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**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
2900 Crystal Drive
Arlington, Virginia 22202-3513**

KSK

Mailed: February 5, 2004

Opposition No. 91114353
Cancellation No. 92031763

Chesapeake Bank

v.

Chesapeake Bank of
Maryland

Before Simms, Rogers and Holtzman, Administrative Trademark
Judges.

By the Board:

On January 22, 2003, the Board suspended proceedings in
Opposition No. 91114353 pending final disposition of the
civil action between the parties in the United States
District Court for the District of Maryland. Thereafter, on
October 10, 2003, the Board resumed proceedings for
consideration of opposer's motion for summary judgment and
any related pending motions pursuant to a court order in the
related civil action.

CONSOLIDATION

As a preliminary matter, it is noted that Opposition
No. 91114353 and Cancellation No. 92031763 involve the same
parties and common questions of law and fact. More
specifically, defendant's mark in the opposition is

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CHESAPEAKE BANK and in the cancellation it is CHESAPEAKE. In both proceedings, plaintiff has alleged use of CHESAPEAKE and CHESAPEAKE BANK and claims ownership of two pending applications, Serial Nos. 75255515 and 75255517, for the mark CHESAPEAKE BANK all for use in connection with, inter alia, banking services. Further, in each case, both plaintiff and defendant intend to rely on use of other, arguably related marks. It is therefore appropriate to consolidate these two proceedings pursuant to Fed. R. Civ. P. 42(a).

Consolidation is discretionary with the Board, and may be ordered upon motion granted by the Board, or upon stipulation of the parties approved by the Board, or upon the Board's own initiative. See, for example, Wright & Miller, *Federal Practice and Procedure: Civil* §2383 (1971); *Regatta Sport Ltd. v. Telux-Pioneer Inc.*, 20 USPQ2d 1154 (TTAB 1991) (Board's initiative).

Accordingly, Opposition No. 91114353 and Cancellation No. 92031763 are hereby consolidated and may be presented on the same record and briefs.¹

The Board file will be maintained in Opposition No. 91114353 as the "parent" case, but all papers filed herein

¹ The parties are reminded that because the Board has ordered the consolidation of the above-identified proceedings, they should no longer file separate papers in connection with each proceeding. Only a single copy of each paper should be filed by the parties.

must include the proceeding numbers of the consolidated cases, in ascending order.

Opposition No. 91114353 now comes before the Board for consideration of the following motions: (1) opposer's motion for summary judgment; (2) applicant's motion to amend its answer; (3) opposer's motion to supplement its summary judgment motion; (4) applicant's motion to strike evidence submitted by opposer in support of opposer's motion for summary judgment; and (5) applicant's motion for judgment for fabrication and spoliation of evidence. The motions have been fully briefed.²

BACKGROUND

Applicant filed an application for registration of the mark CHESAPEAKE BANK in typed form for "consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit, and loans secured by mortgages and automobiles" in Class 36.³ Opposer, in its notice of opposition, alleges likelihood of confusion under Section 2(d) of the Trademark Act with its marks CHESAPEAKE and CHESAPEAKE BANK. Applicant in its answer denies the salient allegations of the opposition. Proceedings were

² Applicant's consented motions filed on April 25, 2002 and May 13, 2002 and opposer's consented motions filed on June 14, 2002 and July 1, 2002 to extend various response times are granted.

³ Application Serial No. 75244844 filed on February 20, 1997 and claiming a bona fide intent to use the mark in commerce.

suspended for some time to facilitate settlement negotiations.

After resumption of proceedings, opposer filed a motion for summary judgment and applicant filed a motion for discovery under Fed. R. Civ. P. 56(f), to seek information on various instances of alleged actual confusion. Thereafter, the Board granted in part and denied in part applicant's subsequent motion to compel its requested 56(f) discovery and after several extensions of time the above-noted motions were fully briefed. The Board will address each motion in turn.

