

ESTTA Tracking number: **ESTTA482518**

Filing date: **07/10/2012**

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

Proceeding	92055735
Party	Defendant American National Insurance Company
Correspondence Address	AMERICAN NATIONAL INSURANCE COMPANY ONE MOODY PLAZA GALVESTON, TX 77550 UNITED STATES
Submission	Motion to Suspend for Civil Action
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Date	07/10/2012
Attachments	Registrants Mtn to Suspend Or To Dismiss Proceeding.pdf (33 pages) (1584324 bytes)

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

In the Matter of Petition for Cancellation of Registration No. 1837021
Mark: AMERICAN NATIONAL

AMERICAN NATIONAL INVESTMENT
ADVISORS, LLC

Petitioner,

v.
AMERICAN NATIONAL INSURANCE
COMPANY,

Cancellation No. 92055735

Registrant

**REGISTRANT’S MOTION TO SUSPEND OR
TO DISMISS PROCEEDING**

Registrant American National Insurance Company (“Registrant”) files this Motion to Suspend or to Dismiss Petitioner American National Investment Advisors, LLC’s (“Petitioner”) Petition for Cancellation of the mark “American National”. Petitioner seeks to cancel the use of the mark solely limited to the mark’s use with regard to “mutual fund investment services”. Registrant has continually used the mark since 1905 with regard to financial and insurance products. Petitioner alleges that Registrant filed false statements with the U.S. Patent and Trademark Office (“PTO”) in support of Registrant’s proofs of continued use filed in 2000 and 2004. Although the allegations by Petitioner are wholly without merit, Registrant seeks to dismiss or alternatively to suspend this proceeding because Petitioner and Registrant are already involved in a proceeding in the U.S. District Court, Northern District of Illinois, Eastern Division wherein the core issues involve the Petitioner’s use of the mark, likelihood of confusion arising from the use and request for injunctive relief. Petitioner has an affirmative defense based on

allegations of misrepresentations by the Registrant to the PTO in one of the registrations plead as a basis for infringement.

ARGUMENT

On June 13, 2011, Registrant filed a civil complaint in the United States District Court, Northern District of Illinois against Petitioner alleging infringement, unfair competition and dilution of the "American National" mark, as Petitioner owns and operates an investment advisory firm offering investment advice and financial planning. A copy of the Complaint in the civil action is attached hereto as Exhibit "1". In the civil action, Petitioner asserted various defenses to the Complaint and among Petitioner's allegations is that Registrant practiced a fraud on the PTO. A copy of Petitioner's answer to the Complaint in the civil action is attached hereto as Exhibit "2". Specifically, Petitioner alleges in the civil action:

(1) On May 15, 2000, as part of its obligation to file proof of continued use of the registered mark under Section 8 of the Trademark Act, Plaintiff submitted a "prospectus" dated May 1, 1999 supposedly from "American National Investment Accounts, Inc." This submission was supported by a May 2, 2000 affidavit of Michael W. McCroskey, Plaintiff's Executive Vice President. Mr. McCroskey knew, or should have known, that Plaintiff's investment service subsidiary had changed its name in 1998 to SM&R GROWTH FUND INC. Thus Plaintiff then no longer offered any such services in interstate commerce under the name and mark AMERICAN NATIONAL, and Mr. McCroskey's affidavit was therefore false, and was relied upon by the U.S. Patent and Trademark Office in allowing the registration to continue in force.

(2) On May 10, 2004, as part of its obligation to file proof of continued use of the registered mark as part of its application to renew the subject registration, Plaintiff submitted a May 7, 2004 example of an internet web page. On that web page, the words and mark AMERICAN NATIONAL nowhere appear as being the source of investment services. This submission was supported by the May 10, 2004 affidavit of Ronald J. Welch, Plaintiff's Senior Vice President. Mr. Welch knew, or should have known, that for at least three years Plaintiff had not offered any investment services in interstate commerce under the name and mark AMERICAN NATIONAL. Plaintiff then no longer offered any such services in interstate commerce under the name and mark AMERICAN

NATIONAL, and Mr. Welch's affidavit was therefore false, and was relied upon by the U.S. Patent and Trademark Office in renewing the registration.

Exhibit 2, Fifth Affirmative Defense, pages 11-12. These allegations are **identical** to the allegations made the basis of Petitioner's instant Board proceeding. *See* Petitioner's Statement of Grounds for Cancellation at paragraphs 4(a) and (b).

The rules clearly contemplate that Board proceedings can be suspended during the pendency of a civil action involving the same parties and the same issues. The rules provide:

Whenever 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 a bearing on the case, proceedings before the Board may be suspended until termination of the civil action or the other Board proceeding.

