

ESTTA Tracking number: **ESTTA657124**

Filing date: **02/20/2015**

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

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	FirstBank Holding Company
Granted to Date of previous extension	02/22/2015
Address	12345 West Colfax Avenue Lakewood, CO 80215 UNITED STATES

Attorney information	Joy Allen Woller and Mark A. Meyer Lewis Roca Rothgerber LLP 1200 Seventeenth Street, Suite 3000 Denver, CO 80202 UNITED STATES mmeyer@lrrlaw.com, jwoller@lrrlaw.com, trademarks@lrrlaw.com Phone:(303)623-9000
----------------------	--

Applicant Information

Application No	86218631	Publication date	08/26/2014
Opposition Filing Date	02/20/2015	Opposition Period Ends	02/22/2015
Applicant	FirstBank of Nebraska 201 East 5th Street Wahoo, NE 68066 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2013/12/19 First Use In Commerce: 2013/12/19 All goods and services in the class are opposed, namely: Banking and financing services

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3093479	Application Date	11/03/1999
Registration Date	05/16/2006	Foreign Priority Date	NONE
Word Mark	EFIRSTBANK.COM		

Design Mark	EFIRSTBANK.COM
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1999/12/01 First Use In Commerce: 1999/12/01 banking services and financial services, namely, financial consulting relating to consumer and business accounts; loan financing; insurance consultation; investment and financial management services;and all of the above services also rendered via the Internet

U.S. Registration No.	4103432	Application Date	11/03/2008
Registration Date	02/28/2012	Foreign Priority Date	NONE


Word Mark	1STBANK
-----------	---------



Description of Mark	The mark consists of a shaded square and the non-shaded wording "1STBANK" appearing inside the square with the exception of the letter "S" which is shaded the same as the background of the square, presented such that the wording "1st" is blended together and the letters "NK" are blended together.
---------------------	---

Goods/Services	Class 036. First use: First Use: 2008/08/01 First Use In Commerce: 2008/08/01 Banking services and financial services, namely, financial consulting relating to consumer and business accounts, loan financing, insurance consultation, investment and financial management services, and all of the above services also rendered via the Internet
----------------	--

U.S. Registration No.	4103433	Application Date	11/03/2008
Registration Date	02/28/2012	Foreign Priority Date	NONE

Word Mark	1STBANK		
Design Mark			
Description of Mark	<p>The mark consists of an orange colored square with lighter shades of orange presented as abstract background lining and the wording "1STBANK" inside the square in the color white with the exception of the letter "S" which is the same color as the background of the square, presented such that the wording "1st" is blended together and the letters "NK" are blended together.</p>		
Goods/Services	<p>Class 036. First use: First Use: 2008/08/01 First Use In Commerce: 2008/08/01 Banking services and financial services, namely, financial consulting relating to consumer and business accounts, loan financing, insurance consultation, investment and financial management services, and all of the above services also rendered via the Internet</p>		
U.S. Registration No.	3317078	Application Date	12/11/2003
Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	FIRST BANK		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 036. First use: First Use: 1986/03/06 First Use In Commerce: 1986/03/06 banking, trust, and mortgage lending services

Attachments	75839518#TMSN.png(bytes) 77606306#TMSN.png(bytes) 77606309#TMSN.png(bytes) 78339420#TMSN.png(bytes) FirstBank Notice of Opposition.pdf(210021 bytes)
-------------	---

Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/JOY ALLEN WOLLER/
Name	Joy Allen Woller
Date	02/20/2015

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

FIRSTBANK HOLDING COMPANY,
a Colorado corporation,

Opposer,

v.

FIRSTBANK OF NEBRASKA, a Nebraska
corporation,

Applicant.

Mark FIRSTBANK OF NEBRASKA
Design Mark

Serial No. 86/218631

Published August 26, 2014

NOTICE OF OPPOSITION

Opposer FirstBank Holding Company (“Opposer”) hereby opposes the registration of the FIRSTBANK OF NEBRASKA SERVING OUR COMMUNITIES ...INVESTING IN YOU mark shown in Application Serial No. 86/218631 (the “ ‘631 Application”) filed on March 12, 2014 by Applicant FirstBank of Nebraska (“Applicant”). Opposer believes it will be damaged by the registration of Applicant’s mark and requests that registration be refused.

