motion to consolidate would be found premature because the lawsuit sought to be consolidated had not been filed at that time.) The Board can properly assess the savings in time, effort, and expense with the prejudice or inconvenience caused by a consolidation only after there is joinder of issue in each of the Potential Opposers' cases and the Additional Potential Opposers' cases.

**II. Consolidation of The Potential Opposers' Future Oppositions
With Lollar's or DeTemple Guitars' Pending Oppositions
Will Prejudice the Potential Opposers.**

Applicant correctly states in its Memorandum that prejudice or inconvenience may result from consolidation of TTAB inter partes proceedings in cases where, for example the proceedings to be consolidated are at different stages. Applicant's Memorandum, p. 4. Here, the Potential Opposers have not filed their Notices of Opposition and the discovery and testimony periods have not been set by the TTAB. In contrast, the respective discovery periods in Lollar and DeTemple Guitars' opposition proceedings have been ongoing for roughly two (2) months.

In its Memorandum, the Applicant states that the requested consolidation is appropriate between DeTemple Guitars and Lollars opposition proceedings because these proceedings were filed days apart and are at the same stage. However, Applicant could not make a similar assertion concerning the Potential Opposers' or the Additional Potential Opposers' proceedings because these future actions may be filed at varying times from each other. For instance, there is a possibility that the Applicant and one (1) or more of the Potential Opposers or the Additional Potential Opposers will enter a consented motion for an additional extension of time to file a notice of opposition against the Trademark Applications in order to allow an additional period to conduct settlement discussions.

To be sure, the trial dates which will be set by the TTAB when the Potential Opposers file their Notices of Opposition will be at least several months apart from Lollar

and DeTemple Guitars' trial dates. Therefore, a consolidation of the Potential Opposers' oppositions with Lollar and DeTemple Guitars should be denied because these cases are at different stages and consolidation will cause prejudice to the Potential Opposers and may also prejudice the other parties. Furthermore, it is premature to consider consolidation with respect to the Additional Potential Opposers because it is unclear at this juncture, when the relevant proceeding time periods will be for these future potential proceedings.

CONCLUSION

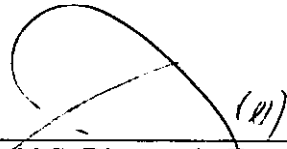
Applicant's Motion to consolidate should be denied because it is premature and will prejudice the Potential Opposers because the pending cases before the TTAB involving Lollar and DeTemple Guitars are at different stages than the future potential proceedings that the Potential Opposers may file. In the alternative, the Applicant's Motion may be denied without prejudice so that the Applicant has a chance to make a consolidation motion after the issues are joined in each of the Potential Opposers' cases and this Board can properly assess the savings in time, effort, and expense with the prejudice or inconvenience caused by a consolidation.

Respectfully submitted,

Bienstock & Michael, P.C.
Attorneys for Potential Opposers

Dated: July 7, 2004

By:



Ronald S. Bienstock, Esq.
Bienstock & Michael, P.C.
250 West 57th Street, Suite 1917
New York, NY 10107
(212) 399-0099

Certificate of Mailing

I certify that on the below date, I served Applicant. with the Potential Opposers' memorandum in opposition to Applicant's motion to consolidate, by depositing a copy of such documents with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed as follows:

Daniel A. Crowe, Esq.
Mark A. Paskar, Esq.
Bryan Cave LLP
211 North Broadway, Suite 3600
St. Louis, Missouri 63102

7/7/04
Date

Elliot W. Lipins
Elliot W. Lipins

Certificate of Filing

I hereby certify that this correspondence, namely Potential Opposers' memorandum in opposition to Applicant's motion to consolidate, is being deposited with the United States Postal Service on the date below with sufficient postage as first-class mail in an envelope addressed to:

Box TTAB No Fee
Assistant Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

on 7/7/04
Elliot W. Lipins
Elliot W. Lipins