

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

DUNN

Mailed: May 7, 2012

Opposition No. 91203410

The Plubell Firm LLC

v.

East West Bank

Cancellation No. 92053712

East West Bank

v.

The Plubell Firm LLC

Elizabeth A. Dunn, Attorney (571-272-4267):

This case comes up on the motions of The Plubell Firm LLC to amend the pleadings and to extend discovery. The motions are contested, and the Board held a phone conference on April 25, 2012. The participants were David Starr, attorney for The Plubell Firm LLC (hereafter, TPF), Aaron Craig, attorney for East West Bank (hereafter, EWB), and Elizabeth Dunn, attorney for the Board.¹

EWB owns Registration Nos. 2025824 issued December 24, 1996 for EAST WEST BANK, 3430148 issued May 20, 2008 for EAST WEST BANK and design, 3623050 issued May 19, 2009 for

¹ Respondent's principal Ann Marie Plubell and respondent's co-counsel Mina Hamilton also attended the conference.

Opposition No. 91203410 and Cancellation No. 92053712

BUSINESS BRIDGE, and application Serial No. 85319594 filed May 12, 2011 for EAST WEST BRIDGE FORUM.² TPF owns Registration No. 3448481 issued June 17, 2008 for EAST-WEST BUSINESS BRIDGE.³

On March 4, 2011, EWB filed a petition to cancel TPF's Registration No. 3448481 pleading priority and likelihood of confusion with its pleaded registrations. An answer was filed, discovery was scheduled to close April 13, 2012, and as noted, TPF now seeks to extend discovery.

On January 18, 2012, TPC filed a notice of opposition to EWB's pending application Serial No. 85319594, pleading priority and likelihood of confusion with its pleaded registration. An answer was filed and discovery is open.

² EWB's Registration No. 2025824 lists "banking services; issuance of travelers checks and letters of credit."

EWB's Registration No. 3430148 lists "automated teller machine services; banking; cash management; checking account services; debit card services; electronic funds transfer; electronic payment, namely, electronic processing and transmission of bill payment data; currency exchange and advice; financial services in the field of money lending; home equity loans; financial management; on-line banking services; installment loans; insurance brokerage; insurance consultation; issuing credit cards; issue of traveller's cheques; issuance of bank checks; issuing of checks and letters of credit; money order services; mortgage banking; providing temporary loans; safe deposit box services; savings account services; security brokerage; tax payment processing services; trust services, namely, investment and trust company services."

EWB's Registration No. 3623050 lists "banking; cash management."

EWB's application Serial No. 8531959 lists "providing an on-line forum for international relations."

³ TPF's Registration No. 3448481 lists "providing business information and business consultation to others about requirements for doing business between China and other countries and facilitating the conducting of business transactions between China and other countries."

PROCEEDINGS CONSOLIDATED

Inasmuch Opposition No. 91203410 and Cancellation No. 92053712 involve the same parties and the same claim of likelihood of confusion between the same or similar marks, there is a significant benefit to the Board in avoiding the potential for duplicative evidence and/or inconsistent action inherent in separate proceedings. In the interest of judicial economy, the Board sua sponte consolidates Opposition No. 91203410 and Cancellation No. 92053712, which may be presented on the same record and briefs.⁴ See Fed. R. Civ. P. 42(a) and TBMP §511 (3rd ed. 2011).

AMENDED ANSWER AND COUNTERCLAIM ACCEPTED IN PART

On March 16, 2011 TPC move to amend its answer in the cancellation to add the affirmative defenses of lack of standing, lack of priority, and unclean hands, and counterclaims to cancel EWB's pleaded Registration Nos. 2025824, 3430148, and 3623050 on the grounds of non-ownership and fraud. In support of its motion TPF alleges that it learned of the basis for the affirmative defenses and counterclaim during the recent deposition of petitioner.⁵ EWB opposes amendment on the grounds that the

⁴ The Board file will be maintained in Opposition No. 91203410 as the "parent" case, but all papers filed herein must include the proceeding numbers of both consolidated cases in ascending order.

