

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
P.O. Box 1451  
Alexandria, VA 22313-1451  
General Contact Number: 571-272-8500

Baxley

Mailed: November 14, 2014

Opposition No. 91218282  
Cancellation No. 92059924

Kicking Horse Coffee Co. Ltd.

v.

David John Critchley

(as consolidated)

**Andrew P. Baxley, Interlocutory Attorney:**

In Defendant's answers and affirmative defense in the above-captioned proceedings, Defendant incorporated separate counterclaims to cancel Plaintiff's pleaded Registration No. 2896141.<sup>1</sup> USPTO records do not indicate that Defendant paid the requisite filing fee for either counterclaim, which is necessary to obtain a filing date for a counterclaim. *See* Trademark Rules 2.111(a) and 2.114(b)(2)(iv); TBMP § 313 (2014). Accordingly, neither

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<sup>1</sup> Under the circumstances, Defendant should have filed a single counterclaim, with the required fee, as part of its answer in one of the proceedings and concurrently moved to consolidate the proceedings.

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counterclaim is entitled to a filing date.<sup>2</sup> Defendant's answers and affirmative defenses, however, are otherwise properly filed.<sup>3</sup>

Because the above-captioned proceedings involve the same parties and common questions of law or fact, the Board hereby orders their consolidation. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP § 511. The consolidated cases may be presented on the same record and briefs. See *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989); *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board file will be maintained in Opposition No. 91218282 as the "parent" case. As a general rule, from this point onward, only a single copy of

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<sup>2</sup> If Defendant elects to resubmit the counterclaim with the appropriate filing fee, it should file an amended answer and counterclaim in the parent case only.

<sup>3</sup> Defendant, in the counterclaims, seeks cancellation of Plaintiff's pleaded Registration No. 2896141 for the mark KICK ASS in typed form for "coffee" in International Class 30 on the ground that, on April 12, 2011, Plaintiff's amendment of the mark in that registration from KICK ASS COFFEE to KICK ASS was a material alteration of the mark. "[T]he deletion of the generic name of the goods ... would not generally be considered a material alteration, unless it was so integrated into the mark that the deletion would alter the commercial impression." TMEP § 807.14 (October 2014). Further, whether or not the amendment was acceptable may be an *ex parte* examination issue which is not a basis for cancellation of a registration. See *Marshall Field & Co. v. Mrs. Fields Cookies*, 11 USPQ2d 1355, 1358-59 (TTAB 1989); *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034 (TTAB 1989). It is not the Board's function to review the work of the Post-Registration Division and substitute its judgment therefor. See *Granny's Submarine Sandwiches, Inc. v. Granny's Kitchen, Inc.*, 199 USPQ 564, 567 (TTAB 1978). Moreover, had the Post-Registration Division determined that the amendment of the mark in pleaded Registration No. 2896141 was a material alteration of that mark, the mark in that registration would have remained as KICK ASS COFFEE.

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any submission should be filed herein. That copy, however, should include all of the consolidated proceeding numbers in the caption thereof.

Despite being consolidated, each proceeding retains its separate character. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleading; a copy of the decision shall be placed in each proceeding file.

In keeping with Board practice, the Board hereby adopts the discovery and trial schedule for Cancellation No. 92059924, the most recently instituted of the consolidated proceedings. *See* TBMP § 511. Those dates are as follows.

Deadline for Discovery Conference	<b>11/21/2014</b>
Discovery Opens	<b>11/21/2014</b>
Initial Disclosures Due	<b>12/21/2014</b>
Expert Disclosures Due	<b>4/20/2015</b>
Discovery Closes	<b>5/20/2015</b>
Plaintiff's Pretrial Disclosures Due	<b>7/4/2015</b>
Plaintiff's 30-day Trial Period Ends	<b>8/18/2015</b>
Defendant's Pretrial Disclosures Due	<b>9/2/2015</b>
Defendant's 30-day Trial Period Ends	<b>10/17/2015</b>
Plaintiff's Rebuttal Disclosures Due	<b>11/1/2015</b>
Plaintiff's 15-day Rebuttal Period Ends	<b>12/1/2015</b>

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 Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by

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Trademark Rule 2.129. If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.