

**IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF KENTUCKY
LOUISVILLE DIVISION**

THE PARK NATIONAL BANK,)	
)	
)	
)	
Plaintiff,)	
)	
v.)	CV <u>3:19-CV-84-DJH</u>
)	
PARK COMMUNITY CREDIT UNION,)	
INC.)	
)	
Defendant.)	

**COMPLAINT FOR DECLARATORY JUDGMENT
AND INJUNCTIVE RELIEF**

Plaintiff The Park National Bank (“Park National Bank”), for its causes of action against Defendant Park Community Credit Union, Inc. (“Park Community Credit Union”) alleges as follows:

I. INTRODUCTION

1. In this case, Park National Bank seeks protection against a threat of trademark litigation by Park Community Credit Union. Park Community Credit Union seeks to prevent Park National Bank from using its tradename “PARK NATIONAL BANK,” or any other name starting with “PARK,” in Kentucky and Southern Indiana, despite Park National Bank’s use of its tradename in Kentucky since at least 2004. Park Community Credit Union has warned Park National Bank in writing of Park Community Credit Union’s allegations that Park National Bank is infringing Park Community Credit Union’s alleged trademarks in: “PARK”; “PARK COMMUNITY”; and “PARK COMMUNITY (and design)”. Park Community Credit Union threatened to sue Park

National Bank regarding such, despite the parties' coexistence, the lack of likelihood of confusion, and Park Community Credit Union's lack of exclusive rights to use of the term "Park" by itself.

Therefore, this Court should enter a judgement that Park National Bank does not and will not infringe any of Park Community Credit Union's marks and that Park Community Credit Union does not have any exclusive rights to use of the term "Park" by itself.

II. JURISDICTION

2. This Court has subject matter jurisdiction under 15 U.S.C. §§ 1121, 1125 as well as 28 U.S.C. §§ 1331, 1338, 1367 involving claims arising under laws of the United States, including potential claims and an actual controversy arising under the Lanham Act wherein all claims are so related to the claims within the Court's jurisdiction that they form part of the same case or controversy. Additionally, this Court has subject matter jurisdiction pursuant to 28 U.S.C. § 1332(a)(1) based on diversity of the parties and an amount in controversy over seventy-five thousand dollars (\$75,000).

3. This Court has personal jurisdiction over Park Community Credit Union because its principal place of business is located in Louisville, Kentucky, which is located in the Western District of Kentucky.

III. VENUE

4. Venue is proper in this action pursuant to 28 U.S.C. § 1391 in that Park Community Credit Union's principal place of business is in Louisville, Jefferson County, Kentucky.

5. A substantial part of the events or omissions giving rise to the claim occurred in the Louisville Division of this Court.

IV. PARTIES

6. Plaintiff Park National Bank is a federally chartered national banking association organized and existing under the laws of the United States, with its principal place of business located at 50 N. Third Street, Newark, Licking County, Ohio 43055. Park National Bank owns and operates under several trade names and marks, including Park National Bank and The Park National Bank of Southwest Ohio & Northern Kentucky. Park National Bank is in the banking and financial services industry.

7. Upon information and belief, Park Community Credit Union, Inc. is a corporation organized and existing under the laws of the Commonwealth of Kentucky, having an office and principal place of business at 2515 Blankenbaker Pkwy, Louisville, Jefferson County, Kentucky 40299. The entity was incorporated as a non-profit organization under Kentucky law on or about November 7, 2013. Park Community Credit Union, Inc. operates under the assumed name "Park Community Credit Union" in Kentucky.

V. FACTS

8. Park National Bank has provided banking and financial services to consumers since 1908, originally as The Park National Bank of Newark, and since 1971 as The Park National Bank. It provides those services in several states, including Ohio, Kentucky, and North Carolina and

operates 112 banking offices with an estimated asset value of \$7.5 billion. Park National Bank has used the word “Park” and the mark “PARK NATIONAL BANK” extensively in connection with its banking and financial services and in interstate commerce.

