

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

Baxley

Mailed: February 23, 2012

Opposition No. 91196299

Connect Public Relations,
Inc.

v.

Digitalmojo, Inc.

Cancellation No. 92054395

Cancellation No. 92054427

Digitalmojo, Inc.

v.

Connect Public Relations,
Inc.

By the Trademark Trial and Appeal Board:

On August 22, 2011, Digitalmojo, Inc. ("Digitalmojo") filed separate petitions to cancel Connect Public Relations, Inc.'s ("Connect") Registration Nos. 2866850 and 2373504, both of which are among Connect's pleaded registrations in the above-captioned proceedings. The petition to cancel Registration No. 2366850 was instituted as Cancellation No. 92054395. The petition to cancel Registration No. 2373504 was instituted as Cancellation No. 92054427. On August 26, 2011, Digitalmojo filed a motion to consolidate the above-captioned proceedings.

The petitions to cancel are the legal equivalent of a counterclaim in the opposition. See Trademark Rules 2.106(b)(2)(i) and (ii) and 2.114(b)(2)(i) and (ii); TBMP Section 313 (3d ed. 2011). Because the above-captioned proceedings involved the same parties and are intertwined, the Board, in its discretion, finds that their consolidation is warranted. See Fed. R. Civ. P. 42(a); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991); *Estate of Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991); and TBMP Section 511 (3d ed. 2011). Digitalmojo's motion to consolidate is therefore granted.

The Board file will be maintained in Opposition No. 91196299 as the "parent" case.¹ As a general rule, from this point onward, only a single copy of any submission should be filed herein. That copy, however, should include all of the consolidated proceeding numbers in the caption thereof.

Prior to the filing of answers in the cancellation proceedings,² Connect, on September 15, 2011, filed separate

¹ 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). 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.

² Connect filed answers in the cancellation proceedings on October 3, 2011.

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motions to dismiss the cancellations under Fed. R. Civ. P. 12(b)(6) for failure to state a claim. Digitalmojo failed to timely respond either motion to dismiss. The Board granted the motion to dismiss in Cancellation No. 92054427 on October 18, 2011, but did not rule on the motion to dismiss in Cancellation No. 92054395.

Following the dismissal of Cancellation No. 92092054427, Digitalmojo's briefs in response to the motions to dismiss, which were filed on October 17, 2011, became associated with the proceeding files. On October 24, 2011, Digitalmojo filed consented motions to reopen its time to respond to the motions to dismiss. Digitalmojo's consented motions to reopen its time to respond to the motions to dismiss are granted to the extent that the Board will consider the briefs in response to that motion that Digitalmojo filed on October 17, 2011. The October 18, 2011 order in Cancellation No. 92054427 is hereby vacated.

On November 8, 2011, Digitalmojo filed first motions for leave to file amended petitions to cancel in the cancellation proceedings. The motions did not include signed copies of proposed amended petitions to cancel. See TBMP Section 507.01. After Connect filed briefs in response to those motions, Digitalmojo, on February 6, 2012, filed second motions for leave to file amended petitions to cancel in the cancellation proceedings. In view of the filing of

the second motions for leave to file amended petitions, the Board will treat the first motions for leave to file amended petitions as having been withdrawn. Accordingly, the first motions for leave to file amended petitions will receive no consideration.

In view of the foregoing, Connect is allowed until **fifteen days** from the mailing date set forth in this order to file a single brief in response to the second motions for leave to file amended petitions to cancel. Digitalmojo's single reply brief in support of the second motions for leave to file is due in accordance with Trademark Rules 2.119(c) and 2.127(a).

During the pendency of the motions to dismiss the petitions to cancel, Connect filed, on October 21, 2011, filed a motion for partial summary judgment in the opposition proceeding.³ Connect withdrew that motion on October 25, 2011 and concurrently filed a corrected motion for partial summary judgment.⁴

³ Because the petitions to cancel are the equivalent of counterclaims in the opposition, one of the parties should have moved for suspension of the opposition pending the Board's decision on the motions to dismiss the cancellations. See Trademark Rules 2.117(a) and (c). Connect should not have filed the motion for partial summary judgment until after a decision was issued on the motions to dismiss the petition to cancel.

⁴ Connect's original motion for partial summary judgment exceeded the twenty-five page limit for briefs on motions because of a page break on page two that left that page with only four lines of text and nearly three-quarters of the page blank. The corrected motion for partial summary judgment was served one day after the original motion was served and was timely filed prior to the commencement of trial. See Trademark Rule 2.127(e)(1); TBMP Section 528.02.

