

ESTTA Tracking number: **ESTTA572920**

Filing date: **11/25/2013**

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

Proceeding	91205081
Party	Defendant Dynamic Sports Nutrition, LLC
Correspondence Address	JOHN S EGBERT EGBERT LAW OFFICES PLLC 1314 TEXAS AVENUE, 21ST FLOOR HOUSTON, TX 77002-1897 UNITED STATES mail@egbertlawoffices.com
Submission	Motion to Consolidate
Filer's Name	John S. Egbert
Filer's e-mail	mail@egbertlawoffices.com
Signature	/2259-36/
Date	11/25/2013
Attachments	2259-36_78 Applicant's Motion to Consolidate.pdf(617880 bytes)

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

In the Matter of Trademark Application No. 85/340,058
Published in the Official Gazette on January 10, 2012

Merck Sharp & Dohme B.V. (as successor	§	
in interest to MSD OSS B.V.),	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91205081
	§	
Dynamic Sports Nutrition, LLC,	§	
	§	
Applicant.	§	

In the Matter of Trademark Application No. 85/628,632
Published in the Official Gazette on January 29, 2013

Merck Sharp & Dohme B.V.,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91210254
	§	
Dynamic Sports Nutrition, LLC,	§	
	§	
Applicant.	§	

APPLICANT'S MOTION TO CONSOLIDATE WITHOUT CONSENT

Pursuant to Fed. R. Civ. P. 42(a) and TBMP §511, Dynamic Sports Nutrition, LLC ("Applicant"), by its attorneys, hereby moves the Trademark Trial and Appeal Board ("TTAB") to consolidate the above-captioned opposition proceedings. In support of Applicant's Motion to Consolidate, Applicant states as follows:

1. Opposition No. 91205081 was filed by Merck Sharp & Dohme B.V. (as successor in interest to MSD OSS B.V.) ("Opposer") on May 9, 2012 against Applicant's "DECA-

DURABOLIN" trademark application, U.S. Serial No. 85/340,058. In the Opposition, Opposer has claimed deceptiveness, false suggestion of a connection, and the mark is deceptively misdescriptive.

2. Opposition No. 91210254 was filed by Opposer on April 16, 2013 against Applicant's "DURABOLIN" trademark application, U.S. Serial No. 85/628,632. In the Opposition, Opposer has claimed deceptiveness, false suggestion of a connection, and the mark is deceptively misdescriptive.

3. "When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases." TBMP §511. Furthermore, "[i]n 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 which may be caused thereby." *Id.* "Identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered." *Id.*

4. As can be seen from the Notices of Opposition and Answers in the above-captioned proceedings, the two cases involve the same questions of law and fact due to the relatedness of the parties, the relatedness of the marks at issue, the related causes of action, and the related affirmative defenses.

5. Furthermore, consolidation will not be prejudicial to either party, because the two opposition proceedings are already scheduled to take place over a very similar time period. Opposition No. 91205081 filed against the mark "DECA-DURABOLIN" is currently set so that discovery closes March 29, 2014 and Opposition No. 91210254 filed against the mark "DURABOLIN" is currently set so that discovery closes May 11, 2014.

6. Applicant has requested consent from the Opposer to file the present motion. Despite multiple inquiries, however, the Opposer has not provided Applicant with a definitive response as

to whether or not they would be willing to consent. Subsequently, this motion is being filed without consent.

7. On October 30, 2013, Applicant contacted Opposer to request whether or not the Opposer would like to consolidate the two opposition proceedings. *See* Exhibit "A" [email correspondence between Applicant and Opposer]. On November 1, 2013, counsel for the Opposer indicated that they would confer with their client and respond at a later date. *See id.* On November 12, 2013 Applicant sent a reminder email requesting whether or not Opposer would like to consolidate the proceedings. *See id.* That same day, counsel for the Opposer again indicated that they would need to contact their client, as they had not received a response. *See id.* Therefore, on November 13, 2013, Applicant sent an email to counsel for the Opposer indicating that Applicant would file the present motion on November 18, 2013 if a response was not received. *See id.* Counsel for the Opposer acknowledged receipt of the November 13, 2013 email and stated that they hoped to respond prior to November 18, 2013. *See id.* As of this date, Applicant has still not received a response from the Opposer.

8. Consolidation may be ordered by the Board when cases involve common questions of law or fact. *See* TBMP §511. Applicant respectfully requests that the Board approve this consolidation request so that the resources of the TTAB, and of the parties, will be conserved. *See id.*

WHEREFORE, Dynamic Sports Nutrition, LLC, the Applicant in both opposition proceedings, requests that Opposition No. 91205081 and Opposition No. 91210254 be consolidated.

Respectfully submitted,

November 25, 2013
Date

/2259-36&78/
John S. Egbert
Reg. No. 30,627
Kevin S. Wilson
Michael F. Swartz

Egbert Law Offices, PLLC
1314 Texas, 21st Floor
Houston, Texas 77002
(713)224-8080
(713)223-4873 (Fax)

ATTORNEYS FOR APPLICANT
Dynamic Sports Nutrition, LLC

CERTIFICATE OF SERVICE

I hereby certify that Applicant's Motion to Consolidate is being sent by first class mail on November 25, 2013, to the attorney of record for Opposer at the following address:

Marie Lavalleye
Hope Hamilton
Bingham Leverich
Covington & Burling LLP
1201 Pennsylvania Avenue, NW
Washington, DC 20004

ATTORNEYS FOR OPPOSER
Merck Sharp & Dohme B.V.

