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Filing date: **06/30/2020**

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

Proceeding	91232721
Party	Plaintiff The Port Authority of New York and New Jersey
Correspondence Address	MICHAEL A GELLER DLA PIPER LLP US 444 WEST LAKE STREET, SUITE 900 CHICAGO, IL 60606 UNITED STATES keith.medansky@dlapiper.com, michael.geller@dlapiper.com, leon.medzhibovsky@dlapiper.com, ch.tm@dlapiper.com 312-368-2152
Submission	Motion to Consolidate
Filer's Name	Michael Geller
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Signature	/Michael Geller/
Date	06/30/2020
Attachments	Port Authority - Motion to Consolidate WTC and WTC WTC LOGISTICS LIMITED.pdf(186310 bytes )

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

THE PORT AUTHORITY OF NEW YORK AND )	
NEW JERSEY, )	
)	
Opposer, )	
)	Opposition Nos.: 91232721
v. )	91242893
)	
WTC LOGISTICS LIMITED, )	
)	
Applicant. )	

**OPPOSER’S MOTION TO CONSOLIDATE**

Pursuant to Fed. R. Civ. P. 42(a) and Trademark Trial and Appeal Board Manual of Procedure Section 511 (“TBMP”), Opposer The Port Authority of New York and New Jersey (“ICE”) moves to consolidate the captioned proceedings, namely, Opposition Nos. 91232721 and 91242893 filed by Opposer against WTC Logistics Limited (“Applicant”). The proceedings should be consolidated because they involve the same parties and nearly identical marks.

**I. BACKGROUND**

**A. The WTC (and design) Opposition**

On May 10, 2016, Applicant filed an application for the mark WTC (and design) covering the following mark:



The application was assigned U.S. Serial No. 87/030,567 (the “567 Application”) and covers the following services in Class 37:

Arranging for travel visas, passports and travel documents for persons traveling abroad; Arranging transport for travelers; Freight forwarding services; Postal, freight and courier services; Rental of trucks; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transportation and storage of goods; Wrapping services for baggage protection during travel.

The '567 Application was published on October 4, 2016, and after extending the time to oppose, Opposer filed a notice of opposition against the application on February 1, 2017.

[Opposition No. 91232721, TTABVUE 1]

On January 1, 2018, Opposer filed a motion to suspend the opposition pending litigation involving Opposer's trademark, [Opposition No. 91232721, TTABVUE 17], and the Board suspended the opposition on August 1, 2018. [Opposition No. 91232721, TTABVUE 18]. On November 11, 2019, after said litigation was disposed, Opposer filed a motion to resume the opposition against the '567 Application. [Opposition No. 91232721, TTABVUE 24]. The Board resumed the proceedings on November 19, 2019. [Opposition No. 91232721, TTABVUE 25].

**B. The WTC WTC LOGISTICS LIMITED (and design) Opposition**

On October 13, 2017, Applicant filed an application for mark WTC WTC LOGISTICS LIMITED (and design) covering the following mark:



The application was assigned U.S. Serial Number 87/644,170 (the "'170 Application") and covers the following services in Class 37:

Arranging transport for travelers; Arranging for travel visas, passports and travel documents for persons traveling abroad; Freight forwarding services; Postal, freight and courier services; Rental of trucks; Supply chain logistics and reverse logistics services, namely, storage, transportation and delivery of goods for others by air, rail, ship or truck; Transportation and storage of goods; Wrapping services for baggage protection during travel.

The '170 Application was published on April 3, 2018, and after extending the time to oppose, Opposer filed a notice of opposition against the application on August 1, 2018. [Opposition No. 91242893, TTABVUE 1].

On August 8, 2018, Opposer filed a motion to suspend the opposition pending litigation involving Opposer's trademark, [Opposition No. 91242893, TTABVUE 4], and the Board suspended the opposition on September 10, 2018. [Opposition No. 91242893, TTABVUE 5]. On November 11, 2019, after said litigation was disposed, Opposer filed a motion to resume the opposition against the '170 Application. [Opposition No. 91242893, TTABVUE 9]. The Board has not yet ruled on said motion to resume the proceedings.

**C. No Response from Respective Applicant's Counsel**

On June 11, 2020, Opposer's counsel contacted Applicant's respective counsel for the '576 Application and the '170 Application to request consent to consolidate the oppositions against the respective marks. Declaration of Michael Geller ("Geller Declaration") ¶ 2, Ex. A. When neither counsel for the '576 Application nor counsel for the '170 Application responded, on June 24, 2020, Opposer's counsel followed up with a second email to Applicant's counsel requesting a response. Geller Declaration, ¶ 3. Applicant's counsel did not respond and, to date, has not responded. Geller Declaration, ¶ 4. Thus, Opposer is forced to make this motion.

