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

Proceeding	91203410
Party	Plaintiff The Plubell Firm, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of Serial No. 85319594
For the mark "EAST WEST BRIDGE FORUM"

In the Matter of Registration No. 3448481
Registered on June 17, 2008
For the mark "EAST-WEST BUSINESS BRIDGE"

EAST WEST BANK

Petitioner,

v.

THE PLUBELL FIRM, LLC

Respondent.

OPPOSITION NO. 91203410

[Consolidated with]

CANCELLATION NO. 92053712

RESPONDENT'S OPPOSITION TO PETITIONER'S MOTION FOR SANCTIONS; AND REQUEST TO VACATE FOOTNOTE IN DISCOVERY CONFERENCE ORDER

Respondent, The Plubell Firm, LLC ("Respondent" or "Plubell"), through its undersigned attorneys, submits this brief in opposition to Petitioner East West Bank's ("Petitioner" or "EW Bank" herein) Motion for Sanctions (hereinafter "Motion").

I. SUMMARY OF ARGUMENT

Enough is enough. Respondent has not violated any Orders of the Board. Not even close.

First, serving new Notices of Depositions on Petitioner's witnesses after Ms. Wang's deposition did not violate the Board's Order of December 22, 2011 which merely granted EW Bank's motion to quash certain noticed depositions *at that time*. The Order states, in pertinent part, as follows:

> "Respondent must depose a Fed. R. Civ. P. witness or Marketing Director Wang, …***before seeking other deponents***."

[See, Exhibit D to Declaration of Thomas T. Chan in Support of Motion ('Chan Dec."), at page 6; (emphasis added).] Thus, the Board's Order specifically contemplated that Respondent could seek further depositions upon the satisfaction of the directive to first take the testimony of the Fed. R. Civ. P. Rule 30(b)(6)/Ms. Wang witness. Moreover, Respondent acted in good faith by advising Petitioner and the Board that its purpose in serving the notices during the subsequent and abbreviated discovery period was to preserve rights while Respondent's "Motion to Extend Discovery Period; Permit Follow-Up Discovery Depositions; or In the Alternative, For Evidentiary Sanctions" (herein "Motion to Extend") was pending. The Board took no issue with the service of these Notices during the April 25, 2012 hearing or its recent May 7, 2012 Order, even though Petitioner raised this issue in its Opposition.

Second, there is no merit to Petitioner's claim that Respondent's Notices of Deposition for Petitioner's 30(b)(6) witness was too broad in scope, or that a brief line of questioning on the nature of Petitioner's business related to its regulatory compliance violated any Board Order. Respondent's Notices and the focused and relevant line of questioning relate directly to the issue of likelihood of confusion in this proceeding.

Third, there is no Board Order "relating to discovery" that Respondent has violated with the settlement correspondence of Respondent's principal, Ms. Plubell, to Petitioner's representatives. The Interlocutory Attorney's confirmation of the discovery conference is not a "discovery order" as contemplated by 37 CFR §2.120(g) or TBMP 527.01(a). Thus, grounds for sanctions do not exist. Moreover, the footnote relied on by Petitioner which states, in part, that "Ms. Plubell's attempt to communicate directly with petitioner" is "improper" lacks any legal citation or reasoning, is prejudicial to Ms. Plubell as it suggests she did something wrong, and it

implicates Ms. Plubell's First Amendment rights.[1] While Ms. Plubell has retained counsel to represent Respondent in this proceedings, and while "questions involved in this proceeding" obviously must be directed through counsel, Ms. Plubell, as Respondent's principal, has every right to direct settlement communications to Petitioner. The Board not only permits party-to-party settlement discussions but, indeed, they are strongly encouraged. See. e.g., March 19, 2012 discovery conference order on file in Opposition No. 91203410 (consolidated with this proceeding on May 7, 2012), which states:

> "The parties may, of course, initiate settlement discussions between themselves if they so choose."

Whether Petitioner chooses to respond to Ms. Plubell's direct communication is its right, but it is not improper for Ms. Plubell to attempt to communicate directly with Petitioner, especially when attorney-to-attorney efforts have been cut off or stifled by disrespectful comments by Petitioner's attorneys.[2]

Finally, Petitioner is a twenty-billion dollar bank. Respondent is a single-employee consultancy. Far from being "forced" to take action against Respondent by filing the present Motion, it is believed that Petitioner tactically timed its frivolous Motion to coincide with and influence the Board's hearing on Respondent's then-pending Motion to Extend. Specifically, the Motion was filed on Monday, April 23, 2012, with the intent to distract from, cloud and disrupt Respondent's focus on the Wednesday, April 25, 2012 hearing on Respondent's Motion to Extend. Such tactics are not a constructive use of the parties or the Board's time.

