

ESTTA Tracking number: **ESTTA140983**

Filing date: **05/16/2007**

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 | East West Bank |
| Granted to Date of previous extension | 05/16/2007 |
| Address | 135 N. Los Robles Ave., 7th Floor Pasadena, CA 91101 UNITED STATES |

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|----------------------------|--|
| Correspondence information | Thomas T. Chan Attorney Chan Law Group LLP 1055 West 7th St., Ste 1880 Los Angeles, CA 90017 UNITED STATES tm@chanlaw.com Phone:213-624-6560 |
|----------------------------|--|

Applicant Information

| | | | |
|------------------------|---|------------------------|------------|
| Application No | 78844125 | Publication date | 01/16/2007 |
| Opposition Filing Date | 05/16/2007 | Opposition Period Ends | 05/16/2007 |
| Applicant | Bainbridge Capital, Inc. Suite 500, #5003 4660 LaJolla Village Dr. San Diego, CA 92122 UNITED STATES | | |

Goods/Services Affected by Opposition

| |
|---|
| Class 036. First Use: 1996/01/22 First Use In Commerce: 1996/05/15 All goods and services in the class are opposed, namely: Banking; Capital investment consultation; Equity capital investment; Investment advisory services; Investment banking services; Investment consultation; Investment management; Investment services, namely asset acquisition, consultation, development and management services |
|---|

Grounds for Opposition

| | |
|---|---|
| Priority and likelihood of confusion | Trademark Act section 2(d) |
| <i>Torres v. Cantine Torresella S.r.l.Fraud</i> | 808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986) |

Marks Cited by Opposer as Basis for Opposition

| | | | |
|----------------------|----------|------------------|------------|
| U.S. Application No. | 78897563 | Application Date | 05/31/2006 |
| Registration Date | NONE | Foreign Priority | NONE |

| | | | |
|---------------------|--|------|--|
| | | Date | |
| Word Mark | YOUR FINANCIAL BRIDGE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 036. First use: First Use: 1997/01/01 First Use In Commerce: 1997/01/01 Banking; Cash management | | |

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|----------------------|--|-----------------------|------------|
| U.S. Application No. | 78890654 | Application Date | 05/23/2006 |
| Registration Date | NONE | Foreign Priority Date | NONE |
| Word Mark | BUSINESS BRIDGE | | |
| Design Mark | | | |
| Description of Mark | NONE | | |
| Goods/Services | Class 036. First use: First Use: 1997/05/15 First Use In Commerce: 1997/05/15 Banking; Cash management | | |

| | |
|-------------|--|
| Attachments | 78897563#TMSN.jpeg (1 page)(bytes) 78890654#TMSN.jpeg (1 page)(bytes) opposition.pdf (8 pages)(3675467 bytes) |
|-------------|--|

| | |
|-----------|----------------------|
| Signature | /Lisa A. Karczewski/ |
| Name | Lisa A. Karczewski |
| Date | 05/16/2007 |

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

In the Matter of Trademark Application Serial No. 78844125
Filed on March 23, 2006
For the mark BAINBRIDGE
Published in the *Official Gazette* on January 16, 2007

| | | |
|--------------------------|---|-----------------|
| _____ |) | |
| EAST WEST BANK, |) | |
| |) | |
| Opposer, |) | |
| |) | |
| v. |) | Opposition No.: |
| |) | |
| BAINBRIDGE CAPITAL, INC. |) | |
| |) | |
| Applicant. |) | |
| _____ |) | |

UNITED STATES PATENT AND TRADEMARK OFFICE
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, VA 22313-1451

NOTICE OF OPPOSITION

EAST WEST BANK (“Opposer”), a California corporation having its business address at 135 N. Los Robles Ave., 7th Floor, Pasadena, California 91101, believes it will be damaged by BAINBRIDGE CAPITAL, INC.’S (“Applicant”) application for trademark registration of the mark, BAINBRIDGE (“Applicant’s mark”), shown in Serial No. 78844125, and hereby opposes the same.