37 C.F.R. 2.117(a); Trademark Rule 2.117(a). Importantly, it is preferred that Board proceedings at least be suspended, and not vice versa, in order to allow civil matters to proceed-

Whenever it comes to the attention of the Board that a party or parties to a case pending before it are involved in a civil action which may have a bearing on the Board case, proceedings before the Board may be suspended until final determination of the civil action.

Most commonly, a request to suspend pending the outcome of another proceeding seeks suspension because of a civil action pending between the parties in a federal district court. To the extent that a civil action in a federal district court involves issues in common with those in a proceeding before the Board, the decision of the federal district court is often binding upon the Board, while the decision of the Board is not binding upon the court.

TBMP section 510.02(a). Thus, it would be a waste of valuable Board and party resources to duplicate the same efforts, especially when there is currently a December 7, 2012 trial date before the court in the civil matter. The civil court proceeding will determine the same factual allegations that form the basis of this Board proceeding as well as the legal consequences that follow and the civil court proceedings will be binding upon the Board. Thus, at the very least, the Board should suspend these proceedings pending the outcome of the civil proceeding. *See*

New Orleans Louisiana Saints LLC & NFL Props. LLC v. Who Dat?, Inc., 99 U.S.P.Q.2d 1550, 1552 (T.T.A.B. 2011) (“[T]he civil action does not have to be dispositive of the Board proceeding to warrant suspension, it need only have a bearing on the issues before the Board.”); accord 6 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 32:47 (4th ed. updated June 2011)(“It is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues.”).

However, the Board can, and should dismiss this proceeding as the Petitioner will lack standing, assuming that Registrant prevails in its infringement claims in the civil proceeding. In the *New Orleans Louisiana Saints* case the Board suspended the opposition proceeding pending the trademark infringement action brought by Applicant against Opposer in district court. *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d at 1552 (“The parties to this opposition are in reversed positions in a civil action pending in the District Court for the Eastern District of Louisiana (“*Who Dat? Inc. v. NFL Properties LLC, New Orleans Louisiana Saints LLC et al.*, Case No. 2:10-CV-02296-CJB-KWR”). There the complaint alleged, among other claims, trademark infringement of Applicant's WHO DAT mark, and sought to enjoin use of the term WHO DAT by all the defendants. The instant proceeding is just like the *New Orleans Louisiana Saints* case. In Registrant’s trademark infringement civil action against Petitioner, Registrant asserts that Petitioner’s use of the mark AMERICAN NATIONAL with its services infringes Registrant’s federally registered service marks and common law rights. The civil action has a bearing on the instant cancellation because it will determine if Petitioner indeed infringes Registrant’s mark and if any of the Petitioner’s defenses from infringement are valid. If the district court decides that Petitioner is infringing Applicant’s marks, it follows that Petitioner’s use of the mark AMERICAN NATIONAL with its services is

unlawful, and therefore Petitioner would not have “real interest” in this proceeding as it will be unable to establish that it is or will be damaged. *See McDermott v. San Francisco Women’s Motorcycle Contingent*, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006); 15 U.S.C.A. 1064 (“A petition to cancel a registration of a mark, stating the grounds relied upon, may, upon payment of the prescribed fee, be filed as follows by any person who believes that he is or will be damaged”). Thus, the opposition proceeding should be suspended until the outcome of the civil matter and thereafter dismissed, if Registrant is successful, due to Petitioner’s lack of standing.

CONCLUSION

As discussed above, because the service mark infringement action pending before the District Court for the Northern District of Illinois will have a significant, if not dispositive, effect, on the instant Board proceeding, Registrant requests that the Board suspend this cancellation proceeding or dismiss this proceeding and for such other and further relief to which it may be entitled.

Respectfully submitted,

Date: July 10, 2012

By: Margaret A. Boulware
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Attorneys for Registrant American National
Insurance Company

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the attached was served on the counsel for the Opposer on the dated listed below via first class U. S. Mail and U.S. Certified Mail, Return Receipt Requested, postage prepaid, on:

George E. Bullwinkel
330 Big Rail Drive
Naperville, IL 60540

Date: July 10, 2014

Meg Boulware
Meg Boulware

EXHIBIT 1

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

American National Insurance Company)
a Texas Insurance Company)
)
 Plaintiff,)
)
v.)
)
American National Investment Advisors,)
LLC, An Illinois Limited Liability Company)
)
 Defendant.)

