

UNITED STATES PATENT & TRADEMARK OFFICE

BEFORE THE TRADEMARK TRIAL & APPEAL BOARD

CITIZENS FINANCIAL
GROUP, INC.

Opposer,

v.

F.N.B. CORPORATION,

Applicant.

Mark: CITIZENS COMMUNITY BANK
Serial No.: 78/148,872
Published: Feb. 3, 2004

Opposition No. _____

03-10-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #22

NOTICE OF OPPOSITION

In the matter of Application Serial No. 78/148,872, filed on July 30, 2002, by Applicant F.N.B. Corporation, for the mark CITIZENS COMMUNITY BANK: Opposer Citizens Financial Group, Inc., a Delaware corporation having its principal place of business at One Citizens Plaza, Providence, Rhode Island 02903, believes it will be damaged by the registration of the mark shown in the above-identified application, and hereby opposes the same in accordance with the provisions of Section 13 of the Act of July 5, 1946 (15 U.S.C. § 1063). As grounds for its opposition, Opposer states as follows.

PARTIES AND STANDING

1. Opposer is a multibank holding company engaged in the business of commercial and retail banking through six bank subsidiaries operating in seven states.

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2. Since April 1871, and long prior to the Applicant's July 30, 2002, filing date, Opposer and its subsidiaries have been continuously using in commerce the service mark CITIZENS BANK and derivatives thereof to identify its products and services and itself as a bank. Opposer's use of the CITIZENS BANK and related marks has been continuous since 1871 up to and including the present time.

3. Opposer is the owner of the following U.S. Registrations featuring the terms CITIZENS or CITIZENS BANK:

<u>Mark:</u>	<u>Reg. No.</u>	<u>Issued:</u>
CITIZENS ASSET MANAGER ACCOUNT	2,698,547	3/18/2003
CITIZENS BANK [and design]	2,634,833	10/15/2002
CITIZENS BANK [& design]	2,668,486	12/31/2002
CITIZENS BANK [and design]	2,482,203	8/28/2001
CITIZENS BANK BIZMART [& design]	2,563,354	4/23/2002
CITIZENS BANK BUSINESS ONLINE	2,657,801	12/10/2002
CITIZENS BANK OF PENNSYLVANIA	2,792,200	12/09/2003
CITIZENS BANK ONLINE	2,407,272	11/21/2000
CITIZENS CIRCLE	2,228,415	3/02/1999
CITIZENS CIRCLE OF SUCCESS	2,803,423	1/06/2004
CITIZENS INNER CIRCLE	2,692,501	3/04/2003
CITIZENS INVESTMENT SERVICES CORP.	2,744,114	7/29/2003
CITIZENS NOUVELLE CREDIT PROGRAM	2,245,710	5/18/1999
CITIZENS PHONEBANK	2,347,599	5/02/2000
CITIZENS RETIREMENT CHOICE	2,462,640	6/19/2001
CITIZENS SELECT	2,226,579	2/23/1999
CITIZENS SELECT GOLD	2,177,462	7/28/1998
THE GOOD CITIZENS CARD	2,043,590	3/11/1997

4. Applicant is also the owner of the following pending U.S. applications for marks featuring the terms CITIZENS or CITIZENS BANK:

<u>Mark:</u>	<u>Serial No.</u>	<u>Filed:</u>
CITIZENS 7	76/568,901	12/22/2003
CITIZENS ATTORNEYS FIRST	76/477,332	12/20/2002
CITIZENS BANK FOREIGN EXCHANGE	76/521,911	6/03/2003
CITIZENS BANK PARK	76/527,623	6/23/2003
CITIZENS BANK PARK [& des]	76/577,924	2/27/2004
CITIZENS CUSTOM PORTFOLIO	76/494,467	3/04/2003
CITIZENSFX	76/540,295	8/13/2003
CITIZENS PROFESSIONALS FIRST	76/525,044	6/16/2003

5. On June 3, 2003, Opposer filed U.S. trademark application Serial No. 76/521,911, for the mark CITIZENS BANK FOREIGN EXCHANGE, which application is still pending before the Patent & Trademark Office ("the '911 Application").

6. On December 29, 2003, the Trademark Examining Operation issued an Office Action suspending Opposer's '911 Application, citing the above-captioned application for CITIZENS COMMUNITY BANK as a potential bar to registration under Section 2(d) of the Act. Opposer therefore has standing to bring this opposition proceeding.

