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

Proceeding no.	91274167
Party	Defendant Balance Athletica, LLC and LODO IP, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

THE NORTH FACE APPAREL CORP., Opposers, v. BALANCE ATHLETICA, LLC, Applicant.	Opposition Nos. 91274167 Mark:  Serial No.: 90/332,530 Filing Date: November 20, 2020

BALANCE ATHELTICA LLC'S MOTION TO CONSOLIDATE OPPOSITION NOS. 91274162, 91274163, AND 91274167 UNDER FRCP 42(a)

Pursuant to Federal Rule of Civil Procedure 42(a) and Trademark Trial and Appeal Board Manual of Procedure Rule 511, Balance Athletica, LLC, ("Applicant") through its undersigned counsel, respectfully moves to consolidate opposition numbers 91274162, 91274163, and 91274167 to its trademark application (the "Motion"), Serial No. 90/332,530, filed on November 20, 2020 , and in support thereof respectfully submits the following:

I. INTRODUCTION

Applicant filed for trademark protection of its signature glute contour seam, 

(the "Mark") on November 20, 2020. On September 28, 2021, the Mark published in the Trademark Official Gazette. On January 26, 2022, three oppositions were filed against the Mark by three different parties in proceeding numbers 91274162, 91274163, and 91274167 (the "Oppositions"). Wrangler Apparel Corp. ("Wrangler") filed Opposition No. 91274162, Retail Royalty Company ("Retail") filed

Opposition No. 91274163, and The North Face Apparel Corp. ("North Face") filed Opposition No. 91274167. Applicant answered Wrangler's Opposition on March 7, 2022, *see* 4 TTABVUE 1-4, Retail's Opposition on March 7, 2022, *see* 4 TTABVUE 1-4, and North Face's Opposition on March 7, 2022, *see* 4 TTABVUE 1-4.

Undersigned counsel for Applicant conferred with Opposer, The North Face Apparel Corp., regarding this Motion and it opposes the Motion.

II. ARGUMENT

The Oppositions should be consolidated because (1) each proceeding contains the same set of legal issues and facts, (2) consolidation will yield significant savings in time, effort, and expense, and (3) consolidation will not prejudice the opposers.

a. Legal Standard under FRCP 42(a) and TBMP 511.

The Trademark Trial and Appeal Board (the "Board") Manual of Procedure Rule 511 permits the Board, in its discretion, to consolidate pending cases before it which "involve[e] common questions of law or fact." TBMP § 511. This TBMP rule is promulgated pursuant to Federal Rule of Civil Procedure 42(a), which states, "If actions before the court involve a common question of law or fact, the court may: (1) join for hearing or trial any or all matters at issue in the actions; (2) consolidate the actions; or (3) issue any other orders to avoid unnecessary costs or delay."

In determining whether to consolidate proceedings, the Board weighs savings in time, effort, and expense, which may be gained from consolidation against any prejudice or inconvenience that may thereby result. TBMP § 511; *see also Servants of the Paraclete v. Great Am. Ins. Co.*, 866 F. Supp. at 1572. Furthermore, the decision whether to consolidate is under the Board's discretion, and an order to consolidate may be granted upon the Board's own initiative, by Board-approved stipulation agreed upon by the parties, or, as is the case here, by motion. *Id*. Generally, the Board will not consider a motion to

consolidate until an answer has been filed in each case sought to be consolidated. *Id*; *see also 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).

b. The Oppositions all involve identical questions of law and fact.

All three of the Oppositions against the Mark involve identical questions of law and fact. First, all three of the Notices of Opposition assert the same claims. These claims consist of (a) the Mark is functional, *see* Opp. No. 91274162, 1 TTABVUE 2 at ¶¶ 8-9; Opp. No. 91274163, 1 TTABVUE 9 at Count One; Opp. No. 91274167, 1 TTABVUE 9 at Count One; (b) the Mark is ornamental, *see* Opp. No. 91274162, 1 TTABVUE 2 at ¶ 9; Opp. No. 91274163, 1 TTABVUE 10 at Count Two; Opp. No. 91274167, 1 TTABVUE 10 at Count Two; (c) the Mark has not acquired distinctiveness, *see* Opp. No. 91274162, 1 TTABVUE 1 at ¶¶ 3, 11; Opp. No. 91274163, 1 TTABVUE 10 at Count Three; Opp. No. 91274167, 1 TTABVUE 10 at Count Three; and (d) the Mark is not capable of acquiring distinctiveness, *see* Opp. No. 91274162, 1 TTABVUE 1 at ¶¶ 4, 5; Opp. No. 91274163, 1 TTABVUE 11 at Count Four; Opp. No. 91274167, 1 TTABVUE 11 at Count Four. *See Payne v. Tri-State Careflight, LLC*, 327 F.R.D. 433, 452 (D.N.M. 2018) (consolidating cases when the two cases asserted the same causes of action); *Blasko v. Wash. Metro. Area Transit Auth.*, 243 F.R.D. 13, *16 (D.D.C. 2007) (consolidating when "suits undisputedly name the same defendant and allege the same claims.").

Second, all of the Oppositions are also premised on the same set of facts and assertions, including but not limited to:

- The Mark is not entitled to registration because it does not serve to identify the goods or services of Applicant. *See* Opp. No. 91274162, 1 TTABVUE 1 at ¶ 4; Opp. No. 91274163, 1 TTABVUE 3 at ¶ 4; Opp. No. 91274167, 1 TTABVUE 3 at ¶ 4.