CASE NO. 11-CV-4016

COMPLAINT

Plaintiff, American National Insurance Company (“American National” or “Plaintiff”), for its Complaint against Defendant, American National Investment Advisors, LLC (“Investment Advisors” or “Defendant”), states as follows:

JURISDICTION, PARTIES, AND VENUE

1. The Court has subject matter jurisdiction over this controversy under 28 U.S.C. §§ 1331 and 1338(a) because it is a civil action involving a federal question related to claims of trademark infringement and unfair competition arising under the Lanham Act, Title 15 of the United States Code. The Court has original jurisdiction over this controversy under 15 U.S.C. § 1121 because it is a civil action involving trademark infringement and unfair competition pursuant to 15 U.S.C. §§ 1114, 1125. The Court has supplemental jurisdiction over all other claims pursuant to 28 U.S.C. § 1367(a).

2. The Court has personal jurisdiction over Defendant because the Defendant is conducting business in the State, Defendant operates in the State and judicial district. The acts of

trademark infringement, trademark dilution and unfair competition are occurring in this State, and Defendant should reasonably anticipate being hauled into court in this State.

3. Plaintiff, American National Insurance Company is an insurance company organized and existing under the laws of the state of Texas with an office and principal place of business at One Moody Plaza, Galveston, Texas 77550.

4. On information and belief, Defendant, Investment Advisors operates a business at 2001 Butterfield Road Ste 500, Downers Grove, Illinois 60515. Defendant regularly transacts business in this State and in this District and has committed a tort in part or in whole in this State and this District.

5. Venue is proper in the Northern District of Illinois pursuant to 28 U.S.C. § 1391(b), (c) and (d) because a substantial part of the events or omissions giving rise to Plaintiff's claims occurred in this District and because Defendant is subject to personal jurisdiction in this District.

NATURE OF ACTION

6. Plaintiff seeks injunctive relief, damages and a declaratory judgment based upon Defendant's infringement of its service marks and unfair competition with Plaintiff arising from Defendant's infringement and dilution of Plaintiff's trademarks. Further, Defendant's willful infringement has impacted both upon Plaintiff's rights directly as well as Plaintiff's ability to maintain consumers.

BACKGROUND FACTS

7. American National was founded in Galveston Texas in 1905. American National offers a broad variety of financial and insurance services including but not limited annuities, investment management and consultation and financial analysis and real estate services. American

National holds the A. M. Best's Rating A (Excellent) and Standard and Poor's rating A+ (Strong). American National does business in all 50 states and as of December 31, 2009, it had assets of over \$21.4 billion, and as of December 31, 2010, it has a ratio of \$120 of assets for every \$100 of liabilities and over \$3.6 billion of unassigned assets. American National has been recognized twice in the "Forbes 100 Most Trustworthy Companies" listing.

8. American National is the owner of the mark "AMERICAN NATIONAL" and various composite trademarks (collectively "American National Marks"). American National Marks include *but are not limited to* the following marks:

Registration Number	Date of Registration	Mark
1,207,500	September 7, 1982	AMERICAN NATIONAL LIFE INSURANCE COMPANY OF TEXAS
1,207,499	September 7, 1982	AMERICAN NATIONAL INSURANCE COMPANY
1,308,303	December 4, 1984	AMERICAN NATIONAL
1,837,021	May 17 1994	AMERICAN NATIONAL
1,243,114	June 21, 1983	
3,217,075	March 13, 2007	

9. Plaintiff's Marks are highly recognized by the public and serve to identify the source of the goods and services as belonging to American National.

10. Due to American National's long use and goodwill in its name and marks, significant advertising, and promotional activities, the American National Marks have achieved widespread acceptance and recognition among the consuming public and trade throughout the United States. The American National Marks identify American National as the source/origin of the goods and services

on which they appear.

11. Upon information and belief, Defendant is using the exact name and mark “AMERICAN NATIONAL” in connection with providing services in a competitive or at least similar field as the Plaintiff. Specifically, Defendant owns and operates an investment advisory firm offering investment advice and financial planning.

12. Defendant is not authorized by Plaintiff to use any of their registered trademarks.

COUNT I
FEDERAL TRADEMARK INFRINGEMENT

13. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 12 as if fully set forth herein.

14. The foregoing acts of Defendant are intended to cause, have caused, and are likely to continue to cause confusion, mistake, and deception among consumers, the public, and the trade as to whether Defendant’s goods and services originate from, or are affiliated with, sponsored by, or endorsed by American National.

15. Upon information and belief, Defendant has acted with knowledge of Plaintiff’s ownership of the American National Marks and with deliberate intention or willful blindness to unfairly benefit from the incalculable goodwill symbolized thereby.

16. The acts of Defendant complained of constitutes infringement of the Plaintiff’s federal service mark registrations in violation of Section (32) of the Lanham Act, 15 USC § 1114.

