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

In the matter of Trademark Application Serial No. 78/095,980
For the Service Mark BOUNCE GUARD
Published in the *Official Gazette* on July 16, 2002

U.S. Patent & TMOfc/TM Mail Rcpt. Dt. #57
[redacted]
09-13-2002

MJCM, L.L.C. Opposer, v. F.N.B. Corporation Applicant.	Opposition No.:

BOX TTAB
FEE
Commissioner for Trademarks
2900 Crystal Drive
Arlington, Virginia 22202-3513

TRADEMARK TRIAL AND APPEAL BOARD
02 SEP 20 AM 12: 56

NOTICE OF OPPOSITION

MJCM, L.L.C., a limited liability company organized and existing under the laws of the State of Texas, believes that it will be damaged by registration of the mark shown in Trademark Application Serial No. 78/095,980 and hereby opposes such registration.

The grounds for opposition are as follows:

1. This Notice of Opposition has been timely filed, Opposer having been granted a thirty-day extension of time in which to oppose, which expires on September 14, 2002, but by application of 37 C.F.R. § 1.7 is extended through and including September 16, 202.

2. The Applicant seeks to register BOUNCE GUARD as a service mark for use in connection with "banking services," among other services, in International Class 36, as evidenced by the publication of said mark in the July 16, 2002, issue of *Official Gazette*.

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3. The term "bounce" describes the dishonor of a check or similar instrument due to the insufficiency of funds in the account on which the check or similar instrument is drawn.

4. The term "guard" describes the act or duty of protecting or defending.

5. The term "bounce guard" describes the features, functions, and purposes of a banking service that protects or defends against the dishonor of a check or similar instrument due to the insufficiency of funds in the account on which the check or similar instrument is drawn.

6. The term "bounce guard" would be viewed by consumers of banking services as describing the essential features, functions, and purposes of an account that guards against the dishonor of a check or similar instrument due to the insufficiency of funds in the account on which the check or similar instrument is drawn.

7. Through related companies, the Opposer provides banking services consisting of account features that provide an account holder with the ability to avoid the dishonor of a check or similar instrument due to the insufficiency of funds in the account on which the check or similar instrument is drawn (the "Opposer's Services").

8. The term "bounce guard" describes the essential features, functions, and purposes of Opposer's Services.

9. Registration of Applicant's proposed mark BOUNCE GUARD would give Applicant a prima-facie exclusive right to use the term "bounce guard" in connection with banking services.

10. Applicant's prima-facie exclusive right to use the term "bounce guard" in connection with banking services resulting from registration of Applicant's proposed mark would damage and injure Opposer either by preventing Opposer from using those terms to advertise or describe

Opposer's Services, or by subjecting Opposer to the possibility of a lawsuit by Applicant based on Opposer's use of those terms to advertising or describe the Opposer's Services.

11. Applicant's prima-facie exclusive right to the use of the term "bounce guard" in connection with banking services resulting from registration of Applicant's proposed mark would further damage and injure Opposer either by preventing Opposer from using confusingly similar terms to advertise or describe Opposer's Services, or by subjecting Opposer to the possibility of a lawsuit by Applicant based on Opposer's use of confusingly similar terms to advertising or describe the Opposer's Services.

12. Opposer currently provides, and since at least August 1, 1998, continuously has provided, Opposer's Services in connection with the service mark BOUNCE PROTECTION incorporating various stylistic features.

13. Opposer owns Reg. No. 2,349,601 on the Principal Register of the United States for the stylized service mark BOUNCE PROTECTION.

14. During prosecution of the application that issued as Reg. No. 2,349,601, the examining attorney required Opposer to disclaim the exclusive right to use "bounce protection" apart from the mark as shown in the drawing.

15. The term "protection" describes the act of protecting, *i.e.*, covering or shielding from exposure or injury.

16. The terms "guard" and "protection" essentially describe the same features, functions, and purposes of banking services that guard an account holder from certain events and circumstances.

17. The terms "guard" and "protection" used in combination with the term "bounce" essentially describe the same features, functions, and purposes of banking services that guard an account holder from the dishonor of a check or similar instrument due to the insufficiency of funds in the account on which the check or similar instrument is drawn.

