

ESTTA Tracking number: **ESTTA1023034**

Filing date: **12/16/2019**

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

Proceeding	91252134
Party	Defendant AMERICAN MEDICAL GROUP LLC
Correspondence Address	JOHN S. HALE GIPPLE & HALE 6718 WHITTIER AVENUE, SUITE 200 MCLEAN, VA 22101 gipple.hale@verizon.net no phone number provided
Submission	Answer
Filer's Name	John S. Hale
Filer's email	gipple.hale@verizon.net
Signature	/John S. Hale/
Date	12/16/2019
Attachments	Applicant Answer to Opposition - Opp. No. 91252134.pdf(265755 bytes )

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

**PATIENT FIRST CORPORATION**

Opposer,

v.

**AMERICAN MEDICAL GROUP  
LLC**

Applicant.

**Opposition No. 91252134**

Application Serial No. **88010256**

Mark: **B-FIRST**

**ANSWER AND AFFIRMATIVE DEFENSES OF  
APPLICANT AMERICAN MEDICAL GROUP LLC**

Applicant **AMERICAN MEDICAL GROUP LLC**, (hereinafter “AMG” or “Applicant”), by and through its attorneys John Hale and Jaime Boggio, hereby answers the Notice of Opposition (the “opposition”) filed by **PATIENT FIRST CORPORATION** (hereinafter “Opposer”). Applicant hereby responds, solely for the purpose of this proceeding, to each of the numbered grounds set forth in the Notice of Opposition, by like numbers as follows:

1. Applicant lacks knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 1 of the Opposition and, therefore, denies the same.

- 2- Applicant admits paragraph 2 of the Opposition.
- 3- Applicant admits having filed the application on the Principal register on the date noted and denies the rest of Paragraph 3 of the Opposition.
- 4- Applicant admits the allegation of Paragraph 4 of the Opposition.
- 5- Applicant admits the allegation of Paragraph 5 of the Opposition.
- 6- Applicant lacks knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 6 of the Opposition and, therefore, denies them.
- 7- Applicant admits that the Opposer is the last listed owner of Reg. '408 which was registered on October 6, 1987 and that Section 8 & Section 15 declarations have been filed.
- 8- Applicant admits that the Opposer is the last listed owner of Reg. '334 which was registered on October 4, 2011 and that Section 8 & Section 15 declarations have been filed.
- 9- Applicant admits that the Opposer is the last listed owner of Reg. '860 which was registered on September 22, 2015.
- 10- Applicant admits that the Opposer is the last listed owner of Reg. '987 which was registered on April 19, 2016, and denies that the services in Class 35 as described by the Opposer on Paragraph 10 of the Opposition mirrors the USPTO records.

- 11- Applicant admits that the Opposer is the last listed owner of Reg. '757 which was registered on April 22, 2014 and that Section 8 & Section 15 declarations have been filed.
- 12- Applicant admits that the Opposer is the last listed owner of Reg. '756 which was registered on April 22, 2014 and that Section 8 & Section 15 declarations have been filed.
- 13- Applicant denies Paragraph 13 of the Opposition as the paragraph is a collective term with other meanings and, therefore, denies same.
- 14- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 14 of the Opposition and, on that basis, denies same.
- 15- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 15 of the Opposition and, on that basis, denies same.
- 16- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 16 of the Opposition and, on that basis, denies same.
- 17- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 17 of the Opposition and, on that basis, denies same.

- 18- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 18 of the Opposition and, on that basis, denies same.
- 19- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 19 of the Opposition and, on that basis, denies same.
- 20- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 20 of the Opposition and, on that basis, denies same. Applicant also denies any and all remaining allegations and/or legal conclusions contained in Paragraph 20 of the Opposition. Applicant also denies that there is any legal, statutory or factual basis for the term “seemingly famous”.
- 21- Applicant is without knowledge or information sufficient to form a belief as to the truth of the matters alleged in Paragraph 21 of the Opposition and, on that basis, denies same. Applicant denies any and all remaining allegations and/or legal conclusions contained in Paragraph 21 of the Opposition. Applicant also denies that there is any legal or factual basis for the term “generally famous”.
- 22- Applicant denies any and all allegations and/or legal conclusions contained in Paragraph 22 of the Opposition.

23- Applicant denies any and all remaining allegations and/or legal conclusions contained in Paragraph 23 of the Opposition. Furthermore, the Examining Attorney amended the description of services in Class 42 with the consent of the Applicant and reclassified the aforementioned to Class 44 with the following recitation: “PROVIDING MEDICAL TESTING SERVICES IN THE FIELD OF BREAST CANCER, NAMELY, ASSESSING AND PREDICTING DISEASE AND RISK OF BREAST CANCER DISEASE BY IDENTIFYING RISK FACTORS OF BREAST CANCER DISEASE BY IDENTIFYING BIOLOGICAL MARKERS WHICH HAVE A CORRELATION TO BREAST CANCER DISEASE FOR MEDICAL DIAGNOSTIC PURPOSES IN INTERNATIONAL CLASS 44.” The original Class 10 goods were deleted by the Examiner Attorney in the same telephonic amendment.