As grounds of opposition, it is alleged that:

A. There is a Likelihood of Confusion Between Applicant's Mark and Opposer's Mark

1. The Applicant has requested protection in the United States of the mark BAINBRIDGE for the following services: "Banking; Capital investment consultation; Equity capital investment; Investment advisory services; Investment banking services; Investment consultation; Investment management; Investment services, namely, asset acquisition, consultation, development and management services," in International Class 36. The application was filed on March 23, 2006 under Section 1(a) and was published in the *Official Gazette* on January 16, 2007.

2. Opposer is the owner of the trademarks ("Opposer's Marks"): (a) YOUR FINANCIAL BRIDGE, Serial No. 78/897,563, for "banking; cash management," in International Class 36; and (b) BUSINESS BRIDGE, Serial No. 78/890,654, for "banking; cash management," in International Class 36.

3. Opposer has used the respective marks identified above in interstate commerce since at least (a) January 1, 1997 and (b) May 15, 1997, respectively. Opposer is now using the marks identified above in connection with the respective services identified above. The use has been valid and continuous since the date of first use within the United States and has not been abandoned. Opposer's Marks are symbolic of the good will and consumer recognition built up by Opposer through time and effort in advertising and promotion.

4. Applicant claims to have used its mark identified above in interstate commerce since as early as May 15, 1996.

5. On information and belief, Applicant has not used the alleged BAINBRIDGE

Mark prior to the dates identified above in Paragraph 3 with respect to banking services in International Class 36.

6. Applicant's Mark, as shown in Serial No. 78844125, so resembles Opposer's Marks and is for banking services which so resemble that of Opposer as to be likely to cause confusion. Such services are sold within the same channels of trade to the same class of purchasers for substantially the same use and function. Accordingly, Applicant's use of the mark, BAINBRIDGE, in association with the sale of its banking services will lead to confusion and deception within the purchasing public as to the origin of all such services bearing Applicant's Mark.

7. If the Applicant is permitted to use and register the BAINBRIDGE mark for its banking services, as specified in the application herein opposed, confusion in trade resulting in damage and injury to the Opposer would be caused and would result by reason of Applicant's use of a mark so resembling Opposer's Marks. Individuals or entities familiar with Opposer's Marks would likely buy Applicant's banking services, which would result in the loss of sales to Opposer. Furthermore, any defect, objection or fault found with Applicant's banking services marketed under Applicant's Mark would necessarily reflect upon and seriously injure the reputation which the Opposer has established for its services under its Marks.

8. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to the use of its mark. Such registration would be a source of damage and injury to the Opposer.

B. Applicant is Barred from Obtaining a Registration of Applicant's Mark Because It Failed to Use Applicant's Mark in Commerce in Connection with All the Services Listed in the Application Prior to the Filing Date of the Application

9. Applicant's application was filed pursuant to Section 1(a) of the Lanham Act based on use of Applicant's Mark in connection with the services listed in such application. In the application, Applicant asserts that it has used Applicant's Mark in connection with each of the following services: "Banking; Capital investment consultation; Equity capital investment; Investment advisory services; Investment banking services; Investment consultation; Investment management; Investment services, namely, asset acquisition, consultation, development and management services," in International Class 36.

10. According to Applicant's website, <http://www.bainbridgecapital.com> (visited May 15, 2007), Bainbridge Capital is a "leading global investment banking, private equity, research, venture capital, and financial management firm that provides a wide range of services worldwide to a diversified client base that includes corporations, management groups, and high net-worth individuals." *See Exhibit A attached hereto.*

11. Upon information and belief, Applicant had not used Applicant's Mark in connection with all of Applicant's services as of March 23, 2006, the filing date of Applicant's application.

12. Upon information and belief, Applicant had not used Applicant's Mark in connection with banking services as of March 23, 2006, the filing date of Applicant's application.

13. Upon information and belief, Applicant falsely stated the date of first use of its Mark on its banking services recited in its application.

14. Applicant's application would not have been allowed for all of the services identified therein but for the willful, material misrepresentation in the application regarding the use of the Applicant's mark on each of the recited services.

15. Opposer accordingly alleges that Applicant's application constitutes a fraud on the U.S. Patent and Trademark Office.

