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

Proceeding	92059134
Party	Defendant Fin.Ing. S.r.L. (Finanziaria Inghirami S.r.L.)
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

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RICHEMONT INTERNATIONAL S.A.,
Petitioner,
v.
FIN.ING. S.r.l.,
Respondent.
-----X

Cancellation No. 92059134

RESPONDENT’S OPPOSITION TO PETITIONER’S MOTION TO CONSOLIDATE

Respondent FIN.ING. S.r.l. (“Respondent”) opposes the motion of Petitioner Richemont International S.A. (“Petitioner”) to consolidate Cancellation No. 92/056,635 (“the ‘635 Cancellation”) with Cancellation No. 92/059,134 (the “‘134 Cancellation”).

The cancellation proceedings involve different trademark registrations, different goods and two of the Respondent’s marks in the ‘134 Cancellation differ from the mark in the ‘635 Cancellation.

A consolidation will obfuscate the foregoing differences and potentially confuse the different facts and issues that exist in each of the separate proceedings.

Petitioner’s motion to consolidate is tantamount to a motion to reopen the discovery and expert disclosure periods in the ‘635 Cancellation. Discovery is closed in the ‘635 Cancellation. A consolidation will reopen discovery. Respondent will be prejudiced by being forced to spend additional time and incur expense with respect to the *de facto* reopening of the discovery now closed in the ‘635 Cancellation. Excusable neglect

justifying the reopening of discovery and expert disclosure periods has not been demonstrated

Thus, Respondent will be clearly prejudiced by a consolidation.

BACKGROUND

A. Cancellation No. 92/056,635

On January 4, 2013, Petitioner filed a petition for cancellation of Registration No. 3,514,885 ("the '885 Registration") for Respondent's mark REPORTER for "clocks, watches, jewelry and imitation jewelry" on the grounds of abandonment in Cancellation No. 92/056,635 ("the '635 Cancellation").

On March 19, 2013, Respondent moved to dismiss the '635 Cancellation under Fed. R. Civ. P. 12(b)(6) for failure to state a claim of abandonment. Respondent concurrently filed an answer.

On April 8, 2013, Petitioner filed a response to Respondent's motion to dismiss and, as well, an amended petition for cancellation.

On June 19, 2013, the Board granted Respondent's motion holding that Petitioner's amended petition for cancellation did not sufficiently plead a claim of abandonment. The Board allowed Petitioner thirty days to file a second amended petition.

Petitioner filed a second amended petition on July 12, 2013. Respondent answered the second amended petition on July 31, 2013.

Expert disclosures were due by July 31, 2014. Neither party served expert disclosures.

Discovery closed on August 30, 2014. Petitioner served document requests and interrogatories, and Respondent provided written responses and documents responsive to Petitioner's discovery requests. Neither party has taken any discovery depositions.

Petitioner, with Respondent's consent, moved to extend the deadline for the close of discovery to August 30th. The motion was granted by the Board.

Petitioner did not move to extend the discovery deadline beyond the August 30, 2014 deadline or to reopen the discovery period.



The '635 cancellation is ready for trial testimony with the following scheduled dates remaining:

Petitioner's Pretrial Disclosures :	10/14/2014
Petitioner's Trial Period Ends :	11/28/2014
Respondent's Pretrial Disclosures :	12/13/2014
Respondent's Trial Period Ends :	01/27/2015
Petitioner's Rebuttal Disclosures :	02/11/2015
Petitioner's Rebuttal Period Ends :	03/13/2015

B. Cancellation No. 92/059,134

Petitioner filed a petition to cancel in Cancellation No. 92/059,134 ("the '134 Cancellation"), seeking cancellation of six (6) additional registrations of Respondent on the grounds of abandonment. The marks and goods of the Respondent's registrations at issue in the '134 Cancellation are summarized below.