7. Upon information and belief, Applicant is a bank holding company based in Hermitage, Pennsylvania, with one bank subsidiary: First National Bank of Pennsylvania.

SUBSTANTIVE ALLEGATIONS

8. The specimen submitted by the Applicant in support of the within application purported to show use of the mark in commerce by means of use as the name of one of Applicant's then bank subsidiaries.

9. Upon information and belief, prior to the summer of 2001, Applicant had a bank subsidiary named "Citizens Community Bank" which operated in Naples and Marco Island, Florida.

10. Upon information and belief, in August of 2002, and beginning possibly as early as June of 2001, Applicant merged and consolidated all of its subsidiary banks in Florida with and into the First National Bank of Florida. Further on information and belief, use of the name "Citizens Community Bank" was phased out by the Applicant and its subsidiaries in or around August of 2002.

11. Upon information and belief, on or about January 1, 2004, the Applicant spun off its Florida subsidiary bank into a completely independent entity, First National Bankshares of Florida, Inc. As a result of this transaction, Applicant no longer has any subsidiary banks or other banking operations in Florida.

12. Upon information and belief, Applicant's sole bank subsidiary now is the First National Bank of Pennsylvania, which does business under the trade name "First National Bank."

13. Upon information and belief, neither the Applicant nor its remaining bank subsidiary are presently using the mark CITIZENS COMMUNITY BANK in commerce in connection with any of the services recited in the within application. Further on information and belief, such non-use has been continuous since August of 2002, and possibly as early as June 2001.

14. The deliberate discontinuation of use of the mark, followed by such an extended period of non-use, constitutes abandonment of the subject mark. Because the mark is no longer

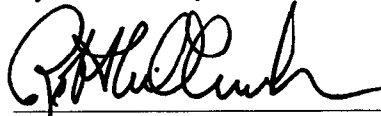
in use in commerce as required by section 1(a) of the Act (15 U.S.C. § 1051(a)), the statutory basis for the application is lacking and registration should be refused.

WHEREFORE, Opposer Citizens Financial Group, Inc., respectfully prays that this Notice of Opposition be sustained, and that the aforesaid application of F.N.B. Corporation be refused registration; and for such other and further relief that the Board deems just and proper.

Respectfully submitted,

CITIZENS FINANCIAL GROUP, INC.,

By its Attorneys,



R. David Hosp
Robert M. O'Connell, Jr.
GOODWIN PROCTER LLP
Exchange Place
53 State Street
Boston, MA 02109-2881
Tel: 617/570-1000
Fax: 617/523-1231

Dated: March 10, 2004

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Robert M. O'Connell, Jr.
617.570.1479
roconnell@
goodwinprocter.com

Goodwin Procter LLP
Counsellors at Law
Exchange Place
Boston, MA 02109
T: 617.570.1000
F: 617.523.1231

10 March 2004



03-10-2004

U.S. Patent & TMOtc/TM Mail Rcpt Dt. #22

Via Express Mail
Receipt No. EL 737882705 US

Box TTAB FEE
Hon. Commissioner for Trademarks
United States Patent & Trademark Office
2900 Crystal Drive
Arlington, Virginia 22202

Re: **Notice of Opposition**
Citizens Financial Group, Inc. v. FNB Corporation
Mark: CITIZENS COMMUNITY BANK
Serial No. 78/148,872

Dear Sir or Madam:

On behalf of the above-captioned Opposer, Citizens Financial Group, Inc., I enclose the following documents for filing:

1. Notice of Opposition (two copies in accordance with TBMP § 309.02(c)); and
2. A return postcard.

Also enclosed is this Firm's check no. 963816 in the amount of US \$300.00 in payment of the filing fees. Any overpayment or underpayment of fees may be charged or credited as is appropriate to Goodwin Procter's deposit account, no. 07-1700.

To confirm filing, kindly date-stamp the enclosed self-addressed stamped postcard and forward it to this office by return mail. Future correspondence in this matter may be directed to the undersigned counsel for Opposer. Thank you for your attention to this matter.

Respectfully,

Robert M. O'Connell, Jr.
ATTORNEY FOR OPPOSER
CITIZENS FINANCIAL GROUP, INC.

RMO/s
Enclosures

EXPRESS MAIL CERTIFICATE

DATE 3/10/04 LABEL NO. EL 737882705 US

I hereby certify that, on the date indicated above, I caused this paper or fee to be deposited with the U.S. Postal Service and that it was addressed for delivery to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3514, by "Express Mail Post Office to Addressee" service.

Robert M. O'Connell, Jr.