9. Park National Bank has had customers in Kentucky for more than a decade with more than 250 customers in Kentucky in 2004. Park National Bank operated a branch in northern Kentucky under the trade name “The Park National Bank of Southwest Ohio & Northern Kentucky” from 2006 through September 2014 and used the “PARK NATIONAL BANK” mark. That branch was located in Florence, Kentucky and was opened to serve some of Park National Bank’s Kentucky customers. Prior to opening this branch, Park National Bank had been doing business in three counties in Kentucky (Boone, Campbell, and Kenton) since at least 1995.

10. Currently, Park National Bank has more than 5,000 active accounts tied directly to a Kentucky address. More than 675 of those accounts are tied to addresses in the Louisville area, representing nearly \$100 million in initial deposits and loan value. In total, Park National Bank maintains more than \$1.2 billion in initial deposits and loan value in accounts associated with Kentucky addresses.

11. Park National Bank has had customers in Kentucky and has operated alongside Park Community Credit Union in Kentucky without any likelihood of confusion for years.

12. Upon further information and belief, Park Community Credit Union is also in the financial and banking services industry and provides services in Kentucky and Southern Indiana.

13. The “Park” in Park Community Credit Union is merely descriptive of the geographical area that it serves. Park Community Credit Union advises its customers and prospective customers that it “was established in 1965 to serve the employees of General Electric’s Appliance Park in Louisville, Kentucky, hence the name ‘Park’ Community Credit Union.” *See About Us*, Park

Community Credit Union, <https://parkcommunity.com/about-us/> (last visited Feb. 1, 2019, 12:24 p.m.) (emphasis added). A true and correct copy of Park Community Credit Union's "About Us" website page is attached hereto as Exhibit 1.

14. Upon information and belief, Park Community Credit Union did not disclose to the United States Patent and Trademark Office that the word "Park" in its name was descriptive of its location as outlined by paragraph 12.

15. Park Community Credit Union is the owner of U.S. Trademark Registration No. 4,249,689 for the mark "PARK COMMUNITY (and design)" for "banking and financing services; credit union services." The mark is described as "consist[ing] of two crescent shapes facing opposite directions and one positioned slightly higher than the other to the left of the word 'PARK' positioned over the word 'COMMUNITY' in smaller font." The application for registration was filed on April 3, 2012 and registered on November 27, 2012. The claimed date of first use in commerce is January 1, 2004. A true and correct copy of Park Community Credit Union's Certificate of Registration is attached hereto as Exhibit 2.

16. Numerous entities in the banking industry use the word "Park" and have coexisted. For example, the United States Patent and Trademark Office registered the following marks: (i) "PARK BANK (and design)", Registration No. 2,314,413; (ii) "PARK24", Registration No. 2,569,286; (iii) "PARK VIEW", Registration No. 3,034,015; (iv) "PARK VIEW ONLINE", Registration No. 4,248,830; (v) "PARK STERLING BANK", Registration No. 3,886,365; (vi) "ROGERS PARK COMMUNITY BANK", Registration No. 4,081,489 (almost identical to Park Community); (vii) "PARKSIDE FINANCIAL BANK & TRUST", Registration No. 4,378,436; (viii) "ePARK", Registration No. 5,092,065; (ix) "PARK LANE", Registration No. 5,329,927, (x)

“PARKCITYHUB.COM”, Registration No. 5,183,510; and (xi) “PARK HILL”, Registration No. 5,240,269. True and correct copies of the Certificates of Registration are attached as Exhibit 3.

17. A registration granted by the United States Patent and Trademark Office gives national trademark rights.

18. The United States Patent and Trademark Office examines all trademark applications for a likelihood of confusion prior to granting a registration.

19. The United States Patent and Trademark Office also publishes allowed applications, allowing anyone who thinks they may be harmed to oppose the registration.

