

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451
General Contact Number: 571-272-8500

mt

Mailed: September 1, 2016

Opposition No. 91203057

Churchill Downs Incorporated

v.

Commemorative Derby Promotions, Inc.

Geoffrey M. McNutt, Interlocutory Attorney:

On March 23, 2016, Applicant, Commemorative Derby Promotions, Inc., (“Commemorative Derby”) notified the Board that the civil action between the parties in the U.S. District Court for the Northern District of Georgia (Atlanta Division) has concluded.¹

Background

Commemorative Derby has applied to register the mark LOUISVILLE JOCKEY CLUB, in standard character form, for “promoting the sport of horse racing,” in International Class 35.²

Churchill Downs, Inc. (“Churchill Downs”), filed a notice of opposition in which it opposes registration pursuant to Section 2(d) on the grounds that Commemorative

¹ *Churchill Downs Inc. v. Commemorative Derby Promotions, Inc.*, Civil Action No. 1:12-cv-517.

² Application Ser. No. 85219903, filed on January 18, 2011, based on intent to use under Trademark Act Section 1(b), 15 U.S.C. 1051(b); “LOUISVILLE” disclaimed.

Derby's mark LOUISVILLE JOCKEY CLUB is likely to cause confusion with Churchill Down's previously-used marks LOUISVILLE JOCKEY CLUB and KENTUCKY JOCKEY CLUB for horse racing and horse-racing facilities. As an additional ground for opposition, Churchill Downs has alleged that Commemorative Derby's application to register the mark LOUISVILLE JOCKEY CLUB violates the terms of the parties' license agreement.

Commemorative Derby filed an answer in which it denied the salient allegations in the notice of opposition and asserted various affirmative defenses.

In an order dated August 7, 2012, the Board suspended proceedings pending the final determination of the civil action between the parties. Board proceedings have been suspended since then.

The Civil Action

Commemorative Derby has submitted copies of the District Court's March 3, 2016 judgment dismissing the civil action and the Court's August 7, 2014, order and opinion, in which the Court granted in part and denied in part Commemorative Derby's motion for reconsideration and clarification of the Court's prior order granting partial summary judgment to Churchill Downs. In the order and opinion, the District Court held that plaintiff Churchill Downs had abandoned the mark LOUISVILLE JOCKEY CLUB and that Commemorative Derby did not breach the parties' license agreement by applying to register the mark LOUISVILLE JOCKEY CLUB" See Order, pp. 6–8 (20 TTABVue 10–12). Commemorative Derby has stated

that it believes the District Court's judgment and order is dispositive of all claims in this opposition proceeding.

As noted *supra*, however, in the notice of opposition Churchill Downs also asserted a Section 2(d) claim based on its prior use of the mark KENTUCKY JOCKEY CLUB. The District Court's judgment and order do not address Churchill Downs' rights in the mark KENTUCKY JOCKEY CLUB vis-à-vis Commemorative Derby's mark LOUISVILLE JOCKEY CLUB, and therefore do not dispose of the entirety of this opposition proceeding.³

Accordingly, proceedings are resumed and dates are reset as follows.

Deadline for Discovery Conference	9/29/2016
Discovery Opens	9/29/2016
Initial Disclosures Due	10/29/2016
Expert Disclosures Due	2/26/2017
Discovery Closes	3/28/2017
Plaintiff's Pretrial Disclosures	5/12/2017
Plaintiff's 30-day Trial Period Ends	6/26/2017
Defendant's Pretrial Disclosures	7/11/2017
Defendant's 30-day Trial Period Ends	8/25/2017
Plaintiff's Rebuttal Disclosures	9/9/2017
Plaintiff's 15-day Rebuttal Period Ends	10/9/2017

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits, must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

³ If either party believes that Churchill Downs' Section 2(d) claim based on the mark KENTUCKY JOCKEY CLUB was disposed of by an order of the Court that has not submitted to the Board, then they should submit any such order forthwith.

Opposition No. 91203057

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.