

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

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Associates in Financial Planning, Inc.,  
d/b/a The AFP Group,

Opposer,

vs.

The AFP Group,

Applicant.  
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Opposition No. 91159774

In the matter of Ser. No. 75/805795

Published in the Official Gazette on  
September 9, 2003

  
03-29-2004

U.S. Patent & TMO/c/TM Mail Rcpt Dt. #78

**APPLICANT'S ANSWER**

Applicant The AFP Group (hereinafter "Applicant") hereby answers the Notice of Opposition (hereinafter the "Opposition") of Associates in Financial Planning, Inc. d/b/a The AFP Group (hereinafter "Opposer"). Any allegation not specifically admitted hereinafter is denied by Applicant.

1. Upon information and belief, Applicant The AFP Group (hereinafter "Applicant"), is a Texas corporation with an address of 1300 Post Oak Blvd., Suite 1200, Houston, Texas 7705.

ANSWER. Applicant admits the allegations contained in paragraph 1.

2. Upon information and belief, Applicant seeks to register the mark AFP GROUP for goods identified as "printed matter, namely financial newsletters and financial reports" in International Class 16.

ANSWER: Applicant admits the allegations contained in paragraph 2.

3. Upon information and belief, this application was filed on September 22, 1999 and was published for opposition on page TM 294 of the Official Gazette on September 9, 2003.

ANSWER: Applicant admits the allegations contained in paragraph 3.

4. Opposer Associates in Financial Planning, Inc, which does business as The AFP Group (hereinafter "Opposer") is a California corporation having a principal place of business at 12100 Wilshire Boulevard, Suite 500, Los Angeles California 90025.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth of the allegations contained in paragraph 4, therefore Applicant denies the truth of the allegations contained in paragraph 4.

5. Opposer offers financial and insurance services, including financial advisory services, financial planning, estate planning, tax planning, portfolio management and asset allocation, financial analysis and consultation, insurance consultation, and provides financial reports and materials in connection therewith.

ANSWER: Applicant denies the truth of the allegations contained in paragraph 5.

6. Upon information and belief, Opposer adopted and began using the trademark THE AFP GROUP well prior to the Applicant's filing date and well prior to the date of first use claimed by the Applicant.

ANSWER: Applicant denies the truth of the allegations contained in paragraph 6.

7. Opposer is the owner of U.S. Application No. 75876591 for the mark THE AFP GROUP "for financial and insurance services, namely, comprehensive financial planning; financial planning to maintain desired cash flow; estate planning; tax planning; financial planning and consultation for charitable giving; portfolio management and asset allocation; financial analysis and consultation for funding college education, for salary continuation in the case of death or terminal illness, for disability plans, for retirement funding strategies, and for qualified and non-qualified retirement plans; insurance consultation; risk management and insurance consultation with regard to equity investment transactions, executive compensation plans, deferred compensation plans and employee benefit plans in International Class 36 and "business planning; business consultation" in International Class 35, filed on December 21, 1999.

ANSWER: Applicant admits Opposer has filed an application which has been assigned Serial No. 75/876,591, but denies the remainder of the allegations contained in paragraph 7.

8. Opposer is also the owner of U.S. Application No. 75876590 for the mark THE AFP GROUP & Design for “financial and insurance services, namely, comprehensive financial planning; financial planning to maintain desired cash flow; estate planning; tax planning; financial planning and consultation for charitable giving; financial portfolio management including asset allocation; financial analysis and consultation for funding college education, for salary continuation in the case of death or terminal illness, for disability plans, for retirement funding strategies, and for qualified and non-qualified retirement plans; insurance consultation; risk management and insurance consultation with regard to equity investment transactions, executive compensation plans, deferred compensation plans and employee benefit plans” in International Class 36 and “Business planning; business consultation” in International Class 35 filed on December 21, 1999.

ANSWER: Applicant admits Opposer has filed an application which has been assigned Serial No. 75/876,590 but denies the remainder of the allegations contained in paragraph 8.