20. The United States Patent and Trademark Office did not find a likelihood of confusion between “PARK COMMUNITY (and design)” and any of: “PARK BANK (and design)”, “PARK24”, “PARK VIEW”, “PARK VIEW ONLINE”, “PARK STERLING BANK”, “ROGERS PARK COMMUNITY BANK”, “PARKSIDE FINANCIAL BANK & TRUST”, “ePARK”, “PARK LANE”, “PARKCITYHUB.COM”, and “PARK HILL”.

21. Additionally, the United States Patent and Trademark Office did not find a likelihood of confusion amongst any of the aforementioned marks. Those marks, therefore, are distinguishable from each other by the public.

22. Park Community Credit Union did not oppose any of the above applications for registration at the United States Patent and Trademark Office.

23. Park Community Credit Union’s rights are limited to “PARK COMMUNITY CREDIT UNION” and “PARK COMMUNITY (and design).”

24. Park National Bank has used the word “Park” in conjunction with its banking and finance services in Ohio and Kentucky since at least 1995. In 2012, the same year that Park Community

Credit Union registered its “PARK COMMUNITY (and design)” mark, Park National Bank’s initial deposits and loan value in Kentucky exceeded \$230 million.

25. On or about December 7, 2018, Park Community Credit Union sent Park National Bank a Cease and Desist Letter (“First C&D Letter”) dated December 7, 2018 requesting that Park National Bank discontinue any use of the tradename or mark “PARK NATIONAL BANK,” or any mark beginning with the word “Park” in Kentucky and Southern Indiana, as Park Community Credit Union claimed such use harmed Park Community Credit Union.

26. Park Community Credit Union also stated that during a Greater Louisville Inc. chamber of commerce meeting, a Greater Louisville Inc. representative discussed helping “Park” with selecting its location, and clearly advised the audience that there were two separate Park institutions by saying “that Park, not this Park.” *Id.* Despite Park Community Credit Union’s assertion that this incident demonstrates actual confusion, this evidence demonstrates no likelihood of confusion, as the representative recognized that Park Community Credit Union and Park National Bank are two separate entities.

27. Park National Bank responded to Park Community Credit Union’s First C&D Letter in a letter dated December 19, 2018 advising that Park National Bank has not infringed on any marks requested by Park Community Credit Union and there is no confusion between the two. Park National Bank pointed out that the registered trademark did not give Park Community Credit Union exclusive use of the word “Park” and that Park National Bank’s use of a similar phrase was not an infringement of Park Community Credit Union’s mark.

28. Additionally, Park National Bank demonstrated that there was no likelihood of confusion and questioned the validity and strength of any trademark held by Park Community Credit Union, given the co-existence of a similarly named *Rogers Park Community Bank*, which was registered

with the United States Patent and Trademark Office from October 12, 2011 through August 10, 2018 under registration number 4,081,489.

29. Additionally, the letter advised Park Community Credit Union that Park National Bank had been conducting business in Kentucky since at least 1995 and had a branch in Kentucky starting in 2006, which was not known to have caused any confusion with Park Community Credit Union. The letter requested that Park Community Credit Union provide any evidence of confusion to Park National Bank's counsel.

30. Park Community Credit Union's counsel sent Park National Bank a second cease and desist letter ("Second C&D Letter") dated January 11, 2019 that advised that the branch office Park National Bank intended to open in Louisville in 2019 was located more than half a mile away from the nearest branch of Park Community Credit Union's closest branch. The letter threatened that Park National Bank's continued use of "PARK NATIONAL BANK" in Louisville will be considered willful infringement of [Park Community Credit Union's] exclusive federal and common law rights and will be addressed accordingly" and that "continued use of the mark . . . in Louisville is unacceptable."

