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Filing date: **08/31/2006**

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

Proceeding	91166203
Party	Plaintiff Drive Financial Services LP Drive Financial Services LP 8585 N. Stemmons Frwy Suite 1100-North Dallas, TX 75247 UNITED STATES
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Submission	Other Motions/Papers
Filer's Name	John F. Martin
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Signature	/John F. Martin/
Date	08/31/2006
Attachments	Motion to Suspend 8-31-2006.pdf (13 pages)(420831 bytes)

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

DRIVE FINANCIAL SERVICES, LP,	§	Serial No. 78/324,239
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91166203
	§	
CITICORP,	§	Mark: DRIVER'S EDGE (intent to-use)
	§	
Applicant.	§	Int'l Class(es): 35, 36, 37, 41

Motion to Suspend without Consent

Drive Financial Services, LP (“Drive”) requests that the Board suspend this Proceeding, for the reasons set forth in this Motion and supporting brief.

**I.
SUMMARY OF POSITION**

Citicorp has a pending intent-to-use application on a similar mark to the one in the current proceeding, serial no. 78/746,226, for the mark “DRIVE CARD” in International Classes 35 and 36.¹ The PTO has not refused the mark for publication, and Citicorp presumably intends to pursue this mark to publication, which Drive would oppose and intends to file an opposition proceeding. Drive would then propose a consolidation of this Proceeding and the “DRIVE CARD” proceeding, on the grounds that the proceedings would involve identical parties, involve similar marks, would allow the parties avoid engaging in duplicative discovery efforts, and would promote the judicial economy of this Board. A suspension would also allow the parties sufficient time to pursue settlement discussions on both marks or pursue a means of alternative dispute resolution, such as a mediation.

¹ See Exhibit A (printout from www.uspto.gov).

Drive proposes a suspension of the current proceeding, pending the outcome of the prosecution of Citicorp's "DRIVE CARD" application (or unless Citicorp abandons its "DRIVE CARD" application), so that Drive may move to consolidate both proceedings.

II. **AUTHORITY**

Flowing from the Board's inherent power to schedule disposition of the cases on its docket is the power to stay proceedings, which may be exercised by the Board upon its own initiative, upon motion, or upon stipulation of the parties approved by the Board.² Proceedings may be suspended for good cause upon motion or upon stipulation of the parties approved by the Board.³ A suspension may be appropriate when an examining attorney is considering a matter that may have an impact on the proceeding, including the disposition of a party's application before the examining attorney.⁴ The fact that parties are pursuing settlement discussions is good cause for a suspension.⁵

III.

A. The Current Proceeding.

The current proceeding involves the Applicant, Citicorp, and its application for "DRIVER'S EDGE" as an intent-to-use mark, Serial No. 78/324,329. Drive's main objection to the application is that the dominant distinctive component to Citicorp's mark, "DRIVE," is

² Trademark Trial and Appeal Board Manual of Procedure (TBMP) Rule 510.01.

³ See 37 C.F.R. § 2.117(c).

⁴ See TBMP 510.03(a); *The Tamarkin Co. v. Seaway Food Town Inc.*, 34 USPQ2d 1587, 1592 (TTAB 1995) (granting a suspension pending the outcome of the prosecution of another application).

⁵ See, e.g., *Instruments SA Inc. v. ASI Instruments Inc.*, 53 U.S.P.Q.2d 1925, 1927 (TTAB 1999) (it may be the safest course of action for parties engaged in settlement to file a consented motion or stipulation to suspend proceedings).

identical to the dominant distinctive component of Drive's marks – "DRIVE," and that both Citicorp's and Drive's services are in the consumer financing industry, including automobile financing services.⁶ Drive's marks are registered in International Class 36; Citicorp seeks to register "DRIVER'S EDGE" in, *inter alia*, International Class 36.

B. Citicorp's "DRIVE CARD" Application.

On November 3, 2005, Citicorp submitted an Intent-to-Use application for the mark "DRIVE CARD," Serial No. 78/746,226.⁷ On May 11, 2006, the Examining Attorney issued a Non-Final Action letter to Citicorp, requesting a disclaimer on the use of the wording "CARD" apart from the mark as shown, and requesting a substitute specimen showing use of the mark for the services specified in the application.⁸ Clearly, neither issue is a serious impediment to approval of the application for publication.

A response to the Examining Attorney's Non-Final Action is due from Citicorp on or before November 11, 2006.⁹ Counsel for Citicorp has represented to counsel for Drive that she presumes that Citicorp will further pursue this application to approval for publication by the Examining Attorney.

