

ESTTA Tracking number: **ESTTA803264**

Filing date: **02/23/2017**

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

Proceeding	91231662
Party	Defendant Confluence Outdoor, LLC
Correspondence Address	JACK B HICKS WOMBLE CARLYLE SANDRIDGE & RICE LLP ONE WEST FOURTH STREET WINSTON-SALEM, NC 27101 UNITED STATES jhicks@wcsr.com, jwharton@wcsr.com
Submission	Motion to Consolidate
Filer's Name	Jacob S. Wharton
Filer's e-mail	jwharton@wcsr.com, jhicks@wcsr.com, krwebb@wcsr.com, tmdocketting@wcsr.com
Signature	/Jacob S. Wharton/
Date	02/23/2017
Attachments	Consent Motion.pdf(12817 bytes )

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

**In the Matter of Trademark Application No. 86864274  
Published on July 19, 2016  
Mark: HELIX PD**

**In the Matter of Trademark Application No. 86864279  
Published on August 16, 2016  
Mark: HELIX MD**

<b>JOHNSON OUTDOOR MARINE</b>	)	
<b>ELECTRONICS, INC.,</b>	)	
	)	
<b>Opposer,</b>	)	<b>Opposition No. 91231199</b>
	)	<b>Opposition No. 91231662</b>
<b>v.</b>	)	
	)	
<b>CONFLUENCE OUTDOOR, LLC,</b>	)	
	)	
<b>Applicant</b>	)	
	)	

**OPPOSERS' CONSENT MOTION TO CONSOLIDATE PROCEEDINGS  
AND MEMORANDUM OF LAW IN SUPPORT THEREOF**

Pursuant to Rule 42(a) of the Federal Rules of Civil Procedure and Section 511 of the Trademark Trial and Appeal Board Manual of Procedure, Applicant Confluence Outdoor, LLC (hereinafter, "Applicant"), moves to consolidate the two above-captioned proceedings (hereinafter, "the Oppositions") for purposes of trial and pre-trial proceedings, and reset times for discovery and testimony periods. Applicant has consulted with Opposer, who consents to this motion.

The following table summarizes the trademark applications ("Applicant's Marks") which are the subject of the Opposition Proceedings referenced above.

<b>Mark and Serial Number</b>	<b>Description of Goods and Services</b>	<b>Opposition Number</b>
HELIX PD (SN 86864274)	Human powered pedal propulsion system for kayaks comprised of propellers and pedals	91231199
HELIX MD (SN 86864279)	Marine engine propulsion and motor system for kayaks comprised of motors and propellers	91231662

In support of this Motion, Applicant states the following:

1. The parties to the Oppositions are the same;
2. The mark (HELIX) asserted by Opposer in the Oppositions is identical, and the opposed marks (HELIX MD and HELIX PD) share similar characteristics;
3. Opposer's goods (sonar depth finders and fish finders) at issue in the Oppositions are identical since the same mark is the basis of both Oppositions, and Applicant's goods in the applications both relate to specific propulsion systems;
4. The pleadings in the Oppositions are nearly identical;
5. The legal and factual issues in the Oppositions are closely related;
6. Applicant believes discovery requests in the Oppositions will be identical or substantially similar;
7. As Applicant has just filed its answers, affirmative defenses, and counterclaims in the Oppositions, Applicant would not expect consolidation to cause prejudice or inconvenience to Opposer and, instead, would provide efficiencies and cost saving measures;
8. Consolidation will save the Board and the parties time, effort, and expense.

