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

Proceeding	92054058
Party	Defendant Crenshaw Whitley & Associates, L.L.C.
Correspondence Address	CRENSHAW WHITLEY & ASSOCIATES LLC 343 RIVER CHASE BLVD GEORGETOWN, TX 78628 UNITED STATES
Submission	Other Motions/Papers
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Date	07/08/2011
Attachments	Motion_to_Suspend.pdf (19 pages)(1589051 bytes)

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

Winston Fraser dba WFCI,	§	
	§	
Petitioner,	§	
	§	<u>Cancellation No. 92054058</u>
v.	§	
	§	
Crenshaw Whitley & Associates, L.L.C.	§	
	§	
Registrant.	§	

REGISTRANT'S MOTION TO SUSPEND

Pursuant to 37 C.F.R. § 2.117(a) and TBMP § 510, Registrant moves to suspend this cancellation proceeding. Registrant has filed a complaint against Petitioner, in the United States District Court for the Eastern District of Texas (the "Court") in the civil action styled *Crenshaw Whitley & Associates LLC v. Winston Fraser and WFCI d/b/a Prime Generic Domains for Sale*, Civil Action No. 4:11-cv-00431 (the "Civil Action"), which may be dispositive of this case. A copy of Registrant's Complaint (the "Complaint") is attached as Appendix A.

As can be seen from the Complaint, the parties in this opposition proceeding also are also parties in the Civil Action, and an issue in dispute in both cases is Registrant's registration of and rights in the MEDBENEFIT mark. Suspension of this cancellation proceeding is clearly appropriate under these circumstances. As stated in TBMP § 510.02(a), "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." This is because, "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." Id.

Here, there is no question that the Civil Action will have a bearing on the issues in this cancellation proceeding. Indeed, a determination by the Court that Registrant has rights to the MEDBENEFIT mark and registration would be dispositive of this cancellation proceeding.

Finally, suspension of this proceeding will not prejudice Petitioner in any way. Petitioner will have a full and fair opportunity to pursue its position on any disputed issues between the parties in the Civil Action, which proceeding should allow for final resolution of all disputes between the parties.

For these reasons, this proceeding should be suspended pending termination of the Civil Action.

CONCLUSION

Because there is a civil action pending between these parties that is potentially dispositive of (or at the very least will have a bearing on) this cancellation proceeding, the cancellation should be suspended until termination of that action.

Dated: July 8, 2011

Respectfully Submitted,

/Scott Griggs/

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**ATTORNEYS FOR REGISTRANT
CRENSHAW WHITLEY &
ASSOCIATES, LLC**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that on this 8th day of July 2011, the foregoing **Registrant's Motion to Suspend** is being deposited with the United States Patent and Trademark Office, Trademark Trial and Appeal Board via electronic filing through their website at <http://estta.upsto.gov> and served upon Petitioner by delivering a true and correct copy of same via first class mail, postage prepaid to counsel for Petitioner as follows:

James R. Menker
Holley & Menker, P.A.
P.O. Box 331537
Atlantic Beach, FL 32233

/Scott Griggs/

Scott T. Griggs

APPENDIX A

3. Defendant WFCI d/b/a Prime Generic Domains For Sale is a Canadian company located at 581 B Station, Montreal, Quebec H3B3K3, Canada, and may be served with process through the Convention on Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matters.

II.
JURISDICTION AND VENUE

4. This action is brought under the Lanham Act, 15 U.S.C. § 1114(1) for trademark infringement, 15 U.S.C. § 1125(a) for unfair competition, 15 U.S.C. § 1125(c) for trademark dilution, and under the Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d) for cyberpiracy.

5. Plaintiff also brings a state law claim for injury to business reputation.

6. The Court has original subject matter jurisdiction over this action pursuant to 28 U.S.C. §§ 1331, 1332, 1338 and 15 U.S.C. § 1121. The Court has supplemental jurisdiction over the state law claim pursuant to 28 U.S.C. § 1367.

