

ESTTA Tracking number: **ESTTA335097**

Filing date: **03/02/2010**

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

Proceeding	92051847
Party	Defendant Baney Corporation
Correspondence Address	Susan Daly Stearns Susan Daly Stearns LLC P.O. Box 215 Bend, OR 97709 UNITED STATES info@stearnstmlaw.com
Submission	Motion to Suspend for Civil Action
Filer's Name	Susan Daly Stearns
Filer's e-mail	info@stearnstmlaw.com
Signature	/Susan Daly Stearns/
Date	03/02/2010
Attachments	Motion to Suspend - outcome of civil case _2_.pdf (3 pages)(40190 bytes) Conformed Complaint.pdf (13 pages)(562598 bytes) Clerk's Notification to Director of USPTO.pdf (1 page)(24594 bytes)

this proceeding pending the outcome of the pending civil action. Petitioner further asserts that by granting this motion, the parties will be alleviated from duplicating the costs and efforts required to address the identical issues in both the civil proceed and before the Board, and no undue prejudice to the Petitioner will result by granting this motion.

Pursuant to TBMP §501.02(a) and 37 CFR §2.117(a), Petitioner hereby respectfully requests the Board to grant Petitioner's motion to suspend Cancellation No. 92051847 pending the outcome of civil case no. CV-10-06040-TC.

Respectfully submitted, this 2nd day of March, 2010.

Respectfully submitted,

BANEY CORPORATION



By: _____

Susan Daly Stearns, Esq.
Susan Daly Stearns, LLC
P.O. Box 215
Bend, OR 97709
Tel: (541) 306-6753
Fax: (888) 746-4621
Attorney for Registrant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and complete copy of the Motion to Suspend Pending Civil Action was deposited with United States Postal Service on March 2, 2010 by first class postage prepaid air mail addressed to:

Ellen Reilly
The Reilly Intellectual Property Law Firm, P.C.
1325 East 16th Avenue
Denver, CO 80218



Susan Daly Stearns

Dated: March 2, 2010
 Bend, Oregon

Michael K. Heilbronner, OSB No. 010050
MHeilbronner@IdeaLegal.com
IdeaLegal, P.C.
1631 NE Broadway; No. 443
Portland, OR 97232
Telephone: (503) 449-9084
Facsimile: (503) 914-0301

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Attorney for Plaintiff

**UNITED STATES DISTRICT COURT
DISTRICT OF OREGON
PORTLAND DIVISION**

BANEY CORPORATION,
an Oregon Corporation

CV '10 - 6040 - TC

Plaintiff,

v.

**DECLARATORY JUDGMENT
COMPLAINT**

SAGE HOSPITALITY RESOURCES LLC
a Delaware Limited Liability Company

(TRADEMARK DISPUTE)

and

Declaratory Judgment Under 28 USC § 2201
and 15 U.S.C. §§ 1116, 1125 and 1127

OXFORD 2005 HOLDINGS, LLC
a Colorado Limited Liability Company

Defendants.

DEMAND FOR JURY TRIAL

Plaintiff Baney Corporation (“Baney” or “Plaintiff”) states the following for its complaint for declaratory judgment against Defendants Sage Hospitality Resources LLC (“Sage”) and Oxford 2005 Holdings, LLC (“Oxford 2005”) (collectively, “Defendants”):

INTRODUCTION

1. For over twenty years, Baney has owned and operated a growing chain of hotels throughout the states of Oregon, Washington, Idaho and California under the marks OXFORD SUITES; OXFORD INN & SUITES; and OXFORD HOTELS. Baney has longstanding and imminent plans to open a hotel under the OXFORD name in Sedona, Arizona. Defendants own and operate a single hotel in Denver, Colorado now called The Oxford Hotel and formerly called The Oxford Alexis hotel. Defendants have never operated a single hotel outside of Denver under the “Oxford” name. Defendants have initiated formal proceedings with the U.S. Patent and Trademark Office that would expressly prevent Baney’s lawful expansion into Arizona and other states, and Defendants’ other conduct indicates that Baney will face additional litigation if it moves forward with its specific plans in the State of Arizona and general plans to expand into other states.

