

ESTTA Tracking number: **ESTTA871824**

Filing date: **01/18/2018**

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

Petition for Cancellation

Notice is hereby given that the following party has filed a petition to cancel the registration indicated below.

Petitioner Information

Name	FOLIOfn, Inc.		
Entity	Corporation	Citizenship	Virginia
Address	8180 Greensboro Drive 8th Floor McLean, VA 22102 UNITED STATES		

Attorney information	Kathleen Gallagher-Duff Covington & Burling LLP One CityCenter, 850 Tenth Street NW Washington, DC 20001 UNITED STATES Email: trademarks@cov.com Phone: 202.662.5299		
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Registration Subject to Cancellation

Registration No.	5131534	Registration date	01/31/2017
International Registration No.	NONE	International Registration Date	NONE
Registrant	Affirmative Investment Management Partners Limited 107 Cheapside London, EC2V6DN UNITED KINGDOM		

Goods/Services Subject to Cancellation

Class 036. First Use: 0 First Use In Commerce: 0 All goods and services in the class are subject to cancellation, namely: Equity capital investment; Financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; Financial consultation in the field of environmental management, namely, advising business and individuals on issues of portfolio planning and investment planning; Financial services, namely, coordination, within a single account, of an investment portfolio's maintenance, trading, rebalancing, and tax management needs; Financial services, namely, operation and management of hedge funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures, derivatives, debt instruments and commodities
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Grounds for Cancellation

Priority and likelihood of confusion	Trademark Act Sections 14(1) and 2(d)
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Marks Cited by Petitioner as Basis for Cancellation

U.S. Application No.	87369416	Application Date	03/14/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FIRST AFFIRMATIVE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1988/00/00 First Use In Commerce: 1988/00/00 Financial services, namely, providing investment advice, investment management, investment consultation and investment of funds for others; financial analysis and consultation for others, namely, financial professionals and their client investors and individual and institutional investors; financial planning services; providing investment and portfolio status information by electronic means; financial administration of retirement plans; financial investment research services		

U.S. Application No.	87369358	Application Date	03/14/2017
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 Financial services, namely, providing investment advice, investment management, investment consultation and investment of funds for others; financial analysis and consultation for others, namely, financial professionals and their client investors and individual and institutional investors; financial planning services; providing investment and portfolio status information by electronic means;		

	financial administration of retirement plans; financial investment research services
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U.S. Application No.	87479089	Application Date	06/07/2017
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Registration Date	NONE	Foreign Priority Date	NONE
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Word Mark	FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC
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Design Mark	
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Description of Mark	The mark consists of a circle with a white jagged line running through the middle, with one half of the circle shaded in blue and the other half in green, with the words FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC in black lettering to the right of the circle.
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Goods/Services	Class 036. First use: First Use: 1999/00/00 First Use In Commerce: 1999/00/00 Financial services, namely, providing investment advice, investment management, investment consultation and investment of funds for others; financial analysis and consultation for others, namely, financial professionals and their client investors and individual and institutional investors; financial planning services; providing investment and portfolio status information by electronic means; financial administration of retirement plans; financial investment research services
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Attachments	87369416#TMSN.png(bytes) 87369358#TMSN.png(bytes) 87479089#TMSN.png(bytes) Petition to Cancel Reg. No. 5131534.pdf(375379 bytes)
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Signature	/KathleenGallagher-Duff/
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Name	Kathleen Gallagher-Duff
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Date	01/18/2018
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Registration No. 5,131,534 - AIM Affirmative Investment Management & Design

Registered: January 31, 2017

FOLIO*fn*, Inc.,

Petitioner,

v.

Affirmative Investment Management Partners Limited,
dba Affirmative Investment Management,

Respondent.

Cancellation No. _____

PETITION FOR CANCELLATION

FOLIO*fn*, Inc., (“Folio*fn*” or “Petitioner”), a Virginia corporation located and doing business at 8180 Greensboro Drive, 8th Floor, McLean, Virginia 22102, believes that it is, and will be, damaged by Reg. No. 5,131,534, and hereby petitions to cancel the same pursuant to Section 14 of the Trademark Act of 1946, 15 U.S.C. § 1064 *et seq.*, as amended.

Reg. No. 5,131,534 is a registration on the Principal Register for the mark AIM Affirmative Investment Management & Design. The registration issued on January 31, 2017 to Respondent. The registration covers “equity capital investment; financial and investment services, namely, management and brokerage in the fields of stocks, bonds, options, commodities, futures and other securities, and the investment of funds of others; financial consultation in the field of environmental management, namely, advising business and individuals on issues of portfolio planning and investment planning; financial services, namely, coordination, within a single account, of an investment portfolio's maintenance, trading, rebalancing, and tax management needs; financial services, namely, operation and management of hedge

funds, commodity pools and other collective investment vehicles, and trading for others of securities, options, futures, derivatives, debt instruments and commodities,” in International Class 36 (“Respondent’s Services”).