In the event that the application for "DRIVE CARD" is approved for publication, Drive intends to file a Notice of Opposition with the Board on this application, for the same reasons in the current proceeding. Drive's main objection to the application is that the dominant distinctive component to Citicorp's "DRIVE CARD" mark, "DRIVE," is identical to the dominant

⁶ See Drive's Notice of Opposition, at ¶¶ 7-8.

⁷ See Exhibit A.

⁸ See Exhibit B (Copy of Examining Attorney Michael G. Lewis' Non-final May 11, 2006 action letter/e-mail).

⁹ See Exhibit B.

distinctive component of Drive's marks – "DRIVE," and that both Citicorp's and Drive's services are in the consumer financing industry, including automobile financing services.¹⁰ Drive's marks are registered in International Class 36; Citicorp seeks to register "DRIVE CARD" in, *inter alia*, International Class 36. After such a Notice of Opposition, Drive intends to propose a consolidation of the "DRIVE CARD" opposition with the current proceeding, due to the fact that the two cases would involve common questions of fact and law.

C. Suspending this Proceeding until Both Marks Could Be Consolidated into a Single Proceeding Would Save the Parties and Board Considerable Time, Fees, and Expenses.

To proceed without a consolidation would require the parties to redo discovery on identical issues, take depositions of the same personnel in two proceedings, and submit duplicative testimony and briefs when the issue in both proceedings is identical – whether the "DRIVE" dominant distinctive component of Citicorp's two applications are substantially similar or identical to the "DRIVE" dominant distinctive component of Drive's marks, such that it would cause confusion in the marketplace. Suspending this proceeding and then consolidating this proceeding with the "DRIVE CARD" opposition proceeding would save the parties considerable time, expense, and attorneys' fees in resolving this issue, and would spare the Board from engaging in a duplicative proceeding.

D. A Suspension Would Also Allow the Parties Time to Pursue Settlement.

The parties have engaged in informal discussions about a settlement meeting or engaging in an alternative dispute resolution, such as a mediation, to resolve the dispute between Drive and Citicorp over Citicorp's "DRIVER'S EDGE" and "DRIVE CARD" applications. A suspension would permit the parties to fully pursue settlement discussions and/or a mediation.

¹⁰ See Drive's Notice of Opposition, at ¶¶ 7-8; Exhibit A (Citicorp's Application for 78/746,226).

IV.
PRAYER

For the reasons stated above, Drive requests that the Board suspend this proceeding until Citicorp's "DRIVE CARD" application is approved for publication (and subsequently opposed by Drive), unless Citicorp decides to abandon its "DRIVE CARD" application. Drive would request that the Board order a Joint Status Report from the parties on the status of the "DRIVE CARD" application, to be delivered to the Board by no later than November 11, 2006.

Dated: Dallas, Texas
August 31, 2006

By: 

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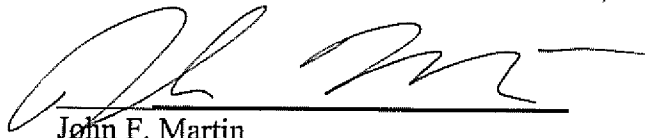
Attorneys for Drive Financial Services, LP

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the above and foregoing pleading has been forwarded in accordance with TBMP Rule 113 and 37 C.F.R. § 2.119 to all counsel of record on the 31 day of August, 2006:

Bruce J. Goldner, Esq.
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Successor by Merger to Applicant Citicorp



John F. Martin
Michael J. Lang



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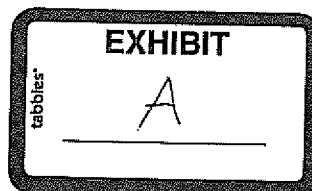
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DRIVE CARD

<p>Word Mark</p> <p>Goods and Services</p> <p>Standard Characters Claimed</p> <p>Mark Drawing Code</p> <p>Design Search Code</p> <p>Serial Number</p> <p>Filing Date</p> <p>Current Filing Basis</p> <p>Original Filing Basis</p> <p>Owner</p> <p>Type of Mark</p>	<p>DRIVE CARD</p> <p>IC 035. US 100 101 102. G & S: Promoting the goods and services of others through the administration of a customer loyalty program. FIRST USE: 20040930. FIRST USE IN COMMERCE: 20040930</p> <p>IC 036. US 100 101 102. G & S: Credit card services. FIRST USE: 20040930. FIRST USE IN COMMERCE: 20040930</p> <p>(4) STANDARD CHARACTER MARK</p> <p>78746226</p> <p>November 3, 2005</p> <p>1A</p> <p>1A</p> <p>(APPLICANT) Citigroup Inc. CORPORATION DELAWARE 399 Park Avenue New York NEW YORK 10043</p> <p>SERVICE MARK</p>
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To: Citigroup Inc. (blotners@citigroup.com)
Subject: TRADEMARK APPLICATION NO. 78746226 - DRIVE CARD - N/A
Sent: 5/11/06 8:48:37 AM
Sent As: ECOM111@USPTO.GOV
Attachments: Attachment - 1
Attachment - 2
Attachment - 3

