

ESTTA Tracking number: **ESTTA336484**

Filing date: **03/10/2010**

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

Proceeding	92052167
Party	Plaintiff RCN Television, S.A.
Correspondence Address	Gary H. Fechter McCarter & English LLP 245 Park Avenue, 27th Floor New York, NY 10167-0001 UNITED STATES gfechter@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Submission	Motion to Consolidate
Filer's Name	Gary H. Fechter
Filer's e-mail	gfechter@mccarter.com, lshyavitz@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com
Signature	/Gary H. Fechter/
Date	03/10/2010
Attachments	Motion to Consolidate.pdf ( 6 pages )(200630 bytes )

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

In the Matter of:

RCN TELEVISIÓN, S.A. )  
Petitioner, )

) CANCELLATION NO. 92052167  
) RCN GLOBAL PASSPORT  
) Registration No. 3,740,986  
) Registration Date: January 19, 2010

v. )

RCN TELECOM SERVICES, INC. )  
Registrant. )

**MOTION TO CONSOLIDATE PENDING  
INTER-PARTES PROCEEDING**

Petitioner, RCN Televisión, S.A., by its attorneys, McCarter & English, LLP, moves to consolidate the above-captioned proceeding with presently pending Consolidated Proceeding No. 91182377 for purposes of trial and pre-trial proceedings.

Dated: March 10, 2010

Respectfully submitted,

RCN TELEVISIÓN, S.A.

By: 

Gary H. Fechter  
Kelly J. Garrone  
Lori J. Shyavitz  
McCarter & English, LLP  
245 Park Ave., 27<sup>th</sup> Floor  
New York, NY 10167  
Phone (212)609-6800

Attorneys for Petitioner

CERTIFICATE OF SERVICE UNDER 37 CFR §§ 2.111

I hereby certify that the foregoing Motion to Consolidate Inter-Partes Proceeding has been served via regular mail upon the Applicant's attorney of record at the address listed below, on March 10, 2010:

GLENN A. GUNDERSEN  
DECHERT LLP  
2929 ARCH ST  
CIRA CENTRE  
PHILADELPHIA, PA 19104

  
Deborah Popovic

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

In the Matter of:

RCN TELEVISIÓN, S.A.	)	
Petitioner,	)	
	)	CANCELLATION NO. 92052167
	)	RCN GLOBAL PASSPORT
	)	Registration No. 3,740,986
	)	Registration Date: January 19, 2010
v.	)	
	)	
RCN TELECOM SERVICES, INC.	)	
Registrant.	)	

**BRIEF IN SUPPORT OF MOTION TO CONSOLIDATE  
PENDING INTER-PARTES PROCEEDING**

On February 3, 2010, the Board entered an order consolidating five proceedings currently pending between the parties<sup>1</sup> under Consolidated Proceeding No. 91182377. Each of the consolidated proceedings involves the same issue: Does Petitioner or Registrant RCN Telecom Services, Inc. (“Registrant”) have priority of use of an “RCN” formative mark?

On January 19, 2010, Registrant obtained U.S. Registration No. 3,740,986 for the mark RCN GLOBAL PASSPORT (the “GLOBAL PASSPORT Mark”). On March 5, 2010, Petitioner filed a Petition to Cancel the GLOBAL PASSPORT Mark under Cancellation No. 92052167 (the “GLOBAL PASSPORT Proceeding”). The GLOBAL PASSPORT Proceeding has at its heart the very same issue that is central to the Consolidated Proceeding: a determination of which party has priority of use with respect to the term “RCN.”

---

<sup>1</sup> The five *inter partes* proceedings in the Consolidated Proceeding are: Opposition No. 91182377, Opposition No. 91192058, Opposition No. 91192065, Opposition No. 91192239, and

The Trademark Trial and Appeal Board Manual of Procedure (“TBMP”) provides that “[w]hen cases involving common questions of law or fact are pending before the Board, the Board may order consolidation of the cases.” TBMP §511. The Consolidated Proceeding and the GLOBAL PASSPORT Proceeding involve common questions of law and fact, as both proceedings are based on the parties’ competing claims of prior rights in the term RCN. Thus, the Board should order consolidation of the proceedings.