As grounds for its opposition, Opposer alleges:

1. Opposer, FirstBank Holding Company, is a Colorado corporation with a principal place of business at 12345 West Colfax Avenue, Lakewood, Colorado 80215.
2. Applicant, FirstBank of Nebraska, is a Nebraska Corporation with a correspondence address of 201 East 5th Street, Wahoo, Nebraska 68066.

OPPOSER’S PRIORITY OF USE AND STANDING

3. Opposer is the owner of the marks FIRSTBANK, FIRST BANK, 1STBANK, EFIRSTBANK.COM, and related design marks (collectively “Opposer’s Marks”) in connection with banking services and financial services.

4. Opposer has used the marks FIRSTBANK and 1STBANK since at least as early as 1978 to identify its banking and financial services.

5. Opposer presently has over 125 physical branch banking locations in Colorado, California, and Arizona. Opposer has served customers for many years throughout the United States in areas in which it does not have physical banking locations.



6. In addition, Opposer has an interactive online banking system, which serves clients nationwide.

7. As a result of the promotion, marketing, advertising, and continuous use of its marks in connection with banking and financial services, the public has come to recognize Opposer's Marks as those identified with Opposer's services.

8. In addition to its extensive common law rights, Opposer owns or is licensee of a number of federal Registrations.

9. Opposer owns the following registrations:

Mark	Reg. No.	Services	Filing Date	Reg. Date	First Use In Commerce
EFIRSTBANK.COM	3,093,479	IC 36: banking services and financial services, namely, financial consulting relating to consumer and business accounts; loan financing; insurance consultation; investment and financial management services; and all of the above services also rendered via the Internet.	11/03/99	05/16/06	12/01/99
1STBANK & Design	4,103,432	IC 36: banking services and financial services, namely, financial consulting relating to consumer and business accounts; loan financing; insurance consultation; investment and financial management	11/03/08	02/28/12	08/01/08

Mark	Reg. No.	Services	Filing Date	Reg. Date	First Use In Commerce
		services; and all of the above services also rendered via the Internet.			
ISTBANK & Design 	4,103,433	IC 36: banking services and financial services, namely, financial consulting relating to consumer and business accounts; loan financing; insurance consultation; investment and financial management services; and all of the above services also rendered via the Internet.	11/03/08	02/28/12	08/01/08

10. Opposer is the licensee of First Banks, Inc., a Missouri corporation, 135 North Meramec, Suite 410, Clayton, Missouri, 63105, with respect to the following registration (the '078 Registration):

Mark	Reg. No.	Services	Filing Date	Reg. Date	First Use In Commerce
FIRST BANK	3,317,078	IC 36: banking, trust, and mortgage lending services	12/11/03	10/23/07	03/06/86

11. Opposer's registered marks are valid and subsisting, and are prima facie evidence of Opposer's exclusive right to use said marks in commerce on the services specified in the registrations.

12. Opposer's Marks are inherently distinctive to the public and serve to show the origin of banking and financial services provided by Opposer.

13. As a result of the widespread use and display of Opposer's Marks, the public uses them to identify and refer to Opposer's banking and financial services and the public recognizes that the Marks refer to high quality banking and financial services emanating from a single source. Thus, the Marks have built up secondary meaning and extensive good will.

14. Opposer has created a publically known and recognized corporate persona and identity as FIRST BANK, FIRSTBANK, and 1STBANK, and those terms uniquely point to Opposer in large portions of the United States.

15. For the reasons set forth in this Notice of Opposition, Opposer will be damaged by and has standing to oppose this application.

16. This Notice of Opposition is timely filed. Applicant's mark published for opposition on August 26, 2014 and Opposer obtained extensions of time through and including February 22, 2015. 15 U.S.C. 1063.

