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

Proceeding	91191159
Party	Plaintiff Upward Unlimited
Correspondence Address	Richard M. Moose DORITY & MANNING, P.A. P.O. BOX 1449 GREENVILLE, SC 29602 UNITED STATES docketing@dority-manning.com
Submission	Reply in Support of Motion
Filer's Name	Tim F. Williams
Filer's e-mail	docketing@dority-manning.com
Signature	/Tim F. Williams/
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ATTORNEY DOCKET NO.: UPU-15-M1-7

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

UPWARD UNLIMITED	)	
	)	
Opposer,	)	Opposition Nos: 91191159,
	)	91191160, 91191161, 91191162,
	)	91191163, 91191164, and
	)	911911165
	)	
v.	)	
	)	
UNITED FOOTBALL LEAGUE, LLC	)	
	)	
Applicant.	)	

OPPOSER'S REPLY BRIEF IN SUPPORT OF CONSOLIDATING OPPOSITION NOS. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 911911165 PURSUANT TO FED R. CIV P. 42 (a)

Opposer, Upward Unlimited, has moved pursuant to Fed. R. Civ. P. 42(a) to consolidate Opposition Nos. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 91191165 (collectively the "Oppositions").[1] Applicant, United Football League, LLC, opposes such consolidation on the grounds that the consolidation of proceedings involving identical parties, identical marks, identical pleadings and multiple common questions of law and fact

[1] On December 30, 2009, after the filing of Opposer's Motion and Brief in Support of Consolidating Opposition Nos. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 911911165 ("Opposer's Motion to Consolidate"), Applicant filed an Answer in Opposition No. 91192776. Opposer will be moving to consolidate Opposition No. 91192776 with the above referenced proceedings for at least similar reasons as those set forth in Opposer's Motion to Consolidate and in this Reply Brief. However, Opposer respectfully requests that the Board consider consolidating Opposition No. 91192776 with the above referenced proceedings when deciding the present motion.

would somehow create undue confusion, delay, expense and prejudice and would not be in the interests of judicial economy. Opposer respectfully submits that the consolidation of the present proceedings—each of which involve identical parties, substantially identical marks, identical pleadings, and multiple common questions of law and fact—will provide for significant savings in time, effort, and expense that substantially outweigh any alleged prejudice or inconvenience caused to Applicant. Accordingly, Opposer respectfully requests that the Oppositions be consolidated under the parent case, Opposition No. 91191159.

I. ARGUMENT

The Board may consolidate pending cases that involve common questions of law or fact. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). In determining whether to consolidate proceedings, the Board should weigh the savings in time, effort, and expense to be gained from consolidation against any prejudice or inconvenience caused thereby. TBMP § 511 (citations omitted).

A. The Proceedings Involve Multiple Common Questions of Law and Fact

Applicant alleges that Opposer has not met its burden of proving that each distinct Opposition involves a common question of law or fact. (Applicant's Opposition to Opposer's Motion to Consolidate, at 3.) A simple examination of the pleadings and Opposer's Motion and Brief in Support of Consolidating Opposition Nos. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 91191165 ("Opposer's Motion to Consolidate"), however, reveals that many common questions of law and fact pervade the seven Oppositions that are the subject of the present motion.

The parties in each of the above-referenced Oppositions are identical. "Actions involving the same parties are apt candidates for consolidation." Wright & Miller, *Federal Practice and Procedure*, § 2383 (2009). This is because many of the various factual and legal issued related to the overall dispute between the parties will also be identical. In this case, a common dispute exists in each of the seven Oppositions as to whether Applicant is entitled to federal registration of identical marks in view of Opposer's prior common law rights. Various factual and legal issues common to the seven Oppositions must necessarily be resolved to address the common dispute between parties. Failure to consolidate the seven Oppositions will result in duplicative litigation, duplicative discovery, a waste of judicial resources, and possibly inconsistent findings pertaining to the various factual issues. *See A.V. By Versace, Inc. v. Gianni Versace, S.p.A.*, 1998 WL 832692 (S.D.N.Y. Dec. 1, 1998) (subsequent history omitted).

Indeed, the similarity of the factual and legal issues in each of the seven Oppositions can be easily discerned from the pleadings. The pleadings in the seven Oppositions are virtually identical. The only substantive differences in Opposer's notices of opposition are the identification of the applications being opposed and the identification of goods and services listed in the opposed applications and being asserted as part of Opposer's common law rights.

For instance, in all seven proceedings, Opposer has asserted common law rights in its numerous marks associated with the services and products offered through its youth ministerial services and organized sports programs. The nature and extent of Opposer's common law rights will be a question of fact and law common to all Oppositions. The resolution of the nature and extent of Opposer's common law rights at a single time in a single consolidated action will lead to significant savings in time, effort, and expense when compared to separately addressing the issue seven different times in seven different actions.

