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

Proceeding	91239532
Party	Defendant American National Bank of Texas
Correspondence Address	LEKHA GOPALAKRISHNAN WINSTEAD PC 2728 NORTH HARWOOD ST STE 500 DALLAS, TX 75201 UNITED STATES tmdocket@winstead.com, lgopalakrishnan@winstead.com, awalker@winstead.com, lgopalakrishnan@winstead.com 214-745-5356
Submission	Motion to Amend Application
Filer's Name	Lekha Gopalakrishnan
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Signature	/Lekha Gopalakrishnan/
Date	02/22/2019
Attachments	91239532_AmendedConsentMotion.pdf(256094 bytes)

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

In the Matter of Application No. 87/315,217
For the Trademark YOUR BANK. FOR LIFE.

Old National Bank,	§	
	§	
Opposer,	§	
	§	
v.	§	Opposition No. 91239532
	§	
	§	
American National Bank of Texas	§	
	§	
Applicant.	§	

**AMENDED CONSENT MOTION TO AMEND APPLICATION
TO ONE SEEKING CONCURRENT USE REGISTRATION**

In response to the Board’s order dated January 24, 2019, American National Bank of Texas (“Applicant”) hereby submits an amended motion requesting that Application No. 87/315,217 be amended to one seeking concurrent use registration. This motion is being filed with Opposer’s consent. The basis for the motion and the related facts are set forth herein, and in the accompanying signed Verified Statement and signed Settlement Agreement.

1. Applicant seeks concurrent registration of the mark "YOUR BANK. FOR LIFE." for "Banking services," in the geographic area comprising the states of Texas, Louisiana, New Mexico, Oklahoma, California, Arizona, Colorado, Utah, Nevada, Oregon and Washington.
2. Applicant is providing banking services since at least as early as June 30, 2012 under the mark "YOUR BANK. FOR LIFE." which is used in advertising the services through print advertising, Internet advertising, and other forms of advertising for services.
3. Applicant claims an exception to its exclusive use of the mark "YOUR BANK. FOR LIFE." by Old National Bank (“Opposer”), a chartered bank with an address of 1 Main Street, Evansville, Indiana 47708, who is the owner of Application No. 87/606,287 for the mark YOUR BANK. FOR LIFE. filed on September 13, 2017.

4. Opposer asserts that it has used the mark YOUR BANK. FOR LIFE. for “banking services; investment management, namely, fiduciary representation services and financial planning services” since 1979.
5. Opposer claims the right to exclusive use of the mark for the area comprising the entire United States except the states of Texas, Louisiana, New Mexico, Oklahoma, California, Arizona, Colorado, Utah, Nevada, Oregon and Washington.
6. Applicant’s date of first use in commerce (at least as early as June 30, 2012) is prior to the filing date of Opposer’s pending application.
7. Applicant has entered into a settlement agreement with Opposer with respect to the proposed concurrent use amendment, a signed copy of which is attached hereto.
8. As set forth in the accompanying signed verified statement, Applicant states that no other person except as specified in the application has the right to use the mark.
9. Subject to a Concurrent Use Proceeding with Old National Bank, a chartered bank with an address of 1 Main Street, Evansville, Indiana 47708, 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.

This Motion to Amend is being filed with Opposer’s consent. Based on the foregoing, and the attached settlement agreement and verified statement, Applicant respectfully requests that Application No. 87/315,217 be amended to one seeking concurrent use registration, that this opposition proceeding be terminated, and that a concurrent use proceeding be initiated.

Date: February 22, 2019

Respectfully submitted,

/Lekha Gopalakrishnan/

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ATTORNEYS FOR OPPOSER
Old National Bank

CERTIFICATE OF SERVICE

The undersigned certifies that a true and correct copy of the foregoing has been served on this 22nd day of February 2019, by electronic mail to the following persons:

Caitlin R. Byczko
Caitlin.Byczko@btlaw.com
Julia Gard
Julia.Gard@btlaw.com
Joe Witkowski
Joe.Witkowski@btlaw.com

ATTORNEYS FOR OPPOSER
Old National Bank

/Lekha Gopalakrishnan/

CERTIFICATE OF ELECTRONIC FILING

The undersigned hereby certifies that the foregoing is being submitted electronically through the Electronic System for the Trademark Trial and Appeal Board (“ESTTA”) on this 22nd day of February 2019.

/Lekha Gopalakrishnan/

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

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	§	
American National Bank of Texas	§	
	§	
Applicant.	§	

VERIFIED STATEMENT UNDER 37 C.F.R. 2.42


Pursuant to 37 C.F.R. § 2.42(b), Applicant submits the following verified statement that indicates the following, to the extent of the applicant's knowledge:

1. Applicant is using the mark in its physical branch locations in Texas as well as on its website www.anbtx.com.
2. Applicant has been using the mark in connection with banking services since at least as early as June 30, 2012.
3. Applicant seeks registration of the mark for the advertising of banking services through print advertising, Internet advertising, and other forms of advertising for services.
4. The concurrent user is Old National Bank, a chartered bank with an address of 1 Main Street, Evansville, Indiana 47708.
5. The concurrent user's pending application is Application No. 87/606,287, which was filed on September 13, 2017.
6. The concurrent user is using the mark on its website www.oldnational.com.

7. The concurrent user is using the mark in connection with banking services; investment management, namely, fiduciary representation services and financial planning services.
8. The concurrent user is using the mark for the advertising of banking services through Internet advertising.
9. The concurrent user asserts a date of first use of at least as early as 1979 in its application.
10. To the best of Applicant's knowledge, and upon information and belief, no other person except as specified in the application has the right to use the mark in commerce.