⁵ The Board gives no consideration to TPF's submission of another lawyer's criticism of the witness, made in a reply brief on a motion

proposed defenses and claims are legally insufficient and untimely.⁶

With respect to the affirmative defenses that EWB lacks standing, lacks priority, and has unclean hands, these are not affirmative defenses as much as they are reiterations of the counterclaims. That is, TPF contends that EWB lacks standing because one registration will fall, and lacks priority because EWB will not be able to prove its dates of use in another registration. Where, as here, EWB pleads common law use and pleads multiple registrations, neither standing nor priority rest on a single registration, and thus even if TPF succeeds in proving its allegations regarding those separate registrations, EWB's standing and priority will not be affected.

Similarly, TPF contends that EWB's "pattern of misrepresentation and deception" in obtaining its registrations constitutes unclean hands. Plainly, this is affirmative defense will fail if the counterclaims fail. Moreover, where the conduct alleged to have resulted in unclean hands relates to a plaintiff's acquisition, or attempt to acquire, a registration, the unclean hands defense goes only to the plaintiff's ability to rely on its

brought in an unrelated proceeding, except to note that the other lawyer failed to convince the Board, and the motion was denied.

⁶ The Board notes TPF's detailed argument that EWB served its response the day after the response was filed (instead of the same day) but disagrees that a motion to the Board was necessary for the response to be considered.

registration, not to its common law rights. *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733, 1739 (TTAB 2001).

With respect to the counterclaims, TPF seeks to cancel Registration No. 2025824 because EWB failed to meet the requirements of Sec. 8 and Sec. 9, and because EWB made fraudulent misrepresentations with the intent to deceive USPTO in connection with its Sec. 8 and 9 filings. TPF seeks to cancel Registration No. 3430148 on the ground of fraud because EWB was not using the mark with "insurance brokerage", "insurance consultation", and "security brokerage" services listed in the registration at the time its application was filed, and made fraudulent misrepresentations with the intent to deceive USPTO in connection with its trademark application.⁷ These claims are legally sufficient, and thus not futile. EWB's argument and evidence that TPF will be unable to prevail on its claims would be appropriate when seeking summary judgment, and is premature in connection with this motion.⁸

⁷ Nonuse is not a separately pleaded claim. While at the conference the Board suggested that TPF could amend its pleading to allege nonuse, the Board now notes that this is not necessary. If TPF fails to prove fraud, but proves nonuse with respect to the noted services, the Board may restrict the description of services in the registration under Trademark Act Sec. 18. See *M.C.I. Foods Inc. v. Bunte*, 96 USPQ2d 1544, 1550 (TTAB 2010).

⁸ Of course, the scope of discovery on the counterclaim is affected by the information EWB set forth in connection with this motion. That is, while TPF's claim may be sufficient for the purposes of amendment, any discovery sought must reflect the information already provided by EWB.

TPF seeks to cancel Registration No. 3623050 on the ground of fraud because EWB was not using the mark on the dates specified in its application and made fraudulent misrepresentations with the intent to deceive USPTO in connection with its trademark application. This claim is legally insufficient. See *Western Worldwide Enterprises Group Inc. v. Qingdao Brewery*, 17 USPQ2d 1137, 1141 (TTAB 1990) ("the fact that a party has set forth an erroneous date of first use does not constitute fraud unless, inter alia, there was no valid use of the mark until after the filing date of the application.").

EWB's argument that the motion is untimely because the facts underlying the new claims were already known to TPF is not persuasive. While, as noted above, sufficient for notice pleading, the supporting allegations for the two counterclaims are scant, and some derive from the deposition testimony. On balance, the Board cannot say that an obvious claim was overlooked.

Accordingly, TPF's motion to amend is denied with respect to the affirmative defenses and the counterclaim to cancel Registration No. 3623050, and is granted with respect to the counterclaim to cancel Registration Nos. 2025824 and 3430148.

TPF is allowed until TEN DAYS from the mailing date of this order to file an amended answer and counterclaim which reflects this order.