31. Park Community Credit Union's Second C&D Letter also advised that Park National Bank's offering of financial services "has already caused consumer confusion and will continue to cause confusion." The Second C&D Letter did not provide any details related to such claims, including the nature of the confusion, who was confused, or where the confusion occurred. *See id.*

32. To date, Park Community Credit Union has not provided Park National Bank's counsel with any examples or evidence of actual confusion between the two entities, despite Park Community Credit Union's claims, Park National Bank having operated a branch in Kentucky from 2006 to 2014, and Park National Bank having numerous customers in Louisville, Kentucky.

33. Park Community Credit Union continues to insist that Park National Bank cease any use of the word “Park” and has threatened litigation to address Park National Bank’s use of such, which would be to Park National Bank’s detriment.

COUNT I
DECLARATORY JUDGMENT AS TO “PARK”

34. Park National Bank incorporates by reference each and every allegation contained in paragraphs 1-33 as if fully rewritten herein.

35. Park Community Credit Union has not registered the word “Park” as a mark with the United States Patent and Trademark Office.

36. Upon information and belief, Park Community Credit Union does not use the word “Park” as a mark in advertising, and instead only uses the word “Park” as part of the marks “PARK COMMUNITY (and design)” or “PARK COMMUNITY CREDIT UNION.”

37. There exists in interstate commerce extensive third-party use of the word “Park” in the financial and banking industry as well as in other industries.

38. According to the National Credit Union Association’s (“NCUA”) website, 111 credit unions’ names contain or contained the word “Park.” *See Research a Credit Union*, NCUA, <https://mapping.ncua.gov/researchcreditunion.aspx> (last visited Feb. 1, 2019, 12:58 a.m.) (search term “park”). A true and correct copy of the search results for the word “park” on the NCUA’s website page is attached hereto as Exhibit 4.

39. Additionally, four other credit unions contain or contained the words “Park” and “Community” other than Park Community Credit Union. *See Research a Credit Union*, NCUA,

<https://mapping.ncua.gov/>

researchcreditunion.aspx (last visited Feb. 1, 2019, 12:58 a.m.) (search term employed was “park community”). A true and correct copy of the search results for “park community” on the NCUA’s website page is attached hereto as Exhibit 5.

40. Moreover, according to the Federal Deposit Insurance Corporation’s (“FDIC”) website, 334 FDIC insured banks include or included the word “Park” in their names. *See BankFind Search Results*, FDIC <https://research.fdic.gov/bankfind/results.html?name=park&fdic=&address=&city=&state=&zip=&bankUrl=> (last visited Feb. 1, 2019, 1:02 p.m.). A true and correct copy of the search results for the word “park” on the FDIC’s website page is attached hereto as Exhibit 6.

41. Consumers are not likely to, and do not, associate the descriptive term “Park” with a single source or business, including Park Community Credit Union.

42. The term “Park” is widely recognized as a common word in the American lexicon, especially as it relates to location name.

43. Park National Bank’s use of its “PARK NATIONAL BANK” mark in advertisements and marketing is unlikely to cause confusion with respect to Park Community Credit Union, any of its outlets, services and/or business.

44. The term “Park” is and has been used on almost all of Park National Bank’s signage, advertisements, marketing pieces, and website materials along with other trade names and service marks owned by Park National Bank, including in Kentucky. Any order preventing Park National Bank’s continued use of the word “Park” in any part of Kentucky would cause significant financial harm and entangle many of Park National Bank’s other non-infringing products and services. This

includes any attempt to prevent Park National Bank from opening a branch in Louisville, Kentucky.

45. Over many years of overlapping use, Park Community Credit Union has provided no evidence of actual confusion or that there is a likelihood of confusion between Park National Bank and Park Community Credit Union, its outlets, services and/or business, or vice versa. To the contrary, Park Community Credit Union advised of one scenario where a chamber of commerce representative publicly identified the two as different entities co-existing in Louisville.

46. Park National Bank's use of its mark "PARK NATIONAL BANK" will not lead the public to conclude, incorrectly, that its services originate with or are authorized by Park Community Credit Union in such manner as to cause damage to either Park Community Credit Union or the public. Park National Bank's use of "PARK NATIONAL BANK" is not confusingly similar with Park Community Credit Union's use of the word "Park".

