

TTAB

Attorney Reference Number 2669-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD
IN RE SERIAL NO. 76/448,315



12-30-2003

U.S. Patent & TMO/TTM Mail Rpt Dt. #78

OPPOSER,)	
International Star Registry of Illinois, Ltd.,)	Opposition No. 91158299
an Illinois Corporation,)	Serial No. 76/448,315
Opposer,)	
v.)	Mark: NAME A STAR and Design
Tonya S. Vaughan,)	Certificate of Mailing I hereby certify that this paper is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to Box TTAB No Fee, Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, on: 12-26-2003 Depositor Joan I. Norek.
An Individual d.b.a. Name A Star,)	
Applicant.)	Date signed 12-26-2003

**APPLICANT'S MEMORANDUM IN OPPOSITION TO
OPPOSER'S MOTION FOR CONSOLIDATION OF OPPOSITIONS**

Applicant here responds to Opposer's motion to consolidate this Opposition 91158299 (the " '299 Opposition") with Opposition 91157178 (the " '178 Opposition").

I. Background: Parties, Marks and Proceedings

Both Applicant and Opposer are in the novelty-gift star-registration business.

Applicant's two applications being opposed by Opposer are:

(1) The present application SN 76/448,315 to register Applicant's NAME A STAR and Design mark for her star registration goods/services, first used in commerce on October 7, 1999.

(2) The earlier opposed application SN 76/448,314 to register Applicant's NAME A STAR mark in typed form for her star registration goods/services.

Both applications were filed on September 10, 2002.

The typed-form '314 application was published for opposition on March 11, 2003. After multiple time extensions before filing an opposition, the earlier '178 Opposition was declared on July 29, 2003. Applicant answered, admitting competitor status and denying all other salient allegations. Thereafter, before any discovery was instituted, and more than a month before the present opposition was instituted, Applicant filed a motion for summary judgment ("sj motion") and a motion to hold discovery in abeyance pending disposition of the sj motion.

In the present '299 Opposition Applicant filed an Answer (admitting competitor status and denying all other salient allegations) plus motions (a) for summary judgment, (b) to hold discovery in abeyance, and (c) to suspend the opposition proceeding pending disposition of the sj motion in the earlier '178 Opposition.

On December 16, 2003 this Board suspended proceedings in the earlier '178 Opposition pending disposition of Applicant's sj motion.

Opposer's present motion to consolidate the present '299 Opposition with the earlier '178 Opposition was mailed for filing on December 22, 2003.

A table providing a chronological list of the proceedings in both Oppositions is attached hereto as demonstrative Exhibit 1. Courtesy copies of this Board's Adversary Proceeding Data for both Oppositions, and the pre-opposition period, are attached hereto as group Exhibit 2.

II. Similarities/Dissimilarities In Oppositions

The allegations of both oppositions are essentially the same. As stated in Applicant's motion to suspend the present '299 Opposition, it is not the design in Applicant's mark, but instead the *undisclaimed* words NAME A STAR therein that is targeted by Opposer. In its Notice of Opposition, Opposer contends that the NAME A STAR text of the NAME A STAR

AND DESIGN mark: (a) is generic or descriptive of the goods and services of the application, and has been so used in the field (Opp. ¶¶ 6-14, 18, 19, 23, 24); and (b) has not acquired secondary meaning. (Opp. ¶¶ 15, 17, 20-22).

The marks of the applications differ. In the earlier '178 Opposition, the mark is NAME A STAR in typed for which a date of December 25, 1978 is claimed for first use and first use in commerce. In the present '299 Opposition, the mark is NAME A STAR and Design for which a date of October 7, 1999 is claimed for first use and first use in commerce.

Because the target of both Oppositions is the same, but the marks are not identical, in Applicant's sj motions the documentary exhibits are the same, but the declaration evidentiary submissions and arguments (while overlapping) are not the same.

III. Judicial Economy Weighs Heavily Against Consolidation Prior to Decision on Pending Summary Judgment Motion

a. Proceedings in the '178 Opposition are already Suspended

Proceedings in the earlier '178 Opposition are already suspended pending the disposition of Applicant's sj motion. Proceedings in the earlier '178 Opposition were already suspended pending the disposition of Applicant's sj motion *at the time Opposer filed its motion to consolidate the present '299 Opposition with the earlier '178 Opposition.* (See the chronological table of Exhibit 1.)

b. Consolidation Would Entail Needless Paperwork

Opposer did not seek consolidation in the earlier '178 Opposition until after Applicant had filed her sj motion. (See the chronological table of Exhibit 1.) As explained in Section II

above, because the marks are not identical, Applicant's sj motions are not identical, and a sj motion directed to a consolidated opposition would also not be identical.