On November 21, 2011, Digitalmojo filed a consented motion to extend its time in which to respond to the corrected motion for partial summary judgment to December 19, 2011. That motion is hereby granted.

On December 19, 2011, Digitalmojo timely filed a brief in response to the corrected motion for partial summary judgment. Concurrently with Connect's reply brief in support of the corrected motion for partial summary judgment, Connect, on January 9, 2012, filed a motion to strike the brief in response to the corrected motion for partial summary judgment. Digitalmojo, on January 30, 2012, incorporated a motion for leave to file an amended brief in response to the corrected motion for partial summary judgment into its brief in response to the motion to strike, and then, on February 16, 2012, filed a motion to correct the January 30, 2012 submission and reset Connect's time in which to file a reply brief in support of the motion to strike and brief in response to the motion for leave to file an amended brief in response to the corrected motion for partial summary judgment.

In the interest of bringing to an end the parties' motion practice in connection with Digitalmojo's brief in response to the corrected motion for partial summary judgment, the Board, in exercising its inherent authority to

control the conduct of cases on its docket, elects to decide the motion to strike and motion for leave to file an amended brief in response to the corrected motion for partial summary judgment at this time. See Trademark Rule 2.127(a); TBMP Section 510.01.

The text of Digitalmojo's brief in response to the corrected motion for partial summary judgment is thirty-five pages, well in excess of the twenty-five page limit for briefs in response to motions in Board proceedings. See Trademark Rule 2.127(a). A non-moving party may file one brief in response to a motion. See *id.* Even in situations where the filing party's adversary does not object, the Board does not consider briefs in connection with motions that exceed the page limit, does not dissect those briefs to bring them within the page limit, and does not grant leave to file corrected briefs that meet the page limit. See *Mattel Inc. v. Brainy Baby Co.*, 101 USPQ2d 1140 (TTAB 2011); *Cooper Technologies Co. v. Denier Electric Co.*, 89 USPQ2d 1478 (TTAB 2008); *Saint-Gobain v. Minnesota Mining and Manufacturing Company*, 66 USPQ2d 1220 (TTAB 2003) (page limits for briefs on motions are intended to prevent unnecessary burdens on the Board and cannot be waived by action, inaction or consent of the parties). Accordingly, Connect's motion to strike Digitalmojo's original brief in response to Connect's corrected motion for partial summary

judgment is granted, and Digitalmojo's motion for leave to file an amended brief in response to Connect's corrected motion for partial summary judgment is denied.

Digitalmojo's briefs in opposition to Connect's motion for partial summary judgment will receive no consideration.⁵

Digitalmojo's original brief in response is distinguished from Connect's original motion for partial summary judgment because (1) Connect's corrected motion for partial summary judgment merely corrected a single pagination error, whereas Digitalmojo's proposed amended brief in response reduces the text of the original brief in response by ten pages; and (2) Connect's corrected motion for partial summary judgment was served one day after the original motion for partial summary judgment, whereas Digitalmojo's proposed amended brief in response was served six weeks after its original brief in response, i.e., after Connect's reply brief and in response to a motion to strike.⁶ Further, inasmuch as Connect filed the corrected motion for partial summary judgment to bring that motion

⁵ Digitalmojo's motion to correct its January 30, 2012 submission and to reset time to respond thereto is moot.

⁶ The Board notes in addition that, if Digitalmojo were allowed to file an amended brief in response to the corrected motion for summary judgment, fairness dictates that Connect would have to be allowed to time in which to file an amended reply brief.

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within the page limit, Digitalmojo should have been aware of the applicable page limit.⁷

However, Digitalmojo's briefs in response clearly indicate that Digitalmojo does not concede the corrected motion for partial summary judgment on the merits. Accordingly, the Board will decide that motion on the merits. See Trademark Rule 2.127(a); TBMP Section 502.04.

Proceedings herein are suspended retroactive to August 26, 2011, pending disposition of Connect's corrected motion for partial summary judgment in Opposition No. 91196299 and Digitalmojo's motions to dismiss and the second motions for leave to file amended petitions to cancel in Cancellation Nos. 92054395 and 92054427. See Trademark Rules 2.117(c) and 2.127(d). Any paper filed during the pendency of these motions which is not relevant thereto will be given no consideration. The pending motions will be decided after the expiration of time for briefing Digitalmojo's second motions for leave to file amended petitions to cancel in Cancellation Nos. 92054395 and 92054427.

⁷ The Board expects all parties appearing before it to comply with the applicable rules.