24- Applicant denies the allegations of Paragraph 24 of the Opposition.

25- Applicant denies the allegations of Paragraph 25 of the Opposition.

26- Applicant denies the allegations of Paragraph 26 of the Opposition.

27- Applicant denies the allegations of Paragraph 27 of the Opposition.

28- Applicant denies the allegations of Paragraph 28 of the Opposition.

- 29- Applicant reasserts the admissions and/or denials set forth in Paragraphs 1-28 of the Opposition in response to Paragraph 29 of the Opposition as fully set forth herein.
- 30- Applicant denies the allegations of Paragraph 30 of the Opposition.
- 31- Applicant denies the allegations of Paragraph 31 of the Opposition.
- 32- Applicant denies the allegations of Paragraph 32 of the Opposition.
- 33- Applicant denies the allegations of Paragraph 33 of the Opposition.
- 34- Applicant is without knowledge as to the veracity of the allegation of Paragraph 34 of the Opposition and therefore denies it.
- 35- Applicant denies the allegations of Paragraph 35 of the Opposition.
- 36- Applicant denies the allegations of Paragraph 36 of the Opposition.
- 37- Applicant denies the allegations of Paragraph 37 of the Opposition.
- 38- Applicant incorporates its Answer to Paragraphs 1-37 of the Answer as if incorporated fully herein.
- 39- Applicant denies the allegations of Paragraph 39 of the Opposition.
- 40- Applicant denies the allegations of Paragraph 40 of the Opposition.
- 41- Applicant denies the allegations of Paragraph 41 of the Opposition.

**AFFIRMATIVE DEFENSES**

Applicant undertakes the burden of proof as to those defenses deemed affirmative defenses by law, regardless of how the defenses are denominated below. Applicant

expressly reserves the right to plead additional affirmative and other defenses should any such defenses be revealed by discovery in this case. As and for its affirmative and other defenses, Applicant states as follows:

**First Affirmative Defense**

The word “FIRST” included in the Opposer’s marks is a weak mark widely used and is only subject to a narrow scope of protection.

**Second Affirmative Defense**

There is no likelihood of confusion, mistake, deception or misleading impression between the Opposer’s “PATIENTS FIRST” marks and Applicant’s “B-FIRST” mark.

**Third Affirmative Defense**

There is neither dilution, risk of dilution or a famous mark involved in this Opposition as alleged by the Opposer.

**Fourth Affirmative Defense**

There is no risk of causing damages to the Opposer or its “PATIENT FIRST” marks.



### **Fifth Affirmative Defense**

The word “FIRST” has been used as a trademark and service mark for hundreds of different trademarks and service marks, and is a weak mark.

### **Sixth Affirmative Defense**

The Opposer has allowed its “PATIENT FIRST” marks to be used without adequate controls and/or supervision amounting to a “naked license” and that constitutes a forfeiture of the exclusive rights to those marks.

Applicant hereby appoints John Hale of Gipple & Hale, a member in good standing of the bar of the Commonwealth of Virginia, and Jaime Boggio, a member in good standing of the Bar of the Commonwealth of Virginia, at the firm of:

**Gipple & Hale**  
**6718 Whittier Avenue, Suite 200**  
**McLean, VA 22101**  
[gipple.hale@verizon.net](mailto:gipple.hale@verizon.net)

to act as attorneys in the matter of the opposition identified above, to prosecute said opposition, to transact all business in the Patent and Trademark Office connected with the opposition, to sign its name to all papers which are hereinafter to be filed in connection therewith, and to receive all communications relating to the same.

**WHEREFORE**, Applicant prays that the Trademark Trial and Appeal Board dismisses the Opposer's Notice of Opposition with prejudice and pass the Applicant's application of "B-FIRST" to registration.

Dated: December 16, 2019

**Gipple & Hale**  
**By: /John Hale/**  
[gipple.hale@verizon.net](mailto:gipple.hale@verizon.net)  
**6718 Whittier Avenue, Suite 200**  
**McLean, VA 22101**  
**Tel: (703) 448-1770, ext. 301**  
**Fax: (703) 448-7780**  
**Attorneys for Applicant**  
**AMERICAN MEDICAL GROUP**  
**LLC**

**CERTIFICATE OF SERVICE**

I hereby certify that a true and accurate copy of ANSWER has been served on the following by delivering said copy on December 17, 2019, via First Class Mail, to counsel for Opposer at the following address:

**Belinda D. Jones  
Christina & Barton, LLP  
909 East Main Street, Suite 1200  
Richmond, VA 23219**

By:           /John S. Hale/            
          John S. Hale, Esq.