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

Petition for Cancellation

Notice is hereby given that the following party requests to cancel indicated registration.

Petitioner Information

Name	RCN Televisi3n, S.A.		
Entity	Corporation	Citizenship	Colombia
Address	Av. Las Americas No. 65-82 AA Bogota, 35800 COLOMBIA		

Attorney information	Gary H. Fechter, Esq. McCarter & English, LLP 245 Park Avenue 27th Floor New York, NY 10167 UNITED STATES gfechter@mccarter.com, lshyavitz@mccarter.com, kgarrone@mccarter.com, dpopovic@mccarter.com Phone:212-609-6800
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Registration Subject to Cancellation

Registration No	3764807	Registration date	03/23/2010
Registrant	RCN Telecom Services, Inc. Suite 300 196 Van Buren Street Herndon, VA 20170 UNITED STATES		

Goods/Services Subject to Cancellation

Class 038. First Use: 2009/05/01 First Use In Commerce: 2009/05/01 All goods and services in the class are cancelled, namely: Global cable television transmission and global video on demand transmission services
Class 041. First Use: 2009/05/01 First Use In Commerce: 2009/05/01 All goods and services in the class are cancelled, namely: Cable television programming services and video on demand programming services provided via a global network

Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act section 2(d)
Related Proceedings	91182377 (Parent) (Consolidation of 91192058, 91190265, 91192239 & 92051509); Opposition No. 91194069 and Cancellation No. 92052167.

Mark Cited by Petitioner as Basis for Cancellation

U.S. Application/Registration No.	NONE	Application Date	NONE
Registration Date	NONE		

Word Mark	RCN
Goods/Services	Provision of radio programs, provision of radio broadcasting services, provision of television programs and provision of television broadcasting services

Attachments	Petition to Cancel.pdf (22 pages)(815676 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by Overnight Courier on this date.

Signature	/Gary H. Fechter/
Name	Gary H. Fechter, Esq.
Date	04/08/2010

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.
)	RCN GLOBAL PASSPORT & Design
)	Registration No. 3,764,807
)	Registration Date: March 23, 2010
v.)	<u>PETITION FOR CANCELLATION</u>
)	
RCN TELECOM SERVICES, INC.)	
Respondent.)	

Petitioner, RCN TELEVISIÓN, S.A., believes that it is or will be damaged by the trademark registration for the GLOBAL PASSPORT Design Mark (as defined below) set forth herein and hereby petitions to cancel that registration. As grounds for this Petition, Petitioner alleges that:

1. Petitioner RCN TELEVISIÓN, S.A. is an entity incorporated under the laws of Colombia, located and doing business at Av. Las Americas No. 65-82 AA 35800, Bogota, Colombia.
2. Upon information and belief, the owner of Respondent's Marks is RCN TELECOM SERVICES, INC. ("Respondent"), and, as set forth in the records of the U.S. Patent and Trademark Office, has a place of business at 105 Carnegie Center, Princeton, New Jersey 08540.
3. Petitioner, in part through its predecessors in interest and its affiliated companies (collectively hereinafter, "RCN"), has been engaged in providing radio programming and radio broadcasting services in the United States for over twenty years, television programming

services in the United States for over fifteen years, and television broadcasting services in the United States for over fourteen years.

4. Since at least as early as May of 1989, RCN has continuously used the mark RCN in connection with the provision of radio programs and radio broadcasting services in the U.S., and since at least as early as June of 1994, RCN has continuously used the mark RCN in connection with the provision of television programs in the U.S., and since at least as early as January of 1995, RCN has continuously used the mark RCN in connection with television broadcasting services in the U.S. (collectively, "Petitioner's Mark").

5. By reason of RCN's extensive promotion, advertising, and provision of high-quality services in conjunction with Petitioner's Mark, the public and the trade have come to recognize services offered in conjunction with this mark as signifying RCN and its programming and broadcasting services.

6. Notwithstanding RCN's long prior rights in the Petitioner's Mark, Respondent filed trademark applications on the dates indicated in Exhibit A hereto, and obtained federal registrations for nineteen marks that consist of or include the term RCN, as listed below, which are registered in connection with the services listed in Exhibit A hereto, and which Respondent alleges were first used on the dates indicated in Exhibit A hereto.