## II. ARGUMENT

Consolidation of Opposition No. 91232721 and Opposition No. 91242893 is proper because the proceedings involve common questions of law and fact because the parties are identical, the opposed marks are highly similar, and consolidation will save the parties' and the Board's time and resources.

Actions may be consolidated if they "involve a common question of law or fact." Fed. R. Civ. P. 42(a); TBMP § 511 (2020). "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 that may be caused thereby." TBMP § 511.

In this case, consolidation is proper because (1) both proceedings involve the same parties; (2) both proceedings involve nearly identical marks with common questions of law and fact concerning the confusing similarity of the WTC trademark; and (3) consolidation will cause no prejudice or inconvenience to either party as both proceedings are in early stages.

First, consolidation is proper because both proceedings involve highly similar marks with common questions of law and fact concerning the confusing similarity of Opposer's WTC trademark to Applicant's WTC (and design) and WTC WTC LOGISTICS LIMITED (and design) trademarks. The most distinctive element of each mark is the WTC designation; the other terms in the WTC WTC LOGISTICS LIMITED mark are descriptive or generic and are therefore disclaimed. Thus, the minor differences between Applicant's WTC (and design) and WTC WTC LOGISTICS LIMITED (and design) marks are unlikely to carry significant weight. Correspondingly, both proceedings involve common questions of law and fact concerning

whether Applicant's WTC (and design) and WTC WTC LOGISTISCS LIMITED (and design) marks are confusingly similar to Opposer's WTC trademark.

Second, consolidation is proper because each opposition involves the same parties.

Finally, consolidation is proper because consolidation will cause no prejudice or inconvenience to either party as both cases are in early stages. Opposition No. 91242893 is in its infancy – the Opposer has not even filed its Answer. In Opposition No. 91232721, fact discovery is still open, suggesting consolidation is proper and neither party will face prejudice. *Cf. Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982) (refusing to consolidate proceedings where one case was in the pleading stage and testimony periods had already expired in the other). In fact, Opposer would have filed the motion to consolidate sooner, but it has been awaiting the Board's ruling on the motion to resume proceedings in Opposition No. 91242893.

The proceedings can therefore be consolidated without prejudice or inconvenience to either party because both proceedings are still in the discovery phase.

Consolidation is generally favored after an answer is filed in each proceeding. TBMP § 511. In this case, the Board has not yet acted on Opposer's motion to resume Opposition No. 91242893, TTABVUE 9; thus, an answer cannot be filed in that case. Therefore, if the Board does not grant Opposer's motion outright, Opposer requests that the Board: (1) grant its motion to resume Opposition No. 91242893; (2) suspend Opposition No. 91232721 pending an Answer being filed in Opposition No. 91242893; and (3) if an Answer is filed in Opposition No. 91242893, granting the motion to consolidate.

### III. CONCLUSION

In view of the foregoing, Opposer requests that the Board consolidate Opposition Nos. 91242893 and 91233721, with Opposition No. 91232721 serving as the "parent case."

Pursuant to 37 CFR § 2.120(j)(1), Opposer requests that this motion be resolved telephonically to ensure scheduling issues do not arise in connection with Opposition No. 91232721.

Dated: June 30, 2020

DLA PIPER LLP (US)

By:  /s/ Michael Geller

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Keith Medansky  
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Michael A. Geller  
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444 West Lake Street  
Suite 900  
Chicago, Illinois 60606-0089  
Phone: (312) 368-4000  
Fax: (312) 236-7516

**CERTIFICATE OF SERVICE**

The undersigned counsel of record hereby certifies that a true and correct copy of the Motion to Consolidate has been served upon the following:

KEVIN VIAU  
IP LAW GROUP LLP  
12 S FIRST STREET 12TH FLOOR  
SAN JOSE, CA 95113  
UNITED STATES  
tm\_docket@iplg.com  
Phone: 408-286-8933

CYRENA NG  
BKIP  
160 GLOUCESTER ROAD , 19B OTB BUILDING  
WANCHAI,  
HONG KONG  
tm@bkip.com.hk, cyrenang@bk.com.hk

via email, this 30th day of June, 2020.

