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

Proceeding	91193207
Party	Plaintiff Kentucky Distillers' Association
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Submission	Motion to Suspend for Civil Action
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

KENTUCKY DISTILLERS' ASSOCIATION,

 Opposer,

 v.

SAZERAC COMPANY, INC.,

 Applicant.

SAZERAC COMPANY, INC.,

 Counterclaimant,

 v.

KENTUCKY DISTILLERS' ASSOCIATION,

 Counter-Defendant.

KENTUCKY DISTILLERS' ASSOCIATION,

 Opposer,

 v.

SAZERAC COMPANY, INC.,

 Applicant.

**CONSOLIDATED
PROCEEDINGS UNDER**

Parent Opposition 91193207

- Opposition No. 91193207 (parent)
- with Opposition No. 91193209
- Opposition No. 91193210
- Opposition No. 91193212
- Opposition No. 91193680

- Opposition No. 91194466
- Opposition No. 91194467
- Opposition No. 91194468
- Opposition No. 91194469

Commissioner for Trademarks
Trademark Trial and Appeal Board
P. O. Box 1451
Alexandria, VA 22313-1451



**KENTUCKY DISTILLERS' ASSOCIATION'S MOTION
TO SUSPEND FOR CIVIL ACTION**

Pursuant to 37 C.F.R. §2.117(a) AND TBMP 510.02(a), Opposer/Counter-Defendant/Applicant, Kentucky Distillers' Association ("KDA") by and through its undersigned counsel respectfully requests the Trademark Trial and Appeal Board ("TTAB") to suspend the opposition and cancellation proceedings, Consolidated Proceedings under Parent Opposition 91193207, Opposition Proceeding Nos. 91194466, 91194467, 91194468 and 91194469 and Counterclaims for Cancellation in this matter, wherein the parties are engaged in a civil action that will have a bearing on the issues before the TTAB. The KDA also requests the TTAB suspend the opposition and cancellation proceedings as listed above until the final termination of the civil action, which includes any resolution of any appeal.

The suspension of the opposition and cancellation proceedings pending resolution of the civil action is appropriate under 37 C.F.R. §2.117(a) which provides:

[w]henver it shall come to the attention of the Trademark Trial and Appeal Board that a party or parties to a pending case are engaged in a civil action or another Board proceeding which may have bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceedings.

Pursuant to this provision, "[o]rdinarily, 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." TBMP 510.02(a).

In further support of its Motion, the KDA states as follows:

1. The KDA owns numerous federal trademark registrations in the mark “KENTUCKY BOURBON TRAIL®” including “KENTUCKY BOURBON TRAIL®” with design, U.S. Trademark Registration No. 2,584,119, “KENTUCKY BOURBON TRAIL®”, U.S. Trademark Registration No. 3,556,684, “KENTUCKY BOURBON TRAIL®” with design, U.S. Trademark Registration No. 3,556,715 and “KENTUCKY BOURBON TRAIL®”, U.S. Trademark Registration No. 3,710,981 (collectively with U.S. Trademark Application Serial No. 77/649,426 referred as to “BOURBON TRAIL Marks”).

2. The KDA is also the owner of U.S. Trademark Application Serial No. 77/649,426 filed on January 14, 2009 under Trademark Act Section 1(b), 15 U.S.C. § 1051(b) for the mark “KENTUCKY BOURBON TRAIL” (collectively with U. S. Trademark Registration No. 2,584,119, U.S. Trademark Registration No. 3,556,684, U.S. Trademark Registration No. 3,556,715, and U.S. Trademark Registration No. 3,710,981 referred to as “BOURBON TRAIL Marks”).

3. On December 30, 2009, the KDA filed Notices of Opposition against Sazerac’s applications to register the mark “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design including “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design, U. S. Trademark Application Serial No. 77/801,630, “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design, U.S. Trademark Application Serial No. 77/801,708, “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design, U. S. Trademark Application Serial No. 77/801,615, and “BUFFALO TRACE DISTILLERY ON THE BOURBON

TRAIL” with design, U. S. Trademark Application Serial No. 77/801,608. The KDA asserts in its Notices of Opposition that the registration of the marks “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design as identified above should be refused based on various grounds including, likelihood of confusion between the marks “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” and the KDA’s “BOURBON TRAIL Marks” and dilution of the KDA’s “BOURBON TRAIL Marks”. *See Opposition Proceedings Nos. 91193207, 91193209, 91193210 and 91193212.*

4. On February 4, 2010, Sazerac filed its Answers to the KDA’s Notices of Opposition against Sazerac’s applications to register the mark “BUFFALO TRACE DISTILLERY ON THE BOURBON TRAIL” with design and with its Answers filed Counterclaims for Cancellation seeking to cancel the KDA’s federal registered trademarks in the mark “KENTUCKY BOURBON TRAIL®” on various grounds including, alleged genericness of the KDA’s KENTUCKY BOURBON TRAIL® marks, alleged descriptiveness of the KDA’s KENTUCKY BOURBON TRAIL® marks, and alleged fraud on the United States Patent and Trademark Office. The KDA denies any and all allegations as set forth in Sazerac’s Answers and Counterclaims for Cancellation.

5. On February 4, 2010, Sazerac filed a Notice of Opposition against the KDA’s application to register the mark “KENTUCKY BOURBON TRIAL” with design, U.S. Trademark Application Serial No. 77/649,426 seeking refusal of the KDA’s application for registration on various grounds including, alleged genericness of the KDA’s mark, “KENTUCKY BOURBON TRIAL” with design and alleged

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