UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

Baxley

Mailed: June 8, 2006

Opposition No. **91164989**
Opposition No. **91170316**

Michael Stars, Inc.

v.

michael starr

Andrew P. Baxley, Interlocutory Attorney:

This case now comes up for consideration of (1) applicant's motion (filed May 15, 2006) to suspend Opposition No. 91170316 pending final determination of Opposition No. 9164989; and (2) opposer's combined motion (filed May 17, 2006) to (a) reopen discovery in Opposition No. 91164989; (b) consolidate the above-captioned proceedings; and (c) compel applicant's attendance for a discovery deposition in both of the above-captioned proceedings.

The Board turns first to opposer's motion to reopen the discovery period in Opposition No. 91164989, which closed on February 21, 2006. See Trademark Rule 2.197. Because that discovery period has closed, opposer must show that its failure to timely act prior to such closing was the result of excusable neglect. See Fed. R. Civ. P. 6(b); *Pioneer Investment Services Co. v. Brunswick Associates L.P.*, 507

U.S. 380 (1993); *Pumpkin, Ltd. v. The Seed Corps*, 43 USPQ2d 1582 (TTAB 1997).

After reviewing the parties' arguments and evidence, the Board finds that opposer has not shown that its failure to act prior to the close of the discovery period in Opposition No. 91164989 was the result of excusable neglect. In particular, opposer has failed to explain adequately why it let such discovery period close without taking appropriate action, e.g., filing a motion to extend the discovery period or a motion to suspend the case for settlement negotiations.[1] While opposer contends that applicant consented to an extension of the discovery period, the Board considers any alleged consent to an extension of the discovery period to be at most an offer which lapsed when the discovery period closed.[2] Moreover, even if the parties were negotiating to settle this case shortly prior

[1] Opposer contends that applicant did not respond to an electronic mail transmission that was sent on February 21, 2006, the closing date of the discovery period, from opposer's attorney, in which opposer's attorney suggested that the parties extend the discovery period by sixty days. However, opposer could have filed a motion to extend the discovery period without applicant's consent. See Fed. R. Civ. P. 6(b); TBMP Section 509 (2d ed. rev. 2004).

[2] The Board further notes that applicant's refusal to consent to a reopening of the discovery period was promptly conveyed to opposer's attorney on February 27, 2006, i.e., less than a week after the close of the discovery period and nearly three months prior to the filing of opposer's combined motion.
Moreover, it does not necessarily follow that, because a party consented to an extension prior to the expiration of a time to act, the party is precluded from refusing to consent to a reopening of that time after that time has expired.

to the close of the discovery period, the fact that the parties were in settlement negotiations does not constitute excusable neglect. See *Atlanta-Fulton County Zoo, Inc. v. DePalma*, 45 USPQ2d 18858 (TTAB 1998). Accordingly, opposer's motion to reopen the discovery period in Opposition No. 91164989 is hereby denied.

The Board turns next to opposer's motion to consolidate the above-captioned proceedings and applicant's motion to suspend Opposition No. 91170316 pending final determination of Opposition No. 91164989. Although the proceedings at issue involve common issues of law and fact, the Board notes that Opposition No. 91164989 has moved forward to trial, while Opposition No. 91170316 is early in the discovery period. As such, the proceedings are in different procedural postures. See *Lever Brothers Co. v. Shaklee Corp.*, 214 USPQ 654 (TTAB 1982); TBMP Section 511 (2d ed. rev. 2004).

Further, consolidation of these proceedings would grant opposer the windfall of a reopened discovery period in Opposition No. 91164989 without having made the requisite showing of excusable neglect. Accordingly, the Board, in exercising its sole discretion, finds that consolidation of the proceedings is inappropriate. Rather, the Board finds that the Board's decision in Opposition No. 91164989 may have a bearing upon Opposition No. 91170316 and that,

therefore, suspension of Opposition No. 91170316 pending final determination of Opposition No. 91164989 is appropriate. See Trademark Rule 2.117(a); TBMP Section 510.02(a) (2d ed. rev. 2004).

In view thereof, opposer's motion to consolidate the above-captioned proceedings is hereby denied, and applicant's motion to suspend Opposition No. 91170316 is hereby granted. Opposition No. 91170316 is suspended retroactive to May 15, 2006 pending final determination, including any appeals or remands, of Opposition No. 91164989. Within twenty days after the final determination of the Opposition No. 91164989, the parties should notify the Board so that Opposition No. 91170316 may be called up for appropriate action.[3]

With regard to opposer's motion to compel applicant's appearance at a discovery deposition for both of the above-captioned proceedings, all discovery depositions must be noticed and taken during the discovery period. See Trademark Rule 2.120(a); TBMP Section 404.01 (2d ed. rev. 2004). As noted *supra*, the discovery period in Opposition No. 91164989 has closed. Further, proceedings in Opposition No. 91170316 have, earlier in this order, been suspended retroactive to May 15, 2006 pending final determination of

[3] While Opposition No. 91170316 is suspended, any address changes for the parties or their attorneys should be filed in both of the above-captioned proceedings.

Opposition No. 91164989. Accordingly, opposer's motion to compel is denied.

The Board deems the filing of applicant's motion to suspend Opposition No. 91170316 on May 15, 2006 to have tolled the running of all dates in both of the above-captioned proceedings. Proceedings in Opposition No. 91164989 are hereby resumed. Opposer will be allowed a testimony period in that proceeding which is equal to the number of days remaining in its testimony period therein case when the motion to suspend was filed in Opposition No. 91170316, i.e., seven days.

Testimony periods in Opposition No. 91164989 are reset as follows:[4]

Plaintiff's **seven-day** testimony period to close:	**7/20/06**
Defendant's 30-day testimony period to close:	**9/18/06**
Plaintiff's 15-day rebuttal testimony period to close:	**11/2/06**

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served

[4] Inasmuch as, pursuant to the discovery and trial schedule as last reset in Opposition No. 91164989 in a trial commenced in Opposition No. 91164989 on April 23, 2006, any motions to compel or motions for summary judgment in that proceeding may be denied as untimely. See Trademark Rules 2.120(e)(1) and 2.127(e)(1); TBMP Sections 523.03 and 528.02 (2d ed. rev. 2004). A resetting of dates cannot serve to render timely an untimely filed motion. See *La Maur, Inc. v. Bagwells Enterprises, Inc.,* 193 USPQ 234, 235 (Comm'r 1976).

on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.l25.

Briefs shall be filed in accordance with Trademark Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.l29.