

ESTTA Tracking number: **ESTTA169174**

Filing date: **10/17/2007**

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

Proceeding	92047559
Party	Plaintiff East West Bank
Correspondence Address	Thomas T. Chan Chan Law Group LLP PO Box 79159 Los Angeles, CA 90079-0159 UNITED STATES tm@chanlaw.com
Submission	Motion to Amend Pleading/Amended Pleading
Filer's Name	Lisa A. Karczewski
Filer's e-mail	litigation@chanlaw.com
Signature	/Lisa A. Karczewski/
Date	10/17/2007
Attachments	Amend.pdf (8 pages)(246810 bytes) Decl.pdf (5 pages)(121557 bytes) Petition.pdf (6 pages)(156496 bytes)

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

EAST WEST BANK,)	
)	
Petitioner,)	
)	
v.)	Cancellation No.: 92047559
)	
THE AIMBRIDGE GROUP,)	
)	
Registrant.)	
)	

**PETITIONER’S MOTION TO AMEND PLEADING PURSUANT TO
FED.R.CIV.P. 15(a) AND MEMORANDUM IN SUPPORT THEREOF**

Petitioner East West Bank (“EWB”) hereby moves to amend its Petition to Cancel pursuant to *Federal Rule of Civil Procedure* 15(a). Registrant The Aimbridge Group (“Aimbridge”) has indicated that it reserves the right to oppose the instant motion. An executed copy of EWB’s proposed amended pleading is concurrently filed herewith.

MEMORANDUM OF POINTS AND AUTHORITIES

I. INTRODUCTION

Pursuant to *Federal Rule of Civil Procedure* 15(a), Petitioner EWB seeks to amend its Petition to Cancel, in order to include an additional fact that was discovered during the discovery stage of the instant proceeding. EWB’s proposed amendment merely adds the common law use of EWB’s bridge logo in connection with the EWB marks already at issue in this cancellation, which only clarifies EWB’s existing grounds for cancellation with respect to the likelihood of confusion caused by Registrant’s mark. This proposed amendment is not prohibited by the U.S. trademark

laws, namely, 37 C.F.R. § 2.115 (Amendment of pleadings in a cancellation proceeding). *See* 37 C.F.R. § 2.115 (indicating “[p]leadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court).

The federal courts and Trademark Trial and Appeal Board (“Board”) liberally grant leave to amend pleadings at *any stage* of a proceeding when justice so requires, unless such proposed amendment is in violation of settled law or is prejudicial to the rights of the adverse party. *See* Fed.R.Civ.P. 15(a) and TBMP § 507.02. EWB’s proposed amendment is not in violation of any rule or prejudicial to Aimbridge because leave is requested at the pre-trial discovery stage of proceedings. Thus, the Board should grant EWB’s request for leave to amend to further clarify its grounds asserted in the existing Petition to Cancel.

II. STATEMENT OF FACTS

This cancellation proceeding, filed on May 22, 2007, involves Petitioner’s “Bridge marks”—namely, (a) YOUR FINANCIAL BRIDGE, Serial No. 78/897,563, for “banking; cash management,” in International Class 36; and (b) BUSINESS BRIDGE, Serial No. 78/890,654, for “banking; cash management,” in International Class 36—and Registrant’s confusingly similar mark, POWERBRIDGE, Registration No. 3196507, for the following services: “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, among others.

Following the filing of the Petition to Cancel, the Board set the discovery and testimony periods for the instant cancellation proceeding. These dates have since been reset pursuant to a later Order on or about June 13, 2007. The reset dates are as follows: December 30, 2007 (Discovery

Period to Close); March 29, 2008 (Thirty-day Testimony Period for Party in Position of Plaintiff to Close); May 28, 2008 (Thirty-day Testimony Period for Party in Position of Defendant to Close); and July 12, 2008 (Fifteen-day Rebuttal Testimony Period to Close).

On June 28, 2007, Aimbridge filed its Answer to EWB's Petition to Cancel. Discovery has not yet been propounded on either party. During the discovery stage of the instant proceeding while preparing a proposed draft coexistence agreement, it became apparent that EWB should amend the pleading to clarify its grounds for cancellation relating to the issue of likelihood of confusion. In

particular, EWB found that it should add the common law use of its bridge logo  in connection with its respective marks identified above to further identify and distinguish its services for at least the reason that the confusingly similar POWERBRIDGE mark likewise uses the term "BRIDGE", which may be associated with a bridge logo.