47. Park Community Credit Union's claim that Park National Bank is violating Park Community Credit Union's legal rights irreparably injures Park National Bank and adversely affects Park National Bank's business and large investment in its own mark and attendant goodwill that took years and great expense to establish. Park Community Credit Union's assertions will continue to adversely affect Park National Bank's business unless prevented by this Court.

48. Park Community Credit Union has made clear that it believes its trademarks are currently being infringed by Park National Bank's use of the tradename and/or mark "PARK NATIONAL BANK", and Park National Bank denies any wrongdoing. This dispute is substantial, definite, immediate, and not hypothetical.

49. Park Community Credit Union does not have any exclusive rights to use of the word "Park" in any geographical area.

50. Park National Bank's use of the tradename or mark "PARK NATIONAL BANK" does not violate any rights Park Community Credit Union may have pursuant to 15 U.S.C. § 1125(a), 15 U.S.C. § 1125(c), or common law.

51. In order to resolve the legal and factual questions raised by Park Community Credit Union and to afford relief from any uncertainty and controversy which Park Community Credit Union's assertions have created, Park National Bank is entitled to a declaratory judgment of its rights under the Declaratory Judgment Act.

COUNT II
DECLARATORY JUDGMENT AS TO "PARK COMMUNITY"

52. Park National Bank incorporates by reference each and every allegation contained in paragraphs 1-51 as if fully rewritten herein.

53. Park National Bank's use of "PARK NATIONAL BANK" is not confusingly similar to Park Community Credit Union's use of the mark "PARK COMMUNITY" and does not mislead consumers into believing that Park National Bank's services originate with or are authorized by Park Community Credit Union.

54. Park National Bank's use of its mark "PARK NATIONAL BANK" will not lead the public to conclude, incorrectly, that its services originate with or are authorized by Park Community Credit Union in such manner as to cause damage to either Park Community Credit Union or the public.

55. Over many years of overlapping use, Park Community Credit Union has provided no evidence of actual confusion or that there is a likelihood of confusion between "PARK NATIONAL BANK" and "PARK COMMUNITY".

56. There is no likelihood of confusion between the marks "PARK COMMUNITY" and "PARK NATIONAL BANK".

57. Park Community Credit Union's claim that Park National Bank is violating Park Community Credit Union's legal rights irreparably injures Park National Bank and adversely affects Park National Bank's business and large investment in its own mark and attendant goodwill that took years and great expense to establish. Park Community Credit Union's assertions will continue to adversely affect Park National Bank's business unless prevented by this Court.

58. Park Community Credit Union has made clear that it believes its "PARK COMMUNITY" mark is currently being infringed by Park National Bank's use of the tradename and/or mark "PARK NATIONAL BANK", and Park National Bank denies any wrongdoing. This dispute is substantial, definite, immediate, and not hypothetical.

59. Park National Bank's use of the mark "PARK NATIONAL BANK" does not violate any rights Park Community Credit Union may have in the mark "PARK COMMUNITY" pursuant to 15 U.S.C. § 1125(a), 15 U.S.C. § 1125(c), or common law.

60. In order to resolve the legal and factual questions raised by Park Community Credit Union and to afford relief from any uncertainty and controversy which Park Community Credit Union's assertions have created, Park National Bank is entitled to a declaratory judgment of its rights under the Declaratory Judgment Act.

COUNT III - DECLARATORY JUDGMENT AS TO "PARK COMMUNITY (AND DESIGN)"

61. Park National Bank incorporates by reference each and every allegation contained in paragraphs 1-60 as if fully rewritten herein.

62. Park Community Credit Union's registered "PARK COMMUNITY (and design)" mark, shown below, "consists of two crescent shapes facing opposite directions and one positioned

slightly higher than the other to the left of the word ‘PARK’ positioned over the word ‘COMMUNITY’ in smaller font.” *See* Exhibit 2.