WHEREFORE, Opposer prays that said application Serial No. 78844125 be rejected and stricken, that no registration be issued thereon to the Applicant, BAINBRIDGE CAPITAL, INC., and that this opposition be sustained in favor of Opposer.

Opposer hereby appoints Thomas T. Chan; Ronald M. St. Marie; Ivan Posey (Reg. No. 43,865), and Lisa A. Karczewski (Reg. No. 53,096), members of the CHAN LAW GROUP LLP, with offices at P.O. Box 79159, Los Angeles, California 90079-0159, as its attorneys to prosecute this opposition proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith.

Respectfully submitted,

CHAN LAW GROUP LLP

Dated: 5/15/2007

By:



Thomas T. Chan
Ronald M. St. Marie
Ivan Posey
Lisa A. Karczewski
Attorneys for Opposer
EAST WEST BANK

CHAN LAW GROUP LLP
1055 W. 7th Street, Suite 1880
Los Angeles, CA 90017

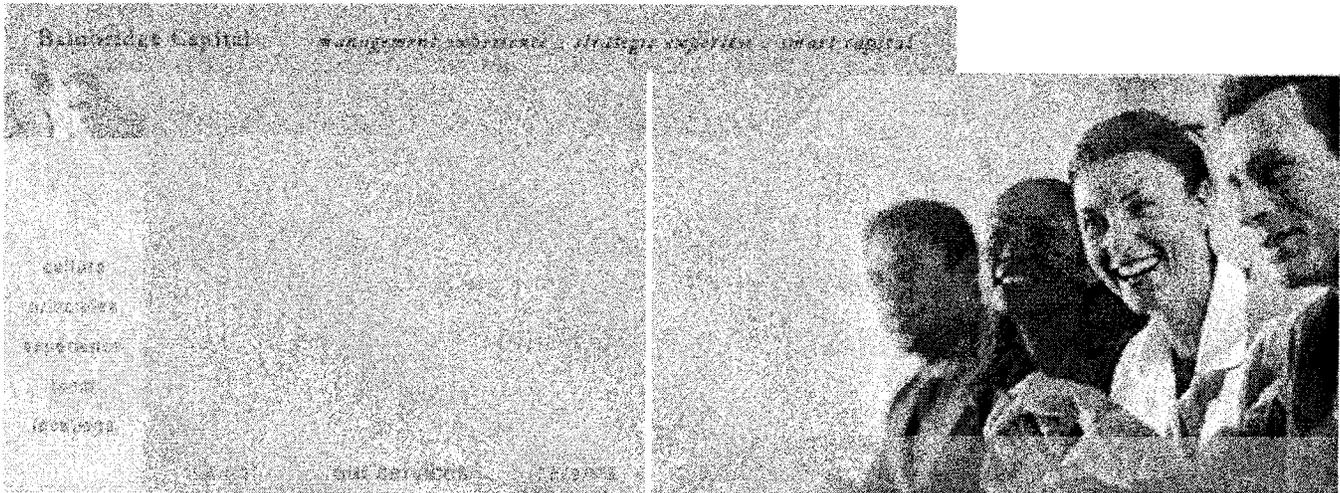
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EXHIBIT A



OUR FIRM

INTELLECTUAL CAPITAL - REPORTS

- >> 2005 M&A Summary Report
- >> Small-to-mid cap M&A
- >> Profiles of the people of Bainbridge Capital
- >> Historical Investment Summary 2001 to 2005
- >> Healthcare M&A
- >> Oil & Gas M&A