NATURE OF ACTION; JURISDICTION; AND VENUE

2. This is an action at law and in equity for declaratory judgment under the Federal Declaratory Judgment Act (28 U.S.C. § 2201 *et seq.*) and Rule 57 of the Federal Rules of Civil Procedure, for a declaratory judgment finding that:

- (i) Baney has not infringed or interfered with, and is not infringing or otherwise interfering with, and will not infringe or otherwise interfere with the asserted trademark rights of Defendants;
- (ii) Baney’s federal trademark Registrations Nos. 3,076,619, 3,076,626 and 3,600,199 are not subject to cancellation by Defendants;
- (iii) Defendants’ (through the acts and omissions of their predecessors in interest) abandoned their alleged rights in trademarks comprised of or including the phrase THE OXFORD HOTEL, leaving Baney as the senior user of the term OXFORD as the only distinctive element of a trademark used in connection with hotel services; and

- (iv) Baney has not violated, is not violating and will not violate federal or state laws relating to trademark infringement, unfair competition or deceptive practices, including without limitation Sections 32, 43(a), 43(c), and 43(d) of the Lanham Act, 15 U.S.C. §§ 1116 and 1125, or the statutory or common law of any state.

3. Specifically, the claims set forth in this Complaint for Declaratory Judgment arise under the above-referenced laws of the United States and involve an actual controversy between Baney and Defendants as to whether Baney will infringe Defendants' alleged trademark rights by opening a hotel under the OXFORD name in Sedona, Arizona and also as to the parties' ownership of their respective trademarks in several states and other geographic territories of the United States.

4. This Court has jurisdiction over the subject matter and the parties under Section 37 of the Lanham Act (15 U.S.C. § 1119); Section 39 of the Lanham Act (15 U.S.C. § 1121); under 28 U.S.C. §§ 1331, 1338; and pursuant to 28 U.S.C. § 1367.

5. This District is a proper venue pursuant to 28 U.S.C. § 1391(b) and (c) because (i) a substantial part of the events or omissions giving rise to the claim occurred here, including Baney's use and ownership of its trademark rights and Defendants' claim that Oxford 2005's trademarks are famous in Oregon and that Oxford 2005 has sold services under Defendants' trademarks in Oregon; (ii) a substantial part of property that is the subject of this dispute (namely, Baney's trademark rights and accompanying goodwill) are situated in Oregon; and (iii) Defendants are subject to personal jurisdiction in Oregon.

6. This Court has personal jurisdiction over Defendants because Sage owns and/or operates multiple hotels and restaurants in Oregon; and Oxford 2005 acknowledges personal jurisdiction in Oregon because it has formally alleged (in a pleading filed with the Trademark Trial and Appeal Board of the U.S. Patent and Trademark Office) that its trademarks at issue in this case are famous in Oregon; Oxford 2005 has engaged in acts causing injury within this State; Defendants have engaged in acts or omissions outside of this State causing injury within this State; or Defendants have otherwise made or established contacts with this State sufficient to permit the exercise of personal jurisdiction.

THE PARTIES

7. Plaintiff Baney, Inc. is a corporation organized and existing under the laws of the State of Oregon, having its principal place of business at 475 NE Bellevue Drive; Suite 210, Bend, Oregon, 97701.

8. On information and belief, Defendant Sage Hospitality Resources LLC is a Delaware limited liability company with a principal place of business at 1575 Welton Street, Suite 300, Denver, Colorado, 80202.

9. On information and belief, Defendant Oxford 2005 Holdings, LLC is a Colorado limited liability company with a principal place of business at 1575 Welton Street, Suite 300, Denver, Colorado, 80202.

FACTS

10. Baney owns and operates temporary lodging facilities throughout the states of Oregon, Washington, Idaho and California under the marks OXFORD SUITES; OXFORD INN & SUITES; and OXFORD HOTELS.

