

ESTTA Tracking number: **ESTTA323336**

Filing date: **12/21/2009**

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

Proceeding	91192239
Party	Defendant RCN Telecom Services, Inc.
Correspondence Address	GLENN A. GUNDERSEN DECHERT LLP 2929 ARCH ST CIRA CENTRE PHILADELPHIA, PA 19104 UNITED STATES glenn.gundersen@dechert.com
Submission	Opposition/Response to Motion
Filer's Name	Jacob Bishop
Filer's e-mail	trademarks@dechert.com, glenn.gundersen@dechert.com, erik.bertin@dechert.com, jacob.bishop@dechert.com
Signature	/Jacob Bishop/
Date	12/21/2009
Attachments	RCN BUSINESS SERVICES Reply Brief In Support of Motion to Consolidate.pdf ( 5 pages )(243368 bytes )

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

-----X	:	
RCN TELEVISIÓN, S.A	:	
	:	
Opposer,	:	
	:	
v.	:	Opposition No. 91192239
	:	
RCN TELECOM SERVICES, INC.	:	
	:	
Applicant.	:	
-----X	:	

**APPLICANT’S REPLY BRIEF IN SUPPORT OF ITS MOTION TO CONSOLIDATE  
AND BRIEF IN OPPOSITION TO OPPOSER’S CROSS-MOTION TO CONSOLIDATE**

Applicant, RCN Telecom Services, Inc., respectfully submits this reply brief in support of its motion to consolidate Opposition Nos. 91192239, 91192058, 91192065, and Cancellation No. 92051509, and in opposition to Opposer, RCN Television, S.A.’s cross-motion to consolidate these four proceedings with Opposition No. 91182377.

**I. The Parties Agree That Opposition Nos. 91192239, 91192058, 91192065, And Cancellation No. 92051509 Should Be Consolidated**

Applicant moved to consolidate Opposition Nos. 91192239, 91192058, 91192065, and Cancellation No. 92051509, because these proceedings are likely to involve common questions of law and fact. Opposer made the same request in its cross-motion to consolidate. (Opposer’s Brief at 1.) Because Opposer agrees that these four proceedings should be consolidated, Applicant’s motion should be granted as conceded.

**II. Opposition Nos. 91192239, 91192058, 91192065, And Cancellation No. 92051509 Should Be Suspended Pending The Disposition Of Applicant’s Motion To Dismiss**

Applicant has filed a motion to dismiss Cancellation No. 92051509 and in response to Applicant’s request, the Cancellation has been suspended pending the disposition of Applicant’s

motion. Although the parties agree that Cancellation No. 92051509 should be consolidated with Opposition Nos. 91192239, 91192058, 91192065, Opposer claims that the parties should be allowed to proceed with discovery in the Oppositions – even though the Cancellation has been suspended. Denying Applicant’s request for a blanket suspension of these four proceedings would be inefficient.

Applicant moved to dismiss Cancellation No. 92051509 because the priority and fraud claims that Opposer asserted in that proceeding are compulsory counterclaims which should have been asserted in another opposition proceeding. In addition, Applicant has moved to dismiss the likelihood of confusion claims that Opposer asserted against three of Applicant’s registrations, because those registrations are more than five years old and as such they are not subject to attack under Section 2(d). If the Board grants Applicant’s motion to dismiss, the complexity of these four disputes will be substantially reduced. Instead of challenging 18 of Applicant’s registrations, Opposer would be left with claims that it has asserted against 3 of Applicant’s registrations. Since the priority claims that Opposer has asserted in Opposition Nos. 91192239, 91192058, and 91192065 are virtually identical to the priority claims it has asserted in Cancellation No. 92051509, it stands to reason that any dismissal or narrowing of those claims would have a significant impact on the nearly identical claims that Opposer has asserted in the Oppositions. Indeed, allowing Opposer to proceed with the Oppositions, while the motion to dismiss the Cancellation is pending, would lead to the piecemeal resolution of legal disputes that the rule against compulsory counterclaims is intended to prevent. It would be far more efficient to suspend all of the proceedings until the Board has ruled on the motion to dismiss Opposer’s priority and fraud claims in the Cancellation, and then allow the parties to proceed with discovery based on the claims (if any) that survive Applicant’s motion.

**III. There Is No Basis For Consolidating Opposition No. 91182377 With Opposition Nos. 91192239, 91192058, 91192065 And Cancellation No. 92051509**

Opposer claims that the Board should consolidate the Cancellation and the four Oppositions that are at issue in Applicant's motion with the Opposition that Applicant filed in 2007 against Opposer's application for the mark RCN NUESTRA TELE & Design (designated Opposition No. 91182377). But contrary to what Opposer suggests, the RCN NUESTRA TELE opposition is not at the same stage as these other proceedings. In fact, the RCN NUESTRA TELE opposition is nearly at the end of the discovery period, while the other proceedings are just getting started.