Mark	Reg. No.
RCN MUSIC & Design	3,400,083
RCN MUSICTOGO	3,474,052
RCN MUSICLIBRARY	3,474,051

RCN QUICK CONNECT SUPPORT & Design	3,474,012
RCN 4 & Design	3,433,045
RCN TV & Design	3,433,044
RCN & Design	3,119,573
RCN BUSINESS SERVICES	3,635,277
RCN TALKWARE	3,562,410
RCN METRO	3,546,300
RCN	2,715,673
RCN BUSINESS & Design	2,752,381
RCN THE LIVE WIRE & Design	2,827,378
RCN ENTERTAINMENT	2,826,216
RCN POWER	3,405,859
RCN INTERACTION	2,939,481
RCN	2,471,719
RCN & Design	2,360,973
RCN GLOBAL PASSPORT	3,740,986

(collectively, "Respondent's Marks").

7. As a part of Respondent's applications to register the Respondent's Marks, filed on the dates listed in Exhibit A hereto, Respondent submitted sworn declarations to the U.S. Patent and

Trademark Office (“PTO”) in which Respondent stated that to the best of Respondent’s knowledge and belief, no other person or entity has the right to use the Respondent’s Marks in commerce, in an identical or confusingly similar form.

8. RCN has filed petitions to cancel Respondent’s Marks.

9. Notwithstanding RCN’s long prior rights in the Petitioner’s Mark, Respondent filed an additional trademark application on December 3, 2008, and obtained U.S. Registration No. 3,764,807 for the mark RCN GLOBAL PASSPORT & Design, and which Respondent alleges to have first used on May 1, 2009 (the “GLOBAL PASSPORT Design Mark”) (see Exhibit B hereto).

10. As a part of Respondent’s application to register the GLOBAL PASSPORT Design Mark, filed on December 3, 2008, Respondent submitted a sworn declaration to the PTO in which Respondent stated that to the best of Respondent’s knowledge and belief, no other person or entity has the right to use the GLOBAL PASSPORT Design Mark in commerce, in an identical or confusingly similar form (the “Declaration”).

11. RCN first used the Petitioner’s Mark at least as early as May of 1989. This date is long before the date when Respondent filed its application to register the GLOBAL PASSPORT Design Mark, before the GLOBAL PASSPORT Design Mark registered, and before Respondent alleges to have first used the GLOBAL PASSPORT Design Mark. Therefore, at the time Respondent sought to register GLOBAL PASSPORT Design Mark, Petitioner’s Mark was already in use in the U.S.

12. One of the ways in which Petitioner’s Mark was in use in the U.S. in 1995, at the time Respondent filed its first trademark application to register one of Respondent’s Marks, was

in connection with its programming on Canal 66, a Spanish language television channel available in the New York City viewing area.

13. Canal 66 was referred to as “RCN Canal 66,” as it was owned in part by RCN, and it carried a large volume of RCN-trademarked programming (hereinafter “RCN Canal 66”).

14. In 1995, the Spanish language television channels available in the New York City viewing area were extremely limited. The only Spanish language television channels available in the New York City viewing area were RCN Canal 66, Univision, and Telemundo. Of these channels, RCN Canal 66 was one of the only Spanish language channels available on cable television.

15. In 1995, Time Warner Cable Inc. (“Time Warner”) was the leading provider of cable television services in the New York City viewing area. The only Spanish language television channel that Time Warner included in its cable programming was Canal 66.

16. In 1995, the Hispanic population was a target market of media companies. In the five counties of New York City alone, approximately 1.5 million residents spoke Spanish at home, according to 1990 Census data. The New York City Hispanic market specifically was a matter of tremendous interest for investors and media companies because it was the largest television market in the country, had a substantial Hispanic market segment, was one of the most heterogeneous Hispanic markets in the United States, and was underserved compared to the traditional Hispanic markets in California and the Southern United States.

17. Between 1995 and 2008, when Respondent filed its application to register the GLOBAL PASSPORT Design Mark, RCN continued to use and expanded its use of the Petitioner’s Mark in the United States in connection with radio programs and radio broadcasting services and television programming and television broadcast services.

18. Respondent, in prosecuting one of its first applications for an RCN formative mark, asserted that it expended “millions of dollars promoting its RCN mark.” Applicant’s Appeal Brief, filed September 14, 1998, Application Serial No. 75/013069.

19. Prior to expending “millions of dollars” to promote its RCN formative mark, Respondent, a publicly traded corporation, had an obligation to engage in due diligence to determine who its competitors in the market would be, how to serve all segments of the community, including the large Spanish-speaking population, and what foreign language programming options were available. Respondent also had a duty to conduct a due diligence inquiry to ensure that no other entities were making use of confusingly similar marks in connection with related services in the market it intended to enter. Had Respondent engaged in any market inquiry, Respondent would have discovered that Petitioner was making use of its RCN formative marks in connection with identical or closely related services for a number of years. Respondent acted recklessly by either failing to engage in such due diligence or acted in reckless disregard of the results of such due diligence.

