

ESTTA Tracking number: **ESTTA578537**

Filing date: **12/23/2013**

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

Proceeding	91213603
Party	Defendant AmFirst Holdings, Inc.
Correspondence Address	STEPHEN J. CARMODY BRUNINI LAW FIRM PO BOX 119 JACKSON, MS 39205-0119 UNITED STATES scarmody@brunini.com
Submission	Answer
Filer's Name	Stephen Carmody
Filer's e-mail	scarmody@brunini.com, smartin@brunini.com
Signature	/sjc/
Date	12/23/2013
Attachments	Answer and Affirmative Defenses (01725029).pdf(18050 bytes)

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

In Re: Application Serial No. 85/394,861
For the Mark: AmFirst Insurance Company (and design)
Filed: August 10, 2011
Published in the Official Gazette: October 22, 2013

)	
AmFirst Bank, N.A.)	
)	
Opposer,)	
)	
v.)	Opp. No. 91213603
)	
AmFirst Holdings, Inc.)	
)	
Applicant.)	
)	

ANSWER AND AFFIRMATIVE DEFENSES

AmFirst Holdings, Inc. (“Applicant”) responds to AmFirst Bank, N.A.’s (“Opposer”) Notice of Opposition (“Opposition”) as follows:

FIRST DEFENSE

The Opposition fails to state a claim upon which relief may be granted, and thus, the Opposition should be dismissed.

SECOND DEFENSE

There is no likelihood of confusion, mistake or deception because, *inter alia*, the AF Insurance Mark and the marks of the Opposer are not confusingly similar.

THIRD DEFENSE

Opposer’s claims are barred by the doctrines of laches, acquiescence, and estoppel.

FOURTH DEFENSE

Opposer's claims are barred by the doctrine of unclean hands.

FIFTH DEFENSE

As a result of Applicant's continuous use of the AF AmFirst Insurance Company mark (which is the subject of this Objection and hereinafter referred to as the "AF Insurance Mark") since the time of Applicant's adoption thereof, the AF Insurance Mark has developed significant goodwill among the consuming public and consumer acceptance of the services offered by Applicant in conjunction with the AF Insurance Mark. Such goodwill and widespread usage has caused the mark to acquire distinctiveness with respect to Applicant, and caused the AF Insurance Mark to become a valuable asset of Applicant.

SIXTH DEFENSE

Applicant intends to rely on all other affirmative defenses that may become available or apparent during the course of discovery and therefore reserves the right to amend its Answer and Affirmative Defenses to assert all such defenses.

SEVENTH DEFENSE

Having raised these affirmative defenses and without waiving them, Applicant responds paragraph by paragraph to the particular allegations of the Opposition as follows:

To the extent necessary, Applicant denies the allegations set forth in the first, unnumbered paragraph of the Opposition.

To the extent necessary, Applicant denies the allegations set forth in the second, unnumbered paragraph of the Opposition.

1. Applicant admits that it is a Mississippi corporation located 5722 I-55 North Frontage Road, Jackson, Mississippi 39211. Applicant further admits that on August 10, 2011, it

filed USPTO trademark application 85394861, which speaks for itself. Applicant denies the remaining allegations in paragraph 1 of the Opposition.

2. Applicant admits that Opposer owns federal trademark registrations: 4141673, 2305835, 4141675, 4141677 (which Applicant agrees to refer to collectively as the “AMFIRST BANK Marks”) but states that the registrations for those marks speak for themselves. Applicant admits that trademark reports from the United States Patent and Trademark Office (“USPTO”) are attached as Exhibit A to the Opposition. Applicant denies the remaining allegations contained in paragraph 2 of the Opposition.

3. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 3 of the Opposition and therefore denies the same.

4. Applicant admits that the AMFIRST BANK Marks were filed with the USPTO before Applicant filed application 85394861 with the USPTO. Applicant denies the remaining allegations in paragraph 4 of the Opposition.

5. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in paragraph 5 of the Opposition and therefore denies the same.

6. Applicant denies the allegations in paragraph 6 of the Opposition.

7. Applicant admits that on August 10, 2011, it filed USPTO trademark application 85394861, which speaks for itself. Applicant denies the remaining allegations in paragraph 7 of the Opposition.

8. Applicant admits that in its USPTO trademark application 85394861, Applicant noted that the first AF Insurance Mark use anywhere was at least as early as December 30, 1998,

and its first use in commerce was at least as early as December 30, 1998. Applicant denies the remaining allegations in paragraph 8 of the Opposition.

9. Applicant denies the allegations in paragraph 9 of the Opposition. Applicant holds Opposer to strict proof on the use of marks relating to insurance related services.

10. Applicant denies the allegations in paragraph 10 of the Opposition.

11. Applicant denies the allegations in paragraph 11 of the Opposition.

12. Applicant denies the allegations in paragraph 12 of the Opposition.

13. Applicant denies the allegations in paragraph 13 of the Opposition.

14. Applicant denies the allegations in paragraph 14 of the Opposition.

15. Applicant denies the allegations in paragraph 15 of the Opposition.

16. Applicant denies the allegations in paragraph 16 of the Opposition.

17. Applicant denies the allegations in paragraph 17 of the Opposition.

18. Applicant admits that if it were granted registration of the AF Insurance Mark, Applicant would obtain at least a prima facie exclusive right to the use of the subject mark. Applicant denies the remaining allegations in paragraph 18 of the Opposition.

WHEREFORE, given Applicant's responses to the Opposition, Applicant respectfully requests that the Trademark Trial and Appeal Board ("TTAB") grant the following relief:

- (a) That the Opposition be dismissed with prejudice and judgment be granted in Applicant's favor;
- (b) That the TTAB award Applicant its attorneys' fees in connection with this litigation, this being an exceptional case;
- (c) That the TTAB award Applicant its costs in connection with this litigation; and

(d) That the TTAB award Applicant such other and further relief as the TTAB deems appropriate.

Dated: December 23, 2013.

Respectfully submitted,

AMFIRST HOLDINGS, INC.

By: /s/ Stephen J. Carmody
One of Its Attorneys

OF COUNSEL:

Stephen J. Carmody, MSB # 8345
Norman E. "Benje" Bailey, Jr., MSB # 100053
Brunini, Grantham, Grower & Hewes, PLLC
Post Office Drawer 119 (39205)
190 East Capitol Street, Suite 100
Jackson, Mississippi 39201
Telephone: (601) 948-3101
Facsimile: (601) 960-6902
scarmody@brunini.com
bbailey@brunini.com

CERTIFICATE OF SERVICE

I hereby certify that a true and complete copy of the foregoing Answer and Affirmative Defenses has been served on Stephen J. Horace, Lathrop & Gage LLP, Attorney for Opposer, by mailing said copy on December 23, 2013, via First Class Mail, postage prepaid and via e-mail to:

Stephen J. Horace
Lathrop & Gage LLP
950 Seventeenth Street, Suite 2400
Denver, Colorado 80202-2822
shorace@lathropegage.com
ipdocketing@lathropegage.com

s/ Stephen J. Carmody
Stephen J. Carmody