Applicant's evidentiary submissions filed in the earlier '178 Opposition amount to a very large volume. The consolidation Opposer seeks would entail a multiplication of the paper work, not only for Applicant but for this Board. That paperwork multiplication is needless because a simple suspension of the present '299 Opposition pending disposition of the sj motion in the earlier '178 Opposition will provide the same judicial economy. If Applicant is granted summary judgment in the '178 Opposition, this '299 Opposition tracks it under the doctrine of collateral estoppel or claim preclusion.

If this '299 Opposition is suspended, rather than consolidated, we avoid: (1) the filing of a consolidated sj motion by Applicant; (2) the filing of a response to Applicant's sj motion in this '299 Opposition, and (3) the handling of a consolidated sj motion, rather than the simpler single-mark sj decision of the '178 Opposition.

c. Judicial Economy is Better Served by Suspension than Consolidation

There is no judicial economy that would not be better met by a suspension of the present '299 Opposition pending the disposition of the first sj motion, which Applicant has requested. A grant of summary judgment to Applicant would dispose of the present Opposition under the doctrine of collateral estoppel or issue preclusion, and a denial would dispose of the sj motion in this '299 Opposition under the same doctrines. Consolidation would then of course be appropriate.

Opposer has not pointed out any benefit from consolidation that is not provided by suspension. To the contrary, the result Opposer seeks by requesting consolidation, rather than

joining Applicant's motion for suspension, apparently is the needless paperwork and delay consolidation would entail.

d. Opposer Missed All Opportunities to Chronologically Harmonize the Oppositions

The combination of Opposer's repeated extensions of time to oppose in the earlier '178 Opposition and the undeferred publication of the present '315 application for opposition provided Opposer with a genuine opportunity to harmonize the two oppositions chronologically, and thereby facilitate the consolidation it now seeks. In fact, the Opposer had a window day for filing its oppositions against both applications on the very same day. (See the chronological table of Exhibit 1.)

Below is an excerpt from the Exhibit 1 table.

Y	M	D	SN 76/448,314, Opp. 91157178	SN 76/448,315, Opp. 91158299
2003				
	3	11	Published for opposition	
	6	20	Op's 2nd extension to 10/15/03 granted	
	7	14	Op's opposition	
	7	15	(Op's extended deadline for opposition)	Published for Opposition
	7	29	TTAB's notice; opposition instituted	
	8	18		Op's 1st request for extension to oppose
	9	3		Op's extension granted
	9	8	Ap's Answer	
	9	15		Op's 2nd request for extension to oppose
	9	24	Ap's Motion for Summary Judgment	
	9	26	Ap's Motion to Hold Discovery in Abeyance	

As seen in this table excerpt, Opposer had a time extension to July 15, 2003 to file an opposition against the '314 application, and the window period for filing an opposition against

the '315 opposition opened the same day. A true timing opportunity. No only did Opposer disregard this opportunity, it waited out the entire opposition period of the '315 opposition and then requested a time extension. Then it requested another time extension. The timing result was that Applicant had not only filed her Answer but also her sj motion in the '178 Opposition more than a month before this '299 Opposition was instituted.

Opposer's timing strategy is inconsistent with a concern for judicial economy and is inconsistent with a concern for consolidation to obtain judicial economies.

IV. No Inconsistencies on Applicant's Part

In the earlier '178 Opposition, Applicant seeks summary judgment and submits all available documents and information on sales, promotion, use and the like, including all use samples known. There is no need for discovery because all Applicant has is in the record. Hers is a "let's get to a decision" approach, which saves precious time and precious financial resources.

Given these goals of reaching a decision without a needless waste of time and resources, there is nothing inconsistent in Applicant's filing a motion to suspend the present '299 Opposition while also filing a sj motion to cut off discovery in this '299 Opposition, should her motion to suspend not be decided before such discovery was instituted. Filing a sj motion here while seeking a suspension is wholly consistent with the goals of an early dispositive decision in the '178 Opposition, which will in turn dispose of this '299 Opposition.

