

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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Mailed: January 8, 2010

Opposition No. 91124251
Cancellation No. 92032311

INTERNATIONAL CONSULTING
SERVICES, LTD

v.

CHEAP TICKETS, INCORPORATED

By the Trademark Trial and Appeal Board:

These consolidated proceedings now come before the Board for consideration of (1) applicant/registrant's motion to resume these consolidated proceedings and for judgment based upon the ruling in a district court action involving the parties herein and (2) applicant/registrant's motion to amend the drawing of its Registration No. 2021749 which is the subject of Cancellation No. 92032311 of these consolidated proceedings. Opposer/petitioner has not filed a response to either of the aforementioned motions.

We first turn to applicant/registrant's motion to amend. Applicant/registrant seeks to amend the drawing of its mark in Registration No. 2021749 from CHEAP TICKETS INC. to CHEAP TICKETS. Concurrently with its motion, applicant/registrant has submitted the appropriate filing fee, a new drawing of the

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proposed amended mark and a new specimen of use of the amended mark.

An amendment to the drawing of a mark may not be made if it materially alters the character of the mark. See Trademark Rule 2.72(a)(2). The general test of whether an alteration of the mark is material is whether the mark would have to be republished after the alteration in order to fairly present the mark for purposes of opposition. See *Visa International Service Association v. Life-Code Systems, Inc.*, 220 USPQ 740 (TTAB 1983).

In this instance, applicant/registrant is merely seeking to delete the entity designation "INC." from its drawing. The Board finds that such an amendment does not materially alter the character of the mark or change the mark's overall commercial impression.

The Board notes, however, that applicant/registrant failed to submit with its motion to amend the required affidavit or declaration under 37 C.F.R. §2.20 stating that the specimen showing use of the proposed mark as amended was in use in commerce at least as early as the date of its filing of its motion to amend. See Trademark Rule 2.173(b)(3). In view thereof, applicant/registrant's motion to amend its drawing is denied without prejudice.

We next turn to applicant/registrant's motion to resume proceedings and for judgment based upon the disposition of a

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civil action involving the parties herein. In support of its motion, applicant/registrant contends that the United States District Court for the Eastern District of New York, *inter alia*, ruled in favor of applicant/registrant on the ground that applicant/registrants CHEAP TICKETS marks are not generic for its identified services.¹

Inasmuch as the district court's ruling has a direct bearing on the claims asserted by opposer/petitioner in these consolidated proceedings, i.e., a claim of genericness, and because the district court has found that applicant/registrant's CHEAP TICKETS marks are not generic for the services identified² and insofar as opposer/petitioner has not contested the motion, applicant/registrant's motion for judgment in its favor based upon the district court's ruling is granted.

Accordingly, both Opposition No. 91124251 and Cancellation No. 92032311 are hereby dismissed with prejudice.

As a final matter, the Board notes that on May 10, 2004, the Board issued an order to show cause under Trademark Rule 2.134(b) in view of the fact that applicant/registrant

¹ By order dated August 23, 2002, the Board suspended these consolidated proceedings pending the final disposition of the civil action between the parties in United States District Court for the Eastern District of New York.

² The Board notes that, to the extent that a civil action in a Federal district court involves issues in common with those in a Board proceeding, the district court decision would be binding on the Board, whereas the Board decision is merely advisory to the district court. See *American Bakeries Co. v. Pan-O-Gold Baking Co.*, 2 USPQ2d 1208 (D.C. Minn. 1986).

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permitted its Registration No. 2021844, which, as noted above, is subject to Cancellation No. 92032311 of these consolidated proceedings, to be cancelled for failing to file a Section 8 affidavit of continued use.

In its response to the Board's show cause order, applicant/registrant states that it did file a timely Section 8 affidavit but due to an inadvertent clerical error its registration was nevertheless cancelled. Notwithstanding, applicant/registrant now states that it no longer wishes to reinstate this particular registration.

The Board is persuaded that the foregoing reasons constitute sufficient cause to not enter judgment against respondent because the Board finds that applicant/registrant's failure to file a Section 8 affidavit was occasioned by mistake and/or inadvertence

Accordingly, the order to show cause is hereby discharged, however, applicant/registrant's Registration No. 2021844 remains cancelled.