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

Proceeding	91184538
Party	Defendant MidFirst Bank
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Date	08/20/2008
Attachments	Answer.pdf (7 pages)(305122 bytes)

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

Commerce Bancorp, Inc.)
)
 Opposer,)
)
 v.) Opposition No. 91184538
)
 MidFirst Bank,)
)
 Applicant.)

In re: Application Serial No. 77/353,689
Published in the Official Gazette on May 13, 2008
Mark: MORE CONVENIENCE

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
PO Box 1451
Alexandria, Virginia 22313-1451

APPLICANT'S ANSWER TO NOTICE OF OPPOSITION

Applicant, MidFirst Bank, a federally chartered savings association ("Applicant"), for its answer to the Notice of Opposition filed by Opposer, Commerce Bancorp, Inc. ("Opposer"), in the above-captioned case, alleges and states as follows:

1. Applicant admits that United States Trademark Registration No. 2,890,738 for the mark AMERICA'S MOST CONVENIENT BANK and United States Trademark Registration No. 3,204,243 for the mark MOST CONVENIENT BANK list Commerce Bancorp, Inc., a New Jersey corporation, as the Registrant. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the averments set forth in paragraph 1 and based thereon denies each and every such averment.

2. Applicant admits that United States Trademark Registration Nos. 2,890,738 and 3,204,243 serve as constructive notice of the Registrant's claim of ownership thereof. Applicant

is without knowledge or information sufficient to form a belief as to the truth of the remainder of the averments set forth in paragraph 2 and based thereon denies each and every such averment.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 3 and based thereon denies each and every such averment.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 4 and based thereon denies each and every such averment.

5. Applicant admits that on December 17, 2007, Applicant filed an application in the United States Patent and Trademark Office (the "USPTO") to register MORE CONVENIENCE on the Principal Register of the USPTO for banking services in International Class 36. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the averments set forth in paragraph 5 and based thereon denies each and every such averment. At this time, Applicant does not know what "Opposer's services" entail.

6. Applicant admits that the opposed application was filed on December 17, 2007 and claims a date of first use in commerce of February 1, 2006, both of which are subsequent to the filing date and claimed date of first use in commerce referenced in Opposer's U.S. Trademark Registration No. 2,890,738 for AMERICA'S MOST CONVENIENT BANK. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the averments set forth in paragraph 6 and based thereon denies each and every such averment.

7. Applicant denies the averments set forth in paragraph 7 of the Notice of Opposition and demands strict proof thereof.

8. Applicant admits that the term “convenience” can be used as a noun meaning suitable and handy, and that the term “convenient” can be used as an adjective also meaning suitable and handy. Applicant further admits that both the mark MORE CONVENIENCE and the mark MOST CONVENIENT BANK begin with an adjective. Applicant further admits that its mark contains the adjective MORE and Opposer’s marks AMERICA’S MOST CONVENIENT BANK and MOST CONVENIENT BANK contain the adjective MOST, both adjectives denoting “having an additional quality” and being superlatives of the term “many.” Applicant denies the remaining averments of paragraph 8 and demands strict proof thereof.

9. Applicant denies the averments set forth in paragraph 9 of the Notice of Opposition and demands strict proof thereof.

10. Applicant denies that there is a likelihood of confusion between Opposer’s MOST CONVENIENT marks and Applicant’s MORE CONVENIENCE mark. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remainder of the averments set forth in paragraph 10 and based thereon denies each and every such averment.

11. Applicant is without knowledge or information sufficient to form a belief as to the truth of the averments set forth in paragraph 11 and based thereon denies each such averment.

12. Applicant denies the averments set forth in paragraph 12 of the Notice of Opposition and demands strict proof thereof.

13. Applicant denies the averments set forth in paragraph 13 of the Notice of Opposition and demands strict proof thereof.

AFFIRMATIVE DEFENSES

In further answer to the Notice of Opposition, Applicant asserts the following:

14. Applicant affirmatively alleges that there is not a likelihood of confusion, mistake or deception under Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d), because Applicant's mark, when used in association with banking services, is not confusingly similar to the MOST CONVENIENT marks referred to by Opposer in the Notice of Opposition. The MOST CONVENIENT marks pleaded by Opposer are, at most, suggestive of the recited services and are therefore not entitled to a broad scope of protection. As a result, the differences between Applicant's mark and all of Opposer's pleaded marks are sufficient to negate a likelihood of confusion.

