

ESTTA Tracking number: **ESTTA815489**

Filing date: **04/19/2017**

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 party opposes registration of the indicated application.

Opposer Information

Name	Homestreet, Inc.
Granted to Date of previous extension	04/22/2017
Address	601 Union Street Suite 2000 Seattle, WA 98101 UNITED STATES

Attorney information	Stuart Dunwoody Davis Wright Tremaine 1201 Third Avenue Suite 2200 Seattle, WA 98101 UNITED STATES stuardunwoody@dwt.com, SeattleTrademarkDocket@dwt.com, lisamer- ritt@dwt.com Phone:206-757-8034
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Applicant Information

Application No	87189473	Publication date	02/21/2017
Opposition Filing Date	04/19/2017	Opposition Period Ends	04/22/2017
Applicant	Santo, John 3564 Avalon Park Blvd. E Ste 1, #202 Orlando, FL 32828 UNITED STATES		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0 All goods and services in the class are opposed, namely: Clothing, namely, t-shirts, sweaters, sweat-shirts, polo shirts, hats, caps, visors, shorts, pants, jeans, belts, socks, underwear, footwear, sneakers

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act Section 2(d)
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Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	2586213	Application Date	04/20/2000
Registration Date	06/25/2002	Foreign Priority Date	NONE
Word Mark	HOMESTREET		

Design Mark	HOMESTREET		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/05/15 First Use In Commerce: 2000/11/01 Printed matter, namely, booklets, brochures, bulletins; business cards, leaflets, newsletters, pamphlets, forms, and instructional materials all featuring banking services, insurance services, commercial and residential lending services; paper goods and other printed matter, namely appointment books, display units formerchandising products, personal organizers, memo pads, desk accessories, greeting cards, labels, loose leaf binders, merchandise bags, note books, paper banners, paper emblems, printed invitations, stationery writing paper and envelopes, stickers		

U.S. Registration No.	2621853	Application Date	01/14/2000
Registration Date	09/17/2002	Foreign Priority Date	NONE
Word Mark	HOMESTREET		
Design Mark	HOMESTREET		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 2000/05/15 First Use In Commerce: 2000/05/15 banking services; mortgage services, namely banking, brokerage, and lending mortgage services; insurance services, namely agencies in the field of property andcasualty, life and disability; commercial and consumer lending services; financing services; financial planning services; trust services		

U.S. Registration No.	2758516	Application Date	09/03/2002
Registration Date	09/02/2003	Foreign Priority Date	NONE
Word Mark	HOMESTREET		

Design Mark	HOMESTREET		
Description of Mark	NONE		
Goods/Services	Class 016. First use: First Use: 2000/05/15 First Use In Commerce: 2000/05/15 Printed matter, namely, booklets, brochures, bulletins, business cards, leaflets, newsletters, pamphlets, forms, and instructional materials all featuring banking services, mortgage services, insurance services, financial services, commercial and residential lending services; paper goods and other printed matter, namely, [appointment books,] memo pads, desk accessories, labels, loose leaf binders, merchandise bags, note books, paper banners, [paper emblems,] paper bags, [personal organizers,] posters, printed invitations, printed emblems, stationery writing paper and envelopes, stickers, [bookmarks;] display units for merchandising products, greeting cards		

U.S. Registration No.	4288678	Application Date	06/18/2012
Registration Date	02/12/2013	Foreign Priority Date	NONE
Word Mark	HOMESTREET		
Design Mark	HOMESTREET		
Description of Mark	NONE		
Goods/Services	Class 036. First use: First Use: 1990/11/00 First Use In Commerce: 1990/11/00 Advice relating to investments and financial aspects of retirement; financial and investment services, namely, management and brokerage in the fields of mutual funds, stocks, bonds, annuities, and other securities, and the investment of funds of others; financial planning and investment advisory services; investment of funds for others; insurance services, namely, agencies in the field of long term care insurance; credit card services; debit card services; electronic payment, namely, electronic processing and transmission of bill payment data; online banking services		

U.S. Registration No.	4793414	Application Date	10/01/2014
Registration Date	08/18/2015	Foreign Priority Date	NONE
Word Mark	HOMESTREET BANK		

