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Filing date: **12/19/2011**

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

Proceeding	92053537
Party	Plaintiff Modern Housing, LLC
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Date	12/19/2011
Attachments	reply brief.pdf (9 pages)(112781 bytes)

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

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MODERN HOUSING, LLC,	:	
	:	
Opposer/Petitioner,	:	
	:	Opposition No.: 91,193,970
v.	:	Mark: ACESTAY
	:	Serial No.: 77/824,124
AMERICAN CASINO AND ENTERTAINMENT	:	
PROPERTIES, LLC,	:	Cancellation No.: 92,053,537
	:	Mark: ACE PLAY
Applicant/Respondent.	:	Reg No.: 3,824,189
-----X		

**MODERN HOUSING, LLC'S REPLY BRIEF IN SUPPORT
OF ITS MOTION TO CONSOLIDATE**

Opposer/Petitioner Modern Housing, LLC ("Modern Housing") files this reply brief in support of its Motion to Consolidate, and respectfully requests that the Board consolidate Opposition No. 91,193,970 (the "Opposition") with Cancellation No. 92,053,537 (the "Cancellation") because (1) the marks and core issues are substantially similar, (2) Modern Housing should not be penalized for the delay in suspension of the proceedings (and regardless, the procedural posture of the proceedings is substantially the same), and (3) consolidation will promote efficiency.

1. Both Cases Involve the Same Parties, Highly Similar Marks and Related Services.

Applicant/Respondent American Casino and Entertainment Properties, LLC ("American Casino") does not dispute that the proceedings involve the identical parties. Furthermore, contrary to American Casino's assertions, the Cancellation and Opposition are highly similar in that both marks in issue fully incorporate Modern Housing's ACE mark, and are used or intended to be used in connection with hotel-related services. In fact, the core issues are so similar that American Casino filed a Declaratory Judgment

action against Modern Housing in the Federal District Court of Nevada covering *both* marks. *American Casino and Entertainment Properties, LLC v. Modern Housing, LLC* (Case No. 11-cv-00222) (the “Civil Action”). The Civil Action was, however, ultimately dismissed by the District Court, on Modern Housing’s motion, under Rule 12(b)(1) of the Federal Rules of Civil Procedure. Thus, it is clear that resolution of the issues will be decided based upon evidence common to both proceedings.

2. Modern Housing Should Not be Penalized for the Delay in Suspension of the Opposition Proceeding.

On February 9, 2011, American Casino filed the Civil Action, but neglected to notice the Board of this filing in the Opposition. On March 18, 2011, more than thirty days prior to the discovery cut-off deadline in this proceeding, Modern Housing took it upon itself to advise the Board of the Civil Action, and filed a Motion to Suspend the Opposition in light of same. The Board granted Modern Housing’s motion on April 21, 2011, more than thirty days after it was filed, and suspended the Opposition proceeding. The Board’s suspension order happened to be entered two days after what would have been the close of discovery in the Opposition proceeding. In the event that discovery is deemed closed in the Opposition proceeding, Modern Housing should not be penalized, and formally asks that it be re-opened. However, even if discovery is deemed closed in the Opposition, the procedural posture of both proceedings remains largely the same, in that nothing substantive has occurred in either proceeding. Both proceedings were previously suspended pending the outcome of the Civil Action; they remain suspended based upon Modern Housing’s consolidation motion and American Casino’s summary

judgment motion; and no discovery has taken place apart from the exchange of Initial Disclosures.¹

3. Consolidation will Promote Efficiency, Economy and Convenience.

Modern Housing submits that the interests of efficiency, economy and convenience will be served by consolidation of the Opposition with the Cancellation. It will be needlessly burdensome and redundant for the parties to prepare and submit virtually identical briefs and arguments in the two proceedings. Likewise, it will be an enormous waste of resources for the Board to manage two separate proceedings.

Modern Housing respectfully submits that consolidation of these proceedings would be more efficient and economical for the Board and the parties, and would serve to streamline the Board's administration of these cases. Without consolidation, the parties and the Board will face increased expense and inconvenience. Consolidation will not change the character of the proceedings, and Modern Housing will gain no unfair advantage from consolidation.

¹With respect to American Casino's false allegation that Modern Housing never served Initial Disclosures in the Opposition proceeding, Modern Housing did in fact timely serve such Initial Disclosures, on November 19, 2010. Attached hereto as Exhibit "A" are Modern Housing's Initial Disclosures, and the accompanying Certificate of Service.

CONCLUSION

For all of the above reasons, Modern Housing respectfully requests that the Board grant this motion, and consolidate Opposition No. 91,193,970 with Cancellation No. 92,053,537.

KENYON & KENYON LLP

Dated: December 19, 2011

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Modern Housing, LLC*

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing document, entitled "Modern Housing, LLC's Reply Brief in Support of its Motion to Consolidate," was served by First Class mail, postage prepaid, on this 19th day of December, 2011, on the attorney of record for Applicant/Respondent American Casino and Entertainment Properties, LLC, as follows:

Michael J. McCue, Esq.
Lewis and Roca LLP
3993 Howard Hughes Pkwy
Suite 600
Las Vegas, Nevada 89169-5996



Michelle C. Morris

EXHIBIT A

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

MODERN HOUSING, LLC,	:	
	:	
Opposer,	:	
	:	Opposition No.: 91193970
v.	:	Mark: ACESTAY
	:	Serial No.: 77/824,124
AMERICAN CASINO AND ENTERTAINMENT PROPERTIES, LLC,	:	
	:	
Applicant.	:	
	:	
	:	

OPPOSER'S INITIAL DISCLOSURES

Modern Housing, LLC, ("Opposer"), pursuant to 37 C.F.R. § 2.120(a) and Federal Rule of Civil Procedure 26, makes the following initial disclosures:

A. The following individual is likely to have discoverable information concerning the claims in this opposition proceeding:

- Ms. Caterina DeCarlo, Modern Housing, LLC

Discoverable Information: The above-listed individual has discoverable information concerning ownership of the ACE® service mark, as referenced in Opposer's Notice of Opposition, and general knowledge concerning the facts and circumstances alleged in the Notice of Opposition.

Contact Information: Counsel of record for Opposer, as set forth below.

B. Opposer may use the following documents to support its claims in this opposition proceeding:

- Documents relating to Opposer's ownership of the ACE[®] service mark, as referenced in Opposer's Notice of Opposition.
- Documents relating to Opposer's allegations in the Notice of Opposition.

The above-mentioned documents are in the possession of Opposer or its counsel.

Opposer reserves the right to amend these disclosures and to make additional disclosures as a result of further discovery in this matter.

KENYON & KENYON LLP

Dated: November 19, 2010

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Certificate of Service

It is hereby certified that a true and correct copy of the foregoing document, entitled Opposer's Initial Disclosures, was served on this 19th day of November, 2010, by first class mail, postage prepaid, upon Applicant's counsel, at the following address:

Mr. Michael J. McCue, Esq.
Lewis and Roca, LLP
3993 Howard Hughes Pkwy, Suite 600
Las Vegas, Nevada 89169-5996



Michelle C. Morris