

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

MBA

Mailed: January 9, 2012

Opposition No. 91194948

Community Trust Bancorp,
Inc.

v.

Community Trust Bank

Michael B. Adlin, Interlocutory Attorney:

This case now comes up for consideration of opposer's motion, filed December 27, 2011, to suspend this proceeding pending final resolution of a pending civil action between the parties herein (Community Trust Bancorp, Inc. v. Community Trust Bank et al., Case No. 7:10-cv-00062-KKC, pending in the U.S. District Court for the Eastern District of Kentucky) (the "Federal Case"). Applicant opposes the motion.¹

In this case, opposer is challenging applicant's application for registration of COMMUNITY TRUST BANK and Design, with TRUST BANK disclaimed, for "Banking services."² Specifically, opposer alleges prior use and registration of

¹ The circumstances leading to opposer's motion are described, and the briefing schedule for the motion is set forth, in the Board's order of December 7, 2011.

² Application Serial No. 76685026, filed December 17, 2007 based on claimed dates of first use of October 26, 2007.

COMMUNITY TRUST for banking and related services³ and that use of applicant's mark is likely to cause confusion with opposer's mark. Opposer's pleaded registration is over five years old. In its answer, applicant denies the salient allegations in the notice of opposition, and counterclaims for cancellation of opposer's pleaded registration based on abandonment.⁴ Opposer denies the salient allegations in the counterclaim. On July 19, 2011, the Board granted applicant's motion to compel, and ordered opposer to respond to applicant's discovery requests within 30 days. After opposer failed to comply with the July 19, 2011 order, applicant filed a motion for sanctions, which is fully briefed and ready for decision.

Opposer filed the Federal Case on the same day it filed this one. In that case, opposer is the plaintiff, and therein alleges prior use and registration of COMMUNITY TRUST for banking and financial services, relying on the same registration it pleads in this case. Complaint in Federal Case ¶¶ 11-12. Opposer specifically alleges that applicant's use of COMMUNITY TRUST BANK & Design is likely to cause confusion with opposer's mark and specifically

³ Registration No. 1946537, issued January 9, 1996 with TRUST disclaimed, based on dates of first use of January 3, 1995. [Renewed; Section 15 affidavit acknowledged].

⁴ In its order of November 2, 2010, the Board dismissed applicant's counterclaim alleging fraud, and found that opposer's claim under Section 2(a) of the Act was inadequately pled.

mentions applicant's application involved in this case. Id. ¶¶ 19, 31, 32. Opposer's prayer for relief seeks an injunction prohibiting applicant from using COMMUNITY TRUST BANK "or any variation thereof," and a declaration that opposer's pleaded registration is "valid, enforceable." Id. Prayer for Relief ¶¶ 1(a), 2.⁵ Applicant filed a motion to dismiss the Federal Case for lack of personal jurisdiction, which the district court denied, but that decision is currently on appeal to the U.S. Court of Appeals for the Sixth Circuit.

Opposer argues that this proceeding should be suspended pending resolution of the Federal Case, because the Federal Case is between the same parties and "raises the same or similar issues of fact and law." Opposer also argues that suspension "will avoid the unnecessary expenditure of both the Board's and each of the parties' resources in litigating the same issues in two forums as well as avoid the potential for inconsistent results."

Applicant argues, however, that by requesting suspension, opposer "seeks to avert the consequences of its actions which have led to [applicant's pending] Motion for Sanctions" Applicant specifically claims that opposer filed this proceeding and the Federal Case on the same day,

⁵ Opposer also seeks cancellation of applicant's related Registration No. 3743528.

but intentionally "separated the relief requested in the respective proceedings to avoid any direct overlap and to allow both proceedings to go forward." Now, however, "past the eleventh hour," opposer conveniently requests suspension of this case, while a potentially dispositive motion for sanctions is pending, and therefore, applicant argues, suspension would be "exceedingly unfair." In any event, applicant argues that whether the Federal Case may have a bearing on this one is "speculative at best," because in the Federal Case opposer seeks no specific relief with respect to applicant's involved application. Applicant also points out that if its motion to dismiss is granted, the Federal Case may not proceed. Finally, because the Board already decided applicant's *ex parte* appeal concerning its involved application, the "normal rationale" for suspension in favor of the Federal Case is "not present in this instance."

