

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Mailed: January 3, 2005

Cancellation No. 92041710

GUSTAFSON, L.L.C.

v.

CIRCLE ONE INTERNATIONAL INC.
and SMART WORLD ORGANICS,
INC., joined as party
defendants

Cancellation No. 92043663

CIRCLE ONE INTERNATIONAL INC.
and SMART WORLD ORGANICS,
INC., joined as party
plaintiffs

v.

GUSTAFSON, L.L.C.

Frances S. Wolfson, Interlocutory Attorney:

On December 29, 2004, Smart World Organics, Inc. responded to the Board's show cause order directing the parties to show cause why Smart World Organics, Inc. should not be joined as a party to Cancellation Nos. 92041710 and 92043663, and why these proceedings should not be consolidated.

Smart World Organics, Inc. has shown that it was assigned registration no. 2271859 on November 30, 2004 and

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that the assignment was recorded with the Office at Reel and Frame Nos. 2983/0646.

Accordingly, Smart World Organics, Inc. is hereby joined as party plaintiff in Cancellation No. 92043663 and as party defendant in Cancellation No. 92041710.¹ The cases are further hereby consolidated as they involve common questions of law and fact.

The cases may now be presented on the same records and briefs. Papers should bear the number of each of the consolidated cases, although Cancellation No. 92041710 is treated as the "parent" case, and most of the papers filed by the parties, or issued by the Board, will be placed only in the file of the parent case. The parties need not file a copy for each consolidated case; a single copy, bearing the number of each consolidated case, normally is sufficient.

¹ If the mark in an application or registration which is the subject matter of an inter partes proceeding before the Board is assigned, and the assignment is recorded in the Assignment Branch of the PTO, the assignee may be substituted as a party defendant if the assignment occurred prior to the commencement of the proceeding, or the assignor is no longer in existence, or the plaintiff raises no objection to substitution, or the discovery and testimony periods have closed; otherwise, the assignee will be joined, rather than substituted, to facilitate discovery. See TBMP §512.01.

If marks pleaded by a plaintiff in an inter partes proceeding are assigned, the assignee will be joined as a party, rather than substituted, in order to facilitate discovery, unless the assignment took place prior to the commencement of the proceeding, or the assignor is no longer in existence, or the discovery and testimony periods have closed. See Fed. R. Civ. P. 17 and 25; and *William & Scott Co. v. Earl's Restaurants Ltd.*, 30 USPQ2d 1871 (TTAB 1994). See also TBMP §512.01.

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Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. See Wright & Miller, Federal Practice and Procedure: Civil §2382 (1971).

Smart World Organics, Inc.'s answer, filed on December 12, 2004 in Cancellation No. 92041710, is hereby accepted and entered into the record.

Dates remain as previously set (restated below for the convenience of the parties).

DISCOVERY PERIOD TO CLOSE: March 31, 2005

30-day testimony period for party in the position of plaintiff to close: **June 29, 2005**

30-day testimony period for party in the position of the defendant to close: **August 28, 2005**

15-day rebuttal period for party in the position of the plaintiff to close: **October 12, 2005**

IN EACH INSTANCE, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within **thirty days** after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.