Trademark and Registration No.	Goods
REPORTER Registration No. 1,610,625	"jackets, suits, shirts, coats, waistcoats, overcoats, raincoats, t-shirts, sweaters, pullovers, scarves, neck ties, shawls, hats, caps" in International Class 25
REPORTER Registration No. 1,664,193	"footwear" in International Class 25

Trademark and Registration No.	Goods
<p>REPORTER</p> <p>Registration No. 2,313,547</p>	<p>“belts for clothing articles and gloves” in International Class 18</p>
<p>REPORTER</p> <p>Registration No. 2,071,060</p>	<p>“eyeglasses, eyeglass cases, eyeglass chains and cords, eyeglass frames” in International Class 9</p> <p>“parasols, walking-sticks; trunks for traveling and travelling bags, suitcases, wallets, handbags, purses, umbrellas, all made of leather and/or imitation leather, in whole or in part; leather sold in bulk and imitation leather sold in bulk” in International Class 18</p> <p>“clothing, namely, suits, coats, jackets, blouses, shirts, T-shirts, pullovers, sweaters, cardigans, trousers, pants, ties and scarves, footwear, headwear” in International Class 25</p>
 <p>Registration No. 2,971,183</p>	<p>“men's and boy's apparel, namely, suits, waistcoats, trousers, pants, shorts, jackets, long jackets, short jackets, coats, overcoats, raincoats, cloaks, shirts, T-shirts, vests, sweaters, jumpers, pullovers, cardigans, blazers, scarves, head scarves, ties, gloves, belts, waistbands, bathing suits; track suits, sportswear, namely, tops, bottoms, sweatpants, sweatshirts; jeans; casual wear, namely, casual shirts, casual trousers, casual jackets; headwear, namely, caps and hats; footwear, namely, shoes, sport shoes, boots” in International Class 25</p>
 <p>Registration No. 3,548,728</p>	<p>“clothes for men, women and children, namely, shirts, tops, pants, dresses, suits, jackets, short jackets and blouses” in International Class 25</p>

The schedule pending in the '134 Cancellation is as follows:

Expert Disclosures Due:	12/7/2014
Discovery Closes:	1/6/2015
Petitioner's Pretrial Disclosures:	2/20/2015
Petitioner's Trial Period Ends:	4/6/2015
Respondent's Pretrial Disclosures:	4/21/2015
Respondent's Trial Period Ends:	6/5/2015
Petitioner's Rebuttal Disclosures:	6/20/2015
Petitioner's Rebuttal Period Ends:	7/20/2015

ARGUMENT

The Board may order consolidation of proceedings which involve common issues of law or fact. TBMP § 511. "In determining whether to consolidate proceedings, the Board will weigh the savings in time, effort, and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby." *Id.*

Petitioner, as the moving party, bears the burden of persuading the Board to consolidate these proceedings. *BellSouth Intellectual Property Corp. v. RealTelephony, Inc.*, 2002 TTAB LEXIS 123 at *7 (TTAB Jan. 30, 2002) (denying consolidation); *Realnetworks, Inc. v. Real Telephony, Inc.*, 2002 TTAB LEXIS 124 at *8 (TTAB Jan. 30, 2002) (denying consolidation).

Petitioner fails to carry its burden of persuasion as it does not identify any common issues of law or fact between the two proceedings, or any savings in time, effort, and expense to be gained by a consolidation.

The issue in the '635 Cancellation is whether Respondent has abandoned the mark REPORTER for "clocks, watches, jewelry and imitation jewelry" in the '885 Registration.

The issues in the '134 Cancellation are whether the Respondent has abandoned Respondent's marks registered in six other registrations of Respondent, not including the '885 Registration, and not including "clocks", "watches", "jewelry" or "imitation jewelry."

There is no overlap between the registrations and/or goods at issue. The goods are not even in the same classes. The '635 Cancellation concerns goods in Class 14, while the '134 Cancellation concerns goods in Classes 9, 18, and 25.

Further, in two registrations at issue in the '134 Cancellation (Nos. 2,971,183 and 3,548,728), the marks REPORTER JEANS (stylized) and REPORTER JACKET (stylized), respectively, are different from the REPORTER mark at issue in the '635 Cancellation.

The lack of common facts and issues between the proceedings warrants denial of the motion for consolidation.

Moreover, the Board has refused to consolidate cases that are at different stages in the proceedings. TBMP § 511; *see, e.g., Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654, 655 (TTAB 1992) (request for consolidation denied where one case at pleading stage and testimony period had expired in another).

Here, the cancellation proceedings are at different stages.

Discovery closed on August 30, 2014 in the '635 Cancellation. Petitioner previously requested an extension of the discovery period, consented to by Respondent and granted by the Board (Docket No. 26, 27). Expert disclosures were due by July 31, 2014 (Docket No. 26, 27). Neither party served expert disclosures. Petitioner's Pretrial Disclosures are now shortly due, i.e., by October 14, 2014.