V. Clarification of Applicant's Goods/Services

To counter Opposer's repeated misleading paraphrasing of Applicant's star-registration goods/services, the descriptions from the '315 application are set forth below:

Printed publications, namely, certificates of registration, charts, printed sheets and registers all identifying celestial stars as named by persons dedicating a celestial star as a personal gift, charts and printed sheets identifying celestial bodies, and essays regarding celestial bodies and astronomy. *International Class 16.*

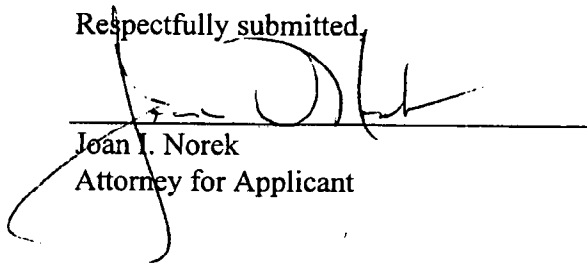
Novelty gift registry services, namely, registering celestial stars with names selected by customers and providing personalized certificates of registration. *International Class 35.*

VI. Summary

Both this '299 Opposition and the earlier '178 Opposition are directed at Applicant's NAME A STAR mark for star-registration goods/services. Although Opposer's opposition allegations are the same in each, Opposer disregarded opportunities to file its oppositions on the same day or about the same time. Instead of facilitating a consolidation by harmonizing the chronologies of these proceedings, Opposer spaced apart these oppositions with repeated time extensions. In result, the present '299 Opposition was instituted more than a month after Applicant filed her sj motion in the '178 Opposition. Judicial economies are best met by suspending this '299 Opposition pending disposition of the sj motion in the '178 Opposition, where proceedings have already been suspended for that purpose. Opposer has provided no reason for seeking consolidation (which now will lead to needless paperwork and delay) rather than joining Applicant's motion for a suspension.

Opposer is not seeking a judicial economy, but instead delay and more paperwork. Applicant requests that the consolidation motion be denied.

Respectfully submitted,



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Attorney for Applicant

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Chicago IL 60601
312/419-8055, fax 312/855-0535

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Y	M	D	SN 76/448,314, Opp. 91157178	SN 76/448,315, Opp. 91158299
2003				
	3	11	Published for opposition	
	4	14	Op's 1st request for extension to oppose	
	5	5	Op's extension granted	
	6	9	Op's 2nd request for extension to oppose	
	6	20	Op's extension to 10/15/03 granted	
	7	14	Op's opposition	
	7	15	(Op's extended deadline for opposition)	Published for Opposition
	7	29	TTAB's notice; opposition instituted	
	8	18		Op's 1st request for extension to oppose
	9	3		Op's extension granted
	9	8	Ap's Answer	
	9	15		Op's 2nd request for extension to oppose
	9	24	Ap's Motion for Summary Judgment	
	9	26	Ap's Motion to Hold Discovery in Abeyance	
	10	13		Op's extension granted
	10	17	Op's motion for extension for response to Ap's Discovery in Abeyance motion	
	10	20		Op's opposition
	10	30	Op's Rule 56(f) motion, motions for time to respond to sj motion, and consolidation motion	
	10	30		TTAB's notice; opposition instituted
	11	3	Op's response to Ap's Discovery in Abeyance motion	
	11	13	Ap's memorandum responses to Op's Rule 56(f) motion	
	11	19		Ap's Answer, motions for sj, hold Discovery in Abeyance, Suspend pending outcome of '178 sj
	12	11		Op's motion for extension
	12	16	TTAB's suspension of proceedings pending disposition of sj motion	
	12	22		Op's Rule 56(f) motion for discovery, motions to consolidate, alternatively for extension to respond to sj motion

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Adversary Proceeding Data

Proceeding Number: 76448314

Proceeding Status and Date: Terminated 2003-05-05

Prosecution History

Entry#	Entry Date	Due Date	History Text
4	2003-06-20		EXTENSION OF TIME GRANTED
3	2003-06-09		INCOMING - EXT TIME TO OPPOSE FILED
2	2003-05-05		EXTENSION OF TIME GRANTED
1	2003-04-14		INCOMING - EXT TIME TO OPPOSE FILED

Potential Opposer's Name Information:
INTERNATIONAL STAR REGISTRY OF ILLINOIS, LTD

Granted To Date: 2003-07-09

Correspondence Address:
BURTON S. BIRLICH
ARNSTEIN & LEHR
120 S. RIVERSIDE PLAZA, SUITE 1200
CHICAGO, IL 60606

Potential Opposer's Property Information:

Serial Number: 0

Registration Number: 0

Applicant Name Information:

Vaughan, Tonya S.