7. The Court has personal jurisdiction over Defendants because Defendants maintain continuous and systematic commercial contacts with Texas. Also, Defendants have purposefully availed themselves of the opportunity to conduct commercial activities in this forum, and this action arises out of those activities. Specifically, Defendants expressly aimed their conduct towards Texas by intending to cause competitive injury in Texas through the infringement of Plaintiff's trademark rights. Further, there is a nexus between Defendants' contacts with Texas and the cause of action. Defendants maintain websites <www.medbenefits.com> and <www.medbenefits.net>, and through those websites Defendants actively and continuously solicit commercial interaction with Texas residents, and actively display, disseminate, and promote the infringing mark. The publication and dissemination of the infringing trademark in

Texas is causing ongoing injury to Plaintiff and dilution of Plaintiff's mark. Defendants have done or attempted to do business in Texas, and all or a substantial portion of Defendants' conduct giving rise to this action occurred in Texas. Further, the Court has jurisdiction over this action, as Plaintiff is seeking injunctive relief, and the amount in controversy is within the Court's jurisdiction.

8. Venue is proper in this judicial district under 28 U.S.C. § 1391 because a substantial amount of the events giving rise to Plaintiff's claims occurred within this district.

III. **FACTUAL BACKGROUND**

A. Plaintiff's Business

9. Plaintiff is a company that, for over ten (10) years, has offered insurance agency and brokerage services for ancillary benefit programs to various industries including the education, medical and municipal government industries.

10. CWA d/b/a MedBenefit, is a company with a proven track record in the healthcare alliance marketplace that serves as an aggregation point for regional healthcare alliances across the United States to purchase health and welfare benefits strategically and economically.

11. Utilizing the power and stability of aggregation, CWA d/b/a MedBenefit performs at a very high level, producing savings and improving service and long term pricing stability for all participants.

12. CWA d/b/a MedBenefit manages one of the largest employee benefits group purchasing programs for the healthcare industry, with over 100 healthcare organizations and over 200,000 employees.

13. CWA d/b/a MedBenefit partners have significant experience working with high growth healthcare clients.

14. CWA d/b/a MedBenefit, with its access to healthcare industry information including benefits benchmarking data, has developed economies of scale within the marketplace allowing its participating members to take advantage of cost savings and improve their employee benefit offerings.

15. At least as early as December 15, 2010, Plaintiff has used the trademark MedBenefit® (the “Mark”) to promote its healthcare alliance business through, among other things, Plaintiff’s website <www.medbenefit.com>.

16. On or about January 16, 2009, Plaintiff applied for the registration of its MedBenefit® trademark. United States Trademark Registration No. 3,927,063 was issued on March 1, 2011. *See* Exhibit A.

17. Since at least as early as December 2010, Plaintiff has spent significant resources marketing its products and services using the MedBenefit® trademark. Plaintiff has continuously used the Mark in interstate commerce since at least as early as December 15, 2010, and continues to widely advertise and market its healthcare alliance business using the Mark.

18. The ongoing success of Plaintiff is due at least in part to Plaintiff’s extensive efforts to promote its products and services using the MedBenefit® trademark. The Mark has been and is recognized by the public and the industry as originating from a single source, namely Plaintiff. The Mark serves to distinguish Plaintiff’s products and services from those of others.

19. The name and goodwill of the MedBenefit® mark is one of Plaintiff’s most valuable corporate assets.

20. Through its significant efforts and expense, Plaintiff has acquired and enjoys substantial goodwill and a valuable reputation through its distinctive Mark. Plaintiff maintains high standards of quality and excellence for its products and services, and continues to expend a significant amount of time and money to advertise, offer, and promote its healthcare alliance business through the Mark, including advertising on www.medbenefit.com and through, among other things, brochures and marketing literature.

21. In fact, Plaintiff developed www.medbenefit.com at considerable expense and effort, and Plaintiff is the owner of the copyrights of the content created for and used throughout the website. Plaintiff has provided the appropriate copyright notice throughout its website giving legal notice of its claim of copyright ownership in these works.