17. Defendant’s wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff’s advertising, consumer recognition, and goodwill.

18. Defendant has not ceased its infringing acts.

19. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

COUNT II
FEDERAL UNFAIR COMPETITION

20. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 19 as if fully set forth herein:

21. The acts of Defendant complained of constitutes the use in commerce of false designations of origin and false and/or misleading descriptions or representations, tending to falsely or misleadingly describe and/or represent Defendant's services as those of Plaintiff in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).

22. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.

23. Defendant has not ceased its wrongful acts.

24. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

COUNT III
COMMON-LAW TRADEMARK INFRINGEMENT

25. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 24 as if fully set forth herein.

26. The foregoing acts of Defendant are intended to cause, have caused, and are likely to continue to cause confusion, mistake, and deception among consumers, the public, and the trade as to whether Defendant's goods and services originate from, or are affiliated with, sponsored by, or

endorsed by American National.

27. Upon information and belief, Defendant has acted with knowledge of Plaintiff's ownership of the American National Marks and with deliberate intention or willful blindness to unfairly benefit from the incalculable goodwill symbolized thereby.

28. Defendant's acts constitute trademark infringement in violation of the common law of the State of Illinois.

29. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.

30. Defendant has not ceased its infringing acts.

31. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

COUNT IV
STATUTORY AND COMMON-LAW UNFAIR COMPETITION

32. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 31 as if fully set forth herein.

33. Defendant's wrongful conduct constitutes unfair methods of competition and unfair and deceptive acts or practices in trade or commerce and creates a likelihood of confusion, misunderstanding or deception in the public's minds as to the origin of the parties' services and goods, all in violation of 815 ILCS 505/1 *et seq.*, 815 ILCS 510/1 *et seq.*, and the common law of Illinois.

34. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer

recognition, and goodwill.

35. Defendant has not ceased its wrongful acts.

36. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

COUNT V
TRADEMARK DILUTION

37. Plaintiff repeats and re-alleges the allegation contained in paragraphs 1-36 as if fully set forth herein.

38. The foregoing acts of Defendant constitute trademark dilution in violation of Illinois common law and the Illinois Anti-Dilution Act (765 ILCS 1035/15). Defendant's use of the American National Marks, without authorization from Plaintiff, is diluting the distinctive quality of the American National Marks and decreasing the capacity of such marks to identify and distinguish Plaintiff products and has caused a likelihood of harm to Plaintiff's business reputation.

39. Defendant have diluted the distinctive quality of the American National Marks.

40. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.

41. Defendant has not ceased its wrongful acts.

42. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

43. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

PRAYER FOR RELIEF

WHEREFORE, Plaintiff American National requests that the Court order the following relief:

1. That Defendant be required to account to Plaintiff for all profits resulting from Defendant's infringing activities and that the award to Plaintiff be trebled as provided for under 15 U.S.C. § 1117;

2. That the Court enter a permanent injunction ordering the Defendant, their officers, agents, servants, employees, and all persons acting in concert or participation with them who receive actual notice of the Court's order, be enjoined and restrained from:

a. Using any reproduction, copy or colorable imitation of the "AMERICAN NATIONAL" mark or a confusingly similar mark to AMERICAN NATIONAL to identify any goods or the offering or provision of any services not authorized by Plaintiff;

b. Engaging in any course of conduct likely to cause confusion, deception or mistake, or injure Plaintiff's business reputation or dilute the quality and goodwill of Plaintiff's "AMERICAN NATIONAL" mark;

c. Using a false designation or representations including words or other symbols tending to falsely describe or represent Defendant's unauthorized goods or services as being those of Plaintiff or sponsored by or associated with Plaintiff and from offering such goods or services in commerce; and

d. Attempting, causing, or assisting any of the above-described acts.

3. That Defendant, within thirty (30) days of judgment herein, file and serve Plaintiff with a sworn statement setting forth in detail the manner and form in which Defendant have complied with this injunction pursuant to 15 U.S.C. § 1116(a);

4. That Plaintiff have a recovery from Defendant of the costs, disbursement of this action and Plaintiff's reasonable attorneys' fees pursuant to 15 U.S.C. § 1117;

5. That Defendant be ordered to pay pre-judgment interest to American National on all amounts awarded and post-judgment interest until paid at the maximum lawful rate;

6. That the Court retain jurisdiction of this action for the purposes of enabling American National to apply to the Court at any time for such further orders and interpretation or execution of any order entered in this action; for the modification of any such order; for the enforcement or compliance therewith; and for the punishment of any violations thereof; and

7. That the Plaintiff has all other and further relief as the Court may deem just and proper under the circumstances.

Dated: June 13, 2011

Respectfully submitted,

CHITTENDEN, MURDAY & NOVOTNY LLC

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EXHIBIT 2

**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF ILLINOIS
EASTERN DIVISION**

American National Insurance Company)	
a Texas Insurance Company)	
)	
Plaintiff,)	
)	CASE NO. 11-CV-4016
)	
American National Investment Advisors,)	Judge Sharon Coleman
LLC, An Illinois Limited Liability Company)	Magistrate Judge Denlow
)	
Defendant.)	

