

ESTTA Tracking number: **ESTTA218257**

Filing date: **06/17/2008**

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	Premier Commercial Bank
Granted to Date of previous extension	06/18/2008
Address	701 Green Valley Rd., Suite 102 Greensboro, NC 27408 UNITED STATES
Party who filed Extension of time to oppose	Premier Commercial Bank [proposed]
Relationship to party who filed Extension of time to oppose	The entity is the same. The deleted wording was, at the time, required by state banking regulations and is no longer required for this entity. The entity is Premier Commercial Bank f/k/a Premier Commerical Bank [proposed].

Attorney information	David W. Sar Brooks, Pierce, McLendon, Humphrey & Leonard, L.L.P. P.O. Box 26000 Greensboro, NC 27420 UNITED STATES dsar@brookspierce.com Phone:336-373-8850
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Applicant Information

Application No	77273108	Publication date	02/19/2008
Opposition Filing Date	06/17/2008	Opposition Period Ends	06/18/2008
Applicant	Premier Commercial Bank, N.A. 2400 East Katella Avenue, Suite 125 Anaheim, CA 928065920 UNITED STATES		

Goods/Services Affected by Opposition

Class 036. First Use: 2001/11/25 First Use In Commerce: 2001/11/25 All goods and services in the class are opposed, namely: On-line banking services; Banking
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Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
The mark is merely descriptive	Trademark Act section 2(e)(1)
The mark is deceptively misdescriptive	Trademark Act section 2(e)(1)
The mark comprises matter that, as a whole, is	Trademark Act section 2(e)(5)

functional	
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Genericness	Trademark Act section 23
Other	Please see the Notice of Opposition attachment for greater elaboration.

Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	Premier Commercial Bank		
Goods/Services	banking services		

Attachments	PCBNoticeofOpposition.pdf (8 pages)(395976 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/DavidWSar/
Name	David W. Sar
Date	06/17/2008

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

In the matter of Application
Serial No. 77273108

Published in the Official Gazette of February 19, 2008

_____)	
PREMIER COMMERCIAL BANK,)	
)	
Opposer,)	
)	
v.)	Opposition No. _____
)	
PREMIER COMMERCIAL BANK, N.A.,)	NOTICE OF OPPOSITION
)	
Applicant.)	
_____)	

Premier Commercial Bank f/k/a Premier Commercial Bank [proposed] (“Opposer”), a banking corporation organized and existing under the laws of the State of North Carolina, believes that it will be damaged by the registration of the trademark shown in Application Serial No. 77273108 filed September 6, 2007, and hereby opposes registration of the same.

As grounds for the opposition, Opposer, by and through its undersigned attorney, respectfully shows and alleges as follows:

1. Opposer is a state chartered banking corporation organized and existing under the laws of the State of North Carolina, with its principal place of business at 701 Green Valley Road, Suite 102, Greensboro, North Carolina 27408.

2. Applicant Premier Commercial Bank, N.A. (“Applicant”) is chartered as a national banking association organized under the laws of the United States of America, with its principal place of business at 2400 East Katella Avenue, Suite 125, Anaheim, California 92806.

3. In early 2006, the organizer(s) of Opposer conceived the idea of forming North Carolina's first business bank headquartered in the Piedmont Triad region (Greensboro, Winston-Salem and High Point) of North Carolina, focused exclusively on meeting the banking needs of small and midsize businesses, their owners and employees. The organizer(s), acting on behalf of and for the benefit of Opposer began the processes of selecting the name "Premier Commercial Bank" as trademark for Opposer's banking services and also began developing, acquiring and enhancing public recognition of, goodwill in, and the distinctiveness of "Premier Commercial Bank" as a tradename and trademark for Opposer's banking services.

4. Prior to the development actions taken for the benefit of Opposer, no one had previously used the phrase "Premier Commercial Bank" as a trademark for banking services in North Carolina or in any reasonable proximity to North Carolina. Upon information and belief, prior to the development activity taken for the benefit of Opposer, no one had developed any nationwide trademark rights to "Premier Commercial Bank," nor had the phrase acquired distinctiveness in association with anyone else's banking services in any particular location. No one had applied for a federal trademark registration of "Premier Commercial Bank" prior to the development activity taken for Opposer.

