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

Proceeding	91195324
Party	Plaintiff Federation of the Swiss Watch Industry
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Submission	Motion to Consolidate
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Date	08/25/2010
Attachments	Federation v. Holzer - Motion to Consolidate SWISS MASTER and NIVADA SWISS.pdf (5 pages)(52686 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

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Federation of the Swiss Watch :
Industry : Opp. Nos.: 91/184,635
: 91/195,324
:
: **Opposer,** :
: App. Nos.: 78/966,212
v. : 77/586,482
:
: **Holzer y Cia., S.A. e C.V.,** : Pot. Marks:
: NIVADA SWISS
: SWISS MASTER
:
: **Applicant.** :
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MOTION ON CONSENT TO CONSOLIDATE PROCEEDINGS

Pursuant to the Trademark Trial and Appeal Board Manual of Procedure § 511 and to Fed. R. Civ. P. 42(a), Trademark Rule 2.116(a), Opposer, the Federation of the Swiss Watch Industry (“Federation”) respectfully requests that Opposition Nos. 91/184,635 and 91/195,324 be consolidated and that the proceedings be suspended pending the Board’s determination of this motion. Counsel for Applicant consented to this motion in an email dated August 11, 2010.

BACKGROUND

On June 16, 2008, the Federation filed a Notice of Opposition against the application by Holzer to register NIVADA SWISS, Application Serial No. 78/966,212, Opposition Proceeding No. 91/184,635. Opposition No. 91/184,635 is currently suspended as the parties are discussing settlement. Thereafter, on June 16, 2010, the Federation filed a Notice of Opposition against the

application by Holzer to register SWISS MASTER, Application Serial No. 77/586,482, Opposition Proceeding No. 91/195,324.

Opposer is the owner of Certification Marks SWISS (Registration No. 3,047,277) and SWISS MADE (Registration No. 3,038,819). Both Oppositions share multiple common characteristics, including, the parties are the same, the goods are the same, the grounds for opposing alleged in the Notices of Opposition are the same, Applicant's answer to the grounds for opposition are the same and the counsel representing the parties in both oppositions are the same. As a result, virtually all of the legal issues in both the above captioned applications are identical. Accordingly, it is in the interest of the parties and the Board to consolidate the oppositions. Further, the parties respectfully requests that both proceedings be suspended pending disposition of the Motion for Consolidation to T.B.M.P. 510.03(a).

ARGUMENT

I. CONSOLIDATION IS APPROPRIATE

Consolidation of the Oppositions is proper because the Oppositions share common parties, marks, questions of law, and facts. See TBMP § 511 ("When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of those cases."); see also Fed. R. Civ. P. 42(a) ("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 . . ."); *S. Indus. Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293 (TTAB 1997) (Consolidation granted, stating "when actions involving a common question of law and fact are pending before the Board, 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.").

Here, as stated above the Oppositions share the common parties, *i.e.*, the Federation is the Opposer and Holzer is the Applicant in both Oppositions. The Oppositions also share common questions of law relating to the (i) likelihood of confusion, mistake and deception between Opposer's SWISS and SWISS MADE marks and Applicant's NIVADA SWISS and SWISS MASTER marks; and (ii) The marks are primarily geographically deceptively misdescriptive of Opposer's SWISS and SWISS MADE marks. Further, Holzer has asserted identical affirmative defenses in its answers to the Oppositions. Finally, the Oppositions share many stipulated common questions of fact, including many commonalities between the opposed applications, as listed above.¹

Due to the foregoing common set of facts and circumstances between the Oppositions, consolidation will result in considerable savings of time, effort, and expense on the part of the parties and the Board, while creating no discernable prejudice to any of the same. *See* TBMP § 511 ("In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby.").

¹ That the two marks vary does not preclude consolidation. *See, e.g., Ritchie v. Simpson*, 41 U.S.P.Q.2d 1859 (TTAB 1996), *rev'd on other grounds*, 170 F.3d 1092, 50 U.S.P.Q.2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods). In this case, of course, both applications are for word marks containing the name and mark SWISS, thus making the instant Oppositions even more suitable for consolidation.

Additionally, the parties request that the proceedings be suspended pending the disposition of this motion and all dates reset accordingly.

Respectfully submitted,

STEPTOE & JOHNSON LLP

By:



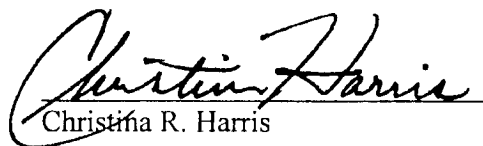
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CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing MOTION ON CONSENT TO CONSOLIDATE PROCEEDINGS has been served on Applicant this 25th day of August, 2010 by U.S. mail and electronic mail to the below address:

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