

TRADEMARK
Docket No. 30208.24006.30

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

32311

Nancy Omella

INTERNATIONAL CONSULTING SERVICES,
LTD. d/b/a ICS TRAVEL

Petitioner and Opposer,

v.

CHEAP TICKETS, INC.

Registrant and Applicant.

Cancellation No. 32,311
Opposition No. 124,251

Marks: CHEAP TICKETS, INC.;
CHEAP TICKETS, INC. & Design;

Registration Nos. 2,021,749 and 2,021,844
Serial No. 76/043,058

Box TTAB NO FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

MOTION ON CONSENT FOR CONSOLIDATION AND SUSPENSION OF
PROCEEDINGS

Applicant and Respondent, Cheap Tickets, Inc., ("Cheap Tickets") with the consent of Opposer and Petitioner, International Consulting Services, Ltd. d/b/a ICS Travel ("ICS Travel"), hereby moves the Board for an order consolidating and suspending the above-identified opposition and cancellation proceedings, pending disposition of ICS Travel v. Cheap Tickets, Inc., Civil Action No. 01CV-4768, which is presently pending in the United States District Court for the Eastern District of New York.

BACKGROUND

Cheap Tickets is the owner and registrant of two service marks for CHEAP TICKETS INC., which were registered in the United States Patent & Trademark Office on December 10,

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1996 with registration numbers 2,021,749 and 2,021,844. On May 8, 2000, Cheap Tickets filed an application for the registration of an additional service mark, CHEAP TICKETS INC. and design, under Application Serial No. 76/043,058. ICS Travel has objected to these marks on the ground that they are descriptive and/or generic and has challenged the marks in the following proceedings:

1. District Court Proceeding

On July 18, 2001, ICS Travel filed a Complaint against Cheap Tickets for Cancellation of Federal Trademark Registrations and Declaratory Judgment of Noninfringement in the United States District Court for the Eastern District of New York, Civil Action No. 01CV-4768, claiming that Registration Nos. 2,021,749 and 2,021,844 were descriptive and/or generic and seeking cancellation of the marks on those grounds. Thereafter, on October 10, 2001, Cheap Tickets filed an Answer and Counterclaimed against ICS Travel for federal trademark infringement; unfair competition; cybersquatting; unfair business practices; dilution, deceptive, false, and misleading advertising; and common law trademark infringement. This action currently is pending and remains in the discovery phase.

2. Cancellation Proceeding before the Board - Cancellation No. 32,311

On August 17, 2001, ICS Travel filed a Petition for Cancellation against both of the Cheap Tickets registered service marks (Registration Nos. 2,021,749 and 2,021,844) on the grounds that the marks were invalid as being merely descriptive and/or generic. On October 10, 2001, Cheap Tickets filed its Answer to the Petition for Cancellation, denying that its marks are descriptive and/or generic.

3. Opposition Proceeding before the Board - Opposition No. 124,251

On September 11, 2001, the CHEAP TICKETS and design mark was published for opposition in the Official Gazette. On November 6, 2001, ICS Travel filed a Notice of Opposition against the CHEAP TICKETS and design application, Serial No. 76/043,058, alleging that the mark should not be registered because it was descriptive and/or generic. On

December 14, 2001, Cheap Tickets filed its Answer to ICS Travel's Notice of Opposition, denying that its CHEAP TICKETS and design mark is descriptive and/or generic.

ARGUMENT

"Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board." TBMP § 510.01. 37 C.F.R. section 2.117 provides that the Board may stay proceedings where parties to a case pending before the Board are engaged in a civil action which may have a bearing on the proceedings before the Board. *See also, Opticians Ass'n of America v. Independent Opticians of America, Inc.*, 734 F. Supp. 1171 (D.N.J. 1990), *rev'd on other grounds*, 920 F.2d 187 (3d Cir. 1990).

As set forth in detail above, Cheap Tickets and ICS Travel are engaged in a civil action pending in the United States District Court for the Eastern District of New York, which involves the same or similar legal and factual issues as those in the opposition and cancellation proceedings before the Board -- namely, the validity of the federal service mark registrations for the CHEAP TICKETS INC. marks. The proceedings in the civil action in the Eastern District of New York therefore necessarily will have a bearing on these Board proceedings. Accordingly, under 37 C.F.R. § 2.117, it is permissible, proper, and efficient for the Board to stay the opposition and cancellation proceedings pending final disposition in the civil district court action.

Moreover, in order to provide for the efficient resolution of the proceedings before the Board, pending final disposition in the Eastern District of New York, the parties request that the Board consolidate the proceedings in Opposition No. 124,251 and Cancellation No. 32,311. Because both proceedings involve the same parties, the same or similar marks, and the same or similar legal issues, the parties believe such consolidation will avoid unnecessary and duplicative discovery, motion and briefing practice, and duplicative testimony periods. *See* TBMP § 511

("When cases involving common questions of law or fact are pending before the Board, the Board may order the consolidation of the cases.") (citing Fed. R. Civ. P. 42 (a)).

Counsel for Opposer and Petitioner, Thomas A. O'Rourke at Wyatt, Gerber & O'Rourke L.L.P., consented to this motion in a telephone conference with the undersigned on April 30, 2002.

Copies of the Complaint, Answer, and Counterclaim in Civil Action No. 01CV-4768 are attached hereto as Exhibit A. A proposed Order for Stay Pending Final Disposition in Civil Action is attached hereto as Exhibit B.

CONCLUSION

Cheap Tickets respectfully requests that the Board consolidate and stay all proceedings in Opposition No. 124,251 and Cancellation No. 32,311 pending final disposition of ICS Travel v. Cheap Tickets, Inc., Civil Action No. 01CV-4768, in the United States District Court for the Eastern District of New York.

Respectfully submitted,

Dated: May 1, 2002

By:


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