

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

Mailed: February 7, 2002

Opposition No. 91122816

Russell Simmons

v.

Kerry Colin Keane

David Mermelstein, Attorney:

On February 6, 2002, counsel for opposer contacted the Board to determine the status of this matter in light of the Board's order of January 30, 2002.¹

Discovery and Trial Dates

Counsel inquired first as to the dates set in the January 30 order. It was quickly determined that opposer's latest consent motion to extend discovery and trial dates was not associated with the file prior to issuance of the January 30 order. In view of the parties' settlement negotiations, proceedings herein are SUSPENDED until SIX MONTHS from the mailing date of this action, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

In the event that there is no word from either party concerning the progress of their negotiations within the next six months, the Board will issue an order resuming

¹ The order instituted the counterclaim to cancel Registration No. 2,457,235, and reset discovery and trial dates.

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proceedings and resetting trial dates, including the time for discovery. If, during the suspension period, the parties or their attorneys should have a change of address, the Board should be promptly informed.

Parties to this Proceeding

Second, counsel noted that the name of the opposer in the caption had been changed from "Russell Simmons" to "Rush Media LLC." The undersigned assured counsel that he would examine the file and take any corrective action necessary. Unfortunately, examination of the file has raised a number of questions regarding the real parties in interest for this proceeding.

The subject application was published for opposition on January 30, 2001. On February 7, 2001, a request for extension of time to oppose until April 2, 2001, was filed by "DJR Holdings, LLC." On March 30, 2001, a notice of opposition was filed. The opposition named as opposer

RUSSELL SIMMONS ... individually and as the principal owner, majority shareholder and/or controlling member of RUSH COMMUNICATIONS, INC., a New York corporation ..., RUSH MEDIA, LLC, a New York limited liability company ..., RUSH ASSOCIATED LABELS, INC., a New York corporation ..., and DJR HOLDINGS, LLC, a New York limited liability company...

The fee for one opposer accompanied the notice of opposition, and the caption on the notice of opposition - and on opposer's subsequent papers - named only Russell Simmons as the opposer herein. Absent settlement, when

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proceedings herein resume, the parties will be required to address the following issues:

(1) Who is the opposer in this proceeding? Mr. Simmons is the only named opposer, but many of the asserted marks appear to be owned and used by the separate legal entities also referenced in the pleading.²

(2) Inasmuch as the extension of time to oppose was filed solely in the name of DJR Holdings, LLC, is the notice of opposition by Mr. Simmons untimely, because of lack of privity? Likewise, to the extent other identified entities, namely, Rush Communications, Inc., Rush Media, LLC, and Rush Associated Labels, Inc., were intended to be joint opposers, is opposition by each of them untimely, because of lack of privity?³

(3) If there is more than one opposer that can show privity with the potential opposer, an opposition fee (in this case, \$600.00) must be submitted for each opposer.

(4) If Rush Media, LLC is not a proper opposer in this proceeding, applicant may be required to bring its counterclaim as a separate cancellation proceeding or move to join Rush Media, LLC as a party.

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² At least one of the opposer's pending applications identified in the notice of opposition, App. No. 76/045,645, has since matured into a registration. Registration No. 2,457,235, owned by Rush Media, LLC, is the subject of applicant's counterclaim.

³ See TBMP §§ 206.02 and 303.05(a)-(c).