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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEALS BOARD  
IN THE MATTER OF APPLICATION SERIAL NO. 76/448,315

INTERNATIONAL STAR REGISTRY )  
OF ILLINOIS, LTD )  
Opposer, )  
)  
)  
TONYA S. VAUGHAN, )  
)  
Applicant. )

Opposition No. 91158299



12-11-2003

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

**OPPOSER'S MOTION FOR EXTENSION OF TIME TO "APPLICANT'S MOTION TO SUSPEND OPPOSITION FOR DECISION ON APPLICANT'S DISPOSITIVE SUMMARY JUDGMENT MOTION IN RELATED OPPOSITION 91157178" AND TO APPLICANT'S MOTION TO HOLD DISCOVERY IN ABEYANCE**

Now comes the Opposer, by and through its attorney Burton S. Ehrlich of Ladas & Parry and hereby requests a fourteen (14) day extension of time for Opposer to respond to Applicant's Motion To Suspend Opposition Proceedings until a Motion is decided in Related Opposition 91157178 and to respond to Applicant's Motion to Hold Discovery in Abeyance. Subject to this Board's approval the Opposer would under this Motion have **until and including, December 22, 2003** in which to respond to Applicant's Motions. In support of this Motion, the Opposer submits the following rationale:

The caption of the Applicant's Motion To Suspend refers to a related Opposition 91157178. On October 27, 2003, the Opposer filed a Motion to consolidate the present Opposition Proceedings in the application for "name a star" and design with the prior Opposition No. 91157178 against the same Applicant's application for "name a star". Both applications

also cover the same identified items where the Applicant provides star naming services, specifically the offering to name a star with the name requested by consumers. In response to the Opposer's Motion to Consolidate the Opposition Proceedings which is mandated for such matters by Trademark Rule 2.117(a) for related Opposition Proceedings. In response, the Applicant objected to the consolidation of proceedings in Opposition No. 91157178 in its paper filed on November 11, 2003. The Applicant in the caption of the Motion at issue now refers to Opposition No. 91157178 as a "Related Opposition". The Applicant's Motion now goes so far as to argue that Opposition Proceedings No. 91157178 (which one week prior to Applicant's present Motion it objected to being consolidated with the present opposition) will "in turn dispose of the present opposition under the doctrine of collateral estoppel or claim preclusion". This requested extension of time could also allow for a ruling on the Motion to Consolidate the Opposition Proceedings which appears to now be conceded as proper by Applicant. Such consolidation of Opposition Proceedings could moot Applicant's present Motions and with the granting under Federal Rule 56(f) of Opposer's Motion for discovery on the related Opposition Proceedings which will also allow for discovery to properly proceed in the Consolidated Opposition Proceedings.

Accompanying Applicant's Motion to suspend these Opposition Proceedings pending a decision in the related Opposition No. 91157178 the Applicant also concurrently filed in these proceedings a Motion for Summary Judgment. The Motion to suspend the present Opposition pending a decision in Related Opposition No. 91157178 would apparently be inconsistent with the Applicant also filing of the concurrently filed Motion for Summary Judgment. The Applicant appears not only to have taken different positions on the related/non-related nature of the

Opposition Proceedings (with Applicant objecting to consolidation, but now asserting that the other Opposition would be virtually controlling), but has also requested a suspension of these proceedings pending the outcome of the Related Opposition, while at the same time moving for Summary Judgment in these proceedings. Under this requested extension, the Opposer will now be able to file its responsive papers to Applicant's Motion to suspend or Hold Discovery in Abeyance on the same schedule as when Opposer's response to the Motion for Summary Judgment would become due. It is submitted that all three Motions should be considered together in a consolidated filing in a responsive paper on the Summary Judgment Motion, due to the relationship of the Motions to consolidate and suspend with the Summary Judgment Motion. In fact, under normal circumstances, any requested discovery would be considered with the filing of papers in response to a Summary Judgment Motion, but the Applicant has apparently sought to further complicate matters by filing separate Motions to Hold Discovery in Abeyance or suspend proceedings.

Should the Opposer's prior Motion in the Related Opposition to consolidate the Opposition Proceedings and allow for discovery not moot the Applicant's present Motions in these proceedings, then the Applicant also requests the extension to allow for Opposer's counsel to confer with his client and prepare an appropriate Affidavit and responsive papers.

The Applicant has relied upon factual assertions in support of its 2(f) claim. Opposer intends to demonstrate a number of areas where discovery is pertinent on issues pertaining to admissions of Applicant on lack of exclusivity, descriptive or generic uses, Applicant's own limited use, Applicant's promoting of the uses of others and many other aspects showing that Applicant is lacking any claim under Section 2(f). This extension will permit time for the

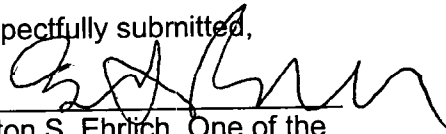
preparation of an appropriate affidavit in support of discovery by allowing sufficient time for counsel and his client to confer, as well as prepare appropriate responsive papers.

This rescheduling will also accommodate the busy schedule of Opposer's counsel and his client. Opposer's counsel has recently been involved in multiple out of state business trips. Furthermore, Opposer's counsel has been extensively involved in a number of matters for other clients including District Court proceedings, as well as in being involved in foreign trademark adversarial and application matters, and a variety of other matters for foreign and domestic clients. This extension will also allow Opposer's counsel to confer and meet with his client to obtain appropriate information and documentation for the planned affidavit. The Opposer's principals are also heavily involved in matters pertaining to the Christmas selling season and coordinating of matters during the present time is difficult.

The Opposer herein requests a fourteen (14) day extension of time for responding to the Motion and with this extension the Opposer's response will now be due on **December 22, 2003**, instead of December 8, 2003.

It is respectfully requested that with the provided rationale the Opposer requests the approval of this Motion.

Respectfully submitted,

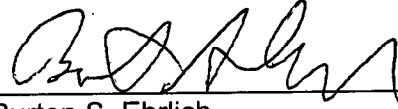


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**CERTIFICATE OF MAILING**

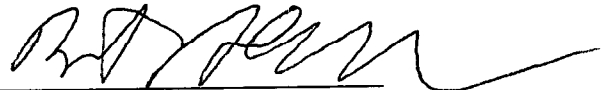
I hereby certify that this paper is being deposited (in triplicate) with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Box TTAB; Assistant Commissioner for Trademarks, U.S. Trademark Office, 2900 Crystal Drive, Arlington, VA 22202-3513 on this 5th day of December, 2003.



Burton S. Ehrlich

**CERTIFICATE OF SERVICE**

I hereby certify that a copy of the foregoing OPPOSER'S MOTION FOR EXTENSION OF TIME TO RESPOND TO APPLICANT'S MOTION TO HOLD DISCOVERY IN ABEYANCE AND NOTIFICATION OF CHANGE OF ADDRESS FOR OPPOSER'S COUNSEL was deposited with the United States Postal Service on the date shown below with sufficient postage as First Class Mail in an envelope addressed to Ms. Joan I. Norek, at The Law Offices of Joan I. Norek, 180 N. LaSalle Street, Suite 1800, Chicago, Illinois 60601, this 5th day of December, 2003.



Burton S. Ehrlich