- The Mark does not distinguish Applicant's goods from the goods sold by others. *See* Opp. No. 91274162, 1 TTABVUE 1 at ¶ 5; Opp. No. 91274163, 1 TTABVUE 10 at ¶ 20; Opp. No. 91274167, 1 TTABVUE 10 at ¶ 20.

- Applicant's application was refused registration initially because it is a decorative or ornamental feature. *See* Opp. No. 91274162, 1 TTABVUE 2 at ¶ 10; Opp. No. 91274163, 1 TTABVUE 8 at ¶ 9; Opp. No. 91274167, 1 TTABVUE 8 at ¶ 9.

- Applicant's Mark consists of a "Y stitching design that forms a central vertical line that extends up the rear area of a garment and splits into two lines that extend up and curve outward toward opposing sides of the garment near the waist area forming a 'Y' shape." Opp. No. 91274162, 1 TTABVUE 2 at ¶ 6; Opp. No. 91274163, 1 TTABVUE 8 at ¶ 9; Opp. No. 91274167, 1 TTABVUE 8 at ¶ 9.

- There are several third parties who use a similar "Y" stitching design on similar products. *See* Opp. No. 91274162, 1 TTABVUE 2 at ¶ 12; Opp. No. 91274163, 1 TTABVUE 3 at ¶¶ 4-5; Opp. No. 91274167, 1 TTABVUE 3 at ¶¶ 4-5.

See Welzt v. Lee, 199 F.R.D. 129, 131 (S.D.N.Y. 2001) (consolidating cases when they "name the same Defendants and involve the same factual and legal issues.").

Notably, both the Retail and North Face oppositions are filed by the same law firm (Saunders & Silverstein LLP) and are identical to one another, except for the name of the opposer. It appears that the firm is attempting to force Applicant to duplicate its work and expend unnecessary legal fees by forcing it to respond to each opposition proceeding separately, thereby causing it to incur unnecessary expenses. Wrangler's opposition, while filed by a different law firm, contains the same identical set of facts and the same legal issues.

Thus, the Mark is challenged on identical legal grounds and presents identical factual and legal questions for the Board to resolve. This weighs heavily in favor of consolidation.

c. Consolidation will yield significant savings in time, effort, and expense.

Consolidation of the Oppositions will yield significant savings in time, effort, and expense. *See Payne v. Tri-State Careflight, LLC*, 327 F.R.D. 433, 452 (D.N.M. 2018) (consolidating the two cases when "the facts, parties, and legal claims are virtually identical, consolidating the cases would be the most efficient way forward."). All of the Oppositions are on an identical timeline; at this time, they are all in the nascent phases of discovery. There is significant overlap between the discovery sought by all

opposers. For example, each and every one of Wrangler's interrogatories and requests for production are also contained within North Face's same requests. And North Face and Retail's discovery requests contain the identical requests. *See Hanson v. District of Columbia*, 257 F.R.D. 19, 22 (D.D.C. 2009) (consolidating cases when both are at their nascent stages even though one case had broader issues than the other). Significant benefits would inure to Applicant and Opposers if discovery were to be consolidated rather than forcing Applicant to produce the same documents and answer the same interrogatories in triplicate and forcing each Opposer to respond to Applicant's discovery requests, which will be identical for each.

Further, when actions involve "substantially the same witnesses and arise from the same series of facts or events," "consolidation is particularly appropriate." *Blasko v. Wash. Metro. Area Transit Auth.*, 243 F.R.D. 13, *16 (D.D.C. 2007). Here, Applicant will employ the same expert for all the Oppositions, and opposers can easily use the same expert as well (given that their cases are essentially identical to one another, and two Opposers appear to share counsel and legal strategy). Further, all of the Opposers will surely wish to depose the Applicant, which would result in three separate (but virtually identical) depositions, without consolidation. There are no other witnesses anticipated at this time. This provides further evidence that consolidation is appropriate in this case.

Without consolidation, Applicant will incur unnecessary and significant expense in participating in depositions for each Opposer. Given that the same questions of law and fact are involved in all three oppositions, Applicant will have to participate in, and incur the costs of, being deposed on the same questions.

d. Consolidation will not prejudice any of the Opposers.

There is no prejudice to the opposers if the Motion is granted. There are no individual issues specific to one opposer that are distinct from the others. *See Innovation Ventures, LLC v. Custom*

Nutrition Lab., LLC, 451 F. Supp. 3d 769, 794 (E.D. Mich. 2020) ("When cases involve some common issues but *individual issues* predominate, consolidation should be denied."). For example, none of them claim to make a product with a glute seam that would infringe the Mark if the Mark were to register. Another potential prejudice would be if the discovery in one case was voluminous but irrelevant to another. *See id.* As noted above, discovery only opened April 6, 2022, and so discovery has barely begun. When documents are produced, we anticipate similar discovery for each case, as each is based on the same predicate facts and asserts the same legal issues. Therefore, there is no risk of prejudice to any of the opposers.

III. CONCLUSION

Based on the foregoing, Applicant respectfully requests that the Board grants this Motion and consolidates the Oppositions.

Dated: May 31, 2022

Respectfully submitted,

Milgrom & Daskam

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CERTIFICATE OF SERVICE

The undersigned hereby certifies that on May 31, 2022, a true and correct copy of the foregoing **BALANCE ATHELTICA LLC'S MOTION TO CONSOLIDATE OPPOSITION NOS. 91274162, 91274163, AND 91274167 UNDER FRCP 42(a)** was served upon counsel for Opposer by email as follows:

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