

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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mbm

December 12, 2019

Opposition No. 91248148

*Comite Interprofessionnel du vin de
Champagne*

v.

Jisselle Anderson

Opposition No. 91248233

*Consorzio Di Tutela Della Denominazione Di
Origine Controllata Prosecco*

v.

Jiselle Anderson

Mary Beth Myles, Interlocutory Attorney:

These proceedings now come before the Board for consideration of the motions of Jisselle Anderson (“Applicant”) to consolidate Opposition Nos. 91248148 and 91248233. The motions are fully briefed.

I. Background

Applicant seeks to register the mark PETIT PROSECCO PARLOUR CHAMPAGNE & COCKTAILS EST. 2018 and Design, as shown below, for

“Bartending services; Cocktail parlor services; Bar and cocktail lounge services; Providing an interactive web site featuring information in the field of recipes for alcoholic beverages and cocktails; Providing information in the field of drinks, namely, providing information about bartending; Rental of drink dispensing machines” in International Class 43:¹



On May 14, 2019, Comite Interprofessionnel du vin de Champagne (“Champagne”) filed a notice of opposition opposing Applicant’s involved application on the grounds of likelihood of confusion and dilution. In its notice of opposition, Champagne alleges that it is “a quasi-regulatory organization organized and existing under the laws of the Republic of France” and that it is “made up of representatives of all Champagne houses and growers, as well as the government.” Notice of opposition in Opposition No. 91248148 ¶ 2. Opposer further alleges that its members have prior use of “CHAMPAGNE” in connection with products certified to use the designation. *Id.* at ¶ 5.

¹ Application Serial No. 88033344, filed July 11, 2018, alleging May 1, 2018 as both the date of first use anywhere and the date of first use in commerce. “PROSECCO PARLOUR EST. 2018 CHAMPAGNE & COCKTAILS” is disclaimed. The description of the mark is as follows: “The mark consists of the words ‘PETIT PROSECCO PARLOUR CHAMPAGNE & COCKTAILS’ forming a circle with the outline of a bottle of champagne in the middle of the circle. Underneath the bottle is the word ‘EST. 2018’ with a vertical line underneath it.”

Applicant filed an answer denying the salient allegations in the notice of opposition on July 26, 2019.

On May 16, 2019, Consorzio Di Tutela Della Denominazione Di Origine Controllata Prosecco (“Prosecco”) filed a notice of opposition opposing registration of Applicant’s involved mark on the following grounds: likelihood of confusion; the mark is geographically deceptively misdescriptive; dilution by blurring and tarnishment; deceptiveness. In support of its standing and claims, Prosecco pleads, inter alia, ownership of Registration No. 5268635, for the certification mark DOC PROSECCO PDO PROSECCO and Design, as shown below, for “Wine.”²



Additionally, Prosecco pleaded, inter alia, that “Prosecco is a generally known geographic place, referring to both a township and an area located in the north-east of Italy where the certified PROSECCO-denominated wines are produced.” Notice of opposition in Opposition No. 91248233 ¶ 20.

² Registration No. 5268635, issued August 22, 2017. “DOC” is disclaimed. The description of the mark is as follows: “The mark consists of nine stylized stem glasses joined by their bases to form a wheel-shaped figure with a circle in the center. On the glasses, there are some motifs resembling stylized vine stocks. Between each stem glass, three circles of different sizes appear aligned vertically, with the smallest circles close to the center and the largest circles close to the external side. Around the wheel-shaped figure, the words ‘PROSECCO PDO PROSECCO DOC’ are displayed in a circular pattern.”

Applicant filed separate motions to consolidate in each of these proceedings. Because the motions are largely identical and address the issue of consolidation of the two cases, the Board addresses both motions together in this order.

II. Applicant's Motions to Consolidate

Applicant contends that the proceedings should be consolidated, because they both involve the same application and because both plaintiffs have “assert[ed] the same claims” and “assert[] the same rights based on their respective prior use, registration, and allegedly protected geographic designations of ‘PROSECCO’ and ‘CHAMPAGNE.’”⁹ TTABVUE 4-5.³ Applicant argues that consolidation is appropriate, because both proceedings are in early stages and because discovery in the two proceedings would be duplicative. *Id.* at 5.

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, 1156 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382, 1384 n.3 (TTAB 1991). In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense that may be gained from consolidation against any prejudice or inconvenience that may be caused thereby.

Consolidation 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

³ Unless otherwise specified, citations refer to TTABVUE entry numbers in Opposition No. 91248148.

USPQ2d 1423, 1424 n.1 (TTAB 1993); *Regatta Sport Ltd.*, 20 USPQ2d at 1156. Consolidation is discretionary with the Board. *See* TBMP § 511; *see also* *Honda Giken Kogyo Kabushiki Kaisha v. H-D Michigan Inc.*, 43 USPQ2d 1526, 1527 (TTAB 1997) (Board's inherent authority to manage cases on its docket).

The Board finds that consolidation is not warranted in this instance. The plaintiffs in each of these proceedings are different and represented by different counsel. Although Applicant argues to the contrary, the claims in each proceeding also differ. While Prosecco has asserted claims of likelihood of confusion, dilution by blurring and tarnishment, deceptiveness, and geographic deceptive misdescriptiveness, Champagne has only asserted claims of likelihood of confusion and dilution by blurring and tarnishment. Indeed, in its response to the motion to consolidate, Champagne confirms that its pleading is limited to its claims of likelihood of confusion and dilution. 10 TTABVUE 4. Accordingly, the claims in each proceeding are not identical.⁴

The fact that both plaintiffs have asserted claims of likelihood of confusion and dilution against Applicant's involved mark does not, in and of itself, warrant consolidation of the two proceedings. A review of the plaintiffs' respective notices of opposition indicates that the two proceedings share few common issues of law or fact. Champagne's standing and claims are predicated upon Champagne's use of and rights in the designation CHAMPAGNE, while Prosecco's standing and claims are predicated upon Prosecco's use of and rights in the designation PROSECCO. The

⁴ The Board makes no determination as to the sufficiency of the claims in either notice of opposition.

issues presented in these proceedings are therefore different and involve distinct questions of law and fact. In light of the differences in the plaintiffs and their counsel, the differences in the marks and rights asserted by each of the plaintiffs, and the differences in the claims, the Board does not find that consolidation is beneficial under the circumstances.

In view of the foregoing, Applicant's motions to consolidate are **denied** and the two oppositions will proceed separately on the schedule set forth below:

Deadline for Discovery Conference	12/30/2019
Discovery Opens	12/30/2019
Initial Disclosures Due	1/29/2020
Expert Disclosures Due	5/28/2020
Discovery Closes	6/27/2020
Plaintiff's Pretrial Disclosures Due	8/11/2020
Plaintiff's 30-day Trial Period Ends	9/25/2020
Defendant's Pretrial Disclosures Due	10/10/2020
Defendant's 30-day Trial Period Ends	11/24/2020
Plaintiff's Rebuttal Disclosures Due	12/9/2020
Plaintiff's 15-day Rebuttal Period Ends	1/8/2021
Plaintiff's Opening Brief Due	3/9/2021
Defendant's Brief Due	4/8/2021
Plaintiff's Reply Brief Due	4/23/2021
Request for Oral Hearing (optional) Due	5/3/2021

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits,

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declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).