

ESTTA Tracking number: **ESTTA712098**

Filing date: **12/02/2015**

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 parties oppose registration of the indicated application.

Opposers Information

Name	BNC Bancorp
Granted to Date of previous extension	12/02/2015
Address	3980 Premier Drive, Suite 210 High Point, NC 27265 UNITED STATES

Name	Bank of North Carolina
Granted to Date of previous extension	12/02/2015
Address	1226 Eastchester Drive High Point, NC 27265 UNITED STATES

Attorney information	Marcy L. Sperry Womble Carlyle Sandridge & Rice LLP 271 17th Street, NESuite 2400 Atlanta, GA 30363 UNITED STATES msperry@wcsr.com, atltrademarks@wcsr.com
----------------------	---

Applicant Information

Application No	86474504	Publication date	08/04/2015
Opposition Filing Date	12/02/2015	Opposition Period Ends	12/02/2015
Applicant	BNCCORP, INC. 333 South 7th Street, Suite 150 Minneapolis, MN 55402 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1997/00/00 First Use In Commerce: 1997/00/00 All goods and services in the class are opposed, namely: Tax preparation in the field of corporations, partnerships, individuals, fiduciaries, and retirement planning
Class 036. First Use: 1995/00/00 First Use In Commerce: 1995/00/00 All goods and services in the class are opposed, namely: Banking services; financial services, namely, checking and savings account services, financing loans for individual consumers and small businesses, and wealth management services; mortgage loan financing services; financial planning services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance

specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates

Applicant Information

Application No	86495492	Publication date	08/11/2015
Opposition Filing Date	12/02/2015	Opposition Period Ends	
Applicant	BNCCORP, INC. 333 South 7th Street, Suite 150 Minneapolis, MN 55402 UNITED STATES		

Goods/Services Affected by Opposition

Class 035. First Use: 1997/00/00 First Use In Commerce: 1997/00/00
 All goods and services in the class are opposed, namely: Tax preparation in the field of corporations, partnerships, individuals, fiduciaries, and retirement planning

Class 036. First Use: 1995/00/00 First Use In Commerce: 1995/00/00
 All goods and services in the class are opposed, namely: Banking services; financial services, namely, checking and savings account services, financing loans for individual consumers and small businesses, and wealth management services; mortgage loan financing services; financial planning services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Other	See Complaint, BNC Bancorp and Bank of North Carolina v. BNCCORP, INC. and BNC National Bank, No. 1:15-cv-00793 pending in the United States District Court for the Middle District of North Carolina

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	3971788	Application Date	04/28/2010
Registration Date	05/31/2011	Foreign Priority Date	NONE
Word Mark	BNC BANK		

Design Mark	
Description of Mark	The mark consists of the outline of a cardinal bird with the letters "BNC" appearing to the upper left and the word "BANK" appearing to the bottom right.
Goods/Services	Class 036. First use: First Use: 2010/04/09 First Use In Commerce: 2010/04/09 Banking services

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BNC		
Goods/Services	Banking services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BNC BANK		
Goods/Services	Banking services		

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	BNC BANK & DESIGN		
Goods/Services	Banking services		

Related Proceedings	BNCCORP, INC. and BNC National Bank v. BNC Bancorp and Bank of North Carolina, Civil Action No. 0:15-cv-03624 pending in the United States District Court for the District of Minnesota; BNC Bancorp and Bank of North Carolina v. BNCCORP, INC. and BNC National Bank, Civil Action No. 1:15-cv-00793 pending in the United States District Court for the Middle District of North Carolina
---------------------	--

Attachments	85025023#TMSN.png(bytes) Notice of Opposition.pdf(280024 bytes) Exhibits.pdf(1904427 bytes)
-------------	---

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	/Marcy L. Sperry/
Name	Marcy L. Sperry
Date	12/02/2015

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

In the matter of Application Serial Number 86474504
Published: Aug 4, 2015
In the matter of Application Serial Number 86495492
Published: Aug 11, 2015

BNC BANCORP and)	
BANK OF NORTH CAROLINA)	
)	
Opposers,)	
)	
v.)	Opposition No. _____
)	
BNCCORP, INC.)	
)	
Applicant.)	
)	

CONSOLIDATED NOTICE OF OPPOSITION

BNC Bancorp, a corporation organized and existing under the laws of North Carolina, having its principal place of business at 3980 Premier Drive, Suite 210, High Point, North Carolina, 27265 and Bank of North Carolina, a corporation organized and existing under the laws of North Carolina, having its principal place of business at 1226 Eastchester Drive, High Point, North Carolina, 27265 (“Opposers”), believe that they would be damaged by the registration of the marks BNC NATIONAL BANK and BNC as shown in Application Serial Nos. 86495492 and 86474504, filed by BNCCORP., Inc. (“Applicant”). As grounds for the opposition, Opposers allege the following:

1. Opposers are now, and have been, engaged in providing banking services under the service marks and/or trade names BNC, BNC BANK and BNC BANK & DESIGN (“Opposers’ Marks”).

2. Opposers have widely and extensively advertised, offered, and sold banking services in connection with Opposers' Marks. As a consequence, the consuming public and trade have come to recognize and do recognize Opposers' Marks as being used by Opposers, and associate and identify said marks with Opposers, and Opposers derive substantial goodwill and value from the aforesaid identification by the consuming public and trade.

3. Opposer Bank of North Carolina owns a U.S. federal trademark registration for BNC BANK & DESIGN, for the words and design depicted below this paragraph, in connection with banking services under Reg. No. 3971788. This registration, which was not opposed and issued on May 31, 2011, is valid and subsisting. A copy of the USPTO Registration is attached as **Exhibit A**.



4. Applicant, BNCCORP, Inc., a Delaware corporation with its principal place of business in Bismarck, North Dakota, filed Application Serial Nos. 86495492 for the mark BNC and 86474504 for the mark BNC NATIONAL BANK on January 5, 2015 and December 8, 2014, respectively, for "Tax preparation in the field of corporations, partnerships, individuals, fiduciaries, and retirement planning" in International Class 35 and "Banking services; financial services, namely, checking and savings account services, financing loans for individual consumers and small businesses, and wealth management services; mortgage loan financing services; financial planning services; investment management, namely, management of 401k

plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates” in International Class 36 (Collectively, “Applicant’s Claimed Marks”). A copy of the USPTO electronic database records showing the current status of the Applications is attached as **Exhibit B**.

5. On May 15, 2015, Applicant, a Delaware bank holding company, and its subsidiary BNC National Bank, an Arizona headquartered bank with branches in North Dakota, Arizona and Minnesota, filed a lawsuit against Opposers in the United States District Court for the Middle District of North Carolina, alleging trademark infringement and unfair competition by Opposers regarding the same marks at issue in this Opposition (“Applicant’s North Carolina Complaint”). A copy of the Applicant’s North Carolina Complaint is attached as **Exhibit C**. On September 9, Applicant and its subsidiary dismissed Applicant’s North Carolina Complaint without prejudice.

6. On September 9, 2015, Applicant and its subsidiary filed a lawsuit against Opposers in the United States District Court for the District of Minnesota, which lawsuit is substantially identical to Applicant’s North Carolina Complaint and likewise alleges trademark infringement and unfair competition by Opposers (“Applicant’s Minnesota Complaint”). A copy of Applicant’s Minnesota Complaint is attached as **Exhibit D**.

7. In its Complaints, Applicant allege that the Opposers’ Marks are “identical or confusingly similar to the [Applicant’s Claimed Mark].” (Applicant’s North Carolina Complaint ¶ 23; Applicant’s Minnesota Complaint ¶ 25).

8. In its Complaints, Applicant also alleges that Opposers' use of Opposers' Marks is "likely to cause confusion, to cause mistake and to deceive as to the affiliation, connection or association of [Applicant] with [Opposer] and as to the origin, sponsorship or approval of such goods and/or services by [Applicant]." (Applicant's North Carolina Complaint ¶ 31; Applicant's Minnesota Complaint ¶ 33).

9. On September 25, 2015, Opposers filed a lawsuit against Applicant and its subsidiary in the United States District Court for the Middle District of North Carolina seeking, *inter alia*, a declaratory judgment that the Applicant's Claimed Marks are not entitled to registration. A copy of Opposers' Complaint is attached as **Exhibit E**.

10. Applicant is not entitled to registration of Applicant's Claimed Marks. Opposers will be damaged by the registration of Applicant's Claimed Marks. Registration would be in violation and derogation of Opposers' superior rights.

WHEREFORE, Opposers believe they will be damaged by registration of Applicant's Marks and request that registration be refused.

This 2nd day of December, 2015.

Respectfully submitted,

/Marcy L. Sperry/
Sarah Anne Keefe
Marcy L. Sperry
WOMBLE CARLYLE SANDRIDGE & RICE LLP
271 17th Street, NW
Suite 2400
Atlanta, Georgia 30363-1017
Telephone: (404) 879-2432
Facsimile: (404) 879-2932
Email: msperry@wcsr.com

*Attorneys for Opposers BNC BANCORP and BANK OF NORTH
CAROLINA.*

CERTIFICATE OF MAILING

I do hereby certify that on December 2, 2015, I filed via electronic means (ESTTA) this CONSOLIDATED NOTICE OF OPPOSITION with the:

U.S. Patent and Trademark Office
Trademark Trial and Appeal Board
P.O. Box 1451
Alexandria, Virginia 22313-1451

/Marcy L. Sperry/
Marcy L. Sperry

CERTIFICATE OF SERVICE

I do hereby certify that on December 2, 2015, I mailed by United States mail, first class postage prepaid, a true and correct copy of this CONSOLIDATED NOTICE OF OPPOSITION to Applicant's attorney of record:

Daniel A. Rosenberg
Briggs and Morgan, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, Minnesota 55402-2157

/Marcy L. Sperry/
Marcy L. Sperry

EXHIBIT A

United States of America

United States Patent and Trademark Office



Reg. No. 3,971,788

BANK OF NORTH CAROLINA (NORTH CAROLINA CORPORATION)
1226 EASTCHESTER DRIVE
HIGH POINT, NC 27265

Registered May 31, 2011

Int. Cl.: 36

FOR: BANKING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

SERVICE MARK

FIRST USE 4-9-2010; IN COMMERCE 4-9-2010.

