

ESTTA Tracking number: **ESTTA859452**

Filing date: **11/20/2017**

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

Proceeding	91237182
Party	Defendant First Mid-Illinois Bancshares, Inc.
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Date	11/20/2017
Attachments	Answer to MidFirst_s Notice of Opposition.pdf(202256 bytes )

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

MidFirst Bank,	)	
	)	
Opposer,	)	Opposition No. 91237182
	)	
v.	)	
	)	
First Mid-Illinois Bancshares, Inc.,	)	
	)	
Applicant.	)	
	)	

**ANSWER TO NOTICE OF OPPOSITION**

Applicant First Mid-Illinois Bancshares, Inc. answers Opposer MidFirst Bank’s Notice of Opposition as follows:

1. Opposer is a federally-chartered savings association, whose principal place of business is located at 501 N.W. Grand Blvd., 3<sup>rd</sup> Floor, Oklahoma City, Oklahoma 73118.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 1.

2. Opposer is a national banking and financial institution, providing personal, commercial, trust, private banking, and mortgage banking products and services, and has been providing those services under the “MIDFIRST” marks since at least as early as 1981.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 2.

3. Opposer’s primary markets include Oklahoma, Colorado, Arizona, and California, with commercial real estate lending offices in multiple markets including in Atlanta, Chicago, Dallas, Houston, New York City and Southern California.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 3.

4. Opposer’s services and its advertising efforts ensure that its reputation carries far beyond its retail banking establishments. Opposer is a founding sponsor of the Oklahoma City Thunder. For at least 7 years, Opposer has sponsored the popular \$20,000 half-court shot contest which involves significant placement of Opposer’s name throughout the arena and on television, including national outlets, before, during, and after the contest. Opposer is also the official banking institution of Arizona State University.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 4.

5. As a result of Opposer’s long and extensive history of providing banking and financial services under its “MIDFIRST” marks, those marks have become famous and well-known across the United States, the general banking public in the United States recognizes the “MIDFIRST” marks as exclusively associated with Opposer, and the services provided by Opposer under the “MIDFIRST” marks have gained a reputation for quality emanating exclusively from Opposer.

**RESPONSE:** Applicant denies that Opposer’s “MIDFIRST” marks have become famous and well-known across the United States. Applicant also denies that the general banking public in the United States recognizes the “MIDFIRST” marks as exclusively associated with Opposer. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 5.

6. As a result of the above usage, Opposer is the owner of common law trademark rights in the “MIDFIRST” mark for banking and financial services, including personal and commercial banking, mortgage services, treasury management services, and healthcare lending.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 6.

7. In addition to its common law rights, Opposer is the owner of a number of U.S. trademark registrations including:

Reg. No.	Mark	Classes and Goods/Services	Reg. Date
1,425,140	MIDFIRST	Class 36: savings and loan association services and mortgage loan services.	01/13/87

3,593,714	MIDFIRST BANK MORE THAN YOU'D EXPECT FROM A BANK	Class 36: Banking services, namely, checking accounts, investment accounts, savings accounts, money market accounts, issuing certificates of deposit, lines of credit, providing ATM cards, individual retirement accounts, home equity loans and automobile loans	03/24/09
3,867,418	TRUE TO YOUR MONEY MIDFIRST BANK	Class 36: Banking services; Financial services, namely, investment advice, investment management, investment consultation and investment of funds for others, including private and public equity and debt investment services; Financial services, namely, wealth management services; Savings and loan services	10/26/10
3,878,657	MIDFIRST BANK	Class 36: Banking and financing services; Savings and loan services	11/23/10
3,925,320	MIDFIRST BANK	Class 35: Assistance, advisory services and consultancy with regard to business planning, business analysis, business management, and business organization; Business advice and information; Business consulting and information services.	03/01/11
4,032,545	MIDFIRST DIRECT	Class 36: Banking and financing services; Electronic banking via a global computer network; Investment banking services; On-line banking services.	09/27/11
4,342,589	MIDFIRST MONEY MOMENTS	Class 36: Banking and financing services; Banking consultation	05/28/13

**RESPONSE:** Applicant admits that U.S. Patent and Trademark Office records indicate that Opposer is the owner of U.S. Trademark Registration Nos. 1,425,140; 3,593,714; 3,867,418; 3,878,657; 3,925,320; 4,032,545; and 4,342,589. Applicant is without knowledge or information sufficient to form a belief as to the truth of the remaining allegations in Paragraph 7.

