ESTTA Tracking number: **ESTTA485485**
Filing date: **07/25/2012**

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	MARGARET A BOULWARE BOULWARE & VALOIR THREE RIVERWAY, STE 950 HOUSTON, TX 77056 UNITED STATES mboulware@boulwarevaloir.com, tmarshall@boulwarevaloir.com
Submission	Other Motions/Papers
Filer's Name	Margaret A. Boulware
Filer's e-mail	mboulware@boulwarevaloir.com, tmarshall@boulwarevaloir.com
Signature	/Margaret A. Boulware/
Date	07/25/2012
Attachments	Reply to Petitioner's Opposition to Registrat's Motion To Suspend Further Proceedings.pdf (8 pages)(344196 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

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

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

Registrant filed a Motion to suspend this cancellation action pending the disposition of a civil action American National Insurance Company v. American National Investment Advisors, LLC, No.1:11-cv-04016 before United States District Court, N.D. Ill.

As admitted by the Petitioner, its motion to stay in the civil action has been **denied** (see Exhibit 1). The civil action will determine the pivotal issue of standing: whether Petitioner (Defendant) suffers any harm with the instant registration, i.e. whether Petitioner is lawfully conducting business under the name AMERICAN NATIONAL INVESTMENT ADVISORS and has standing to petition or whether, as Registrant (Plaintiff) contends, Petitioner is using the identical mark Registrant has used in insurance and financial industry for over 100 years and is a willful infringer and will be enjoined from using the AMERICAN NATIONAL mark . Registrant moves the Board to suspend current cancellation proceeding pending the outcome of the civil action.

STATEMENT OF FACTS AND ARGUMENTS

Registrant has stated in the Motion to Suspend that (1) the civil action only needs to have a bearing on the issue before the board, (2) an Petitioner in an cancellation proceeding before the Board must have "real interest" in the proceeding to have standing, (3) the "real interest" requirement means that the Petitioner must plead a "direct and personal stake in the outcome of the cancellation," and (4) the civil action has a bearing on the instant cancellation proceeding. Petitioner's unlawful use of AMERICAN NATIONAL would deprive its standing in the cancellation proceeding, making the cancellation moot.

For the purpose of motion to suspend, Registrant believes these relevant facts clearly show the civil action has a bearing on the instant cancellation proceeding to warrant its suspension. Registrant will, however, refute each of Petitioner's arguments.

1. Petitioner's motion to stay the Civil Action was denied.

Petitioner admitted that its attempt to stay the civil action was denied by Judge John Z. Lee on July 11, 2012, as shown in Exhibit 1 in Registrant's previous Supplemental Submission to Registrant's Motion to Suspend Proceedings on July 13, 2012. Registrant will not go into length regarding Petitioner's erroneous assertions as the document speaks for itself.

2. The civil action will determine whether Petitioner has standing.

Petitioner in its Statement of Grounds for Cancellation stated that it has standing both because (a) it offers and provides investment advisory services under the name and mark AMERICAN NATIONAL, and (b) Registrant sued Petitioner for infringement. Logically, as Registrant has pointed out, the reason why the civil action has a bearing on the instant cancellation is because it will determine whether Petitioner has standing to

petition for the cancellation. The Board has articulated that Petitioner (1) must have a "real interest" in the proceedings, and (2) must have a "reasonable basis for his belief of damage. *McDermott v. San Francisco Womens Motorcycle Contingent*, 81 U.S.P.Q.2d 1212 (T.T.A.B. 2006). The Federal Circuit also noted that a Petitioner is required "to have a legitimate personal interest in the opposition," which means that "the Petitioner must have a direct and personal stake in the outcome of the opposition." *Ritchie v. Simpson*, 170 F.3d 1092, 1095 (Fed. Cir. 1999).

Courts have also held that a party who is the subject of a permanent injunction that prohibits him from using a registered mark lacked a legitimate commercial interest in the registered mark, thus lacked standing. *See, e.g.*, *Soro v. Citigroup*, 287 F. App'x 57, 60 (11th Cir. 2008) ("Here, Soro is the subject of a permanent injunction that prohibits him from using the word 'Citigroup' in providing financial services. Because of this prohibition, Soro lacked a legitimate commercial interest in the CITIGROUP mark."). The Eleventh Circuit therefore affirmed the TTAB's dismissal of the cancellation because the petitioner lacked standing. *Id.*

Here, for Petitioner to have standing, it must show that it has a legitimate personal interest in the cancellation. Registrant has requested for permanent injunction against Petitioner in the civil action, and, if granted, will deprive Petitioner its standing in both the present cancellation and the co-pending opposition proceeding.

