

UNITED STATES PATENT AND TRADEMARK OFFICE  
Trademark Trial and Appeal Board  
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GCP

Mailed: January 27, 2012

Opposition No. 91193970  
Cancellation No. 92053537

Modern Housing, LLC

v.

American Casino and  
Entertainment Properties, LLC

**By the Trademark Trial and Appeal Board:**

These proceedings now come before the Board for consideration of (1) Modern Housing, LLC's ("Modern Housing") motion (filed November 8, 2011) to consolidate Opposition No. 91193970 and Cancellation No. 92053537 and (2) American Casino and Entertainment, LLC's ("American Casino") cross-motion (filed November 28, 2011) for summary judgment filed in Opposition No. 91193970. Both motions have been briefed.

We first turn to Modern Housing's motion to consolidate. Modern Housing's motion to consolidate is **granted** for the reasons set forth below.

Background

Modern Housing filed a motion to suspend for civil action in Opposition No. 91193970 on March 18, 2011. At the time of such filing, discovery in Opposition No. 91193970 was set to close on April 19, 2011. By order dated April 21, 2011, the Board granted Modern Housing's motion and suspended Opposition No. 91193970 pending the final disposition of the civil action between the parties.<sup>1</sup> On November 8, 2011, Modern Housing filed a communication with the Board in both Opposition No. 91193790 and Cancellation No. 92053537 advising that the district court granted Modern Housing's motion to dismiss under Fed. R. Civ. P. 12(b)(1) and 12(c) and that the district court dismissed the civil action without prejudice. By the same communications, Modern Housing requested that the Board resume proceedings in Opposition No. 91193970 and Cancellation No. 92053537 and reset trial dates accordingly. Also, on November 8, 2011, Modern Housing filed its motion to consolidate Opposition No. 91193970 and Cancellation No. 92053537 under consideration herein.

Modern Housing's Motion to Consolidate

In support of its motion, Modern Housing argues that (1) the parties are identical in Opposition No. 91193970 and

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<sup>1</sup> On March 29, 2011, American Casino filed a motion to suspend for civil action in Cancellation No. 92053537 which the Board granted on April 4, 2011.

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Cancellation No. 92053537, (2) both cases involve common issues of law and fact, (3) consolidation will promote efficiency, economy and convenience, and (4) American Casino will not be prejudiced by consolidation.

In response, American Casino contends that the Board should deny consolidation because Modern Housing is using the motion to consolidate as a back door effort to reopen discovery in the opposition proceeding, which American Casino maintains has already closed. Moreover, American Casino argues that consolidation is not appropriate because the mark and related goods and services at issue in the opposition proceeding are different from the mark and related goods and services at issue in the cancellation proceeding. Finally, American Casino maintains that consolidation should be denied because any marginal savings in time, effort and expense will be outweighed by the prejudice and inconvenience American Casino will suffer.

Where the parties are the same, the proceedings involve common issues of law and fact, and the interest of judicial economy will be served thereby, the Board may consolidate proceedings. See Fed. R. Civ. P. 42(a); *Dating DNA LLC v. Imagini Holdings Ltd.*, 94 USPQ2d 1889, 1893 (TTAB 2010).

In this instance, because the parties are the identical, and since we find that the two proceedings do involve common

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issues of law and fact,<sup>2</sup> the Board believes that the interest of judicial economy will be served by consolidation of Opposition No. 91193970 and Cancellation No. 92053537. See Fed. R. Civ. P. 42(a) and TBMP § 511 TBMP (3d ed. 2011). We further note that, despite American Casino's argument to the contrary and as explained more fully *infra*, discovery has not yet closed in either proceeding. Moreover, consolidation will avoid duplication of effort concerning the factual issues and will thereby avoid unnecessary costs and delays. Consolidated cases do not lose their separate identity because of consolidation. Each proceeding retains its separate character and requires entry of a separate judgment. The decision on the consolidated cases shall take into account any differences in the issues raised by the respective pleadings and a copy of the final decision shall be placed in each proceeding file. See Wright & Miller, Federal Practice and Procedure: Civil § 2382 (updated 2011).

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<sup>2</sup>The Board notes that, while obviously not identical, the issues related to American Casino's involved marks ACESTAY and ACE PLAY, when used with frequent guest reward programs and the administration of incentive award programs both in association with hotel-related services, are closely related and should be tried together. The Board further notes that, although Modern Housing has asserted a dilution claim only in the cancellation proceeding, it has nonetheless asserted the identical claim of priority and likelihood of confusion in both cases and relies upon its pleaded registration for the mark ACE, i.e., Registration No. 2656435, in support of its claims in both proceedings.