63. When used as a logo, shown below, Park National Bank’s use of the mark “PARK NATIONAL BANK” does not include any crescent shapes, and uses a different font than the font used in Park Community Credit Union’s “PARK COMMUNITY (and design)” mark



64. Park National Bank’s use of its “PARK NATIONAL BANK” mark is not confusingly similar to Park Community Credit Union’s “PARK COMMUNITY (and design)” mark and does not mislead consumers into believing that Park National Bank’s services originate with or are authorized by Park Community Credit Union.

65. Park National Bank’s use of its mark “PARK NATIONAL BANK” will not lead the public to conclude, incorrectly, that its services originate with or are authorized by Park Community Credit Union in such manner as to cause damage to either Park Community Credit Union or the public.

66. Over many years of overlapping use, Park Community has provided no evidence of actual confusion or that there is a likelihood of confusion between “PARK NATIONAL BANK” and “PARK COMMUNITY (and design).”

67. There is no likelihood of confusion between the “PARK NATIONAL BANK” and “PARK COMMUNITY (and design).”

68. Park Community Credit Union’s claim that Park National Bank is violating Park Community Credit Union’s legal rights irreparably injures Park National Bank and adversely affects Park National Bank’s business and large investment in its own mark and attendant goodwill that took years and great expense to establish. Park Community Credit Union’s assertions will continue to adversely affect Park National Bank’s business unless prevented by this Court.

69. Park Community Credit Union has made clear that it believes its “PARK COMMUNITY (and design)” trademark is currently being infringed by Park National Bank’s use of the mark “PARK NATIONAL BANK”, and Park National Bank denies any wrongdoing. This dispute is substantial, definite, immediate, and not hypothetical.

70. Park National Bank’s use of its “PARK NATIONAL BANK” mark does not violate any rights Park Community Credit Union may have in the mark “PARK COMMUNITY (and design)” pursuant to 15 U.S.C. § 1114(1), 15 U.S.C. § 1125(a), 15 U.S.C. § 1125(c), or common law.

71. In order to resolve the legal and factual questions raised by Park Community Credit Union and to afford relief from any uncertainty and controversy which Park Community Credit Union’s assertions have created, Park National Bank is entitled to a declaratory judgment of its rights under the Declaratory Judgment Act.

VI. RELIEF REQUESTED

Park National Bank requests that this Court enter judgment in favor of Park National Bank declaring:

72. Park National Bank's use of the mark "PARK NATIONAL BANK" does not and will not violate Park Community Credit Union's rights under 15 U.S.C. § 1114, 15 U.S.C. § 1125, common law, or any other law.

73. Park Community Credit Union does not have any exclusive rights to use of the word "Park."

74. Park Community Credit Union is barred by laches, acquiescence, failure to police and estoppel from asserting any likelihood of confusion between its marks and Park National Bank's use of the word "Park," or Park National Bank's use of the mark "PARK NATIONAL BANK."

75. There is no likelihood of confusion between Park National Bank's "PARK NATIONAL BANK" mark and Park Community Credit Union's use of the word "Park".

76. There is no likelihood of confusion between Park National Bank's "PARK NATIONAL BANK" mark and Park Community Credit Union's mark "PARK COMMUNITY".

77. There is no likelihood of confusion between Park National Bank's "PARK NATIONAL BANK" mark and Park Community Credit Union's mark "PARK COMMUNITY (and design)".

78. Park Community Credit Union and each of its agents, employees, officers, attorneys, successors, assigns, affiliates and any persons in privity or active concert or participation with any of them are permanently enjoined and restrained from interfering with Park National Bank's use of the "PARK NATIONAL BANK" mark in interstate commerce.

79. Park National Bank be granted such other, further relief as the Court determines is just.

Respectfully submitted this the 1st day of February, 2019.

/s/ J.B. Lind

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