UNITED STATES PATENT AND TRADEMARK OFFICE

SERIAL NO: 78/746226

APPLICANT: Citigroup Inc.

CORRESPONDENT ADDRESS:
CITIGROUP INC.
909 3RD AVE FL 15
NEW YORK, NY 10022-4731

78746226

RETURN ADDRESS:
Commissioner for Trademarks
P.O. Box 1451
Alexandria, VA 22313-1451

MARK: DRIVE CARD

CORRESPONDENT'S REFERENCE/DOCKET NO: N/A

CORRESPONDENT EMAIL ADDRESS:
blotners@citigroup.com

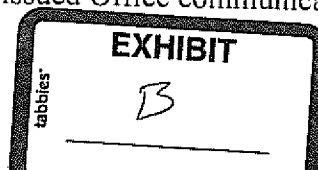
Please provide in all correspondence:

1. Filing date, serial number, mark and applicant's name.
2. Date of this Office Action.
3. Examining Attorney's name and Law Office number.
4. Your telephone number and e-mail address.

OFFICE ACTION

RESPONSE TIME LIMIT: TO AVOID ABANDONMENT, THE OFFICE MUST RECEIVE A PROPER RESPONSE TO THIS OFFICE ACTION WITHIN 6 MONTHS OF THE MAILING OR E-MAILING DATE.

MAILING/E-MAILING DATE INFORMATION: If the mailing or e-mailing date of this Office action does not appear above, this information can be obtained by visiting the USPTO website at <http://tarr.uspto.gov/>, inserting the application serial number, and viewing the prosecution history for the mailing date of the most recently issued Office communication.



Serial Number 78/746226

The assigned trademark examining attorney has reviewed the referenced application and has determined the following:

Search of Office Records

The Office records have been searched and no similar registered or pending mark has been found that would bar registration under Trademark Act Section 2(d), 15 U.S.C. §1052(d). TMEP §704.02. However, several other issues currently exist that prevent the pending application from being approved for registration.

Disclaimer

Applicant must disclaim the descriptive wording "CARD" apart from the mark as shown because it merely describes a feature and function of the services. Please see the attached definitional evidence that defines the word card as "plastic card storing information: a small piece of plastic that holds information in a magnetic strip or microprocessor, used in financial activities such as getting cash from ATMs or making phone calls." The word is merely descriptive of a feature and function of the credit card services and customer loyalty programs because both services are likely to use a "card" in order to administer said services. Trademark Act Section 6, 15 U.S.C. §1056; TMEP §§1213 and 1213.03(a).

The Office can require an applicant to disclaim exclusive rights to an unregistrable part of a mark, rather than refuse registration of the entire mark. Trademark Act Section 6(a), 15 U.S.C. §1056(a). Under Trademark Act Section 2(e), 15 U.S.C. §1052(e), the Office can refuse registration of the entire mark where it is determined that the entire mark is merely descriptive, deceptively misdescriptive, or primarily geographically descriptive of the goods. Thus, the Office may require the disclaimer of a portion of a mark which, when used in connection with the goods or services, is merely descriptive, deceptively misdescriptive, primarily geographically descriptive, or otherwise unregistrable (e.g., generic). TMEP §1213.03(a). If an applicant does not comply with a disclaimer requirement, the Office may refuse registration of the entire mark. TMEP §1213.01(b).

A "disclaimer" is thus a written statement that an applicant adds to the application record that states that applicant does not have exclusive rights, separate and apart from the entire mark, to particular wording and/or to a design aspect. The appearance of the applied-for mark does not change.

Accordingly, the disclaimer statement, when printed in the *Trademark Official Gazette*, will read as follows:

No claim is made to the exclusive right to use "CARD" apart from the mark as shown.