PRINCIPAL REGISTER

NO CLAIM IS MADE TO THE EXCLUSIVE RIGHT TO USE "BANK", APART FROM THE MARK AS SHOWN.

THE MARK CONSISTS OF THE OUTLINE OF A CARDINAL BIRD WITH THE LETTERS "BNC" APPEARING TO THE UPPER LEFT AND THE WORD "BANK" APPEARING TO THE BOTTOM RIGHT.

SN 85-025,023, FILED 4-28-2010.

GEORGE LORENZO, EXAMINING ATTORNEY



David J. Kyffers

Director of the United States Patent and Trademark Office

EXHIBIT B

Generated on:

This page was generated by TSDR on 2015-12-01 10:17:24 EST

Mark: BNC NATIONAL BANK

BNC NATIONAL BANK

US Serial Number: 86474504

Application Filing Date:

Dec. 08, 2014

Register:

Principal

Mark Type:

Service Mark

Status:

A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date:

Aug. 12, 2015

Publication Date: Aug. 04, 2015

Mark Information

Mark Literal Elements:

BNC NATIONAL BANK

Standard Character Claim:

Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type:

4 - STANDARD CHARACTER MARK

Disclaimer:

"NATIONAL BANK"

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks "*" identify additional (new) wording in the goods/services.

For:

Tax preparation in the field of corporations, partnerships, individuals, fiduciaries, and retirement planning

International Class(es): 035 - Primary Class

U.S Class(es):

100, 101, 102

Class Status:

ACTIVE

Basis:

1(a)

First Use: 1997

Use in Commerce:

1997

For:

Banking services; financial services, namely, checking and savings account services, financing loans for individual consumers and small businesses, and wealth management services; mortgage loan financing services; financial planning services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates

International Class(es): 036 - Primary Class

U.S Class(es):

100, 101, 102

Class Status:

ACTIVE

Basis:

1(a)

First Use: 1995

Use in Commerce:

1995

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name:

BNCCORP, INC.

Owner Address:

333 South 7th Street, Suite 150
Minneapolis, MINNESOTA 55402
UNITED STATES

Legal Entity Type: CORPORATION

**State or Country Where
Organized:**

DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Daniel A. Rosenberg

**Attorney Primary Email
Address:** ip@briggs.com

**Attorney Email
Authorized:**

Yes

Correspondent

**Correspondent
Name/Address:**

DANIEL A. ROSENBERG
BRIGGS & MORGAN
2200 IDS CENTER 80 S 8TH ST
MINNEAPOLIS, MINNESOTA 55402
UNITED STATES

Phone: 612-977-8795

Fax:

612-977-8650

Correspondent e-mail: ip@briggs.com

**Correspondent e-mail
Authorized:**

Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 12, 2015	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 04, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 04, 2015	PUBLISHED FOR OPPOSITION	
Jul. 15, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 01, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	68123
Jul. 01, 2015	ASSIGNED TO LIE	68123
Jun. 16, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
May 28, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
May 28, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
May 28, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	

Apr. 30, 2015	NOTIFICATION OF FINAL REFUSAL EMAILED	
Apr. 30, 2015	FINAL REFUSAL E-MAILED	
Apr. 30, 2015	FINAL REFUSAL WRITTEN	82421
Apr. 01, 2015	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	88889
Apr. 01, 2015	TEAS VOLUNTARY AMENDMENT RECEIVED	
Mar. 31, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 31, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 31, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 21, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 21, 2015	NON-FINAL ACTION E-MAILED	6325
Mar. 21, 2015	NON-FINAL ACTION WRITTEN	82421
Mar. 21, 2015	ASSIGNED TO EXAMINER	82421
Jan. 05, 2015	TEAS AMENDMENT ENTERED BEFORE ATTORNEY ASSIGNED	88889
Jan. 05, 2015	TEAS VOLUNTARY AMENDMENT RECEIVED	
Dec. 12, 2014	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: LEWIS, SHAILA E

Law Office Assigned:

LAW OFFICE 114

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location:

Jul. 01, 2015

Proceedings

Summary

Number of Proceedings:

1

Type of Proceeding: Extension of Time

Proceeding Number: [86474504](#)

Filing Date:

Aug 12, 2015

Status: Not Instituted

Status Date:

Aug 12, 2015

Interlocutory Attorney:

Defendant

Name:

BNCCORP, INC.

Correspondent Address:

DANIEL A. ROSENBERG
BRIGGS & MORGAN
2200 IDS CENTER 80 S 8TH ST
MINNEAPOLIS MN , 55402

Associated marks

Mark	Application Status	Serial Number	Registration Number
BNC NATIONAL BANK	Request For Extension of Time to File Opposition	86474504	

Potential Opposer(s)

Name:

BNC Bancorp

Correspondent Address:

Marcy L. Sperry
Womble Carlyle Sandridge & Rice LLP
271 17th Street, NESuite 2400
Atlanta GA , 30363
UNITED STATES

Correspondent e-mail:

mosperry@wcsr.com , tmDocketing@wcsr.com

Name:

Bank of North Carolina

Correspondent Address:

Marcy L. Sperry
Womble Carlyle Sandridge & Rice, LLP
P.O. Box 7037
Atlanta GA , 30357-0037
UNITED STATES

Correspondent e-mail:

tmdocketing@wcsr.com , msperry@wcsr.com , lechols@wcsr.com

Prosecution History			
Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Aug 12, 2015	
2	EXTENSION OF TIME GRANTED	Aug 12, 2015	
3	INCOMING - EXT TIME TO OPPOSE FILED	Aug 12, 2015	
4	EXTENSION OF TIME GRANTED	Aug 12, 2015	

Generated on:

This page was generated by TSDR on 2015-12-01 10:18:52 EST

Mark: BNC

BNC

US Serial Number: 86495492

Application Filing Date:

Jan. 05, 2015

Register:

Principal

Mark Type:

Service Mark

Status:

A request for an extension of time to file an opposition has been filed with the Trademark Trial and Appeal Board. For further information, see TTABVue on the Trademark Trial and Appeal Board web page.

Status Date:

Aug. 12, 2015

Publication Date: Aug. 11, 2015

Mark Information

Mark Literal Elements:

BNC

Standard Character Claim:

Yes. The mark consists of standard characters without claim to any particular font style, size, or color.

Mark Drawing Type:

4 - STANDARD CHARACTER MARK

Goods and Services

Note: The following symbols indicate that the registrant/owner has amended the goods/services:

- Brackets [...] indicate deleted goods/services;
- Double parenthesis ((...)) identify any goods/services not claimed in a Section 15 affidavit of incontestability; and
- Asterisks *...* identify additional (new) wording in the goods/services.

For:

Tax preparation in the field of corporations, partnerships, individuals, fiduciaries, and retirement planning

International Class(es): 035 - Primary Class

U.S Class(es):

100, 101, 102

Class Status:

ACTIVE

Basis:

1(a)

First Use: 1997

Use in Commerce:

1997

For:

Banking services; financial services, namely, checking and savings account services, financing loans for individual consumers and small businesses, and wealth management services; mortgage loan financing services; financial planning services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates

International Class(es): 036 - Primary Class

U.S Class(es):

100, 101, 102

Class Status:

ACTIVE

Basis:

1(a)

First Use: 1995

Use in Commerce:

1995

Basis Information (Case Level)

Filed Use: Yes	Currently Use: Yes	Amended Use: No
Filed ITU: No	Currently ITU: No	Amended ITU: No
Filed 44D: No	Currently 44D: No	Amended 44D: No
Filed 44E: No	Currently 44E: No	Amended 44E: No
Filed 66A: No	Currently 66A: No	
Filed No Basis: No	Currently No Basis: No	

Current Owner(s) Information

Owner Name:

BNCCORP, INC.

