ESTTA Tracking number: **ESTTA984725**

Filing date: **07/01/2019**

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

Proceeding	91247175
Party	Plaintiff Atara Biotherapeutics, Inc.
Correspondence Address	DAVID E HEIDEY SHEPPARD MULLIN RICHTER & HAMPTON LLP 12275 EL CAMINO REAL, SUITE 200 SAN DIEGO, CA 92130-2006 UNITED STATES docketing@sheppardmullin.com, jsalen@sheppardmullin.com 858-720-8900
Submission	Opposition/Response to Motion
Filer's Name	Jesse A. Salen
Filer's email	docketing@sheppardmullin.com, jsalen@sheppardmullin.com, jelee@sheppardmullin.com
Signature	/Jesse A. Salen/
Date	07/01/2019
Attachments	Opp to App Mtn to Consolidate - ALLOCAR T 4829-5233-2955 v.2.pdf(151503 bytes)

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

In the matter of Application Serial No. 88/117,993
For the mark ALLOCAR T
Published in the Official Gazette on February 26, 2019

Atara Biotherapeutics, Inc., Opposer, Allogene Therapeutics, Inc., Applicant.	Opposition No. 91247175

TABLE OF CONTENTS

Page

ATARA'S OPPOSITION TO ALLOGENE'S MOTION TO CONSOLIDATE

Opposer, Atara Biotherapeutics, Inc. ("Atara") responds as follows to Applicant, Allogene Therapeutics, Inc.'s ("Allogene") Motion to Consolidate Opposition No. 91247175 (the "Atara Opposition") with Opposition No. 91247245 (the "CRISPR Opposition") because: (i) the two proceedings involve different parties and facts; and (ii) the two proceedings are at different stages such that consolidation will unduly prejudice Atara by unnecessarily delaying the trial schedule in the Atara Opposition to coincide with the delayed trial schedule of the CRISPR Opposition. Accordingly, Atara respectfully requests that Allogene's Motion to Consolidate be denied in its entirety.

I. INTRODUCTION AND BACKGROUND

Atara brought the instant action to stop its competitor, Allogene, from monopolizing the use of the descriptive and/or generic term "ALLOCAR T." (Atara Opposition, Dkt. 1 at ¶¶ 16-22.) As explained in Atara's Notice of Opposition, the terms "CAR T," "allogeneic CAR T," and "allo CAR T" are commonly used in the pharmaceutical industry to describe immunotherapies that use allogeneic CAR-T cells. (*Id.* at ¶ 4.) Atara directly competes with Allogene to develop allo CAR T immunotherapy treatments, and thus, Allogene's federal registration for trademark protection of ALLOCAR T will directly impact and harm Atara. (*Id.* at ¶¶ 10-15.).

On March 25, 2019 Atara filed its Notice of Opposition challenging Allogene's U.S. Application Serial No. 88/117,993 (the "Application") based on Atara's assertion that the term "ALLOCAR T" merely describes and/or is generic of a characteristic of the goods that each party markets and Allogene's federal trademark registration of that term would "improperly and unfairly restrict the public, including Atara, from using the term in advertising or describing its own goods and services." (*Id*. at ¶ 15.)

On March 27, 2019 CRISPR Therapeutics, AG, ("CRISPR") also filed a Notice of Opposition against Allogene's registration of the term ALLOCAR T on similar grounds. (CRISPR Opposition, Dkt. 1 ¶ 24.) Despite being based on similar ground, the two notices of opposition look vastly different and are based on different factual allegations. (Compare Atara Opposition, Dkt. 1 with CRISPR Opposition, Dkt. 1.) On May 6, 2019, Applicant moved to dismiss the CRISPR Opposition. (CRISPR Opposition, Dkt. 4.) In response, on May 28, 2019, CRISPR moved to amend the CRISPR Opposition. (CRISPR Opposition, Dkt. 6.) On May 30, 2019, the Board accepted CRISPR's motion to amend, and on June 10, 2019, the Board set new trial dates in the CRISPR Opposition that lag behind the Atara Opposition by nearly two months. (CRISPR Opposition, Dkt. 9.)

On June 10, 2019, Allogene filed the present Motion. Atara respectfully requests that the Board deny Allogene's Motion because the two proceedings

involve different facts, parties, and trial schedules such that consolidation will unnecessarily delay the Atara proceeding and prejudice Atara.

II. ARGUMENT

In its Motion, Allogene contends that the respective oppositions reference common questions of law and fact and are at similar stages, and that consolidation will ensure juridical economy without prejudice. But Allogene mischaracterizes the facts and misapplies the law.

