

ESTTA Tracking number: **ESTTA436252**

Filing date: **10/17/2011**

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

Proceeding	91196299
Party	Defendant Digitalmojo, Inc.
Correspondence Address	THOMAS W. COOK 3030 BRIDGEWAY, SUITE 425-430 SAUSALITO, CA 94965-2810 UNITED STATES thomascooklaw@pacbell.net
Submission	Opposition/Response to Motion
Filer's Name	Thomas W. Cook
Filer's e-mail	thomascooklaw@pacbell.net, tom@thomascooklaw.com
Signature	/Thomas W. Cook/
Date	10/17/2011
Attachments	2011 10 17 DIGI's Response to CPR's Memo in Opposition to Motion to Consolidate.pdf ( 5 pages )(87197 bytes )

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

3 In the Matter of Trademark Application Serial No. 77/714,693

4 Mark: CONNECT

5 \_\_\_\_\_ )  
6 CONNECT PUBLIC RELATIONS, INC., a )  
Utah corporation. )

7 Opposer, )

8 v. )

9 DIGITALMOJO, INC., a California corporation )

10 Applicant. )  
11 \_\_\_\_\_ )

Opposition No. 91196299

APPLICANT'S REPLY TO  
OPPOSER'S RESPONSE TO TO  
APPLICANT'S MOTION  
CONSOLIDATE

12  
13  
14 **INTRODUCTION**

15 Applicant DigitalMojo, Inc. ("DigitalMojo") has requested the Board consolidate this  
16 Opposition No. 91196299, filed August 30, 2010, with and into Applicant's action for  
17 cancellation of the registration of the registration of the mark CONNECTPR, No. 92054395,  
18 owned by Opposer Connect Public Relations, Inc. ("ConnectPR"). This cancellation action was  
19 filed August 22, 2011. DigitalMojo has also filed an action for cancellation of the registration of  
20 ConnectPR's mark CONNECT PUBLIC RELATIONS, Reg. No. 2373504, also filed August 22,  
21 2011, and believes this action should also be consolidated, so that all common issues arising in  
22 these three cases may be efficiently resolved. This Reply to ConnectPR's September 15, 2011,  
23 Response is submitted on October 17, 2011, after the time at which a response would normally be  
24 due, consistent with the agreement of counsel for ConnectPR on September 23, 2011.

25  
26 **MEMORANDUM IN SUPPORT OF MOTION TO CONSOLIDATE**

27 As DigitalMojo has noted in its Motion to Consolidate, the marks involved in each of  
28 these proceedings, CONNECTPR (Reg. No. 2366850, Cancellation No. 92054395), CONNECT

1 PUBLIC RELATIONS (Reg. No. 2373504, Cancellation No. 92054427), and CONNECT (App.  
2 Serial No. 77714693, Opposition 91196299) are sufficiently similar to induce ConnectPR to cite  
3 its registrations in this opposition. Based on this use of these registrations by ConnectPR, and the  
4 further evidence and statements presented in this opposition, DigitalMojo asserts these  
5 cancellation proceedings and this opposition proceeding do and will involve many common issues  
6 of law and fact. The consolidation of these proceedings will save considerable time, effort, and  
7 expense. The prejudice or inconvenience resulting from consolidation will be negligible as this  
8 proceeding was still in the discovery stage at the time of filing of this Motion to Consolidate.

9  
10 **I. ConnectPR’s Assertion Regarding Timeliness - Answers Filed in Petitions**

11 ConnectPR has requested this Motion to Consolidate be denied because ConnectPR has  
12 not yet filed its Answers in the co-pending cancellation proceedings, and ConnectPR has opined  
13 that consolidation should be denied until its motions to dismiss in those consolidation cases have  
14 been determined.

15 On October 3, 2011, ConnectPR filed its Answers in the co-pending cancellation  
16 proceedings. ConnectPR’s objection that it has not yet filed its Answers is therefore moot, and so  
17 no longer a reason to deny consolidation. As to ConnectPR’s Motions to Dismiss the Petitions to  
18 Cancel, DigitalMojo agrees that those motions should be decided prior to consolidation as  
19 requested in this Motion.