5. The actions of the organizer(s) to establish "Premier Commercial Bank" as a tradename and trademark were taken on behalf of and for the benefit of Opposer. Opposer is currently the owner of and successor in interest to the trademark rights and priority to "Premier Commercial Bank" developed or held itself, on its behalf or by its organizer(s).

6. In September 2006, the organizers gave notice to the Office of the North Carolina Commissioner of Banks ("NC Banking Commissioner") of their intention to submit an application to charter a bank to be called "Premier Commercial Bank," thereby formally commencing with the banking regulators the lengthy process of satisfying the regular banking and administrative requirements required to charter a bank. The organizers also submitted on September 30, 2006 an application to the State of North Carolina Department of the Secretary of

State ("NC Secretary of State") to reserve the name "Premier Commercial Bank," which application was accepted on October 9, 2006 and filed by the NC Secretary of State.

7. In October 2006, the organizers formed a North Carolina limited liability company named Premier Commercial, LLC to conduct pre-opening activities and to enter into contracts ultimately for the benefit of Opposer.

8. Over the course of the subsequent year (prior to the September 6, 2007 filing of the Application herein opposed) and beyond, Opposer, through its organizers, engaged in substantial and extensive activities to establish, promote and raise awareness of the fact that "Premier Commercial Bank" was Opposer's tradename and trademark for banking services. For example, and without limitation, numerous presentations describing the Opposer's business plan and services were made to members of the business community in the Piedmont Triad region and other metropolitan areas throughout the State of North Carolina and surrounding states; press releases were published; meetings were held with members of the public; interviews were conducted with journalists from the banking, business and general media; and mailers were sent to thousands of potential subscribers and customers introducing them to and highlighting Opposer's brand and services. A live website for the Opposer was established by July 2007.

9. Substantial work, time and energy was also expended to ready and to establish Opposer as a bank with the name "Premier Commercial Bank." For example and without limitation, a feasibility study was commissioned, detailed business plans were established, meetings were held with the NC Banking Commissioner and Federal Deposit Insurance Corporation ("FDIC"), capital requirements were determined, office space was leased to serve as Opposer's organizational and main banking office, and banking professionals were recruited.

10. On August 8, 2007, an InterAgency Charter and Federal Deposit Insurance application was filed with the NC Banking Commissioner and FDIC for Opposer. That application indicated that Opposer intended to open as a bank under the tradename and trademark "Premier Commercial Bank." Public notice about the bank appeared in a newspaper

on August 16, 2007, pursuant to federal regulatory requirements. Additional notices appeared subsequently, pursuant to state regulatory requirements. Opposer's applications to the NC Banking Commissioner and FDIC were not opposed.

11. The promotional efforts of and on behalf of Opposer were successful in building public and customer recognition of "Premier Commercial Bank" as the tradename and trademark of Opposer.

12. Among other evidence, media accounts demonstrate that the media and the public recognized the phrase "Premier Commercial Bank" as Opposer's name and trademark.

13. Opposer thus adopted the use of the phrase "Premier Commercial Bank" as a tradename and trademark, and the public identified and distinguished Opposer's services as being symbolized by the phrase, all before September 6, 2007 (the filing date of the trademark application herein opposed).

14. Since September 6, 2007, Opposer has continued its promotional and marketing efforts such that the recognition and goodwill attributable to its tradename and trademark have continued and grown.

15. Opposer is now, and has been for some time, offering and providing its banking services under the tradename and trademark "Premier Commercial Bank."

16. Approximately a year after the Opposer began promoting and establishing goodwill and recognition for its tradename and trademark "Premier Commercial Bank," the Applicant filed on September 6, 2007 its U.S. Trademark Application Serial No. 77273108 for the use of "Premier Commercial Bank" in connection with "on-line banking services; banking" in international class 36 (the "Application").

17. Applicant has only two (2) physical locations from which it provides its services. Both of those locations are in Orange County, California. Applicant reinforces its connection to the Orange County area of California through its website/URL address "<http://www.pcboc.com>."