8. The registration certificates for each of the above registrations are attached as Exhibit A. Opposer's collective rights in the above registrations and common law rights in the above "MIDFIRST" marks are collectively referred to as the "MIDFIRST Marks."

**RESPONSE:** Applicant admits that what appear to be copies of the registration certificates for the registrations in the table in Paragraph 7 are attached as Exhibit A to the Notice of Opposition.

9. The MIDFIRST Marks have been used in connection with banking and financial services since at least as early as September 1981, which is well prior to the filing date for the Application.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 9.

10. Applicant is a community-focused bank providing financial services, including, but not limited to, personal banking, commercial banking, mortgage services, insurance services, and trust and wealth management.

**RESPONSE:** Admitted.

11. The Application seeks registration on the Principal Register of the mark "FIRST MID" in the following classes for the following services:

- International Class 35: Estate management, namely, assistance in the gathering and organization of personal vital and financial records in conjunction with instructions for handling of such documents by others, including executors and attorneys, upon death or when otherwise necessary.
- International Class 36: Banking services; financing services; wealth management services; mortgage banking services; insurance agency and brokerage services; insurance claims reporting services; insurance services; estate planning services; estate settlement services; estate trust planning services; estate trust management services; financial trust services; real estate appraisal services.
- International Class 44: Agricultural advice; agricultural consultancy and advisory services in the field of farm management and field management, namely, planning crop rotation, fertilization and pest control, supervising farm operations through field visits and review of farm records, developing farm leases, developing payment programs for crop production expenses, furnishing statements and analyses of farm income, expense and production, and marketing crops for sale to others.

**RESPONSE:** Admitted.

12. The Application was published for opposition in the *Trademark Official Gazette* on June 13, 2017. Opposer timely filed an extension of time to oppose on June 27, 2017.

**RESPONSE:** Admitted.

13. Opposer had used its MIDFIRST Marks in at least International Class 36 for approximately 35 years at the time Applicant filed the Application.

**RESPONSE:** Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations in Paragraph 13.

14. The MIDFIRST Marks are substantially similar to the “FIRST MID” mark that is the subject of the Application, as all of the MIDFIRST Marks contain a combination of the words “MID” and “FIRST,” which comprise the “FIRST MID” mark.

**RESPONSE:** Denied.

15. The MIDFIRST Marks cover goods and services that are substantially similar and related, if not identical, to the goods and services described in the Application, and that are advertised and marketed through the same or similar channels of trade.

**RESPONSE:** Applicant admits that the Opposer’s registered “MIDFIRST” marks cover some services that are substantially similar and related, or identical, to some of the services described in the Application. Applicant denies the remaining allegations in Paragraph 15.

16. As a result of the substantial similarity between the MIDFIRST Marks and the “FIRST MID” mark that is the subject of the Application, as well as the overlapping goods and services and channels of trade, Applicant’s use of the “FIRST MID” mark for the goods and services within the Application is likely to cause confusion, mistake, and/or deception with respect to Opposer’s MIDFIRST Marks, and consumers are likely assume, incorrectly, that there is an association between Opposer and the goods and services sold under Applicant’s use of the “FIRST MID” mark.

**RESPONSE:** Denied.

17. Based on the foregoing, Applicant’s registration of the “FIRST MID” mark would cause injury and damage to Opposer because such registration will support and assist Applicant in its confusing and misleading use of the “FIRST MID” mark, give color of rights to Applicant in violation of Opposer’s prior and superior rights in the MIDFIRST Marks, and cause damage to the goodwill associated with Opposer’s MIDFIRST Marks.