11. Baney began operations in 1989 and first used the mark OXFORD SUITES in commerce in connection with temporary lodging services at least as early as July 1, 1989.

12. As of July 1, 1989, when Baney first adopted the OXFORD SUITES mark, Baney was not aware of Defendants or Defendants' predecessors in interest or their alleged use of the mark THE OXFORD HOTEL.

13. Baney owns federal Registration No. 3,076,619 for the mark OXFORD SUITES for "hotel services for providing temporary lodging accommodation." This registration issued on April 4, 2006.

14. Baney began using the OXFORD INN & SUITES mark in connection with temporary lodging services at least as early as January 1, 1998.

15. Baney owns federal Registration No. 3,076,626 for the mark OXFORD INN & SUITES for “hotel services for providing temporary lodging accommodations.” This registration issued on April 4, 2006.

16. Baney has used the OXFORD HOTELS mark in connection with temporary lodging services.

17. Baney owns federal Registration No. 3,600,199 for the mark OXFORD HOTELS for “hotel services for providing temporary lodging accommodations to guests.” This registration issued on March 31, 2009. Baney’s OXFORD SUITES; OXFORD INN & SUITES and OXFORD HOTELS marks are collectively referred to below as “Baney’s Marks.”

18. Baney has used Baney’s Marks in connection with its temporary lodging services for more than twenty years, including extensive use throughout the States of Oregon, Washington, California, and Idaho.

19. In addition to its currently operating properties, Baney has long been engaged in a variety of development activities in preparation of opening a hotel under the OXFORD name in Sedona, Arizona (the “Sedona Property”). Baney’s active preparation and plans to develop and open the Sedona Property have included: acquiring the land for the hotel on March 3, 2006; completing an initial design plan and site layout in May 2006; working on a joint site plan in cooperation with owners of neighboring property; meeting with the City of Sedona to discuss the site plan and design layout; fulfilling a requirement to remove an underground storage tank and conduct a related environmental report; and a variety of other work and plans.

Oxford 2005 is the Alter Ego of Sage

20. Oxford 2005 is the putative owner of “The Oxford Hotel” in Denver, Colorado.

21. On information and belief, Oxford 2005 is wholly owned and controlled by Sage.

22. On information and belief, all operational and managerial activity of Oxford 2005 and the Oxford Hotel in Denver, Colorado, including all of the services offered under Defendants’ Marks (as that term is defined below), is directly made, determined or controlled by Sage.

23. On information and belief, Oxford 2005 is the alter ego of Sage and should be treated as and indistinguishable from Sage for all purposes in this litigation.

Defendants' Conduct Leading to This Dispute

24. Oxford 2005 is the putative owner of U.S. federal registration application Serial No. 77/558,889 for the mark THE OXFORD HOTEL for "hotel services."

25. Oxford 2005 is the putative owner of U.S. federal registration application Serial No. 77/561,757 for the mark depicted below for "hotel and restaurant services":



(collectively, the word and stylized/design versions of THE OXFORD HOTEL mark are referred to below as, "Defendants' Marks").

26. On information and belief, Sage controls all decisions relating to the filing and prosecution of the federal trademark registration applications for Defendants' Marks.

27. On information and belief, Defendants' Marks have never been used in connection with hotel or restaurant services at a facility other than a single property in Denver, Colorado.

28. On information and belief, Sage controls all use of Defendants' Marks and all aspects of the services offered under Defendants' Marks.

29. On information and belief, Sage controls all aspects of and all of the decisions relating to the goods and services offered under Defendants' Marks, including the hotel services offered under Defendants' Marks at the Oxford Hotel in Denver, Colorado.

30. On information and belief, Sage is the real party in interest in and effectively the owner of Defendants' Marks and the goods and services offered under Defendants' Marks.

31. On December 6, 2008, the USPTO initially refused registration of Defendants' Marks on the basis of alleged likelihood of confusion with the marks covered by Baney's Registration Nos.