Design Mark	
Description of Mark	The mark consists of the words "HOMESTREET" and "BANK" with brackets around "HOMESTREET".
Goods/Services	Class 036. First use: First Use: 2013/02/03 First Use In Commerce: 2013/02/03 Banking services; mortgage services, namely, banking, brokerage, and lending mortgage services; insurance services, namely, agencies in the field of property and casualty, life and disability; commercial and consumer lending services; financing services; financial planning services; advice relating to investments and financial aspects of retirement; financial and investment services, namely, management and brokerage in the fields of mutual funds, stocks, bonds, annuities, and other securities, and the investment of funds of others; financial planning and investment advisory services; investment of funds for others; insurance services, namely, agencies in the field of long term care insurance; credit card services; debit card services; electronic payment, namely, electronic processing and transmission of bill payment data; online banking services

U.S. Registration No.	4862391	Application Date	03/10/2015
Registration Date	12/01/2015	Foreign Priority Date	NONE

Word Mark	HOMESTREET BANK
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Design Mark	
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Description of Mark	The mark consists of the word "HOMESTREET" in white with blue brackets around it and the word "BANK" in blue, all of which appears on a black background.
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Goods/Services	Class 036. First use: First Use: 2013/02/03 First Use In Commerce: 2013/02/03 Banking services; mortgage services, namely, banking, brokerage, and lending mortgage services; insurance services, namely, agencies in the field of property and casualty, life and disability; commercial and consumer lending services; financing services; financial planning services; advice relating to investments and financial aspects of retirement; financial and investment services, namely, management and brokerage in the fields of mutual funds, stocks, bonds, annuities, and other securities, and the investment of funds of others; financial planning and investment advisory services; investment of funds for others; insurance services, namely, agencies in the field of long term care insurance; credit card services; debit card services; electronic payment services, namely, electronic processing and subsequent transmission of billpayment data; online banking services
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Signature	/stuart dunwoody/
Name	Stuart Dunwoody
Date	04/19/2017

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

7 HOMESTREET, INC., a Washington
8 corporation,

9 Opposer,

10 v.

11 JOHN SANTO, an individual,

12 Applicant.

Opposition No.

Application Serial No. 87/189,473

NOTICE OF OPPOSITION

13 TO THE COMMISSIONER FOR TRADEMARKS

14 TRADEMARK TRIAL AND APPEAL BOARD:

15 Homestreet, Inc., a Washington corporation having a place of business at 601 Union
16 Street, Seattle, Washington 98101 (hereinafter "Opposer"), believes that it will be damaged by
17 registration of the trademark HOME STREET HOME as requested by Application Serial
18 No. 87/189,473, in International Class 25, and hereby opposes the same. As grounds for the
19 opposition, Opposer alleges as follows.

20 1. On information and belief, John Santo is an individual with a place of business at
21 3564 Avalon Park Blvd. E, Suite 1, #202, Orlando, Florida 32828 (hereinafter "Applicant").

22 2. Opposer is the owner of six U.S. Trademark Registrations for marks consisting of
23 HOMESTREET or [HomeStreet] Bank and design (the "Homestreet Marks"), for various goods
24 and services in International Classes 16 and 36: Reg. No. 2,586,213, Reg. No. 2,621,853, Reg.
25 No. 2,758,516, Reg. No. 4,288,678, Reg. No. 4,793,414, and Reg. No. 4,862,391. Copies of
26 certificates for these registrations are attached as Exhibit A. In addition to use in connection
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NOTICE OF OPPOSITION - 1

4826-7677-3447v.1 0090522-000053

Davis Wright Tremaine LLP
LAW OFFICES
Suite 2200 · 1201 Third Avenue
Seattle, Washington 98101-3045
(206) 622-3150 · Fax: (206) 757-7700

1 with goods and services claimed in these registrations, Opposer has also, since a time earlier than
2 any use by Applicant of its proposed HOME STREET HOME mark, applied Homestreet Marks
3 to clothing in International Class 25, including polo shirts, t-shirts, caps, fleece jackets and
4 oxford shirts.

5 3. The mark HOME STREET HOME subsumes the entirety of Opposer's
6 HOMESTREET mark and so resembles Opposer's HOMESTREET mark when used in
7 association with the goods claimed by Application Serial No. 87/189,473, as to be likely to cause
8 confusion, or to cause mistake, or to deceive within the meaning of Section 2(d) of the Lanham
9 Act, 15 U.S.C. § 1052(d).