/2259-36&78/
John S. Egbert
Reg. No. 30,627
Kevin S. Wilson
Michael F. Swartz

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1314 Texas, 21st Floor
Houston, Texas 77002
(713)224-8080
(713)223-4873 (Fax)

ATTORNEYS FOR APPLICANT
Dynamic Sports Nutrition, LLC

JSE:mfs
Our File: 2259-36/78

Exhibit "A"

Subject: RE: TTAB Opposition # 91210254 — DURABOLIN
From: Lavalleye, Marie (mlavalleye@cov.com)
To: mswartz@egbertlawoffices.com;
Cc: bleverich@cov.com; pphelan@cov.com; kwilson@egbertlawoffices.com;
Date: Wednesday, November 13, 2013 1:31 PM

Mike -

I will do what I can to get back to you before then.

Marie

Marie Lavalleye | **COVINGTON & BURLING LLP**
1201 Pennsylvania Ave., N.W., Washington, D.C. 20004
Tel: (202) 662-5439 | Fax: (202) 778-5439
mlavalleye@cov.com

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Please consider the environment before printing this e-mail. Thank you.

From: Mike Swartz [mailto:mswartz@egbertlawoffices.com]
Sent: Wednesday, November 13, 2013 1:54 PM
To: Lavalleye, Marie
Cc: Leverich, Bingham; Phelan, Patrick; Kevin Wilson
Subject: Re: TTAB Opposition # 91210254 -- DURABOLIN

Dear Marie,

Thanks for the response. If we do not hear back from you, we will plan on filing a Motion to Consolidate Without Consent on Monday, November 18, 2013.

If you have any questions or concerns, feel free to contact our office at any time.

Best regards,

Mike Swartz

Michael F. Swartz | Egbert Law Offices, PLLC | 1314 Texas, 21st Floor | Houston, Texas
77002 | Voice: 713-224-8080 | Fax: 713-223-4873

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From: "Lavalleye, Marie" <mlavalleye@cov.com>
To: Mike Swartz <mswartz@egbertlawoffices.com>
Cc: "Leverich, Bingham" <bleverich@cov.com>; "Phelan, Patrick" <pwhelan@cov.com>; Kevin Wilson <kwilson@egbertlawoffices.com>
Sent: Tuesday, November 12, 2013 6:32 PM
Subject: Re: TTAB Opposition # 91210254 -- DURABOLIN

Mike -

I have yet heard back from client on this but hope to have an answer for you soon.

Marie

Sent from my cell

On Nov 12, 2013, at 5:00 PM, "Mike Swartz"
<mswartz@egbertlawoffices.com<<mailto:mswartz@egbertlawoffices.com>>> wrote:

Dear Marie,

This email is a kind reminder regarding our October 30, 2013 email requesting whether or not your client would like to consolidate the proceedings. Thanks.

If you have any questions or concerns, feel free to contact our office at any time.

Best regards,

Mike Swartz

Michael F. Swartz | Egbert Law Offices, PLLC | 1314 Texas, 21st Floor | Houston, Texas
77002 | Voice: 713-224-8080 | Fax: 713-223-4873

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this transmission in error, please notify the sender immediately and delete it from your system.

From: "Lavalleye, Marie" <mlavalleye@cov.com<<mailto:mlavalleye@cov.com>>>
To: Mike Swartz <mswartz@egbertlawoffices.com<<mailto:mswartz@egbertlawoffices.com>>>
Cc: "Leverich, Bingham" <bleverich@cov.com<<mailto:bleverich@cov.com>>>; "Phelan, Patrick" <pphelan@cov.com<<mailto:pphelan@cov.com>>>; Kevin Wilson <kwilson@egbertlawoffices.com<<mailto:kwilson@egbertlawoffices.com>>>
Sent: Friday, November 1, 2013 4:21 PM
Subject: RE: TTAB Opposition # 91210254 -- DURABOLIN

Mike -

I am responding as Pat is out of the office on paternity leave. We are conferring with our client and will get back to you soon with respect to your request below.

Marie

Marie Lavalleye | COVINGTON & BURLING LLP
1201 Pennsylvania Ave., N.W., Washington, D.C. 20004
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mlavalleye@cov.com<<mailto:mlavalleye@cov.com>>

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From: Mike Swartz [<mailto:mswartz@egbertlawoffices.com>]
Sent: Wednesday, October 30, 2013 12:20 PM
To: Phelan, Patrick; Kevin Wilson
Cc: Leverich, Bingham; Lavalleye, Marie
Subject: Re: TTAB Opposition # 91210254 -- DURABOLIN

Dear Pat

We note that the Board recently issued an Order Denying the Motion for Summary Judgment in the "DECA-DURABOLIN" Opposition. We are wondering if you would consent to lift the suspension in the "DURABOLIN" Opposition and have that case consolidated with "DECA-DURABOLIN". Please let us know. Thanks.

If you have any questions or concerns, feel free to contact our office at any time.

Best regards,
Mike Swartz

Michael F. Swartz | Egbert Law Offices, PLLC | 1314 Texas, 21st Floor | Houston, Texas
77002 | Voice: 713-224-8080 | Fax: 713-223-4873

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