

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: March 14, 2011

Opposition No. 91196016

Opposition No. 91198643

Carlos Ramirez

v.

Fredrick J. Staves

**M. Catherine Faint,
Interlocutory Attorney:**

Applicant filed on February 24, 2011 a communication which the Board reads as a motion to consolidate Opposition Nos. 91196016 and 91198643.¹

When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

Inasmuch as the parties to the instant proceedings are essentially identical and the issues are substantially the same, Opposition Nos. 91196016 and 91198643 are **hereby consolidated.**

¹ Applicant did not include a certificate of service with the communication. Opposer may view the communication at: <http://ttabvue.uspto.gov/ttabvue/v?pno=91198643&pty=OPP&eno=4>. Strict compliance with Trademark Rule 2.119 will be required in all future filings with the Board as noted below.

The consolidated cases may be presented on the same record and briefs. See *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989).

The Board file will be maintained in Opposition No. **91196016 as the "parent" case.** As a general rule, from this point on the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order. Because the involved proceedings, however, were consolidated prior to joinder of the issues in the later proceeding, applicant should file **a separate answer for Opposition No. 91198643** before commencing the practice of filing a single copy of any paper in the parent case.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

NATURE OF BOARD PROCEEDINGS

Applicant is advised that an *inter partes* proceeding before the Board is similar to a civil action in a Federal district court. There are pleadings, a wide range of possible motions; discovery (a party's use of discovery

depositions, interrogatories, requests for production of documents and things, and requests for admission to ascertain the facts underlying its adversary's case), a trial, and briefs, followed by a decision on the case. The Board does not preside at the taking of testimony. Rather, all testimony is taken out of the presence of the Board during the assigned testimony, or trial, periods, and the written transcripts thereof, together with any exhibits thereto, are then filed with the Board. No paper, document, or exhibit will be considered as evidence in the case unless it has been introduced in evidence in accordance with the applicable rules.

REQUIREMENT FOR SERVICE OF PAPERS

The service requirements are set forth in Trademark Rule 2.119. Trademark Rules 2.119(a) and (b) and require that every paper filed in the Patent and Trademark Office in a proceeding before the Board must be served upon the attorney for the other party, or on the party if there is no attorney, and proof of such service must be made before the paper will be considered by the Board.

Consequently, copies of all papers which either party may subsequently file in this proceeding, including applicant's answer to the notice of opposition, must be accompanied by a signed statement indicating the date and manner in which such service was made. Strict compliance with Trademark Rule 2.119 is required in all further papers filed with the Board.

The Board will accept, as *prima facie* proof that a party filing a paper in a Board *inter partes* proceeding has served a copy of the paper upon every other party to the proceeding, a statement signed by the filing party, or by its attorney or other authorized representative, clearly stating the date and manner in which service was made. This written statement should take the form of a "certificate of service" which should read as follows:

The undersigned hereby certifies that a true and correct copy of the foregoing [insert title of document] was served upon opposer by forwarding said copy, via first class mail, postage prepaid to: [insert name and address].

The certificate of service must be signed and dated. See also TBMP §113 (2d ed. rev. 2004).

OPTION OF E-MAIL SERVICE

The parties may agree to the email service option now available under Trademark Rule 2.119(b)(6) ("Electronic transmission when mutually agreed upon by the parties.").² Should the parties decide to continue using traditional service options, the parties may consider agreeing at least to courtesy email notification when any paper is served.

² The additional five days available under Trademark Rule 2.119(c) for traditional service modes (e.g., First Class Mail) is not available for email service.

THE BOARD'S STANDARDIZED PROTECTIVE ORDER IS IN PLACE

The Board's standard protective order is in place in this case governing the exchange of confidential and proprietary information and materials. The parties may substitute a stipulated protective agreement (signed by both parties). However, the Board will not become involved in a dispute over any substitution in view of the existence of the Board's standardized protective order.

REPRESENTATION

The Board notes applicant is representing himself. Applicant may do so. However, it should also be noted that while Patent and Trademark Rule 11.14 permits any person to represent itself, it is generally advisable for a person who is not acquainted with the technicalities of the procedural and substantive law involved in an opposition proceeding to secure the services of an attorney who is familiar with such matters. The Patent and Trademark Office cannot aid in the selection of an attorney. In addition, as the impartial decision maker, the Board may not provide legal advice, though may provide information as to procedure.

ELECTRONIC RESOURCES

All parties may refer to the Trademark Trial and Appeal Board Manual of Procedure (TBMP) and the Trademark Rules of Practice, both available on the USPTO website, www.uspto.gov. The TTAB homepage provides electronic access to the Board's

standardized protective order, a chart of the new rules and the text of the new rules (effective August 31, 2007 and November 1, 2007), and answers to frequently asked questions. Other useful databases include the ESTTA filing system³ for Board filings and TTABVUE for status and prosecution history.

The Board's records are public records. Thus, applicant may use the TTABVUE database to view other cases to get an idea of the course of Board proceedings.

Strict compliance with the Trademark Rules of Practice, and where applicable the Federal Rules of Civil Procedure, is expected of all parties before the Board, whether or not they are represented by counsel.

Schedule

³ Use of electronic filing with ESTTA, available through the USPTO website, is strongly encouraged. This electronic file system operates in real time. The filing party is also provided with a confirmation number that the filing has been received.

A party may also use first class mail. Correspondence required to be filed in the Office within a set period of time will be considered as being timely filed on the date of deposit in the mail if accompanied by a certificate of mailing.

Certificate of Mailing

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first-class mail in an envelope addressed to:

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

The certificate of mailing must be signed and dated. The actual date of receipt by the Office will be used for all other purposes, including electronically filed documents.

In accordance with Board procedure, the trial schedule for the consolidated case is the one with the latest dates and is copied below for ease of reference.⁴

Time to Answer	3/29/11
Deadline for Discovery Conference	4/28/11
Discovery Opens	4/28/11
Initial Disclosures Due	5/28/11
Expert Disclosures Due	9/25/11
Discovery Closes	10/25/11
Plaintiff's Pretrial Disclosures	12/9/11
Plaintiff's 30-day Trial Period Ends	1/23/12
Defendant's Pretrial Disclosures	2/7/12
Defendant's 30-day Trial Period Ends	3/23/12
Plaintiff's Rebuttal Disclosures	4/7/12
Plaintiff's 15-day Rebuttal Period Ends	5/7/12

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

⁴ While discovery is already open in Opposition No. 91196016, and remains so, discovery in the consolidated case will close according to the schedule below.