10 4. Opposer will be damaged by the registration sought by Applicant insofar as the
11 registration will be *prima facie* evidence of the validity of the registration, of Applicant's
12 ownership of the mark HOME STREET HOME for the goods claimed by Application Serial
13 No. 87/189,473, and of Applicant's exclusive right to use the mark HOME STREET HOME in
14 association with the goods claimed by Application Serial No. 87/189,473 when, in fact,
15 Applicant is not entitled to such rights by virtue of Opposer's prior and continuous use of the
16 Homestreet Marks.

17 5. Based upon the foregoing, registration of the mark HOME STREET HOME as
18 requested by Application Serial No. 87/189,473, filed September 30, 2016, is likely to cause
19 injury and damage to Opposer.

20 WHEREFORE, Opposer respectfully requests that registration of the mark HOME
21 STREET HOME claimed by Application Serial No. 87/189,473, be denied under Section 2(d) of
22 the Lanham Act, 15 U.S.C. § 1052(d), and that this Opposition be sustained.

23 Please charge the filing fee of US \$400.00 to Deposit Account No. 04-0258 of Opposer's
24 counsel noted below.

1 Please direct all correspondence to Stuart R. Dunwoody of Davis Wright Tremaine LLP
2 at the following address:

3 Stuart R. Dunwoody
4 Davis Wright Tremaine LLP
5 1201 Third Avenue, Suite 2200
6 Seattle, WA 98101-3045
7 Email: stuardunwoody@dwt.com

8 Please direct all telephone calls to Stuart Dunwoody at 206-757-8034.

9 DATED this 19th day of April, 2017.

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Davis Wright Tremaine LLP
Attorneys for Opposer

By Stuart R. Dunwoody/
Stuart R. Dunwoody
1201 Third Avenue, Suite 2200
Seattle, WA 98101-3045
Tel: 206-757-8034
Fax: 206-757-7034
Email: stuardunwoody@dwt.com

EXHIBIT A

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38, and 50

Reg. No. 2,586,213

United States Patent and Trademark Office

Registered June 25, 2002

**TRADEMARK
PRINCIPAL REGISTER**

HOMESTREET

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET
SEATTLE, WA 981012326

FOR: PRINTED MATTER, NAMELY, BOOKLETS, BROCHURES, BULLETINS; BUSINESS CARDS, LEAFLETS, NEWSLETTERS, PAMPHLETS, FORMS, AND INSTRUCTIONAL MATERIALS ALL FEATURING BANKING SERVICES, INSURANCE SERVICES, COMMERCIAL AND RESIDENTIAL LENDING SERVICES; PAPER GOODS AND OTHER PRINTED MATTER, NAMELY APPOINTMENT BOOKS, DISPLAY UNITS FOR MERCHANDISING

PRODUCTS, PERSONAL ORGANIZERS, MEMO PADS, DESK ACCESSORIES, GREETING CARDS, LABELS, LOOSE LEAF BINDERS, MERCHANDISE BAGS, NOTE BOOKS, PAPER BANNERS, PAPER EMBLEMS, PRINTED INVITATIONS, STATIONERY WRITING PAPER AND ENVELOPES, STICKERS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 5-15-2000; IN COMMERCE 11-1-2000.

SN 76-030,142, FILED 4-20-2000.

DOMINICK J. SALEMI, EXAMINING ATTORNEY

Int. Cl.: 36

Prior U.S. Cls.: 100, 101, and 102

Reg. No. 2,621,853

United States Patent and Trademark Office

Registered Sep. 17, 2002

**SERVICE MARK
PRINCIPAL REGISTER**

HOMESTREET

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET
SEATTLE, WA 981012326 BY CHANGE OF NAME
CONTINENTAL, INC. (WASHINGTON CORPORATION) SEATTLE, WA 981012326

FOR: BANKING SERVICES; MORTGAGE SERVICES, NAMELY BANKING, BROKERAGE, AND LENDING MORTGAGE SERVICES; INSURANCE SERVICES, NAMELY AGENCIES IN THE FIELD OF PROPERTY AND CASUALTY, LIFE AND DIS-

ABILITY; COMMERCIAL AND CONSUMER LENDING SERVICES; FINANCING SERVICES; FINANCIAL PLANNING SERVICES; TRUST SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102),

FIRST USE 5-15-2000; IN COMMERCE 5-15-2000.