In the '134 Cancellation, expert disclosures are due on December 7, 2014, and discovery is set to close on January 6, 2015 (Docket No. 2). Petitioner's Pretrial Disclosures are due by February 20, 2015.

"Upon consolidation, the Board will reset dates for the consolidated proceeding, usually by adopting the dates as set in the most recently instituted of the cases being consolidated." TBMP 511. Therefore, if the dates of the '135 Cancellation are adopted in consolidated proceeding, the expert disclosure and discovery periods, now closed in the '635 Cancellation, in effect will be reopened.

In order to reopen the now-expired discovery period and expert disclosure period in the '635 Cancellation, Petitioner must establish "excusable neglect." *Baron Philippe de Rothschild S.A. v. Styl-Rite Optical Mfg. Co.*, 55 USPQ2d 1848, 1852 (TTAB 2000). Factors considered in determining "excusable neglect" include: (1) the danger of prejudice to the nonmovant, (2) the length of the delay and its potential impact on the proceedings; (3) the reason for the delay, including whether it was within the reasonable control of the movant, and (4) whether the movant acted in good faith. *Id.* (Citations omitted.)

These factors weigh against the grant of the motion to consolidate. Petitioner has not proffered any evidence showing "excusable neglect". Indeed, Petitioner's motion to consolidate eschews the clear prejudice to Respondent by reopening of discovery now closed and/or the potential issues and costs arising from an unjustified belated presentation of expert disclosure in the '635 Cancellation.

Respondent will be considerably prejudiced by a consolidation and a reopening of the expired deadlines in the '635 Cancellation. See TBMP § 511 (savings in consolidation weighed against prejudice or inconvenience to non-moving party).

A consolidation will extend the schedule in the '635 Cancellation, including reopening discovery and the time for expert disclosures.

A consolidation will give Petitioner an unwarranted tactical advantage by providing it with opportunities to serve discovery requests on Respondent relating to the issues in the '635 Cancellation. Respondent will have to spend additional resources in preparation of responses, searches for and production of documents and communications with counsel, among other activities.

Petitioner did not take any discovery depositions in the '635 Cancellation. Consolidating the proceedings, moreover, will subject Respondent to the possibility of having to prepare for and defend discovery depositions related solely to the issues in the '635 Cancellation.

Respondent's attention and resources will be diverted from the issues in the '134 Cancellation to issues in the '635 Cancellation which have already been discovered. Time will be required to answer discovery and to resolve any possible discovery disputes if discovery is reopened. Such efforts will detract from Respondent's ongoing efforts, defense and strategies in the second filed cancellation proceeding, *i.e.*, the '134 Cancellation.

In addition, a consolidation creates potential confusion of the issues and facts relating to Respondent's registration at issue in the '635 Cancellation and Respondent's registrations at issue in the '134 Cancellation. *See, BellSouth Intellectual Property Corp.*, 2002 TTAB LEXIS at *7 ("consolidation . . . would risk causing confusion of the issues"). Facts relating to Respondent's use of the REPORTER mark on or in connection with the Class 14 goods listed in the '885 registration at issue in the '635 Cancellation should not

be relevant to the issue of whether or not Respondent abandoned any of Respondent's marks for the goods (Class 9, 18 and 25) listed in the registrations at issue in the '134 Cancellation. 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).

The prejudice to Respondent outweighs possible savings, if any, created by a consolidation.

Petitioner has not been diligent in moving to consolidate. Petitioner offers no explanation or justification for its delay.

Granting of the motion to consolidate will result in added delay, prejudice and complicate the proceedings as noted above.

In the event that the Board grants the present motion, Respondent respectfully requests that the Board not reopen the expert disclosure and discovery periods in the '635 Cancellation and order that these periods are closed in all respects.

CONCLUSION

For all of the foregoing reasons, Petitioner's motion to consolidate is not warranted and should be denied.

Dated: September 9, 2014

Respectfully submitted,



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CERTIFICATE OF SERVICE

I hereby certify that a complete copy of the foregoing RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION TO CONSOLIDATE has been served on Paul J. Reilly, Esq. and Lauren B. Emerson, Esq., Attorneys for Petitioner, by mailing said motion on September 9, 2014 via First Class Mail, postage prepaid, to:

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Kristin Tetro