3,076,626 (OXFORD INN & SUITES) and 3,076,619 (OXFORD SUITES) and, prospectively, Baney's then-pending application Serial No. 78/607,104 (now a registration for OXFORD HOTELS) (collectively, the "USPTO's Refusals").

32. On information and belief, on June 8, 2009, Oxford 2005 filed responses to the USPTO's Refusals and argued that there was no likelihood of confusion between the parties' marks because there has been nearly twenty years of concurrent use of the respective marks without any evidence of confusion.

33. On information and belief, in Oxford 2005's June 8, 2009 responses to the USPTO's Refusals, Oxford 2005 argued that there was no likelihood of confusion between the parties' respective marks because there are material differences in the parties' marks themselves

34. On information and belief, in Oxford 2005's June 8, 2009 response to the USPTO's Refusals, Oxford 2005 argued that there was no likelihood of confusion between the parties' respective marks because of the geographic separation of the parties' use of their respective marks.

35. On information and belief, the USPTO did not accept the arguments in Oxford 2005's June 8, 2009 responses to the USPTO's Refusals.

36. On or about the last week of May, 2009 or the first week of June, 2009, Defendants counsel contacted Baney about entering a consent agreement.

37. The parties exchanged revisions to draft agreements. The last draft proffered by Defendants would have prevented Baney from offering its services in Colorado, Wyoming, Arizona, New Mexico, Utah, Texas and Oklahoma.

38. On information and belief, Defendants' own no trademarks rights in Defendants' Marks in the States of Arizona, New Mexico, Utah, Texas, Oklahoma and Wyoming and own only limited rights in the State of Colorado.

39. With the parties unable to resolve their differences about their respective geographic trademark rights, on December 11, 2009, Oxford 2005 filed a "Petition to Cancel" the federal

registrations for Baney's Marks with the Trademark Trial and Appeal Board of the USPTO (the "Cancellation Action.").

40. In the Cancellation Action, Oxford 2005 alleges that Defendants' Marks are famous throughout the United States, including the State of Oregon.

41. On information and belief, Defendants' Marks are not famous.

42. In the Cancellation Action, Oxford 2005 alleges that Baney was on constructive notice or had actual notice or, upon reasonable inquiry, would have had actual notice of the fame of Defendants' Marks. Although these allegations in the Cancellation Action appear to be based on a fundamental misunderstanding and/or misapplication of trademark law, the allegations are an active attempt to unlawfully reduce and/or freeze the common law trademark rights Baney has already lawfully acquired in Baney's Marks.

43. The parties had and have a specific dispute about Baney's right to open hotels and offer hotel services in the State of Arizona and other states under and in connection with Baney's Marks, including an imminent dispute and actual case and controversy about whether Baney is free to open the Sedona Property without infringing the trademark rights Defendants have formally asserted in Defendants' Marks.

44. As a result of the Cancellation Action and Defendants' conduct and assertions during settlement negotiations preceding the Cancellation Action, the Court has before it a contest and controversy over which party has the rights to use their respective marks in connection with hotel services offered in the State of Arizona as well as other states and regions in the United States.

45. In light of the Cancellation Action and Defendants' conduct and assertions during settlement negotiations preceding the Cancellation Action, Plaintiff has been put in apprehension of additional litigation by Defendants because of Plaintiff's active plans to open the Sedona Property.

46. Accordingly, the parties are entitled to a declaratory order to determine which party has the rights to use its respective marks in the relevant States and geographic regions, including whether the Sedona property will infringe the trademark rights formally alleged by Defendants.

47. There is an actual controversy within its jurisdiction pursuant to 28 U.S.C. § 2201(a).

The Abandonment of Defendants' Marks

48. On information and belief, from at least the period of 1987-1997, the hotel in Denver, Colorado that Defendants' now operate under Defendants' Marks was operated and served guests under a different name and mark, namely, the OXFORD ALEXIS HOTEL.

