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

In the Matter of Registration No. 2,280,179  
Issued On September 21, 1999  
For the Mark FOOT & ANKLE CENTERS OF AMERICA, INC.

Foot And Ankle Clinics Of America, Inc.,	}	
Petitioner,	}	
	}	
v.	}	Cancellation No. <u>92042238</u>
	}	
Foot & Ankle Centers of America, Inc.,	}	
Respondent.	}	

**Box TTAB NO FEE**

Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, Virginia 22202-3513

**Motion to Suspend Proceedings**

Respondent, Foot & Ankle Centers of America, Inc., by counsel, hereby requests the pending cancellation proceeding in the current matter be suspended and would show the Trademark Trial and Appeal Board the following in support of its request:

1. The Petitioner, Foot & Ankle Clinics of America, Inc., filed its Petition for cancellation on June 27, 2003.
2. The parties, by counsel, stipulated to an extension of time to answer said Petition.
3. On September 22, 2003, Respondent filed a Complaint for Injunctive Relief and Damages in the United States District Court for the Southern District of Indiana, Evansville Division, Case No. 3:03-CV-162 RLY-WGH.
4. Whenever it shall come to the attention of the Board that the parties to a case pending before it are involved in a civil action which may be dispositive of the Board case, proceedings before the Board may be suspended until final determination of the civil action. 37 C.F.R. § 2.117(a); General Motors Corp. v. Cadillac Club Fashions, Inc., 22 U.S.P.Q.2d 1933 (TTAB 1992).
5. To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is binding upon the Board, while the decision of the Board is not binding upon the court. See Goya Foods, Inc. v. Tropicana Products, Inc., 846 F.2d 848, 6 U.S.P.Q.2d 1950 (2d Cir. 1988).

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6. Ordinarily, the Board will suspend proceedings in the case before it if the final determination of the other proceeding will have a bearing on the issues before the Board. See Other Telephone Co. v. Connecticut National Telephone Co., 181 U.S.P.Q. 125 (TTAB 1974).

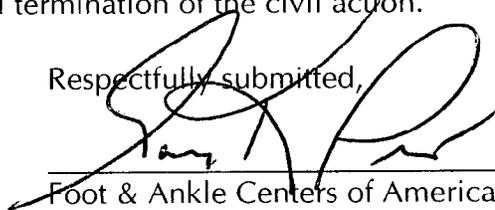
7. The Complaint pending in the United States District Court for the Southern District of Indiana, Evansville Division will have a bearing upon the issues currently before the Board.

8. A copy of the Complaint pending in the United States District Court for the Southern District of Indiana, Evansville Division is attached hereto as Exhibit "A" to show the final determination of the civil action will have a bearing on the issues before the Board pursuant to SCOA Industries, Inc. v. Kennedy & Co., Inc., 188 U.S.P.Q. 411 (TTAB 1975).

9. Pursuant to the Notice of Final Rule Making published in the Federal Register on May 23, 1983, at 48 FR 23122, 23129, the Respondent is not required to file its answer as the final determination of the pending Complaint in Federal Court will have a bearing on the issues before the Board.

WHEREFORE, Respondent respectfully requests the Trademark Trial and Appeal Board to suspend the proceedings until termination of the civil action.

Respectfully submitted,



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Foot & Ankle Centers of America, Inc.

Dated: 9/30/03

By: Gary K. Price, One of its Attorneys  
Bowers Harrison, LLP  
25 N.W. Riverside Dr.  
P.O. Box 1287  
Evansville, IN 47706-1287  
Telephone: (812) 426-1231  
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U.S. DISTRICT COURT  
EVANSVILLE DIVISION

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UNITED STATES DISTRICT COURT  
SOUTHERN DISTRICT OF INDIANA  
EVANSVILLE DIVISION

SOUTHERN DISTRICT  
OF INDIANA  
LAURA A. BRIGGS  
CLERK

FOOT & ANKLE CENTERS OF  
AMERICA, INC.,  
Plaintiff,

)  
) **3:03-CV-162 RLY - WG**  
)

vs.

) Case No. \_\_\_\_\_  
)

FOOT & ANKLE CLINICS OF  
AMERICA, LLC,  
Defendant.

)  
)  
)  
)  
)

**COMPLAINT FOR INJUNCTIVE RELIEF AND DAMAGES**

**JURISDICTION AND VENUE**

1. This is an action for trademark infringement arising under the Lanham Act, 15 U.S.C. §1501 et seq., 15 U.S.C. §1125, Indiana trademark law and/or Indiana or common law of unfair competition or trade.

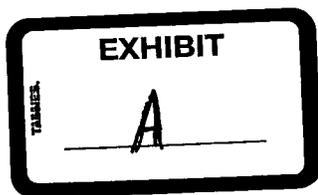
2. This Court has jurisdiction of this action under 15 U.S.C. §1121 and 28 U.S.C. §1338.

3. Venue is proper in this district under 28 U.S.C. §1391.

**PARTIES**

4. Plaintiff Foot & Ankle Centers of America, Inc. ("Plaintiff") is a Delaware corporation with its principal place of business in Evansville, Indiana.

