UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

CSG/CAB

Opposition No. 100,014
Opposition No. 100,049
Opposition No. 100,196
Opposition No. 100,206
Opposition No. 100,264
Opposition No. 101,472

Rosenbluth International, Inc.

v.

Sterling Software Inc.

Before, Cissel, Wendel and Holtzman, Administrative Trademark Judges.

By the Board:

This case now comes up on opposer's July 31, 2000 motion to consolidate proceedings, applicant's June 30, 2000 motion to dismiss for failure to prosecute in Opposition No. 100,014, and applicant's response to the notice of default in Opposition No. 100,206. Opposer has responded to applicant's motion to dismiss in opposition No. 100,014; applicant has not responded to opposer's motion for consolidated proceedings.

Consolidation

In support of its motion, opposer states that opposer has instituted six proceedings against applicant opposing the registration of applicant's marks; that each opposition is based on the same grounds; that the marks are similar and the parties identical; and that in the interest of judicial economy, the proceedings can be presented on the same record without "appreciable inconvenience or prejudice."

The Board has reviewed each of the above identified proceedings, and each proceeding involves the same parties and at least some of the same questions of law and fact.

When cases involving common questions of law or fact are pending before the Board, consolidation of such cases may be appropriate. See Fed. R. Civ. P. 42(a); and TBMP Section 511. In addition, the Board, in its discretion, may order cases consolidated prior to joinder of issue (i.e., before an answer has been filed in each case).[1]

Inasmuch as the Board finds it appropriate to consolidate the above identified proceedings, the opposer's motion to consolidate is granted. See, also, Trademark Rule 2.127(a).

Opposition Nos. 100,014, 100,049, 100,196, 100,206, 100,264, and 101,472 will be presented on the same records

[1] Answers have been filed in Opposition Nos. 100,014, 100,049, 100,196, 100,264, and 101,472. Answer has not been filed in Opposition No. 100,206.

and briefs. The record will be maintained in Opposition No. 100,014 as the "parent" case, but all papers filed in these cases should include all proceeding numbers in ascending order.

Response to Notice of Default as to Opposition No. 100,206

Answer was due on November 10, 1999. A notice of default was issued in Opposition No. 100,206 on April 3, 2000, and applicant was allowed time to show cause why default judgment should not be entered against it.

On April 18, 2000, applicant responded to the notice of default alleging that it never received, and the Board never issued, a resumption order lifting the suspension in this case, and as a result, it was not aware of any due date for filing its answer.

Although the six-month suspension period as set forth in the Board order of October 14, 1998 had lapsed, and no resumption order had been issued by the Board, applicant exercised its right of resumption by filing seven consented requests to extend time to answer subsequent to the expiration of the six month suspension period.[2] While successive extensions of time to extend undercut applicant's position that proceedings were not resumed, the totality of the circumstances herein, including consolidation of

[2] Prior to receiving a resumption order from the Board, the better practice would have been for applicant to file a motion to resume proceedings rather than successive motions to extend its time to answer once the six month suspension period expired.

proceedings, warrant setting aside the notice of default.[3] Thus, notice of default is discharged and applicant is allowed **thirty days** from the date of this order to file its answer.

The Board notes that there have been numerous extensions filed, totaling over three and a half (3 ½) years, ostensibly to allow the parties to pursue settlement. However, the Board will not grant infinite extensions of time, even with consent. Thus, no further extensions of time to file an answer will be permitted. In the event that an answer is not filed in the time allowed, default judgment will be entered against applicant in Opposition No. 100,206.

Motion to Dismiss as to Opposition No. 100,014

On March 1, 2000, the Board issued an order allowing applicant thirty days in which to file an answer, and reiterating that the discovery and trial dates would remain as set in the Board order of January 6, 2000 (which adopted the discovery and trial dates set forth in the parties' November 11, 1999 consented motion to extend).

Applicant's answer, filed on March 31, 2000, is noted and entered.

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[3] Applicant filed seven consented requests to extend its time to answer for thirty day periods on April 16, 1999, May 17, 1999, June 14, 1999, July 15, 1999, August 11, 1999, September 13, 1999, and October 14, 1999. The consented motion of October 14, 1999 requested an extension up to November 10, 1999 for applicant to file its answer.

As set forth in the parties' November 11, 1999 motion, discovery in this proceeding closed on February 27, 2000, and the testimony period for opposer concluded on May 27, 2000.

On June 30, 2000, applicant filed a motion to dismiss Opposition No. 100,014 because of opposer's failure to take testimony.

In support of its motion to dismiss, applicant states that the testimony period closed on May 27, 2000; that neither the applicant nor its attorney have been informed of any intention on the part of opposer to take testimony; and that as a result of opposer's failure to take testimony, opposer cannot meet the burden of proof for supporting this opposition because it cannot show it will be damaged by the issuance of the applicant's registration or that it has priority over applicant.

In response, opposer states that the parties have spent four years in settlement negotiations which are still ongoing; that on March 1, 2000, the Board granted applicant additional time to answer the notice of opposition; that opposer never received an answer to the notice of opposition and assumed applicant was in default; that in the weeks prior to applicant's filing of the motion to dismiss, opposer's counsel attempted repeatedly to contact applicant's counsel and left messages for applicant's

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