

From: Gartner, John

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Subject: U.S. TRADEMARK APPLICATION NO. 86575127 - AMERICAN NATIONAL BANK OF TEXAS - 19123-K004US - Request for Reconsideration Denied - Return to TTAB

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**UNITED STATES PATENT AND TRADEMARK OFFICE (USPTO)
OFFICE ACTION (OFFICIAL LETTER) ABOUT APPLICANT'S TRADEMARK APPLICATION**

U.S. APPLICATION SERIAL NO. 86575127

MARK: AMERICAN NATIONAL BANK OF TEXAS



CORRESPONDENT ADDRESS:

LEKHA GOPALAKRISHNAN

WINSTEAD PC

PO Box 131851

DALLAS, TX 75313-1851

GENERAL TRADEMARK INFORMATION:

<http://www.uspto.gov/trademarks/index.jsp>

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APPLICANT: The American National Bank of Texas

CORRESPONDENT'S REFERENCE/DOCKET NO:

19123-K004US

CORRESPONDENT E-MAIL ADDRESS:

lgopalakrishnan@winstead.com

REQUEST FOR RECONSIDERATION DENIED

ISSUE/MAILING DATE: 8/26/2016

The trademark examining attorney has carefully reviewed applicant's request for reconsideration and is denying the request for the reasons stated below. *See* 37 C.F.R. §2.63(b)(3); TMEP §§715.03(a)(ii)(B), 715.04(a). The Section 2(d) refusal made final in the Office action dated January 18, 2016 is maintained and continue to be final. *See* TMEP §§715.03(a)(ii)(B), 715.04(a).

In the present case, applicant's request has not resolved the outstanding issue, nor does it raise a new issue or provide any new or compelling evidence with regard to the outstanding issue in the final Office

action. In addition, applicant's analysis and arguments are not persuasive nor do they shed new light on the issues. Accordingly, the request is denied.

In its request for reconsideration, applicant argues that "a likelihood of confusion analysis should take into account the realities of the relevant marketplace in which trademarks are used and encountered by customers in the ordinary course of business or commerce."

The difficulty with this argument is that it suggests that the examining attorney should exercise discretion that, in fact, the examining attorney does not possess.

For instance, applicant points out the marketplace reality that "out of a total of 65 locations, there are only 2 cities in the State of Texas where both Applicant and Registrant have a location, namely, Dallas and McKinney. Thus, in terms of actual business locations and trademark use in commerce, the subject marks do not coexist in most places and there is relatively little overlap in the service areas."

Although the examining attorney does not doubt that this is true, the examining attorney is unable to consider this fact in a likelihood of confusion analysis. Registrant possesses, and applicant seeks, a geographically unrestricted registration. The owner of a registration without specified limitations enjoys a presumption of exclusive right to nationwide use of the registered mark under Trademark Act Section 7(b), 15 U.S.C. §1057(b), regardless of its actual extent of use. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 1568, 218 USPQ 390, 393 (Fed. Cir. 1983). Therefore, the geographical extent of applicant's and registrant's activities is not relevant to a likelihood of confusion determination.

Similarly, applicant points out the marketplace reality that "Registrant has announced publicly that it is merging with and into First United Bank based in Oklahoma" and that "upon completion of the merger the Registrant will no longer use or own the Cited Mark because it will no longer render services under the name or mark, American Bank of Texas."

Again, the examining attorney does not doubt that this is true. However, a trademark registration on the Principal Register is prima facie evidence of the validity of the registration and the registrant's exclusive right to use the mark in commerce in connection with the specified goods or services. See 15 U.S.C. §1057(b); TMEP §1207.01(d)(iv). Therefore, evidence and arguments that constitute a collateral attack on a cited registration, such as information or statements regarding a registrant's nonuse of its mark, are not relevant during ex parte prosecution. See *In re Dixie Rests.*, 105 F.3d 1405, 1408, 41 USPQ2d 1531, 1534-35 (Fed. Cir. 1997); *In re Peebles Inc.*, 23 USPQ2d 1795, 1797 n.5 (TTAB 1992); TMEP §1207.01(d)(iv). Such evidence and arguments may, however, be pertinent to a formal proceeding before the Trademark Trial and Appeal Board to cancel the cited registration.

Applicant argues that “a Google® search for the Cited Mark AMERICAN BANK OF TEXAS brings up the Registrant (and not Applicant) in the top search results” while “a Google® search for Applicant’s mark AMERICAN NATIONAL BANK OF TEXAS brings up the Applicant (and not Registrant) in the top search results . . .” Applicant concludes that this demonstrates that “its mark and the Cited Mark appear to peacefully coexist in e-commerce without confusion among consumers with respect to online identification of the Registrant and Applicant as the sources of their respective services.”

A search of the respective marks on Google yields different results because the literal portions of the marks are not identical. This has already been established. The issue is not whether or not the marks are identical when subjected to a side-by-side analysis (or, in this case, a side-by-side search on Google), but whether or not the marks create the same overall commercial impression which, in this case, they do.

As applicant has already filed a timely notice of appeal with the Trademark Trial and Appeal Board, the Board will be notified to resume the appeal. See TMEP §715.04(a).

/John M. Gartner/

Trademark Examining Attorney

Law Office 102

(571) 272-9255

john.gartner@uspto.gov (informal correspondence)