9. Opposer’s THE AFP GROUP and THE AFP GROUP & Design trademarks are of significant value to Opposer as identifications of source in connection with the promotion and offering of its products and services.

ANSWER: Applicant is without knowledge sufficient to form a belief as to the truth of the allegations contained in paragraph 9, therefore Applicant denies the truth of the allegations contained in paragraph 9.

10. Applicant’s use of the mark AFP GROUP in connection with printed matter, namely, financial newsletters and financial reports is likely to cause confusion with Opposer’s THE AFP GROUP and THE AFP GROUP & Design marks as used in connection with its financial services.

ANSWER: Applicant denies the truth of the allegations contained in paragraph 10.

11. Applicant’s use of the mark AFP GROUP in connection with printed matter, namely, financial newsletters and financial reports will result in confusion, mistake, and/or deception in that the public will wrongly assume that Opposer has approved of Applicant, is affiliated with Applicant, or has otherwise sanctioned or sponsored the goods and services of Applicant.

ANSWER: Applicant denies the truth of the allegations contained in paragraph 11.

12. Opposer would be damaged by the registration of the mark AFP GROUP by Applicant as the registration will result in confusion, mistake, and/or deception, and Applicant will be able to trade on Opposer 's goodwill and reputation.

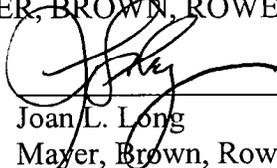
ANSWER: Applicant denies the truth of the allegations contained in paragraph 12.

Respectfully submitted,

MAYER, BROWN, ROWE & MAW

Dated: March 29, 2004

By:

  
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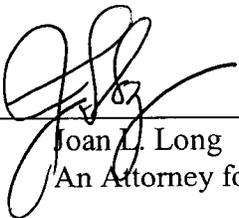
Attorney for Applicant  
THE AFP GROUP

**CERTIFICATE OF SERVICE**

I certify that on this date a copy of the foregoing **APPLICANT'S ANSWER** was served by overnight delivery on counsel for Opposer at the following address:

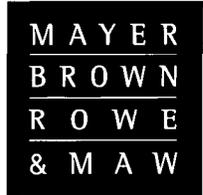
Norman Zafman  
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Dated: March 29, 2004

  
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March 29, 2004

Via E-Mail

Mr. Gilbert Baker  
The AFP Group  
1300 Post Oak Blvd., Ste. 120  
Houston, TX 77056-3010



03-29-2004

U.S. Patent & TMO/TM Mail Rcpt Dt. #78

Re: Opposition filed by AFP Group in LA

Dear Mr. Baker:

We have now received the second opposition filed by the AFP Group in LA, this time against the application of the AFP GROUP mark. As you may recall, this LA firm also filed an opposition on January 7, 2004 against the application for THEAFPGROUP.COM mark. I have enclosed a copy of the opposition, our answer and a schedule for discovery and briefs set by the Trademark Trial and Appeal Board. These oppositions are in addition to the oppositions filed by Agence France Presse that are still pending despite my repeated efforts offering a reasonable consent agreement.

Given our effort to try and resolve the French Press oppositions, we should discuss whether we should also try to resolve the LA firm oppositions through negotiations. I know you had a prior relationship with these individuals, but I don't know if a settlement is something you want to offer them. Given the cost of maintaining oppositions proceedings against two different parties, and the French Press' unwillingness to negotiate (despite their weak opposition case) we may be more successful in trying to negotiate a settlement with the LA Group. I look forward to discussing this with you after you have had an opportunity to review the enclosed material.

Sincerely,

Joan L. Long

JLL:tpa  
Enclosure  
cc: David Ronn

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Brussels Charlotte Chicago Cologne Frankfurt Houston London Los Angeles Manchester New York Palo Alto Paris Washington, D.C.  
Independent Mexico City Correspondent: Jauregui, Navarrete, Nader y Rojas, S.C.

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