49. On information and belief, from at least 1987-1997, a wide variety of media outlets and other sources identified Defendants' Denver hotel as the OXFORD ALEXIS HOTEL, including *New York* magazine' Kiplinger's Personal Finance publication *Changing Times*; *The New York Times*; *The New Yorker*; the owners of MEZCAL spirits and liquors; the owners of the website located at www.erbzine.com; and the National Multiple Sclerosis Society.

50. On information and belief, the *current* (as of December 2009) Colorado Department of Revenue's Liquor Enforcement Division's list of 3.2% Beer, Wine & Spiritous Liquor licenses states that the liquor license for the Denver hotel is in the name of the OXFORD ALEXIS HOTEL at 1600 17th Street in Denver, which is the address of the hotel now operating under Defendants' Marks.

51. On information and belief, Defendants' and/or Defendants' predecessors discontinued use of Defendants' Marks in connection with the goods and services offered by the hotel in Denver, Colorado for at least three years.

52. On information and belief, Defendants and/or Defendants' predecessors intended not to resume use of Defendants' Marks in connection with the goods and services offered by the hotel in Denver, Colorado.

COUNT I

DECLARATORY JUDGMENT OF NON-INFRINGEMENT and NON-DILUTION

53. Plaintiff repeats and incorporates by reference the allegations in paragraphs 1- 52 as if fully set forth here.

54. On information and belief, Plaintiff's and Defendants' respective customers, marketing channels, trade channels, advertising channels, and other related marketplace factors are not similar.

55. On information and belief, Plaintiff's and Defendants' respective customers and prospective customers are sophisticated and exercise a high degree of care when purchasing the types of goods and services offered by the parties.

56. On information and belief, there has been no actual confusion among relevant consumers between the respective marks of Baney and Defendants.

57. On information and belief, several other entities have used and continue to use the term OXFORD as a trademark or as part of a trademark used in connection with temporary lodging services like those offered by the parties.

58. On information and belief, Defendants do not have exclusive trademark rights in and to the term "OXFORD."

59. Defendants do not have rights, much less exclusive trademark rights, in and to the terms "OXFORD SUITES" or "OXFORD INN & SUITES."

60. Baney's use of Baney's Marks is not likely to cause confusion or to cause mistake or to deceive purchasers of Plaintiff's or Defendant's goods or services.

61. Baney's use of Baney's Marks in connection with the opening and operation of the Sedona Property is not likely to cause confusion or to cause mistake or to deceive purchasers of Baney's or Defendants' goods or services.

62. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does and will not violate Section 32 of the Lanham Act, 15 U.S.C. § 1114.

63. Baney has not and will not (including in connection with the opening and operation of the Sedona Property) use Baney's Marks in a manner that constitutes a false designation of origin, false or misleading description of fact, or false or misleading representation of fact. Moreover, Baney's use of Baney's Marks (including in connection with the opening and operation of the Sedona Property) is not likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of Baney with Defendants, or as to the origin, sponsorship, or approval of Baney's goods or services by Defendants.

64. Baney's use of Baney's Marks does not and will not (including in connection with the opening and operation of the Sedona Property) violate Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

65. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, is not likely to cause dilution of the purported distinctive quality of Defendants' trademarks or trade names.

66. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does not and will not violate Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

67. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does not constitute trademark infringement under the laws of any state or territory.

68. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does not constitute unfair competition or deceptive practices under the laws of any state or territory.

69. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does and will not constitute dilution under the laws of any State, the District of Columbia or the common law.

70. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does not and will not violate Section 43(d) of the Lanham Act, 15 U.S.C. § 1125(d).

71. Baney's use of Baney's Marks, including in connection with the opening and operation of the Sedona Property, does not and will not violate any other law of the United States or any state or territory.

COUNT II

DECLARATORY JUDGMENT OF ABANDONMENT OF TRADEMARKS

72. Baney repeats and incorporates by reference the allegations in paragraphs 1- 71 as if fully set forth here.

73. Defendants (or their predecessors) discontinued use of Defendants' Marks without an intent to resume use for a sufficient period of time as to result in an abandonment of Defendants' Marks.

