

ESTTA Tracking number: **ESTTA58030**

Filing date: **12/16/2005**

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	Security Pacific Bancorp		
Entity	Corporation	Citizenship	California
Address	12121 Wilshire Boulevard Suite 1350 Los Angeles, CA 90025 UNITED STATES		

Name	Security Pacific Bank		
Granted to Date of previous extension	12/17/2005		
Address	12121 Wilshire Boulevard Suite 1350 Los Angeles, CA 90025 UNITED STATES		

Attorney information	Mark J. Shean Orrick Herrington & Sutcliffe LLP 4 Park Plaza Suite 1600 Irvine, CA 92614 UNITED STATES ipprosecution@orrick.com, mshean@orrick.com Phone:9495676700		
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**Applicant Information**

Application No	76568942	Publication date	10/18/2005
Opposition Filing Date	12/16/2005	Opposition Period Ends	12/17/2005
Applicant	Security Pacific Home Loans, Inc. 123 North Lake Avenue Pasadena, CA 91101 UNITED STATES		

**Goods/Services Affected by Opposition**

Class 036. First Use: 2004/06/00 First Use In Commerce: 2004/06/00 All goods and services in the class are opposed, namely: Financial services, namely mortgage lending and mortgage banking
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Attachments	spopp.pdf ( 5 pages )
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Signature	/mark shean/
Name	Mark J. Shean
Date	12/16/2005



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

In the Matter of Trademark Application Serial No. 76/568,942  
Published in the Official Gazette on October 18, 2005

Security Pacific Bancorp, a California corporation, and Security Pacific Bank, a California corporation,	)	) Opposition No. _____
	)	
Opposers,	)	
	)	
v.	)	
	)	
Security Pacific Home Loans, Inc., a California corporation,	)	
	)	
Applicant.	)	

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Commissioner for Trademarks  
P.O. Box 1451  
Alexandria, Virginia 22313-1451

**NOTICE OF OPPOSITION**

Security Pacific Bancorp (“Bancorp- Opposer”) and its wholly-owned subsidiary, Security Pacific Bank (formerly known as Network Bank USA) (“Bank–Opposer” and together with Bancorp-Opposer, the “Opposers”), each believes that it will be damaged by registration of the mark shown in Serial No. 76/568,942 and hereby opposes the same.

As grounds of opposition, it is alleged that:

1. Bancorp-Opposer is a corporation organized and existing under the laws of California with a principal place of business at 12121 Wilshire Boulevard, Suite 1350, Los Angeles, California 90025.

2. Bank-Op poser is a corporation organized and existing under the laws of California with a principal place of business at 12121 Wilshire Boulevard, Suite 1350, Los Angeles, California 90025.

3. By way of valid assignment reflecting the change in name from Network Bank USA to Security Pacific Bank, Bank-Op poser owns all rights, title, goodwill, and interest in and to U.S. Trademark Application Serial No. 76/619,977 (the '977 Application) filed on November 10, 2004 for the trademark "SECURITY PACIFIC BANK" in International Class 36 for financial services, namely banking.

4. The Applicant, Security Pacific Home Loans, Inc. ("Applicant"), is a corporation organized and existing under the laws of California with a principal place of business at 123 North Lake Avenue, Pasadena, California 91101.

5. Applicant seeks to register "SECURITY PACIFIC HOME LOANS" as a trademark for financial services, namely mortgage lending and mortgage banking. The application was filed on January 6, 2004 and published for opposition in the *Official Gazette* on October 18, 2005.

6. Bank-Op poser on behalf of the Opposers applied for and was granted a thirty (30) day extension to oppose registration of Applicant's mark.

7. The '977 Application has been provisionally refused registration based on Applicant's application.

8. As of April 24, 2002, Bancorp-Op poser duly filed an amendment to its articles of incorporation with the Secretary of State of the State of California and thereby adopted the name Security Pacific Bancorp as its legal name and as its trade name in the conduct of its business, which then included the businesses of commercial banking and commercial finance which were conducted through its subsidiaries.

