

ESTTA Tracking number: **ESTTA124487**

Filing date: **02/12/2007**

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

|                        |   |
|------------------------|---|
| Proceeding             | 91167182  |
| Party                  | Plaintiff<br>Senco Products, Inc.<br>Senco Products, Inc.<br>Senco Products, Inc.<br>8485 Broadwell Road<br>Cincinnati, OH 45244<br>UNITED STATES                   |
| Correspondence Address | LOUIS K. EBLING, ESQ.<br>GREENEBAUM, DOLL & MCDONALD PLLC<br>2800 CHEMED CENTER, 255 EAST FIFTH STREET<br>CINCINNATI, OH 45202-4728<br>UNITED STATES<br>lke@gdm.com |
| Submission             | Other Motions/Papers  |
| Filer's Name           | Michael G. Frey   |
| Filer's e-mail         | mgf@gdm.com   |
| Signature              | /michael.g.frey/  |
| Date                   | 02/12/2007  |
| Attachments            | consolidate.pdf ( 6 pages )(210482 bytes )  |

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

---

|                          |   |                               |
|--------------------------|---|-------------------------------|
| Senco Products, Inc.     | : |                               |
|                          | : |                               |
| Opposer,                 | : | Opposition Nos.: 91167181,    |
|                          | : | 91167182, 91167243, 91167285, |
| v.                       | : | 91167294, 91167314, 91167325, |
|                          | : | 91167375, 91167379, 91167428  |
| Porter-Cable Corporation | : |                               |
|                          | : |                               |
| Applicant.               | : |                               |

---

**OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS  
AND RESET TRIAL DATES**

Pursuant to Federal Rule of Civil Procedure 42(a), Opposer Senco Products, Inc.

("Opposer") hereby moves to consolidate the following ten proceedings presently before the Trademark Trial and Appeal Board:

Opposition No. 91167181; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,311, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, cordless power drills;"

Opposition No. 91167182; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,312, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, sanders;"

Opposition No. 91167243; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,313, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, sanders;"

Opposition No. 91167285; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,330, a mark comprised of the colors gray and black

Opposer's Motion to Consolidate Proceedings

Opposition Nos.: 91167181, 91167182, 91167243, 91167285, 91167294, 91167314, 91167325, 91167375, 91167379, 91167428

Page 2.

as applied to the goods, identified in the application as "power tools, namely, circular saws;"

Opposition No. 91167294; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,331, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, belt sanders;"

Opposition No. 91167314; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,335, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, miter saws;"

Opposition No. 91167325; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,326, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, reciprocating saws;"

Opposition No. 91167375; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,327, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, pneumatic and electric nailers;"

Opposition No. 91167379; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,329, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, routers;"

Opposition No. 91167428; Senco Products, Inc. v. Porter-Cable Corporation, concerning Serial No. 76/566,333, a mark comprised of the colors gray and black as applied to the goods, identified in the application as "power tools, namely, corded power drills."

Consolidation is warranted as the opposition proceedings identified above involve the same parties, similar marks, similar goods and common questions of law and fact.

Opposer's Motion to Consolidate Proceedings

Opposition Nos.: 91167181, 91167182, 91167243, 91167285, 91167294, 91167314, 91167325, 91167375, 91167379, 91167428

Page 3.

37 C.F.R. §2.116(a) provides that inter partes proceedings shall be governed by the Federal Rules of Civil Procedure wherever applicable and appropriate and except as otherwise provided. FED. R. CIV. P. 42(a) provides:

When actions involving a common question of law or fact are pending before the court, it may order a joint hearing or trial of any or all the matters in issue in the actions; it may order all the actions consolidated; and it may make such orders concerning proceedings therein as may tend to avoid unnecessary costs or delay.

The *Trademark Trial and Appeal Board Manual of Procedure* ("TBMP") provides that "[w]hen cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases." *TBMP* §511, citing FED. R. CIV. P. 42(a).

