

THIS OPINION IS NOT A
PRECEDENT OF THE TTAB

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

Baxley

Mailed: August 22, 2008

Cancellation No. 92047559

East West Bank

v.

Aimbridge Lending Group, LLC

Before Hairston, Kuhlke, and Ritchie de Larena,
Administrative Trademark Judges

By the Board:

Aimbridge Lending Group, LLC ("respondent") is the record owner of Registration No. 3196507 for the mark POWERBRIDGE in standard character form for "consumer lending services; credit reporting services; financial information provided by electronic means; financial loan consultation; matching borrowers with potential lenders in the field of consumer and mortgage lending; mortgage procurement for others; mortgages services, namely, buyer pre-qualification of mortgages for mortgage brokers and banks" in International Class 36.¹

¹ Respondent's registration was issued on January 9, 2007 and recites June 2004 as the date of first use anywhere and date of first use in commerce.

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East West Bank ("petitioner") filed a petition to cancel respondent's registration. As grounds for cancellation, petitioner alleged therein that: (1) the mark is being used by respondent "so as to misrepresent the source of the services on or in connection with which the mark is used;"² (2) respondent has abandoned use of the registered mark; (3) the registered mark is "a generic term of art that has been used in that segment of the financial services to which the [p]etitioners are members [] to describe **<generic meaning>**" (emphasis supplied); and (4) the registered mark is "confusingly similar" to its previously used marks YOUR FINANCIAL BRIDGE and BUSINESS BRIDGE for "banking [and] cash management" services.³ Respondent, in its answer, denied the salient allegations of the petition to cancel.

The following motions are pending herein: (1) petitioner's first motion (filed October 17, 2007) for leave

² Although not stated in the petition to cancel, such claim is brought under Trademark Act Section 14(3), 15 U.S.C. Section 1064(3).

³ Although petitioner did not expressly state so, the Board will treat this claim as one of priority and likelihood of confusion under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d).

Petitioner's pleaded YOUR FINANCIAL BRIDGE mark is the subject of application Serial No. 78897563. Petitioner alleges in the petition to cancel and in such application that it has used this mark in commerce since January 1, 1997.

Petitioner's pleaded BUSINESS BRIDGE mark is the subject of application Serial No. 78890654. Petitioner alleges in the petition to cancel and such application that it has used this mark in commerce since May 15, 1997.

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to file an amended petition to cancel to rely on an additional mark in support of its claims; (2) respondent's motion (filed November 13, 2007) for summary judgment in its favor on petitioner's pleaded likelihood of confusion claim; (3) petitioner's second motion (filed December 18, 2007) for leave to file an amended petition to cancel; and (4) petitioner's cross-motion (filed December 18, 2007) for summary judgment on the grounds of priority, likelihood of confusion and fraud and motion to take discovery under Fed. R. Civ. P. 56(f) in support of its motion for summary judgment on its newly pleaded fraud claim.

As an initial matter, we are not persuaded by respondent's contention that petitioner's second motion for leave to file an amended petition to cancel, petitioner's cross-motion for summary judgment and motion for Rule 56(f) discovery were filed in contravention of the Board's November 16, 2007 suspension order. Petitioner's cross-motion for summary judgment is germane to respondent's motion for summary judgment, and petitioner's second motion for leave to file an amended petition to cancel and its motion for Rule 56(f) discovery are germane to the cross-motion. See Trademark Rule 2.127(d); TBMP Section 528.03 (2d ed. rev. 2004). Further, although Rule 2.127(d) states that "no party should file any [submission] which is not germane to the motion" which prompted issuance of the

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suspension order, the November 16, 2007 order did not so state. Accordingly, those motions are properly before the Board and will receive consideration.

We turn first to petitioner's motions for leave to file an amended petition to cancel. By the first such motion, petitioner seeks to amend the petition to cancel to add a stylized bridge design to the marks upon which it relies in support of its claims herein. By the second such motion, petitioner seeks to add a claim of fraud based on respondent's alleged failure to have used the registered mark in connection with all of the services recited in the involved registration when it filed the underlying use-based application therefor.

Inasmuch as respondent has filed an answer herein, petitioner may file an amended petition to cancel only by written consent of respondent or by leave of the Board; leave is to be freely granted when justice so requires. See Fed. R. Civ. P. 15(a); TBMP Section 507.02(a) (2d ed. rev. 2004). The Board liberally grants leave to amend pleadings at any stage of a proceeding when justice so requires, unless entry of the proposed amendment would violate settled law, be prejudicial to the rights of the adverse party or parties, or be futile. See *id.* There is no indication that respondent will be prejudiced by allowing petitioner to amend its pleading. That is, there is no indication that

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respondent's ability to defend the cancellation would be adversely affected by allowing petitioner to amend the petition to cancel to rely in addition upon the bridge design mark and to add a claim of fraud. See *Pratt v. Philbrook*, 109 F.3d 18 (1st Cir. 1997). Moreover, the proposed additional fraud claim is adequately pleaded in paragraphs 15-22 of the second amended petition to cancel. Whether or not petitioner can prevail on that claim is a matter for resolution on the merits. See *Flatley v. Trump*, 11 USPQ2d 1284 (TTAB 1989).

