

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513

Ryan

MAILED: May 7, 2003

Opposition No. 151,332 (parent)
Opposition No. 151,352
Opposition No. 151,353
Opposition No. 151,365

PANAMSAT CORPORATION

v.

SIRIUS SATELLITE RADIO INC.

Before Karyn K. Ryan, Interlocutory Attorney
Trademark Trial and Appeal Board:

This case now comes up for action on several
outstanding matters in the above referenced cases.

NAME CHANGE OF APPLICANT IN OPPOSITION NO. 151,332

It has come to the Board's attention that the named
party defendant in Opposition No. 151,332, CD Radio Inc.,
had changed its name to Sirius Satellite Radio Inc. prior to
commencement of this proceeding. This name change was
recorded with the Patent and Trademark Office's Assignment
Branch at Reel/Frame 2043/0169.

In view thereof, the Board *sua sponte* changes the case caption for Opposition No. 151,332 to reflect the new name of the defendant as Sirius Satellite Radio Inc. The parties are directed to refer to the party defendant by its new name in future papers filed in this proceeding.

**COUNTERCLAIM NOTED ONLY IN OPPOSITION NO. 151,352 FILE;
EXCESS COUNTERCLAIM FEE TO BE REFUNDED IN OPPOSITION NOS.
151,332, 151,353, AND 151,365**

It has come to the Board's attention that applicant Sirius Satellite Radio Inc. separately filed identical counterclaims for cancellation of opposer's pleaded registration, No. 1,827,748 -- in the files for Opposition Nos. 151,332, 151,352, 151,353, and 151,365.¹ Opposer-counterclaim respondent then separately filed its answer to the counterclaim against Reg. No. 1,827,748 in each of these four proceeding files.²

The parties are advised that the Board will not institute duplicate (or multiple as is the case here) counterclaim proceedings between the same parties against the same registration. Accordingly, **applicant-counterclaim**

¹ In Opposition No. 151,332, the applicant's answer and counterclaim was filed on June 24, 2002; in the other cases, the answer and counterclaim was filed on May 28, 2002.

² In Opposition No. 151,332, the opposer-counterclaim respondent's answer to the counterclaim was filed on July 9, 2002; in the other cases, opposer-counterclaim respondent's answer to the counterclaim was filed on June 11, 2002.

petitioner's counterclaim is noted only in the Opposition No. 151,352 proceeding record and will not be considered in Opposition Nos. 151,332, 151,353, or 151,365.

The excess filing fees (totaling \$900), inadvertently charged in Opposition Nos. 151,332, 151,353, and 151,365 shall be refunded to the applicant-counterclaim petitioner in due course.

MISCELLANEOUS PENDING MATTERS IN OPPOSITION NO. 151,332

On August 9, 2002, opposer filed its discovery responses and objections to applicant's request for production of documents; however, such filing is not appropriate under Trademark Rule 2.120(j)(8). Accordingly, the Board is returning to opposer, with its copy of this order, the August 9, 2002 discovery responses filed in violation of this rule.

Opposer's February 19, 2003 consented motion to suspend for settlement is **granted**. Proceedings are hereby **suspended** for six months from the mailing date set forth on this order, subject to the right of either party to request resumption at any time. See Trademark Rule 2.117(c).

The opposer's November 4, 2002 consented motion to extend is **granted** to the extent of the suspension herein.

CASES ARE CONSOLIDATED: OPPOSITION NO. 151,332 SHALL BE THE PARENT CASE

Opposer's August 9, 2002 consented motion to consolidate Opposition Nos. 151,332, 151,352, 151,353, and 151,365 is **granted**. Proceedings are hereby consolidated. See Fed. R. Civ. P. 42(a). The cases involve the same parties and common issues of law and fact. Consolidation therefore is in the interests of judicial economy and the orderly presentation and decision of these cases.

The cases shall retain their separate characters, but may be presented and decided on the same record and briefs. Opposition No. 151,332 is hereby designated the "parent" case in which all papers pertaining to the consolidated proceedings shall be filed. However, all proceeding numbers must be included in the caption of every paper filed. See the caption of this order as an example.

It is observed that, at this juncture, each of the four cases are suspended to permit the parties time to pursue settlement of their disputes. In the event that there is no word from either party concerning the progress of their negotiations within the next six months, the Board will issue an order resuming proceedings and resetting the close of discovery, and all trial dates (in the scheduling format appropriate for a case involving a counterclaim).

If, during the suspension period, either of the parties or their attorneys should have a change of address, the Board should be so informed in writing. Trademark Rule 2.18.

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