The Board's well-settled policy is to suspend proceedings when the parties are involved in a civil action which may be dispositive of or have a bearing on the Board case. Trademark Rule 2.117(a); General Motors Corp. v. Cadillac Club Fashions Inc., 22 USPQ2d 1933, 1937 (TTAB 1992). Here, it is clear from the Complaint in the Federal Case that the Federal Case may have a bearing on this proceeding. Indeed, in both this case and the Federal Case, opposer relies on its prior use of, and the same

registration for, its COMMUNITY TRUST mark, and argues in both cases that applicant's mark COMMUNITY TRUST BANK & Design is likely to be confused with opposer's mark. If opposer's prayer for relief is granted in the Federal Case, applicant will be prohibited from using the mark in its involved application. Moreover, the validity of opposer's pleaded registration is specifically at issue in both proceedings. Cf. Applicant's Counterclaim for Abandonment with Federal Case Complaint Prayer for Relief ¶ 2. The fact that opposer has not specifically challenged applicant's involved application in the Federal Case does not mean that the Federal Case will not have a bearing on this one. To the contrary, it appears likely, and is at the very least possible, that the decision in the Federal Case might have a bearing on this one.

Applicant's other arguments against suspension are also unavailing. If its motion to dismiss is ultimately granted, this case will be promptly resumed, with applicant's pending motion for sanctions the first order of business. But if applicant's motion to dismiss is denied, deciding applicant's motion for sanctions before the Federal Case is over would risk inconsistent judgments, and potentially waste the parties' and the Board's (and maybe the Court's) time. Indeed, the decision in the Federal Case may be "binding upon the Board, while the decision of the Board is

not binding upon the court." TBMP § 510.02(a) (3d ed. 2011); see also, The Other Telephone Co. v. Connecticut National Telephone Co., Inc., 181 USPQ 779 (Comr. 1974); Whopper-Burger, Inc. v. Burger King Corp., 171 USPQ 805 (TTAB 1971).

Furthermore, the Board's decision in applicant's *ex parte* appeal is not relevant. The issue here is opposer's *inter partes* objection to registration of applicant's involved application, and opposer was not and could not have been a party to applicant's *ex parte* appeal. Rather, opposer was not entitled to oppose the involved application until it was published for opposition.

Finally, while applicant's frustration with opposer's decision to litigate what are essentially the same issues in two forums simultaneously is more than understandable, that does not mean that suspension is inappropriate. The bottom line is that the need to avoid potentially inconsistent judgments outweighs any concerns with fairness or inappropriate conduct. Moreover, while the Board may in its discretion decide a potentially dispositive motion such as applicant's motion for sanctions prior to considering suspension, "[t]he purpose of this rule is to prevent a party served with a potentially dispositive motion from escaping the motion by filing a civil action and then moving to suspend before the Board has decided the potentially

dispositive motion." TBMP § 510.02(a) (3d ed. 2011). Here, opposer filed the Federal Case well before applicant filed its motion for sanctions, and it was the Board, not opposer, which originally raised the issue of suspension, so the purpose of the rule would not be furthered by deciding applicant's motion for sanctions now. However, applicant should be aware that "if, as sometimes happens, the court before which a civil action is pending elects to suspend the civil action to await determination of the Board proceeding and the Board is so advised, the Board will go forward with its proceeding." Id.⁶

In short, suspension is appropriate and accordingly opposer's motion to suspend is hereby **GRANTED**. Proceedings herein are suspended pending final disposition, or suspension, of the Federal Case. Within twenty days after the final determination or suspension of the Federal Case, the parties shall so notify the Board and call this case up for any appropriate action. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

⁶ If the Federal Case proceeds, one or both parties should also consider bringing applicant's involved application into the Federal Case, and/or specifically seeking an appropriate judgment regarding the involved application, so that all issues are decided together.