Owner Address:

333 South 7th Street, Suite 150
Minneapolis, MINNESOTA 55402
UNITED STATES

Legal Entity Type: CORPORATION

State or Country Where
Organized:

DELAWARE

Attorney/Correspondence Information

Attorney of Record

Attorney Name: Daniel A. Rosenberg

Attorney Primary Email ip@briggs.com
Address:

Attorney Email
Authorized:

Yes

Correspondent

Correspondent
Name/Address:

DANIEL A. ROSENBERG
BRIGGS & MORGAN
2200 IDS CENTER, 80 S. 8TH ST.
MINNEAPOLIS, MINNESOTA 55402
UNITED STATES

Phone: 612-977-8795

Fax:

612-977-8650

Correspondent e-mail: ip@briggs.com

Correspondent e-mail
Authorized:

Yes

Domestic Representative - Not Found

Prosecution History

Date	Description	Proceeding Number
Aug. 12, 2015	EXTENSION OF TIME TO OPPOSE RECEIVED	
Aug. 11, 2015	OFFICIAL GAZETTE PUBLICATION CONFIRMATION E-MAILED	
Aug. 11, 2015	PUBLISHED FOR OPPOSITION	
Jul. 22, 2015	NOTIFICATION OF NOTICE OF PUBLICATION E-MAILED	
Jul. 06, 2015	LAW OFFICE PUBLICATION REVIEW COMPLETED	70633
Jul. 06, 2015	ASSIGNED TO LIE	70633
Jun. 18, 2015	APPROVED FOR PUB - PRINCIPAL REGISTER	
Jun. 08, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Jun. 08, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Jun. 08, 2015	TEAS REQUEST FOR RECONSIDERATION RECEIVED	
Apr. 30, 2015	NOTIFICATION OF FINAL REFUSAL EMAILED	
Apr. 30, 2015	FINAL REFUSAL E-MAILED	

Apr. 30, 2015	FINAL REFUSAL WRITTEN	82421
Apr. 01, 2015	APPLICANT AMENDMENT PRIOR TO EXAMINATION - ENTERED	88889
Apr. 01, 2015	TEAS VOLUNTARY AMENDMENT RECEIVED	
Mar. 31, 2015	TEAS/EMAIL CORRESPONDENCE ENTERED	88889
Mar. 31, 2015	CORRESPONDENCE RECEIVED IN LAW OFFICE	88889
Mar. 31, 2015	TEAS RESPONSE TO OFFICE ACTION RECEIVED	
Mar. 21, 2015	NOTIFICATION OF NON-FINAL ACTION E-MAILED	6325
Mar. 21, 2015	NON-FINAL ACTION E-MAILED	6325
Mar. 21, 2015	NON-FINAL ACTION WRITTEN	82421
Mar. 21, 2015	ASSIGNED TO EXAMINER	82421
Jan. 15, 2015	NEW APPLICATION OFFICE SUPPLIED DATA ENTERED IN TRAM	

TM Staff and Location Information

TM Staff Information

TM Attorney: LEWIS, SHAILA E

Law Office Assigned:

LAW OFFICE 114

File Location

Current Location: PUBLICATION AND ISSUE SECTION

Date in Location:

Jul. 06, 2015

Proceedings

Summary

Number of Proceedings:

1

Type of Proceeding: Extension of Time

Proceeding Number: [86495492](#)

Filing Date:

Aug 12, 2015

Status: Not Instituted

Status Date:

Aug 12, 2015

Interlocutory Attorney:

Defendant

Name:

BNCCORP, INC.

Correspondent Address:

DANIEL A. ROSENBERG
BRIGGS & MORGAN
2200 IDS CENTER, 80 S. 8TH ST.
MINNEAPOLIS MN , 55402

Associated marks

Mark	Application Status	Serial Number	Registration Number
BNC	Request For Extension of Time to File Opposition	86495492	

Potential Opposer(s)

Name:

BNC Bancorp

Correspondent Address:

Marcy L. Sperry
Womble Carlyle Sandridge & Rice LLP
271 17th Street, NE Suite 2400
Atlanta GA , 30363
UNITED STATES

Correspondent e-mail:

mosperry@wcsr.com , tmcketing@wcsr.com

Name:

Bank of North Carolina

Correspondent Address:

Marcy L. Sperry
Womble Carlyle Sandridge & Rice, LLP
P.O. Box 7037
Atlanta GA , 30357-0037

UNITED STATES

Correspondent e-mail:

tmddocketing@wcsr.com , msperry@wcsr.com , lechols@wcsr.com

Prosecution History			
Entry Number	History Text	Date	Due Date
1	INCOMING - EXT TIME TO OPPOSE FILED	Aug 12, 2015	
2	EXTENSION OF TIME GRANTED	Aug 12, 2015	
3	INCOMING - EXT TIME TO OPPOSE FILED	Aug 12, 2015	
4	EXTENSION OF TIME GRANTED	Aug 12, 2015	

EXHIBIT C

IN THE UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF NORTH CAROLINA

Civil Case No. 15-392

<hr/>		
BNCCORP, INC. and BNC National)	
Bank,)	
)	
Plaintiffs,)	COMPLAINT FOR TRADEMARK
)	INFRINGEMENT AND UNFAIR
v.)	COMPETITION
)	
BNC Bancorp and Bank of North)	(JURY TRIAL DEMANDED)
Carolina,)	
)	
Defendants.)	
<hr/>		

For their Complaint against Defendants, Plaintiffs state and allege as follows:

THE PARTIES

1. Plaintiff BNCCORP, INC. is a Delaware corporation with its principal place of business located in Bismarck, North Dakota.
2. Plaintiff BNC National Bank is a federally chartered national banking association with its principal place of business located in Glendale, Arizona.
3. On information and belief, Defendant BNC Bancorp is a North Carolina corporation with its principal place of business located in High Point, North Carolina.
4. On information and belief, Defendant Bank of North Carolina is a North Carolina corporation with its principal place of business located in High Point, North Carolina.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction under 28 U.S.C. § 1338(a) in that this case arises under the Trademark Laws of the United States, 15 U.S.C. §§ 1051, *et seq.*, 15 U.S.C. §1119, and 28 U.S.C. § 1331 (federal question). This Court also has jurisdiction pursuant to 28 U.S.C. § 1332 because the parties have complete diversity of citizenship and the amount in controversy exceeds \$75,000, exclusive of interest and costs.

6. This Court has subject matter jurisdiction over all claims herein arising under state law pursuant to 28 U.S.C. § 1367 in that said claims are so related to the claim under the Trademark Laws of the United States, 15 U.S.C. §§ 1051, *et seq.*, that they form part of the same case or controversy.

7. Venue in this District is proper under 28 U.S.C. §§1391(b) and (c).

FACTS

8. Plaintiff BNCCORP, INC. is a registered bank holding company.

9. Plaintiff BNC National Bank, a federally chartered bank, is a wholly owned subsidiary of Plaintiff BNCCORP, INC. Plaintiff BNC National Bank is dedicated to providing banking, mortgage, wealth management, and insurance products and services to businesses and consumers throughout the United States. Without limitation, Plaintiff BNC National Bank offers a full range of financial products and services including checking, savings, consumer loans, business loans, 401k, wealth management, financial advice, mortgage loans, insurance, tax services, and many online and mobile services.

10. Since at least as early as 1995, the “BNC” and “BNC NATIONAL BANK” names and marks have been used continually by Plaintiff BNCCORP, INC., Plaintiff BNC National Bank and their predecessors in interest and related companies (hereinafter referred to as “Plaintiffs”) nationwide in interstate commerce to identify certain of their goods and services and to distinguish such goods and services from those made and sold by others.

11. As a result, Plaintiffs have established, through continuous, long-term use in commerce, common law rights in the “BNC” and “BNC NATIONAL BANK” marks and in the use of “BNC” and “BNC NATIONAL BANK” as a trade name or part of a trade name (hereinafter referred to as the “BNC Marks”.)

12. Plaintiffs have expended considerable time, resources, and effort in promoting the BNC Marks and developing substantial goodwill associated therewith.

13. The BNC Marks are arbitrary and inherently distinctive when used in conjunction with Plaintiffs’ goods and services.

14. Due to the continual use of the BNC Marks by Plaintiffs, such marks acquired secondary meaning many years ago. The BNC Marks have come to indicate Plaintiffs as the single source of the quality goods and services associated with the mark.

15. Plaintiff BNCCORP, INC. is also the owner of U.S. Trademark Application Serial Nos. 86/495,492 2,801,949 and 86/474,504 for the standard character marks “BNC” and “BNC NATIONAL BANK,” respectively. Such applications cover “[b]anking services; financial services, namely, checking, savings, consumer loans, business loans, wealth management; mortgage loan financing services; financial planning

services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates” and “[t]ax preparation (Corporate/Partnership/Individual/Fiduciary/Retirement Plans); tax planning; accounting services; [and] payroll tax debiting services.”

16. Without the knowledge or consent of Plaintiffs, and beginning after Plaintiffs had established extensive and valuable goodwill in connection with the BNC Marks and their goods and services, Defendants commenced to use in interstate commerce and commerce affecting interstate commerce the mark “BNC,” in whole or in part, to promote goods and/or services covered by Plaintiffs’ trademark rights, including, without limitation, banking services.

17. Defendants have continued to encroach on Plaintiffs’ senior rights in the BNC Marks, including recently acquiring the nationally chartered Harbor Bank Group, Inc., of Charleston, South Carolina. Upon information and belief, Defendants are in the process of closing on the acquisition of Valley Financial Corporation, the holding company for Valley Bank headquartered in Roanoke, Virginia. Valley Bank operates nine (9) branches in Roanoke, Virginia and Salem, Virginia.

18. Use of the BNC Marks and name by Defendants is without permission or authority of Plaintiffs and is likely to cause or has caused confusion, mistake, and

deception among consumers and customers as to the source, nature and quality of the goods and services offered by Defendants.

19. Defendant Bank of North Carolina is the current owner of contestable U.S. Federal Trademark Registration No. 3,971,788 for a design mark incorporating “BNC BANK” covering “[b]anking services.” Such registration alleges a date of first use of 2010, approximately fifteen (15) years after Plaintiffs’ prior and senior first use in commerce of the BNC Marks.

20. Such use of the “BNC” and/or “BNC BANK” mark and name by Defendants is without permission or authority of Plaintiffs and is likely to cause or has caused confusion, mistake, and deception among consumers and customers as to the source, nature, and quality of the goods and services offered by Defendants.

21. As a direct and proximate result of Defendants’ unlawful conduct alleged herein, Plaintiffs have sustained actual damages and, upon information and belief, Defendants have generated profits to which they are not entitled.