3. TTAB precedent *Who Dat* supports suspension of this proceeding.

Petitioner fails to provide any argument regarding the standing issue. Instead, Petitioner argued, erroneously, that the Board precedent *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 U.S.P.Q.2d 1550 (T.T.A.B. 2011) should not be dispositive because Petitioner strongly opposes a suspension. That is an

incorrect interpretation of the precedent because parties' consent is not required to warrant a suspension. The Rules and TBMP only requires that the civil action may have a bearing on the Board case.

Registrant cites *Who Dat* for the proposition that "the 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," *Who Dat*, 99 U.S.P.Q.2d at 1552, which is in accordance with the TBMP's instruction, especially section 510.02(a) that provides: "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 § 510.02(a) (2011).

Indeed, the Board in *Who Dat* cited *McCarthy on Trademark and Unfair Competition* for the proposition that "[i]t is standard procedure for the Trademark Board to stay administrative proceedings pending the outcome of court litigation between the same parties involving related issues." *Who Dat*, 99 U.S.P.Q.2d at 1552 (citing *McCarthy on Trademark and Unfair Competition*, §32:47 (4th ed. updated June 2011)). The fact that both parties had moved for suspension is <u>not</u> a prerequisite required by either 37 C.F.R. § 2.117(a) or TBMP §510.02(a) to support a suspension.

Here, as discussed above, the civil action will determine whether Petitioner has standing to file the instant cancellation, and therefore the civil action not only has a bearing, but will be dispositive of the issues alleged in this cancellation. As a consequence, the only requirement of Rule 2.117(a) is met to warrant a suspension.

Additionally, Petitioner did not cite any authority to support its assertions, nor did Petitioner address any of the standing issues or prejudice issues. As a consequence, Petitioner provides no legitimate reason to oppose the present motion to suspend.

CONCLUSION

Registrant moves the Board to suspend further proceedings pending the outcome of the civil action in which the Registrant has requested damages for willful infringement and a permanent injunction.

Respectfully submitted,

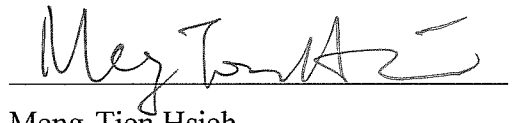
Date: July 25, 2012

Margaret A. Boulware
Attorney for Petitioner,
Boulware & Valoir
Three Riverway
Suite 950
Houston, Texas 77056
Tel: 832-369-7852
Fax: 713-650-6458

CERTIFICATE OF SERVICE

I hereby certify that, on this 25th day of July 2012, a true and correct copy of Registrant's Reply Brief of Motion to Suspend Opposition Proceeding was served by United States Certified Mail, Return Receipt Requested, postage prepaid and First Class Mail on:

George E. Bullwinkel
330 Big Rail Drive
Naperville, Illinois 60540
Tel: (630) 418-2273
Email: geb@bullwinkel.com



Meng-Tien Hsieh
Boulware & Valoir
Three Riverway
Suite 950
Houston, Texas 77056
Tel: 832-369-7852
Fax: 713-650-6458

EXHIBIT 1

UNITED STATES DISTRICT COURT
FOR THE Northern District of Illinois – CM/ECF LIVE, Ver 5.0.3
Eastern Division

American National Insurance Company

Plaintiff,

v.

Case No.: 1:11–cv–04016
Honorable John Z. Lee

American National Investment Advisors, LLC

Defendant.

NOTIFICATION OF DOCKET ENTRY

This docket entry was made by the Clerk on Wednesday, July 11, 2012:

MINUTE entry before Honorable John Z. Lee:Motion hearing held on 7/11/12. Expert discovery date to stand. Defendants motion to vacate 6/18/2012 scheduling order and suspend further proceedings pending outcome of pending trademark [43] is granted in part and denied in part. Defense attorney to provide names to plaintiffs attorney of individuals to be deposed by the end of the day. Defendant shall have 30 days to complete the depositions that he described in open court. Defendants' motion to stay is denied. Status hearing set for 8/16/12 at 9:15 am. Mailed notice(ca,)

ATTENTION: This notice is being sent pursuant to Rule 77(d) of the Federal Rules of Civil Procedure or Rule 49(c) of the Federal Rules of Criminal Procedure. It was generated by CM/ECF, the automated docketing system used to maintain the civil and criminal dockets of this District. If a minute order or other document is enclosed, please refer to it for additional information.

For scheduled events, motion practices, recent opinions and other information, visit our web site at ***www.ilnd.uscourts.gov***.