

ESTTA Tracking number: **ESTTA1083225**

Filing date: **09/21/2020**

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

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|------------------------|---|
| Proceeding | 91263692 |
| Party | Defendant Mark's Work Wearhouse Ltd. |
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| Date | 09/21/2020 |
| Attachments | Applicant Reply to Motion to Consolidate.pdf(210888 bytes) |

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

The Men's Wearhouse, Inc.

Opposer,

vs.

Mark's Work Wearhouse Ltd.

Applicant.

Opposition No.: 91263692

Mark: MARK'S WORK WEARHOUSE

Serial No.: 88648121

Published: June 23, 2020

**APPLICANT'S RESPONSE TO
OPPOSER'S MOTION TO
CONSOLIDATE**

Opposer's unconsented Motion to Consolidate should be denied. When actions before the Trademark Trial and Appeal Board involve common questions of law and fact, the Board may consolidate the actions. Fed. R. Civ. P. §42(a); TBMP §511. Applicant asserts that the '353 and '692 Oppositions involve different issues of law and fact, in that the marks at issue are different, the services claimed in connection with the subject applications are not identical, and the assertions raised in each of the Notices of Opposition filed by Opposer contain significant differences, such that the proceedings should not be consolidated. *See Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial to defendant where defendant's involved marks were not all the same) and *Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441-42 (TTAB 1973) (consolidation denied where issues differed).

In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation. TBMP §511. If the Motion to Consolidate is granted in this matter, it will result in the resolution of the '353 proceeding

being further delayed and will cause the Applicant to needlessly expend additional time and resources. The mark at issue in the '353 proceeding was published for opposition in April 2019. Applicant served its initial discovery requests on Opposer in October 2019. Applicant has consented to Opposer's many requests to suspend the proceedings in a good faith effort to amicably resolve this matter. However, Opposer has continued to delay the proceedings. After numerous follow-ups from the Applicant, Opposer agreed to properly respond to Applicant's first set of discovery requests and complete its production of documents by July 31, 2020. To date, Opposer has not properly responded to Applicant's discovery requests. Despite Applicant's good faith efforts to move the '353 proceeding forward, Opposer has continued to delay the proceedings by requesting numerous extensions and suspensions of the '353 proceeding and by ignoring Applicant's repeated requests to properly respond to its discovery requests, and Applicant believes the filing of the Motion to Consolidate is simply another tactic to delay a resolution of the '353 proceeding and to increase and extend Opposer's deadlines.

Applicant has already spent a significant amount of resources defending the '353 proceeding that involves an entirely different mark from the mark at issue in the '692 proceeding. The marks at issue in the proceedings are applied for in connection with different services and the issues raised by Opposer in the two proceedings are not identical. Consolidation should be denied as possibly prejudicial to defendant where the involved marks were not all the same. *Envirotech Corp.*, 211 USPQ at 726.

If Opposer's Motion to Consolidate is granted, Applicant will be forced to incur additional delays and expenses in connection with the mark at issue in the '353 proceeding. Furthermore, prejudice will occur because the '353 proceeding is impacting Applicant's entry into the United States market. Accordingly, consolidation of the proceedings would be

prejudicial as it would not streamline the issues for the Board, but rather serves to continuously increase and extend Opposer's deadlines as the '353 proceeding is nearing the close of discovery, while the '692 proceeding was just filed and discovery has not opened. *See Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1982) (consolidation denied where one case was just in pleading stage, and testimony periods had expired in other).

As noted in Opposer's Motion to Consolidate, Applicant recently filed a Motion to Compel in the '353 proceeding, after Opposer failed to properly respond to Applicant's first set of discovery requests initially served upon Opposer in October 2019 and complete its production of documents. Opposer still has not properly responded to Applicant's first set of discovery requests and complete its production of documents. Applicant has consented to Opposer's many requests to suspend the proceedings in a good faith effort to amicably resolve this matter; however, the Opposer has continued to delay the proceedings, unfairly inhibiting Applicant's ability to defend its case.

In view of the foregoing, Applicant opposes the Motion to Consolidate at this time.

Respectfully submitted,

BARNES & THORNBURG LLP

/s/ dwong/

Date: September 21, 2020

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that a copy of this Applicant's Response To Opposer's Motion To Consolidate has been served on September 21, 2020 via electronic mail to Opposer's attorney of record at: MVanderTuig@atllp.com, iptm@armstrongteasdale.com, and dschmitt@atllp.com.

/s/ Kathleen S. Fennessy