

ESTTA Tracking number: **ESTTA89114**

Filing date: **07/10/2006**

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

Proceeding	91169654
Party	Defendant Neways, Inc. Neways, Inc. 2089 Neways Drive Springville, UT 84663
Correspondence Address	John C Stringham Workman Nydegger 1000 Eagle Gate Twr, 60 E South Temple Salt Lake City, UT 84111
Submission	Motion to Consolidate
Filer's Name	Robyn L. Phillips
Filer's e-mail	rphillips@wnlaw.com,jgarcia@wnlaw.com
Signature	/Robyn L. Phillips/
Date	07/10/2006
Attachments	0010 Motion to Consolidate.pdf (5 pages)(185585 bytes)

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

In the matter of Trademark Application No. 78/490,974
Published in the Official Gazette of September 13, 2005
Filing Date: September 28, 2004
For the Mark: **RESURRECTION BIOMIST**

VISUAL CHANGES SKIN CARE
INTERNATIONAL, INC.

Opposer,

v.

NEWAYS, INC.,

Applicant.

)
)
)
) **MOTION TO CONSOLIDATE**
) **AND MEMORANDUM IN**
) **SUPPORT THEREOF**
)
)
)
)
)
)
)
)

Opposition No. 91169654

MOTION

Applicant Neways, Inc. (“Neways”), by and through its counsel of record, hereby moves the Trademark Trial and Appeal Board (“TTAB”) for an order consolidating Opposition No. 91169654 with Opposition No. 91169655 pursuant to 37 C.F.R. § 2.116(a) and Fed. R. Civ. P. 42(a).

MEMORANDUM

I. Introduction.

Opposition Nos. 91169654 (“the ‘654 Opposition”) and 91169655 (“the ‘655 Opposition”) were both filed on the same date (March 9, 2006) and involve the same parties. In both oppositions, Neways is the Applicant and the Opposer is Visual Changes Skin Care International Inc. (“Opposer”). In both the ‘654 Opposition and the ‘655 Opposition, Opposer asserts United

**MOTION TO CONSOLIDATE AND
MEMORANDUM IN SUPPORT
THEREOF**

States Registration No. 3,064,428 for the mark “RESURRECTION” as the basis for opposing Neways’ marks. The ‘654 Opposition involves United States Trademark Application Serial No. 78/490,974 filed by Neways for the mark “RESURRECTION BIOMIST” for goods in International Class 03 identified as “personal care preparation; skin moisturizer made from the Resurrection Plant.” Similarly, the ‘655 Opposition involves Neways’ United States Trademark Application Serial No. 78/490,954 for the mark “NEWAYS RESURRECTION BIOMIST” for goods in International Class 03 identified as “personal care preparation; skin moisturizer made from the Resurrection Plant.”

Accordingly, while there is a slight difference in the marks being opposed, the basis for the opposition, the parties and the goods at issue are the same. On June 28, 2006, Neways contacted counsel for Opposer and requested that they stipulate to the present motion. Unfortunately, Opposer refused Neways’ request. Accordingly, Neways brings the present motion.

II. Legal Standard.

The determination of whether to consolidate multiple actions is at the discretion of this Board. *See* Fed. R. Civ. P. 42(a) and TBMP § 511. Consolidation of multiple oppositions is proper where the two oppositions involve common questions of law and fact and will avoid unnecessary costs or delay. Fed. R. Civ. P. 42(a); *see, e.g., S. Indus. Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (consolidating cases involving the same mark and virtually identical pleadings); *Ritchie v. Simpson*, 41 USPQ2d 1859, 1860 (TTAB 1996) (consolidating cases despite variations in marks and the goods involved), *rev’d on other grounds*, 50 USPQ2d 1023 (Fed. Cir. 1999); *see also* TBMP § 511. In addition, another factor to be considered by the Board in deciding whether to consolidate multiple actions is whether the same parties are involved in both actions. *Bigfoot 4x4 Inc. v. Bear Foot Inc.*, 5 USPQ2d 1444, 1445 (TTAB 1987) (consolidating two oppositions “[i]n view of the identity of parties and issues to be determined.”).

