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

Proceeding	91210145
Party	Plaintiff CFA Institute
Correspondence Address	Ann K. Ford DLA Piper LLP (US) 5008th Street, NW Washington, DC 20004 UNITED STATES Ann.Ford@dlapiper.com, John.Nading@dlapiper.com, Radiance.Harris@dlapiper.com, David.Huff@dlapiper.com
Submission	Motion to Consolidate
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

CFA INSTITUTE)	
)	
Opposer,)	Opposition No. 91204476
)	Service Mark: CDEA
)	Application Serial No.: 85/330,831
v.)	
)	
FINANCIAL INSTITUTE ADVISORS, LLC)	
)	
Applicant.)	
)	

CFA INSTITUTE)	
)	
Opposer,)	Opposition No. 91210145
)	Certification Mark: CDEA
)	Application Serial No.: 85/343,242
v.)	
)	
FINANCIAL INSTITUTE ADVISORS, LLC)	
)	
Applicant.)	
)	

MOTION TO CONSOLIDATE PROCEEDINGS AND RE-SET DATES

Pursuant to Rule 42(a) of the Federal Rules of Civil Procedure, as made applicable by Trademark Rule 37 C.F.R. § 2.116(a) and Trademark Trial and Appeal Board Manual of Procedure Section 511, Opposer CFA Institute (“Opposer”) moves the United States Trademark Trial and Appeal Board (“Board”) for an order consolidating the above-referenced Opposition

Proceedings and re-setting the discovery and testimony schedule for the consolidated proceeding, for the reasons set forth herein.¹

Applicant Financial Institute Advisors, LLC (“Applicant”) owns the two applications at issue in the above-referenced Opposition Proceedings: U.S. Application Serial No. 85/330,831 for the service mark CDFA, used in connection with “providing education in the field of financial analysis rendered through correspondence schools; arranging and conducting educational workshops, training courses, conferences and seminars in the field of financial analysis and the distribution of course materials in connection therewith,” in International Class 41 (“Service Mark”), and U.S. Application Serial No. 85/343,242 for the certification mark CDFA, used in connection with “financial analyses in the field of divorce” in International Class B (“Certification Mark”) (Service Mark and Certification Mark, collectively, the “Applications”). Opposer filed Notices of Opposition against the Applications alleging likelihood of confusion and dilution by blurring.

Under Federal Rule of Civil Procedure 42(a), as made applicable by 37 C.F.R. § 2.116(a), cases may be consolidated when they involve common questions of law or fact. Here, Opposition Nos. 91204476 and 91210145 involve common questions of law and fact. Both Opposition Proceedings involve Applicant’s CDFA Mark for the same or closely related services/certification – educational services in the field of financial analysis and certification of financial analyses services. Applicant’s CDFA Service Mark and Certification Mark have the

¹ The undersigned counsel for Opposer, Ann Ford, spoke with counsel for Applicant, Devon White, on April 12, 2013 regarding Applicant’s consent to a motion to consolidate. Ms. White did not indicate an objection on the call. Counsel for Opposer provided Ms. White with a draft consented motion later that same day for her review and approval, and followed up on April 15 regarding same. Having still not received a response from Applicant’s counsel, Opposer filed the instant Motion.

same alleged dates of first use and first use in commerce. In both Opposition Proceedings, Opposer has alleged the same two grounds – likelihood of confusion and dilution – and relies on the same federal trademark registrations (in Opposition Proceeding No. 91210145, Opposer has included an additional registration which issued subsequent to filing the first Notice of Opposition in Opposition Proceeding No. 91204476).

Opposer filed the Notice of Opposition to the CDFA Service Mark, which became Proceeding No. 91204476, on March 28, 2012, and Applicant filed its Answer on April 20, 2012. Opposer and Applicant then engaged in good faith settlement negotiations. Recently, on April 5, 2013, Opposer and Applicant served their respective first sets of written discovery requests, including requests for admissions, interrogatories, and requests for documents. The parties' discovery responses are due May 5, 2013. The next deadlines in Opposition Proceeding No. 91204476 are for expert disclosures on May 4, 2013, followed by the close of discovery on June 3, 2013.

On April 9, 2013, Opposer filed the Notice of Opposition to the CDFA Certification Mark, which became Opposition Proceeding No. 91210145. Applicant's deadline to respond to the Notice of Opposition is May 19, 2013.

As a result of the commonality of questions of law and fact, consolidation of these Opposition Proceedings will save the Parties and the Board substantial time, effort, and expense.

Accordingly, Opposer respectfully requests that the Board grant this motion and consolidate these Opposition Proceedings. Given the upcoming deadline for expert disclosures on May 4, 2013 in Opposition Proceeding No. 91204476, Opposer further requests the Board suspend Opposition Proceeding No. 91204476 pending the outcome of the instant motion.

Respectfully submitted,

Dated: April 17, 2013

DLA PIPER LLP (US)

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CERTIFICATE OF SERVICE

This is to certify that a copy of the foregoing **MOTION TO CONSOLIDATE PROCEEDINGS AND RE-SET DATES** was served via electronic mail, as agreed to by the Parties, and First Class U.S. Mail, postage prepaid, and properly addressed to Applicant's counsel of record:

Devon E. White, Esq.
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this 17th day of April, 2013.

/s/ Ann K. Ford

Ann K. Ford
Attorney for Opposer