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

Proceeding	91201052
Party	Plaintiff Moda Group LLC
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Submission	Motion to Consolidate
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Moda Group, LLC,	)	
a Michigan limited liability company,	)	Opposition No. 91200995
	)	Opposition No. 91201015
Opposer	)	Opposition No. 91201052
	)	
v.	)	Mark: IMPORTED FROM DETROIT
	)	
Chrysler Group, LLC	)	
a Delaware limited liability company	)	
	)	
Applicant	)	
	)	
_____	)	

**OPPOSER’S COMBINED MOTION AND BRIEF FOR SUSPENSION AND  
CONSOLIDATION OF PROCEEDINGS UNDER TBMP 510 AND 511**

In accordance with Fed. R. Civ. P. 42(a) and TBMP 510 and 511, Opposer hereby moves the Board to consolidate pending Opposition Nos. 91200995, 91201015, and 91201052 into a single opposition proceeding given the identical nature of both the Applicant’s marks and the grounds of opposition submitted by the Opposer. Based upon current TTAB practice, it is believed that the requested Consolidated Inter Partes Proceeding would then bear the lower opposition number, which is Opposition No. 91200995.

Once consolidated, Opposer further moves the Board to suspend the Consolidated Proceeding until the resolution and final determination of an on going civil action, which may have a bearing upon pending Board cases. See 37 CFR 2.117(a). The relevant Civil Action is identified as the earlier-filed and pending Case No. 11-11074 before the Honorable Arthur J. Tarnow of the U.S. District Court for the Eastern District of Michigan.

The relevant and applicable pleadings for Case No. 11-11074 have been attached to each of the individual Notice(s) of Opposition which seek to be consolidated by this motion. In Case No. 11-11074, the Applicant (as Plaintiff) has brought a total of four (4) counts predicated under Section 43(a) of the Lanham Act as well as the state statutory and common law of the State of Michigan, but all of which claim some form of protectable legal interest in the unregistered designation IMPORTED FROM DETROIT. In view of the fact that this Civil Action has been pending before the U.S. District Court for the Eastern District of Michigan since March 15, 2011 and the Civil Action has already addressed and ruled upon the asserted claims in the same IMPORTED FROM DETROIT designation in at least the June 28, 2011 Order denying the Applicant's (as Plaintiff) request for a preliminary injunction for the overlapping designation, IMPORTED FROM DETROIT, it is submitted that Applicant (as Plaintiff) has already picked the chosen forum to assert its putative rights by filing the Civil Action before a federal district court.

Further, it is submitted that a consolidated and suspended inter partes proceeding proceeding would also preserve the Board's resources, avoid duplication of effort, and reduce expense to the parties given the similarities of fact and law at issue in both proceedings. In support of this Motion, Opposer states as follows:

#### **BACKGROUND**

- 1) All three of the above-identified Opposition Proceedings involve both common parties and common claims opposing a common putative mark, IMPORTED FROM DETROIT. The current basis for all three oppositions is Section 2(a), Section 2(e)(2), and Section 2(e)(3) of the Lanham Act.

- 2) Opposer in all three opposition proceedings, Moda Group, LLC, has timely opposed the Applicant's filings based upon its fair and mere use of what is believed to be unprotectable designation(s), IMPORTED FROM DETROIT, and the fact that it will be damaged if these applications were to mature as issued registrations upon the Principal Register. Opposer states that Applicant may seeks to amend its complaint in the Civil Action to add a claim under 15 U.S.C. §1114.
- 3) Opposer provided the Applicant with two separate written communications seeking the Applicant's position/potential consent for the relief requested herein. Although Opposer's counsel received a response from the same counsel of record that represents the Applicant in the Civil Action stating that the same counsel has been retained in this matter, to date no counsel has filed an appearance on behalf of the Applicant and no substantive response to these issues has been provided by the Applicant. Thus, both concurrence and/or communication was sought, but could not be obtained.

#### **ARGUMENT FOR CONSOLIDATION**

- 4) Under Fed. R. Civ. P. 42(a) and TBMP 511, the Board may consolidate matters when they involve common questions of law or fact. "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." TBMP 511.

- 5) The three (3) opposition proceedings involve common questions of both fact and law. The parties to all proceedings are identical. The Opposer alleges the same grounds to oppose and challenge the three (3) applications on the same facts and legal grounds in all three proceedings. All proceedings involve the same business of the Applicant and the same mark, albeit with different goods. In reviewing the three (3) opposition proceedings, the Board would be considering the same factual and legal arguments, as applied to the same putative mark (i.e. IMPORTED FROM DETROIT). Moreover, there would also be overlap of many, if not all, discovery issues. For these reasons, consolidation of the proceedings would save both time and money for the Board as well as the parties.
- 6) No prejudice or inconvenience to the parties will flow from consolidation. The parties are identical, so they would be litigating each matter regardless of whether they are separate or consolidated. In fact, although the Applicant does not have a formal counsel of record at this time, it is believed that Applicant's counsel will be the same counsel of record in the Civil Action. Thus, if consolidated, the parties would save resources by filing pleadings in only one matter. As stated in TBMP 511, the Board will still consider each matter separately, so the merits of each opposition proceeding will be heard. See TBMP 511 ("Consolidated cases do not lose their separate identity because of consolidation."). Consolidation will merely serve to assist in the organizing, scheduling, and filing of the

matters.

### **ARGUMENT FOR SUSPENSION**

- 7) All three (3) opposition proceedings (whether consolidated or not) should also be suspended pending the final determination of Civil Action 11-11074 before the U.S. District Court for the Eastern District of Michigan. The Civil Action involves issues in common with those in the all three (3) proceedings currently before the Board; thereby the Civil Action may have a bearing upon the pending Board cases. See Trademark Rule 2.117(a) and TBMP 510. Most notably, the decision of the Federal District Court is binding upon the Board, while the decision of the Board is not binding upon the Court. See *Goya Foods Inc. v. Tropicana Products Inc.*, 846 F.2d 848, 6 USPQ2d 1950 (2d Cir. 1988).

### **CONCLUSION**

- 8) Given the inherent benefits of both consolidating and suspending these matters, coupled with the already pending nature of the earlier-filed Civil Action, consolidation followed by suspension is respectfully requested. It is submitted that the clear common questions of both fact and law clearly outweigh any prejudice or inconvenience to the parties in consolidating the matters, if any.
- 9) As such, Opposer respectfully requests that the Board consolidate and suspend currently-pending Opposition Nos. 91200995, 91201015, and 91201052 into a single opposition proceeding given the identical nature of both the

Applicant's mark and the grounds for opposition.

- 10) In submitting this motion to consolidate and suspend Opposition Nos. 91200995, 91201015, and 91201052 into a single opposition proceeding, Opposer respectfully submits that this motion also embodies a brief within the meaning of 37 C.F.R. 2.127(a).

Dobrusin & Thennisch, PC  
Attorneys for Petitioner

Dated: August 17, 2011

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**CERTIFICATE OF SERVICE**

I, hereby certify that on August 17, 2011, I filed the foregoing paper(s) with the Trademark Trial and Appeal Board and sent a copy to counsel of record via US Mail to the address below:

Amanda L. Conti-Duhaime  
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/s/Jeffrey P. Thennisch

Jeffrey P. Thennisch