

**UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
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Mailed: September 13, 2012

Opposition No. 91205629
Opposition No. 91206585
Cancellation No. 92055735

American National Investment
Advisors, LLC

v.

American National Insurance
Company

THIS ORDER REPLACES THE BOARD'S SEPTEMBER 5, 2012 ORDER.

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the motion of American National Insurance Company to suspend proceedings pending the disposition of the civil action between the parties. The motion has been fully briefed. For the reasons set forth below, the Board sua sponte consolidates these proceedings.

American National Insurance Company (defendant) owns a registration and two pending applications for the mark AMERICAN NATIONAL for "mutual fund investment services" (Registration No. 1837021, issued May 17, 1994 under Trademark Act Sec. 2(f)); "estate planning services"

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(application Serial No. 85488352 based on Trademark Act Sec. 1(a) and 2(f)); and "investment brokerage in the field of mutual funds and variable insurance products" (application Serial No. 85370115 based on Trademark Act Sec. 1(b) and 2(f)).

American National Investment Advisors, LLC (plaintiff) filed a petition to cancel the registration, and notices of opposition against both applications. In each pleading plaintiff alleges that it has common law rights based on its use of the mark AMERICAN NATIONAL since 2009 on investment advisory services, and that defendant has never done business as an investment advisor. In both Opposition Nos. 91205629 and 91206585, plaintiff alleges priority of use and likelihood of confusion, false suggestion of a connection with plaintiff, and misrepresentation of source. In Opposition No. 91205639, plaintiff also alleges geographic descriptiveness. In Opposition No. 91206585, plaintiff also alleges nonuse. In Cancellation No. 92055735, plaintiff alleges nonuse and fraud based on misrepresentations of use. Answers have been filed in Opposition No. 91205629 and the cancellation.

PROCEEDINGS CONSOLIDATED

Because the parties are the same, and the three proceedings involve common issues of law and fact, the Board

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believes that the interest of judicial economy will be served by consolidation of Opposition Nos. 91205629, 91206585, and Cancellation No. 92055735. See Fed. R. Civ. P. 42(a) and TBMP §511 (3rd ed., rev. 2012). Accordingly, the Board sua sponte consolidates Opposition Nos. 91205629, 91206585, and Cancellation No. 92055735, which, with the exception of the need for separate pleadings, will be presented on the same record and briefs. The Board file will be maintained in Opposition No. 91205629 as the "parent" case, but all papers filed herein must include the proceeding numbers of all consolidated cases in ascending order.

PROCEEDINGS ARE SUSPENDED

Defendant moves to suspend each proceeding pending the disposition of American National Insurance Company v. American National Investment Advisors, LLC, 11-CV-4016, pending in the United States District Court for the Northern District of Illinois. As shown by the case title, the parties are in reversed position, and the defendant in the Board proceedings asserts common law rights in the term AMERICAN NATIONAL as well as five pleaded registrations, one of which is the subject of the cancellation. According to the June 13, 2011 complaint, submitted with defendant's motion, defendant brings claims of trademark infringement,

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unfair competition, and dilution, and seeks, among other remedies, to permanently enjoin plaintiff's use of the term AMERICAN NATIONAL.¹

In the two oppositions, plaintiff contends that because the opposed applications were filed after the civil action commenced, any finding of infringement by the court in the civil action will not determine the oppositions before the Board, and that the oppositions also involve issues which are not before the court.² In the cancellation plaintiff argues that the Board has expertise in the area of trademark registrability, and the likelihood that the court will enjoin plaintiff's use is too small to warrant suspension.

Pursuant to Trademark Rule 2.117, "Whenever it shall come to the attention of the Trademark Trial and Appeal Board that a

¹ Six registrations were pleaded, but Registration No. 1243114 was cancelled August 17, 2012. Three registrations asserted in the civil action involve insurance services only, namely "underwriting life and health insurance" in Registration Nos. 1207499 and 1207500, and "property and casualty insurance underwriting services" in Registration No. 1308303. Registration No. 3217075 lists "insurance consultation, investment consultation, financial analysis and consultation, and financial planning for employers, employees, and employee groups; mutual fund and securities brokerage, distribution, and investment; and insurance underwriting services for all types of insurance."

² Applicant's contention (Opposition to Motion in 91205639, p. 2) that filing an application under Trademark Act Section 1(b) is "a tacit admission that Applicant was not then using the mark in commerce" is mistaken. See *In re Paul Wurth S.A.*, 21 USPQ2d 1631, 1633 (Comm'r Pat. 1991) (there is no inconsistency in an applicant stating it has a bona fide intention to use when some actual use of the mark has already begun); Trademark Manual of Examining Procedure § 903 (8th ed. 2011) ("TMEP") ("A §1(b) applicant may assert dates of use that are earlier than the filing date of the application in an amendment to allege use or statement of use.").

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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." 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." *New Orleans Louisiana Saints LLC and NFL Properties LLC v. Who Dat?, Inc.*, 99 USPQ2d 1550 (TTAB 2011).

Here, if the court rules in defendant's favor in the civil action and enjoins plaintiff's use of the AMERICAN NATIONAL mark pleaded in these proceedings, plaintiff will be unable to assert its use to establish standing or priority in this proceeding. *Otto Roth & Co. v. Universal Food Corp.*, 640 F.2d 1317, 209 USPQ 40, 43 (CCPA 1981) (With a likelihood of confusion claim, "the opposer must prove he has proprietary rights in the term he relies upon to demonstrate likelihood of confusion as to source, whether by ownership of a registration, prior use of a technical 'trademark,' prior use in advertising, prior use as a trade name, or whatever other type of use may have developed a trade identity."). A decision by the district court may be binding on the Board whereas a determination by the Board as to a defendant's right to obtain or retain a registration would not be binding or res judicata in respect to the proceeding pending before the court. *Whopper-Burger, Inc.*

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v. Burger King Corp., 171 USPQ 805, 807 (TTAB 1971).

Accordingly, defendant's motion to suspend proceedings pending the disposition of the district court proceeding is granted in each of the now-consolidated proceedings.

Within twenty days after the final determination of the civil action, defendant must notify the Board so that this consolidated case may be called up for appropriate action. During the suspension period the Board shall be notified of any address changes for the parties or their attorneys.

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