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

Proceeding	91263692
Party	Plaintiff The Men's Wearhouse, Inc.
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Submission	Motion to Consolidate
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Attachments	MWW Motion to Consolidate.pdf(20689 bytes )

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

The Men’s Wearhouse, Inc.,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91263692
	)	Serial No. 88648121
Mark’s Work Wearhouse Ltd.,	)	Mark: MARK’S WORK
	)	WEARHOUSE
Applicant.	)	
	)	
	)	

**OPPOSER THE MEN’S WEARHOUSE, INC.’S MOTION TO CONSOLIDATE  
OPPOSITION NO. 91263692 AND OPPOSITION NO. 91250353**

Opposer, The Men’s Wearhouse, Inc., (“Opposer” or “MW”), hereby moves to consolidate Opposition No. 91263692 and Opposition No. 91250353 (collectively, the “Proceedings”) under Federal Rule of Civil Procedure 42(a) and Rule 2.104(b). The Proceedings involve common questions of fact and law relating to two related applications, one for WORK WEARHOUSE and one for MARK’S WORK WEARHOUSE. Due to discovery delays in the first-filed proceeding, these Proceedings are similarly situated. Consolidating these Proceedings will save time, effort, and expense by eliminating duplicative discovery and aligning the deadlines of these two related oppositions. Therefore, Opposer respectfully requests the Board to grant this motion and exercise its discretion to consolidate the Proceedings.

Where, as here, two proceedings involve common questions of law or fact, the Board has the discretion to consolidate the proceedings. *See* TBMP § 511; Fed. R. Civ. P. 42(a). In deciding whether to order consolidation, the Board weighs the benefits of consolidation—savings in time, effort, and expense—against potential prejudice or inconvenience to the parties. *See* TBMP § 511.

The Proceedings involve the same parties, namely MW and Applicant Mark's Work Warehouse Ltd. ("Applicant"). Each of the parties is represented by the same legal counsel in the Proceedings.

The Proceedings both involve Applicant's applications for marks that incorporate the phrase, "WORK WEARHOUSE," under Section 1(b). Opposition No. 91263692 involves Applicant's application for the mark MARK'S WORK WEARHOUSE in International Class 35 (Serial No. 88648121), and Opposition No. 91250353 involves Applicant's application for the mark WORK WEARHOUSE in International Class 35 (Serial No. 88034113). In opposing these related applications, MW has raised the same grounds in both Proceedings, relying on the same prior use and registration of MEN'S WEARHOUSE marks.<sup>1</sup> Applicant has filed substantially similar answers in the Proceedings. Therefore, common questions of law and fact are presented in each of the Proceedings and consolidation is appropriate. *See e.g., S. Industries Inc. v. Lamb-Weston Inc.*, 45 U.S.P.Q.2d 1293, 1297 (T.T.A.B. 1997) (granting motion to consolidate where both proceedings involved the same mark and virtually identical pleadings); *Wisconsin Cheese Group, LLC. v. Comercializadora de Lacteos y Derivados S.A. de C.V.*, 118 U.S.P.Q.2d 1262, 1264 (T.T.A.B. 2016) (consolidating proceedings in light of common questions of law and fact).

In this proceeding, Opposition No. 91263692, Applicant just filed its answer on August 25, 2020, and discovery does not open until September 25, 2020. In the first-filed opposition (91250353), the parties have not yet completed written discovery and have not taken any depositions. The COVID-19 pandemic and the adverse economic effects resulting therefrom

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<sup>1</sup> Opposer's family of MEN'S WEARHOUSE marks includes: MEN'S WEARHOUSE (U.S. Reg. No. 1672903); MEN'S WEARHOUSE (U.S. Reg. No. 4632483); MEN'S WEARHOUSE (U.S. Reg. No. 3194243) MEN'S WEARHOUSE MW (U.S. Reg. No. 2448040); MEN'S WEARHOUSE MW (U.S. Reg. No. 2367145); and MEN'S WEARHOUSE AND TUX (U.S. Reg. No. 3798222).

have delayed discovery efforts in the first-filed proceeding. This proceeding is currently stayed pending resolution of a motion to compel. Therefore, the two Proceedings are similarly situated with regard to status.

Because the same parties, same phrase within the marks, and same rights and claims are involved in both Proceedings, consolidation will result in considerable savings in time, effort, and expense. For example, consolidation would avoid duplication of efforts and redundant discovery. Consolidation will not result in any prejudice or inconvenience to any party. Counsel for Opposer inquired whether Applicant would consent to consolidation on July 17, 2020—the day that the notice of opposition was filed in this matter. Through counsel, Applicant indicated that it opposed consolidation earlier today.

For the foregoing reasons, Opposer requests that the Board grant this motion and consolidate Opposition Nos. 91263692 and 91250353 and adopt the schedule set in this Opposition No. 91263692 for the consolidated Proceedings.

Respectfully submitted,

Date: September 2, 2020

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**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing MOTION TO CONSOLIDATE has been served on Mark's Work Warehouse Ltd. by forwarding said copy on September 2, 2020, via email, to its counsel of record:

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*/ Donna F. Schmitt /*