ANSWER AND AFFIRMATIVE DEFENSES

Defendant American National Investment Advisors, LLC (“Investment Advisors”), for its answer to the complaint of plaintiff American National Insurance Company (“ANIC”), states as follows:

JURISDICTION, PARTIES, AND VENUE

1. *The Court has subject matter jurisdiction over this controversy under 28 U.S.C. §§ 1331 and 1338(a) because it is a civil action involving a federal question related to claims of trademark infringement and unfair competition arising under the Lanham Act, Title 15 of the United States Code. The Court has original jurisdiction over this controversy under 15 U.S.C. § 1121 because it is a civil action involving trademark infringement and unfair competition pursuant to 15 U.S.C. §§ 1114, 1125. The Court has supplemental jurisdiction over all other claims pursuant to 28 U.S.C. § 1367(a).*

ANSWER: Defendant admits to subject matter jurisdiction and venue.

Paragraph 1 is otherwise denied.

2. *The Court has personal jurisdiction over Defendant because the Defendant is conducting business in the State, Defendant operates in the State and judicial district. The acts of trademark infringement, trademark dilution and unfair competition are occurring in this State, and Defendant should reasonably anticipate being hauled into court in this State.*

ANSWER: Defendant admits to personal jurisdiction. Paragraph 2 is otherwise denied.

3. *Plaintiff, American National Insurance Company is an insurance company organized and existing under the laws of the state of Texas with an office and principal place of business at One Moody Plaza, Galveston, Texas 77550.*

ANSWER: Defendant has insufficient information with which to form a belief as to the truth or falsity of paragraph 3, which is therefore denied.

4. *On information and belief, Defendant, Investment Advisors operates a business at 2001 Butterfield Road Ste 500, Downers Grove, Illinois 60515. Defendant regularly transacts business in this State and in this District and has committed a tort in part or in whole in this State and this District.*

ANSWER: Defendant admits that it operates a business at 2001 Butterfield Road Ste 500, Downers Grove, Illinois 60515 and regularly transacts business in this State and in this District. Paragraph 4 is otherwise denied.

5. *Venue is proper in the Northern District of Illinois pursuant to 28 U.S.C. § 1391(b), (c) and (d) because a substantial part of the events or omissions giving rise to Plaintiff's claims occurred in this District and because Defendant is subject to personal jurisdiction in this District.*

ANSWER: Defendant admits that venue is proper in this judicial district. Paragraph 5 is otherwise denied.

NATURE OF ACTION

6. *Plaintiff seeks injunctive relief, damages and a declaratory judgment based upon Defendant's infringement of its service marks and unfair competition with Plaintiff arising from Defendant's infringement and dilution of Plaintiff's trademarks. Further, Defendant's willful infringement has impacted both upon Plaintiff's rights directly as well as Plaintiff's ability to maintain consumers.*

ANSWER: Defendant admits that ANIC seeks certain judicial relief as stated in its complaint. Paragraph 6 is otherwise denied.

BACKGROUND FACTS

7. *American National was founded in Galveston Texas in 1905. American National offers a broad variety of financial and insurance services including but not limited annuities, investment management and consultation and financial analysis and real estate services. American National holds the A. M. Best's Rating A (Excellent) and Standard and Poor's rating A+ (Strong). American National does business in all 50 states and as of December 31, 2009, it had assets of over \$21.4 billion, and as of December 31, 2010, it has a ratio of \$120 of assets for every \$100 of liabilities and over \$3.6 billion of unassigned assets. American National has been recognized twice in the "Forbes 100 Most Trustworthy Companies" listing.*

ANSWER: Defendant has insufficient information with which to form a belief as to the truth or falsity of paragraph 7, which is therefore denied.

8. *American National is the owner of the mark "AMERICAN NATIONAL" and various composite trademarks (collectively "American National Marks"). American National Marks include but are not limited to the following marks: [Six alleged registrations omitted]*

ANSWER: Defendant admits that AMNI appears to be the record owner of the six alleged trademark registrations, but has insufficient information with which to form a belief as to the truth or falsity of whether such registrations are valid, subsisting, or legally enforceable. Paragraph 8 is otherwise denied.

