

ESTTA Tracking number: **ESTTA994637**

Filing date: **08/13/2019**

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

Proceeding	91248148
Party	Plaintiff Comite Interprofessionnel du vin de Champagne
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Date	08/13/2019
Attachments	20190813_130846_Oppose_Consolidation_Pleading.pdf(106866 bytes)

Applicant's mark (for example, genericness), but because two different opposers each have their *own*, unique objections to the mark. And that, in turn, is because Applicant chose a mark that implicates rights relating to *two* other parties' respective designations, not just one.

Because the two opposers are not identical, because the opposers assert rights in wholly separate designations, because there are few issues of law or fact common to the two opposition, and because Opposer believes that any savings in time, effort, and expense resulting from the proposed consolidation will be minimal, and outweighed by the prejudice and inconvenience to Opposer and (it presumes) Prosecco, Opposer respectfully submits that the Board should deny this motion.

DISCUSSION

I. STANDARD OF REVIEW

Fed. R. Civ. P. 42(a) reads in relevant part that a court may consolidate actions that "involve a common question of law or fact." Similarly, TBMP § 511 states that

[w]hen cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. 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. Although identity of the parties is another factor considered by the Board in determining whether consolidation should be ordered, it is not always necessary. 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 also, e.g., Wisconsin Cheese Grp. v. Comericalizadora de Lacteos y Derivados, 118

U.S.P.Q.2d 1262, 1262 (T.T.A.B. 2016) (citing TBMP § 511).

II. APPLICANT'S MOTION FOR CONSOLIDATION SHOULD BE DENIED

A. There are Few Meaningful Common Questions of Law or Fact

Applicant contends that both the CIVC Opposition and the Prosecco Opposition "involve

the same mark, the same rights and claims, and the same Applicant.” Mot. at 4. Only one of these contentions, however, is entirely true.

Both matters do in fact involve the Applicant. However, while Applicant asserts that CIVC and Prosecco have “assert[ed] the same claims, including, *inter alia*, likelihood of confusion, dilution, primarily geographically deceptively misdescriptive, and deceptiveness,” Mot. at 3, in fact, as even the most cursory review of the two notices of opposition reveals, Prosecco brought claims on all four of these bases, while CIVC brought claims on only two of these bases: confusion and dilution. *Compare* Notice of Opposition, Dkt. 1 (“Not. of Opp.”), at ¶¶ 7-8 *with* Opp. No. 91/248,233, Dkt. 1, at ¶¶ 1-27.)

Moreover, while both the CIVC Opposition and Prosecco Opposition involve “the same mark” – that is, *Applicant’s* applied-for mark – each also involves entirely separate sets of rights belonging to the respective opposers: the controlled appellation of origin and common-law certification mark CHAMPAGNE on the one hand, and the common-law certification mark PROSECCO and registered certification mark DOC PROSECCO PDO PROSECCO and design on the other. The opposer’s respective designations are no more alike than are “COKE” and “PEPSI,” or “FORD” and “CHEVROLET,” and they each pose distinct, unique, and fairly uncommon issues of fact and law. (*Compare* Not. of Opp. at ¶¶ 1-6 *with* Opp. No. 91/248,233, Dkt. 1, at ¶¶ 2-7.)] For example, each opposition will involve unique facts and questions involving the application of law to those facts concerning (i) each opposer’s acquisition and ownership of, use of, and rights in its own respective asserted designation, and (ii) how Applicant’s intended use of its applied-for mark in connection with the goods listed in its application may be likely to cause confusion with each opposer’s designation, may dilute the distinctiveness of that designation, or (only in the case of Prosecco) may be deceptive or

primarily geographically deceptively misdescriptive.

Accordingly, Opposer respectfully submits that there are not common issues of law or fact sufficient to warrant consolidation. *See, e.g., Envirotech Corp. v. Solaron Corp.*, 211 U.S.P.Q. 724, 726 (T.T.A.B. 1981) (denying consolidation where defendant's marks in each opposition were not all the same); *Izod, Ltd. v. La Chemise Lacoste*, 178 U.S.P.Q. 440, 441-42 (T.T.A.B. 1973) (denying consolidation, despite relatedness of opposers and identity of applicant and attorneys, where "there exists a difference of such character and extent in the issues involved as to militate against consolidation").¹

B. The Consolidation Would Not Save Time, Effort, and Expense

Given the two different opposers and the separate and distinct designations in which each is asserting rights (as discussed above), consolidating the CIVC Opposition and the Prosecco Opposition would not save the Board time or effort and instead would risk causing confusion of the issues before the Board in each proceeding.

Moreover, although Applicant "anticipates that she will take and receive substantially similar discovery" in both actions, which will "avoid duplicative efforts and redundant discovery by the parties" (Mot. at 4), Opposer contends that consolidating the CIVC Opposition and the Prosecco Opposition would not save CIVC, Prosecco, or even Applicant any meaningful time,

¹ Applicant cites TBMP § 511, which in turn cites to *New Orleans Louisiana Saints LLC v. Who Dat? Inc.*, 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011), for the proposition that "where multiple oppositions are brought by different opposers, consolidation may be ordered by the Board for consistency and economy provided that the oppositions are at the same state of litigation and plead the same claims." (Mot. at 3.) But while TBMP § 511 does cite to that decision for that proposition, the Board in that case did *not* consolidate the multiple oppositions at issue, but merely mentioned that such a thing was possible as part of a discussion of "the Board's practices regarding multiple opposers of an application and multiple proceedings against an application."

effort, or expense, as each opposer's claims, as well as Applicant's defense, will involve *non-overlapping* discovery on such topics as, for example, those noted above, namely, each opposer's acquisition and ownership of, use of, and rights in its own respective designation, and how Applicant's intended use of its applied-for mark in connection with the goods listed in its application may be likely to cause confusion with each opposer's separate and distinct designation, may dilute the distinctiveness of that designation, or (only in the case of Prosecco) may be deceptive or primarily geographically deceptively misdescriptive.

C. The Consolidation Would Cause Prejudice and Inconvenience to Opposer

Finally, although Applicant simply and flatly asserts (without any argument or evidence) that consolidation will not "result in any prejudice or inconvenience" to the parties (Mot. at 4), the mere fact of consolidation would require Opposer and its counsel to coordinate its litigation of this action with Prosecco and its counsel, and could require it to either lead the consolidated opposition on behalf of both parties or to relinquish that lead role to Prosecco's counsel – both of which Opposer considers inconvenient, and potentially if not unquestionably prejudicial. *See* TBMP § 511 ("[w]hen actions by different plaintiffs are consolidated, and the plaintiffs are represented by different counsel, the plaintiffs may be required to appoint one lead counsel to supervise and coordinate the conduct of the plaintiffs' cases and to provide one point of contact with the Board"). Consolidation also would potentially subject Opposer to any scheduling constraints applicable to Prosecco, and *vice versa*.

III. CONCLUSION

For the foregoing reasons, Opposer respectfully requests that the Board deny Applicant's motion to consolidate the CIVC Opposition with the Prosecco Opposition.