Owner Address:

Vaughan, Tonya S.
22435 Victoria Lane
Bend, OR 97702

Correspondence Address:

JOAN I. NOREK
THE LAW OFFICE OF JOAN I. NOREK
180 N. LASALLE STREET SUITE 1800
CHICAGO, IL 60601

Applicant Property Information:

Serial Number: 76448314

Registration Number: 0000000

International Classes: 035 016

Application Status: 774 - An opposition is now pending at the Trademark Trial and Appeal Board.

Application Status Date: 2003-07-29

Application Location: 657 - Pre-Publication Final Review

Application Date in Location: 2003-07-29

Law Office Assigned: L70 - TMEG Law Office 107

Exhibit 2

Attorney: Joan I. Norek
Domestic Representative:
Application Charged to Location: 845 - TTAB
Application Charged to Employee:
Registration Date:
Examiner Name: DAWNA BERYL GARDNER
Mark: NAME A STAR
Application Filing Date: 2002-09-10

Adversary Proceeding Data

Proceeding Number: 91157178
Proceeding Status and Date: Pending 2003-07-29
Interlocutory Attorney Name: JYLL S TAYLOR
Proceeding Location: 845 - TTAB
Proceeding Location Date: 2003-12-16
Proceeding Charged To Location: 84K - TTAB-Pending Docket Shelf
Proceeding Charged To Employee Name:
Date Proceeding Filed: 2003-07-14

Prosecution History

Entry#	Entry Date	Due Date	History Text
11	2003-12-16		PROC SUSPENDED PENDING SJ D'S MEMORANDUM IN RESPONSE TO P'S MOTION FOR DISCOVERY OR TO EXTEND TIME FOR FILING P'S RESPONSE TO.
10	2003-11-13		P'S MOTION W/REQ TO ALLOW DISCOVERY TIME PERIOD IN RESPONSE TO D'S MOTION FOR SUMMARY JUDGEMENT OR O
9	2003-10-30		P'S RESPONSE TO D'S MOTION TO HOLD DISCOVERY IN ABEYANCE
8	2003-11-03		P'S MOT FOR EXT OF TIME TO RESPOND TO D'S MOTION TO HOLD DISCOVERY IN ABEYANCE AND P'S CHANGE OF ADD
7	2003-10-17		D'S MOTION TO HOLD DISCOVERY IN ABEYANCE PENDING DECISION ON D'S DISPOSITION SUMMARY JUDGEMENT MOTIO
6	2003-09-26		D'S MOTION FOR SUMMARY JUDGMENT
5	2003-09-24		ANSWER
4	2003-09-08		PENDING, INSTITUTED
3	2003-07-29		NOTICE AND TRIAL DATES SENT; ANSWER DUE:
2	2003-07-29	2003-09-07	FILED AND FEE
1	2003-07-14		

Defendant Name Information:

Vaughan, Tonya S.

Owner Address:

Vaughan, Tonya S.
22435 Victoria Lane
Bend, OR 97702

Correspondence Address:

JOAN I. NOREK

**THE LAW OFFICE OF JOAN I. NOREK
180 N. LASALLE STREET, SUITE 1800
CHICAGO, IL 60601**

Defendant Property Information:

Serial Number: 76448314

Registration Number: 0

International Classes: 035 016

Application Status: 774 - An opposition is now pending at the Trademark Trial and Appeal Board.

Application Status Date: 2003-07-29

Application Location: 657 - Pre-Publication Final Review

Application Date in Location: 2003-07-29

Law Office Assigned: L70 - TMEG Law Office 107

Attorney: Joan I. Norek

Domestic Representative:

Application Charged to Location: 845 - TTAB

Application Charged to Employee:

Registration Date:

Examiner Name: DAWNA BERYL GARDNER

Mark: NAME A STAR

Application Filing Date: 2002-09-10

Plaintiff Name Information:

**INTERNATIONAL STAR REGISTRY OF ILLINOIS, LTD
ILLINOIS, LTD**

Correspondence Address:

BURTON S. BHRlich

LADAS & PARRY

224 SOUTH MICHIGAN AVENUE SUITE 1200

CHICAGO, IL 60604

Plaintiff Property Information:

Serial Number: 0

Registration Number: 0

Adversary Proceeding Data

Proceeding Number: 76448315

Proceeding Status and Date: Terminated 2003-09-03

Prosecution History

Entry#	Entry Date	Due Date	History Text
5	2003-11-25		TERMINATED
4	2003-10-03		EXTENSION OF TIME GRANTED
3	2003-09-15		INCOMING - EXT TIME TO OPPOSE FILED
2	2003-09-03		EXTENSION OF TIME GRANTED
1	2003-08-18		INCOMING - EXT TIME TO OPPOSE FILED

