

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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kds

December 5, 2024

Cancellation No. 92086567 (parent)

Cancellation No. 92086571

Cancellation No. 92086572

*Construction Management Corporation
d/b/a Green Shield*

v.

Green Shield Home LLC

Katerina D. Sparer, Interlocutory Attorney:

This case comes up on Petitioner's motion, filed November 4, 2024, to consolidate Cancellation Nos. 92086567 ("the '567 Cancellation"), 92086571 ("the '571 Cancellation"), and 92086572 ("the '572 Cancellation").¹ '567 Cancellation, 5 TTABVUE. The motion is fully briefed.

The Board has carefully considered all of the parties' arguments, presumes the parties' familiarity with the bases for their filings, and does not recount the facts or arguments here except as necessary to explain this decision. *See Guess? IP Holder LP v. Knowlux LLC*, 116 USPQ2d 2018, 2019 (TTAB 2015).

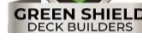
¹ On October 25, 2024 and November 22, 2024, two successive notices of appearance were filed on behalf of Respondent in each of the three cancellation proceedings at issue. *See* '567 Cancellation, 4 and 6 TTABVUE; '571 Cancellation, 4 and 5 TTABVUE; '572 Cancellation, 4 and 5 TTABVUE. The Board's records have been updated to reflect the attorneys identified in the most recent of the notices of appearance filed in each proceeding (i.e., the notices of appearance dated November 22, 2024).

I. Background

On October 23, 2024, Petitioner filed the following three petitions to cancel:


- (1) petition to cancel in the '567 Cancellation against Respondent's



Registration No. 7436374 for the mark , for use in connection with “constructing decks; construction of decks; residential and building construction consulting; residential and commercial building construction; residential building construction” in International Class 37;²


- (2) petition to cancel in the '571 Cancellation against Respondent's



Registration No. 7436375 for the mark , for use in connection with “construction of decks; construction consultation; construction of porches; construction planning; residential and building construction consulting; building construction; constructing decks” in International Class 37;³ and

- (3) petition to cancel in the '572 Cancellation against Respondent's



Registration No. 7198889 for the mark , for use in connection with “construction consultation; construction grading services; construction of buildings; construction of decks; construction of porches; construction of sunrooms; construction planning; construction supervision; roofing consultation; roofing contracting; roofing installation; roofing repair; roofing services; building construction; comprehensive preventative maintenance service for roofing systems; custom construction of homes; custom building construction; general construction contracting; installation of doors and windows; installing siding; provision of information relating to roofing installation and repair; residential building construction” in International Class 37⁴.

² Issued July 9, 2024. “DECK BUILDERS” is disclaimed.

³ Issued July 9, 2024. “DECK BUILDERS” is disclaimed.

⁴ Issued October 24, 2023. “HOME IMPROVEMENT” is disclaimed.

In each of the three petitions to cancel, Petitioner alleges prior use of GREEN SHIELD and GREEN SHIELD BUILDERS as both marks and trade names, and

prior use of , , and  as marks, in

connection with, inter alia, “residential and commercial building construction” and “construction of decks” (i.e., Petitioner’s Marks”).⁵ ’567 Cancellation, 1 TTABVUE 6-10, ¶¶ 1-7; ’571 Cancellation, 1 TTABVUE 6-10, ¶¶ 1-7; ’572 Cancellation, 1 TTABVUE 6-10, ¶¶ 1-7. As grounds for cancellation, Petitioner alleges a single claim of likelihood of confusion under Section 2(d) of the Trademark Act in each of the cancellation proceedings at issue.⁶ ’567 Cancellation, 1 TTABVUE 11-12, ¶¶ 14-15; ’571 Cancellation, 1 TTABVUE 11-12, ¶¶ 14-15; ’572 Cancellation, 1 TTABVUE 11-12, ¶¶ 14-15.