In addition, Applicant has filed virtually identical answers and pled identical defenses in each of the seven Oppositions. For example, Applicant has alleged in all seven Oppositions that Opposer's claims are barred by the doctrine of estoppel, the doctrine of waiver, the doctrine of laches, the doctrine of acquiescence, etc. (Exhibit 1 to Opposer's Motion to Consolidate.) These common defenses certainly present questions of fact and law common to each of the seven Oppositions making consolidation of the Oppositions appropriate. *See, e.g., S. Indus., Inc.*, 45 USPQ2d at 1297 (consolidating two cancellation proceedings involving identical parties, virtually identical pleadings, and different marks each containing the words STEALTH FRIES); *Ritchie,* 41 USPQ2d at 1860. ("Inasmuch as the notices of opposition are virtually identical and present common questions of law and fact, despite the variations in the marks and goods involved, the Board has found it appropriate to consolidate the cases." (emphasis added)).

In Applicant's Opposition to Opposer's Motion to Consolidate, Applicant attempts to discount the fact that Applicant has filed virtually identical answers in all seven opposition proceedings by stating that it was only required to plead statutory defenses and that other defenses will likely arise following discovery. (Opposition to Motion to Consolidate, at 4.) Simply because new defenses may develop during discovery does not mean that the seven Oppositions currently do not involve common questions of law and fact. Moreover, under 37 C.F.R. 11.18(b), Applicant, as signee of each of the virtually identical answers in each of the Oppositions, must have had at least a good faith basis for the legal and factual contentions set forth in such answers. Applicant is not entitled to simply enumerate statutory defenses and see which defenses stick during the discovery process. For at least this reason, Opposer respectfully submits that Applicant has admitted to having a good faith factual and legal basis for defenses common to the seven Oppositions.

In addition to having identical parties and virtually identical pleadings, the alleged marks being opposed in all seven Oppositions are also substantially identical. ("Opposer's Motion to Consolidate," at 3.) The only difference between the opposed applications are the goods and services listed in the respective applications being opposed. In this regard, Opposer respectfully submits that the factual analysis for most of the thirteen *DuPont* factors for assessing a likelihood of confusion will also be identical for the seven Opposition proceedings. For instance, because the applied for marks in each Opposition are identical in appearance, the seven Oppositions will necessarily involve at least a common question of fact pertaining to the first *DuPont* factor in a likelihood of confusion analysis, namely the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression. *See In re E. I. DuPont DeNemours & Co.*, 177 USPQ 563, 567 (C.C.P.A. 1973).

In view of the foregoing, Applicant respectfully submits that the seven Oppositions include numerous common questions of fact and law. Applicant further submits that consolidation of the actions will lead to substantial savings in time, effort, and resources by avoiding duplicative litigation, and possibly inconsistent findings regarding underlying factual and/or legal issues. Accordingly, consolidation of the above-referenced Oppositions is appropriate and, respectfully, should be ordered.

B. The Variation in the Goods Listed In Applicant's Applications Does Not Bar Consolidation

Applicant alleges that consolidation should be denied because there are different questions of fact to be determined for each Opposition Proceeding. (Applicant's Opposition to Opposer's Motion to Consolidate, at 3.) In particular, Applicant alleges that because the goods and services and international classifications for the opposed applications are different, the seven

Opposition proceedings should not be consolidated. (Opposer's Motion to Consolidate, at 3.) Applicant's arguments are without merit.

First, Rule 42(a) of the Federal Rules of Civil Procedure states that consolidation is appropriate for proceedings involving a common question of fact and law. Rule 42(a) does not require that **all** factual and legal questions be common to the proceedings. Rather, Rule 42(a) simply requires at least one common question of fact or law. Thus, it is simply irrelevant that some different questions of fact may be present in the seven Oppositions. This is particularly true in circumstances where the Oppositions involve identical parties, virtually identical pleadings, and identical marks.

Second, the Board has previously found consolidation to be appropriate in proceedings involving identical pleadings and identical parties, despite variations in the marks and goods involved in the proceedings. In *Ritchie v. Simpson*, the Board consolidated four separate opposition proceedings for applications involving the marks O.J. SIMPSON, O.J., O.J. SIMPSON, and THE JUICE for over a hundred distinct goods and services spanning multiple international classifications. *Ritchie,* 41 USPQ2d at 1860. The Board consolidated the opposition proceedings because the parties in each case were identical and because the notices of opposition in each case were virtually identical. *Id.*

Thus, even if the alleged marks of Applicant's applications were vastly different – which they are not – consolidation is still appropriate due to the numerous common questions of law and fact between the seven Oppositions.

