

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

Baxley

Mailed: March 21, 2013

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:

In compliance with the Board's September 11, 2012 order, Digitalmojo, Inc. ("Digitalmojo"), on October 1, 2012, filed second amended petitions to cancel in the above-captioned cancellation proceedings. In view of that order, the Board will review the second amended petitions to cancel to determine their sufficiency.

In the amended petitions to cancel, Digitalmojo has adequately pleaded its standing in paragraphs 2-5 thereof by alleging that Connect Public Relations, Inc. ("Connect")

Opposition No. 91196299; Cancellation Nos. 92054395 and 92054427

has opposed Digitalmojo's application Serial No. 77714693 for the mark CONNECT in the above-captioned opposition proceeding. See *M. Aron Corporation v. Remington Products, Inc.*, 222 USPQ 93, 96 (TTAB 1984); TBMP Section 309.03(b) (3d ed. rev. 2012). Further, Digitalmojo has adequately pleaded claims of abandonment in paragraphs 8-9 of the second amended petitions to cancel by alleging facts that show nonuse less coupled with an intent not to resume use.¹ See *Otto Int'l Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007). Accordingly, the second amended petitions to cancel set forth claims upon which relief can be granted, and the cancellation proceedings can move forward. See Fed. R. Civ. P. 12(b)(6); TBMP Section 503.

The above-captioned cancellation proceedings are the functional equivalent of compulsory counterclaims in the above-captioned opposition proceedings. See Trademark Rules 2.106(b)(2)(ii) and 2.114(b)(2)(ii). In deciding cases that include counterclaims, the Board decides the counterclaim first.² See, e.g., *Tea Board of India v.*

¹ Whether or not Digitalmojo can prevail on the merits in the cancellation proceedings is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

² By deciding the counterclaim first, the Board determines whether the plaintiff in an opposition or cancellation proceeding can rely upon the registration that is the subject of the counterclaim in support of the opposition or cancellation.

Opposition No. 91196299; Cancellation Nos. 92054395 and 92054427

Republic of Tea Inc., 80 USPQ2d 1881 (TTAB 2006). Because Connect's pleaded Registrations Nos. 2366850 (subject of Cancellation No. 92054395) and 2373504 (subject of Cancellation No. 92054427) are subject of pending cancellation proceedings, which are the equivalent of counterclaims in the opposition proceeding, Connect cannot rely upon those registrations in support of the motion for partial summary judgment that it filed in Opposition No. 91196299 on October 25, 2011.

In that motion for partial summary judgment, Connect seeks entry of partial summary judgment with regard to sixteen separate subsets of services in International Classes 35, 38, 42, and 45, and not for all of the services in those classes, based on likelihood of confusion with the CONNECT PUBLIC RELATIONS and CONNECTPR marks in its pleaded registrations. However, Connect, in its amended notice of opposition, seeks refusal of registration of Digitalmojo's involved CONNECT mark in International Classes 9, 35, 38, 42, and 45 under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), for all the identified services in those classes,³ and did not seek to restrict or limit the goods

³ Rather, as noted in the September 11, 2012 order, likelihood of confusion in Board *inter partes* proceedings may be found with respect to a particular international class based on any single item within the identification of goods or services for that class. See *Tuxedo Monopoly Inc. v. General Mills Fun Group*, 648

Opposition No. 91196299; Cancellation Nos. 92054395 and 92054427

and services in the involved application under Trademark Act Section 18, 15 U.S.C. Section 1068. See *DAK Industries Inc. v. Daiichi Kosho Co.*, 35 USPQ2d 1434, 1437 (TTAB 1995); *Eurostar Inc. v. "Euro-Star" Reitmoden GmbH & Co.* KG 34 USPQ2d 1266, 1270 (TTAB 1994). As such, seeking entry of judgment for subsets within international classes is based on unpleaded issues for which Connect cannot obtain partial summary judgment. See TBMP Section 528.07(a).

Further, among the main purposes of motions for summary judgment is judicial economy. See TBMP Section 528.01. Judicial economy is not served by making sixteen separate determinations regarding whether there is a genuine dispute as to any material fact with regard to Connect's pleaded Section 2(d) claim.

In addition, as the Board noted in the February 23, 2012 and September 11, 2012 orders, Connect should not have filed the motion for partial summary judgment until Connect's motions to dismiss the petition to cancel were resolved. See Trademark Rule 2.127(d). Based on the

F.2d 1335, 209 USPQ 986, 988 (CCPA 1981); *Rocket Trademarks Pty Ltd. v. Phard S.p.A.*, 98 USPQ2d 1066 (TTAB 2011). That is, if likelihood of confusion is found with respect to any item within a particular class, that finding applies to the entire class at issue.

foregoing, Connect's motion for partial summary judgment will receive no consideration.⁴

Proceedings herein are resumed.⁵ Dates herein are reset as follows.

Answers to second amended petitions to cancel due: ⁶	April 18, 2013
Deadline for discovery conference:	May 18, 2013
Discovery in cancellation proceedings opens:	May 18, 2013
Initial disclosures in cancellation proceedings due:	June 17, 2013
Expert disclosures in all proceedings due:	October 15, 2013
Discovery in all proceedings closes:	November 14, 2013
Connect's pretrial disclosures due:	December 29, 2013
Connect's 30-day testimony period as plaintiff in the opposition to close:	February 12, 2014
Digitalmojo's pretrial disclosures due:	February 27, 2014
Digitalmojo's 30-day testimony period as defendant in the opposition and as plaintiff in the cancellations to close:	April 13, 2014

⁴ In any event, the vast majority of motions for summary judgment are denied.

⁵ As noted in the September 11, 2012 order, the parties appear to have already undertaken considerable discovery in this case. Accordingly, the parties should consider accelerated case resolution (ACR) for these consolidated proceedings. The parties should review the Board website regarding ACR, <http://www.uspto.gov/web/offices/com/sol/notices/acrognoticerule.pdf>. If the parties agree to pursue ACR, they should notify the Board within thirty days of the mailing date set forth in this order.

⁶ Such answers should be filed in the Board files for the cancellation proceedings.

Connect's pretrial disclosures for rebuttal in the opposition and as defendant in the cancellations due:	April 28, 2014
Connect's 30-day testimony period as defendant in the cancellations and for rebuttal as plaintiff in the opposition to close:	June 12, 2014
Digitalmojo's rebuttal disclosures as plaintiff in the cancellations due:	June 27, 2014
Digitalmojo's 15-day rebuttal testimony period as plaintiff in the cancellations to close:	July 27, 2014
Brief for Connect as plaintiff in the opposition due:	September 25, 2014
Brief for Digitalmojo as defendant in the opposition and as plaintiff in the cancellations due:	October 25, 2014
Brief for Connect as defendant in the cancellations and reply brief, if any, as plaintiff in the opposition due:	November 24, 2014
Reply brief, if any, for Digitalmojo as plaintiff in the cancellations due:	December 9, 2014

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125. An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.

If either of the parties or their attorneys should have a change of address, the Board should be so informed promptly.