As will be shown further herein, the Motion should be denied.

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[1] See, Exhibit B to Chan Dec., ftn. 2. Accordingly, Respondent respectfully asks the Board to vacate or clarify the footnote when it issues its ruling on this Motion.

[2] As previously reported, Petitioner's counsel's statement of August 2011 to Respondent that he would only consider settlement matters "in the bathtub" was so shockingly disrespectful that Respondent sought clarification as to settlement directly from the Petitioner.

II. LEGAL ARGUMENT

A. Sanctions Under Rule 2.120(g) Require Noncompliance with a Board Order

"[I]f a party fails to comply with an order of the [Board] ***relating to disclosure or discovery***, including a protective order, the Board may make any appropriate order, including those provided in Rule 37(b)(2) of the Federal Rules of Civil Procedure." Rule 2.120 (g)(1)(emphasis added). The determination and imposition of an appropriate sanction is a fact-specific inquiry. *Ehrenhaus v. Reynolds*, 965 F. 2d 916, 920 (10th Cir. 1992). Dismissal of a party's case is appropriate only in instances of willful misconduct.[3] *Id.; Meade v. Grubbs*, 841 F.2d 1512, 1520-21 (10th Cir. 1988). Here, as shown below, there has been no failure to comply, let alone willful misconduct warranting the imposition of any sanctions whatsoever.

B. The Service of Deposition Notices Did Not Violate a Board Order

Petitioner has taken the indefensible position that Respondent's service of Notices of Deposition during the then remaining discovery period and after the deposition of Ms. Wang violates the Board's Order of December 22, 2011 which simply quashed earlier deposition notices as premature. Petitioner already raised this frivolous contention in its Opposition to Respondent's Motion to Extend (Dkt. #28). Respondent fully responded in its Reply. (Dkt. #30, p. 5-6). Specifically, Respondent demonstrated in its Reply that: the granting of a motion to quash as premature in no way prohibited Respondent from later seeking the depositions after the Board's stated conditions were satisfied; Respondent's service of Notices of Deposition was for

[3] Pursuant to *Ehrenhaus,* the Court gave a number of factors prior to choosing dismissal as an appropriate sanction. Some of those factors are: (1) the degree of actual prejudice to the opposing party; (2) the amount of interference with the judicial process; (3) the culpability of the litigant; and (4) the efficacy of lesser sanctions. *Ehrenhaus*, 965 F.2d at 921. Respondent has fully complied with all applicable Orders; however, should the Board observe any inadvertent or technical non-compliance, the factors weigh against the imposition of any sanction in this matter.

the purpose of preserving rights by noticing the witnesses during the existing discovery period under TBMP §404.01 while its Motion to Extend and request for the depositions was pending; Respondent acted in good faith by communicating its intentions to the Board before serving the Notices of Deposition, and at the time of service Respondent advised Petitioner that it was serving such notices to preserve its rights pending clarification of the discovery period and request for additional depositions. See, Dkt. #30, p. 5-6; Dkt. #24 at 8-9.

Respondent is not required by the Board's Order and the Board's Order is silent as to any requirement that Respondent obtain leave before it *served* further Notices of Depositions intended to preserve its rights. Moreover, at the April 25, 2012 hearing, the Board observed that, due to the timing of the Board's scheduling order, there was no motion to compel nor a motion to quash pending. That is, the Board found no issue as to the service of Notices of Deposition though Petitioner opposed the Motion to Extend on this basis. Petitioner's attempt to seek *terminating* sanctions against Respondent on this basis is beyond frivolous – it is outrageous.

C. Respondent's Discovery Did Not Violate the Board's Order

Petitioner has taken the further position that the deposition notices for EW Bank and Ms. Wang and certain deposition questions on the nature of EWB's business as it relates to regulatory compliance violated the Board's Order of December 22, 2011. Both contentions are without any merit.

First, the deposition notices clearly and specifically set out narrowly focused topics for examination related to likelihood of confusion, priority and validity, including the specific topic described as the "general nature of [Petitioner's] business". (See, Exhibit E to Chan Dec. at p. 3).