5. Upon information and belief, Defendant Foot & Ankle Clinics of America, Inc. ("Defendant") is an Illinois corporation with its principal place of business in Chicago, Illinois.



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## BACKGROUND FACTS

6. Plaintiff is and at all times relevant was engaged in the business of providing podiatric medical services, including but not limited to, business management for others of podiatric medical services.

7. Since at least June, 1998, Plaintiff has marketed its goods and services under the trademark "Foot & Ankle Centers of America". Plaintiff has widely advertised and extensively offered its goods and services under the trademark "Foot & Ankle Centers of America" throughout the United States, with an emphasis on the Indiana and Kentucky markets. The trademark "Foot & Ankle Centers of America" has become, through widespread and favorable public acceptance and recognition, an asset of substantial value as a symbol of Plaintiff, its quality goods and services, and its goodwill.

8. The United States Patent and Trademark Office granted federal trademark registration to Plaintiff for the trademark "Foot & Ankle Centers of America" under U.S. Reg. No. 2280179, registered September 21, 1999, for business management for others of Podiatric Medical Services in Class 035. A copy of the Certificate of Registration is attached as Exhibit 1.

9. Plaintiff's registration is in full force and effect, and is owned by Plaintiff.

10. On or about February 1, 2003, Plaintiff learned of Defendant's use of the trademark "Foot & Ankle Clinics of America", and on February 3, 2003, Plaintiff issued a cease and desist letter to Defendant.

11. On February 19, 2003, Defendant refused to cease using Plaintiff's trademark "Foot & Ankle Clinics of America".

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12. On July 17, 2003, Defendant filed a cancellation proceeding, No. 92042238, before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office.

**FIRST CLAIM**  
**(Lanham Act - Trademark Infringement)**

13. Paragraphs 1 - 12 are incorporated herein by reference as if fully set forth herein.

14. Notwithstanding Plaintiff's well-known and prior common law and statutory rights in the trademark "Foot & Ankle Centers of America", Defendant, with constructive and actual notice of Plaintiff's federal registration rights under 15 U.S.C. §1072, and long after Plaintiff established its rights to "Foot & Ankle Centers of America", adopted and began using the trademark "Foot & Ankle Clinics of America" in Indiana, and interstate commerce for podiatric medical services.

15. Defendant has infringed and will continue to infringe Plaintiff's trademark by using, advertising, selling, and placing upon the market goods and services which bear the trademark "Foot & Ankle Clinics of America".

16. Defendant has used the trademark "Foot & Ankle Clinics of America" to advertise and market podiatric medical services in Indiana, Illinois, and interstate commerce.

17. Defendant's use of the trademark "Foot & Ankle Clinics of America" creates a likelihood of confusion, deception, and mistake, and violates the Lanham Act, 15 U.S.C. §1114.

18. As a result of Defendant's refusal to cease and desist and its continued

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use of the trademark "Foot & Ankle Clinics of America", irreparable harm and injury to Plaintiff are imminent, and Plaintiff is without an adequate remedy at law. Plaintiff is entitled to an injunction restraining Defendant from engaging in further violations.

19. Plaintiff is also entitled to recover damages, the exact amount to be proven at trial.

**SECOND CLAIM**  
**(Lanham Act - Unfair Competition)**

20. Paragraphs 1 - 19 are incorporated herein by reference as if fully set forth herein.

21. Plaintiff has expended considerable effort and sums of money developing, designing, creating, making, advertising, and marketing its trademark "Foot & Ankle Centers of America". As a result of Plaintiff's activities, the trade and public at large have come to identify the trademark "Foot & Ankle Centers of America" with Plaintiff and Plaintiff's business and with a single source.

22. Defendant has developed, produced, adopted and distributed to the public advertising materials which attempt to trade off the goodwill of Plaintiff's trademark "Foot & Ankle Centers of America". Defendant's conduct has affected and will affect interstate commerce.

23. Defendant's conduct has confused and is likely to confuse the public, cause mistake or deceive the public as to affiliation, connection or association of Defendant with Plaintiff or as to the origin, sponsorship or approval of goods or services of others and violates the Lanham Act §43(a), 15 U.S.C. §1125(a).

24. As a result of Defendant's conduct, irreparable harm and injury to Plaintiff

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are imminent, and Plaintiff is without an adequate remedy at law. Plaintiff is entitled to an injunction restraining Defendant from engaging in further violations.

25. Plaintiff is further entitled to recover from Defendant the damages sustained by Plaintiff as a result of Defendant's acts, the exact amount to be proved at trial.

**THIRD CLAIM**  
**(Violation of Indiana Unfair Competition)**

26. Paragraphs 1 - 25 are incorporated herein by reference as if fully set forth herein.

27. Defendant has passed off its goods or services as those of Plaintiff, and in so doing, has caused a likelihood of confusion, mistake or deception as to the source, sponsorship, approval, affiliation, connection or association of Defendant's goods or services, and/or those of others with Plaintiff's goods or services.

