

ESTTA Tracking number: **ESTTA1397557**Filing date: **11/22/2024**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding no.	92086567
Party	Defendant Green Shield Home LLC
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Date	11/22/2024
Attachments	Response in Opposition to Motion to Consolidate.pdf(219218 bytes)

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

CONSTRUCTION MANAGEMENT)	Cancellation No. 92086567
CORP. d/b/a GREEN SHIELD)	Combined Cancellation No. 92086571
)	Combined Cancellation No. 92086572
Petitioner,)	
)	Registration Nos. 7,436,374
v.)	7,436,375
)	7,198,889
GREEN SHIELD HOME, LLC)	
)	
Registrant.)	

**REGISTRANT’S RESPONSE IN OPPOSITION TO PETITIONER’S MOTION TO
CONSOLIDATE PROCEEDINGS**

Registrant Green Shield Home, LLC (“Green Shield” or “Registrant”), hereby opposes Petitioner Construction Management Corp. d/b/a Green Shield’s (“Petitioner’s”) Motion to Consolidate *Inter Partes* Proceedings, and requests that the Board refrain from consolidating the above-captioned cancellation proceedings pursuant to TBMP § 511 and Fed. R. Civ. P. 42(a). In support of its response, Green Shield respectfully relies upon the accompanying brief in support.

WHEREFORE, Registrant Green Shield Home, LLC respectfully requests that the Board deny Petitioner’s Motion to Consolidate Proceedings, reserve ruling on this motion until after Green Shield’s responsive pleadings are filed, and permit Cancellation Proceeding Nos. 92086567, 92086571, and 92086572 to proceed as independent actions.

Date: November 22, 2024

Respectfully Submitted,

/ Jeffrey T. Hewlett /

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CORP. d/b/a GREEN SHIELD)	Combined Cancellation No. 92086571
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Petitioner,)	
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v.)	Registration Nos. 7,436,374
)	7,436,375
)	7,198,889
GREEN SHIELD HOME, LLC)	
)	
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**REGISTRANT’S BRIEF IN SUPPORT OF ITS RESPONSE IN OPPOSITION TO
PETITIONER’S MOTION TO CONSOLIDATE PROCEEDINGS**

INTRODUCTION


Petitioner Construction Management Corp. d/b/a Green Shield’s (“Petitioner’s”) motion to consolidate attempts to improperly reduce three, independent trademark cancellation proceedings to a single proceeding. These separate cancellation proceedings do not concern “the same trademarks” or “related registrations”, as Petitioner suggests (5 TTABVUE 3, 6), nor do the cancellation proceedings concern identical issues of fact and law. Rather, each of these proceedings concern separate trademark registrations comprising: (A) separate and distinct marks having arguably distinct visual appearance, auditory sound/pronunciation, connotation, and commercial impression; (B) separate goods and services claimed and used in connection with these registrations, and (C) separate sets of facts for other *DuPont* factors bearing on the Court’s likelihood of confusion analysis. Indeed, where Petitioner’s claim is predicated entirely upon purely common law usage, each of the marks and registrations at issue will undergo separate similarity analyses, and importantly, separate priority date analyses. Where consolidating proceedings risks conflating factual and legal issues that are exclusive to each independent mark, the Board should deny Petitioner’s motion.

ARGUMENT



Consolidation is a discretionary decision resting with the Board. *See* TBMP § 511 (citing Fed. R. Civ. P. 42(a)). However, in determining whether to consolidate proceedings, the Board is required to weigh the savings in time, effort, and expense that may be gained from consolidation against any prejudice or inconvenience that may result. TBMP § 511. As with consolidation, the Board may similarly (and discretionarily) order proceedings to remain separate—particularly “[f]or convenience, to avoid prejudice, or to expedite and economize” a matter. *See, e.g.*, Fed. R. Civ. P. 42(b).

As is the case here, the Board routinely denies consolidations where issues differ across separate proceedings. *See Izod, Ltd. v. La Chemise Lacoste*, 178 USPQ 440, 441–42 (TTAB 1973) (consolidation denied for “sound judicial administration” of cases without “common questions of law and fact”). Similarly, where marks differ in aesthetic and/or design, the Board has likewise denied consolidation. *Envirotech Corp. v. Solaron Corp.*, 211 USPQ 724, 726 (TTAB 1981) (consolidation denied as possibly prejudicial where respondent’s marks were not all the same).

Here, Green Shield is the owner and registrant of three separate trademarks at issue¹: U.S. Trademark Reg. No. 7,436,374 (the ‘374 Mark), U.S. Trademark Reg. No. 7,436,375 (the ‘375 Mark), and U.S. Trademark Reg. No. 7,198,889 (the ‘889 Mark). Each of these marks differ in terms of design and the goods and services in which they are used, and at least one of the registrations differs in terms of its first-use date. Each of the Green Shield registrations are detailed below:

Trademark Registration	Goods and Services
 <p data-bbox="269 1461 732 1528">U.S. Trademark Reg. No. 7,436,374 (First-Use Date: October 1, 2022)</p>	<p data-bbox="824 1150 1370 1325">Constructing decks; Construction of decks; Residential and building construction consulting; Residential and commercial building construction; Residential building construction</p>

¹ Although the identity of the parties is a factor the Board may consider, it is not always necessary. TBMP § 511.

