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

Proceeding	91209386
Party	Defendant Realty ONE Group, Inc.
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Date	07/31/2013
Attachments	RELTY.009M-014N-Response to Motion to Consolidate.pdf(136725 bytes)

RELTY.009M/014N TTAB

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

JEC II LLC and THE ONE GROUP LLC, Petitioners/Opposers, v. REALTY ONE GROUP, INC., Registrant/Applicant.	Proceeding No.: 92057487 Registration No.: 3,351,334 Mark: REALTY ONE GROUP A Team of Professionals Proceeding No.: 91209386 (consolidated with 92056849) Serial No.: 85/653,197 Mark: ONE Registration No.: 4,261,532 Mark: REALTY ONE GROUP I hereby certify that this correspondence and all marked attachments are being electronically filed with the Trademark Trial and Appeal Board through their web site located at http://estta.uspto.gov on: July 31, 2013 (Date) Jonathan A. Hyman

RESPONSE TO MOTION TO CONSOLIDATE

Commissioner for Trademarks
P.O. Box 1451
Arlington, VA 22313-1451

Dear Sir:

On July 2, 2013, JEC II LLC and THE ONE GROUP LLC (Collectively hereinafter referred to as "JEC") filed Cancellation No. 92057487 against REALTY ONE GROUP, INC.'s ("Realty") incontestable U.S. Trademark Registration No.: 3,351,334 for the mark REALTY ONE GROUP A Team of Professionals ("Cancellation Against Incontestable Registration"). The deadline to Answer or otherwise respond to the Cancellation Against Incontestable Registration is August 19, 2013.

JEC had previously file a cancellation action against Realty's U.S. Trademark Registration No.: 4,261,532 for the mark REALTY ONE GROUP and an opposition against Realty's U.S.

Trademark Application Serial No.: 85/653,197 for the mark

(the cancellation action against Reg. No. 4,261,532 and the opposition against Trademark App. No. 85/653,197 are collectively referred to herein as the "Previous Actions"). These Previous Actions were consolidated into Proceeding No. 91209386. On July 11, 2013, JEC filed a motion to consolidate the Previous Actions with the Cancellation Against Incontestable Registration.

However, consolidation of all three proceedings at this juncture is premature. Realty has not yet filed an Answer or otherwise responded to the Cancellation Against Incontestable Registration. Section 511 of the TBMP states that "[g]enerally, the Board will not consider a motion to consolidate until an answer has been filed (i.e., until issue has been joined) in each case sought to be consolidated." Accordingly, consolidation should not be granted at this time.

It should be noted that the Cancellation Action Against Incontestable Registration was filed against an incontestable registration that issued on December 11, 2007 and after the mark has been registered for over five years and the PTO acknowledged the Section 15 declaration. JEC alleges a claim under 2(a) based on the alleged fame of the petitioner. Realty is hopeful that the Board will carefully review the allegations made by JEC and *sua sponte* deny the 2(a) claim as it is nothing but a thinly disguised end-around the incontestability of Realty's U.S. Trademark Registration No.: 3,351,334 and an abuse of process. The relief requested by JEC under Section 2(a) is not what congress intended when it enacted Section 2(a) of the Lanham Act and, therefore, it should be stricken. *See* In re Cotter & Company, 228 USPQ 202 (TTAB 1985) ("The critical requirement, under this concept of the protection of one's identity, is that the name (or an equivalent thereof) claimed to be appropriated by another, is unmistakably associated with a particular personality or 'persona.'" *See also* The University of Notre Dame du Lac v. J.C. Gourmet Food Imports, Co., Inc., 703 F.2d 1372, 217 USPQ 505 (Fed.Cir. 1983) ("As the board noted, "Notre Dame" is not a name solely associated with the University. It serves to identify a famous and sacred religious figure and is

used in the names of churches dedicated to Notre Dame, such as the Cathedral of Notre Dame in Paris, France. Thus, it cannot be said that the only "person" which the name possibly identifies is the University and that the mere use of NOTRE DAME by another appropriates its identity."). The Board should use its discretion and strike the Section 2(a) claim.

Accordingly, Realty requests that the Board, at a minimum, deny the motion to consolidate all three proceedings at this time, at least until after Realty has initially responded to the Cancellation Action Against Incontestable Registration. In the event the Board grant's the motion to consolidate, Realty requests that the schedule for the consolidated proceedings be reset in its entirety for all three proceedings.

Dated: 7.31.13

Respectfully submitted,
KNOBBE, MARTENS, OLSON & BEAR, LLP

By: _____

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CERTIFICATE OF SERVICE

I hereby certify that I served a copy of the foregoing **RESPONSE TO MOTION TO CONSOLIDATE** upon counsel for JEC II LLC and THE ONE GROUP LLC by depositing one copy thereof in the United States Mail, first-class postage prepaid, on July 31, 2013, addressed as follows:

Jonathan M. Doloff, Esq.
PERGAMENT GILMAN & CEPEDA LLP
163 Madison Avenue, Suite 110
Morristown, NJ 07960

_____
Jonathan A. Hyman

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