

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

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Mailed: May 10, 2011

Opposition No. 91196904
(parent case)

Opposition No. 91196920

OSRAM GmbH

v.

Sunbeam Products, Inc.

Jennifer Krisp, Interlocutory Attorney:

Consolidation

It has come to the Board's attention that the two above-captioned opposition proceedings involve the same parties and involve similar marks.

Specifically, in **Opposition No. 91196904**, Sunbeam Products, Inc. ("applicant") seeks to register the mark **OSTER** (standard characters) for goods in several classes, including "easy read measuring cups; kitchen scales; measuring cups and spoons; refrigerator magnets; thermometers; timers; jiggers" in International Class 9.¹

In **Opposition No. 91196920**, applicant seeks to register the mark **OSTER** and design, shown below, for "electrical cooling

¹ Application Serial No. 77558655, filed August 29, 2008, alleging a bona fide intent to use the mark in commerce under Trademark Act Section 1(b), and claiming acquired distinctiveness under Trademark Act Section 2(f).

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apparatus for household use, namely, refrigerators, keg coolers, beverage coolers, wine coolers, ice makers, freezers, and parts and accessories thereto" in International Class 11.²



OSRAM GmbH ("opposer") opposes registration of each applied-for mark, pleading ownership of an application for the mark **OSTAR** (standard characters) for "light emitting diodes; light emitting diode displays and display circuit modules; and components of the aforementioned goods" in International Class 9.³

In each proceeding, in lieu of filing an answer, applicant has moved to dismiss for failure to state a claim upon which relief can be granted, pursuant to Fed. R. Civ. P. 12(b)(6).

Opposer's pleaded application, Application Serial No. 76633973, is currently subject to opposition in Opposition No. 91171206, a proceeding in which applicant, as opposer therein, pleads ownership of numerous registrations for the mark OSTER for goods and services in International Classes 3, 5, 7, 8, 9, 10, 11, 21 and 37

The Board may consolidate pending cases that involve common questions of law or fact. See Fed. R. Civ. P. 42(a);

² Application Serial No. 77922071, filed January 28, 2010, asserting a bona fide intent to use the mark in commerce pursuant to Trademark Act Section 1(b).

³ Application Serial No. 76633973, filed March 14, 2005, based on Trademark Act Section 1(b) and 44(e); in a statement of use filed

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Regatta Sport Ltd. v. Telux-Pioneer Inc., 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). Inasmuch as the parties to the proceedings are the same, and the proceedings involve common questions of law and fact, the Board finds that consolidation is appropriate.

Opposition No. 91196904 and Opposition No. 91196920 are hereby consolidated and may be presented on the same record and briefs. The record will be maintained in Opposition No. 91196904 as the "parent case." The parties should no longer file separate motions and papers in each proceeding, but file only a single copy of each motion or paper in the parent case, with each motion or paper captioned as above, listing the consolidated proceedings in ascending order, and identifying the parent case.

Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings, and a copy of the final decision shall be placed in each proceeding file.

Suspension

August 16, 2005, opposer alleges a date of first use anywhere and first use in commerce of July 22, 2005.

The relevant procedural rule, Trademark Rule 2.117(a), reads as follows:

- (a) Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding. (emphasis added)

Thus, the Board may, in its discretion, suspend a proceeding or proceedings pending the final determination of another Board proceeding in which the parties are involved. The Board will suspend where the final determination of the other proceeding will have a bearing on the issues before it. See TBMP § 510.02(a) (2d ed. rev. 2004). As with the issue of consolidation, the determination of the appropriateness of suspension under Trademark Rule 2.117(a) is within the sole discretion of the Board. *Id.* Where a potentially dispositive motion is pending at the time when the question of suspension is considered, the Board may elect to suspend without first deciding the potentially dispositive motion.⁴ *Id.*

Inasmuch as the earlier opposition proceeding against application Serial No. 76633973 and between the parties may have a bearing on these consolidated proceedings, these

⁴ As noted, applicant has moved to dismiss each of the now consolidated oppositions pursuant to Fed. R. Civ. P. 12(b)(6).

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consolidated proceedings are hereby suspended pending final disposition of Opposition No. 91171206.

Within twenty (20) days after the final determination of said opposition, the parties shall file a paper in parent case Opposition No. 91196904 so the Board and call up these consolidated proceedings for any appropriate action.

A proceeding is considered to have been finally determined when a decision on the merits of the case (i.e., a dispositive ruling that ends litigation on the merits) has been rendered, and no appeal has been filed therefrom, or all appeals filed have been decided. See TBMP § 510.02 (2d ed. rev. 2004).

During the suspension period, the parties shall notify the Board of any address changes for the parties or their attorneys.