COUNT I

UNFAIR COMPETITION AND PASSING OFF

22. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

23. Defendants have used a mark which is identical or confusingly similar to the BNC Marks with the intent to deceive the public into believing that goods and/or services offered or sold by Defendants are approved by, sponsored by, or affiliated with Plaintiffs.

24. Defendants' acts as alleged herein were committed with the intent to pass off and palm off Defendants' goods and/or services as the goods and/or services of Plaintiffs, and with the intent to deceive and defraud the public.

25. Defendants' acts constitute unfair competition and passing off, and have caused Plaintiffs damages, including, without limitation, lost profits, harm to reputation, and costs to remediate the confusion and harm to goodwill and reputation caused by Defendants.

26. Defendants' acts constitute violations of 15 U.S.C. § 1125 and of the common law.

27. Plaintiffs seek judgment pursuant to 15 U.S.C. § 1117 for Defendants' profits made by its unfair competition and passing off of Plaintiffs' goods and services, for the damages sustained by Plaintiffs, for all costs necessary to remediate the unfair competition and passing off and their effects, and for the costs, expenses and reasonable attorneys' fees incurred in bringing the present action.

28. Plaintiffs further seek judgment for three times the amount of Defendants' profits or Plaintiffs' damages, whichever is greater, due to the nature of Defendants' conduct.

COUNT II

FALSE DESIGNATION OF ORIGIN

29. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

30. Defendants have offered and sold goods and/or services through interstate commerce with the BNC Marks connected therewith.

31. Defendants' use of said designation and representation constitutes a false designation of origin which is likely to cause confusion, to cause mistake and to deceive as to the affiliation, connection or association of Defendants with Plaintiffs and as to the origin, sponsorship or approval of such goods and/or services by Plaintiffs.

32. Defendants' acts are in violation of 15 U.S.C. § 1125 in that Defendants have used in connection with goods and/or services a false designation of origin, or a false or misleading description and representation of fact, which is likely to cause confusion, and to cause mistake and to deceive as to the affiliation, connection or association of Defendants with Plaintiffs and as to the origin, sponsorship, and approval of Defendants' goods, services, and commercial activities by Plaintiffs.

COUNT III

TRADEMARK AND/OR TRADE NAME INFRINGEMENT

33. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

34. Defendants' acts constitute trademark and/or trade name infringement in violation of Plaintiffs' rights at common law.

COUNT IV

NORTH CAROLINA UNFAIR AND DECEPTIVE TRADE PRACTICES ACT

35. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

36. Defendants have committed and continue to commit unfair or deceptive acts or practices, including using in connection with goods and/or services a false designation of origin, or a false or misleading description and representation of fact, which is likely to cause confusion or mistake, and to deceive as to the origin, sponsorship and approval of Defendants' goods and/or services.

37. Such actions by Defendants are in commerce and affect commerce.

38. Defendants have willfully engaged in such practices and refused, without merit, to halt such practice despite Plaintiffs' good faith requests and communications.

39. Defendants' unfair or deceptive acts or practices have damaged Plaintiffs and constitute a violation of N.C. Gen. Stat § 75-1.1, as a result of which Plaintiffs seek an award of compensatory damages in excess of \$75,000, treble damages, plus costs, attorneys' fees and injunctive relief pursuant to, without limitation, N.C. Gen. Stat. § 75-16.

COUNT V

UNJUST ENRICHMENT

40. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

41. Defendants have made a profit and continue to derive pecuniary gain through their unauthorized use of the BNC Marks.

42. Defendants have been, and continue to be, unjustly enriched as a result of their unauthorized use of the BNC Marks.

43. Plaintiffs have sustained injury, loss and damages in excess of \$75,000 as a result of Defendants' actions.

COUNT VI

CANCELLATION OF FEDERAL TRADEMARK REGISTRATION (15 U.S.C. §1119)

44. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

45. This is a claim for cancellation of a trademark registration under 15 U.S.C. §1119.

46. Defendants began using the "BNC" and/or "BNC BANK" name and mark in commerce in 2010. Plaintiffs began using the BNC Marks at least as early as 1995, approximately fifteen (15) years and prior to Defendants' first use. Therefore, Plaintiffs have priority of use of in the BNC Marks.

47. The wrongful and unauthorized use by Defendants of words and symbols confusingly similar to the BNC Marks, including "BNC" and "BNC BANK," is likely to cause confusion or mistake or deception as to the source of Defendants' services and/or sponsorship or authorization of Defendants' services.

48. Defendants' use of the "BNC", "BNC BANK" and/or "BNC BANK" design mark, when used in connection with banking services so resembles the BNC Marks as to cause confusion, or to cause mistake, or deceive pursuant to 15 U.S.C. § 1052(d).

49. Plaintiffs have or are likely to be damaged by the continued registration of Defendant Bank of North Carolina's U.S. Trademark Registration No. 3,971,788 for a design mark incorporating "BNC BANK" for "[b]anking services" in view of Plaintiffs' prior use of the BNC Marks for identical services.

50. For the reasons set forth above, the U.S. Patent and Trademark Office should not have permitted a registration to issue to Defendant Bank of North Carolina for use of the "BNC BANK" design mark in connection with banking services and therefore said registration should be cancelled.

WHEREFORE, Plaintiffs pray for the following relief:

(a) That this Court issue an injunction pursuant to, without limitation, 15 U.S.C. § 1116, enjoining and restraining Defendants, and their affiliates, agents, servants, and employees from directly or indirectly using the "BNC" or "BNC BANK" mark or any mark or name similar to the BNC Marks which is likely to cause confusion, mistake, or to deceive.

(b) That this Court, pursuant to, without limitation, 15 U.S.C. § 1118, order that all products, labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of Defendants bearing "BNC" or "BNC BANK" shall be delivered and destroyed.

(c) That Defendants be required to account to Plaintiffs for any and all profits derived by Defendants from the sale of any and all goods and/or services associated with the "BNC" and/or "BNC BANK" mark and name, and for all damages sustained by Plaintiffs by reason of said acts complained of herein.

(d) That this Court award Plaintiffs treble the amount of actual damages suffered by Plaintiffs.

(e) That this Court award Plaintiffs their attorneys' fees, costs and expenses incurred in this action.

(f) That this Court issue an order cancelling Defendant Bank of North Carolina's U.S. Trademark Registration No. 3,971,788 pursuant to 15 U.S.C. § 1119.

(g) That the Court grant Plaintiffs such other and further relief as this Court may deem just and proper.

Jury Demand

Plaintiffs demand a trial by jury on all issues so triable.

Dated: May 15, 2015

BRIGGS AND MORGAN, P.A.

By: /s/ Michael M. Lafeber
Michael M. Lafeber (MN #242871)
2200 IDS Center
80 S. 8th Street
Minneapolis, Minnesota 55402
Phone: (612) 977-8400
Facsimile: (612) 977-8650

Attorneys for Plaintiffs

**SMITH, ANDERSON, BLOUNT,
DORSETT, MITCHELL &
JERNIGAN, LLP**

By: /s/ Kelli A. Ovies
Robert J. Morris
N.C. State Bar No. 15981
Kelli A. Ovies
N.C. State Bar No. 35485
jmorris@smithlaw.com
kovies@smithlaw.com
2300 Wells Fargo Capitol Center
150 Fayetteville Street
Raleigh, NC 27601
Telephone: (919) 821-1220
Facsimile: (919) 821-6800

Local Rule 83.1 Attorneys for Plaintiffs

EXHIBIT D

UNITED STATES DISTRICT COURT
DISTRICT OF MINNESOTA

BNCCORP, INC. and BNC National Bank,

Court File No.

Plaintiffs,

**COMPLAINT FOR TRADEMARK
INFRINGEMENT AND UNFAIR
COMPETITION**

v.

BNC Bancorp and Bank of North Carolina,

Defendants.

JURY TRIAL DEMANDED

For their Complaint against Defendants, Plaintiffs state and allege as follows:

THE PARTIES

1. Plaintiff BNCCORP, INC. is a Delaware corporation with its principal place of business located in Bismarck, North Dakota.
2. Plaintiff BNC National Bank is a federally chartered national banking association with its principal place of business located in Glendale, Arizona.
3. On information and belief, Defendant BNC Bancorp is a North Carolina corporation with its principal place of business located in High Point, North Carolina.
4. On information and belief, Defendant Bank of North Carolina is a North Carolina corporation with its principal place of business located in High Point, North Carolina.

JURISDICTION AND VENUE

5. This Court has subject matter jurisdiction under 28 U.S.C. § 1338(a) in that this case arises under the Trademark Laws of the United States, 15 U.S.C. §§ 1051, *et seq.*, 15 U.S.C. § 1119, and 28 U.S.C. § 1331 (federal question). This Court also has

jurisdiction pursuant to 28 U.S.C. § 1332 because the parties have complete diversity of citizenship and the amount in controversy exceeds \$75,000, exclusive of interest and costs.

6. This Court has subject matter jurisdiction over all claims herein arising under state law pursuant to 28 U.S.C. § 1367 in that said claims are so related to the claim under the Trademark Laws of the United States, 15 U.S.C. §§ 1051, *et seq.*, that they form part of the same case or controversy.

7. This Court has personal jurisdiction over Defendants because Defendants conduct business in this District and Defendants have committed acts of infringement and unfair competition in this District. Venue in this District is proper under 28 U.S.C. §§ 1391(b) and (c).

FACTS

8. Plaintiff BNCCORP, INC. is a registered bank holding company.

9. Plaintiff BNC National Bank, a federally chartered bank, is a wholly owned subsidiary of Plaintiff BNCCORP, INC. Plaintiff BNC National Bank is dedicated to providing banking, mortgage, wealth management, and insurance products and services to businesses and consumers throughout the United States. Without limitation, Plaintiff BNC National Bank offers a full range of financial products and services including checking, savings, consumer loans, business loans, 401k, wealth management, financial advice, mortgage loans, insurance, tax services, and many online and mobile services. BNC National Bank has offices in Minnesota and conducts a significant and substantial portion of its business within Minnesota.