COUNT ONE

LIKELIHOOD OF CONFUSION

(As to U.S. Registration No. 3,764,807)

20. RCN repeats and realleges each and every allegation set forth in paragraphs 1 through 19.

21. The GLOBAL PASSPORT Design Mark covers various “global television transmission and global video on demand transmission services” in Class 38, and “cable television programming services and video on demand programming services provided via a

global network” in Class 41, which are identical or closely related to the services covered by Petitioner’s Mark.

22. The GLOBAL PASSPORT Design Mark is extremely similar to Petitioner’s Mark, as both parties’ marks consist of the term RCN or include the term RCN as their dominant element, and the GLOBAL PASSPORT Design Mark is applied to services identical or closely related to services offered by RCN which are promoted and sold or offered for sale in the same or similar channels of trade as those in which RCN’s services bearing the Petitioner’s Mark are promoted and sold. The GLOBAL PASSPORT Design Mark so closely resemble the Petitioner’s Mark as to be likely to be confused therewith and mistaken therefor.

23. In view of the similarity between Petitioner’s Mark and the GLOBAL PASSPORT Design Mark, and the related nature of the services of the respective parties, the GLOBAL PASSPORT Design Mark so resembles Petitioner’s Mark previously used in the United States and not abandoned, as to be likely to cause confusion, or to cause mistakes and deceive.

24. The continued registration of the GLOBAL PASSPORT Design Mark to Respondent would be contrary to Section 2(d) of the Lanham Act, 15 U.S.C. 1052(d), and violate or diminish the prior and superior rights of RCN in Petitioner’s Mark.

25. RCN will be damaged if Registration No. 3,764,807 should continue to coexist on the Principal Register.

COUNT TWO

FRAUD ON THE U.S. PATENT AND TRADEMARK OFFICE

(As to Registration No. 3,764,807)

26. RCN repeats and realleges each and every allegation set forth in paragraphs 1 through 25.

27. At the time Respondent signed the Declaration, the Petitioner's Mark was already in use in the U.S. in connection with the provision of television and radio programming services and television and radio broadcasting services.

28. Petitioner's Mark is substantially identical to the GLOBAL PASSPORT Design Mark, as both parties' marks consist of the term RCN or include the term RCN as their dominant element, and the GLOBAL PASSPORT Design Mark is applied to services identical or substantially identical to services offered by RCN which are promoted and sold or offered for sale in the same or similar channels of trade as those in which RCN's services bearing the Petitioner's Mark are promoted and sold.

29. At the time Respondent signed the Declaration, RCN possessed clearly established rights in the RCN mark superior to Respondent's rights, because RCN used the RCN mark in connection with the provision of television and radio programming services and broadcasting services prior to Respondent's use of the GLOBAL PASSPORT Design Mark in connection with identical or substantially identical services. For example, at the time Respondent filed its first trademark application to register one of Respondent's Marks in 1995, Petitioner's Mark was in use in connection with the Spanish language television channel provided through Time Warner known as Canal 66 or "RCN Canal 66," which carried a large volume of RCN-branded programming.

30. As there were very few Spanish language television channels available in the New York City viewing area and one of the only ones available on cable television in 1995, the options for cable companies to provide Spanish language programming the New York City viewing area were extremely limited.

31. Upon information and belief, in 1995, any cable television services provider entering or doing business in the New York City cable television market would have investigated the limited options it had to provide Spanish language television programming in the New York City viewing area, which includes a significant number of Spanish speaking households.

32. As a cable television provider entering or doing business in the New York City area in 1995, Respondent knew or should have known the limited options it had to provide Spanish language television programming in the New York City viewing area. Canal 66, a channel owned in part by RCN and which provided numerous RCN-branded television content, was one of those limited options and was provided through the leading provider of cable television services in the New York City viewing area and a competitor of Respondent.

33. In addition, upon information and belief, any cable television services provider entering or doing business in the New York City cable television market at that time would have investigated the programming being provided by its competitors, including investigating Time Warner, the leading provider of cable television services in the New York City viewing area, to determine the nature of the programming, including Spanish language programming, provided by Time Warner.

34. As a cable television provider entering or doing business in the New York City area in 1995 and a competitor of Time Warner, Respondent, upon information and belief, knew the programming, including Spanish language programming, being provided by its competitors, including Time Warner, the leading provider of cable television services in the New York City viewing area. Time Warner's Spanish language programming was provided by RCN Canal 66, a channel owned in part by RCN and which provided numerous RCN-branded television content.