9. *Plaintiff's Marks are highly recognized by the public and serve to identify the source of the goods and services as belonging to American National.*

ANSWER: Defendant has insufficient information with which to form a belief as to the truth or falsity of paragraph 9, which is therefore denied.

10. *Due to American National's long use and goodwill in its name and marks, significant advertising, and promotional activities, the American National*

Marks have achieved widespread acceptance and recognition among the consuming public and trade throughout the United States. The American National Marks identify American National as the source/origin of the goods and services on which they appear.

ANSWER: Defendant has insufficient information with which to form a belief as to the truth or falsity of paragraph 10, which is therefore denied.

11. Upon information and belief, Defendant is using the exact name and mark "AMERICAN NATIONAL" in connection with providing services in a competitive or at least similar field as the Plaintiff. Specifically, Defendant owns and operates an investment advisory firm offering investment advice and financial planning.

ANSWER: Defendant admits that it operates an investment advisory firm under the name AMERICAN NATIONAL INVESTMENT ADVISORS, LLC which offers investment advice and financial planning. Paragraph 11 is otherwise denied.

12. Defendant is not authorized by Plaintiff to use any of their registered trademarks.

ANSWER: Defendant denies that it requires any authorization from AMNI to use its name AMERICAN NATIONAL INVESTMENT ADVISORS, LLC. Paragraph 12 is otherwise admitted.

COUNT I.
FEDERAL TRADEMARK INFRINGEMENT

13. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 12 as if fully set forth herein.

ANSWER: Defendant repeats and re-alleges its answers to Paragraphs 1 through 12.

14. The foregoing acts of Defendant are intended to cause, have caused,

and are likely to continue to cause confusion, mistake, and deception among consumers, the public, and the trade as to whether Defendant's goods and services originate from, or are affiliated with, sponsored by, or endorsed by American National.

ANSWER: Paragraph 14 is denied.

15. Upon information and belief, Defendant has acted with knowledge of Plaintiff's ownership of the American National Marks and with deliberate intention or willful blindness to unfairly benefit from the incalculable goodwill symbolized thereby.

ANSWER: Paragraph 15 is denied.

16. The acts of Defendant complained of constitutes infringement of the Plaintiff's federal service mark registrations in violation of Section (32) of the Lanham Act, 15 USC § 1114.

ANSWER: Paragraph 16 is denied.

17. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.

ANSWER: Paragraph 17 is denied.

18. Defendant has not ceased its infringing acts.

ANSWER: Defendant denies any and all acts of infringement. Paragraph 18 is therefore denied.

19. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

ANSWER: Paragraph 19 is denied.

COUNT II.
FEDERAL UNFAIR COMPETITION

20. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 19 as if fully set forth herein.

ANSWER: Defendant repeats and re-alleges its answers to Paragraphs 1 through 19.

21. *The acts of Defendant complained of constitutes the use in commerce of false designations of origin and false and/or misleading descriptions or representations, tending to falsely or misleadingly describe and/or represent Defendant's services as those of Plaintiff in violation of Section 43(a) of the Lanham Act, 15 U.S.C. § 1125(a).*

ANSWER: Paragraph 21 is denied.

22. *Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.*

ANSWER: Paragraph 22 is denied.

23. *Defendant has not ceased its wrongful acts.*

ANSWER: Defendant denies any and all wrongful acts. Paragraph 23 is therefore denied.

24. *Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.*

ANSWER: Paragraph 24 is denied.

COUNT III.
COMMON-LAW TRADEMARK INFRINGEMENT

25. *Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 24 as if fully set forth herein.*

ANSWER: Defendant repeats and re-alleges its answers to Paragraphs 1 through 24.

26. *The foregoing acts of Defendant are intended to cause, have caused, and are likely to continue to cause confusion, mistake, and deception among consumers, the public, and the trade as to whether Defendant's goods and*

services originate from, or are affiliated with, sponsored by, or endorsed by American National.

ANSWER: Paragraph 26 is denied.

27. Upon information and belief, Defendant has acted with knowledge of Plaintiff's ownership of the American National Marks and with deliberate intention or willful blindness to unfairly benefit from the incalculable goodwill symbolized thereby.

ANSWER: Paragraph 27 is denied.

28. Defendant's acts constitute trademark infringement in violation of the common law of the State of Illinois.

ANSWER: Paragraph 28 is denied.

29. Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.

ANSWER: Paragraph 28 is denied.