MOTION TO AMEND THE ANSWER

By its motion to amend, applicant seeks to add fourteen affirmative defenses. In support of its motion, applicant states that it will be prejudiced if not allowed to amend, as it would "make more difficult applicant's ability to defend against opposer's motion for summary judgment." Further, applicant argues that opposer would not be prejudiced by the amendment because the "evidence in applicant's possession in support of its affirmative defenses was provided to opposer pursuant to opposer's discovery requests" and "additional evidence in support of applicant's affirmative defenses was and is in the possession and control of opposer." Finally, applicant argues that it did not delay in bringing this motion because

part of the amended answer includes a defense of unclean hands based on activity occurring during the proceeding and applicant was justified in waiting to assert its defense after completion of its investigation of particulars.

In opposition to the motion, opposer argues that applicant delayed too long in moving to amend and that granting the motion would be highly prejudicial to opposer "at this extremely late date in this opposition proceeding." Opposer argues that applicant's amended answer increases the scope of discovery and discovery is already closed in this case.

Fed. R. Civ. P. 15(a) provides that leave to amend pleadings shall be freely given when justice so requires. In accordance with that principle, the Board liberally grants leave to amend pleadings where the other party will not be prejudiced thereby. See *Buffett v. Chi-Chi's, Inc.*, 226 USPQ 428 (TTAB 1985) and *Cool-Ray, Inc. v. Eye Care, Inc.*, 183 USPQ 618 (TTAB 1974). However, undue delay in moving to amend may be prejudicial to the non-moving party. See *Long John Silver's, Inc. v. Lou Scharf Inc.*, 213 USPQ 263 (TTAB 1982). Moreover, where the moving party seeks to add a new claim or defense, and the proposed pleading thereof is legally insufficient, or would serve no useful purpose, the Board normally will deny the motion for leave to amend. See *Octocom Systems Inc. v. Houston Computer*

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Services Inc., 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990).

Turning now to the affirmative defenses applicant seeks to add, we find that the allegations set forth in paragraph nos. 15-17, 19-21, and 26-27 serve to amplify the denials in the answer and apprise opposer with greater particularity of the position which applicant is taking in the defense of its right to registration, and allowance of the amplification will not prejudice opposer. With regard to paragraph no. 14 we find that allowance of the amendment would not be prejudicial to opposer because the registration recited in that paragraph is the subject of now consolidated Cancellation No. 92031763, in which opposer is the petitioner. With regard to paragraph no. 25, to the extent these allegations operate as an amplification of applicant's defense that there is no likelihood of confusion, it is allowed; however, applicant is advised that the determination of concurrent use rights is only available in a concurrent use proceeding involving a concurrent use application, or in a civil action before a district court. See TBMP Sections 1101.02, 1102.01, 1102.02. In view thereof, while the foregoing paragraphs in the proposed amended answer do not set forth true affirmative defenses, the motion to amend is granted as to paragraph nos. 14-17, 19-21, and 25-27.

With regard to paragraph no. 18, laches may not be asserted as a defense in an opposition proceeding.⁴ See *National Cable Television Ass'n v. American Cinema Editors, Inc.*, 937 F.2d 1572, 19 USPQ2d 1424, 1432 (Fed. Cir. 1991).

Paragraph no. 22 presents allegations regarding applicant's use of a domain name incorporating the term CHESAPEAKE BANK since July 1997 and asserts an estoppel defense. The only relevance applicant's use of the CHESAPEAKE BANK domain name would have is with regard to priority and because the filing dates of opposer's applications⁵ are earlier than the domain name registration, these allegations are immaterial. Paragraph no. 23 presents allegations regarding a third party's priority of use over opposer, which are also immaterial.

Paragraph no. 24 asserts the affirmative defense of unclean hands based on allegations pertaining to fabrication and spoliation of evidence by opposer during the course of this proceeding. Evidentiary matters, such as fabrication and spoliation, do not give rise to the affirmative defense of unclean hands. See *Vodusek v. Bayliner Marine Corp.*, 71

⁴ Moreover, to the extent applicant seeks to present a "Morehouse" defense, *Morehouse Mfg. Corp. v. J. Strickland & Co.*, 407 F.2d 881, 160 USPQ 715 (C.C.P.A. 1969), this defense is unavailable to applicant inasmuch as opposer has petitioned to cancel the registration upon which defendant is relying. See *Estate of Ladislao Jose Biro v. Bic Corp.*, 18 USPQ2d 1382 (TTAB 1991).