APPLICANT'S SUBSEQUENT AND CONFUSING USE OF THE OPPOSED MARK

17. Upon information and belief, Applicant owns four banking branches in Nebraska.

18. In contrast to Opposer's longstanding use and investment in Opposer's Marks, upon information and belief, Applicant only recently adopted the name and mark FIRSTBANK OF NEBRASKA in connection with its goods and services.

19. Upon information and belief, Applicant previously offered banking and financial services under the mark FIRST NATIONAL BANK OF WAHOO. *See* Exhibit A (Byars, Kris "Wahoo bank changes name" posted Dec. 24, 2013 available at http://www.wahoo-ashland-waverly.com/news/wahoo-bank-changes-name/article_4e1de978-6c18-11e3-a374-0019bb2963f4.html.)

20. Applicant is seeking to obtain registration on the principal register of the design mark 1B FIRSTBANK OF NEBRASKA SERVING OUR COMMUNITIES ...INVESTING IN YOU (Serial No. 86/218631) (the “Opposed Mark”) for International Class 36, banking and financing services:



21. The words “FirstBank” are the predominant feature and literal element in the Opposed Mark with the words “FirstBank” in the biggest font, the words “of Nebraska” in a smaller font, and the words “Serving Our Communities ...Investing in You” in the smallest font.

22. Applicant’s application for the Opposed Mark claims a first use in commerce date of December 19, 2013.

23. Thus, Applicant’s claimed first use in commerce date was over six years after the ‘078 Mark was registered and one year after the ‘078 Mark became incontestable. 15 U.S.C. 1065.

24. Applicant adopted the Opposed Mark well after it was on constructive notice of Opposer’s registrations and rights in the registered marks.

25. Applicant’s mark is deceptively similar to Opposer’s marks. The marks have a confusingly similar appearance, sound, meaning, and commercial impression. Consumers will mistakenly believe that Applicant’s services are offered by, affiliated with or sponsored by Opposer when the same is not true.

26. Due to the highly similar nature of Applicant’s mark and Opposer’s marks, the closely related nature of the services provided by the respective parties, consumers, and potential

consumers are likely to believe that Applicant's services originate from Opposer, resulting in a likelihood of confusion in the market place and damage to Opposer.

27. The use and registration by Applicant of the Opposed Mark is likely to cause confusion or to cause mistake or deception among consumers and potential consumers, with Opposer's previously used marks, again resulting in damage to Opposer.

28. Because of the highly related nature of the services and the highly similar nature of the marks in overall appearance, sound, meaning, and commercial impression, use and registration of the Opposed Mark is likely to cause confusion, mistake, or deception that Applicant's services are those of Opposer, or are otherwise endorsed, sponsored, or approved by Opposer causing further damage to Opposer.

29. If Applicant is granted registration of the Opposed Mark, it would thereby obtain at least a *prima facie* exclusive right to the use of its alleged mark. Such registration would be a source of further damage and injury to Opposer, and could bar Opposer from obtaining a future registration of its marks.

30. Applicant further disclaims the words FIRSTBANK OF NEBRASKA, which harms Opposer by suggesting that FIRSTBANK is not registrable and is descriptive, when it is not descriptive.

31. Registration of the mark shown in Application Serial No. 86/218631 will result in damage to Opposer under the provisions of §2(a) and §2(d) of the U.S. Trademark Act, 15 U.S.C. 1052 pursuant to the allegations stated above.

WHEREFORE, Opposer asks that its opposition to this application be sustained and that the registration of the mark shown in Application Serial No. 86/218631 be refused.

Please direct all correspondence to the attention of:

Joy Allen Woller
Lewis Roca Rothgerber LLP
1200 17th Street, Suite 3000
Denver, CO 80202
Tel: 303.623.9000
Fax: 303.623.9222

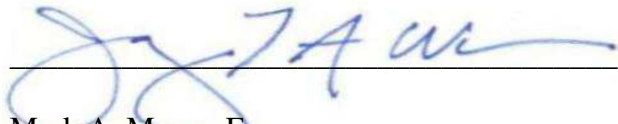
Opposer hereby appoints Joy Allen Woller, Esq. and Mark A. Meyer, Esq. as its attorneys with the full power to represent Opposer in connection with this proceeding.