9. From and after April 24, 2002, Bancorp-Opposer has continuously conducted its business and filed all regulatory applications with the Board of Governors of the Federal Reserve System (the “Federal Reserve Board”), its primary bank regulatory authority, under its legal and trade name, Security Pacific Bancorp.

10. As of December 31, 2003, prior to the filing of Applicant’s intent to use application, and as a result of discussions between the parties that commenced in July 2003, Bancorp-Opposer and Applicant entered into a purchase agreement (the “Purchase Agreement”) pursuant to which Bancorp-Opposer would acquire Applicant. Under the Purchase Agreement, Bancorp-Opposer would purchase a majority of Applicant’s stock and all of Applicant’s goodwill as a result of which Bancorp-Opposer would operate Applicant’s business as a subsidiary of Bancorp-Opposer. The closing of the Purchase Agreement was, subject, among other things, to the satisfaction by Applicant of certain financial conditions and the receipt by Bancorp-Opposer of the approval of the Federal Reserve Board.

11. Before these negotiations commenced, Applicant was considering changing its name from “Genuine Home Loans, Inc.,” the name under which it then operated its home loans mortgage business..

12. It was only after and as a result of its negotiations with Bancorp-Opposer that Applicant considered changing its name from “Genuine Home Loans, Inc.” to “Security Pacific Home Loans.”

13. As a result of its negotiations with Bancorp-Opposer, Applicant learned that Bancorp-Opposer, as an integral part of its strategic plan, intended to operate all of its current and future subsidiary businesses under the “Security Pacific” portion of its trade name, so that its commercial bank subsidiary would operate under the name “Security Pacific Bank,” its commercial finance subsidiary would operate under the name “Security Pacific Finance

Company” and Applicant, as a home loan subsidiary of Bancorp-Op poser, would operate under the name “Security Pacific Home Loans.”

14. In contemplation of Bancorp-Op poser’s proposed acquisition of Applicant, the closing of the Purchase Agreement and in furtherance of Bancorp-Op poser’s strategic plan, Applicant, on behalf of and as permitted by Bancorp-Op poser, applied for registration of the mark “SECURITY PACIFIC HOME LOANS.”

15. In or about October 2004, Bancorp-Op poser received the approval of its application to the Federal Reserve Board to acquire Applicant.

16. In or about February 2005, and primarily as a result of Applicant’s failure to satisfy financial conditions to the closing of the Purchase Agreement, Bancorp-Op poser terminated the Purchase Agreement.

17. Even after the termination of the Purchase Agreement, which was primarily as a result of Applicant’s failure to satisfy mutually agreed upon closing conditions to the Purchase Agreement, Applicant has continued to seek registration of the “SECURITY PACIFIC HOME LOANS” mark even though it applied for the mark on behalf of and as permitted by Bancorp-Op poser and solely in contemplation of Bancorp-Op poser’s proposed acquisition of Applicant, the closing of the Purchase Agreement and in furtherance of Bancorp-Op poser’s strategic plan.

18. In view of the foregoing, registration of Applicant’s mark would be damaging to Op posers within the meaning of 15 U.S.C. § 1063.

19. Each of the Op posers believes that it will be damaged by the registration of Applicant’s mark, and hereby opposes the same. If the Applicant were granted the registration herein opposed, it would thereby obtain at least a *prima facie* exclusive right to use

of the "SECURITY PACIFIC HOME LOANS" mark. Such registration would be a source of commercial harm and injury to each of the Opposers.

WHEREFORE, each of the Opposers prays that the application Serial No. 76/568,942 be assigned to Bancorp-Opposer, or in the alternative rejected and no registration be issued thereon to Applicant, that this opposition be sustained in favor of the Opposers or either of them and for such other and further relief as is deemed just and proper.

The fee required in 37 C.F.R. § 2.6(a)(17) are enclosed herewith. For any additional fees associated with the filing of these papers, please charge Deposit Account No. 15-0665.

Dated: December 16, 2005

Respectfully submitted,

ORRICK, HERRINGTON & SUTCLIFFE LLP

By: \_\_\_\_\_



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Attorney for Opposers

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