15. Applicant affirmatively alleges that as between Opposer's mark MOST CONVENIENT BANK, as shown by United States Trademark Registration No. 3,204,243, and the opposed mark, Applicant has priority.

16. Applicant affirmatively alleges that Opposer is barred from bringing this proceeding due to its unclean hands.

COUNTERCLAIM

Applicant, MidFirst Bank ("Applicant") alleges for its counterclaim:

17. In accordance with 37 C.F.R. § 2.106(b)(2), Applicant hereby counterclaims for cancellation of Opposer's United States Trademark Registration No. 3,204,243 for the mark MOST CONVENIENT BANK in its entirety.

18. Applicant has standing to assert this counterclaim. United States Trademark Registration No. 3,204,243 (hereinafter the "'243 Registration") issued on January 30, 2007. Opposer has pleaded the '243 Registration in the present opposition proceeding.

19. The application for the '243 Registration was filed on February 14, 2002 based on Applicant's alleged bona fide intent to use the mark in commerce pursuant to Section 1(b) of the

Lanham Act, 15 U.S.C. § 1051(b). As stated in an Examiner's Amendment mailed June 28, 2002, Applicant subsequently authorized the Examining Attorney to amend the basis for registration set forth in the application as follows:

The applicant seeks registration under **Trademark Act Section 2(f)** and states that

The wording "most convenient" has become distinctive of the services as evidenced by ownership of U.S. Reg. Nos. 2462917 and 2260060 for the same mark for related services.

Based on this amendment and pursuant to a Notice of Allowance issued on September 14, 2004, the application was allowed. A statement of use was ultimately submitted on September 27, 2006. The statement of use claims that the mark was first used at least as early as September 25, 2006 and first used in commerce at least as early as September 25, 2006.

20. Applicant's basis for registration under Section 2(f) of the Trademark Act, 15 U.S.C. § 1052(f), in the application for the '243 Registration was invalid. In accordance with 37 C.F.R. § 2.41(b), in appropriate cases, ownership of one or more prior registrations on the Principal Register or under the Act of 1905 of the same mark may be accepted as *prima facie* evidence of distinctiveness. (*emphasis added*). However, the mark of both of the registrations cited by the registrant in the 2(f) claim, AMERICA'S MOST CONVENIENT BANK, was not the same as the mark for which registration was being sought, MOST CONVENIENT BANK. Furthermore, neither one of the cited registrations, U.S. Registration Nos. 2,462,917 and 2,260,060 are prior registrations on the Principal Register as required by 37 C.F.R. §2.41(b). U.S. Registration Nos. 2,462,917 and 2,260,060 are both supplemental registrations and therefore cannot serve as the basis for a 2(f) claim. Thus, the 2(f) claim was improper and the application should not have been allowed. As a result, the '243 Registration is invalid and should be canceled.

21. Due to the fact that the '243 Registration is invalid, Opposer is not entitled to use the filing date of the corresponding application as its priority date for the MOST CONVENIENT BANK mark. Based on the application for the '243 Registration, the mark MOST CONVENIENT BANK was first used anywhere and in commerce on September 25, 2006. This is after Applicant's date of first use in commerce of the MORE CONVENIENCE mark, January 1, 2006. Thus, as between the mark MOST CONVENIENT BANK and the mark MORE CONVENIENCE, Applicant, not Opposer, has priority to the mark. The '243 Registration should also be canceled on this basis.

WHEREFORE, Applicant prays that the Notice of Opposition be dismissed in its entirety, with prejudice, and that a registration issue to Applicant for its mark. Applicant also prays that United States Trademark Registration No. 3,204,342 be canceled in its entirety.

Please direct all further correspondence in this case to:

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Respectfully submitted,

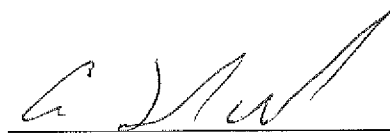


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CERTIFICATE OF SERVICE

This is to certify that on this 20th day of August 2008, a copy of the foregoing Applicant's Answer to Notice of Opposition, including the associated Counterclaim was sent by Federal Express to:

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Grossman, Tucker, Perreault & Pflieger, PLLC
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Manchester, NH 03101
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