F.3d 148, 155-156 (4th Cir. 1995). The Board notes that these allegations are properly dealt with by applicant's motion for judgment, which we construe as a motion for a sanction for alleged misconduct engaged in during the course of this proceeding, which could include a sanction of judgment. In view thereof, the motion to amend is denied as to paragraph nos. 18 and 22-24.

MOTION FOR JUDGMENT

In support of its motion for judgment, applicant alleges that opposer created false evidence of actual confusion and destroyed material evidence "that pertains directly to the creation of false evidence."⁶ It is applicant's contention that there is sufficient evidence to conclude that an e-mail sent by a customer of opposer, one Mr. Carlton Dunford, to applicant "was not an accident of confusion but instead an attempt to fabricate evidence of confusion" and that opposer's customer "willfully erased information on his computer hard drive...that would be essential to proving" that the e-mail was not an accident. In response, opposer states that applicant's allegations are

⁵ Applications Serial Nos. 75255515 and 75255517 filed March 11, 1997.

⁶ In view of our decision *infra* regarding opposer's motion to supplement the summary judgment motion, applicant's motion is arguably moot inasmuch as the allegedly fabricated evidence in question is not evidence of record. However, in order to put this matter to rest the Board takes up the motion on its merits.

"baseless" and that "applicant has presented no evidence whatsoever of either fabrication or spoliation."

Fabrication of evidence is a form of litigation misconduct that is subject to sanction up to and including judgment against a party. See *Vargas v. Peltz*, 901 F. Supp. 1572 (S.D. Fla. 1995); McCarthy, J. Thomas, McCarthy on Trademarks, Section 31:83 (4th ed. 2004).

"To establish spoliation the moving party must show that the adverse party had a duty to preserve the allegedly spoiled documents and that the documents were intentionally destroyed. The degree of culpability and the prejudice suffered by the moving party will guide a court in its formulation of remedial and punitive action." *Trigon Insurance Co. v. U.S.*, 204 FRD 277, 286 (E.D. Va. 2001). Under the spoliation of evidence rule, an adverse inference may be drawn against a party who destroys relevant evidence.

At issue here is a firestorm churned up around a single e-mail from one of opposer's customer's, Mr. Dunford, and addressed to applicant, but a message that had not been submitted by opposer as evidence in support of its motion for summary judgment. Rather, applicant brought the e-mail to opposer's attention and put it in the record here for purposes of supporting its Rule 56(f) motion for discovery. Now, applicant seeks to obtain judgment against opposer based on this e-mail and opposer seeks to rely on this e-

mail in support of its summary judgment motion as an instance of actual confusion.

By way of background, on January 22, 2001 at approximately 8:00 pm, Mr. Dunford found the website with the domain name chesapeakebank.com and through that website sent an e-mail inquiring about tax information for his accounts. As it turns out, this website is for applicant's bank, not opposer's bank. One week later, on January 29, 2001, opposer filed its motion for summary judgment, which did not include this e-mail. Applicant brought this e-mail to opposer's attention in February 2001 and moved for and received time to conduct Rule 56(f) discovery into this e-mail.⁷ Thereafter, applicant moved to compel the production of documents and witnesses in conjunction with its Rule 56(f) discovery requests. The Board, on January 28, 2002, granted applicant's motion in part and specifically compelled the depositions of two of opposer's employees and further responses to one document request and one interrogatory.

Applicant was provided with ample opportunity to explore the circumstances surrounding this e-mail. As a

⁷ Applicant found the proximity of the transmission of the e-mail and the filing of the motion for summary judgment suspicious. Opposer agreed to allow discovery on the subject, stating "opposer is happy to let applicant develop evidence of actual confusion against itself." Opposer's Brief (April 23, 2001) at 5.

result of its investigation, applicant's evidence of fabrication consists of the following: (1) two instances of allegedly contradictory accounts of certain facts appearing in the depositions of John H. Hunt, II, an officer of the opposer, and Mr. Dunford, regarding how Mr. Dunford found applicant's website and whether or not counsel for opposer was present during a February 2001 telephone conversation between Mr. Dunford and Mr. Hunt; and (2) Mr. Dunford's allegedly "contradictory and obviously self-serving testimony." With regard to Mr. Dunford's deposition, applicant essentially finds doubtful various choices made by Mr. Dunford in sending the e-mail (e.g., his taking a "shot in the dark" with the internet rather than remembering he has opposer's business card in his wallet which contains an e-mail address for one of the bank's employees)⁸ and attributes these acts to a conscious plan to use the e-mail as part of an effort to fabricate evidence of actual confusion.