28. Plaintiff has expended considerable effort and sums of money developing, designing, creating, making, advertising, and marketing its trademark "Foot & Ankle Centers of America". As a result of Plaintiff's activities, the trade and public at large have come to identify the trademark "Foot & Ankle Centers of America" with Plaintiff and Plaintiff's business.

29. Defendant has developed, produced, adopted, and distributed to the public advertising materials which attempt to trade off the goodwill of Plaintiff's trademark "Foot & Ankle Centers of America". Defendant's conduct has affected and will affect interstate commerce.

30. Defendant's conduct has confused and is likely to confuse the public, to

cause mistake or to deceive as to affiliation.

31. As a result of Defendant's conduct, irreparable harm and injury to Plaintiff are imminent, and Plaintiff is without an adequate remedy at law. Plaintiff is entitled to an injunction restraining Defendant from engaging in further acts of infringement.

32. Plaintiff is also entitled to recover damages, the exact amount to be proved at trial.

**FOURTH CLAIM**  
**(Indiana Trademark Infringement)**

33. Paragraphs 1 - 32 are incorporated herein by reference as if fully set forth herein.

34. Notwithstanding Plaintiff's well-known and prior common law and federal statutory rights in the trademark "Foot & Ankle Centers of America", Defendant, with constructive and actual notice of Plaintiff's federal registration rights under 15 U.S.C. §1072, with constructive notice of the rights Plaintiff has acquired in good faith by using the mark in the state of Indiana, and long after Plaintiff established its rights to "Foot & Ankle Centers of America" in Indiana and Kentucky, and interstate commerce for podiatric medical services, Defendant attempted to trade off the goodwill of Plaintiff's trademark "Foot & Ankle Centers of America".

35. Defendant has infringed and will continue to infringe Plaintiff's trademark by using, advertising, selling, and placing upon the market goods and services which bear the trademark "Foot & Ankle Clinics of America".

36. Defendant has used the trademark "Foot & Ankle Clinics of America" to advertise and market podiatric medical services in Indiana, Illinois, and interstate

commerce.

37. Defendant's use of the trademark "Foot & Ankle Clinics of America" creates a likelihood of confusion, deception, and mistake, and violates Plaintiff's common law rights to the trademark "Foot & Ankle Centers of America".

38. As a result of Defendant's refusal to cease and desist and its continued use of the trademark "Foot & Ankle Clinics of America," irreparable harm and injury to Plaintiff are imminent, and Plaintiff is without an adequate remedy at law. Plaintiff is entitled to an injunction restraining Defendant from engaging in further violations.

39. Plaintiff is also entitled to recover damages, the exact amount to be proven at trial.

WHEREFORE, Plaintiff prays for judgment against the Defendant as follows:

- a. An injunction restraining Defendant from directly or indirectly infringing Plaintiff's trademark, including but not limited to, any and all uses of "Foot & Ankle Centers of America" or "Foot & Ankle Clinics of America" for any purpose, or any other name that is substantially similar to Plaintiff's trademark;
- b. Recovery of damages as allowed by law;
- c. Recovery of Plaintiff's attorney's fees and costs as allowed by law;
- d. Exemplary damages as allowed by law;
- e. Prejudgment and post-judgment interest as allowed by law; and
- f. That the Court grant such further relief as it deems proper.

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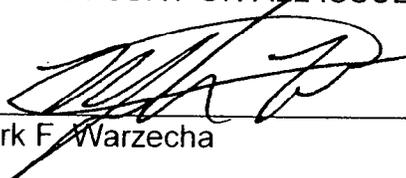
Respectfully submitted,

BOWERS HARRISON, LLP

BY:

  
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Gary K. Price. Attorney No. 15051-82  
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PLAINTIFF HEREBY DEMANDS TRIAL BY JURY ON ALL ISSUES TRIABLE TO A JURY.

  
Mark F. Warzecha

**CERTIFICATE OF SERVICE**

The undersigned hereby certifies that a copy of the foregoing Complaint for Injunctive Relief and Damages has been served upon the attorney for Plaintiff on 9-19, 2003, by depositing same in the United States Mail, first class postage prepaid, in an envelope addressed as follows:

Craig S. Fochler  
Wildman, Harrold, Allen & Dixon  
225 W. Wacker Drive  
Chicago, Illinois 60606-1229

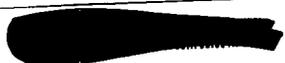
  
Mark F. Warzecha

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**ENCLOSURE MEMO**

TO: Box TTAB No Fee  
Assistant Commissioner for Trademarks  
2900 Crystal Drive  
Arlington, VA 22202-3513

  
**10-03-2003**  
U.S. Patent & TMOs/TM Mail Rpt Dt. #78

FROM: Mark F. Warzecha

DATE: September 30, 2003

RE: Foot and Ankle Clinics of America, Inc. v. Foot & Ankle Centers of America, Inc.  
In the Matter of Registration No. 2,280,179  
Cause No. 3:03-CV-162 RLY-WGH  
Our Client No. 11865.001

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We enclose for filing an original and one (1) copy of the Motion to Suspend Proceedings in the above-referenced matter.