UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

EJW

Mailed: March 17, 2016

Opposition No. 91222214

Dandy Products, Inc.

v.

Nicolon Corporation

ELIZABETH J. WINTER, INTERLOCUTORY ATTORNEY:

This case now comes up on Applicant's renewed and amended contested motion (filed December 29, 2015) to consolidate Opposition Nos. 91222214, 91222215, and 91222223. By way of background, each proceeding involves Applicant Nicolon Corporation and its pending Application Serial No. 86057945.[1]

Applicant requests that the above-referenced proceedings be consolidated because the defending party, the involved mark, and two of Opposers' claims are identical and the proceedings are at the same stage. As regards Opposers' respective claims, Applicant points out specifically that all three Opposers oppose registration on the basis that the applied-for mark is functional under Section 2(e)(5) of the Trademark Act and that Applicant's mark has not acquired

[1] Application Serial No. 83057945, filed under Section 1(a) of the Trademark Act on September 6, 2013, for the mark "consist[ing] of the color orange as applied to one or more yarns or threads woven into the body of geosynthetic or geotextile fabric of indefinite length and width producing a radiant orange surface when light strikes the fabric."

distinctiveness under Section 2(f)[2] of the Trademark Act. Applicant also asserts that Opposers will not be prejudiced by consolidation insofar as cases do not lose their separate identity when consolidated and, with respect to Opposer Lumite's likelihood of confusion claim and Opposers' Lumite and Dandy Products's inequitable conduct/fraud claims, if the Sections 2(e)(5) and 2(f) claims are resolved, the other claims may move forward in separate proceedings, as necessary. Additionally, Applicant contends that in view of the claims involved, each opposition will require substantially similar evidence, discovery, witnesses, testimony and arguments and that, if consolidation is ordered, Applicant's witnesses will not need to be deposed three times and triplicate discovery will be avoided.

In response, Opposer argues that the motion should be denied for four reasons. First, Opposer explains that the three opposers have substantially different business interests, that is, Opposer is a customer of Applicant's, whereas the other opposers are competitors of Applicant. In view thereof, Opposer contends that the evidence to be sought during discovery and adduced in support of their respective claims will likely be different. Opposer also points out that the claims are not "nearly identical" as asserted by Applicant and, in particular, Opposer's likelihood of confusion claim involves substantially different issues and evidence than in the other oppositions, which do not involve such a claim.[3] Inasmuch as the three opposers have different business and legal positions, Opposer posits that the parties

[2] Although Applicant refers to Section 2(e) in its motion, the applicable statute is Section 2(f) of the Trademark Act.

[3] Additionally, only Opposition Nos. 91222215 and 91222223 include a claim of inequitable conduct or fraud.

would have difficulty identifying lead counsel to supervise and coordinate the conduct of the opposers' cases and to provide a single point of contact with the Board. Opposer also argues that the potential prejudice and additional costs to Opposer, such as by having to cross-examine witnesses of the other opposers, outweigh any burden on Applicant in defending multiple proceedings.

- *Decision*

When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991). 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 which may be caused thereby. Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. *See, e.g.*, *Hilson Research Inc. v. Society for Human Resource Management*, 27 USPQ2d 1423 (TTAB 1993). As regards multiple oppositions that are filed against the same application, although they typically proceed simultaneously (*New Orleans Louisiana Saints LLC v. Who Dat? Inc.,* 99 USPQ2d 1550 (TTAB 2011)), when they are at the same stage of litigation and plead the same claims, the Board may order consolidation. *Id.* at 1551 (citing *Stuart Spector Designs Ltd. v. Fender Musical*

Instruments Corp., 94 USPQ2d 1549 (TTAB 2009); *DataNational Corp. v. BellSouth Corp.,* 18 USPQ2d 1862 (TTAB 1991)). *See also* TBMP § 511 (2015).

The Board is not persuaded that consolidation is appropriate in this instance. Although each opposition is in a similar stage and involves claims under Trademark Act Sections 2(e)(5) and/or Sections 1, 2 and 45 against the same application, the parties are unrelated and may have different interests, and the claims involved in each proceeding are not the same, therefore, the issues of fact and law are not identical. As a consequence, consolidation of the three proceedings would not save the Board time or effort; rather, it would risk causing confusion of the issues before the Board in each proceeding. Accordingly, Applicant's motion to consolidate is **denied**.

Proceeding Resumed; Trial Dates Reset

This proceeding is resumed. Trial dates are reset as shown in the following schedule:

Discovery Opens	**3/18/2016**
Initial Disclosures Due	**4/17/2016**
Expert Disclosures Due	**8/15/2016**
Discovery Closes	**9/14/2016**
Plaintiff's Pretrial Disclosures Due	**10/29/2016**
Plaintiff's 30-day Trial Period Ends	**12/13/2016**
Defendant's Pretrial Disclosures Due	**12/28/2016**
Defendant's 30-day Trial Period Ends	**2/11/2017**
Plaintiff's Rebuttal Disclosures Due	**2/26/2017**
Plaintiff's 15-day Rebuttal Period Ends	**3/28/2017**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party **WITHIN THIRTY DAYS** after completion of the taking of testimony. *See* Trademark Rule 2.125, 37 C.F.R. § 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b), 37 C.F.R. §§ 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129, 37 C.F.R. § 2.129.

☼☼☼