Applicant's evidence of spoliation consists of statements made by Mr. Dunford regarding deletions of his e-mails from his personal computer. The Board notes in this regard that applicant's own statement of the law is not supported by the record. Applicant states that "when a

⁸ Q. And rather than wait until the next day to find out or make a call, and rather than check to make sure, since you had a card

party has notice...that evidence is necessary to the opposing party's claim, that party is under a duty not to take actions that would result in the destruction of the evidence" citing *Trigon Insurance Co. v. U.S.*, 204 FRD 277, 287. Mr. Dunford, of course, is not a party and there is, in any event, no evidence his actions were taken at the behest of opposer. Also, based on Mr. Dunford's testimony, the relevant information would have been deleted prior to February 27, 2001, the date on which applicant charges both opposer and Mr. Dunford with knowledge that the computer evidence would be relevant to this litigation.

Q. Is that e-mail still on your computer?

A. No, it's not.

Q. What happened to it?

A. I erased it.

Q. And when did you erase it?

A. Probably 30 minutes after I got a reply back to the e-mail the next day [January 23, 2001], the next day or the day after that.

Dunford Deposition at 40 (December 3, 2001).

Q. How often do you empty out your [e-mail] trash.

A. Prior to all of this - I've got to clarify. Usually every time I would go in the e-mail, it

in your pocket, you went ahead and sent it anyway? A. Correct.

could be once a day or once a week, but I keep it empty...I would do it [delete] every time I was online, just about as a habit to keep it cleaned up.

Dunford Deposition at 60.

It is Mr. Dunford's testimony that no one told him to send an e-mail to applicant and that he had no knowledge of any litigation between applicant and opposer until opposer's phone call to him sometime between March and May 2001, inquiring about the e-mail. Dunford Deposition at 132 and 11.

Considering the severity of the accusations (e.g., "Mr. Dunford's conduct is certainly tortuous [sic], and could be considered criminal") the Board would expect applicant to produce clear evidence of misconduct. However, there is simply nothing in this record on which to base a conclusion that evidence was fabricated or spoliated.⁹ In view thereof, applicant's motion for sanctions in the nature of judgment is denied.

Dunford Deposition at 138 (December 3, 2001).

⁹ In this regard, applicant's attorney is advised that the Board may through its inherent authority sanction parties that increase the cost of litigation by filing frivolous motions. *Central Mfg. Inc. v. Third Millenium Technology, Inc.*, 61 USPQ2d 1210 (TTAB 2001); *Carrini, Inc. v. Carla Carini S.R.L.*, 57 USPQ2d 1067 (TTAB 2000). See also, *Chambers v. NASCO, Inc.*, 501 U.S. 32, 111 S.Ct. 2123, 115 L.Ed.2d 27, rehearing denied, 501 U.S. 1269, 112 S.Ct. 12, 115 L.Ed.2d 1097 (1991).

MOTION TO SUPPLEMENT SUMMARY JUDGMENT MOTION

Opposer's motion to supplement its summary judgment motion with additional examples of alleged actual confusion is denied. The Board, in general, discourages piecemeal litigation and, moreover, Trademark Rule 2.127(a) provides that no further papers will be considered after the reply brief.

MOTION TO STRIKE

By this motion, applicant moves to strike twelve declarations and Exhibits I and J attached to Mr. Hunt's declaration. Applicant's arguments that the declarations are a "disguised survey" and that Exhibits I and J are "inadmissible compilations" are not well taken and the motion to strike is denied.