Moreover, Petitioner's belated complaint about Respondent's deposition notices should be rejected as untimely and without merit. Petitioner included the same belated complaint in its Opposition to the Motion to Extend knowing full well of its obligations to timely raise such matters in advance of the deposition. (Dkt. # 28) Now, Petitioner, having shirked its obligations, complains that the deposition notices were "overbroad and mostly irrelevant," yet fails to point to a single example in support of its position. Indeed, despite Respondent's invitation in the required meet and confer to discuss any concern about matters for examination, Petitioner did not take this position and expressly agreed that the relevancy and breadth of the matters set forth in the deposition notices were not at issue:

> I should say that I don't see any major discrepancy in how the two parties view the scope of the relevant issues in this proceeding. *I do not anticipate the scope of the deposition or relevance being a problem* and I hope that both sides will cooperate in making these depositions go as smoothly as possible.

See, Dkt. #30, Starr Decl., Exh. 1, dated April 24, 2012. Petitioner's opportunistic change of position should be seen for what it is – an improper attempt to impugn Respondent and its right to take relevant discovery in this matter.

Likewise, the complained-of deposition line of questioning relating to the nature of Petitioner's business in so far as its regulatory compliance obligations is relevant to the issue of likelihood of confusion. Obviously, in this proceeding, whether the parties are involved in the same industry is relevant. The extent that the banking industry is highly regulated (and to the extent that such regulation does not exist with Respondent's business consulting services), is relevant because it shows the relatedness (or lack thereof) of the two industries and the services in this case, and thus, weighs on the issue of likelihood of confusion. See, TBMP, section 402 and cases cited therein regarding scope of discovery and relevance. It was therefore improper for

Petitioner's counsel to instruct EW Bank's witness (and fact witness) Ms. Wang *not* to answer such questions; there was nothing improper about asking them.[4]

Petitioner itself has confirmed the relevancy and need to probe regarding the nature of the banking industry and its regulations by producing in discovery a document entitled: "Activities Permissible for a National Bank, Cumulative," a publication of the Office of the Comptroller of the Currency, Treasury Department, upon which it may attempt to rely for its position that banking services are sufficiently closely related to business consultation services, an important factor in the likelihood of confusion analysis. *See* Declaration of Mina Hamilton, at Ex. 1.

Petitioner also contends that it currently provides, or plans to provide, business consulting services relating to U.S.-China business transactions, which again is relevant to the degree of relatedness of the services factor of the likelihood of confusion inquiry. If this is indeed the case, then Petitioner is obligated to disclose its intention to provide such services which are services beyond banking under its state banking charter to investors and shareholders in accordance with its regulatory obligations to the Security and Exchange Commission and other regulatory and oversight bodies. Probing as to these disclosures and regulatory obligations was proper.

Accordingly, there can be no doubt that Respondent's line of questioning on the subject of Petitioner's internal safeguards for ensuring regulatory compliance was relevant and likely to lead to the discovery of admissible evidence per Fed. R. Civ. P. 26(b)(1) as it pertains to the issue of likelihood of confusion.[5] No Board order was violated by such questioning.

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[4] Petitioner has omitted page 206 from the deposition wherein Respondent's counsel stated on the record the relevancy of the line of questioning and Petitioner instructed his witness to not answer. *See* Declaration of Mina Hamilton attached hereto; Ex. 2 at page 206:lines 1-17.

[5] Indeed, it has been *Petitioner*, not Respondent, that engaged in highly objectionable and bizarre lines of questions during deposition, prefacing some inquiry with the phrase "not that it

D. Ms. Plubell's Party-to-Party Settlement Correspondence Is Proper

Finally, Petitioner contends that Ms. Plubell's effort to initiate party-to-party settlement discussions violates the Board's Order of May 9, 2011. Ms. Plubell's correspondence was proper and consistent with the Board's policies in strongly encouraging settlement.

However, the fact that the Board's footnote in its May 9, 2011 order is **not** a "discovery order" contemplated under Rule 2.120(g)(1) defeats Petitioner's grounds for requesting terminating sanctions. There is no legal authority for such sanctions. In a highly analogous case, the Board found that its institution order did not constitute an order within the contemplation of Trademark Rule 2.120(g)(1):

> A notice of institution is merely a scheduling order, whereas the type of order that is contemplated as a prerequisite to a motion for sanctions under Trademark Rule 2.120(g)(1) ***is an order granting or denying a motion to compel*** or a motion for protective order.

Kairos Institute of Sound Healing, LLC v. Doolittle Gardens, LLC, 2008 TTAB LEXIS 61, *8-9 (TTAB October 17, 2008)(emphasis added). The Board's confirmation of a discovery conference is akin to an institution order. It is not an order that decides a substantive discovery dispute such as a motion to compel or a protective order. Accordingly, the Board may deny sanctions on this basis alone.