C. Consolidation Will Not Cause Undue Confusion, Delay, Expense or Prejudice and Will Not Waste Judicial Resources

Applicant further alleges that consolidation should be denied because consolidation will cause undue confusion, delay, expense, and prejudice and is not in the interests of judicial economy. (Applicant's Opposition to Opposer's Motion to Consolidate, at 4-5.) Applicant respectfully disagrees. Consolidation of the seven Oppositions will provide for substantial savings in time, effort, and resources, will avoid duplicative litigation and duplicative discovery, and is in the best interest of judicial economy.

For instance, Applicant alleges that the consolidation of the Oppositions will create undue confusion and "utter chaos in the parsing out of information" relative to each application. (Applicant's Opposition to Opposer's Motion to Consolidate, at 5.) Opposer respectfully submits that the parties and the Board are capable of keeping issues pertaining to the seven different Oppositions separate where necessary. Indeed, "[c]onsolidated cases do not lose their separate identity because of consolidation. **Each proceeding retains its separate character and requires entry of a separate judgment.**" TBMP § 511 (citations omitted) (emphasis added). There is simply no danger of a claim or defense being intertwined with other claims and surviving without merit simply because it has been consolidated with other claims.

Applicant also expresses concern that consolidation will prejudice Applicant during discovery. Indeed, Applicant asserts that consolidation may lead to repeated requests to the Board for additional discovery. Any concerns of Applicant regarding limits on discovery due to consolidation can be addressed by an appropriate Board Order. In fact, such concerns can be more efficiently addressed in a single consolidated action as opposed to seven independent

actions because such concerns can be addressed a single time, in a single proceeding, before a single Interlocutory Attorney.

In fact, directly contrary to Applicant's allegations, failure to consolidate the actions will actually result in inefficient discovery and could potentially lead to discovery abuse. To conduct independent discovery in each of the seven proceedings would necessarily require duplicative discovery requests, duplicative discovery motions, duplicate document production, duplicative discovery depositions, etc. This creates the potential for discovery abuse because a party can impose burdensome discovery on the other party seven separate times as opposed to only once in a consolidated action. In addition, failure to consolidate could possibly result in inconsistent findings pertaining to the various factual issues related to discovery matters, such as privilege matters, confidentiality matters, relevance matters or other matters.

Contrary to Applicants' assertions, consolidation of the seven Oppositions is also in the best interests of judicial economy. Maintaining the Oppositions as seven different independent proceedings will only result in wasting Board resources. Indeed, the seven Oppositions are currently pending before five different Interlocutory Attorneys.[2] Without consolidation, these five different Interlocutory Attorneys will be forced to deal with duplicative litigation and duplicative discovery that could be handled a single time, in a single proceeding, before a single Interlocutory Attorney.

Opposer respectfully submits that consolidation of the Oppositions involving identical parties, identical pleadings, identical marks, and multiple common questions of fact and law will result in significant savings in time, effort, and resources. Such savings in time, effort, and resources will outweigh any prejudice or inconvenience caused to Applicant.

[2] The Interlocutory Attorneys for the seven Oppositions are Atty. Cheryl Goodman, Atty. Mary Catherine Faint, Atty. Frances Wolfson, Atty. Michael Adlin, and Atty. Ann Linnehan.

II. CONCLUSION

For the foregoing reasons, the undersigned respectively requests that Opposition Nos. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 911911165 be consolidated under the parent Opposition No: 91191159.

Respectfully submitted,

ON BEHALF OF OPPOSER
UPWARD UNLIMITED

DATE: January 5, 2010 BY: /Tim F. Williams/

TIM F. WILLIAMS
Reg. No. 47,178

DORITY & MANNING
ATTORNEYS AT LAW, P.A.
P. O. Box 1449
Greenville, SC 29602-1449

TELEPHONE: (864) 271-1592
FACSIMILE: (864) 233-7342

CERTIFICATE OF SERVICE

It is hereby certified that a copy of the **OPPOSER'S REPLY BRIEF IN SUPPORT OF CONSOLIDATING OPPOSITION NOS. 91191159, 91191160, 91191161, 91191162, 91191163, 91191164, and 911911165 PURSUANT TO FED R. CIV P. 42 (a)** was served on Applicant's counsel of record via United Stated Postal Service First Class Mail on **January 5, 2010**, as follows:

BRUCE D. JOBSE, ESQ.
BURNS & LEVINSON, LLP
125 SUMMER ST STE 600
BOSTON, MA 02110-1624
Phone Number: 617-345-3000

PRUDENCE GREENE
(Typed or printed name of person mailing paper or fee)

(Signature of person mailing paper or fee)