30. Defendant has not ceased its infringing acts.

ANSWER: Defendant denies any and all infringing acts. Paragraph 30 is therefore denied.

31. Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.

ANSWER: Paragraph 31 is denied.

COUNT IV.
STATUTORY AND COMMON-LAW UNFAIR COMPETITION

32. Plaintiff repeats and re-alleges the allegations contained in Paragraph 1 through 31 as if fully set forth herein.

ANSWER: Defendant repeats and re-alleges its answers to Paragraphs 1 through 31.

33. *Defendant's wrongful conduct constitutes unfair methods of competition and unfair and deceptive acts or practices in trade or commerce and creates a likelihood of confusion, misunderstanding or deception in the public's minds as to the origin of the parties' services and goods, all in violation of 815 ILCS 505/1 et seq., 815 ILCS 510/1 et seq., and the common law of Illinois.*

ANSWER: Paragraph 33 is denied.

34. *Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.*

ANSWER: Paragraph 31 is denied.

35. *Defendant has not ceased its wrongful acts.*

ANSWER: Defendant denies any and all wrongful acts. Paragraph 35 is therefore denied.

36. *Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.*

ANSWER: Paragraph 33 is denied.

COUNT V.
TRADEMARK DILUTION

37. *Plaintiff repeats and re-alleges the allegation contained in paragraphs 1-36 as if fully set forth herein.*

ANSWER: Defendant repeats and re-alleges its answers to Paragraphs 1 through 36.

38. *The foregoing acts of Defendant constitute trademark dilution in violation of Illinois common law and the Illinois Anti-Dilution Act (765 ILCS 1035/15). Defendant's use of the American National Marks, without authorization from Plaintiff, is diluting the distinctive quality of the American National Marks and decreasing the capacity of such marks to identify and distinguish Plaintiff products and has caused a likelihood of harm to Plaintiff's business reputation.*

ANSWER: Paragraph 38 is denied.

39. *Defendant have diluted the distinctive quality of the American National Marks.*

ANSWER: Paragraph 39 is denied.

40. *Defendant's wrongful acts alleged herein have permitted and/or will permit Defendant to earn substantial revenues and profits on the strength of Plaintiff's advertising, consumer recognition, and goodwill.*

ANSWER: Paragraph 40 is denied.

41. *Defendant has not ceased its wrongful acts.*

ANSWER: Defendant denies any and all wrongful acts. Paragraph 41 is therefore denied.

42. *Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.*

ANSWER: Paragraph 42 is denied.

43. *Defendant's acts have damaged and will continue to damage Plaintiff, and Plaintiff has no adequate remedy at law.*

ANSWER: Paragraph 43 is denied.

AFFIRMATIVE DEFENSES

FIRST AFFIRMATIVE DEFENSE

Plaintiff has no legally enforceable rights in the words AMERICAN and NATIONAL in any of its alleged U.S. trademark registrations, apart from the individual marks viewed in their entirety, because those words when used on or in connection with Plaintiff's services are merely descriptive or deceptively mis-descriptive of them, or are primarily geographically descriptive of them, for

which federal trademark registration is prohibited by 15 U.S.C. § 1052(e). Further, such words were and are so commonly used by others as to be incapable of having become distinctive of Plaintiff's services in commerce under 15 U.S.C. § 1052(f). All of Plaintiff's U.S. trademark registrations, to the extent that they claim exclusive rights in the words AMERICAN and NATIONAL, are therefore void and unenforceable.

SECOND AFFIRMATIVE DEFENSE

Plaintiff has failed to state a claim upon which relief can be granted, because, *inter alia*, and upon information and belief,

- (a) Plaintiff's alleged marks are not famous;
- (b) Users of Defendant's services are sophisticated purchasers;
- (c) Users of Plaintiff's services are sophisticated purchasers;
- (d) Plaintiff's alleged marks are merely descriptive;
- (e) Plaintiff's alleged marks and Defendant's name are distinctively different in appearance, spelling, sound and meaning;
- (f) Plaintiff's alleged marks and Defendant's name convey distinctively different commercial impressions; and
- (g) Plaintiff's alleged marks and Defendant's name are not likely to cause confusion, mistake or deception among purchasers and potential purchasers as to the source of their respective services.

THIRD AFFIRMATIVE DEFENSE

Plaintiff's cause of action is barred by the equitable doctrines of laches

and estoppel in that Plaintiff has, on information and belief, for nearly two decades knowingly allowed numerous other financial services businesses to use the name and mark AMERICAN NATIONAL in various forms, including but not limited to:

American National Financial, Inc. (USDC CDCA 8:01-cv-00977),

American National Services, Inc. (USDC SDTX 3:93-cv-00632),

Amerinational Financial Services, Inc. (USDC SDTX 3:94-cv-00541),

American National Financial Services Inc. (Akron OH, Santa Monica and Beverly Hills CA),

American National Financial Inc. (Upland CA and San Diego CA);

First American National Financial Group (Portland OR); and

First American National Financial Services (Las Vegas NV).

