

ESTTA Tracking number: **ESTTA897622**

Filing date: **05/18/2018**

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

Proceeding	91240594
Party	Defendant First State Bank of Middlebury
Correspondence Address	CHARLES J. MEYER WOODARD, EMHARDT, MORIARTY, MCNETT & HEN 111 MONUMENT CIRCLE, SUITE 3700 INDIANAPOLIS, IN 46204 Email: cjmeyer@uspatent.com, docketdept@uspatent.com
Submission	Answer and Counterclaim
Filer's Name	Charles J. Meyer
Filer's email	cjmeyer@uspatent.com, danielle@uspatent.com, docketdept@uspatent.com
Signature	/Charles J. Meyer/
Date	05/18/2018
Attachments	Answer and Counterclaim.pdf(228502 bytes)

Registrations Subject to the filing

Registration No.	5360625	Registration date	12/19/2017
Registrant	GROWMARK, Inc. 1701 Towanda Avenue Bloomington, IL 61761 UNITED STATES Email: ip.docket@dorsey.com		

Goods/Services Subject to the filing

Class 036. First Use: 1966/05/31 First Use In Commerce: 1966/05/31 All goods and services in the class are requested, namely: Financial services, namely, banking services			
Registration No.	2371319	Registration date	07/25/2000
Registrant	GROWMARK, INC. 1701 Towanda Ave. Bloomington, IL 61761 UNITED STATES		

Goods/Services Subject to the filing

Class 036. First Use: 1966/05/00 First Use In Commerce: 1966/05/00 All goods and services in the class are requested, namely: Financial services, namely, providing loans to farmers			
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Grounds for Cancellation

Abandonment	Trademark Act Section 14(3)		
Registration No.	5121266	Registration date	01/10/2017
Registrant	GROWMARK, Inc. 1701 Towanda Avenue Bloomington, IL 61761 UNITED STATES		

Goods/Services Subject to the filing

Class 036. First Use: 1966/05/31 First Use In Commerce: 1966/05/31

All goods and services in the class are requested, namely: Financial services, namely, banking services

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

In re application Serial No. 87/428,224
For the mark FSB & Design

Growmark, Inc.,)	Opposition No. 91240594
)	
Opposer,)	
)	
v.)	
)	
First State Bank of Middlebury)	
)	
Applicant.)	

**ANSWER TO NOTICE OF OPPOSITION
AND COUNTERCLAIM FOR CANCELLATION**

In response to the Notice of Opposition filed on April 11, 2017 by Opposer, Growmark, Inc. (“Opposer” or “Growmark”), Applicant, First State Bank of Middlebury (“Applicant”), hereby answers as follows:

1. Admitted.
2. Admitted.
3. Admitted.

4. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 4 of the Notice of Opposition and therefore denies such allegations.

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 Notice of Opposition and therefore denies such allegations.

6. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 6 of the Notice of Opposition and therefore denies such allegations.

7. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 7 of the Notice of Opposition and therefore denies such allegations.

8. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 8 of the Notice of Opposition and therefore denies such allegations.

9. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 9 of the Notice of Opposition and therefore denies such allegations.

10. Denied.

11. Denied.

12. Applicant is without knowledge or information sufficient to form a belief as to the truth of the allegations contained in Paragraph 12 of the Notice of Opposition and therefore denies such allegations.

13. Denied.

COUNTERCLAIM

14. Growmark is the owner of Registration No. 5,360,625 for the mark FS, which, among other classes, recites the services, “financial services, namely, banking services” in class 36 (hereafter the “FS Mark”).

15. Growmark is the owner of Registration No. 5,121,266 for the mark FS and design, which, among other classes, recites the services, “financial services, namely, banking services” in class 36 (hereafter the “FS & Design Mark”).

16. Growmark is the owner of Registration No. 2,371,319 for the mark FS-AGRIFINANCE, which, among other classes, recites the services, “Financial services, namely, providing loans to farmers” in class 36 (hereafter the “FS-AGRIFINANCE Mark”).

17. Applicant is being damaged by the registration of Opposer’s FS Mark, Registration No. 5,360,625, and hereby petitions to partially cancel Opposer’s federal registration in whole or in part in class 36.

18. Applicant is being damaged by the registration of Opposer’s FS and design Mark, Registration No. 5,121,266, and hereby petitions to partially cancel Opposer’s federal registration in whole or in part in class 36.

19. Applicant is being damaged by the registration of Opposer’s FS-AGRIFINANCE mark, Registration No. 2,371,319, and hereby petitions to cancel Opposer’s federal registration in whole or in part in class 36.