22. Plaintiff derives significant revenue from money generated from clients who have sought out insurance agency and brokerage services for ancillary benefit programs through the MedBenefit® mark, due to their cost savings and superior employee benefit offerings.

B. Defendants' Infringing Acts

23. Upon information and belief, Defendant Fraser formed Defendant WFCI in or about 1992.

24. Upon information and belief, Defendants are engaged in domain name brokering and cybersquatting.

25. Defendants own and operate the website www.primegenericdomains.com. At that website, Defendants are offering for sale the domains www.medbenefits.com and www.medbenefits.net.

26. Defendants list their business and services as medbenefits.net and medbenefits.com in their billing.

27. This has caused actual confusion for clients and prospective clients of Plaintiff.

28. Specifically, at least five (5) customers of Defendants have contacted Plaintiff, alleging fraudulent billing practices as a result of credit card billing entries by Defendants stating “medbenefits.com” or “medbenefits.net”. For reasons unknown to Plaintiff, somehow Defendants have obtained credit card numbers from consumers, and charged reported amounts of \$298.00 to such consumers. When these consumers contacted their credit card companies to dispute such amounts, the credit card companies directed the consumers (presumably through an Internet search) to contact Plaintiff, who had no knowledge, participation, or involvement in these transactions whatsoever. The consumers believed that it was Plaintiff, rather than Defendants, who were engaging in these unauthorized charges. Such unauthorized charges and the resulting consumer confusion are perpetrating serious damage to the goodwill that Plaintiff has accumulated in the MedBenefit® mark.

29. Upon learning of the customers’ actual confusion, Plaintiff immediately investigated the Defendants’ website and uncovered Defendants’ infringing acts. Specifically, there is a substantial similarity between Defendants’ billing entries and Plaintiff’s Mark, and a substantial difference between Defendants’ billing entries and WFCI’s own mark.

30. On information and belief, Defendants intend to continue to use Plaintiff’s Mark in promoting Defendant’s cybersquatting and domain name brokering business.

31. Defendants’ use of Plaintiff’s Mark and copyrighted materials is without license and is not otherwise authorized by Plaintiff.

32. On information and belief, through its use of Plaintiff’s Mark, Defendants have intentionally, and with knowledge, sought to cause consumer confusion, mistake, and deception.

33. On December 1, 2010, Plaintiff sent written notice to Defendants demanding that Defendants cease all infringing activities and requested information regarding Defendant's sales and products. To date, Defendant has failed to adequately answer Plaintiff's demand or remove infringing content from its website.

34. Plaintiff has suffered actual damages as a result of the trademark infringement trademark dilution, unfair competition, cyberpiracy and injury to business reputation caused by the activities of Defendants alleged herein.

35. Defendants' acts have caused Plaintiff irreparable harm because Defendants' infringement may cause Plaintiff to lose control of its own reputation. Unless enjoined, the acts of Defendants alleged herein will continue to cause Plaintiff irreparable harm. Plaintiff, therefore, has no adequate remedy at law.

IV. CAUSES OF ACTION

COUNT ONE: Trademark Infringement (Lanham Act Section 32, 15 U.S.C. § 1114)

36. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

37. United States Trademark Registration No. 3,927,063 was issued to Plaintiff on or about March 11, 2011.

38. Plaintiff did not license Registration No. 3,927,063 to Defendants.

39. Plaintiff is not in any way associated with Defendants.

40. Defendants have used, and continued to use, the websites <www.medbenefits.com> and <www.medbenefits.net> in interstate commerce.

41. Defendants' use of these websites infringe on Plaintiff's federally registered trademark in violation of 15 U.S.C. § 1114(1), in that the public is likely to be confused,

deceived, or mistaken regarding the source or sponsorship <www.medbenefits.com> and <www.medbenefits.net>, the content of which websites are managed by Defendants.