 <p>U.S. Trademark Reg. No. 7,436,375 (First-Use Date: Oct. 01, 2022)</p>	<p>Construction of decks; Construction consultation; Construction of porches; Construction planning; Residential and building construction consulting; Building construction; Constructing decks</p>
 <p>U.S. Trademark Reg. No. 7,198,889 (First Use Date: June 1, 2020)</p>	<p>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</p>

From a factual and legal standpoint, these differences among the Green Shield registrations in: (A) appearance, auditory sound/pronunciation, connotation, and commercial impression; and (B) priority date and/or date of first use carry significance. Principally, the Board cannot evaluate each mark in its entirety with respect to “the similarity or dissimilarity of the marks in their entireties as to appearance, sound, connotation and commercial impression” if it must view all marks in the aggregate. *See* TBMP 1207.01(b) (citing *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (C.C.P.A. 1973)). The test of likelihood of confusion is *not* whether the marks can be distinguished when subjected to a side-by-side comparison, but whether the marks are sufficiently similar such that there is a likelihood of confusion as to the source of the goods or services. *See id.*

(citing *Midwestern Pet Foods, Inc., v. Societe Des Produits Nestle S.A.*, 685 F.3d 1046, 1053 (Fed. Cir. 2012); *Edom Labs., Inc. v. Lichter*, 102 USPQ2d 1546, 1551 (TTAB 2012); and *In re Iolo Techs., LLC*, 95 USPQ2d 1498, 1499 (TTAB 2010)). Therefore, when comparing the marks, “[a]ll relevant facts pertaining to appearance, sound, and connotation must be considered before similarity . . . may be sufficient to support a finding that the marks are similar or dissimilar.” *Recot, Inc. v. M.C. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

This analysis is based on the marks “as depicted in the respective application and registration *without regard to whether the marks will appear with other marks . . . or other elements when used.*” See *In re Shell Oil Co.*, 992 F.2d 1204, 1207 n.4, 26 USPQ2d 1687, 1690 n. 4 (Fed. Cir. 1993) (indicating that applicant’s assertions that the applied-for mark would appear with applicant’s house mark were not considered in the likelihood-of-confusion determination) (emphasis added); *Mini Melts, Inc. v. Reckitt Benckiser LLC*, 118 USPQ2d 1464, 1470 (TTAB 2016) (rejecting applicant’s argument that, because its mark would appear along with its house mark and other distinguishing matter, the marks at issue were not confusingly similar). Accordingly, each Green Shield registration must be assessed independently with respect to their separate goods and services before any likelihood of confusion analysis can occur. See *Recot*, 214 F.3d at 1322; *In re Nat’l Data Corp.*, 753 F.2d 1056, 1058 (Fed. Cir. 1985) (“The basic principle in determining confusion between marks is that marks must be compared in their entireties and must be considered in connection with the particular goods or services for which they are used.”) (internal citations omitted). This analysis is most easily and readily accomplished through separate cancellation proceedings.

Separately, the present case is predicated on the likelihood of confusion with Petitioner’s supposed common law use of a mark for “GREEN SHIELD” and/or “GREEN SHIELD

BUILDERS”. *See* 1 TTABVUE 3–6. According to Petitioner, it has continuously used these marks since approximately 2010 in connection with among numerous services, including in general contracting. *Id.* Consequently, not only is the similarity of Petitioner’s marks, goods, and services at issue with respect to each of Green Shield’s separate registrations, but the priority date for Petitioner’s use of these alleged marks and services is at issue as well.

Presumably, each of these priority dates may differ and comprise separate facts and analyses that are more easily conducted in separate cancellation proceedings. This is particularly the case when the Board will also be required to compare Petitioner’s numerous alleged marks, goods, and services to the variety of goods and services covered by Green Shield’s registrations. To the extent these priority analyses are carried out in a single proceeding, there is a risk of conflating priority analyses for the numerous marks, goods, and/or services as issue between Petitioner and Green Shield.

Simply put: the differences in appearance, sound, and commercial impression of Green Shield’s registrations, along with the various goods and services with which these registrations are used, counsel the use of separate cancellation proceedings. *See La Chemise Lacoste*, 178 USPQ at 441–42. When coupled with the varying facts, law, and separate likelihood of confusion and common law priority analyses that the Board will have to conduct, prudence and convenience dictates maintaining separate cancellation proceedings.

Ultimately, the Board should deny the motion to consolidate these proceedings for the reasons detailed above. However, these considerations aside, the Board generally “will not consider a motion to consolidate until an answer has been filed” in each case sought to be consolidated. *See* TBMP § 511. Accordingly, the Board should, at the very least, reserve ruling on this motion until after Green Shield files its first responsive pleadings. Green Shield’s responsive

pleadings will highlight and delineate further factual and legal differences amongst the cancellation proceedings that are not yet evident from Petitioner's motion. Accordingly, Green Shield respectfully requests that the Board deny petitioner's motion and reserve ruling on this motion until after Green Shield's responsive pleadings are filed.

CONCLUSION

WHEREFORE, Registrant Green Shield Home, LLC respectfully requests that the Board deny Petitioner's Motion to Consolidate Proceedings, reserve ruling on this motion until after Green Shield's responsive pleadings are filed, and permit Cancellation Proceeding Nos. 92086567, 92086571, and 92086572 to proceed as independent actions.

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CERTIFICATE OF ELECTRONIC FILING AND SERVICE

I hereby certify that on this 22nd day of November 2024, a copy of the foregoing document is being electronically filed with the United State Patent & Trademark Office Trademark Trial and Appeal Board, at <http://esta.uspto.gov/>. I further certify that a copy of the foregoing document has been served on the Petitioner and/or its designated correspondent by e-mail at the following address:

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