SN 75-896,983, FILED 1-14-2000.

TONI HICKEY, EXAMINING ATTORNEY

Int. Cl.: 16

Prior U.S. Cls.: 2, 5, 22, 23, 29, 37, 38 and 50

Reg. No. 2,758,516

United States Patent and Trademark Office

Registered Sep. 2, 2003

**TRADEMARK
PRINCIPAL REGISTER**

HOMESTREET

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET, SUITE 2000
SEATTLE, WA 981912326

FOR: PRINTED MATTER, NAMELY, BOOKLETS, BROCHURES, BULLETINS, BUSINESS CARDS, LEAFLETS, NEWSLETTERS, PAMPHLETS, FORMS, AND INSTRUCTIONAL MATERIALS ALL FEATURING BANKING SERVICES, MORTGAGE SERVICES, INSURANCE SERVICES, FINANCIAL SERVICES, COMMERCIAL AND RESIDENTIAL LENDING SERVICES; PAPER GOODS AND OTHER PRINTED MATTER, NAMELY, APPOINTMENT BOOKS, MEMO PADS, DESK ACCESSORIES, LABELS, LOOSE LEAF BINDERS, MERCHANDISE BAGS, NOTE BOOKS, PAPER BANNERS, PAPER

EMBLEMS, PAPER BAGS, PERSONAL ORGANIZERS, POSTERS, PRINTED INVITATIONS, PRINTED EMBLEMS, STATIONERY WRITING PAPER AND ENVELOPES, STICKERS, BOOKMARKS; DISPLAY UNITS FOR MERCHANDISING PRODUCTS, GREETING CARDS, IN CLASS 16 (U.S. CLS. 2, 5, 22, 23, 29, 37, 38 AND 50).

FIRST USE 5-15-2000; IN COMMERCE 5-15-2000.

OWNER OF U.S. REG. NO. 2,586,213.

SER. NO. 76-446,413, FILED 9-3-2002.

G. T. GLYNN, EXAMINING ATTORNEY

United States of America
United States Patent and Trademark Office

HOMESTREET

Reg. No. 4,288,678

Registered Feb. 12, 2013

Int. Cl.: 36

SERVICE MARK

PRINCIPAL REGISTER

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET
SEATTLE, WA 981012326

FOR: ADVICE RELATING TO INVESTMENTS AND FINANCIAL ASPECTS OF RETIREMENT; FINANCIAL AND INVESTMENT SERVICES, NAMELY, MANAGEMENT AND BROKERAGE IN THE FIELDS OF MUTUAL FUNDS, STOCKS, BONDS, ANNUITIES, AND OTHER SECURITIES, AND THE INVESTMENT OF FUNDS OF OTHERS; FINANCIAL PLANNING AND INVESTMENT ADVISORY SERVICES; INVESTMENT OF FUNDS FOR OTHERS; INSURANCE SERVICES, NAMELY, AGENCIES IN THE FIELD OF LONG TERM CARE INSURANCE; CREDIT CARD SERVICES; DEBIT CARD SERVICES; ELECTRONIC PAYMENT, NAMELY, ELECTRONIC PROCESSING AND TRANSMISSION OF BILL PAYMENT DATA; ONLINE BANKING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 11-0-1990; IN COMMERCE 11-0-1990.

THE MARK CONSISTS OF STANDARD CHARACTERS WITHOUT CLAIM TO ANY PARTICULAR FONT, STYLE, SIZE, OR COLOR.

OWNER OF U.S. REG. NOS. 2,586,213, 3,518,515 AND OTHERS.

SER. NO. 85-654,206, FILED 6-18-2012.

CAITLIN WATTS-FITZGERALD, EXAMINING ATTORNEY



Lisa Street Lee

Acting Director of the United States Patent and Trademark Office

United States of America

United States Patent and Trademark Office

[HomeStreet] Bank

Reg. No. 4,793,414

Registered Aug. 18, 2015

Int. Cl.: 36

SERVICE MARK

PRINCIPAL REGISTER

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET
SUITE 2000
SEATTLE, WA 98101