FEATURES

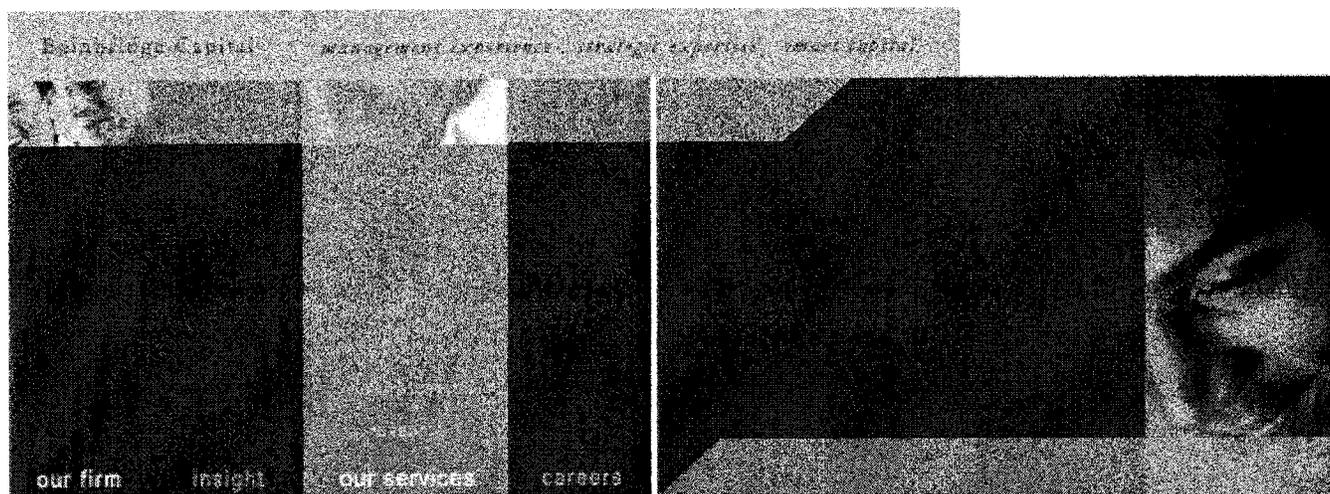
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Bainbridge Capital announces completion of Dianon merger with LabCorp. in a \$598MM sale... >> [read more](#)

Bainbridge Capital has been a leading global investment banking, private equity, research, venture capital, and financial management firm that provides a wide range of services worldwide to a diversified client base that includes corporations, management groups, and high net-worth individuals.

Founded originally as YBI Venture Capital Group, the firm is located in Bermuda, Panama, New York, Boston and other major financial centers around the world.

We are committed to maintaining our distinctive approach which places a premium on management experience and strategic execution. We bring experience from Bainbridge Management Consulting, our strategic advisory firm. Our commitment is to our core values which always places the client's interests first. These values are reflected in our Business Principles, which emphasize integrity, commitment to excellence, innovation and teamwork. This environment enables us to successfully execute a winning business strategy that results in extraordinary client service and superior long-term financial performance for our partners.



CLIENT SERVICES

INTELLECTUAL CAPITAL - REPORTS

- >> 2005 M&A Summary Report
- >> Small-to-mid cap M&A
- >> Profiles of the people of Bainbridge Capital
- >> Historical Investment Summary 2001 to 2005
- >> Healthcare M&A
- >> Oil & Gas M&A

FEATURES

Bainbridge Capital announces the merger of Dianon and LabCorp. in a \$598MM stock sale. Bainbridge Capital has acted as M&A advisor to Dianon... >> [read more](#)

Bainbridge Capital announces completion of Dianon merger with LabCorp. in a \$598MM sale... >> [read more](#)

The people of Bainbridge Capital apply a wealth of experience to a broad range of strategies and transactions for our clients. Our substantial and diversified client base includes corporations, private equity clients, venture capitalists, and high net-worth individuals.

We seek to be the advisor of choice for our clients; by drawing on strategic management and financial expertise our clients will receive unparalleled counsel.

Bainbridge Capital services include:

- >> **Investment Banking**
 - Corporate financial management
 - Mergers and Acquisitions
 - Private Placements
 - Merchant Banking / Private Equity

>> **Venture Capital: Bainbridge VC**

>> **Research: Objective Company Research***

While each of these areas of activity have aided in making the premier boutique firm leader, it is truly our core values: commitment, teamwork, integrity, professional excellence and entrepreneurial spirit that have allowed us to help our clients succeed.

Bainbridge Capital provides company level research and makes no representations regarding the stocks of public traded companies.