

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: November 4, 2006

Opposition No. 91157538
Opposition No. 91157768
Opposition No. 91158277
Opposition No. 91158509
Opposition No. 91158520
Opposition No. 91158786
Opposition No. 91159159
Opposition No. 91164461
Opposition No. 91164602
Opposition No. 91165913
Opposition No. 91170501
Opposition No. 91173632

The Pep Boys Manny, Moe & Jack
of California

v.

Kent G. Anderson

Andrew P. Baxley, Interlocutory Attorney:

The Board, by its own initiative, hereby orders the consolidation of the above-referenced proceedings inasmuch as the parties are the same, and the proceedings involve common questions of law or fact.¹ In view thereof, the above-captioned proceedings are hereby consolidated.²

¹ When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases. See Fed. R. Civ. P. 42(a); see also, *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) and *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

² Other than Opposition Nos. 91170501 and 91173632, the above-captioned oppositions were previously consolidated.

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) and *Hilson Research Inc. v. Society for Human Resource Management*, 26 USPQ2d 1423 (TTAB 1993).

The Board filed will be maintained in Opposition No. 91157538 as the "parent" case. As a general rule, from this point on only a single copy of any paper or motion should be filed herein; but the caption of that copy should set forth all of the proceeding numbers in the manner they are listed in the caption of this order. However, because the involved proceedings were consolidated prior to joinder of the issues in Opposition No. 91173632, once proceedings therein are resumed, applicant should file a separate answer in Opposition No. 91173632 before commencing the practice of filing a single copy of any paper in the parent case.

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.

Applicant's consented motion (filed May 25, 2006) to continue suspension of these proceedings for settlement

Daniel S. Kirshner
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December 18, 2006

Mathew J. Cuccias, Esq.
Jacobson Holman, PLLC
400 7th Street
Washington, DC 20004

Via Certified Mail Return Receipt Requested

Re: The Pep Boys Manny, Moe & Jack of California, Opposer,

vs.

Kent G. Anderson, Applicant

Application No. 76/554,723
Mark: FUTURE/TOMORROW
Opposition No. 91173632

Dear Mr. Cuccias:

Please find enclosed a true and complete copy of Applicant's Answer to Notice of Opposition which was filed with the Trademark Trial and Appeal Board today by Express Mail.

Should you have any questions or concerns, please do not hesitate to contact my office.

Very truly yours,


Daniel Kirshner

Daniel S. Kirshner
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Phone (732) 828-8340
Fax (732) 418-1886

December 18, 2006

Matthew J. Cuccias, Esq.
Jacobson Holman, PLLC
400 7th Street
Washington, DC 20004

Via Certified Mail Return Receipt Requested

Re: The Pep Boys Manny, Moe & Jack of California, Opposer,

vs.

Kent G. Anderson, Applicant

Application No. 76/594,751
Mark: TOMORROW/FUTURISTIC
Opposition No. 91173923

Dear Mr. Cuccias:

Please find enclosed a true and complete copy of Applicant's Answer to Notice of Opposition which was filed with the Trademark Trial and Appeal Board today by Express Mail.

Should you have any questions or concerns, please do not hesitate to contact my office.

Very truly yours,


Daniel Kirshner

Jon A. Schiffrin, P.C.

January 13, 2006

VIA FIRST CLASS MAIL

Matthew J. Cuccias, Esq.
Jacobson Holman PLLC
400 Seventh Street, N.W.
Washington, D.C. 20004

F.R.E. 408 SETTLEMENT COMMUNICATION

File: 1030.0001

Re: The Pep Boys Manny, Moe & Jack of California v. Kent G. Anderson, Opposition Nos. 157,538, 157,768, 158,277, 158,509, 158,520, 158,786, 159,159, 164,461, 164,602, and 165,913, as consolidated

Dear Matthew:

Pursuant to our previous conversations concerning the above-referenced oppositions, we want to renew settlement discussions in order to resolve this matter.

As you know, our client, Kent Anderson has applied for registration for the mark FUTURE for goods and services in many classes, some of which concern automotive products. As your client is involved in the automotive industry, we can understand Pep Boys interest in protecting its FUTURA marks.

You may recall a July 22, 2003 letter to Mr. Paul Fahrenkopf, Mr. Anderson's previous counsel, which outlined some terms of settlement. Your client seemed interested in having Mr. Anderson delete the following language from his applications' description of services:

- Retail automobile and vehicle parts stores, in Class 35;
- Automotive and vehicle parts as it related to discount stores and on-line ordering in the field of..., in Class 35;
- Automobile service and station services, in Class 37;
- Maintenance and repair of vehicles, in Class 37; and
- Vehicle parts, car parts as it relates to custom manufacturing of general product lines in the field of..., in Class 40.

