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

Proceeding	91169296
Party	Plaintiff Sociedade Dos Vinhos Borges, S.A. +Sociedade Dos Vinhos Borges, S.A. Rua Infante D. Henrique, 421 4435 Rio Tinto, 4435 PORTUGAL
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Submission	Motion to Consolidate
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Attachments	VinaSanPedro.MotiononConsenttoConsolidate.pdf (7 pages)(208402 bytes)

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

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VINA SAN PEDRO, S.A.,	:	
	:	Cancellation No. 92,045,026
Petitioner,	:	
v.	:	
	:	
SOCIEDADE DOS VINHOS BORGES, S.A.,	:	
	:	
Respondent.	:	
-----X	:	
-----X	:	
SOCIEDADE DOS VINHOS BORGES, S.A.,	:	
	:	Opposition No. 91,168,776
Opposer,	:	
v.	:	
	:	
VINA SAN PEDRO, S.A.,	:	
Applicant.	:	
-----X	:	
-----X	:	
SOCIEDADE DOS VINHOS BORGES, S.A.,	:	
	:	Opposition No. 91,169,296
Opposer,	:	
v.	:	
	:	
VINA SAN PEDRO, S.A.,	:	
Applicant.	:	
-----X	:	

**MOTION ON CONSENT TO CONSOLIDATE
CANCELLATION ACTION AND OPPOSITION PROCEEDINGS**

The parties jointly move, pursuant to Fed. R. Civ. P. 42, to consolidate Cancellation No. 92,045,026 and Opposition Nos. 91,168,776 and 91,169,296, on the grounds that such proceedings involve common questions of law and fact and would be most expeditiously and

efficiently handled in a single, consolidated proceeding.

BACKGROUND

Cancellation No. 92,045,026

The "parent" case, Cancellation No. 92,045,026, was filed by the petitioner, Vina San Pedro, S.A., on October 5, 2005 and involves Registration No. 2,910,525 for the mark GATAO and Cat Design covering "wines". The Board commenced this proceeding on October 14, 2005.

Vina San Pedro, S.A. seeks to cancel this registration on the basis of its ownership of VINA SAN PEDRO GATO NEGRO and Cat Design Registration 1,280,897 and GATO BLANCO VINA SAN PEDRO and Cat Design Registration No. 1,241,376, covering "wines" and "white wine", respectively; and GATO BLANCO Application No. 78/527,348 and GATO NEGRO Application No. 78/527,343, both covering "wines," respectively.

On January 23, 2006, respondent, Sociedade dos Vinhos Borges, S.A., filed its Answer, which included a counterclaim for cancellation of Petitioner's Registration Nos. 1,241,376 and 1,280,897 on the grounds of abandonment. Petitioner filed a Reply to this counterclaim on April 5, 2006.

This "parent" case is still in the initial stage of discovery, with respondent Sociedade dos Vinhos Borges, S.A. having served written discovery requests upon petitioner on January 30, 2006 and responses due on May 6, 2006. Petitioner Vina San Pedro, S.A. has yet to serve discovery, and no discovery depositions have been taken thus far.¹

Opposition No. 91,168,776

¹ On April 10, 2006, respondent filed a motion on consent for a 60-day extension of the discovery and trial deadlines in Cancellation Action No. 92,045,026.

On January 11, 2006, Sociedade Dos Vinhos Borges, S.A., the respondent in the “parent” case, filed Opposition No. 91,168,776 against Application No. 78/527,348 for the mark GATO BLANCO covering "wines" and owned by Vina San Pedro, the petitioner in the “parent” case. Proceedings were commenced by the Board on January 23, 2006. In support of its opposition, Sociedade Dos Vinhos Borges alleged ownership of superior rights through use of the mark GATAO and Cat Design, the mark covered by Registration No. 2,910,525, and that, if as alleged in Cancellation No. 92,045,026, Vina San Pedro’s GATO BLANCO mark covered by Application No. 78/527,348 so resembles the GATAO and Cat Design mark as to be likely to cause confusion, then Sociedade Dos Vinhos Borges would be damaged by the registration of Vina San Pedro’s GATO BLANCO mark.

Applicant Vina San Pedro, S.A. filed its answer on April 5, 2006. No discovery has been served by either party.

Opposition No. 91,169,296

On February 3, 2006, Sociedade Dos Vinhos Borges, S.A., filed Opposition No. 91,169,296 against Vina San Pedro S.A.’s Application No. 78/527,343 for the mark GATO NEGRO covering "wines". Proceedings were commenced by the Board on February 21, 2006. Again, Sociedade Dos Vinhos Borges, alleged superior rights on the basis of its prior use, including GATAO and Cat Design Registration No. 2,910,525, and that if, as alleged in Cancellation No. 92,045,026, Vina San Pedro’s GATO NEGRO mark covered by Application No. 78/527,343 so resembles Sociedade Dos Vinhos Borges’ GATAO and Cat Design mark covered by Registration No. 2,910,525 as to be likely to cause confusion, then Sociedade Dos Vinhos Borges would be damaged by the registration of Vina San Pedro’s GATO NEGRO

Application No. 78/527,343.