42. Indeed, numerous members of the public already been confused and have mistakenly contacted Plaintiff regarding billing errors caused by Defendants.

43. Defendants' use of <www.medbenefits.com> and <www.medbenefits.net> infringes on Plaintiff's Mark by leading the public to believe that Defendants are authorized by Plaintiff to use the Mark and that Plaintiff has endorsed Defendants' websites.

44. Defendants use, and intended use, of marks identical to or likely to be confused with Plaintiff's trademarks, without Plaintiff's consent, for the purpose of marketing and advertising Defendants' products, continues to cause confusion, mistake and deception in the minds of the public in violation of the Lanham Act.

45. The infringements of Plaintiff's Mark by Defendants were and are willful and deliberate.

46. Defendants' conduct is causing Plaintiff immediate and irreparable injury for which Plaintiff has no adequate remedy at law.

47. Plaintiff is therefore entitled to recover monetary damages and its attorney's fees and costs of litigation in the manner provided by the Lanham Act, 15 U.S.C. Sections 1051, et seq.

COUNT TWO: Trademark Dilution (Lanham Act Section 43, 15 U.S.C. § 1125(c))

48. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

49. Defendants' continued illegal and misleading use of Plaintiff's Mark dilutes the reputation and goodwill and industry trust associated with Plaintiff and its services in violation of 15 U.S.C. § 1125(c).

50. Plaintiff is therefore entitled to recover monetary damages and its attorney's fees and costs of litigation in the manner provided by the Lanham Act, 15 U.S.C. Sections 1051, et seq.

COUNT THREE: Unfair Competition (Lanham Act Section 43, 15 U.S.C. § 1125(a))

51. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

52. Defendants have used, and continued to use, the websites <www.medbenefits.com> and <www.medbenefits.net> in interstate commerce.

53. Defendants' use of these websites constitutes a false designation of origin or description and misrepresents the nature of Defendants' activities by erroneously and explicitly confusing Defendants' information and materials as coming from, or connected with, Plaintiff.

54. Defendants' acts are in violation of Section 43 of the Lanham Act, 15 U.S.C. Section 1125(a).

55. Plaintiff is therefore entitled to recover monetary damages and its attorney's fees and costs of litigation in the manner provided by the Lanham Act, 15 U.S.C. Sections 1051, et seq.

COUNT FOUR: Cyberpiracy (Anticybersquatting Consumer Protection Act, 15 U.S.C. § 1125(d))

56. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

57. Plaintiff is the owner of the Mark.

58. Defendants have a bad faith intent to profit from the Mark.

59. Defendants, with knowledge of Plaintiff's rights and use of Plaintiff's registered Mark, maintain registration of two domain names, specifically, <www.medbenefits.com> and <www.medbenefits.net>, which are confusingly similar to the Mark.

60. Indeed, Defendants use of the aforementioned websites has caused actual confusion between Plaintiff and Defendants.

61. Plaintiff is therefore entitled to recover monetary damages and its attorney's fees and costs of litigation in the manner provided by the Lanham Act, 15 U.S.C. Section 1125(d).

COUNT FIVE: Injury to Business Reputation (Texas Business Commerce Code § 16.29)

62. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

63. Plaintiff owns the federally registered Mark.

64. Defendants' use, and intended use, of marks identical to or likely to be confused with Plaintiff's Mark, without Plaintiff's consent, for the purpose of marketing and advertising Defendants' products, continues to cause confusion, mistake and deception in the minds of the public are likely to injure Plaintiff's business reputation or to dilute the distinctive quality of Plaintiff's Mark in violation of the Texas Business and Commerce Code.

65. Pursuant to Texas Business Commerce Code § 16.29 and Rule 680 of the Texas Rules of Civil Procedure, Plaintiff accordingly is entitled to and seeks injunctive relief.

V.

APPLICATION FOR INJUNCTIVE RELIEF

66. Plaintiff restates and incorporates the foregoing allegations as though fully set forth herein.

67. Plaintiff seeks injunctive relief from this Court pursuant to equitable and statutory principles, under 15 U.S.C. § 1116, Texas Business Commerce Code § 16.29 and Rule 680 of the Texas Rules of Civil Procedure.