MOTION FOR SUMMARY JUDGMENT

Opposer has moved for summary judgment in its favor as to its Section 2(d) ground of opposition. The motion is granted in part and denied in part for the reasons set forth below.

Background/Pleadings

As noted above, applicant has filed an application for registration of the mark CHESAPEAKE BANK (in typed form) for "consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit, and loans secured by mortgages and automobiles" in class 36.

In its notice of opposition, opposer alleges, inter alia, that "since long prior to February 20, 1997,...opposer and its predecessors have used the designations CHESAPEAKE and CHESAPEAKE BANK in the United States as service marks in connection with banking services and related financial services," that "opposer is the owner of pending ...applications serial nos. 75/255,515 and 75/255,517," that "applicant's services identified in its application are identical and/or closely related to opposer's banking services and related financial services and are sold or likely to be sold to the same classes of purchasers as opposer's services," and that applicant's "designation CHESAPEAKE BANK is identical to opposer's mark and is likely when applied to applicant's services to cause confusion or mistake or to deceive."

In its amended answer, applicant admitted the allegations concerning opposer's ownership of opposer's applications and their suspension by the Trademark Office. Further, applicant admitted that the marks are similar, and that "some of the services offered by the two parties overlap." Applicant denied the remaining allegations.

Summary Judgment Standard

Generally, summary judgment is appropriate in cases where the moving party establishes that there are no genuine issues of material fact which require resolution at trial

and that it is entitled to judgment as a matter of law. Fed. R. Civ. P. 56(c). An issue is material when its resolution would affect the outcome of the proceeding under governing law. *Anderson v. Liberty Lobby, Inc.*, 477 U.S. 242, 248 (1986). However, a dispute over a fact which would not alter the Board's decision on the legal issue will not prevent entry of summary judgment. *See, for example, Kellogg Co. v. Pack'Em Enterprises Inc.*, 951 F.3d 330, 21 USPQ2d 1142 (Fed. Cir. 1991). A fact is genuinely in dispute if the evidence of record is such that a reasonable fact finder could return a verdict in favor of the nonmoving party. *See Lloyd's Food Products Inc. v. Eli's Inc.*, 987 F.2d 766, 25 USPQ2d 2027 (Fed. Cir. 1993). The nonmoving party must be given the benefit of all reasonable doubt as to whether genuine issues of material fact exist, and the evidentiary record on summary judgment, including all inferences to be drawn from the undisputed facts, must be viewed in the light most favorable to the nonmoving party. *See Opryland USA, Inc. v. Great American Music Show, Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992); *Olde Tyme Foods Inc. v. Roundy's Inc.*, 961 F.2d 200, 22 USPQ2d 1542 (Fed. Cir. 1992).

The Parties' Evidence And Arguments

In support of its motion, opposer has presented evidence showing that: (1) opposer owns and is the prior

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user of the mark CHESAPEAKE BANK in connection with banking and related financial services; (2) opposer is the successor in interest to CHESAPEAKE BANKING COMPANY and CHESAPEAKE NATIONAL BANK; (3) the involved marks of opposer and applicant, CHESAPEAKE BANK, are identical; (4) the parties' services are virtually identical; and (5) opposer and opposer's predecessors in interest have continuously used the term CHESAPEAKE in combination with other terms, namely, they have used CHESAPEAKE BANKING COMPANY, CHESAPEAKE NATIONAL BANK and CHESAPEAKE BANK, beginning in 1920 and continuing through the present.

Opposer's evidence on summary judgment includes: (1) the declaration of John H. Hunt, II, opposer's senior vice president and chief financial officer, with accompanying exhibits; (2) copies of USPTO office actions suspending prosecution of opposer's application to register CHESAPEAKE BANK in view of the opposed application herein; (3) a copy of opposer's petition to cancel applicant's registration No. 2,301,218 for CHESAPEAKE; (4) the declarations of twelve of opposer's customers; (5) excerpts from applicant's answers to opposer's interrogatories; and (6) excerpts from opposer's depositions of applicant's officers R. Thomas Jefferson and Celeste Tolson.

In response, applicant's evidence includes: (1) the declaration of R. Thomas Jefferson, applicant's president,

with accompanying exhibits; (2) excerpts from the deposition of John H. Hunt, II, taken on March 7, 2002; and (3) excerpts from opposer's answers to applicant's interrogatories.