As grounds for cancellation, Petitioner alleges that:

1. On March 14, 2017, Petitioner filed with the U.S. Patent and Trademark Office (“PTO”) a registration application for the mark FIRST AFFIRMATIVE for “financial services, namely, providing investment advice, investment management, investment consultation and investment of funds for others; financial analysis and consultation for others, namely, financial professionals and their client investors and individual and institutional investors; financial planning services; providing investment and portfolio status information by electronic means; financial administration of retirement plans; financial investment research services,” in International Class 36 (“First Affirmative Services”) (Serial No. 87/369,416). Petitioner’s FIRST AFFIRMATIVE application claims first use of the mark anywhere and in commerce in 1988.

2. On March 14, 2017, Petitioner filed with the PTO a registration application for the mark FIRST AFFIRMATIVE FINANCIAL NETWORK LLC for First Affirmative Services (Serial No. 87/369,358). Petitioner’s FIRST AFFIRMATIVE FINANCIAL NETWORK LLC application claims first use of the mark anywhere and in commerce in 1999.

3. On June 7, 2017, Petitioner filed with the PTO a registration application for the mark FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design for First Affirmative Services (Serial No. 87/479,089). Petitioner’s FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design application claims first use of the mark anywhere and in commerce in 1999.

4. Petitioner’s FIRST AFFIRMATIVE, FIRST AFFIRMATIVE FINANCIAL NETWORK LLC, and FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design applications hereinafter are referred to as “Petitioner’s FIRST AFFIRMATIVE Applications,” and Petitioner’s FIRST AFFIRMATIVE, FIRST AFFIRMATIVE FINANCIAL NETWORK LLC, and FIRST AFFIRMATIVE

FINANCIAL NETWORK LLC & Design marks hereinafter are referred to as “Petitioner’s FIRST AFFIRMATIVE Marks.”

5. On June 7, 2017, the PTO Examining Attorney assigned to review Petitioner’s FIRST AFFIRMATIVE and FIRST AFFIRMATIVE FINANCIAL NETWORK LLC applications refused registration of the marks on the ground that they are confusingly similar to Respondent’s Reg. No. 5,131,532 for Affirmative Investment Management (Stylized) and Reg. No. 5,131,534 for AIM Affirmative Investment Management & Design, which is the subject of a separate petition for cancellation filed concurrently with this Petition for Cancellation (collectively, “Respondent’s AFFIRMATIVE Registrations.” Respondent’s marks Affirmative Investment Management (Stylized) and AIM Affirmative Investment Management & Design hereinafter are referred to as “Respondent’s AFFIRMATIVE Marks,” and Respondent’s AIM Affirmative Investment Management & Design mark and registration hereinafter are referred to as “Respondent’s Mark” and “Respondent’s Registration.”

6. On September 14, 2017, the PTO Examining Attorney assigned to review Petitioner’s FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design application refused registration of the mark on the ground that it is confusingly similar to Respondent’s AFFIRMATIVE Registrations.

7. The Examining Attorneys determined that Petitioner’s FIRST AFFIRMATIVE Marks and Respondent’s Mark are highly similar because (i) they share the dominant word “Affirmative”; (ii) the words in Petitioner’s FIRST AFFIRMATIVE Marks are either highly descriptive (FINANCIAL NETWORK LLC) or extremely weak due to common use in the financial industry (FIRST); (iii) the words INVESTMENT MANAGEMENT in Respondent’s Mark are highly descriptive and disclaimed; (iv) the term AIM in Respondent’s Mark references the words “Affirmative Investment Management” and reinforces the commercial impression created by the “Affirmative Investment Management” portion of Respondent’s Mark; and (v) with respect to Petitioner’s FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design mark and Respondent’s Mark, the word portions of such marks are the dominant elements in such marks, are more likely to indicate the origin of the services identified by the

respective marks, and are highly similar for the reasons discussed herein. In addition, the design elements do not render the marks dissimilar.

8. The Examining Attorneys determined that the services identified by Petitioner's FIRST AFFIRMATIVE Applications and Respondent's AFFIRMATIVE Registrations are highly related and are presumed to travel in the same channels of trade to the same class of customers.

9. On December 7, 2017, Petitioner filed responses to PTO Office Actions issued for Petitioner's FIRST AFFIRMATIVE Applications, advising that Petitioner has prior rights in its FIRST AFFIRMATIVE Marks and would be filing a petition to cancel Respondent's AFFIRMATIVE Registrations.

10. Petitioner has adopted and has used in interstate commerce, from a time prior to any date upon which Respondent can rely, Petitioner's FIRST AFFIRMATIVE Marks to identify First Affirmative Services.