EWB is allowed until TWENTY DAYS from the date of service of the amended answer and counterclaim to file its answer.

DISCOVERY IS EXTENDED

During the conference the Board found that TPF had not provided good cause for the requested extension of discovery in Cancellation No. 92053712. On further consideration, discovery must be extended in view of the Board's decision to consolidate the cancellation with later-filed Opposition No. 91203410, in which discovery recently opened. TPF's motion to extend discovery is moot.

The Board's earlier observation that the parties are using depositions to gain strategic advantage is born out by TPF's motion, which cites "bullying tactics" and seeks sanctions as well as an extension of discovery because EWB identified only a single witness in its initial disclosures, successfully sought to have that witness deposed before producing other witnesses, and had an emergency arise which forced the deposition to take place in two separate sessions, and EWB's response, which seeks to bar any subsequent depositions. It seems clear to the Board upon reading the testimony that respondent's witness was reasonably knowledgeable and responsive in the face of often convoluted questioning. The Board will not entertain any objection if the same witness is produced as a 30(b) (6)

witness for a deposition in connection with the opposition, but will look with great disfavor if the second Fed. R. Civ. P. 30(b) (6) deposition is not considerably streamlined in view of the testimony already taken.

For any other depositions, the Board requires the parties to confer in a timely manner on the witness, the time and place, and the subject matter. If multiple notices of deposition are served, and the responding party says that a lesser number of witnesses can supply the requested information, the Board expects notices of deposition to be withdrawn. If the requested testimony is not provided, another deposition may be scheduled. The issues of corporate ownership which underlie the new fraud claims plainly have a documentary basis, and this should be explored BEFORE depositions are scheduled, unless the parties agree that this would not reduce the length of the deposition.

As detailed, the conduct of this proceeding by both parties remains unsatisfactory and inappropriate for attorneys who should be focused on advancing determination of a case on its merits not disposition through attempts to frustrate and annoy each other.

Further, inasmuch the proceeding file has expanded to thirty docket entries, the parties are barred from filing any unconsented motion without the express permission of the

Board, which must be obtained by calling Board attorney Elizabeth Dunn at 571-272-4267.

The party seeking to file an unconsented motion must (i) discuss with the other party and agree on three alternative dates and times when a conference with the Board attorney could be held; (ii) arrange the conference with the Board and the other party; and (iii) during the conference, explain the circumstances warranting the filing. If appropriate, the Board will authorize filing or addressing by phone the unconsented motion.

This order does not affect the parties' ability to file consent motions or stipulations.

Pursuant to Board practice, the consolidated proceeding will adopt the schedule in the later-filed case. Dates are reset as follows:

Expert Disclosures Due	August 25, 2012
Discovery Closes	September 24, 2012
Plaintiff's Pretrial Disclosures	November 8, 2012
30-day testimony period for plaintiff's testimony to close	December 23, 2012
Defendant/Counterclaim Plaintiff's Pretrial Disclosures	January 7, 2013
30-day testimony period for defendant and plaintiff in the counterclaim to close	February 21, 2013
Counterclaim Defendant's and Plaintiff's Rebuttal Disclosures Due	March 8, 2013
30-day testimony period for defendant in the counterclaim and rebuttal testimony for plaintiff to close	April 22, 2013
Counterclaim Plaintiff's Rebuttal Disclosures Due	May 7, 2013

15-day rebuttal period for plaintiff in the counterclaim to close	June 6, 2013
Brief for plaintiff due	August 5, 2013
Brief for defendant and plaintiff in the counterclaim due	September 4, 2013
Brief for defendant in the counterclaim and reply brief, if any, for plaintiff due	October 4, 2013
Reply brief, if any, for plaintiff in the counterclaim due	October 19, 2013

In each instance, a copy of the transcript of testimony together with copies of documentary exhibits must be served on the adverse party within thirty days after completion of the taking of testimony. Trademark Rule 2.125.

Briefs shall be filed in accordance with Trademark Rules 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.