10. Since at least as early as 1995, the “BNC” and “BNC NATIONAL BANK” names and marks have been used continually by Plaintiff BNCCORP, INC., Plaintiff BNC National Bank and their predecessors in interest and related companies (hereinafter referred to as “Plaintiffs”) nationwide in interstate commerce to identify certain of their goods and services and to distinguish such goods and services from those made and sold by others.

11. As a result, Plaintiffs have established, through continuous, long-term use in commerce, common law rights in the “BNC” and “BNC NATIONAL BANK” marks and in the use of “BNC” and “BNC NATIONAL BANK” as a trade name or part of a trade name (hereinafter referred to as the “BNC Marks”.)

12. Plaintiffs have expended considerable time, resources, and effort in promoting the BNC Marks and developing substantial goodwill associated therewith.

13. The BNC Marks are arbitrary and inherently distinctive when used in conjunction with Plaintiffs’ goods and services.

14. Due to the continual use of the BNC Marks by Plaintiffs, such marks acquired secondary meaning many years ago. The BNC Marks have come to indicate Plaintiffs as the single source of the quality goods and services associated with the mark.

15. Plaintiff BNCCORP, INC. is also the owner of U.S. Trademark Application Serial Nos. 86/495,492 2,801,949 and 86/474,504 for the standard character marks “BNC” and “BNC NATIONAL BANK,” respectively. Such applications cover “[b]anking services; financial services, namely, checking, savings, consumer loans, business loans, wealth management; mortgage loan financing services; financial planning

services; investment management, namely, management of 401k plans, Individual Retirement Accounts (IRAs), Roth and SEP accounts; administration of employee benefit plans concerning finance specifically relating to defined benefit and profit sharing plans; managing estate trusts, particularly, personal trust, revocable trusts, charitable foundation trusts self-directed custodial accounts for IRAs, employee benefit plans, agency accounts, personal trusts and estates” and “[t]ax preparation (Corporate/Partnership/Individual/Fiduciary/Retirement Plans); tax planning; accounting services; [and] payroll tax debiting services.”

16. Without the knowledge or consent of Plaintiffs, and beginning after Plaintiffs had established extensive and valuable goodwill in connection with the BNC Marks and their goods and services, Defendants commenced to use in interstate commerce and commerce affecting interstate commerce the mark “BNC,” in whole or in part, to promote goods and/or services covered by Plaintiffs’ trademark rights, including, without limitation, banking services.

17. Defendants have continued to encroach on Plaintiffs’ senior rights in the BNC Marks, including recently acquiring the nationally chartered Harbor Bank Group, Inc., of Charleston, South Carolina. Defendants also recently acquired Valley Financial Corporation, the holding company for Valley Bank which operated nine (9) branches in Roanoke, Virginia and Salem, Virginia.

18. Without limitation, Defendants’ continuing and intentional encroachment on Plaintiffs’ senior rights in the BNC Marks is evidenced by Defendant Bank of North Carolina’s recent acquisition of the new generic top level domain (“gTLD”)

“bncbank.bank”. The newly created “.bank” gTLD is available exclusively for financial institutions. The purpose of the new “.bank” gTLD is to provide enhanced security and help prevent users from being redirected to fake bank websites and mitigate fraudulent activities such as phishing. Defendant Bank of North Carolina acquired “bncbank.bank” with full knowledge that Plaintiffs’ website has operated at www.bncbank.com continuously since the 1990s.

19. Use of the BNC Marks and name by Defendants is without permission or authority of Plaintiffs and is likely to cause and has caused significant and substantial actual confusion, mistake, and deception among consumers and customers as to the source, nature and quality of the goods and services offered by Defendants.

20. As one example of the actual consumer confusion already occurring as a direct result of Defendants’ expanding use of the BNC Marks, Defendants recently sent out a “Welcome Guide” to its newly acquired Valley Bank customers. On information and belief, such “Welcome Guide” included instructions for enrolling in Defendants’ online banking program. Numerous Valley Bank customers were confused and tried to enroll in Plaintiffs’ online banking program. When Valley Bank customers were unable to do so, they called Plaintiffs’ 1-800-BNC-BANK number to complain and/or seek assistance.

21. Defendant Bank of North Carolina is the current owner of contestable U.S. Federal Trademark Registration No. 3,971,788 for a design mark incorporating “BNC BANK” covering “[B]anking services.” Such registration alleges a date of first use of

2010, approximately fifteen (15) years after Plaintiffs' prior and senior first use in commerce of the BNC Marks.

22. Such use of the "BNC" and/or "BNC BANK" mark and name by Defendants is without permission or authority of Plaintiffs and is likely to cause and has caused significant and substantial actual confusion, mistake, and deception among consumers and customers as to the source, nature, and quality of the goods and services offered by Defendants.

23. As a direct and proximate result of Defendants' unlawful conduct alleged herein, Plaintiffs have sustained actual damages and, upon information and belief, Defendants have generated profits to which they are not entitled.

COUNT I

UNFAIR COMPETITION AND PASSING OFF

24. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

25. Defendants have used a mark which is identical or confusingly similar to the BNC Marks with the intent to deceive the public into believing that goods and/or services offered or sold by Defendants are approved by, sponsored by, or affiliated with Plaintiffs.

26. Defendants' acts as alleged herein were committed with the intent to pass off and palm off Defendants' goods and/or services as the goods and/or services of Plaintiffs, and with the intent to deceive and defraud the public.

27. Defendants' acts constitute unfair competition and passing off, and have caused Plaintiffs damages, including, without limitation, lost profits, harm to reputation, and costs to remediate the confusion and harm to goodwill and reputation caused by Defendants.

28. Defendants' acts constitute violations of 15 U.S.C. § 1125 and of the common law.

29. Plaintiffs seek judgment pursuant to 15 U.S.C. § 1117 for Defendants' profits made by its unfair competition and passing off of Plaintiffs' goods and services, for the damages sustained by Plaintiffs, for all costs necessary to remediate the unfair competition and passing off and their effects, and for the costs, expenses and reasonable attorneys' fees incurred in bringing the present action.

30. Plaintiffs further seek judgment for three times the amount of Defendants' profits or Plaintiffs' damages, whichever is greater, due to the nature of Defendants' conduct.

COUNT II

FALSE DESIGNATION OF ORIGIN

31. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

32. Defendants have offered and sold goods and/or services through interstate commerce with the BNC Marks connected therewith.

33. Defendants' use of said designation and representation constitutes a false designation of origin which is likely to cause confusion, to cause mistake and to deceive

as to the affiliation, connection or association of Defendants with Plaintiffs and as to the origin, sponsorship or approval of such goods and/or services by Plaintiffs.

34. Defendants' acts are in violation of 15 U.S.C. § 1125 in that Defendants have used in connection with goods and/or services a false designation of origin, or a false or misleading description and representation of fact, which is likely to cause confusion, and to cause mistake and to deceive as to the affiliation, connection or association of Defendants with Plaintiffs and as to the origin, sponsorship, and approval of Defendants' goods, services, and commercial activities by Plaintiffs.

COUNT III

TRADEMARK AND/OR TRADE NAME INFRINGEMENT

35. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

36. Defendants' acts constitute trademark and/or trade name infringement in violation of Plaintiffs' rights at common law.

COUNT IV

MINNESOTA UNIFORM DECEPTIVE TRADE PRACTICES ACT

37. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

38. Defendants have used in connection with goods and/or services a false designation of origin, or a false or misleading description and representation of fact, which is likely to cause confusion or mistake, and to deceive as to the origin, sponsorship and approval of Defendants' goods and/or services.

39. Defendants' false designation of origin, sponsorship and approval constitutes a violation of Minn. Stat. § 325D.44, as a result of which Plaintiffs seek an award of compensatory damages in excess of \$75,000, plus costs, attorneys' fees and injunctive relief pursuant to, without limitation, Minn. Stat. §§ 8.31 and 325D.45.

COUNT V

UNJUST ENRICHMENT

40. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

41. Defendants have made a profit and continue to derive pecuniary gain through their unauthorized use of the BNC Marks.

42. Defendants have been, and continue to be, unjustly enriched as a result of their unauthorized use of the BNC Marks.

43. Plaintiffs have sustained injury, loss and damages in excess of \$75,000 as a result of Defendants' actions.

COUNT VI

CANCELLATION OF FEDERAL TRADEMARK REGISTRATION

44. Plaintiffs incorporate the preceding paragraphs as though fully set forth herein.

45. This is a claim for cancellation of a trademark registration under 15 U.S.C. §1119.

46. Defendants began using the "BNC" and/or "BNC BANK" name and mark in commerce in 2010. Plaintiffs began using the BNC Marks at least as early as 1995,

approximately fifteen (15) years and prior to Defendants' first use. Therefore, Plaintiffs have priority of use in the BNC Marks.

47. The wrongful and unauthorized use by Defendants of words and symbols confusingly similar to the BNC Marks, including "BNC" and "BNC BANK," is likely to cause confusion or mistake or deception as to the source of Defendants' services and/or sponsorship or authorization of Defendants' services.

48. Defendants' use of the "BNC", "BNC BANK" and/or "BNC BANK" design mark, when used in connection with banking services so resembles the BNC Marks as to cause confusion, or to cause mistake, or deceive pursuant to 15 U.S.C. § 1052(d).