68. As shown above, Plaintiff has a probable right of recovery in this action. In addition, Plaintiff has suffered, and will continue to suffer, immediate and irreparable harm to its business as a proximate result of Defendants' conduct. The total damages caused by Defendants' activities are not readily quantifiable or measurable, and will likely be unrecoverable.

69. Based upon the foregoing, Plaintiff prays that upon motion, order, or trial, an injunction, either preliminary and/or permanent, be issued, as specified below.

VI.
CONCLUSION AND REQUEST FOR RELIEF

Based upon the foregoing, Plaintiff prays for the following relief:

- a. A judgment that Defendants have infringed Plaintiff's trademark;
- b. A judgment that Defendants have diluted Plaintiff's trademark;
- c. A judgment that Defendants have unfairly competed with Plaintiff, in violation of the Lanham Act;
- d. A judgment that Defendants' acts constitute cyberpiracy in violation of the Anticybersquatting Consumer Protection Act;
- e. A judgment that Defendants' have injured Plaintiff's business reputation under the Texas Business & Commerce Code;
- f. That Defendants, their officers, agents, servants, employees and all persons in concert or participation with Defendants be preliminarily and permanently enjoined from:
 - (i) Directly or indirectly infringing Plaintiff's trademarks;
 - (ii) Diluting the distinctive quality of Plaintiff's trademark;

- (iii) Selling or marketing products or services that in any way tend to deceive, mislead or confuse the public into believing that Defendant's products are in any way sanctioned by or affiliated with Plaintiff;
 - (iv) Otherwise competing unfairly with Plaintiff.
- g. That Defendants' websites, <www.medbenefits.com> and <www.medbeenfits.net> be shut down immediately, and said domain names be transferred to Plaintiff.
 - h. That Defendants be required to account for all gains, profits, and advantages derived from their acts of infringement, unfair competition, and for their other violations of law.
 - i. That, pursuant to 15 U.S.C. § 1117, Plaintiff be awarded an amount equal to (i) Defendants' profits, (2) Plaintiff's damages, and (3) the costs and attorneys' fees of bringing this action.
 - j. That, pursuant to 15 U.S.C. § 1117(d), for Defendants' violation of section 15. U.S.C. § 1125(d)(1), Plaintiff be awarded statutory damages in the amount of not less than \$1,000 and not more than \$100,000 per domain name, as the Court considers just.
 - k. That Plaintiff be granted all other relief to which it is entitled in law or equity.

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Dated: July 8, 2011

Respectfully submitted,

/s/ Brant C. Martin

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**ATTORNEYS FOR PLAINTIFF
CRENSHAW WHITLEY &
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EXHIBIT A

United States of America

United States Patent and Trademark Office

MEDBENEFIT

Reg. No. 3,927,063

CRENSHAW WHITLEY & ASSOCIATES, L.L.C. (TEXAS LIMITED LIABILITY COMPANY)
343 RIVER CHASE BLVD.
GEORGETOWN, TX 78628

Registered Mar. 1, 2011

Int. Cl.: 36

FOR: INSURANCE AGENCY AND BROKERAGE SERVICES FOR ANCILLARY BENEFIT PROGRAMS, NAMELY, DENTAL, VISION, DISABILITY, LIFE, AND LONG-TERM CARE COVERAGE, OFFERED TO EMPLOYEES OF INSTITUTIONAL HOSPITAL AND HEALTH SYSTEMS, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

SUPPLEMENTAL REGISTER FIRST USE 12-15-2010; IN COMMERCE 12-15-2010.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NO. 3,314,483.

SER. NO. 77-651,103, FILED P.R. 1-16-2009; AM. S.R. 12-29-2010.

KAREN SEVERSON, EXAMINING ATTORNEY



David J. Kappas

Director of the United States Patent and Trademark Office