A disclaimer does *not* physically remove the disclaimed matter from the mark, but rather is a written statement that applicant does not claim exclusive rights to the disclaimed wording and/or design separate and apart from the mark as shown in the drawing.

Specimen Requirement for International Class 35

Applicant must submit a substitute specimen showing use of the mark for the services specified in the

application, because the specimen currently of record does not show use of the mark for any services identified in the application. 37 C.F.R. §2.56; TMEP §§904 and 904.01 *et seq.* Applicant must also submit a statement that "the substitute specimen was in use in commerce at least as early as the filing date of the application," verified with an affidavit or a signed declaration under 37 C.F.R. §2.20. 37 C.F.R. §2.59(a); TMEP §904.09.

The current specimen of record comprises "sales brochure" which shows the proposed mark appearing in the center of the brochure and on a picture of a credit card. It does not show use for applicant's services for International Class 35 because the specimen does not contain any information about promoting goods and services through customer loyalty programs. Where the mark is used in advertising the services, the specimen must show an association between the mark and the services for which registration is sought. A specimen that shows only the mark, with no reference to the services, does not show service mark usage. *In re Adair*, 45 USPQ2d 1211 (TTAB 1997) (tags affixed to decorated Christmas tree that bear the mark "TREE ARTS CO. and design" and the applicant's location, but make no reference to services, fail to show use for "design services in the nature of designing handcrafted, permanently decorated Christmas and designer trees").

If an amendment of the dates-of-use clause is necessary in order to state the correct dates of first use, then applicant must verify the amendment with an affidavit or a signed declaration in accordance with 37 C.F.R. §2.20. 37 C.F.R. §2.71(c).

The following is a sample declaration under 37 C.F.R. §2.20 with a supporting statement for a substitute specimen:

The undersigned being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. §1001, and that such willful false statements and the like may jeopardize the validity of the application or document or any registration resulting there from, declares *that the substitute specimen was in use in commerce at least as early as the filing date of the application*; all statements made of his/her own knowledge are true; and all statements made on information and belief are believed to be true.

(Signature)

(Print or Type Name and Position)

(Date)

Pending an adequate response to the above, registration is refused as to International Class 35 ONLY because the specimens of record do not show use of the proposed mark as a service mark. Trademark Act Sections 1, 2, 3 and 45, 15 U.S.C. §§1051, 1052, 1053 and 1127; TMEP §§904.11 and 1301.02 *et seq.*

Please note that the specimen submitted for International Class 36 is an acceptable specimen.

Applicant may respond to the stated refusal by doing one of the following:

- (1) deleting the classes to which the refusal pertains;
- (2) submitting a substitute specimen that adheres to the requirements explained above;
- (3) changing the basis, if appropriate to 1(b) (the basis may not be changed for applications filed under Trademark Act §66(a)).

Conclusion

If applicant has questions about its application or needs assistance in responding to this Office Action, please telephone the assigned trademark examining attorney directly at the number below.

/Michael G. Lewis/
Examining Attorney
Law Office 111
United States Patent and Trademark Office
(571) 272-5495

HOW TO RESPOND TO THIS OFFICE ACTION:

- **ONLINE RESPONSE:** You may respond using the Office's Trademark Electronic Application System (TEAS) Response to Office action form available on our website at <http://www.uspto.gov/teas/index.html>. If the Office action issued via e-mail, you must wait 72 hours after receipt of the Office action to respond via TEAS. **NOTE: Do not respond by e-mail. THE USPTO WILL NOT ACCEPT AN E-MAILED RESPONSE.**
- **REGULAR MAIL RESPONSE:** To respond by regular mail, your response should be sent to the mailing return address above, and include the serial number, law office number, and examining attorney's name. **NOTE: The filing date of the response will be the date of receipt in the Office,** not the postmarked date. To ensure your response is timely, use a certificate of mailing. 37 C.F.R. §2.197.

STATUS OF APPLICATION: To check the status of your application, visit the Office's Trademark Applications and Registrations Retrieval (TARR) system at <http://tarr.uspto.gov>.

VIEW APPLICATION DOCUMENTS ONLINE: Documents in the electronic file for pending applications can be viewed and downloaded online at <http://portal.uspto.gov/external/portal/tow>.

GENERAL TRADEMARK INFORMATION: For general information about trademarks, please visit the Office's website at <http://www.uspto.gov/main/trademarks.htm>

FOR INQUIRIES OR QUESTIONS ABOUT THIS OFFICE ACTION, PLEASE CONTACT THE ASSIGNED EXAMINING ATTORNEY SPECIFIED ABOVE.

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