The Board has discretion to grant a motion to consolidate. TBMP § 511. In considering whether to consolidate proceedings, the Board "weigh[s] the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby." *Id.* Consolidation is not appropriate in cases that do not "involve a common question of law or fact." *Id.*; *see also* Fed. R. Civ. P. 42(a). Here, these factors weigh against consolidating the Atara and CRISPR Oppositions.

A. The Parties and Issues Presented in the Operative Pleadings in Each Opposition Substantially Differ.

Consolidation should be denied because the parties, factual allegations, and claims alleged in the respective proceedings substantially differ. Specifically, the two proceedings have been brought by disparate parties. Neither the Atara Opposition nor the CRISPR Opposition allege, explicitly or implicitly, that Atara

and CRISPR offer the same goods and/or services. Accordingly, the outcome of the two proceedings may affect the two opposers differently, and may provide different settlement opportunities, such that treating the proceedings together would potentially prejudice both opposers. *See Fisons Ltd. v. Capability Brown Ltd.*, 209 U.S.P.Q. 167 (TTAB 1980) (finding consolidation to be prejudicial when the interests of the parties vary substantially); *see also Izod, Ltd. v. La Chemise Lacoste,* 178 U.S.P.Q. 440 (TTAB 1973) (declining to consolidate proceedings because the respective issues differed in character and scope). Thus, consolidating the proceedings would potentially risk confusing the respective issues involved in each individual proceeding. Such risk of confusion outweighs the potential judicial economy that would result from consolidation. *See BellSouth Intellectual Prop Corp. v. RealTelephony, Inc.*, (TTAB 2002). Accordingly, this factor weighs against consolidation.

B. Consolidation Would Unnecessarily Delay the Trial Schedule in the Atara Opposition.

The Atara Opposition and CRISPR Opposition will proceed with different effective trial schedules, such that consolidation will be inefficient and unduly prejudicial to Atara.

In the Atara Opposition, discovery opened, the parties held a discovery conference, and Atara has served its initial disclosures and first sets of discovery

requests. Allogene's initial disclosures are due on July 3, 2019, and trial disclosure deadlines and briefing dates are set to commence on January 14, 2020 and conclude on September 25, 2020. (Atara Opposition, Dkt. 2.) In contrast, the trial schedule for the CRISPR Opposition now lags behind that of the Atara Opposition by approximately two months. (CRISPR Opposition, Dkt. 9; Atara Opposition Dkt. 2.) For example, in the CRISPR Opposition, discovery will not open until July 29, 2019, and the trial disclosure deadlines and briefing dates are set to commence on March 10, 2020 and conclude November 20, 2020. (*Id*.) Therefore, the proceeding will likely be set at least 3 months after the trial dates in the Atara Opposition. Thus, consolidating the two actions will substantially delay the Atara Opposition trial schedule.

Delaying the trial schedule in the Atara Opposition will prejudice Atara because it will leave unresolved the issue as to whether Atara may freely use the descriptive and/or generic term, Allo CAR T, on its marketing materials and products. Accordingly, this factor also weighs against consolidating the two proceedings.

III. CONCLUSION

For at least the foregoing reasons, Atara respectfully requests that the Allogene's Motion to Consolidate be denied.

Dated: July 1, 2019

Respectfully submitted,

By /*Jesse A. Salen*/
DAVID E. HEISEY
JESSE A. SALEN

Attorneys for Atara Biotherapeutics, Inc.

CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that the foregoing "Atara's Opposition to Allogene's Motion to Consolidate" is being transmitted electronically to Commissioner of Trademarks, Attn: Trademark Trial and Appeal Board through ESTTA pursuant to 37 C.F.R. §2.195(a), on this 1st day of July, 2019.

/Jennifer Lee/
Jennifer Lee

CERTIFICATE OF SERVICE

I hereby certify that the foregoing "Atara's Opposition to Allogene's Motion to Consolidate" has been electronically served upon Applicant by e-mailing a copy to the following addressee(s):

JASON S. HOWELL
PERKINS COIE LLP
1900 SIXTEENTH STREET, SUITE 1400
DENVER, CO 80202
pctrademarks@perkinscoie.com; JHowell@perkinscoie.com,
AJAGarcia@perkinscoie.com, SDanielson@perkinscoie.com,
CGanin@perkinscoie.com

on this 1st day of July, 2019.

/Jennifer Lee/
Jennifer Lee