

ESTTA Tracking number: **ESTTA343113**

Filing date: **04/20/2010**

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

| | |
|------------------------|---|
| Proceeding | 92052330 |
| Party | Plaintiff RCN Televisi3n, S.A. |
| Correspondence Address | GARY H. FECHTER 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 |
| Submission | Motion to Consolidate |
| Filer's Name | Gary H. Fechter |
| Filer's e-mail | dpopovic@mccarter.com, gfechter@mccarter.com, lshyavitz@mccarter.com, kgarrone@mccarter.com |
| Signature | /ghf/ |
| Date | 04/20/2010 |
| Attachments | RCN 92052330 Motion Consolidate.pdf (6 pages)(226182 bytes) |

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

| | | |
|----------------------------|---|-----------------------------|
| RCN TELEVISIÓN, S.A. |) | Mark: RCN GLOBAL PASSPORT & |
| |) | Design |
| Petitioner, |) | |
| |) | Registration No. 3,764,807 |
| v. |) | |
| |) | CANCELLATION NO. 92052330 |
| RCN TELECOM SERVICES, INC. |) | |
| Respondent. |) | |

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

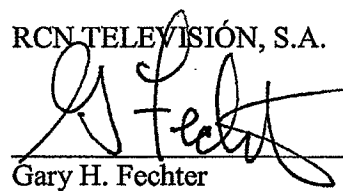
Petitioner, RCN Televisión, S.A., by its attorneys, McCarter & English, LLP, moves to consolidate the above-captioned proceeding with presently pending Consolidated Proceeding No. 91182377 for purposes of trial and pre-trial proceedings.

Dated: April 20, 2010

Respectfully submitted,

RCN TELEVISIÓN, S.A.

By:




Gary H. Fechter
Kelly J. Garrone
Lori J. Shyavitz
McCarter & English, LLP
245 Park Ave., 27th 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 Respondent's attorney of record at the address listed below, on April 20, 2010:

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


Mary Ann Boyce

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

| | | |
|----------------------------|---|-----------------------------|
| RCN TELEVISIÓN, S.A. |) | Mark: RCN GLOBAL PASSPORT & |
| |) | Design |
| Petitioner |) | |
| |) | Registration No. 3,764,807 |
| v. |) | |
| |) | CANCELLATION NO. 92052330 |
| RCN TELECOM SERVICES, INC. |) | |
| Respondent. |) | |
| |) | |

**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 parties¹ under Consolidated Proceeding No. 91182377 (the “Consolidated Proceeding”). Each of the Consolidated Proceedings involves the same issue: Does Petitioner RCN Televisión, S.A. (“RCN”) or Respondent RCN Telecom Services, Inc. (“Telecom”) have priority of use of an “RCN” formative mark?

On March 10, 2010, RCN filed a Motion to Consolidate Cancellation No. 92052167 with the Consolidated Proceeding, and on the same date, RCN filed a Motion to Consolidate Opposition No. 91194069 with the Consolidated Proceeding. On March 31, 2010, the Board entered an order dictating that these proceedings would be consolidated with the Consolidated Proceeding upon resumption of the Consolidated Proceeding (which is currently suspended) if no

¹ The five *inter partes* proceedings in the Consolidated Proceeding are: Opposition No. 91182377, Opposition No. 91192058, Opposition No. 91192065, Opposition No. 91192239, and Cancellation No. 92051509.

opposition to these motions is filed. No opposition to these motions has been filed. RCN's Cancellation No. 92052167 and Opposition No. 91194069 also involve the same central issue as the Consolidated Proceeding - Does RCN or Telecom have priority of use of an "RCN" formative mark?

Respondent's mark RCN GLOBAL PASSPORT (& Design), Registration No. 3,764,807, was registered on March 23, 2010. On April 8, 2010, RCN filed a Petition for Cancellation of the registration of the RCN GLOBAL PASSPORT (& Design) mark under Cancellation No. 92052330 (the "RCN GLOBAL PASSPORT (& Design) Proceeding"). The RCN GLOBAL PASSPORT (& Design) 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."

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 RCN GLOBAL PASSPORT (& Design) 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 initial five proceedings between the parties, the Board reset the schedule in all of those proceedings. As a result, discovery did 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.

The discovery in the Consolidated Proceeding and in the RCN GLOBAL PASSPORT (& Design) 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.

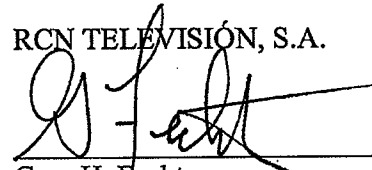
Since the Consolidated Proceeding and the RCN GLOBAL PASSPORT (& Design) Proceeding involve the same parties, common questions of law and fact and will not prejudice or inconvenience the parties, consolidation is warranted. Consolidation of these proceedings is also appropriate because it will promote judicial economy, as well as save the parties significant time, effort and expense to resolve the proceedings. Accordingly, the Board should grant RCN's Motion to Consolidate.

Dated: April 20, 2010

Respectfully submitted,

RCN TELEVISION, S.A.

By:



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

Attorneys for Petitioner