49. Plaintiffs have or are likely to be damaged by the continued registration of Defendant Bank of North Carolina's U.S. Trademark Registration No. 3,971,788 for a design mark incorporating "BNC BANK" for "[B]anking services" in view of Plaintiffs' prior use of the BNC Marks for identical services.

50. For the reasons set forth above, the U.S. Patent and Trademark Office should not have permitted a registration to issue to Defendant Bank of North Carolina for use of the "BNC BANK" design mark in connection with banking services and therefore said registration should be cancelled.

WHEREFORE, Plaintiffs pray for the following relief:

(a) That this Court issue an injunction pursuant to, without limitation, 15 U.S.C. § 1116, enjoining and restraining Defendants, and their affiliates, agents, servants, and employees from directly or indirectly using the "BNC" or "BNC BANK" mark or

any mark or name similar to the BNC Marks which is likely to cause confusion, mistake, or to deceive.

(b) That this Court, pursuant to, without limitation, 15 U.S.C. § 1118, order that all products, labels, signs, prints, packages, wrappers, receptacles, and advertisements in the possession of Defendants bearing “BNC” or “BNC BANK” shall be delivered and destroyed.

(c) That Defendants be required to account to Plaintiffs for any and all profits derived by Defendants from the sale of any and all goods and/or services associated with the “BNC” and/or “BNC BANK” mark and name, and for all damages sustained by Plaintiffs by reason of said acts complained of herein.

(d) That this Court award Plaintiffs treble the amount of actual damages suffered by Plaintiffs.

(e) That this Court award Plaintiffs their attorneys’ fees, costs and expenses incurred in this action.

(f) That this Court issue an order cancelling Defendant Bank of North Carolina’s U.S. Trademark Registration No. 3,971,788 pursuant to 15 U.S.C. § 1119.

(g) That the Court grant Plaintiffs such other and further relief as this Court may deem just and proper.

JURY DEMAND

Plaintiffs demand a trial by jury on all issues so triable.

Dated: September 9, 2015

BRIGGS AND MORGAN, P.A.

By: s/Michael M. Lafeber

Michael M. Lafeber (#0242871)

Scott M. Flaherty (##388354)

Michael M. Sawers (#0392437)

2200 IDS Center

80 South Eighth Street

Minneapolis, Minnesota 55402-2157

(612) 977-8400

ATTORNEYS FOR PLAINTIFFS

EXHIBIT E

**UNITED STATES DISTRICT COURT
MIDDLE DISTRICT OF NORTH CAROLINA**

BNC BANCORP and)	
BANK OF NORTH CAROLINA,)	Civil Action No. 1:15-cv-00793
)	
Plaintiffs,)	
)	COMPLAINT
v.)	
)	JURY TRIAL DEMANDED
BNCCORP, INC. and)	
BNC NATIONAL BANK,)	
)	
Defendants.)	
)	

Plaintiffs BNC Bancorp and Bank of North Carolina (collectively, “BNC”) hereby bring this declaratory judgment and breach of contract action against Defendants BNCCORP, INC. and BNC National Bank (collectively, “Defendants”), and allege as follows:

THE PARTIES

1. BNC Bancorp is a North Carolina corporation with its principal place of business in High Point, North Carolina.
2. Bank of North Carolina is a North Carolina corporation with its headquarters in Thomasville, North Carolina.
3. Upon information and belief, BNCCORP, INC. is a Delaware corporation with a principal place of business in Bismarck, North Dakota.
4. Upon information and belief, BNC National Bank is a national banking association with a principal place of business in Glendale, Arizona.

JURISDICTION AND VENUE

5. This action arises under the Declaratory Judgment Act, 28 U.S.C. § 2201 *et seq.*, and the Lanham Act, 15 U.S.C. § 1051 *et seq.*

6. This Court has subject matter jurisdiction pursuant to 28 U.S.C. §§ 1331, 1332, 1338, and 1367. Additionally, the parties are diverse and the amount in controversy exceeds \$75,000 exclusive of interest and costs.

7. This Court has personal jurisdiction over Defendants.

8. On May 15, 2015, Defendants filed suit against BNC in this Judicial District alleging acts of infringement in this Judicial District, styled as *BNCCORP, INC. et al. v. BNC Bancorp et al.*, No. 1:15-cv-00392-WO-JEP (M.D.N.C.) (“Defendants’ North Carolina Infringement Action”). Defendants’ North Carolina Infringement Action presents issues substantially identical to those to be resolved in this action.

9. Venue is proper in this District under at least 28 U.S.C. §§ 1391 and 1400(b). A substantial part of the events giving rise to Defendants’ North Carolina Infringement Action and, correspondingly BNC’s claims in this action, occurred in this Judicial District, and furthermore the Defendants are subject to personal jurisdiction in this Judicial District.

10. An actual case or controversy exists between the parties. Defendants first threatened to take legal action against BNC by letter dated January 6, 2015, have asserted that BNC is engaging in acts of trademark and/or trade name infringement, false designation of origin, unfair competition and passing off, and related claims, have

demanded that BNC cease and desist from using BNC's own federally registered trademark and trade name in connection with banking and financial services, and have in fact taken legal action against BNC by filing an action for trademark and/or trade name infringement, false designation of origin, unfair competition and passing off, and related claims, and cancellation of BNC's BNC BANK & Design registered mark, under federal and North Carolina law, in this District on May 15, 2015, and by filing a subsequent substantially identical action in the District of Minnesota on September 9, 2015 (styled as *BNCCORP, INC. et al. v. BNC Bancorp et al.*, No. 0:15-cv-03624-DWF-TNL (D. Minn.) ("Defendants' Minnesota Infringement Action"). A true and correct copy of Defendants' North Carolina Infringement Action filed in this Judicial District, which was voluntarily dismissed on September 9, 2015, is attached hereto as Exhibit A. A true and correct copy of Defendants' Minnesota Infringement Action is attached hereto as Exhibit B.

FACTS

11. BNC is a commercial bank and bank holding company with assets in excess of \$5.0 billion. BNC offers banking and financial services to individuals and businesses primarily through its 67 banking branches and offices in North Carolina, South Carolina and Virginia. BNC has accounts with customer mailing addresses in approximately 47 states, the District of Columbia and the Virgin Islands.

12. BNC has regularly used its "BNC" name and marks in its communications with its customers and in its promotions, marketing and advertising.

13. BNC's account holders and shareholders regularly receive materials bearing the "BNC" marks via direct mail and email, including monthly statements, annual statements, annual reports, privacy notices, marketing and promotional materials, and other correspondence.

14. Plaintiff Bank of North Carolina was incorporated and began operations in 1991. From the early period of its operations, Bank of North Carolina referred to itself and was referred to by customers as "BNC," an initialism of Bank of North Carolina.

15. Bank of North Carolina was using the mark "BNC" in commerce in connection with the bank's goods and services at least as early as 1995.

16. Examples of Bank of North Carolina's uses in commerce of the "BNC" mark in the 1990s include at least those in connection with banking accounts, bank cards and mortgage services, and as a general reference to the bank and its services.

17. At least as early as 1998, Bank of North Carolina used the "BNC" brand in connection with its interactive customer telephone system, "BNC ACCESS 24," through which customers could access account information twenty-four hours a day.

18. At least as early as the 1999-2001 time period, Bank of North Carolina used "BNC" in connection with its "BNC Check Card" and "BNC Free Checking Account" goods and services.

19. Bank of North Carolina began use of its website, www.bankofnc.com, in approximately 1999. The "BNC" name and brand was used on the website in connection

with banking and financial services, on information and belief, in 1999 and at least as early as 2001.

20. BNC Bancorp is the parent and bank holding company of Bank of North Carolina. BNC Bancorp's stock is quoted in the NASDAQ Capital Market under the symbol "BNCN." BNC Bancorp was formed in 2002 and since its inception has used the "BNC" name and mark in connection with its operations as a holding company for banking and financial services.

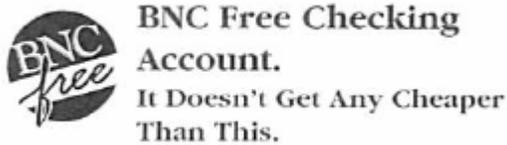
21. BNC has offered online banking services to customers under the "BNC" name and mark since at least as early as 2003. These online banking services have been used by BNC customers without geographic restriction.

22. At least as early as 2005, most all of BNC's banking accounts were branded with "BNC," including, without limitation, "BNC Savings," "BNC Commercial Checking," "BNC Money Market," "BNC Commercial Interest Checking," "BNC Non-Profit Interest Checking," and "BNC Premium Money Market."

23. BNC thereafter continually introduced and offered further goods and services branded with "BNC," including, without limitation, "BNC Bank," "BNC Banking," "BNC Business Check Card," "BNC Small Business Account," "BNC Non-Profit Checking," "BNC Financial Services," "BNC Treasury Services," "BNC Wealth Services," "BNC Wealth Management," "BNC Personal Services," "BNC Minor Savings," "BNC ATM," "BNC Remote Deposit Capture," "BNC Private Banking," "BNC@Work," and "BNC Mortgage."

24. BNC has continuously used its BNC marks in commerce to identify its goods and services and to distinguish its goods and services from those made, sold, or offered by others.

25. Non-exclusive examples of historical and current uses of the BNC marks are shown below:





26. BNC has established substantial goodwill and public recognition in its BNC marks, and BNC has expended substantial time and resources to promote BNC marks in connection with BNC's goods and services. Customers of banking and financial services have come to associate the BNC marks with Bank of North Carolina and BNC Bancorp, and the marks have acquired secondary meaning.