- Opposer filed its answer in the RCN NUESTRA TELE opposition on June 19<sup>th</sup>. By contrast, Applicant did not file an answer in the other proceedings until the first week of November.
- The parties held their mandatory discovery conference in the RCN NUESTRA TELE opposition on August 25<sup>th</sup>. By contrast, the parties did not hold their discovery conference in the other proceedings until December 10<sup>th</sup>.
- The parties were required to serve their initial disclosures in the RCN NUESTRA TELE opposition by September 24<sup>th</sup>. By contrast, the parties have not served their initial disclosures in the other proceedings, and in fact, disclosures are not even due until January 2010.
- The discovery period in the RCN NUESTRA TELE opposition opened on September 25<sup>th</sup> and is scheduled to close on February 21, 2010. By contrast, discovery did not open in Cancellation No. 92051509 and Opposition Nos. 91192058 and 91192065 until the first week of December, and it did not open in Opposition No. 91192239 until today.
- The parties have not served any discovery requests in Cancellation No. 92051509 and Opposition Nos. 91192239, 91192058, 91192065. By contrast, both parties have served discovery requests in the RCN NUESTRA TELE opposition. In fact, Petitioner served its first set of interrogatories and document requests on September 30<sup>th</sup> – within five days after the discovery period opened. Applicant served its responses and objections to Opposer's discovery requests on November 4<sup>th</sup>, and has produced hundreds of pages of documents in response to those requests. In addition, the parties have held a discovery conference to discuss Applicant's objections to Opposer's discovery requests and have exchanged follow-up letters concerning those issues. Applicant served its first set of

discovery requests on November 20<sup>th</sup>. Opposer's responses to those requests were due on December 28<sup>th</sup>, but the parties have agreed to extend that deadline until January 11<sup>th</sup>.

The primary source of discovery in each of these proceedings will be very different. In Cancellation No. 92051509 and Opposition Nos. 91192239, 91192058, 91192065 Opposer claims priority based on the alleged use of the mark RCN by its predecessors in interest. By contrast, Opposer has sought to register RCN NUESTRA TELE based on its own intent to use this mark. Thus, Opposer is likely to be the primary source of discovery in the RCN NUESTRA TELE opposition, while its predecessors in interest are likely to be the primary source of discovery in the other proceedings.

Moreover, the Registrations at issue in the RCN NUESTRA TELE opposition are not the same as the registrations at issue in Cancellation No. 92051509. Applicant cited 23 applications and registrations in its notice of opposition to RCN NUESTRA TELE. Opposer has sought to cancel 15 of those registrations, along with 3 other registrations which were not pleaded in the RCN NUESTRA TELE opposition. Applicant moved to dismiss the claims that Opposer asserted against 15 of those registrations, but has not moved to dismiss the claims Opposer asserted against the 3 remaining registrations. Thus, if the Board grants Opposer's motion to dismiss Cancellation No. 92051509, there will be no overlap between the registrations at issue in the cancellation proceeding and the RCN NUESTRA TELE opposition.

Finally, the services at issue in each of these proceedings are not the same. The application to register RCN NUESTRA TELE only covers "Entertainment in the nature of on-going television programs in the field of variety, comedy, news, sports, drama, special interest" in Class 41. By contrast, Opposer claims in the other proceedings that it has used the mark RCN for providing television and radio programs, and for providing television and radio broadcasting services.

**CONCLUSION**

For the foregoing reasons, Applicant submits that the Board should consolidate Opposition Nos. 91192239, 91192058, 91192065, and Cancellation No. 92051509, and if the Board grants this motion, Applicant respectfully submits that the Board suspend the consolidated proceedings until it has ruled on Applicant's motion to dismiss Cancellation No. 92051509.

Dated: December 21, 2009

Attorneys for Applicant,  
RCN TELECOM SERVICES, INC.




---

Glenn A. Gundersen  
Erik Bertin  
Jacob R. Bishop  
DECHERT LLP  
Cira Centre, 2929 Arch Street  
Philadelphia, PA 19104-2808  
(215) 994-2183

**CERTIFICATE OF SERVICE**

I hereby certify that a true and correct copy of the foregoing Applicant's Reply Brief In Support of Its Motion to Consolidate and Brief In Opposition to Opposer's Cross-Motion to Consolidate has been duly served by sending such copy by first class mail, postage prepaid, to Gary H. Fechter, McCarter & English, LLP, 245 Park Avenue, New York, NY 10167, on December 21, 2009.



---

Erik Bertin