18. Prior to the time when Opposer established its prior rights to “Premier Commercial Bank,” Applicant had not used the phrase “Premier Commercial Bank” as a trademark in connection with any services in a geographic or other market in which Opposer has utilized “Premier Commercial Bank.”

19. Opposer has priority over Applicant to use the phrase “Premier Commercial Bank” within the United States, or in the alternative, within a substantial portion of the United States, or, in the further alternative, within North Carolina and a reasonable territory emanating from North Carolina.

20. Upon information and belief, Applicant’s phrase “Premier Commercial Bank” has not acquired distinctiveness as an indicator of Applicant’s banking services.

21. In the alternative, Applicant’s use of the phrase “Premier Commercial Bank,” as designated in its Application, is merely descriptive, misdescriptive, generic or otherwise unregistrable.

22. The Application was published for opposition on February 19, 2008.

23. On March 19, 2008, the Opposer, both itself and through Premier Commercial, L.L.C., filed a Request for Extension of Time to File Notice of Opposition to U.S. Application Serial No. 77273108 through the Trademark Trial and Appeal Board’s ESTTA electronic filing system.

24. If Applicant’s and Opposer’s respective banking services were offered within the same geographic markets and if the phrase “Premier Commercial Bank” is determined to be protectable as a mark by both Opposer and Applicant, then the parties’ relevant consumers and the public would likely be confused by the competing uses of the same mark with the same or similar banking services.

25. If Applicant is granted a registration for the mark herein opposed for the services specified in the Application, notwithstanding Opposer’s priority to the term and the lack of distinctiveness acquired in the mark by Applicant, Opposer would be irreparably injured and

damaged. Such a registration would be inconsistent with Opposer's rights in its trade name and trademark.

26. The Application should therefore be denied for the following independent reasons, among others asserted herein and as may be determined through the course of this Opposition proceeding or by the Trademark Trial and Appeal Board:

a. Opposer has prior rights to use the phrase "Premier Commercial Bank" as a tradename and/or trademark in commerce in connection with its services, and the registration of the mark sought in the Application by Applicant would be inconsistent with Opposer's rights;

b. Opposer has prior rights to use the phrase "Premier Commercial Bank" as a tradename and/or trademark in commerce in connection with its services in certain geographic areas, and the registration of the mark sought in the Application by Applicant would be inconsistent with Opposer's rights;

c. Upon information and belief, Applicant knew of, or had constructive notice of, or should have known of, Opposer and Opposer's prior rights in advance of filing the Application, and thereby violated 15 U.S.C. § 1051(a)(3), made a material misrepresentation, and/or committed fraud when it asserted in the Application, among other things, that no other person has a right to use the mark in commerce either in the identical form thereof or in such near resemblance thereto as to be likely, when used on or in connection with the goods of such other person, to cause confusion, or to cause mistake, or to deceive;

d. Applicant failed to claim concurrent use, failed to state exceptions to Applicant's claim of exclusive use, and failed to specify the extent of the concurrent use by Opposer, as required by 15 U.S.C. § 1051(a)(3);

e. The mark when used on or in connection with the services of Applicant is merely descriptive or deceptively misdescriptive, generic, and/or functional; and

f. The mark when used on or in connection with the services of Applicant has not acquired distinctiveness under 15 U.S.C. § 1052(f).

WHEREFORE, Opposer respectfully requests that

- i. this Opposition be sustained;
- ii. Application Serial No. 77273108 be denied registration, in whole or in part; and
- iii. the Trademark Trial and Appeal Board enter such other and further relief as is just and proper.

Respectfully submitted, this the 17th day of June, 2008.

/David W. Sar/

David W. Sar

N.C. State Bar No. 23533

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Attorney for Opposer

Premier Commercial Bank

CERTIFICATE OF SERVICE

The undersigned counsel hereby certifies that the foregoing Notice of Opposition was served upon the Applicant by mailing on the day set forth below a copy thereof by first class mail, Certified Mail, Return Receipt Requested, postage prepaid, addressed as follows:

Eric J. Goodman, Esq.
Burkhalter Kessler Goodman & George LLP
2020 Main Street, Suite 600
Irvine, CA 92614-8226

Attorney of Record for Applicant

This the 17th day of June, 2008.

/David W. Sar/
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