

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
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Baxley

Mailed: December 1, 2004

Opposition No. 91162082  
Opposition No. 91162093  
Opposition No. 91162098X  
Opposition No. 91162128  
Cancellation No. 92043669

Federation of the Swiss Watch  
Industry

v.

Swiss Watch International

(as consolidated)

**Andrew P. Baxley, Interlocutory Attorney:**

On October 25, 2004, defendant filed a separate combined motion to consolidate the above-captioned opposition proceedings and suspend them pending disposition of the above-captioned cancellation proceeding in each of the above-captioned opposition proceedings. On November 8, 2004, plaintiff filed papers with the Board indicating that it consents to those motions.<sup>1</sup>

With regard to the motions to consolidate, when cases involving common questions of law or fact are pending before

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<sup>1</sup> Although none of defendant's motions were associated with the proceedings at issue when the papers indicating defendant's consent were filed, plaintiff's counsel, at the request of the above-signed Board attorney, transmitted copies of those motions by facsimile on November 29, 2004.

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the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

The Board notes that the above-captioned proceedings involve common questions of law and fact. In particular, they all include claims under Trademark Act Sections 2(a) and 2(e)(3), 15 U.S.C. Sections 1052(a) and 1052(e)(3), which are based on similar arguments. The Board also notes that they are in similar procedural postures in that they are all early in the discovery period. The Board notes in addition that suspending the opposition proceedings until the cancellation proceeding is finally determined would lead to piecemeal litigation and could delay resolution of the opposition proceedings for years.

Accordingly, the Board, in the interest of judicial economy and in exercising its discretion to control the scheduling of cases on its docket, has elected to consolidate all of the above-captioned proceedings and to allow them to go forward as one case. So doing will save the parties and the Board time, effort and expense by allowing for determination of all five proceedings in a single trial. See TBMP Section 511 (2d ed. rev. 2004).

In view thereof, defendant's motion to consolidate the above-captioned opposition proceedings and suspending them

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pending final determination of the cancellation proceeding is hereby denied. Rather, the Board, by its own initiative, hereby orders consolidation of Opposition Nos. 91162082, 91162093, 91162098, and 91162128 and Cancellation No. 92043669.<sup>2</sup>

The five 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. 91162082 as the "parent" case.

As a general rule, henceforth only a single copy of any paper or motion should be filed herein, but that copy should bear all five proceeding numbers in its caption. However, because the involved proceedings were consolidated prior to joinder of the issues in the four opposition proceedings, defendant should file an answer in each opposition proceeding before commencing the practice of filing a single copy of any paper in the parent case. Defendant is allowed until **thirty days** from the mailing date of this order to

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<sup>2</sup> The Board may consolidate proceedings by its own initiative. *World Hockey Ass'n v. Tudor Metal Products Corp.*, 185 USPQ 246 (TTAB 1975); TBMP section 511.

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file a separate answer in each of the opposition proceedings.<sup>3</sup>

Despite being consolidated, each proceeding retains its separate character.<sup>4</sup> The decision on the consolidated case shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file.

Discovery and trial dates are hereby reset as follows:

DISCOVERY PERIOD TO CLOSE:	05/13/05
30-day testimony period for plaintiff closes:	08/11/05
30-day testimony period for defendant closes:	10/10/05
15-day rebuttal testimony period closes:	11/24/05

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<sup>3</sup> The Board deems the filing of defendant's motions to consolidate and suspend to have tolled its time for filing answers in the opposition proceedings.

<sup>4</sup> The Board notes that defendant's answer in Cancellation No. 92043669 includes an affirmative defense which attacks the marks in plaintiff's pleaded application Serial Nos. 76442496 and 76442497 on the ground that plaintiff does not control or is unable to legitimately exercise control over use of the pleaded marks and that, in Opposition No. 91159208, Invicta Watch Company of America, Inc. opposed registration of those marks on the same ground. However, following the filing of opposer's withdrawal of that opposition with plaintiff's consent on November 8, 2004, that opposition was dismissed without prejudice on December 1, 2004. See Trademark Rule 2.106(c). Accordingly, those applications will mature into registrations in due course.

If plaintiff seeks leave to amend its notices of opposition and petition to cancel to rely upon those registrations, any attacks upon those registrations are compulsory counterclaims which can only be raised by way of a counterclaim in one of these proceedings or a separate petition to cancel. See Trademark Rules 2.106(b)(2) and 2.114(b)(2); TBMP Sections 313.01 and 313.04 (2d ed. rev. 2004).

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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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.