In an effort to initiate settlement discussions, EWB's counsel forwarded to Aimbridge's counsel via e-mail on two separate occasions (i.e., August 29, 2007 and September 26, 2007) a proposed coexistence (settlement) agreement and updated version thereof. *See* Declaration of Lisa A. Karczewski ("Karczewski Decl."), at ¶ 2, filed concurrently herewith. Aimbridge's counsel has yet to respond to EWB's counsel's e-mails regarding resolution of the instant proceeding. *Id.*

EWB's counsel contacted Aimbridge's counsel via e-mail on October 3, 2007 to inquire as to whether Aimbridge would consent to EWB's proposed amended pleading to include the common law usage of EWB's bridge logo. *Id.* at ¶ 3. EWB's counsel received no response to the e-mail and subsequently followed up with Aimbridge's counsel via telephone on October 9, 2007. *Id.* at ¶ 3.

Later that same day, Aimbridge’s counsel responded to EWB’s earlier email of October 3, 2007 indicating that Aimbridge reserved the right to oppose the instant motion. *Id.*

III. LEGAL STANDARD

Amendments to pleadings in *inter partes* proceedings before the Board are governed by Rule 15(a) of the *Federal Rules of Civil Procedure*. TBMP § 507.01. Pursuant to Rule 15(a):

“A party may amend the party’s pleading once as a matter of course at any time before a responsive pleading is served or . . . [o]therwise a party may amend the party’s pleading only by leave of court or by written consent of the adverse party; and *leave shall be freely given when justice so requires.*”

Fed.R.Civ.P. 15(a) (emphasis added). Generally, pleadings in an *inter partes* proceeding before the Board may be amended in the same manner as in a civil action before the U.S. district court. TBMP § 507.01; 37 CFR § 2.115.

Further, a decision to allow leave to amend pleading “does not depend on whether the Board believes the moving party will ultimately prevail on the merits of the claim . . . sought to be added; rather, a proposed pleading need only be legally sufficient, and otherwise allowable under Fed.R.Civ.P. 15(a).” Reed Elsevier Properties, Inc. v. Linguistic Electronic System, 2001 TTAB LEXIS 760, *4 (TTAB 2001).

IV. ARGUMENT

A. EWB’s Proposed Amendment Clarifies Petitioner’s Contention of Confusing Similarity Arising from the POWERBRIDGE Mark

The trademark laws do not expressly prohibit a party from amending a pleading in a cancellation proceeding for the purpose of clarifying an existing ground of opposition. 37 C.F.R. § 2.115 (Amendment of pleadings in a cancellation proceeding). *See* 37 C.F.R. § 2.115 (indicating

“[p]leadings in a cancellation proceeding may be amended in the same manner and to the same extent as in a civil action in a United States district court); TBMP § 507.01. This is exactly what EWB wishes to do with respect to its proposed amendment, namely, adding the common law use of

its bridge logo  with the Bridge marks, in order to clarify its existing ground of confusing similarity arising from the POWERBRIDGE mark.

The incorporation of this additional fact, which became apparent when EWB was in the process of preparing a proposed coexistence agreement during the discovery stage of this proceeding, is not a new ground of opposition, but rather serves the sole purpose of clarifying EWB’s existing ground of confusing similarity between the Bridge marks and the POWERBRIDGE mark.

Further, as EWB’s proposed amendment seeks only to clarify the existing viable ground of likelihood of confusion based on Section 2(d) of the Lanham Act, such amendment is hence legally sufficient. Thus, in the spirit of Rule 15(a), the Board should liberally grant EWB leave to amend the pleading as justice so requires in this instance.

