

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

RR

Mailed: December 14, 2007

Opposition Nos. 91174291 (parent)
91174292

Penthouse Digital Media
Productions, Inc.

v.

Adrienne Diane Jacoby

**Robert H. Coggins,
Interlocutory Attorney:**

This case now comes up on opposer's stipulated motion (filed November 15, 2007) to consolidate Opposition Nos. 91174291 and 91174292, to suspend proceedings pending disposition of a civil action, and to reset discovery and trial dates.

As a preliminary matter, the Board notes that opposer filed two copies of its motion via the Board's on-line system (ESTTA) using the form wizard for motions to suspend for civil proceedings with consent. As a result, ESTTA automatically granted the suspension but did not consider the full range of issues in the motion. The order herein supercedes the automatically generated ESTTA suspension order.

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The Board notes that opposer also filed its motion by snail mail, and included a duplicate copy of the motion and certificate of service filed via ESTTA. Extra copies of a paper should not be submitted. See *DeLorme Publishing Co. v. Eartha's Inc.*, 60 USPQ2d 1222, 1222 n.1 (TTAB 2000) (papers should be filed in single copies only, unless otherwise required by rule). Moreover, when a party submits a document electronically, that party should not send a follow-up or duplicate copy of the same document by mail.

Consolidation

The stipulated motion seeks to consolidate Opposition Nos. 91174291 and 91174292. Consolidation is discretionary with the Board, and may be ordered upon stipulation of the parties approved by the Board. See, for example, *Wright & Miller, Federal Practice and Procedure: Civil* §2383 (2004); and *Helene Curtis Industries Inc. v. Suave Shoe Corp.*, 13 USPQ2d 1618 (TTAB 1989) (stipulation).

The Board has reviewed the records in the two opposition files and concludes that Opposition Nos. 91174291 and 91174292 involve the same parties, the same marks, and common questions of law and fact. It would therefore be appropriate to consolidate these proceedings pursuant to Fed. R. Civ. P. 42(a). Accordingly, opposer's motion to consolidate is granted. The above-noted opposition

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proceedings are hereby consolidated and may be presented on the same record and briefs.

The Board file will be maintained in Opposition No. 91174291 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties and each paper should bear the case caption as set forth above.

Suspension for Civil Action

It is the policy of the Board to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. See Trademark Rule 2.117(a) and *General Motors Corp. v. Cadillac Club Fashions Inc.*, 22 USPQ2d 1933 (TTAB 1992).

Inasmuch as the parties to the consolidated opposition proceedings are also parties in a civil action¹ that may have a bearing on the Board case, opposer's stipulated motion to suspend is granted.

Within twenty days after the final determination of the civil action, the interested party should notify the Board so that this case may be called up for appropriate action.

¹ Civil action styled *Adrienne Moore Jacoby, aka Jill Kelly v. Penthouse Digital Media Productions, Inc., et al.* filed in bankruptcy proceeding number SV-05-15389-KT, styled *In re Jill Kelly Productions, Inc.*, which is pending in the United States Bankruptcy Court, Central District of California, San Fernando Valley Division.

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During the suspension period the Board should be notified of any address changes for the parties or their attorneys.

Discovery and Trial Dates

In view of the suspension granted hereinabove, opposer's motion to reset discovery and trial dates is denied as moot.

News from the TTAB

The USPTO published a notice of final rulemaking in the Federal Register on August 1, 2007, at 72 F.R. 42242. By this notice, various rules governing Trademark Trial and Appeal Board inter partes proceedings are amended. Certain amendments have an effective date of August 31, 2007, while most have an effective date of November 1, 2007. For further information, the parties are referred to a reprint of the final rule and a chart summarizing the affected rules, their changes, and effective dates, both viewable on the USPTO website via these web addresses:

<http://www.uspto.gov/web/offices/com/sol/notices/72fr42242.pdf>

http://www.uspto.gov/web/offices/com/sol/notices/72fr42242_FinalRuleChart.pdf

By one rule change effective August 31, 2007, the Board's standard protective order is made applicable to all TTAB inter partes cases, whether already pending or commenced on or after that date. However, as explained in the final rule and chart, this change will not affect any case in which any protective order has already been approved or imposed by the Board. Further, as explained in the final rule, parties are free to agree to a substitute protective order or to supplement or amend the standard order even after August 31, 2007, subject to Board approval. The standard protective order can be viewed using the following web address:

<http://www.uspto.gov/web/offices/dcom/ttab/tbmp/stdagmnt.htm>