FOR: BANKING SERVICES; MORTGAGE SERVICES, NAMELY, BANKING, BROKERAGE, AND LENDING MORTGAGE SERVICES; INSURANCE SERVICES, NAMELY, AGENCIES IN THE FIELD OF PROPERTY AND CASUALTY, LIFE AND DISABILITY; COMMERCIAL AND CONSUMER LENDING SERVICES; FINANCING SERVICES; FINANCIAL PLANNING SERVICES; ADVICE RELATING TO INVESTMENTS AND FINANCIAL ASPECTS OF RETIREMENT; FINANCIAL AND INVESTMENT SERVICES, NAMELY, MANAGEMENT AND BROKERAGE IN THE FIELDS OF MUTUAL FUNDS, STOCKS, BONDS, ANNUITIES, AND OTHER SECURITIES, AND THE INVESTMENT OF FUNDS OF OTHERS; FINANCIAL PLANNING AND INVESTMENT ADVISORY SERVICES; INVESTMENT OF FUNDS FOR OTHERS; INSURANCE SERVICES, NAMELY, AGENCIES IN THE FIELD OF LONG TERM CARE INSURANCE; CREDIT CARD SERVICES; DEBIT CARD SERVICES; ELECTRONIC PAYMENT, NAMELY, ELECTRONIC PROCESSING AND TRANSMISSION OF BILL PAYMENT DATA; ONLINE BANKING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-3-2013; IN COMMERCE 2-3-2013.

OWNER OF U.S. REG. NOS. 2,586,213, 2,758,516 AND OTHERS.

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

THE MARK CONSISTS OF THE WORDS "HOMESTREET" AND "BANK" WITH BRACKETS AROUND "HOMESTREET".

SER. NO. 86-411,498, FILED 10-1-2014.

TOBY BULLOFF, EXAMINING ATTORNEY



Michelle K. Lee

Director of the United States
Patent and Trademark Office

United States of America

United States Patent and Trademark Office



Reg. No. 4,862,391
Registered Dec. 1, 2015
Int. Cl.: 36

HOMESTREET, INC. (WASHINGTON CORPORATION)
601 UNION STREET, SUITE 2000
SEATTLE, WA 98101

SERVICE MARK
PRINCIPAL REGISTER

FOR: BANKING SERVICES; MORTGAGE SERVICES, NAMELY, BANKING, BROKERAGE, AND LENDING MORTGAGE SERVICES; INSURANCE SERVICES, NAMELY, AGENCIES IN THE FIELD OF PROPERTY AND CASUALTY, LIFE AND DISABILITY; COMMERCIAL AND CONSUMER LENDING SERVICES; FINANCING SERVICES; FINANCIAL PLANNING SERVICES; ADVICE RELATING TO INVESTMENTS AND FINANCIAL ASPECTS OF RETIREMENT; FINANCIAL AND INVESTMENT SERVICES, NAMELY, MANAGEMENT AND BROKERAGE IN THE FIELDS OF MUTUAL FUNDS, STOCKS, BONDS, ANNUITIES, AND OTHER SECURITIES, AND THE INVESTMENT OF FUNDS OF OTHERS; FINANCIAL PLANNING AND INVESTMENT ADVISORY SERVICES; INVESTMENT OF FUNDS FOR OTHERS; INSURANCE SERVICES, NAMELY, AGENCIES IN THE FIELD OF LONG TERM CARE INSURANCE; CREDIT CARD SERVICES; DEBIT CARD SERVICES; ELECTRONIC PAYMENT SERVICES, NAMELY, ELECTRONIC PROCESSING AND SUBSEQUENT TRANSMISSION OF BILL PAYMENT DATA; ONLINE BANKING SERVICES, IN CLASS 36 (U.S. CLS. 100, 101 AND 102).

FIRST USE 2-3-2013; IN COMMERCE 2-3-2013.

OWNER OF U.S. REG. NOS. 2,621,853, 2,758,516, AND 4,288,678.

THE COLOR(S) BLUE, BLACK, AND WHITE IS/ARE CLAIMED AS A FEATURE OF THE MARK.

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

THE MARK CONSISTS OF THE WORD "HOMESTREET" IN WHITE WITH BLUE BRACKETS AROUND IT AND THE WORD "BANK" IN BLUE, ALL OF WHICH APPEARS ON A BLACK BACKGROUND.



Michelle K. Lee
Director of the United States
Patent and Trademark Office

SER. NO. 86-558,985, FILED 3-10-2015.

JASON MALASHEVICH, EXAMINING ATTORNEY