35. Thus, at the time Respondent signed the Declaration, Respondent, upon information and belief knew that RCN had rights in the RCN mark superior to Respondent's rights, and had no reasonable basis for believing that confusion between Petitioner's Mark and the GLOBAL PASSPORT Design Mark would not be likely.

36. Despite the prior use of RCN's substantially identical mark used in connection with identical or substantially identical services, Respondent submitted the Declaration and continued to prosecute the trademark application for the GLOBAL PASSPORT Design Mark. Respondent procured the aforesaid registrations by false means and/or by knowingly and willfully making false and/or fraudulent declarations or representations to the PTO, including, *inter alia*, falsely alleging in the Declaration that to the best of Respondent's knowledge and belief, no other person or entity has the right to use the GLOBAL PASSPORT Design Mark in commerce, in an identical or confusingly similar form, when Respondent, upon information and belief, knew that RCN had priority to use and was already using a substantially identical mark in connection with identical or substantially identical services in the U.S.

37. Said false statements were material to the PTO's determination of whether or not to grant Respondent a trademark registration, and made with the intent to induce the PTO to grant registration for the GLOBAL PASSPORT Design Mark, and reasonably relying upon the truth of said false statements, the PTO did, in fact, grant said registration to Respondent.

38. Petitioner has been and will be damaged by the registration of the GLOBAL PASSPORT Design Mark because Respondent has obtained rights in the designation RCN in violation and derogation of the established prior rights of Petitioner.

39. Accordingly, Registration No. 3,764,807 should be cancelled, because the Respondent fraudulently obtained said registration.

WHEREFORE, Petitioner respectfully requests that U.S. Registration No. 3,764,807 be cancelled from the Trademark Register.

Dated: April 8, 2010

Respectfully submitted,

By: 

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Attorneys for Petitioner

CERTIFICATION OF SERVICE

The undersigned hereby certifies that the original of the foregoing PETITION FOR CANCELLATION has been served by overnight mail to Respondent and to Respondent's attorneys of record at the following addresses:

RCN Telecom Services, Inc.
105 Carnegie Center
Princeton, NJ 08540

Glenn A. Gundersen
Dechert LLP
Cira Centre
2929 Arch Street
Philadelphia, PA 19104-2808

Date: April 8, 2010



Donald J. Zorn

EXHIBIT A

Mark	App. Date	Reg. No.	Goods	Reg. Date	First Use Date
RCN MUSIC & Design	8/3/06	3,400,083	Class 38: Telecommunication services, namely, the online transmission of streamed and downloadable music files.	3/18/08	8/16/06
RCN MUSICTOGO	8/3/06	3,474,052	Class 38: Telecommunication services, namely, the online transmission of streamed and downloadable music files.	7/22/08	12/8/06
RCN MUSICLIBRARY	8/3/06	3,474,051	Class 38: Telecommunication services, namely, the online transmission of streamed and downloadable music files.	7/22/08	12/8/06
RCN QUICK CONNECT SUPPORT & Design	7/17/06	3,474,012	Class 38: Providing telecommunications connections to the Internet.	7/22/08	11/13/06
RCN 4 & Design	2/27/06	3,433,045	Class 41: Cable television programming; providing online information in the field of current event news, sports and entertainment; and digital video recording services for others.	5/20/08	1/1/95

RCN TV & Design	2/27/06	3,433,044	<p>Class 38: Transmission of cable television and cable audio signals; video on demand transmission services; and streaming of audio and video material in the fields of news, sports and entertainment on the Internet.</p> <p>Class 41: Cable television programming; providing online information in the field of current event news, sports and entertainment; and digital video recording services for others.</p>	5/20/08	6/1/05
RCN & Design	2/7/05	3,119,573	<p>Class 38: Local and long distance telephone services; transmission of cable television and audio; providing telecommunications connections to the Internet; video on-demand transmission services; telephone call forwarding services; e-mail and instant messaging services; caller identification services; voice mail services; online transmission of streamed and downloadable music files; providing facilities for others for the colocation of telecommunications</p>	7/25/06	3/2005 for all classes