Accordingly, petitioner's motions for leave to file an amended petition to cancel are granted. Petitioner's second amended petition to cancel is the operative complaint herein. Respondent is allowed until thirty days from the mailing date set forth in this order to file an answer to the second amended petition to cancel.

Notwithstanding the foregoing, we note that petitioner's claim of misrepresentation of source is set forth in paragraph 4 of the second amended petition to cancel as follows: "Petitioner has and will continue to be damaged by the issuance and existence of Registration No. 3196507 in that such registration is being used by [respondent] so as to misrepresent the source of the

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services on or in connection with which the mark is used."⁴

A pleading of misrepresentation of source "must be supported by allegations of blatant misuse of the mark by respondent in a manner calculated to trade on the goodwill and reputation of petitioner." *McDonnell Douglas Corporation v. National Data Corporation*, 228 USPQ 45, 47 (TTAB 1985).

Based on the foregoing, we find that petitioner has not properly pleaded a claim of misrepresentation of source. Petitioner has not alleged facts reflecting respondent's deliberate misrepresentation of the source of its services, "blatant misuse" of the mark, or conduct amounting to the deliberate passing-off of respondent's goods. The second amended petition to cancel includes no mention of specific acts or conduct by respondent aimed at deceiving the public into thinking that respondent's goods actually emanate from petitioner. See *Otto International Inc. v. Otto Kern GmbH*, 83 USPQ2d 1861 (TTAB 2007). Accordingly, we *sua sponte* strike paragraph 4 from the second amended petition to cancel.

We further note that petitioner's genericness claim is set forth in paragraph 6 of the second amended petition to cancel as follows: "Upon information and belief, the term

⁴ This paragraph was also included in petitioner's original and first amended petitions to cancel.

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POWERBRIDGE has been a generic term of art that has been used in that segment of the financial services industry to which the [p]etitioners are members [] to describe **<generic meaning>**."⁵ (emphasis supplied). Because applicant does not state what the term POWERBRIDGE has allegedly been used generically to describe, petitioner has failed to provide fair notice of the basis for a genericness claim. See Fed. R. Civ. P. 12(f); TBMP Section 506.01 (2d ed. rev. 2004). Accordingly, we *sua sponte* strike paragraph 6 from the second amended petition to cancel. In view of the foregoing, this proceeding will go forward on petitioner's pleaded claims of abandonment, priority/likelihood of confusion, and fraud only.

We will next consider petitioner's motion to take discovery under Fed. R. Civ. P. 56(f) to support its cross-motion for summary judgment on its newly pleaded fraud claim. Motions for discovery under Rule 56(f) are limited to situations in which a party needs discovery to respond to its adversary's motion for summary judgment, in this case, respondent's motion for summary judgment dismissing petitioner's pleaded likelihood of confusion claim.⁶ Such

⁵ This paragraph was also included in petitioner's original and first amended petitions to cancel.

⁶ Petitioner asserts that it is entitled to Rule 56(f) discovery because respondent prematurely filed its motion for summary judgment seeking dismissal of petitioner's likelihood of confusion claim. Because petitioner commenced this proceeding

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motions may not be used to take discovery necessary to support one's own motion for summary judgment, as petitioner seeks to do here. See Fed. R. Civ. P. 56(f); TBMP Section 528.06 (2d ed. rev. 2004). Accordingly, petitioner's motion for Rule 56(f) discovery is denied.

We turn next to the parties' cross-motions for summary judgment. By such motions, respondent seeks entry of judgment dismissing petitioner's likelihood of confusion claim based on the allegedly different overall commercial impressions of the marks at issue, and petitioner seeks entry of summary judgment in its favor on grounds of priority, likelihood of confusion, and fraud.

With regard to the issue of likelihood of confusion, we find that neither party has established that there are no genuine issues of material fact remaining for trial and that it is entitled to entry of judgment as a matter of law.⁷ At

prior to November 1, 2007, when certain changes to Board procedural rules became effective, respondent was permitted to file its motion for summary judgment after the issuance of the institution notice and prior to the commencement of trial. See Trademark Rule 2.127(e)(1); TBMP Section 528.02 (2d ed. rev. 2004). Notwithstanding that the parties had not propounded any discovery requests at the time that respondent filed its motion for summary judgment, respondent filed that motion more than four months after the issuance of the institution notice. Accordingly, petitioner's assertion that respondent filed its motion for summary judgment prematurely is incorrect.

⁷ Respondent is advised that an assertion of a family of marks is not a valid defense against a priority/likelihood of confusion claim. See *Hornblower & Weeks Inc. v. Hornblower & Weeks Inc.*, 60 USPQ2d 1733 (TTAB 2001).

Further, even if we assume that third parties have used marks containing the word BRIDGE in connection with related services

a minimum, there are genuine issues of material fact as to the similarity or dissimilarity of the overall commercial impressions of the marks at issue, the strength/weakness of petitioner's pleaded marks⁸ and thus as to the scope of protection to which petitioner's pleaded marks are entitled.

