

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

IN RE SERIAL NO. 76/448,315



OPPOSER,)
International Star Registry of Illinois, Ltd.,)
an Illinois Corporation,)
Opposer,)
v.)
Tonya S. Vaughan,)
An Individual d.b.a. Name A Star,)
Applicant.)

Opposition No. 91158299
Serial No. 76/448,315

11-19-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #22

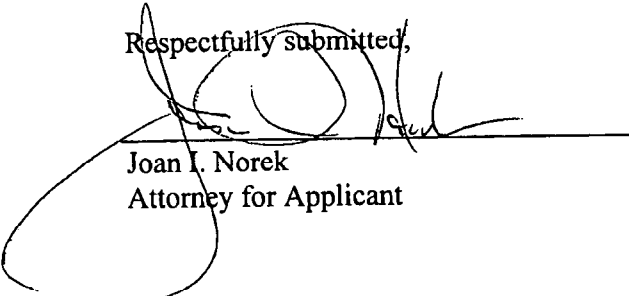
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APPLICANT'S MOTION TO HOLD DISCOVERY IN ABEYANCE PENDING DECISION ON APPLICANT'S DISPOSITIVE SUMMARY JUDGMENT MOTION

Applicant, Tonya S. Vaughan, through undersigned attorney, hereby moves for a suspension of the discovery period pending the disposition of Applicant's dispositive Motion for Summary Judgment that is being forwarded Priority Mail to the TTAB on together herewith. A Memorandum accompanies this motion.

Respectfully submitted,


Joan I. Norek
Attorney for Applicant

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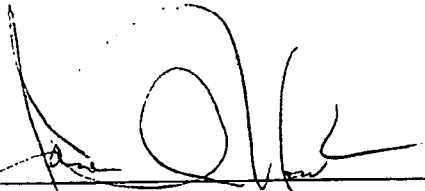
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Date: November 17, 2003



Joan I. Norek
Attorney for Applicant

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**APPLICANT'S MEMORANDUM IN SUPPORT OF HER MOTION TO HOLD
DISCOVERY IN ABEYANCE PENDING DECISION ON APPLICANT'S
DISPOSITIVE SUMMARY JUDGMENT MOTION**

I. Pleadings and Background

This Opposition was instituted on October 30, 2003. The discovery period was set to open on November 19, 2003, and to close on May 17, 2004.

Applicant is at this same time filing an Answer to the Notice of Opposition and Affirmative Defenses, admitting that the Opposer and Applicant were competitors in the for-profit star-registration field and denying all other salient allegations.

Applicant is also at this same time filing a Motion for Summary Judgment, together with a Memorandum, a Statement of Uncontested Material Facts and a volume of evidentiary submissions. The Motion for Summary Judgment seeks a dismissal of the Opposition, and it is potentially wholly dispositive of this proceedings.

Applicant's Motion for Summary Judgment explicitly does not encompass its Fourth Affirmative Defense of unclean hands, which would be moot here upon the summary granting of a dismissal of this Opposition.

The Applicant has not yet filed any discovery requests or notices, and the Applicant has not yet received any discovery requests or notices from the Opposer.

II. Discussion

In view of the dispositive nature of Applicant's Motion for Summary Judgment, it would be in the interest of judicial economy, and within this Board's normal practice, to suspend proceedings, including discovery, upon the filing of a summary judgment motion.

The suspension of discovery, rather than permitting the discovery period to run out, is of particular importance to Applicant here because her Fourth Affirmative Defense of unclean hands is not encompassed in the summary judgment motion. In that affirmative defense the Applicant alleges that:

- (1) Opposer is the largest of the for-profit star registration businesses;
- (2) Opposer has intentionally fostered third-party abuse of Applicant's NAME A STAR mark via a relentless campaign to deter competitors from using the words registration, register and registry to advertise and promote their businesses;
- (3) Opposer intends that the ensuing third-party abuse of Applicant's NAME A STAR mark culminates in the loss of Applicant's NAME A STAR mark; and

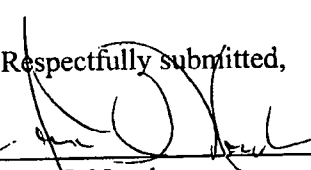
(4) Upon Applicant's loss of the NAME A STAR mark, Opposer seeks to acquire its own proprietary rights to the NAME A STAR mark and eventually to assert it even against Applicant.

Applicant's summary judgment motion is directed to Opposer's grounds of genericness and descriptiveness. Obviously the unclean hands affirmative defense stands apart from the content of the summary judgment motion, and should that motion be denied and this Opposition not be dismissed, Applicant would desire to take discovery regarding the unclean hands affirmative defense.

III. Conclusion

Applicant has filed a summary judgment motion which seeks dismissal of this Opposition prior to the serving of any discovery requests or notices. Applicant here seeks a suspension of the discovery period during the pendency of the summary judgment motion, so as to preserve her right to discovery on her unclean hands affirmative defense should the summary judgment motion not result in a dismissal of this Opposition.

Respectfully submitted,



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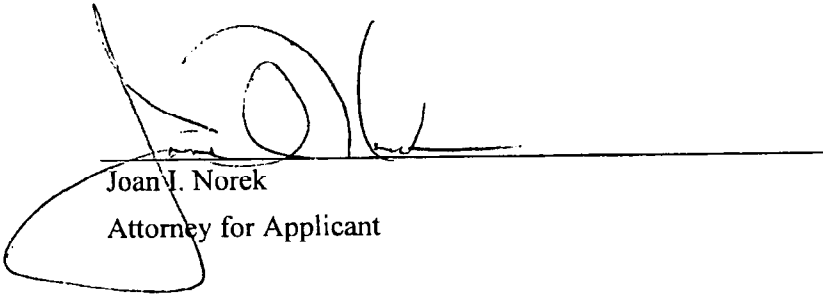
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