		<p>equipment; leasing of fiber in a fiber-optic telecommunications network; leasing of telecommunications network infrastructure, namely, wiring and cable, conduit, ducts, innerducts, switches, nodes, dark fiber, circuits and backbones; streaming of audio and video material in the fields of news, sports and entertainment on the Internet.</p> <p>Class 41: Providing online information in the field of news, sports, and entertainment; digital video recording services; providing online computer games and information in the field of computer games.</p> <p>Class 42: Providing customized on-line web pages featuring user-defined information; application service provider featuring software in the field of online security, filtering, and privacy; hosting the web sites of others on a computer server for a global computer network.</p> <p>Class 45: Home</p>		
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			surveillance and security monitoring services.		
RCN BUSINESS SERVICES	11/19/08	3,635,277	<p>Class 38: Telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, providing telecommunications connections to the Internet; leasing of fiber in a fiber-optic telecommunications network; leasing of telecommunications network infrastructure, namely, wiring and cable, conduit, ducts, innerducts, switches, nodes, dark fiber, circuits and backbones.</p> <p>Class 42: Hosting the web sites of others on a computer server for a global computer network.</p>	6/9/09	6/2007
RCN TALKWARE	5/9/08	3,562,410	Class 38: Telecommunications services, namely, the electronic transmission of voice, data, facsimile, video and information over fiber optic network.	1/13/09	8/1/08
RCN METRO	3/28/08	3,546,300	Class 35: Managing telecommunications networks for others, namely, managing	12/16/08	11/13/07 for all classes

			<p>voice, video and data transmission services of other carriers.</p> <p>Class 38: Providing telecommunications connections to the Internet; leasing of fiber in a fiber-optic telecommunications network; leasing of telecommunications network infrastructure, namely, wiring and cable, conduit, ducts, innerducts, switches, nodes, dark fiber, circuits and backbones.</p> <p>Class 42: Technical support, namely, monitoring of network systems and troubleshooting of telecommunications network problems; computer colocation services, namely, providing facilities for the location of computer servers with the equipment of others.</p>		
RCN	7/29/02	2,715,673	<p>Class 38: Telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, providing telecommunications connections to the Internet, providing</p>	5/13/03	2/1/96

			facilities for others for the colocation of telecommunications equipment; leasing of fiber in a fiber-optic telecommunications network; leasing of telecommunications network infrastructure, namely, wiring and cable, conduit, ducts, innerducts, switches, nodes, dark fiber, circuits and backbones.		
RCN BUSINESS & Design	7/29/02	2,752,381	<p>Class 38: Telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, providing telecommunications connections to the internet, providing facilities for others for the colocation of telecommunications equipment; leasing of fiber in a fiber-optic telecommunications network; leasing of telecommunications network infrastructure, namely, wiring and cable, conduit, ducts, innerducts, switches, nodes, dark fiber, circuits and backbones.</p> <p>Class 42: Hosting the web sites of others on a computer server for a</p>	8/19/03	7/10/02 for both classes.

			global computer network.		
RCN THE LIVE WIRE. & Design	3/4/03	2,827,378	Class 38: Telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, providing telecommunications connections to the Internet.	3/30/04	2/14/03
RCN ENTERTAINMENT	10/10/01	2,826,216	Class 9: Pre-recorded video cassettes, tapes and discs for children and adults featuring entertainment and educational materials. Class 41: Entertainment services in the nature of on-going live action and animated television series and motion picture films for children and adults; production of television shows and motion picture films.	3/23/04	7/19/01 for both classes.
RCN POWER	12/31/03	3,405,859	Class 38: Residential telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, and providing telecommunications connections to a global	4/1/08	12/21/05

			computer network.		
RCN INTERACTION	4/5/04	2,939,481	Class 41: Providing online computer games and information in the field of computer games.	4/12/05	3/29/04
RCN	8/9/00	2,471,719	Class 38: Residential telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, and providing telecommunications connections to a global computer network.	7/24/01	2/1/96
RCN & Design	10/31/95	2,360,973	Class 38: Residential telecommunications services, namely, providing local and long distance telephone service, transmission of cable radio and television, and providing telecommunications connections to a global computer network.	6/27/00	2/1/96
RCN GLOBAL PASSPORT	10/31/08	3,740,986	Class 38: Global cable television transmission and global video on demand transmission services. Class 41: Cable television programming services and video on demand programming services provided via a global	1/19/10	12/1/08

			network		
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EXHIBIT B

Mark	App. Date	Reg. No.	Goods	Reg. Date	First Use Date
RCN GLOBAL PASSPORT & Design	12/3/08	3,764,807	Class 38: Global cable television transmission and global video on demand transmission services. Class 41: Cable television programming services and video on demand programming services provided via a global network	3/23/10	5/1/09