By: /s/ Michael Geller  
Michael Geller

EAST\173898543.3



**EXHIBIT A**

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

THE PORT AUTHORITY OF NEW YORK AND )	
NEW JERSEY, )	
	)
Opposer, )	
	)
v. )	Opposition Nos.: 91232721
	91242893
	)
WTC LOGISTICS LIMITED, )	
	)
Applicant. )	

**DECLARATION OF MICHAEL A. GELLER  
IN SUPPORT OF MOTION FOR CONSOLIDATION**

I, Michael A. Geller, pursuant to 28 U.S.C. § 1746, hereby declare as follows:

1. I am legal counsel for Opposer The Port Authority of New York and New Jersey (“Opposer”) in the captioned matter. I have personal knowledge of the facts set forth below, and if called upon to testify, I could and would do so competently.

2. On June 11, 2020, Opposer’s counsel contacted Applicant’s respective counsel for the ‘576 Application and the ‘170 Application to request consent to consolidate the oppositions against the respective marks. A true and correct copy of the email is attached to this declaration as Exhibit A-1.

3. When neither counsel for the ‘576 Application nor counsel for the ‘170 Application responded, on June 24, 2020, Opposer’s counsel followed up with a second email to Applicant’s counsel requesting a response. A true and correct copy of the email is attached to this declaration as Exhibit A-2.

4. Applicant’s counsel did not respond and, to date, has not responded.

/

/

I declare under the penalty of perjury that the foregoing is true and correct, and that this declaration was executed on June 30, 2020, in Chicago, Illinois.

/s/ Michael Geller  
Michael A. Geller

EAST\166573927.1

**EXHIBIT A-1**

## Geller, Michael

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**From:** Geller, Michael  
**Sent:** Thursday, June 11, 2020 11:49 AM  
**To:** Kevin Viau; Trademark Department; tm@bkip.com.hk; cyrenang@bk.com.hk  
**Cc:** Medansky, Keith W.; Kernen, Joseph; TrademarkDocketChica@dlapiper.com  
**Subject:** Request for Consent to Consolidate WTC (and design) and WTC WTC LOGISTICS LIMITED (and design) Oppositions

Dear Kevin and BKIP,

As you know, the Port Authority of New York and New Jersey has opposed WTC Logistics Limited's U.S. trademark applications for WTC (and design) (Serial No. ) and WTC WTC LOGISTICS LIMITED (and design) (Serial No. 87644170). Mr. Viau is counsel of record in the former case, and BKIP is the correspondent of record in the second. The first case has been resumed after its suspension, but the Board has unfortunately yet to rule on our motion to resume proceedings in the second.

Given the common questions of fact and law in the cases because they involve nearly identical marks, the Port Authority plans to move to consolidate the opposition proceedings. Please advise if WTC Logistics Ltd. will consent to such a motion, in which case we will draft a consent motion for your review. If not, the Port Authority plans to move for consolidation and to request again that the Board reopen the proceedings in the WTC WTC LOGISTICS (and design) proceeding.

We request your response by close of business on June 16, 2020. If you would like to discuss, please let us know.

Best regards,

**Michael Geller**

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United States  
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**EXHIBIT A-2**

## Geller, Michael

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**From:** Geller, Michael  
**Sent:** Wednesday, June 24, 2020 12:52 PM  
**To:** Kevin Viau; Trademark Department; tm@bkip.com.hk; cyrenang@bk.com.hk  
**Cc:** Medansky, Keith W.; Kernen, Joseph; TrademarkDocketChica@dlapiper.com  
**Subject:** RE: Request for Consent to Consolidate WTC (and design) and WTC WTC LOGISTICS LIMITED (and design) Oppositions

Dear Counsel,

We have not received a response to this correspondence. We kindly ask you to respond.

Regards,  
Michael

### Michael Geller

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**From:** Geller, Michael  
**Sent:** Thursday, June 11, 2020 11:49 AM  
**To:** Kevin Viau <kviau@iplg.com>; Trademark Department <tm@iplg.com>; tm@bkip.com.hk; cyrenang@bk.com.hk  
**Cc:** Medansky, Keith W. <keith.medansky@us.dlapiper.com>; Kernen, Joseph <joseph.kernen@us.dlapiper.com>; TrademarkDocketChica@dlapiper.com  
**Subject:** Request for Consent to Consolidate WTC (and design) and WTC WTC LOGISTICS LIMITED (and design) Oppositions

Dear Kevin and BKIP,

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