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In view thereof, Modern Housing's motion to consolidate is granted. Opposition No. 91193970 and Cancellation No. 92053537 are hereby consolidated and may be presented on the same record and briefs.

The record will be maintained in Opposition No. 91193970 as the "parent" case. The parties should no longer file separate papers in connection with each proceeding, but file only a single copy of each paper in the parent case. Each paper should bear the numbers of both consolidated proceedings in ascending order as in the case caption set forth above.

American Casino's Motion for Summary Judgment

We next turn to American Casino's motion for summary judgment filed in Opposition No. 91193970. In support of its motion, American Casino contends that since discovery has closed in the opposition proceeding and because Modern Housing has failed to serve its initial disclosures in that case, Modern Housing cannot rely upon undisclosed witnesses, documents and information during its testimony period. In view of the foregoing, American Casino essentially argues that Modern Housing cannot prove its case and therefore American Casino is entitled to judgment as a matter of law.

In response, Modern Housing contends, *inter alia*, that it did in fact serve its initial disclosures upon American Casino on November 19, 2010. Modern Housing submitted a copy of its

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initial disclosures, including the corresponding certificate of service, with its response.

We note that Modern Housing filed its motion to suspend for civil action in Opposition No. 91193970 approximately a month prior to the close of discovery in that proceeding, as last reset. The fact that the Board granted Modern Housing's motion to suspend subsequent to the close of discovery is of no consequence. Indeed, in the event the district court rendered a decision which ultimately was not dispositive of, or had a bearing on the opposition proceeding, or, alternatively, dismissed the civil action without reaching the merits, as is the case here, the Board would have resumed proceedings in the opposition proceeding and would have provided the parties the remaining time in discovery as of the filing date of Modern Housing's motion to suspend for civil action. The Board would not have penalized the parties by deeming discovery closed just because it issued its order granting Modern Housing's motion to suspend for civil action following the close of discovery.

Accordingly, inasmuch as at least one month of discovery remained in Opposition No. 91193970 as of the filing date of Modern Housing's motion to suspend for civil action, and because Modern Housing did, in fact, serve its initial disclosures upon American Casino in the opposition

proceeding, and since the Board has granted Modern Housing's motion to consolidate resetting the close of discovery in both the opposition and cancellation proceedings, American Casino's motion for summary judgment filed in Opposition No. 91193970 is deemed moot and will be given no further consideration.<sup>3</sup>

Trial Schedule for Consolidated Proceedings

In accordance with Board practice, discovery, disclosure and trial dates are reset to conform to the dates latest set in the proceedings that are being consolidated. In this instance, Cancellation No. 92053537 was the latest filed proceeding with the dates latest set. The Board notes, however, that each of the proceedings consolidated herein were suspended pending the disposition of the civil action between the parties. Since the district court has dismissed the civil action without prejudice and without reaching the merits of the case, these now consolidated

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<sup>3</sup> Even assuming *arguendo* that discovery had closed in Opposition 91193970 and Modern Housing did not propound any discovery in that proceeding, failure to take discovery is not a basis for summary judgment. A plaintiff in a Board proceeding does not necessarily have to conduct discovery in order to prove its case during its testimony period. Further, even if Modern Housing had failed to serve its initial disclosures, judgment would not be entered against Modern Housing for its failure to serve initial disclosures unless (1) Modern Housing failed to comply with a Board order compelling service of its initial disclosures or (2) Modern Housing affirmatively stated that its initial disclosures would not be forthcoming. See Trademark Rule 2.120(g).

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proceedings are hereby resumed. Trial dates for these consolidated proceedings are reset as follows:

Opposition No. 91193970 will remain suspended until the deadline for initial disclosures in Cancellation No. 92053537 as set forth below. Following the deadline for initial disclosures in Cancellation No. 92053537, both cases will proceed upon the same schedule as noted below:

Deadline for Discovery Conference in Cancellation No. 92053537	2/24/2012
Discovery Opens in Cancellation No. 92053537	2/24/2012
Initial Disclosures Due in Cancellation No. 92053537	3/25/2012
Expert Disclosures for Consolidated Proceedings Due	7/23/2012
Discovery for Consolidated Proceedings Closes	8/22/2012
Plaintiff's Pretrial Disclosures	10/6/2012
Plaintiff's 30-day Trial Period Ends	11/20/2012
Defendant's Pretrial Disclosures	12/5/2012
Defendant's 30-day Trial Period Ends	1/19/2013
Plaintiff's Rebuttal Disclosures	2/3/2013
Plaintiff's 15-day Rebuttal Period Ends	3/5/2013

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.



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