Moreover, Petitioner's citation to the footnote in the Board's Order that appears to be a prohibition against party-to-party settlement negotiations is extremely troubling. The footnote should be vacated to the extent that it suggests that Ms. Plubell's direct settlement

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has anything to do with this case," including interest in Ms. Plubell's scuba diving experience and Petitioner's counsel's sporting interests as well as spending extensive time on Respondent's billing practices with its attorneys instead of taking only deposition testimony related to matters concerning the trademark registration. If terminating sanctions were to be granted for Respondent's line of questioning, then terminating sanctions against Petitioner are surely warranted by Petitioner's improper questions.

communications with Petitioner violates any rule of ethics or other TTAB or Federal Rule. Indeed, the policy is always in favor or encouraging settlement by the parties. "The Board certainly encourages settlement discussions at any time." *Promgirl, Inc. v. JPC CO., Ltd.*, 94 USPQ2d 1759 (TTAB 2009); *See also Pernod Ricard v. Molson Breweries*, 1996 TTAB LEXIS 467 (TTAB 1996) ("Certainly, the Board, (as all tribunals) strongly encourages active settlement discussions."). Moreover, the Board's Order in the now-consolidated Opposition No. 91203410 clearly states that "The parties may, of course, initiate settlement discussions between themselves if they so choose." See, Opposition No. 91203410, (Dkt. #8).

The Patent and Trademark Office's Rules of Practice, consistent with state bar rules of ethics,[6] expressly encourage party-to-party settlement communications:

> It is ***not improper***, however, for a practitioner to encourage a client to meet with an opposing party for settlement discussions.

2 C.F.R. §10.87 (emphasis added). *See also Dorsey v. Home Depot U.S.A., Inc.,* 271 F. Supp. 2d 726, 730 (D. Md. 2003) ("Nothing in the law prohibits litigants or potential litigants from speaking among and between themselves, *as opposed to attorneys for such parties attempting direct communications with represented parties*.")(emphasis added).

To be clear: Ms. Plubell is (and never was) acting as an attorney for Respondent in this proceeding. She is Respondent's principal, who happens to be lawyer. Her communications with Petitioner have been as Respondent's principal.

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[6] *See, e.g.*, Maryland Lawyer's Rules of Professional Conduct, Commentary to Rule 4.2 ("Also, parties to a matter may communicate directly with each other and a lawyer having independent justification or legal authorities for communicating with a represented person is permitted to do so."); California Rules of Professional Conduct: "Rule 2-100 is not intended to prevent the parties themselves from communicating with respect to the subject matter of the representation, and nothing in the rule prevents a member from advising the client that such communication can be made."

The footnote in the Board's May 9, 2011 Order suggests that the Interlocutory Attorney simply meant that Ms. Plubell was not to direct "questions involved in this proceeding" before the Board to Petitioner, not settlement discussions. In fact, as to settlement, the Order made clear that "the Board does not become directly involved with settlement discussion between the parties…" Respondent does not believe that the Board intended for its Order to be misinterpreted as a prohibition of party-to-party settlement communications with First Amendment and other implications, and thus requests that the footnote be vacated so that no misunderstanding remains in the record.

The contents of Ms. Plubell's communications are privileged settlement communications under Federal Rule of Evidence 408, were identified as such, and will not be discussed further. They should not, and cannot, be used to support terminating sanctions against Respondent.

III. CONCLUSION

In conclusion, Petitioner's Motion for Sanctions is wholly without merit. Such Motions are not constructive uses of the Board's time. The Board should send a strong message to Petitioner that such tactics will not be permitted in this forum. Respondent therefore respectfully requests that this Motion be denied and that an order issue vacating the identified footnote.

Respectfully submitted,
THE PLUBELL FIRM, LLC

/Mina I. Hamilton/

Dated: May 8, 2012

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DECLARATION OF MINA HAMILTON

I, Mina Hamilton, declare as follows:

1. I am an attorney duly admitted to the bars of the State of California. I am a partner with Lewis Brisbois Bisgaard & Smith, LLP, attorneys of record for The Plubell Firm, LLC herein. The facts set forth herein are of my own personal knowledge, and if sworn I could and would competently testify thereto.

2. Attached hereto as **Exhibit 1** is a true and correct copy of the cover page and table contents from the 132 page document "Activities Permissible for a National Bank, Cumulative," a publication of the Office of the Comptroller of the Currency, Treasury Department, as produced by Petitioner, East West Bank, during discovery and having Bates stamp numbers EWB001627- EWB 001628.

3. Attached hereto as **Exhibit 2** is a true and correct copy of a relevant page (i.e., 206: lines 1-17) of the deposition transcript of East West Bank and Emily Wang that was omitted from Petitioner's Exhibits.