11. Petitioner has used its FIRST AFFIRMATIVE mark in connection with First Affirmative Services since at least as early as 1988, and has used its FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC and FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design marks in connection with First Affirmative Services since at least as early as 1999. As a result of regular use by Petitioner and Petitioner's predecessor-in-interest of Petitioner's FIRST AFFIRMATIVE mark for nearly 30 years and of Petitioner's FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC and FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC & Design marks for 18 years, Petitioner's FIRST AFFIRMATIVE Marks have become known to the public as marks associated with Petitioner, and Petitioner has acquired significant goodwill associated therewith.

12. By adopting and using Petitioner's FIRST AFFIRMATIVE Marks for an extensive period of time, Petitioner has acquired exclusive rights in such marks, which rights are superior to those of Respondent in Respondent's Mark.

13. Respondent's Mark is confusingly similar to Petitioner's FIRST AFFIRMATIVE Marks for all of the reasons cited by the respective PTO Examining Attorney in the June 7, 2017 Office Actions

for Petitioner's FIRST AFFIRMATIVE and FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC applications and in the September 14, 2017 Office Action for Petitioner's FIRST AFFIRMATIVE FINANCIAL NETWORK, LLC & Design application. The dominant element in each of Petitioner's FIRST AFFIRMATIVE Marks and in Respondent's Mark is the word "Affirmative, which creates an overall similarity in the marks. The additional words in Petitioner's FIRST AFFIRMATIVE Marks and Respondent's Mark are either highly descriptive and disclaimed (FINANCIAL NETWORK LLC in Petitioner's FIRST AFFIRMATIVE Marks and INVESTMENT MANAGEMENT in Respondent's Mark), extremely weak due to common use in the financial industry (FIRST), or in the case of the AIM portion of Respondent's mark, references the words "Affirmative Investment Management" and reinforces the commercial impression created by the "Affirmative Investment Management" portion of Respondent's Mark.

14. With respect to Petitioner's FIRST AFFIRMATIVE FINANCIAL NETWORK LLC & Design mark and Respondent's Mark, the word portions of such marks, which are the dominant elements in such marks and are more likely to indicate the origin of the services identified by the respective marks, are highly similar and the design elements do not render the marks dissimilar.

15. Petitioner's FIRST AFFIRMATIVE Services and Respondent's Services are identical or highly related and, upon information and belief, travel in the same channels of trade to the same class of customers.

16. The adoption and use by Respondent of Respondent's Mark is likely to cause confusion with Petitioner's use of Petitioner's FIRST AFFIRMATIVE Marks, and is likely to cause consumers to assume, erroneously, that Respondent's Services originated or are associated with, or are approved by, Petitioner. Petitioner's invaluable goodwill in its FIRST AFFIRMATIVE Marks will be seriously jeopardized thereby.

17. Petitioner will be damaged by continuance of Respondent's Reg. No. 5,131,534 because such registration was cited by the PTO Examining Attorneys assigned to review Petitioner's FIRST AFFIRMATIVE Applications as a bar to registration of said applications of Petitioner. The continued

registration of Respondent's Mark thus blocks federal registration of Petitioner's FIRST AFFIRMATIVE Applications, will assist and support Respondent in the confusing and misleading use of Respondent's Mark, and will continue to provide rights to Respondent in violation and derogation of the prior and superior rights of Petitioner.

18. To the best of Petitioner's knowledge, the name and address of the registrant of Reg. No. 5,131,534 are Affirmative Investment Management Partners Limited dba Affirmative Investment Management at 107 Cheapside, London, United Kingdom EC2V6DN.


19. For the reasons set forth in paragraphs one through eighteen herein, Petitioner asserts that it is and will be damaged by the continued subsistence of Reg. No. 5,131,534 and, therefore, files this cancellation petition.

WHEREFORE, Petitioner requests that this cancellation petition be sustained and that Reg. No. 5,131,534 be cancelled.

Respectfully submitted,

Foliofn, Inc.

By:


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Counsel for Petitioner
FOLIOfn, Inc.

Dated: January 18, 2018

In re Registration No. 5,131,534 - AIM Affirmative Investment Management & Design

Registered: January 31, 2017

FOLIO*fn*, Inc.,

Petitioner,

v.

Affirmative Investment Management Partners Limited
dba Affirmative Investment Management,

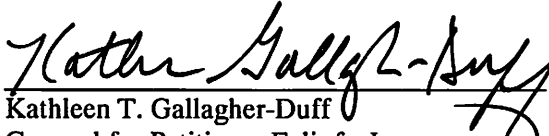
Respondent.

Cancellation No. _____

CERTIFICATE OF SERVICE

This is to certify that I have this 18th day of January, 2018, served Respondent with the foregoing Petition for Cancellation by email (robert.taylor@cubismlaw.com) and by depositing a copy of the same in the United States mail, postage prepaid and properly addressed as follows:

Robert Taylor, Esq.
Cubism Law
1 Plough Place
London, United Kingdom
EC4A1DE


Kathleen T. Gallagher-Duff
Counsel for Petitioner Folio*fn*, Inc.