III. Analysis.

As previously indicated, the parties in both the '654 Opposition and the '655 Opposition are the same. The mark being asserted by Opposer as the basis for preventing registration is identical in both oppositions. The Notices of Opposition filed by Opposer in both the '654 Opposition and the '655 Opposition are virtually identical. The marks sought to be registered by Neways which are at issue in the '654 Opposition and the '655 Opposition differ only by one word. *Compare* the mark "RESURRECTION BIOMIST" *with* the mark "NEWAYS RESURRECTION BIOMIST". Both of Neways' marks at issue in these oppositions are used in the same class of goods and the descriptions of goods in both applications are identical.

In both the '654 Opposition and the '655 Opposition, discovery is in the early stages with both parties having exchanged written discovery. The parties are working towards agreeing upon a Stipulated Protective Order. Accordingly, there will be no prejudice to either party, and in fact, the consolidation will be beneficial to both parties because the documents being produced and discovery in both oppositions will likely overlap.

The present case is similar to *World Hockey Association v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1974). In *World Hockey*, the Applicant sought to register two marks which differed by one word. *Id.* at 247. Both of Applicant's marks were used on the same type of goods. *Id.* In *World Hockey*, the Opposer filed an opposition to each of the Applicant's marks on the basis of two registrations owned by Opposer which differed slightly (one registration also included a graphic element). *Id.* In *World Hockey*, this Board found:

Since the marks sought to be registered by applicant in each of its applications here involved are substantially similar, and inasmuch as opposer has in each instance challenged applicant's right of registration on the basis of its ownership of two substantially similar registered marks, it is believed that the two proceedings may be presented on the same record without appreciable inconvenience or confusion. Moreover, the consolidation would be equally advantages to both parties in the avoidance of the duplication of effort, loss of time, and the extra expense involved in conducting the proceedings alternately.

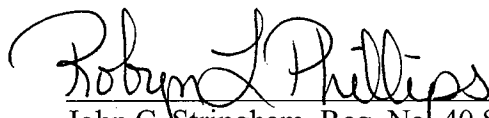
Id. at 248.

The present case provides even more compelling grounds to consolidate the actions because the same registered mark is being relied upon by Opposer in both the '654 Opposition and the '655 Opposition as the basis for denying registration of Neways' marks. Therefore, Neways submits that like the actions in *World Hockey*, the '654 Opposition and the '655 Opposition should be consolidated because of the overlapping issues of fact and law and the avoidance of the duplication of time and effort as well as the extra expense of two proceedings. Further, Neways submits that such a consolidation is also in the interest of judicial economy and more efficiently uses the resources of this Board.

Neways respectfully requests that this Motion be granted and that the '654 Opposition and the '655 Opposition be consolidated into one proceeding.

DATED this 10th day of July, 2006.

Respectfully submitted,



John C. Stringham, Reg. No. 40,831
Robyn L. Phillips, Reg. No. 39,330
Michael M. Ballard, Reg. No. 54,978

WORKMAN | NYDEGGER
1000 Eagle Gate Tower
60 East South Temple
Salt Lake City, Utah 84111
Telephone: (801) 533-9800
Facsimile: (801) 328-1707

ATTORNEYS FOR APPLICANT
NEWAYS, INC.

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this 10th day of July, 2006, a true and correct copy of the foregoing **STIPULATED MOTION TO CONSOLIDATE AND MEMORANDUM IN SUPPORT THEREOF** has been provided by United States First Class Mail, postage prepaid, in an envelope addressed as follows:

Mark D. Miller
Jeremy D. Clar
KIMBLE, MACMICHAEL & UPTON
Post Office Box 9489
Fresno, CA 93792-9489



J:\1456462\0010 Motion to Consolidate.doc