27. BNC is the owner of common law rights in the BNC marks for use in connection with banking and financial services. BNC's rights in the BNC marks in all respects are superior to rights alleged by Defendants.

28. On April 28, 2010, Bank of North Carolina filed an application to register the BNC BANK & Design mark on the Principal Register of the United States Patent and

Trademark Office (“USPTO”), in International Class 36 for banking services. The application included the following words and design:



29. The USPTO approved Bank of North Carolina’s application. The USPTO did not refuse to register the BNC BANK & Design mark based on any likelihood of confusion with any other marks. The USPTO did not determine that there was a likelihood of confusion with any marks allegedly used by Defendants.

30. Bank of North Carolina’s application was published in the Official Gazette between September 28, 2010 and April 28, 2011, without opposition or protest from any third party.

31. Defendants did not object to, oppose or protest the registration of Bank of North Carolina’s BNC BANK & Design mark.

32. Defendants had notice of Bank of North Carolina’s use of its BNC BANK & Design mark and of its application with the USPTO for federal trademark registration of that mark at least as early as 2010.

33. The USPTO issued a registration certificate on May 31, 2011 for the BNC BANK & Design mark.

34. Bank of North Carolina is the rightful owner of U.S. Trademark Registration No. 3971788. A true and correct copy of the registration certificate is attached as Exhibit C.

35. U.S. Trademark Registration No. 3971788 is valid and enforceable in all respects.

36. Bank of North Carolina is the owner of the BNC BANK & Design mark and has the exclusive right to use the mark throughout the United States.

37. Since at least as early as April 9, 2010, Bank of North Carolina has continuously used the BNC BANK & Design registered mark in interstate commerce in connection with banking and financial services.

38. BNC has established substantial goodwill and public recognition in its BNC BANK & Design registered mark, and BNC has expended substantial time, resources and money to promote that mark in connection with BNC's goods and services. Customers of banking and financial services have come to associate the BNC BANK & Design registered mark with Bank of North Carolina and BNC Bancorp.

39. Defendants allege that they provide banking and financial services to customers under the name "BNC National Bank."

40. Defendants conduct their banking and financial services business through branches and offices located in a limited geographical area located in a small number of Midwestern states.

41. According to Defendants' websites, each of the Defendants is "dedicated to providing banking and wealth management services to businesses and consumers in its local markets." (See, e.g., www.bncbank.com/about-us.htm and www.bnccorp.com/54302/mirror/corporate-profile.htm) (emphasis added). According to BNC National Bank's website, "BNC operates community banking, mortgage banking and wealth management in Arizona, Minnesota and North Dakota and also conducts mortgage banking from locations in Illinois, Kansas, Missouri and Nebraska."

42. Defendants assert that they have established common law rights in the "BNC" and "BNC NATIONAL BANK" marks for, among other things, banking and financial services, and in the use of "BNC" and "BNC NATIONAL BANK" as a trade name or part of a trade name (collectively, "Defendants' Alleged Marks").

43. In December 2014, numerous years after Bank of North Carolina filed and obtained its federal registration for its BNC BANK & Design mark, and more than 19 years after Defendants allegedly began using the "BNC" names and marks in connection with banking and financial services in its limited geographic area, Defendant BNCCORP, INC. filed two applications with the USPTO for "BNC" marks relating to banking and financial services, including: "BNC" (U.S. Trademark Application Serial No. 86/495,492) and "BNC NATIONAL BANK" (U.S. Trademark Application Serial No. 86/474,504) (collectively, "Defendant BNCCORP, INC.'s Applications").

44. In filing the applications, Defendant BNCCORP, INC. or its representative was required to sign a declaration under penalty of perjury that Defendant BNCCORP,

INC. was the owner of the mark and had the exclusive right to use it throughout the United States. The Declaration states: “The signatory believes that to the best of the signatory's knowledge and belief, no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive.” True and correct copies of Defendant BNCCORP, INC.’s Applications, which include the Declarations, are attached as Exhibit D.

45. Defendant or their representatives signed and submitted the Declarations on January 5, 2015 (for U.S. Trademark Application Serial No. 86/495,492) and December 8, 2014 (for U.S. Trademark Application Serial No. 86/474,504), with actual knowledge that Bank of North Carolina had obtained U.S. Trademark Registration No. 3971788 for the BNC BANK & Design mark and that Bank of North Carolina and BNC Bancorp had been using that mark in interstate commerce.

46. Defendants allege that the BNC BANK & Design mark is confusingly similar to Defendants’ Alleged Marks and should not have been registered.

47. Defendant BNCCORP, INC.’s Applications published for opposition on August 11, 2015 and August 4, 2015, respectively.

48. BNC filed requests to extend the time to oppose Defendant BNCCORP, INC.’s Applications until December 9, 2015 and December 2, 2015, respectively, which the USPTO granted.

49. On January 6, 2015, more than four years after BNC's application for federal registration published in the Official Gazette, and more than 19 years after Defendants allegedly began using the "BNC" names and marks in connection with banking and financial services in its limited geographic area, Defendants sent BNC a letter demanding that BNC cease use of all "BNC" marks, including its BNC BANK & Design registered trademark.

50. On May 15, 2015, Defendants filed Defendants' North Carolina Infringement Action in this Judicial District alleging trademark and/or trade name infringement, false designation of origin, unfair competition and passing off, related North Carolina state law claims, and requesting that BNC's federal registration be cancelled.

51. Defendants sent a copy of Defendants' North Carolina Infringement Action to counsel for BNC but never served the complaint while the parties conducted extensive settlement negotiations. On September 9, 2015, a few days before the end of the 120-day window for serving the complaint, and while the parties were still engaged in settlement discussions and discussions regarding BNC's agreement to accept service of the summons and complaint or to request this Court to grant an extension for service, Defendants filed a voluntary dismissal without prejudice pursuant to FED. R. CIV. P. 41(a)(1)(A)(i).

52. On the same day, Defendants filed a second suit in the District of Minnesota (Defendants' Minnesota Infringement Action), alleging identical federal

causes of action and state law causes of action similar to those alleged in Defendants' North Carolina Infringement Action.

53. Despite the fact that counsel for Defendants indicated as late as September 8, 2015 that Defendants intended to either serve the complaint (with BNC's counsel's agreement to accept service of the summons and complaint) or explore a possible extension of the service period (with BNC's agreement), Defendants did not disclose to BNC that they planned to dismiss Defendants' North Carolina Infringement Action and refile a nearly identical action in the District of Minnesota.

54. Defendants' accusations and demands must be addressed now, because BNC has made, and continues to make, substantial investment and has developed substantial good will in the BNC marks and thus has been and continues to be damaged by Defendants' allegations.

55. BNC is entitled to conduct its banking and financial services business and to offer related goods and services under the BNC names and marks, and is entitled to a judicial declaration that BNC's use of the BNC names and marks does not infringe upon or misappropriate any of Defendants' Alleged Marks or claimed rights, or otherwise constitute false designation of origin or unfair competition and as requested below.

56. BNC needs the Court to declare its rights in the BNC names and marks, and to require Defendants to abandon their trademark applications.

COUNT ONE

(Declaratory Judgment of Valid Registration and Trademark Ownership)

57. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

58. Defendants claim that Bank of North Carolina's U.S. Trademark Registration No. 3971788 for the BNC BANK & Design Mark was wrongfully issued by the USPTO, and, through litigation and pursuant to 15 U.S.C. § 1119, seeks cancellation of Bank of North Carolina's federal registration.

59. An actual, present and justiciable controversy exists between BNC and Defendants concerning the ownership and registrability of BNC's BNC BANK & Design Mark, and the ownership of BNC's marks.

60. BNC seeks declaratory judgment from this Court that the USPTO properly issued U.S. Trademark Registration No. 3971788 for the BNC BANK & Design mark;(a) that U.S. Trademark Registration No. 3971788 for the BNC BANK & Design mark is valid in all respects; (b) that U.S. Trademark Registration No. 3971788 for the BNC BANK & Design mark is owned by BNC; and (c) that BNC has the exclusive right to use the mark in the United States.

61. BNC seeks declaratory judgment from this Court that BNC has common law rights in, and is the owner of, the BNC marks and that BNC is entitled to use the marks in the United States.

COUNT TWO

(Declaratory Judgment of No Trademark Infringement, False Designation of Origin, Unfair Competition and Passing Off, Deceptive Trade Practices or Unjust Enrichment by BNC)

62. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

63. Defendants claim that BNC's use of the BNC marks in connection with banking and financial services constitutes trademark and/or trade name infringement, false designation of origin, unfair competition and passing off, deceptive trade practices and unjust enrichment, and demands that BNC cease and desist from use of the BNC marks, including the registered BNC BANK & Design mark, in commerce.

64. An actual, present and justiciable controversy exists between BNC and Defendants concerning the right to provide BNC's goods and services under the BNC marks free from Defendants' interference.

65. BNC seeks declaratory judgment from this Court that BNC's use of the BNC marks, including the registered BNC BANK & Design mark, in commerce does not constitute trademark and/or trade name infringement of Defendants' Alleged Marks or any other trademark or trade name that Defendants claim or may claim, under federal, North Carolina or any other state's law.

66. BNC seeks declaratory judgment from this Court that BNC's use of the BNC marks in commerce does not constitute false designation of origin, under federal, North Carolina or any other state's law.

67. BNC seeks declaratory judgment from this Court that BNC's use of the BNC marks in commerce does not constitute unfair competition or passing off, under federal, North Carolina or any other state's law.

68. BNC seeks a declaratory judgment from this Court that BNC's use of the BNC marks in commerce does not constitute deceptive trade practices under federal, North Carolina or any other state's law.