20  
21 **II. ConnectPR’s Assertion Regarding “Reopening” of Discovery - Limited Discovery**

22 As to ConnectPR’s assertion that discovery in this opposition is now closed, and should  
23 not be “reopened,” ConnectPR’s motions to dismiss the cancellation proceedings included an  
24 assertion that the Petitions to Cancel in those proceedings were (untimely) compulsory  
25 counterclaims to this opposition. As a matter of logic, it would seem appropriate to continue  
26 discovery on all issues related to the marks of ConnectPR and DigitalMojo if the Board does not  
27 dismiss the cancellation proceedings. The issues surrounding the marks of ConnectPR and  
28

1 DigitalMojo remain common issues, and ConnectPR has not denied this fact.<sup>1</sup>

2 As to ConnectPR's request that discovery remain closed in this opposition, citing *Dating*  
3 *DNA, LLC v. Imagini Holdings, Ltd.* 94 USPQ2d 1889, *Dating DNA* was a case in which:

- 4 (1) Opposer failed to provide timely initial disclosures (and did not motion for leave to  
5 provide such disclosures),
- 6 (2) Opposer requested discovery be reopened after it was closed; and
- 7 (3) Opposer requested the two opposition cases be consolidated after discovery was  
8 closed.

9 The Board in *Dating DNA* applied the usual rule against "reopening discovery" based on  
10 these facts, but found insufficient evidence of "excusable neglect" to allow discovery to be  
11 reopened. None of the factors noted above appear in the present opposition, and *Dating DNA*  
12 therefore does not apply in our case.

13 What should control in this case is the rule cited in *Dating DNA*, when it consolidated the  
14 cases because it found common issues of fact and law. As in *Dating DNA*, ConnectPR has not  
15 disputed DigitalMojo's contention in this opposition that the three proceedings to be consolidated  
16 here involve the same parties, similar marks, and common issues of fact and law.

17  
18 (4) CONCLUSION

19 ConnectPR has failed to demonstrate these proceedings should not be consolidated, and  
20 also failed to demonstrate why it and DigitalMojo should be barred from discovery directed to the  
21 common issues of fact and law present in these three proceedings:

- 22 (1) CONNECTPR (Reg. No. 2366850, Cancellation No. 92054395),
- 23 (2) CONNECT PUBLIC RELATIONS (Reg. No. 2373504, Cancellation No.  
24 92054427), and

25  
26 \_\_\_\_\_  
27 <sup>1</sup> ConnectPR has questioned DigitalMojo's motive in filing Petitions to Cancel, stating these  
28 actions "...may be little more than an end run to circumvent the closure of the discovery period in this  
opposition," and ConnectPR says DigitalMojo has moved the Board "...to reopen discovery in this matter."  
Contrary to this assertion, DigitalMojo has not moved the Board to reopen discovery, and ConnectPR's  
statement regarding DigitalMojo's motive is without support.

1 (3) CONNECT (App. Serial No. 77714693, Opposition 91196299).

2 ConnectPR has likewise failed to demonstrate why these proceedings should not continue  
3 with a discovery and trial schedule consistent with the later-filed actions, and so consistent with  
4 Board practice. However, DigitalMojo agrees that the parties in these proceedings, once  
5 consolidated, should have available dispositive motions. DigitalMojo also asserts that all  
6 discovery outstanding at the time of discovery close in this opposition should be completed,  
7 whether these cases are consolidated to not, and DigitalMojo requests the Board so order.  
8 Finally, as ConnectPR has pointed out, these proceedings will be delayed pending decision on  
9 ConnectPR's Motions to Dismiss in the cancellation actions. Under the circumstances,  
10 suspension of this opposition is appropriate, and a new trial schedule established upon Board  
11 order.

12  
13  
14 Respectfully submitted,

15  
16 

17 Date: October 17, 2011

18 Thomas W. Cook, Reg. No. 38,849  
19 Attorney for Applicant  
20 3030 Bridgeway, Suite 425-430  
21 Sausalito, California 94965  
22 Telephone: 415-339-8550  
23  
24  
25  
26  
27  
28

1  
2  
3  
4  
5  
6  
7  
8  
9  
10  
11  
12  
13  
14  
15  
16  
17  
18  
19  
20  
21  
22  
23  
24  
25  
26  
27  
28

CERTIFICATE OF ELECTRONIC FILING

I hereby certify that this document is today being submitted via electronic filing utilizing the ESTTA system on:

Date: October 17, 2011



Thomas W. Cook

CERTIFICATE OF SERVICE

This is to certify that on this date, a true copy of the foregoing **APPLICANT'S REPLY TO OPPOSER'S RESPONSE - MOTION TO CONSOLIDATE** is being served, by U.S. mail, postage prepaid, to the attorney of the owner of record, of U.S. Registration No. 2,373,504 at the following addresses:

Karl R. Cannon  
CLAYTON, HOWARTH & CANNON, P.C.  
P.O. Box 1909  
Sandy, Utah 84091-1909

Date: October 17, 2011



Thomas W. Cook