This opinion is not a precedent of the TTAB

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
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wbc

Mailed: January 25, 2017

Opposition No. 91182377 (parent)

RCN Telecom Services, Inc.

v.

RCN Television, S.A.

Opposition Nos. **91192058**
91192065
91192239
91194069
Cancellation Nos. **92051509**
92052167
92052330

RCN Television, S.A.

v.

RCN Telecom Services, Inc.

Opposition Nos. **91201298**
91207257

RCN Television, S.A.

v.

RCN Telecom Services, LLC
(as consolidated)

Before Cataldo, Mermelstein and Hightower,
Administrative Trademark Judges.

By the Board:

These consolidated proceedings come before the Board on RCN Television, S.A.'s ("Television") motion for summary judgment, filed August 30, 2016, on the issue of priority in Opposition Nos. 91192058, 91192065, 91192239, 91194069, and 91201298 and Cancellation Nos. 92051509, 92052167, and 92052330.[1] Television does not move for summary judgment in Opposition No. 91182377.[2] The motion for summary judgment is fully briefed.

Summary judgment is an appropriate method of disposing of cases in which there are no genuine disputes as to any material fact, thus leaving the case to be resolved as a matter of law. *See* Fed. R. Civ. P. 56(c). The party moving for summary judgment has the initial burden of demonstrating that there is no genuine issue of material fact remaining for trial and that it is entitled to judgment as a matter of law. *See Celotex Corp. v. Catrett*, 477 U.S. 317 (1987); *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 4 USPQ2d 1793 (Fed. Cir. 1987). A factual dispute is genuine if, on the evidence of record,

[1] On September 13, 2016, Television filed a motion to consolidate these proceedings with Opposition Nos. 91228018, 91228543, 91228733 and 91229032. In view of the Board's order issued in Opposition No. 91228018, the motion to consolidate is moot. *See* Opposition No. 91228071, 10 TTABVUE.

[2] Opposition No. 91207257 is part of these consolidated proceedings but was not listed in the heading or referenced as part of Television's motion for summary judgment. In view thereof, the Board has not considered the motion for summary judgment with regard to Opposition No. 91207257.

a reasonable fact finder could resolve the matter in favor of the non-moving party. *See Opryland USA Inc. v. Great Am. Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471, 1472 (Fed. Cir. 1992); *Olde Tyme Foods, Inc. v. Roundy's, Inc.*, 961 F.2d 200, 22 USPQ2d 1542, 1544 (Fed. Cir. 1992). Evidence on summary judgment must be viewed in a light favorable to the non-movant, and all justifiable inferences are to be drawn in the non-movant's favor. *See Lloyd's Food Prods., Inc. v. Eli's, Inc.*, 987 F.2d 766, 25 USPQ2d 2027, 2029 (Fed. Cir. 1993); *Opryland USA,* 23 USPQ2d at 1472. The Board may not resolve genuine disputes as to material facts; it may only ascertain whether genuine disputes as to material facts exist. *See Lloyd's Food Prods.*, 25 USPQ2d at 2029; *Olde Tyme Foods*, 22 USPQ2d at 1542.

Television alleges,[3] *inter alia*, that the only issue in dispute is priority because RCN Telecom Services, Inc. ("Telecom") has conceded likelihood of confusion amongst the parties' marks because Telecom alleged likelihood of confusion between "Telecom's marks and RCN NUESTRA TELE (& design) mark in the RCN NUESTRA TELE Proceeding"; and that it has priority by virtue of its "common law use of its RCN and RCN-formative marks in the U.S. since at least as early as 1985 in connection with television programming

[3] In support of its allegations, Television includes, *inter alia*, declarations from Gary Fechter, its attorney with attached deposition transcripts and declarations from Jorge Alarcon, Julian Giraldo, Jacqueline Heitman, Eduardo Aponte, Adriana Castanada, and Jaime Florez; and from Maria Hernandez, its Manager for International Sales, with attached exhibits, including contracts for television and radio broadcasts, copies of the publication, *TV Guide*, which purportedly include RCN-branded programs.

content and at least as early as 1988 in connection with radio content and broadcasting services … use of the trade names RCN INTERNATIONAL and RCN INTERNACIONAL at least as early as December 7, 1994, as well as use of RCN and RCN-formative marks … as early as 1995." 140 TTABVUE 5 and 13.

Telecom alleges,[4] *inter alia*, that it has not conceded likelihood of confusion; that its predecessor in interest used the "RCN Mark at least as early as 1987 and potentially used the mark as early as 1979"; and that its rights in the RCN Mark in the United States "arose before Television had established any rights in the mark." 152 TTABVUE 12.

After reviewing the submitted evidence and arguments, we find that there are genuine disputes of material fact at least as to the issue of priority, and that disposition of this proceeding by summary judgment is therefore inappropriate. In view thereof, Television's motion for summary judgment is **denied**.[5] Because the parties dispute a great many matters of fact, as well as what conclusions are

[4] In support of its claims, Telecom includes a declaration from its attorney, Daniel Hope, which includes deposition transcripts of Maria Hernandez, Julio Rumbaut, Jorge Alarcon, Jacqueline Heitman, an "Awareness, Usage & Image Study for Canal 66" dated June 29, 1995, and other exhibits.

[5] Evidence submitted in connection with the motion for summary judgment is of record for purposes of that motion only. To be considered at trial, the parties must make all evidence properly of record during their testimony periods. *See* TBMP § 528.05(a) (2017-01). However, the parties may stipulate that any or all of the summary judgment evidence be treated as properly of record for purposes of final decision. *See, e.g., Frito-Lay N. America, Inc. v. Princeton Vanguard, LLC*, 109 USPQ2d 1949, 1951 (TTAB 2014) *vacated on other grounds,* 786 F.3d 960 (2015); *Eveready Battery Co. v. Green Planet, Inc.*, 91 USPQ2d 1511, 1513 (TTAB 2009).

to be drawn from the evidence, the Board will not consider any further motions for summary judgment in these proceedings.

Proceedings herein are resumed. Dates are reset as follows:

Telecom's Pretrial Disclosures in Opposition No. 91182377 due:	February 20, 2017
Telecom's 30-day testimony period as plaintiff in Opposition No. 91182377 to close:	April 6, 2017
Television's Pretrial Disclosures in all proceedings due:	April 21, 2017
Television's 30-day testimony period as defendant in Opposition No. 91182377 and as plaintiff in the remaining proceedings to close	June 5, 2017
Telecom's pretrial disclosures for rebuttal as plaintiff in Opposition No. 91182377 and as defendant in the remaining proceedings due:	June 20, 2017
Telecom's 30-day testimony period as defendant in the remaining proceedings and for rebuttal as plaintiff in Opposition No. 91182377 to close:	August 4, 2017
Television's rebuttal disclosures as plaintiff in the remaining proceedings due:	August 19, 2017
Television's 15-day rebuttal period as plaintiff in the remaining proceedings to close:	September 18, 2017
Brief for Telecom as plaintiff in Opposition No. 91182377 due:	November 17, 2017
Brief for Television as defendant in Opposition No. 91182377 and as plaintiff in the remaining proceedings due:	December 17, 2017

Brief for Telecom as defendant in the remaining proceedings and reply brief, if any, as plaintiff in Opposition No. 91182377 due:	January 16, 2018
Reply brief, if any, for Television in the remaining proceedings due:	January 31, 2018

In each instance, a copy of the transcript of testimony, together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.