

UNITED STATES PATENT AND TRADEMARK OFFICE  
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JMM

January 24, 2019

Opposition No. 91239532

*Old National Bank*

*v.*

*American National Bank of Texas*

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

This proceeding comes up for consideration of Applicant's consented motion, filed January 14, 2019, to amend involved application Serial No. 87315217 from an unrestricted application to a concurrent use application, and to dismiss this opposition proceeding in favor of a concurrent use proceeding. For the reasons set forth below, the motion is denied without prejudice.

#### RELEVANT FACTS

On January 26, 2017, American National Bank of Texas (hereafter, CU Applicant) filed an application pursuant to Trademark Act Sec. 1(a) to register the standard character mark YOUR BANK. FOR LIFE. for "banking services" in International Class 36 (Application Serial No. 87315217). On February 15, 2018, Old National Bank (hereafter, Opposer) filed a notice of opposition alleging priority and likelihood of confusion with its use-based application for the standard character mark YOUR

BANK. FOR LIFE. for “banking services; investment management, namely, fiduciary representation services and financial planning services” in International Class 36 (Application Serial No. 87606287, filed September 13, 2017). CU Applicant’s application was cited as a potential bar to Opposer’s application, which now is suspended pending the outcome of this opposition.

With the present consent motion, the parties refer to geographic restriction of both the CU Applicant’s application and Opposer’s application, which is not yet under the Board’s jurisdiction.

#### CONCURRENT USE PROCEEDINGS

The burden of proof in a concurrent use proceeding requires the plaintiff (CU Applicant) to establish facts which would show that there is no likelihood of confusion arising from the parties’ concurrent use of similar marks in their respective geographic areas. *See CDS, Incorporated v. I.C.E.D. Management, Inc.*, 80 USPQ2D 1572, 1574 (TTAB 2006). For the duration of this proceeding, the parties must inform the Board promptly in writing if they own any other application or registration which is for the same or similar mark, and same or similar goods and/or services, and thus should be added to the proceeding. *See Boi Na Braza LLC v. Terra Sul Corp.*, 110 USPQ2d 1386, 1389 n.10 (TTAB 2014); Trademark Trial and Appeal Board Manual of Procedure (TBMP) §1104 (2018).<sup>1</sup>

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<sup>1</sup> The Board notes that the parties are involved in Opposition No. 91239533. Because the opposed mark is not the same or similar, the mark in application Serial No. 87372171 will not be added to any concurrent use proceeding which follows termination of this opposition.

While the parties' consent motion does not state that there is a concurrent use settlement agreement between the parties, most consent motions to amend to concurrent use are part of an agreement which provides for the issuance to the concurrent use applicant(s) of the concurrent registration(s) sought. If this is the case here, the parties are advised that Board will not enter judgment on behalf of the concurrent use applicant(s), and find such applicant(s) entitled to concurrent registration on the basis of a settlement agreement, unless the terms of the agreement are sufficient to persuade the Board that confusion, mistake, or deception is not likely to result from the continued concurrent use by the parties of their marks. The parties may wish to consult TBMP § 1110 for a discussion of provisions which have been found to avoid likelihood of confusion between marks in concurrent use.

#### REQUIREMENTS FOR AMENDMENT TO CONCURRENT USE

An application for registration of a mark based on use in commerce under Trademark Act Section 1(a) may be amended to an application for concurrent use registration, provided that the concurrent use application as amended meets the requirements of Trademark Rule 2.42, 37 C.F.R. § 2.42. *See* Trademark Rule 2.73, 37 C.F.R. § 2.73. Under Trademark Rule 2.42(b), a concurrent use application must include a verified statement indicating, to the extent of the applicant's knowledge:

- (1) For a trademark or service mark, the geographic area in which the applicant is using the mark in commerce; for a collective mark or certification mark, the geographic area in which the applicant's members or authorized users are using the mark in commerce;
- (2) For a trademark or service mark, the applicant's goods or services; for a collective trademark, collective service mark, or certification mark, the applicant's members' or authorized users' goods or services; for a collective

membership mark, the nature of the applicant's collective membership organization;

(3) The mode of use for which the applicant seeks registration;

(4) The concurrent users' names and addresses;

(5) The registrations issued to or applications filed by such concurrent users, if any;

(6) For a trademark or service mark, the geographic areas in which the concurrent user is using the mark in commerce; for a collective mark or certification mark, the geographic areas in which the concurrent user's members or authorized users are using the mark in commerce;

(7) For a trademark or service mark, the concurrent user's goods or services; for a collective trademark, collective service mark, or certification mark, the concurrent user's members' or authorized users' goods or services; for a collective membership mark, the nature of the concurrent user's collective membership organization;

(8) The mode of use by the concurrent users or the concurrent users' members or authorized users; and

(9) The time periods of such use by the concurrent users or the concurrent users' members or authorized users.

Additionally, "[i]n an application for concurrent use under § 2.42, the verified statement in paragraph (b)(1)<sup>2</sup> must be modified to indicate that no other person except as specified in the application has the right to use the mark in commerce."

Trademark Rule 2.33(f); *see also* TMEP § 1207.04(d)(i).

Finally, the concurrent use application must contain a concurrent use statement in the following form:

Subject to Concurrent Use Proceeding with Old National Bank, a chartered bank with an address of 1 Main Street, Evansville, Indiana 47708.

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<sup>2</sup> Trademark Rule 2.33(b)(1), 37 C.F.R. § 2.33(b)(1), requires a verified statement:

That the applicant believes the applicant is the owner of the mark; that the mark is in use in commerce; that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when applied to the goods or services of such other person, to cause confusion or mistake, or to deceive; that the specimen shows the mark as used on or in connection with the goods or services; and that the facts set forth in the application are true.

Applicant claims the exclusive right to use the mark in the area comprising the states of Texas, Louisiana, New Mexico, Oklahoma, California, Arizona, Colorado, Utah, Nevada, Oregon and Washington.

CU Applicant's proposed amendment is not accompanied by the requisite verified statement pursuant to Trademark Rules 2.33(f) and 2.42(b), and does not include the required concurrent use statement.<sup>3</sup> A proper consent motion to amend to concurrent use will include these elements.

**INSTITUTION OF THE CONCURRENT USE PROCEEDING WILL BE FOLLOWED BY SUSPENSION**

When all requirements for amending the CU Applicant's application Serial No. 87315217 are met, the concurrent use proceeding will be instituted with Opposer listed as an excepted user (one who relies on common law trademark rights), but the Board will suspend proceedings so that Opposer may amend its application Serial No. 87606287 to seek concurrent use and, after the opposition period has passed, be joined to this proceeding as the owner of a pending concurrent use application. *See* TBMP § 1104. When both applications are part of the concurrent use proceeding, the Board will resume proceedings and the CU Applicant may prove its entitlement to the concurrent use registration in litigation or the parties may submit a concurrent use settlement agreement as described above.

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<sup>3</sup> Regarding the language for verification, 37 C.F.R. § 2.20 provides that instead of an oath, affidavit, or sworn statement, the following declaration language may be used: "The signatory being warned that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and that such willful false statements and the like may jeopardize the validity of the application or submission or any registration resulting therefrom, declares that all statements made of his/her own knowledge are true and all statements made on information and belief are believed to be true."

SUMMARY

Accordingly, CU Applicant's consent motion to amend its unrestricted application to a concurrent use application is denied without prejudice.

CU Applicant is allowed THIRTY DAYS from the mailing date of this order to file a proper consent concurrent use amendment, failing which the Board will resume proceedings as to the unrestricted application.

Proceedings are SUSPENDED pending CU Applicant's response to this order.