Opposer argues, *inter alia*, that the marks are identical, the services are identical, the trade channels are identical, the services are purchased by the same class of purchasers, there has been actual confusion, opposer is the prior user of the mark CHESAPEAKE BANK and opposer is the prior user of the term CHESAPEAKE in connection with banking services through use by its predecessors in interest of the designations CHESAPEAKE BANKING COMPANY from 1920 to 1967 and CHESAPEAKE NATIONAL BANK from 1967 to 1994.

In response, applicant argues, *inter alia*, that opposer's parent, a non-party, is the owner of the mark CHESAPEAKE BANK, that opposer is not in any event the senior user, in view of applicant's use of the mark CHESAPEAKE since 1960 and the change in commercial impression occurring each time opposer's predecessors changed names, and that opposer is not the successor in interest to any trademark in use prior to 1994.¹⁰

We note that applicant does not dispute that the involved marks [CHESAPEAKE BANK] are identical, that the

¹⁰ As discussed *supra*, applicant's arguments based on laches and the Morehouse defense are unavailable to applicant and have been given no consideration.

parties offer overlapping services, and that opposer first used the mark CHESAPEAKE BANK in 1994.

Decision

In determining whether there is any genuine issue of material fact relating to the legal question of likelihood of confusion, the Board must consider all of the probative facts in evidence which are relevant to the factors bearing on likelihood of confusion, as identified in *In re E.I du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As noted in the *du Pont* decision itself, various factors, from case to case, may play a dominant role. *Id.*, 476 F.2d at 1361, 177 USPQ at 567. Those factors as to which we have probative evidence are discussed below.

We find that there is a likelihood of confusion as to the marks CHESAPEAKE BANK. The evidence of record clearly establishes the lack of a genuine issue of material fact as to the identical nature of the marks CHESAPEAKE BANK and CHESAPEAKE BANK. As to the services offered by each party, the evidence of record shows that opposer offers banking services and related financial services under the CHESAPEAKE BANK mark, see e.g., John Hunt Declaration Exh. E, and applicant's identified services are "consumer banking services, namely, checking accounts, personal savings accounts, certificates of deposit and loans secured by

mortgages and automobiles." These services are virtually identical.

Regarding the channels of trade, the involved application is unrestricted. Thus, the Board must presume that applicant's services are marketed or will be marketed in all the normal channels of trade for the identified services and to all the usual classes of purchasers of such services. See *Kangol Ltd. v. KangaROOS U.S.A.*, 974 F.2d 161, 23 USPQ2d 1945 (Fed Cir. 1992).

In addition, opposer's uncontroverted evidence of prior use of CHESAPEAKE BANK establishes both opposer's prior use of CHESAPEAKE BANK and opposer's standing in this case. Further, we find that opposer is the owner of the mark CHESAPEAKE BANK.¹¹ No genuine issue of material fact exists on any of these issues.

We find that there are no genuine issues of material fact relating to opposer's standing and to the *duPont* likelihood of confusion factors, and we hold that opposer is entitled to partial summary judgment on the question of

¹¹ With regard to the ownership issue applicant seems to argue that because opposer is wholly-owned and controlled by a parent corporation, it is the parent corporation that is the owner of the mark. This argument is without merit. Under the "unity of control" doctrine, either the parent or the subsidiary may be the proper owner of the mark regardless of which one is the controlling entity as long as one of them controls the other. With regard to applicant's arguments regarding the parent subsidiary relationships applicant is directed to *In re Wella A.G.*, 5 USPQ2d 1359, 1361 (TTAB 1987), rev'd on other grounds, 858 F.2d 725, 8 USPQ2d 1365 (Fed. Cir. 1988) and TMEP Section 1201.07.

likelihood of confusion, such question being limited in the opposition to a comparison of the respective CHESAPEAKE BANK marks. On the other hand, while we find no genuine issue regarding opposer's prior use of CHESAPEAKE BANK, per se, we find that opposer is not entitled to judgment in its favor on the overall legal issue of priority, as presented in the opposition. There are factual¹² and legal¹³ issues relating to which party was the first to acquire rights in the term CHESAPEAKE alone and whether such rights are or could be derived from a use of CHESAPEAKE with another descriptive or generic term. Thus, the motion for summary judgment is