I declare under penalty of perjury under the laws of the United States of America that the foregoing is true and correct and that this declaration was executed on May 8, 2012, at Sacramento, California.

/Mina I. Hamilton/

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Mina Hamilton

EXHIBIT “1”

Activities Permissible for a National Bank, Cumulative

2010 Annual Edition

May 2011

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EXHIBIT “2”

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1 MS. HAMILTON: Well, I'm talking about the
2 general nature of the business and the regulations
3 that are applied to the business. This is a
4 proceeding about the business and the nature of the
5 business and compliance requirements and she's
6 referenced other compliance organizations, and now
7 she's referencing one about the government and I
8 don't have knowledge about it, so I'm trying to
9 gather information about it.
10 MR. CRAIG: I've given you a long leash, and if
11 that's your answer, then I'm going to cut it off.
12 I instruct you not to answer. It has
13 nothing to do with any trademark proceeding.
14 THE WITNESS: Okay.
15 Q BY MS. HAMILTON: Are you going to listen to
16 your counsel and --
17 A Yes, I will take his advice.
18 Q If East West Bank was going to start doing
19 business consulting as a separate service, what
20 requirements -- what would they have to do to comply
21 with all the regulations, if anything, to have a
22 separate business of consulting?
23 MR. CRAIG: I'll object that it assumes facts
24 not in evidence, that they don't currently do
25 business consulting.

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1 I'll also object that it calls for some
2 legal conclusions that this witness may not be
3 equipped to answer.
4 Go ahead and answer, if you can.
5 And it is vague and ambiguous as to
6 "business consulting."
7 THE WITNESS: My answer to your question is that
8 we actually been providing business consulting to our
9 customer throughout the year, and when you ask me to
10 say that when we decided to, I think the implication
11 here is that we did not or at this time we're not
12 offering business consultation, consulting to our
13 clients and -- which is not true.
14 We've been doing that since we were in the
15 business.
16 Q BY MS. HAMILTON: Right, and when I say
17 business consulting, I'm not talking about the
18 consulting that you were previously talking about
19 that's in the course of providing or selling the
20 services and products to your clients. You have to
21 have expertise and consult about those products.
22 I'm talking about separate type of business
23 management consulting, and I'm asking you if East
24 West Bank provides such type of consulting.
25 MR. CRAIG: Well, I'm going to object that it's

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1 vague and ambiguous. I mean, if you're asking her to
2 testify about a definition you have in your head,
3 that's not fair.
4 You can say the definition in my head
5 excludes everything that we've been talking about all
6 day.
7 Q BY MS. HAMILTON: You have a master's
8 degree. What is your understanding of business
9 consulting?
10 MR. CRAIG: I'm going to object. Her degrees
11 don't make a term any more or less ambiguous than it
12 naturally is.
13 Q BY MS. HAMILTON: Do you have an
14 understanding of the term "business consulting"?
15 A Yes. That's what we have been doing since
16 day one. We're not going to just provide consulting
17 to what you need to eat to stay thin and healthy, but
18 we definitely have a good sense about how we can help
19 you to be successful in your business in terms of
20 financial services.
21 Q In terms of financial services; is that
22 accurate?
23 A How to use financial services in different
24 business arena.
25 Q Let's mark an exhibit.

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1 (Respondent's Exhibit No. 8
2 was marked for identification.)
3 Q BY MS. HAMILTON: Do you recognize this
4 document?
5 A Yes.
6 Q And what is it?
7 A It's a service mark registration.
8 Q And what's the mark?
9 A East West Business Bridge.
10 Q And can you read the services that are
11 listed in the registration?
12 A "For providing business information and
13 business consultation to others" -- is that the
14 paragraph?
15 Q Yes.
16 A "...develop requirements for doing business
17 between China and other countries and facilitating
18 the conducting of business transactions between China
19 and other countries in class 35" --
20 Q That's all right.
21 Is it East West Bank's contention that East
22 West Bank provides those services?
23 A Yes.
24 MR. CRAIG: Objection. Vague and ambiguous.
25 Q BY MS. HAMILTON: When did East West Bank

CERTIFICATE OF SERVICE

This is to certify that I am on this 8th of May, 2012 serving a copy of the within and foregoing upon the Petitioner's attorneys via electronic mail return receipt requested, addressed as follows: tchan@foxrothschild.com; lkarczewski@foxrothschild.com; cliu@foxrothschild.com; acraig@foxrothschild.com; and IPDocket@foxrothschild.com.

/Mina I. Hamilton/

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Mina Hamilton