20. Growmark provides agricultural financing under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK in the form of a line of credit to assist farmers in purchasing Growmark’s products and services.

21. Growmark does not provide financial services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK other than providing agricultural financing in the form of a line of credit to assist farmers in purchasing Growmark’s products and services.

22. Growmark’s line of credit services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK are only available to Growmark’s customers.

23. Growmark does not provide banking services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
24. Growmark is not a bank or trust company incorporated and doing business under the laws of the United States (including laws relating to the District of Columbia) or of any State.
25. Growmark does not offer checking account services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
26. Growmark does not offer savings account services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
27. Growmark does not offer deposit account services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
28. Growmark does not offer investment account services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
29. Growmark does not offer mortgage loan services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
30. Growmark does not offer debit or credit card services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.
31. Growmark does not provide loans under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK, other than providing agricultural financing in the form of a line of credit to assist farmers in purchasing Growmark's products and services.
32. Growmark does not provide business loans under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK, other than providing agricultural financing in the form of a line of credit to assist farmers in purchasing Growmark's products and services.

33. Growmark does not provide lines or credit under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK, other than providing agricultural financing in the form of a line of credit to assist farmers in purchasing Growmark's products and services.

34. Growmark does not offer trust account services under the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK.

35. Growmark is not insured by the FDIC.

36. Growmark does not use the words "bank" or "banking" to describe its services in any of its marketing materials.

37. Growmark does not promote itself as a "bank" or as providing "banking" services.

38. Growmark does not qualify as a bank or banking institution under 26 U.S.C. §581.

39. Growmark is not licensed as a bank under the Illinois Department of Financial and Professional Regulation.

40. Growmark is not licensed as a bank with any State.

COUNT 1 - GROWMARK'S REGISTRATIONS IN CLASS 36 SHOULD BE CANCELLED OR RESTRICTED UNDER §18

41. The identification of services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 is overbroad and should be cancelled as a whole or in the alternative restricted under 15 U.S.C. §1068 ("§18 of the Trademark Act").

42. The identification of services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 should be cancelled as a whole or in the alternative should be modified and restricted to precisely point out the types of services offered by Growmark and to conform to the actual trade channels where such services are offered.

COUNT 2 – LACK OF BONA FIDE USE AND/OR LACK OF BONA FIDE INTENT TO USE

43. Upon information and belief, Growmark was not using the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK in commerce in the United States for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 as of the filing date of the corresponding applications.

44. Upon information and belief, Growmark is not using the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK in commerce in the United States for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319.

45. Upon information and belief, Growmark had made no preparations to use the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 in commerce in the United States as of the filing date of the corresponding applications.

46. Upon information and belief, Growmark has made no preparations to use the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 in commerce in the United States.

47. Upon information and belief, Growmark did not have a bona fide intent to use the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK in commerce in the United States for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 as of the filing date of the corresponding applications.

48. Upon information and belief, Growmark does not have a bona fide intent to use the FS MARK, the FS & DESIGN MARK or the FS-AGRIFINANCE MARK in commerce in

the United States for all of the claimed services in class 36 in Registrations Nos. 5,360,625; 5,121,266 and 2,371,319.

WHEREFORE, Applicant requests that the Trademark Trial and Appeal Board:

- A. Dismiss the Notice of Opposition with prejudice and that Application Serial No. 87/428,224 be allowed;
- B. Cancel and/or restrict Registrations Nos. 5,360,625; 5,121,266 and 2,371,319 in class 36; and,
- C. For such other and further relief in the premises as may be deemed to be just and proper.

The filing fee of \$1,200.00 is presented herewith. Please credit any overpayment or charge any deficit to deposit account 23-3030.

Respectfully submitted,

By /Charles J. Meyer/
Charles J. Meyer
Woodard, Emhardt, Moriarty,
McNett & Henry LLP
111 Monument Circle, Suite 3700
Indianapolis, Indiana 46204-5137
(317) 634-3456

Attorney for Applicant

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and accurate copy of the foregoing was served via email to:

[Jamie Nafziger](#)

Dorsey & Whitney LLP
50 South Sixth Street, Suite 1500
Minneapolis, MN 55402
UNITED STATES

ip.docket@dorsey.com, nafziger.jamie@dorsey.com, jarzyna.alison@dorsey.com

Phone: 612-392-7922

on this May 18, 2018.

By: /Charles J. Meyer/
Attorney for Applicant