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

Proceeding	92055735
Party	Plaintiff American National Investment Advisors, LLC
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Date	07/11/2012
Attachments	Petitioner's answer brief.pdf ( 5 pages )(84622 bytes )

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

In the matter of Petition to Cancel Reg. No. 1837021  
Mark: AMERICAN NATIONAL  
For "mutual fund investment services"

American National Investment Advisors, LLC Petitioner	)	
v.	)	Cancellation No. 92055735
American National Insurance Company Registrant	)	

PETITIONER'S OPPOSITION TO REGISTRANT'S  
MOTION TO SUSPEND PROCEEDINGS

Registrant seeks an indefinite suspension of the present proceeding on the grounds that the subject registration should be protected from attack because Registrant's earlier-filed infringement suit in the US District Court in Chicago would supposedly be dispositive of all issues in the present proceeding. Petitioner disagrees.

BACKGROUND

The subject registration is of the geographically descriptive words AMERICAN and NATIONAL for "*mutual fund investment services*" in IC 036. To obtain the registration at issue, and thereafter to renew and keep it in force, Registrant has repeatedly claimed rights by reason of five or more years of alleged continued exclusive use.

Petitioner challenges those claims because even a superficial reading of this registration's prosecution file shows that the "specimens" of use submitted by Registrant, to the extent they showed proper trademark use at all, showed use by different entities, under different names, none of which would be likely to be associated with the Registrant by the consuming public.

Petitioner therefore seeks cancelation of the subject registration because of these repeated false statements in the course of prosecution and maintenance of this registration.

### ARGUMENT

This Board has been charged by Congress with the responsibility of adjudicating questions of trademark law, particularly whether the mark was actually used in commerce as claimed, priority of use and likelihood of confusion. For that purpose it possesses special expertise which the District Courts cannot be presumed to have, which of course is one reason behind the existence of the Court of Appeals for the Federal Circuit.

This Board also has the discretionary power to suspend administrative proceedings in a proper case, under 37 CFR §2.117:

#### *Suspension of proceedings.*

*(a) 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. [Emphasis supplied]*

But simply because the Board may suspend proceedings in a proper case is in no way an argument that it must do so. The Board should take into consideration the fact that on June 18, 2012, based on the ex parte representation of Registrant's trial counsel<sup>1</sup> that all fact discovery had been completed (which counsel certainly knew was untrue) Judge Lee of the US District Court in Chicago set an accelerated trial schedule for that litigation.

On discovering this, Petitioner promptly moved both to vacate the ex parte order, allow deposition discovery on the above issues, and also to suspend the Chicago litigation pending final disposition of Petitioner's co-pending opposition to Registrant's pending application to again register the words AMERICAN NATIONAL, this time for "*investment company brokerage services*" in IC 036 (Ser. No. 85370115, TTAB docket No. 91205629). That motion on July 11, 2012 was granted in part (as to the depositions) and denied in part (as to vacating the order and staying the litigation.)

Although Registrant argues that the Board's precedential opinion in New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc. (No. 91198708, TTAB 2011) is dispositive, it is not. In that case both parties had moved to suspend the opposition pending final resolution of federal court litigation. By contrast, Petitioner here strongly opposes any suspension, either of this proceeding or Petitioner's co-pending opposition No. 91205629.

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<sup>1</sup> Petitioner's counsel was six minutes late to the Court's call because of a commuter train delay.

CONCLUSION

On the points and authorities above, Petitioner American National Investment Advisors, LLC requests this Board to exercise its discretion under 37 CFR §2.117(a) and deny Registrant's Motion to Suspend.

Respectfully submitted,

**AMERICAN NATIONAL INVESTMENT  
ADVISORS, LLC**

By: s/George E. Bullwinkel  
Its attorney

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**CERTIFICATE OF SERVICE**

George E. Bullwinkel, attorney of record, hereby certifies that one copy of the foregoing PETITIONER'S OPPOSITION TO REGISTRANT'S MOTION TO SUSPEND PROCEEDINGS was served by mailing, first class, postage prepaid, on July 12, 2012, to the following:

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