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

Proceeding	91201297
Party	Plaintiff Clark Capital Management Group, Inc.
Correspondence Address	Camille M. Miller Cozen O'Connor, PC 1900 Market Street Philadelphia, PA 19103 UNITED STATES cmiller@cozen.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Camille M. Miller
Filer's e-mail	cmiller@cozen.com
Signature	/Camille M. Miller/
Date	08/30/2011
Attachments	PHILADELPHIA-#6163528-v4-Motion_to_Suspend_Proceeding.pdf (4 pages)(30458 bytes)

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

CLARK CAPITAL MANAGEMENT GROUP, INC.	:	
Opposer,	:	Opposition No. 91201297
v.	:	Serial No. 85/193,740
	:	Filed: December 8, 2010
	:	Published: April 26, 2011
	:	Mark: NAVIGATOR
SERENIC SOFTWARE, INC.	:	
Applicant.	:	

BOX TTAB
NO FEE
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

OPPOSER'S MOTION TO SUSPEND PROCEEDINGS PENDING
DISPOSITION OF RELATED FEDERAL LAWSUIT

Opposer, Clark Capital Management Group, Inc. ("Opposer"), pursuant to 37 C.F.R. §2.117, by and through its undersigned counsel, hereby moves to suspend the above-referenced Opposition proceeding (the "Opposition") pending the disposition of a pending federal lawsuit concerning the same marks and involving the same parties. The federal lawsuit is currently being litigated in the United States District Court, Eastern District of Pennsylvania, under the caption *Clark Capital Management Group, Inc. v. Serenic Software, Inc.* (2:2011cv04752), before the Honorable Norma L. Shapiro, U.S. District Judge (the "Federal Action").

In the Federal Action filed on July 27, 2011, Opposer seeks several forms of relief in addition to those available to it through the Trademark Trial and Appeal Board ("TTAB"), which

include the enjoinment of Applicant's unlawful use of marks that are likely to cause confusion as to the source or origin of Opposer's NAVIGATOR marks (the "Opposer's Marks"). A true and correct copy of Opposer's federal Complaint ("Complaint") filed against Applicant, and which addresses Applicant's Application Serial No. 85/193,740, is attached hereto and marked as Exhibit A. True and correct copies of the Docket Entries for Civil Action Number 2:2011cv04752 are attached hereto as Exhibit B. Opposer believes that the Federal Action will have a substantial bearing, if not dispositive impact, on this Opposition proceeding.

The parties will suffer no prejudice if this matter is stayed. This Opposition proceeding has only recently been initiated as Opposer's Notice of Opposition has just been filed. No discovery has yet to be issued or sought in this Opposition.

Opposer expects the relief sought in the Federal Action to be granted. A finding of infringement against Applicant in the Federal Action will also result in findings in this TTAB action, as alleged in the Opposer's Opposition, that if Applicant is permitted to register its mark, confusion is likely to result, and Opposer will be damaged thereby. Moreover, the Federal Action alleges broader claims than this Opposition so involves additional facts.

The Federal Action will directly address and support Opposer's claims in its Opposition that: if Applicant is permitted to register its mark, and, thereby, obtain the *prima facie* exclusive right to use the mark NAVIGATOR in commerce, confusion is likely to result, and Opposer will be damaged thereby. As a result, if Opposer is successful in the Federal Action, allowance of Serial No. 85/193,740 should be refused.

In accordance with Rule 510.02(a) of the Trademark Trial and Appeal Board rules, suspension of this Opposition is proper. *See* 37 CFR § 2.117(a); *General Motors Corp. v.*

Cadillac Club Fashions Inc., 22 USPQ2d 1933 (TTAB 1992); *Toro Co. v. Hardigg Industries, Inc*., 187 USPQ 689 (TTAB 1975), *rev'd on other grounds*, 549 F.2d 785, 193 USPQ 149 (CCPA 1977); *Other Telephone Co. v. Connecticut National Telephone Co*., 181 USPQ 125 (TTAB 1974), *petition denied*, 181 UPSQ 779 (Comm'r 1974); *Tokaido v. Honda Associates Inc*., 179 USPQ 861 (TTAB 1973); *Whopper-Burger, Inc. v. Burger King Corp*., 171 USPQ 805 (TTAB 1971).

WHEREFORE, good cause having been shown, Opposer requests that the above-captioned Opposition be suspended pending the resolution of the Federal Action.

Respectfully submitted,

Date: August 30, 2011

/s/ Camille M. Miller

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CERTIFICATE OF SERVICE

It is hereby certified that a true and correct copy of the foregoing document was served on Counsel for Applicant by first class mail, postage prepaid on August 30, 2011, addressed as follows:

Mr. Jeffrey F. Craft
Law Office of Jeffrey Craft
2069 Cold Canyon Road
Calabasas, CA 91302-2369

Dated: August 30, 2011

/s/ Camille M. Miller
Camille M. Miller