When determining whether or not proceedings should be consolidated, the Board “will weigh savings in time, effort and expense, which may be gained from consolidation, against any prejudice or inconvenience that may be caused thereby.” *Id.* If the proceedings herein were consolidated, the parties and the Board would save time, effort and expense, as the discovery phase of the proceeding would be more efficient, the parties would not have to address two separate discovery and trial schedules, and the parties could address common issues of law or fact throughout the proceeding, where applicable. Further, consolidation of these proceedings would not cause prejudice or inconvenience.

In entering the order consolidating the five prior proceedings between the parties, the Board reset the schedule in all of those proceedings. As a result, discovery does not open in the Consolidated Proceeding until April 5, 2010. Even if this were not the case, “[c]onsolidation is not precluded when cases are at different stages of discovery.” *Blasko v. Washington Metro. Area Transit Auth.*, 243 F.R.D. 13, 16 (D.D.C. 2007) (citing *Monzo v. Port of N.Y. Auth.*, 94 F.R.D. 672, 673 (S.D.N.Y. 1982)); *see also Wright & Miller Federal Practice & Procedure: Civil 3d* § 2383.

---

Cancellation No. 92051509.

The discovery in the Consolidated Proceeding and in the GLOBAL PASSPORT Proceeding will be identical. Both parties will likely request and produce the same documents and will likely rely upon the same witnesses in both proceedings. If the proceedings are consolidated, the parties will only be required to produce documents once and potential witnesses would only need to be available to testify on one occasion, saving the parties and the Board considerable time and effort.

Moreover, consolidation is still warranted even if the goods and services at issue are not identical. *See G-Mar Dev. Corp. v. Tully's Coffee Corp.*, 46 U.S.P.Q.2d 1797, 1798 (TTAB 1998) (consolidating oppositions challenging applications for "coffee" in class 30 and "retail coffee store services; cafe services" in class 42); *Regatta Sport, Ltd. v. Telux-Pioneer, Inc.*, 20 U.S.P.Q.2d 1154, 1156 (TTAB 1991) (stating that the Board may consolidate proceedings involving watches and wearing apparel). The services at issue in all of the proceedings are related. They concern television and radio programs and television and radio broadcasting. Thus, consolidation is proper.

Even if there are issues that are distinct to a particular RCN-formative application or registration, the Board decides the cases on their individual merits. "Consolidated cases do not lose their separate identity because of consolidation." TBMP § 511; *Wright & Miller* at § 2382. "Each proceeding retains its separate character and requires entry of a separate judgment." TBMP § 511.

Since the Consolidated Proceeding and the GLOBAL PASSPORT Proceeding involve the same parties, common questions of law and fact and will not prejudice or inconvenience the parties, consolidation is warranted. Consolidation of these proceedings is also appropriate

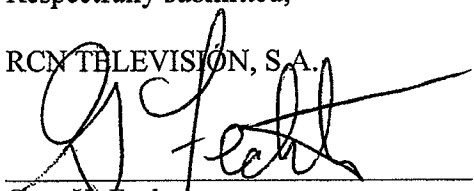
because it will promote judicial economy, as well as save the parties significant time, effort and expense to resolve the proceedings. Accordingly, the Board should grant Petitioner's Motion to Consolidate.

Dated: March 10, 2010

Respectfully submitted,

RCN TELEVISION, S.A.

By:



---

Gary H. Fechter  
Kelly J. Garrone  
Lori J. Shyavitz  
McCarter & English, LLP  
245 Park Ave., 27<sup>th</sup> Floor  
New York, NY 10167  
Phone (212)609-6800

Attorneys for Petitioner