

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

Mailed: July 11, 2006

Opposition No. 91167364
Cancellation No. 92045697

Editorial Planeta, S.A.

v.

Peck, Derek

Cheryl S. Goodman, Interlocutory Attorney:

The following motions are now before the Board:

- 1) Opposer's motion to dismiss, filed in Opposition No. 91167364 on May 18, 2006;
- 2) Respondent's motion to accept late-filed answer, filed in Cancellation No. 92045697 on May 31, 2006; and
- 3) Opposer's request to withdraw motion, filed May 31, 2006.

Motion to Dismiss and Request to Withdraw Motion, Opposition No. 91167364

Opposer filed, in Opposition No. 91167364, a motion to dismiss applicant's compulsory counterclaim as defective for failure to pay a fee.

In response, applicant opposes the motion to dismiss advising that it filed the counterclaim separately as a petition to cancel under the Board's electronic filing system (ESTTA) and that the proceeding was instituted under Cancellation No. 92045697.

In reply, opposer advises that it was not until it received applicant's response to its motion that it became aware that the cancellation was instituted as a separate proceeding; and that it now seeks to withdraw the motion to dismiss.

Opposer's request to withdraw the motion is granted. In view thereof, the motion to dismiss will receive no further consideration.

Cancellation No. 92045697, Consented Motion to Accept Late-Filed Answer

Answer was due in Cancellation No. 92045697 on May 23, 2006.

On May 31, 2006, respondent filed a motion to file its answer late, also advising that petitioner consented to the late filing of the answer up to and including June 23, 2006. On June 13, 2006, respondent filed its answer.

Inasmuch as respondent has established good cause for filing its answer late, and because petitioner consented thereto, respondent's motion is granted and its late answer is accepted in Cancellation No. 92045697.

Consolidation

The Board has reviewed both proceedings and notes that the proceedings involve identical parties, similar marks, and that the cancellation proceeding seeks to cancel the pleaded registration in Opposition No. 91167364.

The Board finds it appropriate to consolidate the above-identified proceedings. In view thereof, Opposition No. 91167364 and Cancellation No. 92045697 are hereby consolidated and, although each proceeding retains its separate character, it may be presented on the same records and briefs. The record will be maintained at the Board in Opposition No. 91167364 as the "parent" case, but all papers filed in these cases should include all proceeding numbers in ascending order.

Opposer/respondent's request to reset the trial schedule is granted.

Discovery and trial dates for the consolidated proceeding are as follows:

THE PERIOD FOR DISCOVERY TO CLOSE: 12/15/2006

Testimony period for
plaintiff in the opposition to close: (opening thirty days
prior thereto) 3/15/2007

Testimony period for defendant in the opposition
and as plaintiff in the cancellation to close: 5/14/2007
(opening thirty days prior thereto)

Testimony period for defendant in the cancellation
and its rebuttal testimony as plaintiff in the
opposition to close: 7/13/2007
(opening thirty days prior thereto)

Rebuttal testimony period for plaintiff in the
Cancellation to close: 8/27/2007
(opening fifteen days prior thereto)

Briefs shall be due as follows:

[See Trademark rule 2.128(a)(2)].

Brief for plaintiff in the opposition shall be due: 10/26/2007

Brief for defendant in the opposition and as
plaintiff in the cancellation shall be due: 11/25/2007

Brief for defendant in the cancellation and its reply
brief (if any) as plaintiff in the opposition
shall be due: 12/25/2007

Reply brief (if any) for plaintiff in the
Cancellation shall be due: 1/9/2008

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.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.