### **ARGUMENT**

#### **I. CONSOLIDATION STANDARD**

Under Rule 42(a) of the Federal Rules of Civil Procedure, consolidation is proper when

actions involve “a common question of law or fact.” FED. R. CIV. P. 42(a); *see also S. Industries Inc. v. Lamb-Weston Inc.*, 45 USPQ2d 1293, 1297 (TTAB 1997) (both proceedings involved the same mark and virtually identical pleadings); *Ritchie v. Simpson*, 41 USPQ2d 1859 (TTAB 1996), *rev’d on other grounds*, 170 F.3d 1092, 50 USPQ2d 1023 (Fed. Cir. 1999) (cases consolidated despite variations in marks and goods). The decision to consolidate proceedings rests within the discretion of the Board. In deciding whether to consolidate, the Board weighs “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.

## **II. CONSOLIDATION IS PROPER BECAUSE THE OPPOSITIONS INVOLVE COMMON QUESTIONS OF LAW AND FACT.**

The issues in the two Oppositions are closely related if not substantially identical. The parties in all Oppositions are the same. Applicant’s Marks are HELIX MD and HELIX PD and both are for use in connection with propulsion systems for kayaks (one involving human powered systems and one involving engine propulsion). In each Opposition, Opposer relies on the identical application and registration for the mark HELIX (“Opposer’s Mark”), and asserts the same claims. Specifically, the Notice of Opposition for each case alleges that Applicant’s Marks are likely to cause confusion, to cause mistake and/or to deceive, and harm Opposer’s alleged trademark rights. The Answers, Affirmative Defenses, and Counterclaim in each Opposition are essentially identical. In view of the substantially identical grounds for opposition in all pending proceedings, common questions of law and fact are involved in each proceeding. Furthermore, both Oppositions are now ready to enter the discovery period. Thus now is an appropriate time to consolidate and issue a joint scheduling order controlling discovery. Accordingly, consolidation will result in savings in time, effort and expense. Applicant is aware of no reason why consolidation would cause prejudice or inconvenience to Opposer.

Counsel for Applicant requested Opposer's counsel's consent to consolidation of the Oppositions, and Opposer's counsel consented to the relief sought by way of this motion.

### III. CONCLUSION

Consolidation of the Oppositions is appropriate due to the substantial commonality of factual and legal issues in the proceedings. Because the Oppositions involve the same parties, marks, and claims, consolidation will streamline the issues and avoid unnecessary costs and delays. Therefore, pursuant to TBMP Section 511 and Rule 42(a) of the Federal Rules of Civil Procedure, Applicant respectfully requests that the Board grant consolidation of the Oppositions. Applicant also requests that the Board suspend all proceedings until the Board rules on this motion. Following the disposition of this motion, Applicant requests that the discovery and testimony periods be reset to allow the parties to complete discovery and to take testimony in a consolidated proceeding.

CONFLUENCE OUTDOORS, LLC,

By its Attorneys

February 23, 2017

*/Jacob S. Wharton/*

Jack B. Hicks

Jacob S. Wharton

WOMBLE CARLYLE SANDRIDGE & RICE, LLP

One West Fourth Street

Winston-Salem, NC 27101

Tel: (336) 747-6609

Fax: (336) 726-6986

E-Mail: [jhicks@wcsr.com](mailto:jhicks@wcsr.com)

[jwharton@wcsr.com](mailto:jwharton@wcsr.com)

**CERTIFICATE OF MAILING**

I hereby certify that on February 23, 2017, I filed via electronic means (ESTTA) this OPPOSER'S CONSENT MOTION TO CONSOLIDATE PROCEEDINGS AND MEMORANDUM OF LAW IN SUPPORT THEREOF with the:

U. S. Patent and Trademark Office  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

/Kristin Webb/  
Kristin Webb

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing OPPOSER'S CONSENT MOTION TO CONSOLIDATE PROCEEDINGS AND MEMORANDUM OF LAW IN SUPPORT THEREOF has been served on Opposer's counsel by mailing said copy on February 23, 2017 via First Class Mail, postage prepaid to:

Gordon M. Wright, Esq.  
REINHART BOERNER VAN DEUREN P.C.  
2215 Perrygreen Way  
Rockford, Illinois 61107

/Kristin Webb/  
Kristin Webb