74. Defendants (or their predecessors) abandoned all rights in Defendants' Marks.

75. As between Baney and Defendants, Baney is the senior user of the term OXFORD as the only distinctive element of a trademark used in connection with hotel services.

WHEREFORE, Plaintiff PRAYS for:

1. An order declaring that Defendants are without right or authority to maintain suit against Plaintiff for alleged infringement, dilution, unfair competition, deceptive practices, or cybersquatting under federal or state law based on Baney's use of Baney's Marks in connection with temporary lodging

services anywhere in the United States (including in connection with the opening and operation of the Sedona Property) except for operating a hotel in the Denver Metropolitan area.

2. An order declaring that Defendants' predecessors in interest abandoned all rights in Defendants' Marks, leaving Baney as the senior user of the term OXFORD by itself as the distinctive part of a mark used in connection with temporary lodgings services.

3. A permanent injunction enjoining and restraining Defendants, their agents, attorneys, and all persons in active concert or participation with Defendants, from initiating or maintaining litigation against Plaintiff (including the Cancellation Action), or any of their representatives based on use of Baney's Marks in connection with temporary lodging services offered anywhere in the United States except for operating a hotel in the Denver Metropolitan area.

4. An order requiring the USPTO to dismiss the Cancellation Action with prejudice.

5. An Order that Defendants be required to pay to Plaintiff the costs of this action and its reasonable attorneys' fees; and

6. Such other and further relief as this Court may deem just and proper.

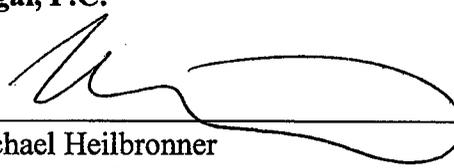
DEMAND FOR JURY TRIAL

Plaintiff demands a trial by jury on any issue that may be properly submitted to a jury.

DATED: February 18, 2010

IdeaLegal, P.C.

By: _____


Michael Heilbronner
OSB No. 010050
Telephone: (503) 449-9084
Fax: (503) 914-0301
MHeilbronner@IdeaLegal.com

Attorney for Plaintiff

AO 120 (Rev. 3/04)

TO: Mail Stop 8 Director of the U.S. Patent and Trademark Office P.O. Box 1450 Alexandria, VA 22313-1450	REPORT ON THE FILING OR DETERMINATION OF AN ACTION REGARDING A PATENT OR TRADEMARK
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In Compliance with 35 U.S.C. § 290 and/or 15 U.S.C. § 1116 you are hereby advised that a court action has been filed in the U.S. District Court OREGON on the following Patents or Trademarks:

DOCKET NO. 10-6040-TC	DATE FILED 2/18/10	U.S. DISTRICT COURT OREGON
PLAINTIFF BANEY CORPORATION		DEFENDANT SAGE HOSPITALITY RESOURCES, INC. and OXFORD 2005 HOLDINGS, LLC
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		SEE ENCLOSED COMPLAINT
2		
3		
4		
5		

FILED '10 FEB 25 12:14 USDC ORE

In the above—entitled case, the following patent(s)/ trademark(s) have been included:

DATE INCLUDED	INCLUDED BY <input type="checkbox"/> Amendment <input type="checkbox"/> Answer <input type="checkbox"/> Cross Bill <input type="checkbox"/> Other Pleading	
PATENT OR TRADEMARK NO.	DATE OF PATENT OR TRADEMARK	HOLDER OF PATENT OR TRADEMARK
1		SEE ENCLOSED COMPLAINT
2		
3		
4		
5		

In the above—entitled case, the following decision has been rendered or judgement issued:

DECISION/JUDGEMENT

CLERK MARY L. MORAN	(BY) DEPUTY CLERK <i>OL C BRINN</i>	DATE 2/25/10
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Copy 1—Upon initiation of action, mail this copy to Director Copy 3—Upon termination of action, mail this copy to Director
 Copy 2—Upon filing document adding patent(s), mail this copy to Director Copy 4—Case file copy