The required fee will be paid via credit card with the filing of this Notice of Opposition. In the event the fee is insufficient in any way, please deduct the opposition fee in the sum of \$300.00 from the Lewis Roca Rothgerber LLP Deposit Account No. 502847.

Dated: February 20, 2015.

FIRSTBANK HOLDING COMPANY,

By its attorneys,

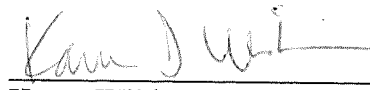
A handwritten signature in blue ink, appearing to read 'Meyer', is written over a horizontal line.

Mark A. Meyer, Esq.
Joy Allen Woller, Esq.
LEWIS ROCA ROTHGERBER LLP
1200 17th Street, Suite 3000
Denver, CO 80202-5839
Tel. 303.623.9000
Fax 303.623.9222
mmeyer@lrrlaw.com
jwoller@lrrlaw.com

CERTIFICATE OF SERVICE

I hereby certify that, on this 20th day of February 2015, a true and complete copy of the foregoing **NOTICE OF OPPOSITION** was served by United States mail, first class postage prepaid, on the following attorney and correspondent of record for Applicant:

Justin Knight, Esq.
PERRY, GUTHERY, HAASE & GESSFORD, P.C., L.L.O.
233 S 13th ST STE 1400
Lincoln, Nebraska 68508-2003
UNITED STATES
jknight@perrylawfirm.com



Karen Wildman

TAB A

TAB A

EXHIBIT A

Wahoo bank changes name

By Kris Byars | Posted: Tuesday, December 24, 2013 1:15 am

WAHOO – After more than 130 years in business, First National Bank of Wahoo has made a significant change to keep up with the times.

On Dec. 19, the financial institution, which has branches in Wahoo, Sterling, Burchard and Syracuse, officially changed its name to FirstBank of Nebraska.

“It was a difficult decision to make,” said FirstBank President and Chief Executive Officer Steve Sallenbach. “We’ve been First National Bank of Wahoo since 1882.”

Sallenbach said there were several factors that played into the decision to change the bank’s name.

“We most recently acquired the branch in Syracuse,” explained Sallenbach. “In many ways, that’s a community much like Wahoo. It’s a bedroom community, with most people working in Lincoln or Nebraska City.”

Wanting to create an atmosphere of trust among all of the bank’s customers, Sallenbach said the decision was made to change the name to something that honored the bank’s history while not necessarily being tied to a specific branch.

“The board felt we needed to change with the times and move to a more general name that people don’t identify with a specific location,” said Sallenbach.

Sallenbach added that it was also decided to move away from being a nationally chartered bank and become a state chartered bank.

Sallenbach said that customers shouldn’t notice a difference due to this change. From the bank’s standpoint, it simply changes which agency would be inspecting them.

“Instead of the National Bank Examiner, we’ll be inspected by the State Bank Examiner,” he said.

The process of changing the bank’s name has taken the better part of the last year. Sallenbach said it’s more involved than most people realize.

Sallenbach said suggestions and opinions were sought from each of the more than 40 employees that are spread across the bank’s four branches.

“And every time we’d find something we liked, we found out someone else already used that name,” he said.

It was almost an accident when Sallenbach stumbled on the idea of “FirstBank,” for a name. He wondered what the employees would think if they just removed the word “National,” since they were no longer going to carry the national charter.

After learning that would work and getting the employees’ approval, the decision was made to move forward.

“We had to file all the paperwork and then we had to change our signage, our legal documents, everything,” said Sallenbach.

As the name, “FirstBank of Nebraska,” is similar to “First National Bank of Wahoo,” Sallenbach said the bank would continue to use its familiar logo.

“We wanted to keep at least as much connection to our past as possible, while still looking toward the future,” noted Sallenbach.

The name officially went into use last week. Over the next few months, Sallenbach said they would work towards changing things like the bank’s letterhead and website.