On December 2, 2024, Respondent filed answers in each of the three cancellation proceedings. *See* ’567 Cancellation, 8 TTABVUE; ’571 Cancellation, 6 TTABVUE; ’572 Cancellation, 6 TTABVUE. Respondent’s answers each deny the salient allegations

⁵ The Board notes that the remainder of Petitioner’s alleged services in the ’567 Cancellation is substantially similar but not identical to the services Petitioner alleges in the ’571 and ’572 Cancellations. *Compare* ’567 Cancellation, 1 TTABVUE 6-7, ¶ 1 *with* ’571 Cancellation, 1 TTABVUE 6, ¶ 1 *and* ’572 Cancellation, 1 TTABVUE 6, ¶ 1.

⁶ Petitioner’s references to Section 43(a) of the Trademark Act, 15 U.S.C. 1125(a) are misplaced inasmuch as the Board has no jurisdiction over such claims. *See, e.g.,* ’567 Cancellation, 1 TTABVUE 12; ’571 Cancellation, 1 TTABVUE 12; ’572 Cancellation, 1 TTABVUE 12. *See also Andersen Corp. v. Therm-O-Shield Int’l, Inc.*, 226 USPQ 431, 432 n.5 (TTAB 1985) (Board may not entertain any claim based on Trademark Act § 43(a)); *Fiat Grp. Autos. S.p.A. v. ISM, Inc.*, 94 USPQ2d 1111, 1116 n.8 (TTAB 2010) (claims under 15 U.S.C. § 1125(a) are outside the Board’s jurisdiction).

Cancellation Nos. 92086567, 92086571, and 92086572

in the respective petitions to cancel and assert nine paragraphs of purported “affirmative and other defenses.” *Id.*

II. Petitioner’s Motion to Consolidate

On November 4, 2024, Petitioner filed the instant motion to consolidate the ’567, ’571, and ’572 Cancellations. ’567 Cancellation, 5 TTABVUE. When cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases. *See* Fed. R. Civ. P. 42(a) and TRADEMARK TRIAL AND APPEAL BOARD MANUAL OF PROCEDURE (TBMP) § 511 (2024). *See Wis. Cheese Grp., LLC v. Comercializadora de Lacteos y Derivados, S.A. de C.V.*, 118 USPQ2d 1262, 1264 (TTAB 2016); *Venture Out Props. LLC v. Wynn Resorts Holding LLC*, 81 USPQ2d 1887, 1889 (TTAB 2007). 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 which may be caused thereby. *See World Hockey Ass’n v. Tudor Metal Prods. Corp.*, 185 USPQ 246, 248 (TTAB 1975); TBMP § 511.

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board’s own initiative. *See, e.g., Wis. Cheese Grp., LLC*, 118 USPQ2d at 1264.

Petitioner argues that consolidation is appropriate because, inter alia: (1) each of the three proceedings involve “[t]he same Registrant, the same Petitioner and the

same trademarks and trade names of Petitioner”⁷ (5 TTABVUE 4); (2) the subject marks in each of the three proceedings include the term “GREEN SHIELD” and are for use in connection with “similar and overlapping” services (*id.* at 2; *id.* at 4); (3) the parties’ claims and defenses and “the related materials to be reviewed and exchanged in discovery, are expected to significantly overlap” (*id.* at 7); and (4) consolidation “would promote judicial economy and avoid unnecessary costs and delay” (*id.*).

In response, Respondent argues that the Board should deny Petitioner’s motion to consolidate because, inter alia: (1) the three proceedings involve “separate and distinct marks” which will require “separate similarity analyses, and . . . separate priority date analyses” in view of Petitioner’s Marks (7 TTABVUE 5); and (2) consolidation “risks conflating factual and legal issues that are exclusive to each independent mark” (*id.*). Respondent further asserts that the Board should, in any event, reserve ruling on Petitioner’s motion to consolidate until after Respondent’s responsive pleadings are filed in each of the proceedings at issue. *Id.* at 9-10.