B. Aimbridge Would Not Be Prejudiced Should the Board Grant EWB’s Motion to Amend Pleading And Justice Requires That Leave to Amend Be Freely Given

The Board liberally grants leave to amend pleadings when justice so requires, unless entry of the proposed amendment is in violation of settled law or is prejudicial to the rights of the adverse party. Reed Elsevier Properties, Inc., 2001 TTAB LEXIS at *4. Here, Aimbridge would not be prejudiced should EWB’s motion for leave to amend be granted by the Board as the instant motion is being submitted during the pre-trial discovery stage of the proceeding. See Buffett v. Chi Chi’s,

Inc., 226 USPQ 428 (TTAB 1985) (finding no substantial prejudice to applicant by allowance of amendment where proceeding remained in a fairly early stage); *see also* Flatley v. Trump, 11 USPQ2d 1284 (TTAB 1989) (allowing leave to amend when proceedings were still in the discovery stage). The discovery cut-off date in the instant proceeding is not until December 30, 2007.

Moreover, Aimbridge has been aware of this issue since at least August 29, 2007 (i.e., four months prior to the discovery cut-off date) when EWB's counsel referred to its portfolio of Bridge marks in EWB's proposed coexistence agreement to Aimbridge as including "any design resembling a bridge". Accordingly, Aimbridge has had and still has sufficient time in which to propound discovery concerning EWB's common law use of its bridge logo in connection with the Bridge marks should it wish to do so.

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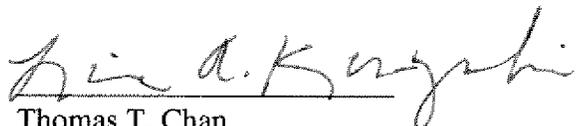
V. CONCLUSION

For the foregoing reasons, the Board should grant the instant motion to amend pleading pursuant to Rule 15(a).

Respectfully submitted,

CHAN LAW GROUP LLP

Dated: 10/17/07

By: 
Thomas T. Chan
Ivan Posey
Lisa A. Karczewski
Attorneys for Petitioner
EAST WEST BANK

CHAN LAW GROUP LLP
1055 W. 7th Street, Suite 1880
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Trademark Registration No. 3196507

For the mark POWERBRIDGE

Date Registered: September 1, 2007

EAST WEST BANK,)

Petitioner,)

v.)

AIMBRIDGE LENDING GROUP, LLC)

Registrant.)

Cancellation No.: 92047559

UNITED STATES PATENT & TRADEMARK OFFICE

Trademark Trial and Appeal Board

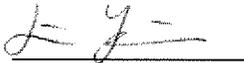
P.O. Box 1451

Alexandria, VA 22313-1451

CERTIFICATE OF SERVICE

I certify **PETITIONER'S MOTION TO AMEND PLEADING PURSUANT TO FED.R.CIV.P.15(a) AND MEMORANDUM IN SUPPORT THEREOF** that is being served on Applicant by mailing a true and correct copy to the attorneys of record, via First Class Mail, Wednesday, October 17, 2007, in an envelope addressed as follows:

David A. Lowe, Esq.
Black Lowe & Graham
701 Fifth Avenue, Suite 4800
Seattle, WA 98104



Yaning Liu
Chan Law Group LLP
1055 West 7th Street, Suite 1880
Los Angeles, California 90017
Tel: (213) 624-6560
Fax: (213) 622-1154
litigation@chanlaw.com

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

EAST WEST BANK,)	
)	
Petitioner,)	
)	Cancellation No. 92047559
v.)	
)	
THE AIMBRIDGE GROUP,)	
)	
Registrant.)	
)	

**DECLARATION OF LISA A. KARCZEWSKI IN SUPPORT OF PETITIONER'S
MOTION TO AMEND PLEADING PURSUANT TO FED.R.CIV.P. 15(a)**

I, Lisa A. Karczewski, Esq., declare:

1. I am an attorney, duly licensed to practice law in the State of California and registered to practice before the U.S. Patent and Trademark Office. I am an associate of the Chan Law Group LLP, counsel of record for Petitioner East West Bank ("EWB"). I make this declaration in support of Petitioner's Motion to Amend Pleading Pursuant to Fed.R.Civ.P. 15(a). If called upon to do so, I could and would competently testify to the following:

2. In an effort to initiate settlement discussions, I forwarded to Aimbridge's counsel via e-mail on two separate occasions (i.e., August 29, 2007 and September 26, 2007) a proposed coexistence (settlement) agreement and updated version thereof. Aimbridge's counsel has yet to respond to my e-mails regarding resolution of the instant proceeding

3. On or about October 3, 2007, I contacted Aimbridge's counsel via e-mail to inquire as to whether Aimbridge would consent to EWB's proposed amended pleading to include the common

law usage of EWB's bridge logo. I received no response to my e-mail and subsequently followed up with Aimbridge's counsel via telephone on October 9, 2007. Later that same day, Aimbridge's counsel responded to my earlier email of October 3, 2007 indicating that Aimbridge reserved the right to oppose the instant motion. Attached hereto as **Exhibit A** is a true and correct copy of the October 9, 2007 email sent by Aimbridge's counsel to EWB's counsel regarding Aimbridge's reservation of rights to oppose the instant motion.