Potential Opposer's Name Information:
INTERNATIONAL STAR REGISTRY OF ILLINOIS
LTED

Granted To Date: 2003-10-15

Correspondence Address:
BURTON S. EHRlich
ARNSTEIN & LEHR
120 S. RIVERSIDE PLAZA, SUITE 1200
CHICAGO, IL 60606

Potential Opposer's Property Information:
Serial Number: 0
Registration Number: 0

Applicant Name Information:
Vaughan, Tonya S.
Owner Address:
Vaughan, Tonya S.
22435 Victoria Lane
Bend, OR 97702
Correspondence Address:
JOAN I. NOREK
THE LAW OFFICE OF JOAN I. NOREK
180 N. LASALLE STREET SUITE 1800
CHICAGO, IL 60601

Applicant Property Information:
Serial Number: 76448315
Registration Number: 0000000
International Classes: 016 035
Application Status: 774 - An opposition is now pending at the Trademark Trial and Appeal Board.
Application Status Date: 2003-10-30
Application Location: 657 - Pre-Publication Final Review

Application Date in Location: 2003-10-08
Law Office Assigned: M10 - TMO Law Office 110
Attorney: Joan I. Norek
Domestic Representative:
Application Charged to Location:
Application Charged to Employee:
Registration Date:
Examiner Name: JENNIFER HAZARD DIXON
Mark: NAME A STAR
Application Filing Date: 2002-09-10

Adversary Proceeding Data

Proceeding Number: 91158299
Proceeding Status and Date: Pending 2003-10-30
Interlocutory Attorney Name: CINDY B GREENBAUM
Proceeding Location: 845 - TTAB
Proceeding Location Date: 2003-12-19
Proceeding Charged To Location: 84K - TTAB-Pending Docket Shelf
Proceeding Charged To Employee Name:
Date Proceeding Filed: 2003-10-20

Prosecution History

Entry#	Entry Date	Due Date	History Text
5	2003-12-11		P'S MOTION FOR AN EXTENSION OF TIME
4	2003-11-19		ANSWER
3	2003-10-30		PENDING, INSTITUTED
2	2003-10-30	2003-12-09	NOTICE AND TRIAL DATES SENT; ANSWER DUE:
1	2003-10-20		FILED AND FEE

Defendant Name Information:

Vaughan, Tonya S.

Owner Address:

Vaughan, Tonya S.
22435 Victoria Lane
Bend, OR 97702

Correspondence Address:

JOAN I. NOREK
THE LAW OFFICE OF JOAN I. NOREK
180 N. LASALLE STREET SUITE 1800.
CHICAGO, IL 60601

Defendant Property Information:

Serial Number: 76448315
Registration Number: 0
International Classes: 016 035
Application Status: 774 - An opposition is now pending at the Trademark Trial and Appeal Board.
Application Status Date: 2003-10-30
Application Location: 657 - Pre-Publication Final Review
Application Date in Location: 2003-10-08
Law Office Assigned: M10 - TMO Law Office 110
Attorney: Joan I. Norek
Domestic Representative:
Application Charged to Location:
Application Charged to Employee:
Registration Date:
Examiner Name: JENNIFER HAZARD DIXON

Mark: NAME A STAR

Application Filing Date: 2002-09-10

Plaintiff Name Information:

**INTERNATIONAL STAR REGISTRY OF ILLINOIS LTD
LTD**

Correspondence Address:

BURTON S. EHRLICH

LADAS & PARRY

224 SOUTH MICHIGAN AVENUE, SUITE 1200

CHICAGO, IL 60604

Plaintiff Property Information:

Serial Number: 0

Registration Number: 0

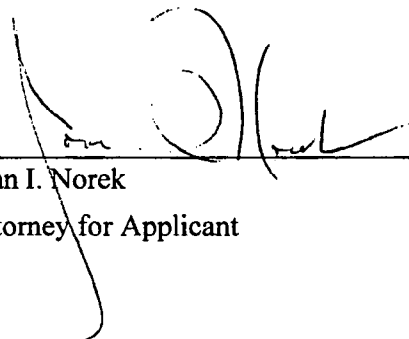
Certificate of Service

I hereby certify that a copy of this correspondence was served the mailing of a copy to each person listed below by first class mail on December 26, 2003.

Burton S. Ehrlich
Ladas & Parry
224 S. Michigan Ave., Suite 1200
Chicago, Illinois 60604

attorney for Opposer.

Date: December 26, 2003



Joan I. Norek
Attorney for Applicant