FOURTH AFFIRMATIVE DEFENSE

On information and belief, Plaintiff has legally abandoned any claim to the name and mark AMERICAN NATIONAL, Reg. 1837021 for "mutual fund investment services", by reason of its intentional nonuse for over a decade. The only such services ever offered by Plaintiff in interstate commerce were through a subsidiary named AMERICAN NATIONAL GROWTH FUND, INC., a Maryland corporation. That subsidiary changed its name to SM&R GROWTH FUND INC. in 1998 and no longer included the words AMERICAN NATIONAL in either its name or its service mark. When Plaintiff filed its application to renew the registration on May 10, 2004, its alleged proof of use consisted only of a May 7,

2004 web page describing the service "Mutual Funds" with the following footnote: "*Offered through Securities Management and Research, Inc.*" without any mention of the name or service mark AMERICAN NATIONAL. Having not offered any investment services under that name and mark AMERICAN NATIONAL from at least 2000 through the present date, Plaintiff has legally abandoned any present claim to rights in this mark under the Lanham Act, Sec. 45 (15 U.S.C. §1127). See, e.g., Natural Answers, Inc. v. Smithkline Beecham Corporation, 529 F.3d 1325 (11th Cir. 2008).

FIFTH AFFIRMATIVE DEFENSE

On information and belief, Plaintiff procured and/or maintained its U.S. Reg. 1837021 of AMERICAN NATIONAL for "mutual fund investment services" by means of inequitable conduct before the U.S. Patent and Trademark Office, namely, by making intentional false statements with the intent and purpose that they be relied upon, as follows:

(1) On May 15, 2000, as part of its obligation to file proof of continued use of the registered mark under Section 8 of the Trademark Act, Plaintiff submitted a "prospectus" dated May 1, 1999 supposedly from "American National Investment Accounts, Inc." This submission was supported by a May 2, 2000 affidavit of Michael W. McCroskey, Plaintiff's Executive Vice President. Mr. McCroskey knew, or should have known, that Plaintiff's investment service subsidiary had changed its name in 1998 to SM&R GROWTH FUND INC. Thus Plaintiff then no longer offered any such services

in interstate commerce under the name and mark AMERICAN NATIONAL, and Mr. McCroskey's affidavit was therefore false, and was relied upon by the U.S. Patent and Trademark Office in allowing the registration to continue in force.

(2) On 10 May 2004, as part of its obligation to file proof of continued use of the registered mark as part of its application to renew the subject registration, Plaintiff submitted a May 7, 2004 example of an internet web page. On that web page, the words and mark AMERICAN NATIONAL nowhere appear as being the source of investment services. This submission was supported by the May 10, 2004 affidavit of Ronald J. Welch, Plaintiff's Senior Vice President. Mr. Welch knew, or should have known, that for at least three years Plaintiff had not offered any investment services in interstate commerce under the name and mark AMERICAN NATIONAL. Plaintiff then no longer offered any such services in interstate commerce under the name and mark AMERICAN NATIONAL, and Mr. Welch's affidavit was therefore false, and was relied upon by the U.S. Patent and Trademark Office in renewing the registration.

PRAYER FOR RELIEF

WHEREFORE, Defendant AMERICAN NATIONAL INVESTMENT ADVISORS, LLC prays:

(A) At the earliest of the first scheduling conference, or 90 days after this case was filed (June 13, 2011), that the parties be required to file a joint statement indicating whether they wish to participate in the voluntary

mediation program pursuant to Local Rule 16.3 applicable to all Lanham Act cases;

(B) That plaintiff's complaint be dismissed with prejudice; and

(C) That defendant be awarded its costs and attorney fees as provided by law; and

(D) That defendant be granted such other and further relief as may be just.

**AMERICAN NATIONAL INVESTMENT
ADVISORS, LLC**

By: s/George E. Bullwinkel
Its attorney

Date: July 12, 2011

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CERTIFICATE OF SERVICE

The undersigned, an attorney of record, hereby certifies that one copy of the foregoing ANSWER AND AFFIRMATIVE DEFENSES was served by electronic mail through the Court's ECM/CF service, and also by first class mail, postage prepaid, on July 12, 2011 to the following:

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ATTORNEY FOR PLAINTIFF

s/George E. Bullwinkel
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Attorney for Defendant