69. BNC seeks a declaratory judgment from this Court that BNC's use of the BNC marks in commerce does not constitute unjust enrichment, under federal, North Carolina or any other state's law.

70. BNC seeks declaratory judgment that Defendants have suffered no, and will not suffer any, damages or loss of goodwill as a result of BNC's use of the BNC marks.

71. BNC seeks declaratory judgment that Defendants are not entitled to any injunctive relief or damages under 15 U.S.C. § 1125 or any other relief whatsoever.

COUNT THREE
(Declaratory Judgment of Unenforceability – Laches and Acquiescence and Statutes of Limitation)

72. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

73. Defendants claim that BNC's use of the BNC marks in connection with banking and financial services constitutes trademark and/or trademark infringement, false

designation of origin, unfair competition, deceptive trade practices and unjust enrichment, seeks cancellation of BNC's BNC BANK & Design registered mark and demands that BNC cease and desist use of the BNC marks in commerce.

74. Since the 1990s, Bank of North Carolina has openly used the BNC marks, including in connection with banking and financial services in interstate commerce.

75. On April 28, 2010, Bank of North Carolina filed an application to register the BNC BANK & Design mark on the Principal Register of the United States Patent and Trademark Office ("USPTO").

76. Bank of North Carolina's federal trademark application for registration of the BNC BANK & Design Mark was published for opposition in the Official Gazette on September 28, 2010.

77. Defendants did not object, oppose or protest the registration of Bank of North Carolina's BNC BANK & DESIGN mark.

78. Bank of North Carolina's federal trademark registration for the BNC BANK & Design Mark issued on May 31, 2011.

79. Defendants had notice of Bank of North Carolina's use of its BNC BANK & Design mark, and of its application with the USPTO for federal trademark registration of that mark, at least as early as 2010, and knew or should have known of such use and of such application since that time.

80. Defendants had notice of Bank of North Carolina's use of its BNC BANK & Design mark and of the USPTO's registration of that mark as of May 31, 2011.

81. Defendants unreasonably delayed in seeking redress to the severe detriment of BNC. BNC has expended substantial time, resources and money to use and promote the BNC marks in connection with BNC's goods and services.

82. Defendants' claims fall outside applicable statutes of limitation.

83. BNC seeks declaratory judgment from this Court that Defendants' claims for trademark and/or trade name infringement, false designation of origin, unfair competition and passing off, deceptive trade practices, unjust enrichment and cancellation of BNC's BNC BANK & Design registered mark are barred due to laches and acquiescence and the applicable statutes of limitation.

COUNT FOUR
**(Declaratory Judgment of Unenforceability – Trademark Misuse, Fraud
Upon the USPTO and Unclean Hands)**

84. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

85. Defendants have filed lawsuits and alleged claims of trademark and/or trade name infringement, false designation of origin, unfair competition, deceptive trade practices and unjust enrichment against BNC in bad faith and without basis in law or fact.

86. Defendant BNCCORP, INC. filed two applications with the USPTO for "BNC" marks relating to banking and financial services, including: "BNC" (U.S. Trademark Application Serial No. 86/495,492) and "BNC NATIONAL BANK" (U.S.

Trademark Application Serial No. 86/474,504) (collectively, “Defendant BNCCORP, INC.’s Applications”).

87. Defendants or their representatives, including without limitation the declarant who submitted Declarations to the USPTO in connection with Defendant BNCCORP, INC.’s Applications, have made misrepresentations to the public in an improper attempt to increase the scope of their alleged marks, at least by submitting Declarations to the USPTO falsely affirming that “no other person has the right to use the mark in commerce, either in the identical form or in such near resemblance as to be likely, when used on or in connection with the goods/services of such other person, to cause confusion or mistake, or to deceive,” despite having actual knowledge of Bank of North Carolina’s federal registration for the BNC BANK & Design mark and of BNC’s open use of the BNC marks in commerce, and by claiming and asserting against BNC common law rights in “BNC” and “BNC National Bank” that are much broader than those, if any, to which they may be entitled.

88. At the time Defendant BNCCORP, INC. filed its applications, it had actual knowledge of BNC’s use of the BNC marks, of Bank of North Carolina’s federal registration and of BNC’s common law rights in its BNC marks.

89. At the time Defendant BNCCORP, INC.’s Applications were filed and the Declaration was signed and submitted and thereafter, Defendant BNCCORP, INC. knew that its declaration was false and intended to deceive the USPTO.

90. In publishing Defendant BNCCORP, INC.'s Applications for opposition, the USPTO reasonably relied on BNCCORP, INC.'s misrepresentations.

91. BNC has suffered damages, and will continue to suffer damages, as a proximate result of such reliance and of Defendant BNCCORP, INC.'s misrepresentations.

92. An actual and justiciable controversy exists by way of Defendants' claiming broad rights in Defendants' Alleged Marks through at least Defendant BNCCORP, INC.'s Applications, and through Defendants' claims that BNC's use of the BNC marks infringes upon those alleged rights.

93. BNC seeks declaratory judgment from this Court that Defendants' Alleged Marks and Defendant BNCCORP, INC.'s Applications are unenforceable, invalid and not subject to registration, and that Defendants' are not entitled to injunctive or other equitable relief, because of their trademark misuse, fraud upon the USPTO and unclean hands.

COUNT FIVE

(Declaratory Judgment That Defendants' Trademark Applications Are Meritless, Invalid and Are Not Entitled to Registration)

94. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

95. Defendants claim to own common law rights in Defendants' Alleged Marks in connection with banking and financial services.

96. Defendant BNCCORP, INC. filed two applications with the USPTO for “BNC” marks relating to banking and financial services, including: “BNC” (U.S. Trademark Application Serial No. 86/495,492) and “BNC NATIONAL BANK” (U.S. Trademark Application Serial No. 86/474,504) (collectively, “Defendant BNCCORP, INC.’s Applications”).

97. Defendant BNCCORP, INC.’s Applications are meritless and invalid, and are not entitled to registration under federal law.

98. Furthermore, Defendant BNCCORP, INC.’s Applications should not be registered and should not be enforced due to Defendants’ trademark misuse, fraud upon the USPTO and unclean hands.

99. An actual and justiciable controversy exists as to whether Defendant BNCCORP, INC.’s Applications are entitled to registration.

100. BNC seeks declaratory judgment that Defendant BNCCORP, INC.’s Applications are meritless, invalid and not entitled to registration.

COUNT SIX
(Breach of Agreement)

101. BNC incorporates by reference the allegations in the foregoing paragraphs, as if stated fully herein.

102. After the filing of Defendants’ North Carolina Infringement Action, in furtherance of settlement discussions, BNC and Defendants agreed to exchange certain confidential business information with each other, subject to Federal Rule of Evidence

408 and additionally subject to the parties' express agreement that the information exchanged would be kept confidential.

103. Through counsel, on July 8, 2015 BNC and Defendants agreed in writing that the "information exchanged will not be disclosed to third parties."

104. On July 17, 2015, BNC, through counsel, sent confidential business information to counsel for Defendants. In doing so, it was expressly stated that the information was submitted to Defendants subject to both Rule 408 and the parties' confidentiality agreement.

105. On September 9, 2015, Defendants filed Defendants' Minnesota Infringement Action.

106. In violation of the July 8, 2015 confidentiality agreement, Defendants base their personal jurisdictional allegations in Defendants' Minnesota Infringement Action on confidential information sent to Defendants by BNC expressly subject to the parties' July 8, 2015 confidentiality agreement and to Rule 408.

107. As a direct and proximate result of Defendants' acts, BNC has been injured, continues to be injured, has sustained, and will continue to sustain substantial damages and injuries, in an amount to be determined at trial.

108. Defendants' acts are wrongful and constitute breach of agreement and contract.

109. Defendants' wrongful acts were willful and deliberate.

110. BNC is entitled to recover a judgment and award adequate to compensate

BNC for Defendants' breach and for appropriate injunctive and equitable relief.

PRAYER FOR RELIEF

WHEREFORE, Plaintiffs respectfully request the following relief:

1. Declaratory Judgment in favor of BNC Bancorp and Bank of North Carolina, and against Defendants, as requested above;
2. A permanent injunction ordering Defendants to abandon, withdraw and discontinue prosecution of Defendant BNCCORP, INC.'s Applications;
3. A judgment in favor of BNC Bancorp and Bank of North Carolina, and against Defendants, for breach of agreement and contract, for damages in an amount to be determined at trial and for appropriate injunctive and equitable relief;
4. An award of interest, attorneys' fees (including without limitation under 15 U.S.C. § 1117(a)), costs and damages, as applicable;
5. An award of such other and further relief as the Court deems just and proper.

TRIAL BY JURY IS REQUESTED

Pursuant to Rule 38(b) of the Federal Rules of Civil Procedure, Plaintiffs request a trial by jury of any issues so triable.

Dated: September 25, 2015

s/Jacob S. Wharton

Jacob S. Wharton
N.C. State Bar No. 37421
WOMBLE CARLYLE SANDRIDGE & RICE, LLP
One West Fourth Street
Winston-Salem, NC 27101
Tel: (336) 747-6609
Fax: (336) 721-3660

Of Counsel:

William M. Ragland, Jr.
Georgia Bar No. 591888
Preston H. Heard
Georgia Bar No. 476319
WOMBLE CARLYLE SANDRIDGE & RICE, LLP
271 17th Street, NW, Suite 2400
Atlanta, GA 30363
Tel: (404) 872-7000
Fax: (404) 888-7490

*Attorneys for Plaintiffs BNC Bancorp and Bank
of North Carolina*