¹² At a minimum, genuine issues of fact remain as to: (1) which party first used the term CHESAPEAKE by itself and the extent of that use, insofar as it may have given rise to service mark rights; and (2) any continuing commercial impression created by the parties' respective uses of their names and/or service marks. See *T.A.B. Systems v. PacTel Teletrac*, 77 F.3d 1372, 37 USPQ2d 1879 (Fed. Cir. 1996). The issues of fact relating to continuing commercial impression include not only the similarity of the marks, but also the context of their use, and customer perception. Applicant's change from using CHESAPEAKE in connection with "federal savings and loan" to using it in connection with "bank" may "convey more information to potential customers" thus creating a different commercial impression, whereas opposer, referred to consistently as a bank of some type or banking company, may have created a single, continuing commercial impression, notwithstanding differences. *American Security Bank v. American Security & Trust Co.*, 571 F.2d 564, 197 USPQ 65 (CCPA 1978); *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036 (TTAB 1989), *aff'd*, 923 F.2d 869, 17 USPQ2d 1726 (Fed. Cir. 1990).

¹³ The question remains as to the appropriate tacking standard to apply: prior use of the salient feature of a trade name, as in *Bionetics Corp. v. Litton Bionetics, Inc.*, 218 USPQ 327 (TTAB 1983), or prior use of a trademark legally equivalent to a current mark, as in *American Paging Inc. v. American Mobilphone Inc.*, 13 USPQ2d 2036. We decline to rule on this question of law because the parties may not have realized its potential importance and did not fully brief the question.

granted as to likelihood of confusion and denied as to priority.¹⁴

CIVIL ACTION/CONCURRENT USE

The Board notes that applicant has asserted that the parties "operate in geographically distinct markets." In the context of these consolidated proceedings, the "geographical separation of the parties' principal places of business cannot be considered to be of significance in determining registrability of applicant's mark since it seeks a geographically unrestricted registration." *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983). In short, there is no concurrent use application before the Board, and the Board will not consider concurrent use rights in the absence of a proper concurrent use application and a concurrent use proceeding. Moreover, with regard to the application involved in the opposition, applicant may not move to amend its application to one seeking concurrent use based on

¹⁴ The parties are advised that our decision granting partial summary judgment is interlocutory in nature. The time for seeking judicial review thereof shall expire two months from the date of a final decision in this opposition proceeding. See Trademark Rule 2.145(d); and *Copelands' Enterprises Inc. v. CNV Inc.*, 887 F.2d 1065, 12 USPQ2d 1562 (Fed. Cir. 1988). Further, the parties are reminded that any evidence submitted in support of or opposition to a summary judgment motion is only considered of record for the purposes of that motion. See TBMP Section 528.05(a). If the case goes to trial, the summary judgment evidence does not form part of the evidentiary record and will not be considered at final hearing unless it is properly introduced in evidence, during the appropriate trial period.

geographic restrictions because the application was filed under Section 1(b) of the Trademark Act based on intent to use. See TBMP Section 1103.01 (2d ed. June 2003). As to applicant/respondent's registration for the term CHESAPEAKE, this could be subject to geographic restriction either by way of court order or by way of a concurrent use proceeding precipitated by a concurrent use application by opposer naming this registration as an exception to opposer's rights.

With this in mind, the Board reiterates that the issue of any respective concurrent use rights is, at this time, more properly considered by the district court in the civil action.

SUSPENSION

Inasmuch as the July 8, 2003 order of the United States District Court of Maryland stayed proceedings in the civil action for the sole purpose of the Board ruling on the summary judgment motion and the motion having now been disposed of, proceedings herein are suspended pending disposition of the civil action between the parties. In the event the court stays the civil action, the Board will resume these consolidated proceedings, including time for discovery,¹⁵ and proceed to trial.

* * *

¹⁵ In keeping with Board practice dates would be reset to coincide with the latest instituted proceeding.