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Admitted in the District of Columbia and Florida. Not admitted in Virginia.

On May 12, 2004, you drafted an agreement that added several provisions. While my client would agree to deleting the above-referenced language from his recitation of services, he would not be willing to make all of the changes you recommended in your May 12, 2004 letter.

However, as a show of good faith and to resolve this matter, my client would also:

- Include exclusionary language relating to tires and wheels as it relates to motorcycles; and
- Agree not to use FUTURE in connection with tires, inner-tubes, wheels, automotive aftermarket parts, accessories and/or services as well as electronic and/or mail order sales of same, and/or retail stores, retail outlets, and/or retail automotive aftermarket outlets featuring automotive parts and accessories.

In return, we would ask your client to withdraw its requirements for many of the amendments requested in the May 12, 2004 letter and to withdraw the requirement that Mr. Anderson could not use FUTURE in connection with any product sold in the automotive aftermarket. We also believe it is reasonable to eliminate the provision that Mr. Anderson could not challenge your client's use of FUTURA in the future, especially where it might use this mark in connection with goods or services that Mr. Anderson may have priority of use.

We believe these are very workable settlement points, and it is our hope that this proposal will settle this matter and put an end to the consolidated opposition.

We look forward to hearing from you.

Very truly yours,

Jon A. Schiffin

JONATHAN LINN

Chartered Patent Attorney European Patent Attorney
Registered Trade Mark Agent

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2nd October 2007

Mr Kent Anderson
Global Future Brands Licensing World
925 North Griffin
Bismarck
North Dakota 58501
USA

Dear Kent

Your United Kingdom Trade Mark Application No: 2290533 "FUTURE" (word)
and Opposition No. 92761 thereto by Future Publishing Limited

I am pleased to report that, at long last, we have the official Decision on the above Opposition, just issued by the Trade Marks Registry following the formal Hearing that was held back on 15th February 2007. A copy of the full Decision is attached.

The Decision is, I am pleased to say, essentially as we expected, and mostly good news for you. In summary:

1. The Opponent's attempt to get your application knocked out in its entirety on the ground that the application was made in bad faith (by reason of the very wide ranging list of goods and services it covers and an allegation that you did not honestly intend that the trade mark should be used as such over such an extensive list) failed. The Decision sets out very nicely in paragraphs 39 to 59 the well-reasoned basis for this ground of attack being thrown out.
2. As I forewarned and as we were expecting, you have been unsuccessful in retaining coverage in your application for goods in Class 16 (printed matter, publications, etc) - Future Publishing Limited have successfully prevented your mark FUTURE being allowed for registration in respect of any goods in Class 16. This is on the basis of their earlier existing marks FUTURE PUBLISHING and THE FUTURE NETWORK for identical Class 16 goods. See paragraphs 60 to 75 of the Decision for the full discussion.

3. Future Publishing Limited's attempt also to prevent you getting your mark FUTURE registered for goods in Class 25 (clothing, etc) has failed. This is because they failed to establish a sufficient level of reputation and goodwill in their earlier marks in respect of such goods outside the publishing field. See paragraphs 76 to 85 and, further, 86 to 91 of the Decision for the full discussion.

4. In light of the above outcomes of the various grounds of opposition relied on by the Opponent, the result is on balance overall slightly in your favour, such as to warrant an order for costs being made in your favour, i.e. Future Publishing Limited is ordered to pay you a contribution to your costs, namely £500. This is admittedly rather better than we were anticipating, and no doubt a good bit of news for you.

How do you feel about the above Decision – are you happy to accept it?

The Decision is of course open to appeal by either party, the deadline for which is very short, namely **25th October 2007**. If no appeal is filed by then (and this date is not extendable except in very exceptional circumstances), then the terms of the Decision will become final, with your application then proceeding to granted registration in its published form, except for Class 16 of course, and the costs payment having to be made to you by Future Publishing Limited within seven days.

Unless you tell me to the contrary immediately, I will assume you are content with this Decision on this UK case as it stands and that you do not wish to challenge it by way of any appeal. Nevertheless please would you confirm to me explicitly that you agree with this?

The above outcome on this opposition to your UK application no. 2290533 to register the FUTURE mark will now have some important ramifications on the related European Community (CTM) case, where there is still the pending opposition by Fokker Services BV currently under further suspension in an extension of the "cooling-off" negotiation period. I am writing to you separately with a status update on this CTM case – I'll be faxing/e-mailing you separately on that within the next few days.

Yours sincerely



Jonathan Linn