I declare the above statements to be true and correct under penalty of perjury under the laws of the United States. Executed on October 17, 2007 in Los Angeles, California.


Lisa A. Karczewski

EXHIBIT A

Lisa Karczewski

From: David Lowe [lowe@blacklaw.com]
Sent: Tuesday, October 09, 2007 10:54 PM
To: Lisa Karczewski
Subject: RE: East West Bank v. The Aimbridge Group (POWERBRIDGE) - Cancellation No. 92047559 - Our Ref. No. 987.426

Lisa,

Based on your discovery production in the opposition proceeding relative to the two noted marks, we believe that any amendment to claim common law rights would be futile, and we reserve the option to oppose any such motion on that or other applicable grounds.

David

From: Lisa Karczewski [mailto:lisa.karczewski@chanlaw.com]
Sent: Wednesday, October 03, 2007 2:29 PM
To: David Lowe
Cc: 'Tom Chan'
Subject: Re: East West Bank v. The Aimbridge Group (POWERBRIDGE) - Cancellation No. 92047559 - Our Ref. No. 987.426

David,

In connection with the above-referenced matter, East West Bank would like to amend its pleading to include the common law usage of its bridge logo in connection with its YOUR FINANCIAL BRIDGE and BUSINESS BRIDGE marks to further identify and distinguish its services. Please let us know whether your client consents to East West Bank's proposed amendment of its pleading by the close of business this week.

Thank you,

Lisa

Lisa A. Karczewski
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10/10/2007

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

In the Matter of Trademark Registration No. 3196507

For the mark POWERBRIDGE

Date Registered: September 1, 2007

_____)	
EAST WEST BANK,)	
)	
Petitioner,)	Cancellation No.: 92047559
v.)	
)	
AIMBRIDGE LENDING GROUP, LLC)	
)	
Registrant.)	
_____)	

UNITED STATES PATENT & TRADEMARK OFFICE
Trademark Trial and Appeal Board
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CERTIFICATE OF SERVICE

I certify **DECLARATION OF LISA A. KARCZEWSKI IN SUPPORT OF PETITIONER'S MOTION TO AMEND PLEADING PURSUANT TO FED.R.CIV.P.15(a)** that is being served on Applicant by mailing a true and correct copy to the attorneys of record, via First Class Mail, Wednesday, October 17, 2007, in an envelope addressed as follows:

David A. Lowe, Esq.
Black Lowe & Graham
701 Fifth Avenue, Suite 4800
Seattle, WA 98104



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

In the Matter of Trademark Registration No. 3196507
For the mark POWERBRIDGE
Date Registered: January 9, 2007

EAST WEST BANK,)	
)	
Petitioner,)	
)	
v.)	Cancellation No.: 92047559
)	
THE AIMBRIDGE GROUP,)	
)	
Registrant.)	
)	

UNITED STATES PATENT & TRADEMARK OFFICE
Trademark Trial and Appeal Board
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FIRST AMENDED PETITION TO CANCEL

EAST WEST BANK (“Petitioner”) is a California corporation having its business address at 135 N. Los Robles Ave., 7th Floor, Pasadena, California 91101. To the best of Petitioner’s knowledge, The Aimbridge Group (“Registrant”) is the current owner of Registration No. 3196507. To the best of Petitioner’s knowledge, Registrant is a Colorado Corporation having its business address at 4610 S. Ulster St., Suite 300, Denver, Colorado 80237.

Petitioner believes that it is and/or will be damaged by the above-identified registration, and hereby petitions to cancel the same.