I hereby declare further that all statements made herein of my own knowledge are true, and that all statements made on information and belief are to be true; and further that these statements are made with the knowledge that false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States code, and that such false statements may jeopardize the validity of the application or any trademark registration issuing therefrom.

This affidavit and declaration is executed on this 22ND day of February, 2019.




Sharon L. Lee
Sr. EVP, American National Bank of Texas

Settlement Agreement

THIS AGREEMENT, executed as of the date of signing set forth below, is entered into by and between American National Bank of Texas (“Applicant”) a chartered bank with an address of P.O. Box 40 Terrell TEXAS 75160, and Old National Bank (“Opposer”) a chartered bank with an address of 1 Main Street Evansville INDIANA 47708.

WHEREAS, Applicant has used the mark “YOUR BANK. FOR LIFE.” for banking services in commerce since at least as early as June 30, 2012, and has applied to register its mark on the Principal Register of the United States Patent and Trademark Office, Serial No. 87/315217; and



WHEREAS, Applicant has used the mark  for banking services in commerce since at least as early as April 30, 2000, and has applied to register its mark on the Principal Register of the United States Patent and Trademark Office, Serial No. 87/372171; and

WHEREAS, Opposer has used the mark YOUR BANK. FOR LIFE for banking services and investment management, namely, fiduciary representation services and financial planning services in commerce since at least as early as 1979, and has applied to register its mark on the Principal Register of the United States Patent and Trademark Office, Serial No. 87/606287; and

WHEREAS, Opposer filed Notices of Opposition opposing registration of Applicant’s marks, Opposition No. 91239532 and 91239533; and

WHEREAS, the parties hereto recognize the validity of each other’s use of their respective marks in connection with their respective goods and services and wish to avoid any conflict with the other’s use or registration of its mark; and

WHEREAS, the parties have been using their respective marks concurrently in connection with their respective services since at least June 30, 2012 and to the knowledge of the respective parties, such use has not resulted in any instances of actual confusion; and

WHEREAS, the parties hereto have concluded that confusion is not likely to arise from their use and concurrent registration of their respective marks in connection with their respective goods and services for the following reasons: the marks at issue are distinct, the channels of trade are distinct, and the parties shall take action and work in good faith to avoid confusion;

NOW, THEREFORE, in consideration of the mutual promises set forth herein and for other good and valuable consideration, the receipt and sufficiency of which are hereby acknowledged, the parties hereto agree as follows:


1. Applicant agrees to amend Serial No. 87/315217 to limit the registration of its mark to Texas, Louisiana, New Mexico, Oklahoma, California, Arizona, Colorado, Utah, Nevada, Oregon and Washington (“Applicant’s Territory”). Applicant shall not use the YOUR BANK. FOR LIFE. term as a stand-alone trademark outside of Applicant’s Territory.
2. Opposer agrees to amend Serial No. 87/606287 to exclude exclusive rights to Texas, Louisiana, New Mexico, Oklahoma, California, Arizona, Colorado, Utah, Nevada, Oregon and Washington.

3. Applicant shall use the YOUR BANK. FOR LIFE. mark on its website only in close association with its name AMERICAN NATIONAL BANK OF TEXAS. Applicant shall not use the YOUR BANK. FOR LIFE. mark on any of its outward facing signage at any of its physical locations outside of Applicant's Territory.

4. Applicant shall prepare the documentation necessary to convert Opposition No. 91239532 to a concurrent use proceeding and provide draft forms of the documents necessary to convert the proceeding to counsel for Opposer by no later than 7 days after the execution date of this Agreement.


5. By no later than 14 days after the execution date of this Agreement, Opposer will file a stipulated motion to withdraw Opposition Proceeding No. 91239533 without prejudice. Counsel for Applicant will provide the relevant signature necessary to finalize this document.

6. Opposer agrees to take no action to interfere with the use or registration of Applicant's YOUR. BANK.

FOR LIFE. or  AMERICAN NATIONAL BANK OF TEXAS
Your Bank. For Life. mark by Applicant for the services outlined in Serial Nos. 87/315217 and 87/372171, so long as Applicant complies with the terms of this Agreement.

7. Applicant agrees to take no action to interfere with the use or registration of Opposer's mark by Opposer for the services set forth above.

8. Applicant hereby agrees to Opposer's registration of Serial No. 87606287 as amended in Section 2.

9. If at any point the Applicant ceases use of the YOUR. BANK. FOR LIFE. or  AMERICAN NATIONAL BANK OF TEXAS
Your Bank. For Life. in commerce for a period of more than 12 months, Opposer shall have the right to file a new application with the USPTO to cover all of the United States and not exclude Applicant's Territory.


10. The parties agree to execute and file with the Patent and Trademark Office any and all documents that may be necessary or proper to effectuate the terms of this Agreement, including the registration of the parties' respective marks or additional consent documents.

11. The parties agree to continue taking reasonable action to prevent any confusion due to the concurrent use, coexistence and registration of their respective marks, to notify each other of any incidences of actual confusion of which they became aware, and to take reasonable action to correct such confusion.

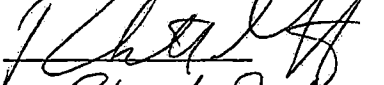
12. This Agreement contains the entire agreement between the parties and may only be amended or supplemented in a writing signed by both parties.

IN WITNESS WHEREOF, the parties hereto enter into this Agreement on the last date set forth below.

American National Bank of Texas

By: 
Name: Sharon L. Lee
Title: Sr. EVP
Dated: 1/4/2019

Old National Bank

By: 
Name: Rhett D. Costerman
Title: Asst General Counsel
Dated: 1-7-2019