In reply to its motion to consolidate, Petitioner asserts, inter alia, that: (1) Respondent has now filed responsive pleadings in each of the three cancellation proceedings (9 TTABVUE 2); (2) the responsive pleadings all identify the same nine “affirmative defenses” (*id.*); (3) “[t]he commonality of issues and proofs in the three proceedings is self evident” (*id.*); and (4) the proceedings are now “ripe for consolidation” (*id.* at 3).

⁷ As noted previously, Petitioner’s alleged services in the ’567 Cancellation are substantially similar but not identical to Petitioner’s alleged services in the ’571 and ’572 Cancellations. *See supra* 3 n.5.

Cancellation Nos. 92086567, 92086571, and 92086572

The parties to the '567, '571, and '572 Cancellations are the same, and the involved marks, allegations, and claims are similar or identical. The operative pleadings in each proceeding were filed on the same day, (i.e., October 23, 2024 for each petition to cancel, and December 2, 2024 for each answer), and the proceeding schedules in effect are identical. In view of the foregoing, the Board finds that consolidation is appropriate. Accordingly, Petitioner's motion to consolidate is **granted**. The '567, '571, and '572 Cancellations are consolidated and may be presented on the same record and briefs. *See Hilson Research Inc. v. Soc'y for Human Res. Mgmt.*, 27 USPQ2d 1423, 1424 n.1 (TTAB 1993); *Helene Curtis Indus. Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618, 1619 n.1 (TTAB 1989).

The Board file will be maintained in the '567 Cancellation as the "parent case." As a general rule, from this point on, the parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper filed should bear the numbers of all consolidated proceedings in ascending order.⁸

Despite being consolidated, each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings; a copy of the decision shall be placed in each proceeding file. *See Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

⁸ The parties should promptly inform the Board of any other Board proceedings or related cases within the meaning of Fed. R. Civ. P. 42, so that the Board can consider whether further consolidation is appropriate.

III. Summary; Proceeding Schedule

Petitioner's motion to consolidate is **granted**.

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. *See* TBMP § 511. However, inasmuch as the now-consolidated proceedings were instituted on the same day and upon the same proceeding schedules, and because none of the proceedings are currently suspended, dates remain as set and are reproduced below for the parties' convenience:

Deadline for Discovery Conference	1/1/2025
Discovery Opens	1/1/2025
Initial Disclosures Due	1/31/2025
Expert Disclosures Due	5/31/2025
Discovery Closes	6/30/2025
Plaintiff's Pretrial Disclosures Due	8/14/2025
Plaintiff's 30-day Trial Period Ends	9/28/2025
Defendant's Pretrial Disclosures Due	10/13/2025
Defendant's 30-day Trial Period Ends	11/27/2025
Plaintiff's Rebuttal Disclosures Due	12/12/2025
Plaintiff's 15-day Rebuttal Period Ends	1/11/2026
Plaintiff's Opening Brief Due	3/12/2026
Defendant's Brief Due	4/11/2026
Plaintiff's Reply Brief Due	4/26/2026
Request for Oral Hearing (optional) Due	5/6/2026

Important Trial and Briefing Instructions

Generally, the Federal Rules of Evidence apply to Board trials. Trial testimony is taken and introduced out of the presence of the Board during the assigned testimony periods. The parties may stipulate to a wide variety of matters, and many

Cancellation Nos. 92086567, 92086571, and 92086572

requirements relevant to the trial phase of Board proceedings are set forth in Trademark Rules 2.121 through 2.125. These include pretrial disclosures, the manner and timing of taking testimony, matters in evidence, and the procedures for submitting and serving testimony and other evidence, including affidavits, declarations, deposition transcripts and stipulated evidence. Trial briefs shall be submitted in accordance with Trademark Rules 2.128(a) and (b). Such briefs should utilize citations to the TTABVUE record created during trial, to facilitate the Board's review of the evidence at final hearing. *See* TBMP § 801.03. Oral argument at final hearing will be scheduled only upon the timely submission of a separate notice as allowed by Trademark Rule 2.129(a).