The grounds for cancellation are as follows:

1. Registrant obtained a registration for POWERBRIDGE 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, among others. The registration was obtained pursuant to Section I(a) of the Trademark Act with a first use in commerce date of June 2004.

2. Petitioner is the owner of the trademarks ("Petitioner's Marks"): (a) YOUR FINANCIAL BRIDGE, Serial No. 78/897,563, for "banking; cash management," in International Class 36; and (b) BUSINESS BRIDGE, Serial No. 78/890,654, for "banking; cash management," in International Class 36.

3. Petitioner has used the respective marks identified above in interstate commerce since at least (a) January 1, 1997 and (b) May 15, 1997, respectively. Petitioner is now using the marks identified above in connection with the respective services identified above. The use has been valid and continuous since the date of first use within the United States and has not been abandoned. Petitioner has also consistently

used the following bridge logo  in connection with its respective marks identified above to further identify and distinguish its services. Petitioner's Marks are symbolic of the good will and consumer recognition built up by Petitioner through time and effort in advertising and promotion.

4. Petitioner has been and will continue to be damaged by the issuance and existence of Registration No. 3196507 in that such registration is being used by the Registrant so as to misrepresent the source of the services on or in connection with which the mark is used.

5. Upon information and belief, Registrant has abandoned use of Registration No. 3196507 for its services in International Class 36, among others.

6. Upon information and belief, the term POWERBRIDGE has been a generic term of art that has been used in that segment of the financial services industry of which the Petitioners are members, to describe *<generic meaning>*.

7. Petitioner has developed extensive goodwill with respect to Petitioner's Marks.

8. Petitioner has spent significant sums in the advertisement and promotion of the services sold in connection with Petitioner's Marks.

9. As a result of the advertisement and promotion of Petitioner's Marks, along with the high quality of the services sold in connection with Petitioner's Marks,

Petitioner has acquired a valuable reputation for Petitioner's Marks.

10. Registrant's mark is confusingly similar to Petitioner's Marks and is applied to services that are nearly identical to those sold by Petitioner.

11. Petitioner has been and will continue to be damaged by the issuance and existence of Registration No. 3196507 in that confusion in the trade is likely to result from any concurrent use of Petitioner's Marks and that of Registrant, all to the great detriment of Petitioner, who has expended considerable sums and effort in promoting Petitioner's Marks.

12. Purchasers are likely to consider the services of the Registrant sold under the mark POWERBRIDGE as emanating from Petitioner, and purchase such services as those of the Petitioner, resulting in loss of sales to Petitioner.

13. Concurrent use of the mark by Registrant and Petitioner may result in irreparable damage to Petitioner's reputation and goodwill if the services sold by the Registrant are inferior, since purchasers are likely to attribute the source of the Registrant's services to the Petitioner.

14. If the Registrant is permitted to retain the registration sought to be canceled, a cloud will be placed on Petitioner's title in and to Petitioner's Marks, and on its right to enjoy the free and exclusive use thereof in connection with the sale of its services, all to the great injury of Petitioner.

WHEREFORE, Petitioner prays that said Registration No. 3196507 be canceled and that this Petition to Cancel be sustained in favor of Petitioner.

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Petitioner hereby appoints Thomas T. Chan, Ivan Posey, and Lisa A. Karczewski (Reg. No. 53,096), members of the CHAN LAW GROUP LLP, with offices at P.O. Box 79159, Los Angeles, California 90079-0159, as its attorneys to prosecute this cancellation proceeding and to transact all business in and before the United States Patent and Trademark Office in connection herewith.

Respectfully submitted,
CHAN LAW GROUP LLP

Dated: October 17, 2007

By: 
Thomas T. Chan
Ivan Posey
Lisa A. Karczewski
Attorneys for Petitioner
EAST WEST BANK

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Los Angeles, California 90017

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

In the Matter of Trademark Registration No. 3196507

For the mark POWERBRIDGE

Date Registered: September 1, 2007

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CERTIFICATE OF SERVICE

I certify **FIRST AMENDED PETITION TO CANCEL** that is being served on Applicant by mailing a true and correct copy to the attorneys of record, via First Class Mail, Wednesday, October 17, 2007, in an envelope addressed as follows:

David A. Lowe, Esq.
Black Lowe & Graham
701 Fifth Avenue, Suite 4800
Seattle, WA 98104



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