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

Proceeding no.	91287225
Party	Defendant FCH Enterprises, Inc.
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Attachments	Motion to Consolidate.pdf(192766 bytes)

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FCH ENTERPRISES, INC.

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

ZIPMONEY PAYMENTS PTY LTD,)	
)	
Opposer and Counterclaim)	
Respondent,)	Opposition No. 91287225
)	Serial No.: 97382743
v.)	(for “ZIPCOINS”)
)	
FCH ENTERPRISES, INC.,)	<i>[parent proceeding]</i>
)	
Applicant and Counterclaimant.)	
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ZIPMONEY PAYMENTS PTY LTD,)	
)	
Petitioner,)	
)	Cancellation No. 92083254
v.)	Registration No. 5312672
)	(for “ZIP EXPRESS”)
FCH ENTERPRISES, INC.,)	
)	
Respondent.)	
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FCH ENTERPRISES, INC., dba ZIPPY’S)	
RESTAURANTS,)	
)	Opposition No. 91287698
Opposer,)	Serial No.: 90742456
)	(for “ZIP” and design)
v.)	
)	
ZIPMONEY PAYMENTS PTY LTD,)	
)	
Applicant.)	
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FCH ENTERPRISES, INC., dba ZIPPY'S)	Opposition No. 91287699
RESTAURANTS,)	Serial No.: 90742480
)	(for "ZIP" and design)
Opposer,)	
)	
v.)	[CONSOLIDATED CASES]
)	
ZIPMONEY PAYMENTS PTY LTD,)	APPLICANT'S MOTION TO
)	CONSOLIDATE; CERTIFICATE OF
Applicant.)	SERVICE
_____)	

APPLICANT'S MOTION TO CONSOLIDATE

I. INTRODUCTION.

Applicant FCH ENTERPRISES, INC. ("*Applicant*" and "*FCH*"), files this Motion to Consolidate (the "*Motion*") certain related proceedings currently pending before the Board pursuant to TBMP §511, and Fed. R. Civ. P. 42(a). For the reasons set forth below and based on the files in this proposed parent proceeding and the related proceedings, Applicant FCH respectfully submits that the Motion should be granted and that the above-captioned proceedings should be consolidated, with this opposition proceeding designated as the parent proceeding.

II. PROCEEDINGS TO BE CONSOLIDATED.

Movant files this Motion in Opposition No. 91287225, which was commenced by Opposer ZIPMONEY PAYMENTS PTY, LTD., an Australia proprietary limited company ("*Zipmoney*"), on September 18, 2023, opposing Applicant FCH's Application Serial No. 97382743 for "ZIPCOINS" in International Class 35. As the initial proceeding at issue in this Motion, this opposition should be designated as the parent proceeding and consolidated with the following pending Board proceedings:

No.	Filing Date	Proceeding No.	Parties / Description & Status
1	09/18/23	Opposition No. 91287225 [<i>proposed parent proceeding</i>]	Filed by Zipmoney against FCH Application No. 97382743 for “ZIPCOINS”, based on various Zipmoney registrations and applications (including Zipmoney Applications 90742456 and 90742480 for “ZIP” and design). Answer filed. ----- Counterclaim filed by FCH for cancellation of Zipmoney’s cited Registrations Nos. 6648711 and 6649040 for “ZIP”, based on various FCH registrations (including FCH Registration No. 5312672 for “ZIP EXPRESS”). Answer filed.
2	09/19/23	Cancellation No. 92083254	Filed by Zipmoney against FCH’s cited Registration No. 5312672 for “ZIP EXPRESS”, based on alleged abandonment. Answer filed.
3	10/17/23	Opposition No. 91287698	Filed by FCH against Zipmoney Application No. 90742456 for “ZIP” and design, based on various FCH “ZIP” registrations (including FCH Registration No. 5312672 for “ZIP EXPRESS”). Answer filed.
4	10/17/23	Opposition No. 91287699	Filed by FCH against Zipmoney Application No. 90742480 for “ZIP” and design based on various FCH “ZIP” registrations (including FCH Registration No. 5312672 for “ZIP EXPRESS”). Answer filed.

III. ARGUMENT.

Consolidation is discretionary with the Board and may be ordered in view of the savings in time, effort, and expense which may be gained from consolidation of proceedings involving common questions of law or fact, absent prejudice to the parties. *See* TBMP §511, Fed. R. Civ. P. 42(a). Identity of the parties is an additional factor considered by the Board in determining whether consolidation should be ordered. *Id.*

In this case, because the above-listed proceedings pending before the Board involve the same parties, as well as common questions of law and fact, consolidation would result in substantial savings in terms of time, effort, and expense to the parties, without prejudice to Zipmoney. For instance, at issue in both this proposed parent proceeding, filed by Zipmoney against FCH's "ZIPCOINS" application, and also in FCH's oppositions nos. 91287698 and 91287699, are Zipmoney's Application Nos. 90742456 and 90742480 for "ZIP" and design, which are cited by Zipmoney in this proceeding in support of its contention under Section 2(d) of the Lanham Act that it has priority of use of "ZIP" and that registration of FCH's applied-for "ZIPCOINS" mark would create a likelihood of confusion. Those same Zipmoney applications are opposed in FCH's opposition nos. 91287698 and 91287699 on the grounds of FCH's prior family of "ZIP" marks, including its "ZIP EXPRESS" mark (Registration No. 5312672).