Vina San Pedro timely on April 5, 2006 filed an answer virtually identical to the answer which Vina San Pedro filed in Opposition No. 91,168,776. No discovery has been served by either party.

ARGUMENT

THE CANCELLATION ACTION AND TWO OPPOSITIONS SHOULD BE CONSOLIDATED GIVEN THEY INVOLVE THE SAME PARTIES AND MARKS AND COMMON ISSUES OF LAW AND FACT.

Fed. R. Civ. P. 42(a) provides, in pertinent part:

Consolidation. 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 of 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 cancellation action and the two oppositions involve the same parties' right to register GATO and GATAO for wine. In all three cases, respondent/opposer, Sociedade Dos Vinhos Borges, S.A. has pleaded the identical registration, namely, GATAO and Cat Design Registration No. 2,910,525 covering "wines", which registration petitioner/applicant, Vina San Pedro, S.A., has sought to cancel on the grounds of likelihood of confusion. Similarly, petitioner/applicant, Vina San Pedro, has pleaded or relies in each proceeding on the same registrations and applications, namely VINA SAN PEDRO GATO NEGRO and Cat Design Registration 1,280,897, GATO BLANCO VINA SAN PEDRO and Design Registration No. 1,241,376, GATO BLANCO Application No. 78/527,348 and GATO NEGRO Application No. 78/527,343.

Moreover, all three proceedings are in the early stages of litigation, including the "parent" case, Cancellation No. 92,045,026, in which only Sociedade Dos Vinhos Borges has served

discovery requests and responses to which are currently due on May 6, 2006. No discovery has been taken yet in the two, more recently filed Oppositions Nos. 91,169,296 and 91,168,776.

Given the identity of parties and involved marks, litigating the subject cancellation action and the two oppositions in a single, consolidated proceeding will result in a significant savings of time, effort and expense to the parties and the Board and will not prejudice the rights of either party. *Hilson Research Inc. v. Society for Human Resource Management*, 27 U.S.P.Q.2d 1423, 1424, n.1 (TTAB 1993); *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 U.S.P.Q.2d 1618, 1619, n.1 (TTAB 1989); *Bigfoot 4x4 Inc. v. Bearfoot Inc.*, 5 U.S.P.Q.2d 1444, 1445 (TTAB 1987) ("In view of the identity of the parties and the issues to be determined, these proceedings were consolidated by order of the Board . . . , pursuant to a joint motion of the parties requesting such consolidation.").

Thus, the parties join in requesting a consolidation of Cancellation No. 92,045,026 and Opposition Nos. 91,169,296 and 91,168,776. Both parties, through counsel, have reviewed this motion.

CONCLUSION

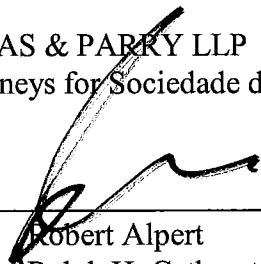
For the foregoing reasons, the parties' Motion on Consent to Consolidate Cancellation

Action and Opposition Proceedings should be granted and discovery and trial deadlines reset accordingly.

Respectfully submitted,

LADAS & PARRY LLP
Attorneys for Sociedade dos Vinhos Borges, S,A,

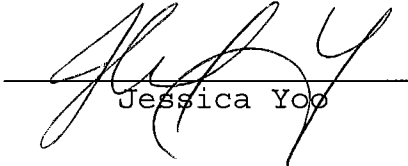
Dated: April 21, 2006

By: 
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CERTIFICATE OF TRANSMISSION

I, Jessica Yoo, hereby certify that the foregoing **MOTION ON CONSENT TO CONSOLIDATE CANCELLATION ACTION AND OPPOSITION PROCEEDINGS** is being electronically transmitted to the United States Patent and Trademark Office today, April 21, 2006.

Dated: April 21, 2006



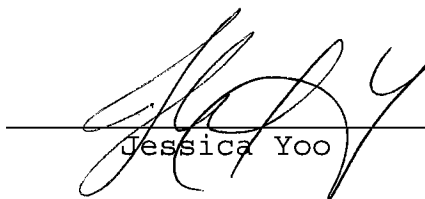
Jessica Yoo

CERTIFICATE OF SERVICE

I, Jessica Yoo, hereby certify that the foregoing **MOTION ON CONSENT TO CONSOLIDATE CANCELLATION ACTION AND OPPOSITION PROCEEDINGS** was served on the person(s) listed below by first class mail, postage prepaid, in an envelope addressed as follows:

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Dated: April 21, 2006



Jessica Yoo