All of the above-identified opposition proceedings involve the same opposer and applicant. All involve similar marks, specifically, marks comprised of the colors black and gray as applied to various types of power tools. All of the opposed applications recite similar goods, again those being various types of power tools. And, finally, all involve common questions of law and fact. Indeed, aside from reference to the specific application being opposed and the particular type of tool covered by that particular application, the allegations and responses in the Notices of Opposition and Answers filed in each proceeding are identical.

Given the identity of the parties in the oppositions, the similarity of the marks and goods at issue, and the common questions of law and fact in each case, Opposer submits that the Board should consolidate the oppositions so that they may be presented on the same record and briefs. Consolidation will obviate the need for duplicative efforts in discovery, the taking of testimony and briefing in these ten essentially indistinguishable proceedings. Further, as all of the

Opposer's Motion to Consolidate Proceedings

Opposition Nos.: 91167181, 91167182, 91167243, 91167285, 91167294, 91167314, 91167325, 91167375, 91167379, 91167428

Page 4.

oppositions are in the same stage, no prejudice or inconvenience to either party would be caused by consolidation of the cases.

Opposer further moves that, as part of the consolidation of the proceedings, the Board reset trial dates for the consolidated proceeding by adopting the schedule currently set for Opposition No. 91167428. *Cf. Trademark Trial and Appeal Board Manual of Procedure §511* (noting that, following consolidation, it is the usual practice of the Board to adopt the trial dates of the latest-filed proceeding). Under that schedule, the trial dates for the consolidated proceeding would be set as follows:

|  |                    |
|--|--------------------|
| THE PERIOD FOR DISCOVERY TO CLOSE:                                   | June 13, 2007      |
| 30-day testimony period for party in position of plaintiff to close: | September 11, 2007 |
| 30-day testimony period for party in position of defendant to close: | November 10, 2007  |
| 15-day rebuttal testimony period to close:                           | December 25, 2007  |

This schedule was set by the Board on December 14, 2006, in connection with a three month suspension of Opposition No. 91167428.

To the extent that Opposer's motion to reset trial dates for the consolidated proceeding is viewed as a request to extend any corresponding time period, Opposer submits that good cause exists for such an extension. Applicant and Opposer have been engaged in ongoing settlement negotiations, seeking to resolve all ten of the above-identified opposition proceedings through a single settlement agreement. Communications regarding settlement are ongoing, with the most

Opposer's Motion to Consolidate Proceedings

Opposition Nos.: 91167181, 91167182, 91167243, 91167285, 91167294, 91167314, 91167325,  
91167375, 91167379, 91167428

Page 5.

recent offer being communicated to Applicant on January 29, 2007. An extension of trial dates would allow the parties further time to negotiate terms of settlement.

For the foregoing reasons, it is respectfully requested that this motion be granted and that the Board order that the proceedings be consolidated and the trial dates reset as set forth herein.

Respectfully submitted,

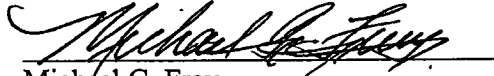


Michael G. Frey  
Louis K. Ebling  
Glenn D. Bellamy  
Greenebaum Doll & McDonald PLLC  
Attorneys for Opposer  
2800 Chemed Center  
255 East Fifth Street  
Cincinnati, Ohio 45202  
(513) 455-7678

Date: February 12, 2007

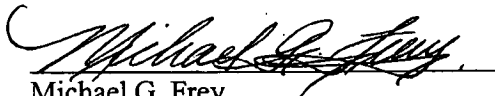
**CERTIFICATE OF FILING**

I certify that this correspondence is being transmitted by electronic filing to the Trademark Trial and Appeal Board at the United States Patent and Trademark Office this 12th day of February, 2007.

  
Michael G. Frey

**CERTIFICATE OF SERVICE**

I certify that a copy of this OPPOSER'S MOTION TO CONSOLIDATE PROCEEDINGS AND RESET TRIAL DATES has been served on: Dean N. Niro, Esq. and Dina M. Hayes, Esq., Niro, Scavone, Haller & Niro, 181 West Madison Street, Suite 4600, Chicago, Illinois 60602, attorney for Applicant, by first-class mail, postage prepaid, this 12th day of February, 2007.

  
Michael G. Frey