In addition, at issue in all the proceedings is FCH's Registration No. 5312672 for "ZIP EXPRESS", which FCH cites in its two oppositions, as noted above, and in its counterclaim in the "ZIPCOINS" opposition proceeding. In Zipmoney's Cancellation No. 92083254, Zipmoney seeks to cancel FCH's "ZIP EXPRESS" registration on the grounds of abandonment. Similarly, Zipmoney asserts in its "Second Affirmative Defense" to FCH's counterclaim in this "ZIPCOINS" opposition that its marks including the "ZIP EXPRESS" registration "merit cancellation, as set forth in Zipmoney's Petition to Cancel (Cancellation No. 92083254)", as the mark has allegedly been abandoned. FCH asserted in its counterclaim in the "ZIPCOINS" proceeding that Zipmoney's cited registrations should be cancelled in view of the FCH's previously issued "ZIP EXPRESS" registration. Likewise, in FCH's Opposition Nos. 91287698 and 91287699, which are based in part on FCH's "ZIP EXPRESS" registration, Zipmoney filed answers in which it asserted in the "Sixth Defense" of its affirmative defenses that "Opposer [FCH] abandoned its rights in and to one or more of its marks." Thus, whether FCH has abandoned the "ZIP EXPRESS" mark is at issue in all the proceedings.

Moreover, in this Zipmoney opposition to FCH’s application for “ZIPCOINS”, FCH has asserted in its counterclaim that it owns several prior registrations for marks containing “ZIP”, that these marks comprise a family of “ZIP” marks having priority over Zipmoney’s cited “ZIP” registrations, and that the “ZIP” marks of Zipmoney’s cited registrations are confusingly similar to FCH’s preexisting family of “ZIP” marks. In FCH’s opposition Nos. 91287698 and 91287699 to Zipmoney’s applications to register “ZIP” and design, FCH similarly asserts the same prior registrations, its family of “ZIP” marks, and the fact that Zipmoney’s applied-for marks are confusingly similar to FCH’s preexisting family of marks.

Given the identity of the parties and the common questions of law and fact involved in the above-listed proceedings, consolidation of the proceedings is appropriate. Although counsel for the parties have discussed the possibility of Zipmoney’s consent to consolidation and Zipmoney has not to date agreed to consent, neither Zipmoney nor its counsel has stated that consolidation would prejudice Zipmoney.

IV. CONCLUSION.

For the reasons stated above, Applicant FCH respectfully submits that the Motion should be granted.

DATED: Honolulu, Hawaii, January 9, 2024

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/s/ Colin O. Miwa

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BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

ZIPMONEY PAYMENTS PTY LTD,)	
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Opposer and Counterclaim)	
Respondent,)	Opposition No. 91287225
)	Serial No.: 97382743
v.)	(for "ZIPCOINS")
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FCH ENTERPRISES, INC.,)	<i>[parent proceeding]</i>
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Applicant and Counterclaimant.)	
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ZIPMONEY PAYMENTS PTY LTD,)	
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Petitioner,)	
)	Cancellation No. 92083254
v.)	Registration No. 5312672
)	(for "ZIP EXPRESS")
FCH ENTERPRISES, INC.,)	
)	
Respondent.)	
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FCH ENTERPRISES, INC., dba ZIPPY'S)	
RESTAURANTS,)	
)	Opposition No. 91287698
Opposer,)	Serial No.: 90742456
)	(for "ZIP" and design)
v.)	
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ZIPMONEY PAYMENTS PTY LTD,)	
)	
Applicant.)	
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FCH ENTERPRISES, INC., dba ZIPPY'S)	Opposition No. 91287699
RESTAURANTS,)	Serial No.: 90742480
)	(for "ZIP" and design)
Opposer,)	
)	
v.)	
)	
ZIPMONEY PAYMENTS PTY LTD,)	[CONSOLIDATED CASES]
)	
Applicant.)	
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)	CERTIFICATE OF SERVICE

CERTIFICATE OF SERVICE

I HEREBY CERTIFY that on this date, a true and correct copy of APPLICANT'S MOTION TO CONSOLIDATE was sent to Petitioner's counsel via email, as follows:

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