To the extent that petitioner seeks entry of partial summary judgment on the ground of priority, petitioner's claim of priority is based on the dates of use to which it averred under oath in its pleaded applications.⁹ However,

prior to any date upon which petitioner can rely in support of its claims herein, such third-party use does not defeat petitioner's claim of priority. Rather, priority of use under Trademark Act Section 2(d), 15 U.S.C. Section 1052(d), refers to whether respondent's use of its involved mark precedes petitioner's use of its pleaded marks. See *id.*

In addition, regarding petitioner's allegedly "overreaching and litigious history," to which respondent refers in its motion for summary judgment, the Board must decide each case on its own merits. See *In re Nett Designs Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001). The other proceedings in which petitioner relies upon its pleaded marks are of limited relevance herein. See TBMP Section 414(10) (2d ed. rev. 2004).

⁸ Petitioner's likelihood of confusion claim is based largely on the parties' common use of BRIDGE as a component of the marks at issue. However, we take judicial notice that the term "bridge financing" has the following meaning in the relevant industry: "interim or emergency financing through a short- or medium-term loan." *The Random House Dictionary of the English Language* at 261 (2d ed. 1987).

⁹ Although petitioner alleges that its pleaded application Serial No. 78897563 for the mark YOUR FINANCIAL BRIDGE matured into Registration No. 3307037 and included a printout of that registration from the USPTO's Trademark Applications and Registrations Retrieval (TARR) database with its brief in opposition to respondent's motion for summary judgment and cross-motion for summary judgment, that registration was cancelled and the application was restored to pendency on January 24, 2008. Accordingly, petitioner may not rely upon Registration No. 3307037 in support of its claim of priority herein. See *King Candy Co. v. Eunice King's Kitchen, Inc.*, 496 F.2d 1400, 182 USPQ 108, 110 (CCPA 1974).

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it is well-settled that dates of use set forth in an application or registration do not constitute evidence of such use; "a date of use of a mark must be established by competent evidence." Trademark Rule 2.122(b)(2).

Petitioner's remaining evidence otherwise fails to establish that there is no genuine issue of material fact as to its priority.

With regard to petitioner's motion for entry of summary judgment on its newly pleaded fraud claim, petitioner contends that, because the specimens of use that respondent submitted in support of its use-based application for its involved registration do not show use of the registered POWERBRIDGE mark on all of the services identified in that registration, respondent was not using the mark on all of those services when it filed that application and thus committed fraud on the Office. However, a use-based application need only include one specimen for each class which shows use of the mark on or in connection with the goods or in the sale or advertising of the services, in commerce. See Trademark Rule Section 1(a)(1), 15 U.S.C.

A review of USPTO records indicates that, in Opposition No. 91176239, filed by Riverbridge Partners, LLC, and Opposition No. 91177344, filed by Bridge Bank, N.A., refusal of registration of the YOUR FINANCIAL BRIDGE mark in application Serial No. 78897563 was sought. In Opposition No. 91177345, Bridge Bank, N.A. also sought refusal of the BUSINESS BRIDGE mark in application Serial No. 78890654. Although Opposition No. 91176239 was dismissed without prejudice on August 31, 2007, Opposition Nos. 91177344 and 91177345 remain pending.

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Section 1051(a)(1); Trademark Rules 2.34(a)(1)(iv) and 2.56(a); TMEP Section 904 (5th ed. 2007). An applicant typically does not submit a specimen for each product or service identified in an application. See TMEP Section 904.01(a) (5th ed. 2007). Thus, even if we assume for sake of argument that respondent's specimens do not show use of the registered mark on all of the services identified in that registration, it does not necessarily follow that respondent was not using the mark in connection with all of the identified services when it filed the use-based application that matured into its involved registration.¹⁰ Accordingly, petitioner has wholly failed to meet its initial burden of establishing that there is no genuine issue of material fact with regard to its newly pleaded fraud claim.

Based on the foregoing, respondent's motion for summary judgment and petitioner's cross-motion for summary judgment are both denied. Proceedings herein are resumed. The parties are allowed until thirty days from the mailing date set forth in this order to serve responses to any

¹⁰ To the extent that petitioner alleges that the specimens that respondent submitted in support of the application for the involved registration are insufficient, petitioner did not so allege in the second petition to cancel and thus cannot obtain judgment on that basis. See TBMP Sections 314 and 528.07(a) (2d ed. rev. 2004). Moreover, it is well-settled that the sufficiency of specimens of use is an *ex parte* matter that is not a valid basis for cancellation of a registration. See *Century 21 Real Estate Corp. v. Century Life of America*, 10 USPQ2d 2034, 2035 (TTAB 1989).

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outstanding written discovery requests. Discovery and testimony periods are reset as follows.

DISCOVERY PERIOD TO CLOSE: October 31, 2008

Plaintiff's 30-day testimony period to close: **January 29, 2009**

Defendant's 30-day testimony period to close: **March 30, 2009**

Plaintiff's 15-day rebuttal testimony period to close: **May 14, 2009**

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 Rule 2.128(a) and (b). An oral hearing will be set only upon request filed as provided by Trademark Rule 2.129.