18. The essential equivalence of the meaning of the terms "protection" and "guard" is likely to confuse banking service consumers.

19. If the Applicant is awarded the registration of its proposed mark BOUNCE GUARD, the confusion of banking service consumers regarding terms "protection" and "guard" could subject Opposer to a lawsuit filed by Applicant, derogating from the Opposer's statutory and common-law right to use its registered stylized mark BOUNCE PROTECTION.

20. Opposer would be further damaged and injured by registration of Applicant's proposed mark, because the rights incident to such registration would give the Applicant a lexicon of terms it can use in connection with its services than is larger than the lexicon available to Opposer to use in connection with Opposer's Service, in that Applicant would not be prevented from using the term "protection" in connection with its services, but Opposer would be prevented from using the term "guard" in connection with its services.

WHEREFORE, Opposer prays that Application 78/095,980 be refused and that no registration be issued thereon to Applicant; that this opposition be sustained in favor of Opposer; and that Opposer be granted such further relief to which it may be justly entitled.

Opposer hereby gives notice under Rule 2.122(d) of the Rules of Practice that in this opposition proceeding and in any appeal of the judgment in this opposition proceeding, it will rely on its Reg. No. 2,349,601 for the stylized service mark BOUNCE PROTECTION as

evidence in partial support of this Notice of Opposition. Two copies of Reg. No. 2,349,601 are attached showing the current status of and the current title to the registration.

A duplicate copy of this Notice of Opposition is enclosed herewith. The Office is authorized and requested to charge the statutory filing fee required under § 2.6(a)(17) to the deposit account of Andrews & Kurth L.L.P., No. 50-0897, and a duplicate copy of this Notice of Opposition, without attachments, is enclosed for the Office's accounting purposes.

Respectfully submitted

Steve Lauff
John Courtney

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Attorney Docket No. 142238

DATED: September 13, 2002

This documents is being deposited on September 13, 2002, with the United States Postal Service with sufficient postage using the "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, bearing "Express Mail" mailing label number EV143322371US.

HOU:2061194.1

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Int. Cl.: 36

Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,349,601

United States Patent and Trademark Office

Registered May 16, 2000

SERVICE MARK
PRINCIPAL REGISTER

MJCM, L.L.C. (TEXAS LIMITED LIABILITY COMPANY)
1235 NORTH LOOP WEST SUITE 220
HOUSTON, TX 77008 AND

COMMUNITY BANK & TRUST S.S.S. (TEXAS CORPORATION)
700 CALDER AVENUE
BEAUMONT, TX 77701

FOR: BANKING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 6-15-1998; IN COMMERCE 8-1-1998.

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BOUNCE PROTECTION", APART FROM THE MARK AS SHOWN.

SER. NO. 75-574,469, FILED 11-8-1998.

MARC LEIPZIG, EXAMINING ATTORNEY

Int. Cl.: 36

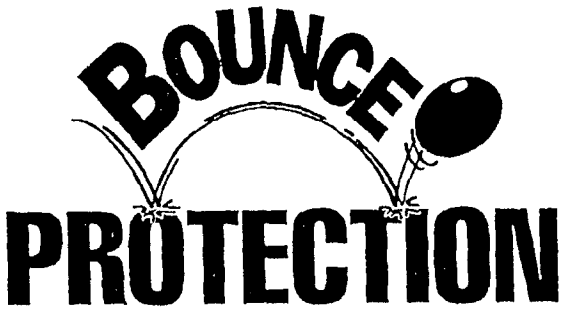
Prior U.S. Cls.: 100, 101 and 102

Reg. No. 2,349,601

United States Patent and Trademark Office

Registered May 16, 2000

SERVICE MARK
PRINCIPAL REGISTER



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CERTIFICATE OF MAILING BY "EXPRESS MAIL"

I hereby certify that on September 13, 2002, the referenced Notice of Opposition is being deposited with sufficient postage using the United States Postal Service "Express Mail Post Office to Addressee" service in an envelope addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, Virginia 22202-3513, and bearing Express Mail mailing label number EV143322371US.

By: Steve Lauff

Printed Name: STEVE LAUFF