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

Proceeding no.	92078681
Party	Plaintiff Coalcity Social Club Inc. Dallas-Forth Worth
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Attachments	PETITIONERS RESPOSNE TO RESPONDENTS MOTION TO SUSPEND PROCEEDING tta bvue 92078681.pdf(91025 bytes)

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

COALCITY SOCIAL CLUB INC.	§	
DALLAS-FORTH WORTH (DFW),	§	
COAL CITY INTERNATIONAL	§	
CLUB	§	
<i>Petitioners,</i>	§	Registration No. 3893666
	§	ESTTA Tracking No. 1179579
v.	§	
	§	
COALCITY SOCIAL CLUB, INC.	§	
<i>Respondents.</i>	§	

**PETITIONER’S RESPOSNE TO RESPONDENT’S MOTION
TO SUSPEND PROCEEDING**

COME NOW, COALCITY SOCIAL CLUB INC. DALLAS-FORTH WORTH (DFW),
COAL CITY INTERNATIONAL CLUB (“Petitioners”) and file this, response to
Respondent’s Motion to Suspend Proceeding and in denial thereof would show the
Board as follows:

1). Petitioner agrees that Respondents and Petitioner are parties in an ongoing matter pending in the Northern District of Texas to wit: Civil Action 3:21-cv-0663; *COALCITY SOCIAL CLUB INC. v COALCITY SOCIAL CLUB, DALLAS FORT WORTH, ERIC UMEH, ET AL.*, In the United States District Court of the Northern District of Texas, Dallas, Division (“Pending Action”.) However, the essence and main issue of this case is the extent to which Petitioner is allowed to use the generic wording “COAL CITY” apart from the use of Respondents’ use of the mark. In Respondent’s prayer for relief in the cited case above, they ask that the Petitioner “*be permanently enjoined and*

restrained from using the COALCITY SOCIAL CLUB Marks and any other mark or name confusingly similar to ... COALCITY SOCIAL CLUB". Respondent is requesting a blanket ban, a copyright like ownership over the wording "COAL CITY" or "COAL CITY SOCIAL CLUB". The implication in their request is that the Petitioners' never file a trademark with the wording containing "COAL CITY." During examination of the Respondent's mark, the wording part of the literal mark of "SOCIAL CLUB" was already required by the trademark office to be disclaimed as a unitary composite because these words are read together as a single unit. Respondent's prayer for relief would also infringe Petitioner's 1st amendment right to free speech to talk with and associate through other coal city clubs with their lifelong COAL CITY friends and associates. Granted, the 1st amendment issue would be in the District Court's realm. However, and casually connected, Petitioners have also filed two additional trademarks with similar names in different services categories with the wording "COAL CITY." Here, the TTAB is in the best position to determine which marks in which services areas are allowable and which are not. Petitioner has filed COAL CITY INTERNATIONAL CLUB in separate categories. If the district court granted Respondent's Prayer request, that would mean Petitioner would not be allowed to use the wording "COAL CITY" in any mark category even if the Trademark Office would allow it. This is a trademark question for the TTAB to resolve. Further, if the TTAB finds Petitioner's reasons for Respondent's mark to be cancelled through genericness, as there are other documented instances of other past and present COAL CITY clubs, there would be conflicting orders.

2). Petitioner agrees with Respondents in their answer that Petitioners were former members of Respondent's Club. However, rather than the Petitioners voluntary

leaving the club as asserted, they remained associated and linked with the Club but wished to form an additional Club with different goals and service categories offered. Petitioners asserts that Respondent's attorney was also a member of the same club having confidential knowledge of the Petitioners during joint ownership of the mark requested to be cancelled.

3). Respondent has threatened that they intent to oppose (litigate against) Petitioners' other filed marks 97156922 and 97157630. For judicial efficiency, it would be beneficial if the TTAB could simultaneously decide these trademark applications as well. The examination of these two marks is of issue for the cited Federal case above.

4). Petitioner denies Respondent's claim that Petitioner does not contest the ownership of the mark. Petitioner does claim ownership of the mark as they formed and applied for the mark was a club unit.

WHEREFORE, Petitioners, COALCITY SOCIAL CLUB INC. DALLAS-FORTH WORTH (DFW), COAL CITY INTERNATIONAL CLUB, respectfully request that suspension of this case be denied.

Dated: February 16, 2022.

Respectfully submitted,

BAKER LAW FIRM

/ s / John G Baker

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CERTIFICATE OF SERVICE

I certify that the foregoing document was electronically submitted to all counsel of record electronically on 2/16/22

/s/ John Gregory Baker

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